

O/1219/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 4041058

BY PLUSHSE16

TO REGISTER THE FOLLOWING TRADE MARK:

PLUSHTM

IN CLASSES 35, 36 AND 37

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 449090

BY BARRY BUTT

BACKGROUND AND PLEADINGS

1. On 18 April 2024, PlushSE16 (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 17 May 2024, and registration is sought for services in classes 35, 36 and 37.¹

2. On 13 August 2024, the application was opposed in full by Barry Butt (“the opponent”), on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”),² relying upon UKTM no. 3846759, for the trade mark ‘PLUSHH:’. The earlier mark was filed on 7 November 2022 and became registered on 17 February 2023. The opponent relies upon all its class 37 services for which the earlier mark is registered.³

3. The opponent claims that there is sufficient similarity between the marks and the respective services to result in a likelihood of confusion on the part of the public, including a likelihood of association.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. The opponent’s mark qualifies as an earlier mark under section 6(1) of the Act. As it had not completed its registration procedure more than five years before the application date for the contested mark, it is not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all the goods and services for which the earlier mark is registered without having to establish genuine use.

6. Neither party filed evidence and neither party requested a hearing. Both parties filed written submissions in lieu of a hearing. This decision is taken following careful consideration of the papers.

¹ See services comparison at paragraph [25].

² The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

³ See services comparison at paragraph [25].

7. The opponent is represented by Handsome I.P. Ltd; the applicant represents itself.

PRELIMINARY ISSUES

8. Several points have been raised by the applicant in its counterstatement and written submissions.⁴ Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

9. The applicant points to the differing target markets of the respective parties and their services, submitting that such differences will prevent a likelihood of confusion. However, for the avoidance of doubt, I must carry out a notional assessment based upon the parties' respective marks and the services contained in their specifications. The actual target market and the activities they carry out are not relevant to my assessment.⁵

10. Additionally, the applicant claims that its mark has been in continuous use for over 22 years without any instances of confusion with the opponent's mark. On this basis, the applicant submits that the lack of prior disputes or confusion supports its right to continue using the mark and completing its registration.

11. With regards to an absence of any evidence of actual confusion, in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

"Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

12. I have no evidence before me of how (or to what extent) the applicant's mark has been used in practice. Consequently, it is impossible to assess whether the absence

⁴ Written submissions in lieu of a hearing, dated 11 July 2025.

⁵ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66]; *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22].

of evidence of confusion is due to the fact that the marks at issue are not confusingly similar or due to other matters relating to the way in which the marks have been used (or not, as the case may be). Therefore, this line of argument does not assist the applicant.

13. Furthermore, the applicant submits that it owns goodwill in its mark on the basis that its use predates any registration or use by the opponent, thus establishing a significant precedent for honest concurrent use, as well as establishing that the mark has acquired distinctive character through its extensive and longstanding use in the local community.

14. In this regard, it is noted that the applicant has not submitted any evidence in support of its claims. As for the applicant's comments that its use of the contested mark predates any registration or use by the opponent, the Tribunal Practice Notice ("TPN") 4/2009, deals with defences to claims under sections 5(1) and 5(2) of the Act. Here it states that the viability of defences based on use of the contested mark which precedes the date of registration of the earlier mark was considered by Ms Anna Carboni, sitting as the Appointed Person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O/211/09. Ms Carboni rejected such defences as being wrong in law. Accordingly, any claim that the applicant was trading prior to the opponent's registration is not relevant to the matter before me, and I will make no further mention of it.

15. Additionally, it is noted that the applicant makes reference to section 5(1) of the Act in its counterstatement and section 5(4)(a) of the Act in its written submissions.⁶ However, in this regard, it should be noted that as the opposition is based on section 5(2)(b) only, the applicant is not required to provide any submissions in relation to these other grounds. Accordingly, I will say no more on the matter of sections 5(1) and 5(4)(a) of the Act.

⁶ Written submissions in lieu of a hearing, dated 11 July 2025.

DECISION

Section 5(2)(b): legislation and case law

16. Section 5(2)(b) and 5A of the Act read as follows:

“(2) A trade mark shall not be registered if because-

(a) [...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

[...]

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

17. I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *EU courts in Sabel BV v Puma AG, Case C-251/95, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97, Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97, Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98, Matratzen Concord GmbH v OHIM, Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P*:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

19. In *Canon*, Case C-39/97, the CJEU stated that:

“23. In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

20. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that “complementary” means:

“82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

22. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.⁷

23. In the case of goods and services, the terms used should not be interpreted widely but confined to the core of the possible meanings attributable to the terms: *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1) [2024] UKSC 36*, at [365].

24. Pursuant to section 60A of the Act, I am mindful of the fact that the services are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes. I also note that in *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity (between goods and services) requires the exercise of common sense.

25. The competing services are as follows:

⁷ Paragraph 5

Earlier mark	Application
<p><u>Class 37</u> Building and construction services; Advisory services relating to the repair of buildings; Advisory services relating to the maintenance of buildings; Advisory services relating to the alteration of buildings; Renovation of buildings; Advisory services relating to the construction of buildings; Building project management services.</p>	<p><u>Class 35</u> Auctioneering of property.</p> <p><u>Class 36</u> Property leasing [real estate property only]; Leasing of freehold property; Rental of real estate and property; Property management; Management of property; Leasing of real estate property; Property (Real estate -) management; Real estate property management; Mortgaging relating to property and land; Financing of property development; Arranging of leases for the rental of commercial property; Property asset management services; Commercial property investment services; Administration of property portfolios; Financing of property loans; Provision of finance for property development; Real estate agency services relating to the purchase and sale of land; Real estate investment; Real estate agency; Property (Real estate -) investment; Real estate agencies; Real estate agency services; Assisting in the acquisition of real estate; Residential real estate agency services; Arranging letting of real estate; Arranging the provision of finance for real estate purchase; Agencies or brokerage for leasing or renting of land; Real estates evaluation (fixing of a price); Renting of commercial premises; Investing of funds; Money brokerage; Lease purchase finance; Financial services for the purchase of real estate.</p> <p><u>Class 37</u> Construction of property; Property development services [construction]; Advisory services relating to the renovation of property; Construction of residential properties; Building of commercial properties.</p>

Class 35 of the contested application

Auctioneering of property

26. The contested services concern the selling of property through a competitive bidding process, i.e. an auction. Such services are rendered by a company specialised in property auctions. I note that these services are not present in the specification of the earlier mark. The earlier mark contains services in class 37, namely *building and construction services; advisory services relating to the repair of buildings; advisory services relating to the maintenance of buildings; advisory services relating to the alteration of buildings; renovation of buildings; advisory services relating to the construction of buildings; and building project management services*. I am of the view that the contested services and the opponent's services have a different nature and a different specific purpose. Whilst I note that they may target the same consumer, their methods of use and channels of trade will differ. Additionally, they are neither complementary, nor are they in competition. Therefore, I find the services at issue to be dissimilar.

Class 36 of the contested application

27. In regard to the contested services in class 36, I will firstly provide an overview of the applicant's services and will then provide my overall analysis of their similarity in respect of the opponent's class 37 services.

Overview of the applicant's class 36 services:

Property leasing [real estate property only]; Leasing of freehold property; Rental of real estate and property; Leasing of real estate property; Arranging of leases for the rental of commercial property; Arranging letting of real estate; Renting of commercial premises

28. Broadly speaking, these contested services are concerned with the leasing, letting and rental of various types of property.

Property management; Management of property; Property (Real estate -) management; Real estate property management

29. These contested services are concerned with property management, namely the administration, operation and oversight of residential or commercial properties on behalf of the owner.

Mortgaging relating to property and land; Financing of property development; Financing of property loans; Provision of finance for property development; Arranging the provision of finance for real estate purchase; Lease purchase finance; Financial services for the purchase of real estate

30. These contested services are financial services relating to the provision of mortgages and other forms of finance used to lease, purchase and/or develop property or land.

Commercial property investment services; Real estate investment; Property (Real estate -) investment; Investing of funds

31. Broadly speaking, the above investment services are all financial services involving the placement of money into assets, such as commercial property and real estate, etc, with the expectation of generating future income or profit from the investment.

Real estate agency services relating to the purchase and sale of land; Real estate agency; Real estate agencies; Real estate agency services; Assisting in the acquisition of real estate; Residential real estate agency services; Agencies or brokerage for leasing or renting of land

32. The above contested services assist people in the buying, selling, renting, leasing or management of real estate (property) or land. The agencies act as professional intermediaries, providing services such as the valuation and marketing of property/land, the finding of suitable buyers/tenants, the arrangement of property/land

viewings, the management of property/land purchase offers, and negotiation services in relation to the purchase price of property/land.

Property asset management services

33. Broadly speaking, these services are a type of financial service in the form of property management, which focusses on adding financial value and receiving financial returns from property, i.e. as a form of investment. The management services will involve, amongst other things, the management and oversight of property assets, such as land and buildings, etc, in order to, for example optimise their value.

Administration of property portfolios

34. In general, the above service is a type of financial service involving the management of a collection of properties in order to meet financial goals. This service involves, amongst other things, the tracking of income, managing tenants, handling maintenance issues, and ensuring legal compliance, for example, in regard to energy performance certificates (EPC's) and safety checks, etc.

Real estates evaluation (fixing of a price)

35. This service relates to the professional, unbiased process of determining a property's financial value at a specific time by taking its size, condition, location and comparable sales in the area, etc., into account. This process is crucial for a variety of transactions and legal matters, including the buying and selling of property/land, mortgage lending, and settling estates or divorces, etc.

Money brokerage

36. In general, the above service is a financial service provided by an individual or organisation, who act as an intermediary, facilitating the lending and borrowing of money between, for example, banks and other financial organisations.

37. Accordingly, in view of the above analysis, I find the contested services in class 36 to broadly concern the following: various financial services, real estate agency services, property management services, and real estate leasing and evaluation services. None of the above class 36 services are included in the opponent's specification. The opponent's services at issue all fall in class 37 in respect of *building and construction services; advisory services relating to the repair of buildings; advisory services relating to the maintenance of buildings; advisory services relating to the alteration of buildings; renovation of buildings; advisory services relating to the construction of buildings and building project management services*. Having compared the competing services at issue I am of the view that whilst they may target the same consumer, their nature, purpose and trade channels will differ. Furthermore, I find that the services are neither complementary, nor are they in competition. As such, even though the services may overlap in users, this factor alone is too tenuous to warrant a finding of similarity between the services at issue. Furthermore, the opponent has not provided any persuasive submissions in relation to the comparison between the competing services beyond its suggestion that they are similar. Accordingly, I find the services at issue to be dissimilar.

Class 37 of the contested application

Construction of property; Property development services [construction]; Construction of residential properties; Building of commercial properties

38. The above contested services all fall within the broader term *building and construction services* contained in the specification of the earlier mark. The services are therefore identical on the principle outlined in *Meric*.

Advisory services relating to the renovation of property

39. The above services concern the provision of guidance, help and advice, etc., in relation to the renovation of property. These services will be provided by an expert within the field of property renovation. The opponent's specification contains the terms *advisory services relating to the repair of buildings; advisory services relating to the alteration of buildings; and renovation of buildings*. I find that these services overlap

with the contested services. Accordingly, the services are identical in line with the principle set out in *Meric*.

40. As some degree of similarity between the services is necessary to engage the test for likelihood of confusion, my findings above mean that the opposition aimed against those services I have found to be dissimilar will fail.⁸ Accordingly, for ease of reference, the opposition under section 5(2)(b) fails against the following services:

Class 35 Auctioneering of property.

Class 36 Property leasing [real estate property only]; Leasing of freehold property; Rental of real estate and property; Property management; Management of property; Leasing of real estate property; Property (Real estate -) management; Real estate property management; Mortgaging relating to property and land; Financing of property development; Arranging of leases for the rental of commercial property; Property asset management services; Commercial property investment services; Administration of property portfolios; Financing of property loans; Provision of finance for property development; Real estate agency services relating to the purchase and sale of land; Real estate investment; Real estate agency; Property (Real estate -) investment; Real estate agencies; Real estate agency services; Assisting in the acquisition of real estate; Residential real estate agency services; Arranging letting of real estate; Arranging the provision of finance for real estate purchase; Agencies or brokerage for leasing or renting of land; Real estates evaluation (fixing of a price); Renting of commercial premises; Investing of funds; Money brokerage; Lease purchase finance; Financial services for the purchase of real estate.

⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

The average consumer and the nature of the purchasing act

41. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).

42. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

43. The average consumer of the class 37 services at issue is likely to be a professional user from within the building and construction sector, though it is acknowledged that in relation to some of the services, such as ‘advisory services relating to the renovation of property’, the average consumer may also comprise members of the general public. Given the services at issue, the frequency of purchase and their cost will vary depending on their nature and type. The average consumer, consisting of both professional consumers and members of the general public will likely to pay a higher-than-average degree of attention when purchasing services, such as the various ‘advisory services’ at issue, as several factors will be considered during their selection, such as experience, reputation and cost, etc. However, I acknowledge that in the case of building, construction and renovation services, for example, the level of attention paid by the average consumer, namely a professional from within the building and construction sector, is likely to be high.

44. The services are likely to be purchased from bricks and mortar premises such as showrooms, from online websites operated by traders or from advertisements (such as flyers, posters or online adverts). Visual considerations are likely to dominate the selection process. However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Comparison of the marks

45. It is clear from *Sabel BV v. Puma AG* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

46. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

47. The trade marks to be compared are as follows:

The opponent's mark	The applicant's mark
PLUSHH:	PLUSH™

Overall impression

48. The opponent's mark consists of the word 'PLUSHH', presented in a standard, uppercase typeface followed by a colon (':'). Whilst the colon contributes to the distinctive character of the mark, the word 'PLUSHH' dominates the overall impression.

49. The applicant's mark consists of the word 'PLUSH', presented in a standard, uppercase typeface followed by the letters '™' presented in a smaller, superscript typeface, which merely indicates that the word 'PLUSH' is being used as a trade mark. As the '™' element is devoid of distinctive character it is the word 'PLUSH' that dominates the overall impression.

Visual comparison

50. Visually, the competing marks identically share the same first five letters, i.e. 'PLUSH'. This similarity appears at the beginning of the respective words, being where consumers tend to focus⁹ as this position is generally considered to have more impact due to consumers in the UK reading from left to right. The marks differ in the last letter 'H' and colon at the end of the opponent's mark, and the letters '™' at the end of the applicant's mark. However, with regards to the colon and '™' elements, due to their non-distinctive nature, I am of the view that these will likely be overlooked by at least a significant proportion of the relevant consumers. Accordingly, weighing up the similarities with the differences, I find the marks to be visually similar to a high degree.

⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Aural comparison

51. The marks identically coincide in the string of letters 'PLUSH'. They differ in the last letter 'H' in the opponent's mark. However, the competing marks have the same number of syllables, i.e. one. I find the aural difference created by the additional 'H' in the opponent's mark to be negligible or non-existent. Therefore, I am of the view that both marks will be identically pronounced as 'PLUSH'. The colon element in the opponent's mark will not be articulated. As for the '™' element in the applicant's mark, as previously stated, this will likely be overlooked and therefore will not be articulated. Accordingly, I find the marks to be aurally identical.

Conceptual comparison

52. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

53. With regards to the word 'PLUSHH' in the opponent's mark, I am of the view that there are a number of possible scenarios. The first is that conceptually the mark 'PLUSHH' may be perceived by a proportion of consumers as an invented word. The second possibility is for consumers to see 'PLUSHH', articulate it in their heads as 'PLUSH', and immediately think of the ordinary meaning of that word, namely, *inter alia*, something that is very smart or expensive. The third possibility is that consumers see 'PLUSHH', merely as a fanciful and/or deliberate misspelling of the common dictionary word 'PLUSH', and immediately think of the ordinary meaning of that word.

54. With regards to the applicant's mark, due to the wholly descriptive nature of the element '™' along with its size and position within the mark, I am of the view that this element will be overlooked by consumers. With regards to the word 'PLUSH' this will be an immediately recognisable word for the average consumer, namely, *inter alia*, something that is very smart or expensive.

55. Accordingly, for the proportion of consumers who perceive the opponent's mark as an invented word, the marks are conceptually dissimilar. However, for those consumers who see the word 'PLUSHH', as a fanciful and/or deliberate misspelling of the common dictionary word 'PLUSH', or for those who articulate the word 'PLUSHH' in their heads as 'PLUSH', and immediately think of the ordinary meaning of that word, for these groups of average consumers, the marks are conceptually identical as they immediately conjure the ordinary meaning of the dictionary word 'PLUSH'. On balance, I am of the view that those who perceive the marks as conceptually identical will represent a significant proportion of the relevant public.

Distinctive character of the opponent's mark

56. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of

commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

57. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it, however, the opponent has not pleaded that the distinctiveness of its mark has been enhanced through use, nor has it filed any evidence to support such a finding. Consequently, I have only the inherent position to consider.

58. The earlier mark is a word mark comprising the word and punctuation mark ‘PLUSHH:’. As previously stated, I am of the view ‘PLUSHH’ may be perceived by a proportion of consumers as an invented word. In which case the mark, as a whole, is inherently highly distinctive. That said, I am of the view that some consumers on seeing the word ‘PLUSHH’, may articulate it in their heads as ‘PLUSH’, and immediately think of the ordinary dictionary meaning of that word, i.e., something that is very smart or expensive. Similarly, there is also a possibility that the consumer may perceive ‘PLUSHH’, merely as a fanciful and/or deliberate misspelling of the common dictionary word ‘PLUSH’, and again, immediately think of the ordinary meaning of that word. Therefore, for those who perceive the word as ‘PLUSH’ or immediately think of ‘PLUSH’ on seeing the mark, this may be seen as allusive in respect of the services, for example, insofar as their quality and characteristics are concerned. Accordingly, for this proportion of consumers, I find the earlier mark, as a whole, to be inherently distinctive to a medium degree.

Likelihood of confusion

59. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned

above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

60. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and the goods and services down to the responsible undertakings being the same or related.

61. Earlier in the decision I found that:

- The parties' services at issue are identical.
- The average consumer for the services at issue is a member of the general public or a professional user from within the building and construction sector, who will pay at least a higher-than-average degree of attention during the purchasing process.
- The purchasing process for the services is predominantly visual, although I do not discount an aural component.
- The marks are visually highly similar; aurally identical; and conceptually dissimilar or identical depending on how the mark is perceived.
- The earlier mark is either inherently highly distinctive, or inherently distinctive to a medium degree depending on how it is perceived.

62. Taking all the factors into account and bearing in mind the imperfect recollection of the average consumer, it is my view that there is a likelihood of the marks being

mistaken one for the other, especially bearing in mind the identical services at issue. The verbal elements in the respective marks, namely PLUSHH and PLUSH respectively are near identical, and I am of the view that the average consumer may easily not recall that there is an extra 'H' and colon at the end of the opponent's mark, even when they are paying a higher degree of attention. As for the '™' present in the application, this is a wholly descriptive/non-distinctive element, merely indicating that the mark is being used as a trade mark, and therefore I am of the view that this element will be overlooked. Accordingly, taking all these factors into account, I find that there is a likelihood of direct confusion for all services that I have found to be identical.

CONCLUSION

63. The opposition under section 5(2)(b) is partially successful. Therefore, the applicant's mark is hereby, subject to any successful appeal of my decision, refused registration for the following services:

Class 37 Construction of property; Property development services [construction]; Advisory services relating to the renovation of property; Construction of residential properties; Building of commercial properties.

64. The applicant's mark can proceed to registration in respect of the following services for which the opposition has been unsuccessful:

Class 35 Auctioneering of property.

Class 36 Property leasing [real estate property only]; Leasing of freehold property; Rental of real estate and property; Property management; Management of property; Leasing of real estate property; Property (Real estate -) management; Real estate property management; Mortgaging relating to property and land; Financing of property development; Arranging of leases for the rental of commercial property; Property asset management services; Commercial property investment services; Administration of property portfolios; Financing of property loans; Provision of finance for property development; Real estate agency

services relating to the purchase and sale of land; Real estate investment; Real estate agency; Property (Real estate -) investment; Real estate agencies; Real estate agency services; Assisting in the acquisition of real estate; Residential real estate agency services; Arranging letting of real estate; Arranging the provision of finance for real estate purchase; Agencies or brokerage for leasing or renting of land; Real estates evaluation (fixing of a price); Renting of commercial premises; Investing of funds; Money brokerage; Lease purchase finance; Financial services for the purchase of real estate.

COSTS

65. On balance, I consider both parties have enjoyed a share of success, with the greater part going to the applicant, who is, in principle, entitled to a contribution towards its costs. As the applicant had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. On 21 May 2025, the applicant submitted a pro-forma for the following award of costs:

Tribunal Cost Pro Forma	
Form types	Time spent in hours/minutes
Notice of Opposition	
Notice of Cancellation	
Notice of Defence	£19/hr x 4 = £76
Considering forms filed by the other party	
TOTAL	£19/hr x 2 = £38
Official fees for the above forms	
TOTAL	
Preparing evidence/written submissions and considering and commenting on the other side's evidence/written submissions	
Description of activity	Time spent in hours/minutes
Preparing counterstatement	£19/hr x 5 = £95
TOTAL	
Preparing for a hearing	
Description of activity	Time spent in hours/minutes
TOTAL	
Other Expenses	
Description of activity	Time spent in hours/minutes
Supporting Document Evidence (Past / Archive)	£15
TOTAL	£224

66. With consideration of the above, I am guided in this decision by the scale of costs set out in Tribunal Practice Notice (“TPN”) 1/2023, as well as the guidance on how costs should be allocated to unrepresented parties such as the applicant.

67. First and foremost, I remind myself that the Tribunal awards costs on a contributory rather than a compensatory basis. It is important to note that only costs which have been incurred during, and as part of, these proceedings are relevant, such as filing official forms, evidence, written submissions etc.

68. I also take into account Mr Hobbs QC’s (as he then was) comments in *Amaro*, O/257/18:

“17. [...] an award of costs is required to reflect the effort and expenditure to which it relates without inflation for the purpose of imposing a financial penalty by way of punishment on the paying party. The determination of a ‘reasonable’ amount to award must depend on the nature and circumstances of the case at hand.”

69. Accordingly, I have set out below my assessment on the applicant’s claim made. As outlined in TPN 1/2023, I will make the award of costs on the basis of £19 per hour, which is the minimum rate of compensation allowed under The Litigants in Person (Costs and Expenses) Act 1975 (as amended).

70. I award costs to the applicant on the following basis:

Considering the notice of opposition, and filing a counterstatement: (6 hours):	£114
Preparing written submissions in lieu of a hearing (5 hours):	£95
Total	£209

71. I therefore order Barry Butt to pay PlushSE16 the sum of £209. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of December 2025

**Sam Congreve
For the Registrar**