

**O/0960/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 03743733 BY  
DAVID DEVINE  
TO REGISTER AS A TRADE MARK:**

**Hi Ho Silver**

**IN CLASS 14**

**AND**

**OPPOSITION THERETO  
UNDER NO. 433223  
BY HI HO SILVER LIMITED**

## Background & Pleadings

1. David Devine (“**the applicant**”) applied to register the mark shown on the front page of this decision in the United Kingdom. The application was filed on 16 January 2022 and was published in the Trade Marks Journal for opposition purposes on 4 February 2022 in respect of the following goods:

**Class 14:** Silver; Coins; Collectible coins; Silver bullion; Commemorative coins; Non-monetary coins; Collectable monetary coin sets; Monetary coin sets for collecting purposes; all the aforesaid goods being made of silver or predominantly made of silver; Gold coins.

2. Hi Ho Silver Limited (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In conjunction with the Section 5(2)(b) ground, this opposition was also initially based on Sections 5(3) and 5(4)(a) of the Act. However, on 28 December 2022, the opponent filed a form TM9 requesting a one month extension of time to file evidence, but the Registry refused the request. Following this, the opponent requested a CMC, which was listed, but before it was dealt with, the opponent withdrew reliance on the additional grounds with its a letter dated 25 January 2023. This was subsequently confirmed by way of letter dated 28 February 2023 by the Registry. The opponent is the proprietor of the following mark:

<b>Trade Mark no.</b>	UK00002634104
<b>Trade Mark</b>	
<b>Goods &amp; Services</b>	Classes 14, 18, 21, 35 & 42
<b>Relevant Dates</b>	Filing date: 10 September 2012
	Date of entry in register: 25 January 2013

3. Under Section 6(1) of the Act, the opponent's trade mark clearly qualifies as an earlier trade mark.
  
4. The opponent relies on the following goods and services for the purposes of this opposition proceedings:

**Class 14:** Articles of precious metals or coated therewith; jewellery; bangles, bracelets, earrings, necklaces, body piercing articles; jewellery of non precious metals; jewellery made of leather or of imitations of leather.

**Class 35:** Customer loyalty services; trade loyalty services; management of customer or trade loyalty incentive or promotional schemes; retail and wholesale services connected with the sale of a range of articles of precious metal or coated therewith; jewellery, bangles, bracelets, earrings, necklaces, body piercing articles enabling customers to conveniently view and purchase those goods from a mail order catalogue, by means of telecommunication and via an internet website all specialising in the aforesaid goods; advisory and consultancy services in connection with all the aforesaid services.

5. The opponent in its notice of opposition claims that the competing marks are highly similar. It also asserts that the competing specifications contain identical or similar goods and services.
6. The applicant filed a defence and counterstatement, denying any similarity between the marks and the goods. I note that the counterstatement contains excerpts demonstrating other marks from the Registry. Whilst I considered these, I note that they are of little, if any, relevance to these proceedings as the marks shown are not pertinent to this case. Only the competing marks are relevant for the assessment of this case.
7. As the earlier mark relied upon had been registered for more than five years on the date on which the contested application was filed, Section 6A of the Act applies. However, the applicant did not request that the opponent provides proof of use of its earlier mark as relied upon. Therefore, my assessment will be based on the notional use of the earlier mark for the goods and services that it relies upon as registered.
8. The opponent is represented by Roger Moore & Associates Limited and the applicant is unrepresented. Only the applicant filed evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

### **Applicant's Witness Statement**

9. The Applicant's evidence consists of the witness statement, dated 30 March 2023, of Pete McClelland, a full-time professional numismatist<sup>1</sup> since 2009 and member of the British Numismatic Society. The main purpose of the evidence is to demonstrate the differences between jewellery and silver coins/bullion and to offer his opinion that consumers would never confuse these two.

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<sup>1</sup> A numismatist is a collector and student of money (and coins in particular).

10. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## **Decision**

### **Section 5(2)(b)**

11. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

[...]

(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”.

12. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.
13. The principles considered in this opposition stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of Goods and Services**

14. When making the comparison, all relevant factors relating to the goods/services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, 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 complementary.”

15. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;  
(b) The respective users of the respective goods or services;  
(c) The physical nature of the goods or acts of service;  
(d) The respective trade channels through which the goods or services reach the market;  
(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;  
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

16. The General Court (“GC”) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

17. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless, the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 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.”

19. The competing goods and services to be compared are shown in the following table:

<b>Opponent's Goods and Services</b>	<b>Applicant's Goods</b>
<p><b>Class 14:</b> Articles of precious metals or coated therewith; jewellery; bangles, bracelets, earrings, necklaces, body piercing articles; jewellery of non precious metals; jewellery made of leather or of imitations of leather.</p>	<p><b>Class 14:</b> Silver; Coins; Collectible coins; Silver bullion; Commemorative coins; Non-monetary coins; Collectable monetary coin sets; Monetary coin sets for collecting purposes; all the aforesaid goods being made of silver or predominantly made of silver; Gold coins</p>
<p><b>Class 35:</b> Customer loyalty services; trade loyalty services; management of customer or trade loyalty incentive or promotional schemes; retail and wholesale services connected with the sale of a range of articles of precious metal or coated therewith; jewellery, bangles, bracelets, earrings, necklaces, body piercing articles enabling customers to conveniently view and purchase those goods from a mail order catalogue, by means of telecommunication and via an internet website all specialising in the aforesaid goods; advisory and consultancy services in connection with all the aforesaid services.</p>	

20. The opponent submitted that:

“18. The Contested Goods would all be covered by the item of the Opponent being “articles of precious metals or coated therewith” as the Contested Goods are all articles and all bar one item are limited to “all the aforesaid goods being made of silver or predominantly made of silver”. The other item is “gold coins”. As both silver and gold are precious metals, and coins are articles, the Contested Goods are all covered by the Earlier Goods meaning there is identity of goods.

19. There is also high similarity between the jewellery items in the Earlier Goods and the Contested Goods. The witness statement of Pete McClelland does not accurately compare the goods – the Earlier Goods covers ‘jewellery’ which would include both jewellery made of silver and also jewellery comprising coins, not just modern-day jewellery. It is also common to set coins into jewellery, known as ‘Gemme Numari’. Coins such as sixpences and farthings are often made into jewellery (necklaces, pendants, cufflinks etc) sometimes to signify the year of birth or other significant event.”

21. The applicant, in his counterstatement, denies any identity or similarity between the competing goods and services. I also note the comparison between silver coins and jewellery provided with the applicant’s witness statement.
22. For the purpose of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.<sup>2</sup>

Coins; Collectible coins; Commemorative coins; Non-monetary coins; Collectable monetary coin sets; Monetary coin sets for collecting purposes; all the aforesaid goods being made of silver or predominantly made of silver; Gold coins

23. I consider that the contested goods will be covered by the opponent’s broad term “*Articles of precious metals or coated therewith*”. Thus, they will be identical pursuant to *Meric* or else they are highly similar coinciding in nature, purpose, users, trade channels, and be in competition.

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<sup>2</sup> *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Silver; Silver bullion

24. The contested goods consist of the raw materials which are considered to be rare or precious metals. I consider that the closest comparable term in the earlier specification is “*Articles of precious metals or coated therewith*”. These goods may have a similar nature as they are made from the same materials. However, their purposes differ, as the contested goods are raw materials that serve as components of other goods, and thus, fulfil a different purpose from the earlier goods. In this regard, the method of use is different. There is the potential that the competing products could be sold through the same trade channels. I do not consider that there is any degree of competition or complementarity between the goods. I find that there is a low degree of similarity.

**Average Consumer and the Purchasing Act**

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

26. In relation to the “*Silver; Silver bullion*”, the average consumer will most likely be a professional user working in the given field of trade, without

excluding members of the general public as well as collectors and investors of such items. The goods will generally be self-selected from specialist stores, exclusive dealers, or the equivalent pages of a website or catalogue. I consider the purchase to be primarily a visual one, but aural considerations may also play a part on the basis of word of mouth recommendations or where the goods are ordered by telephone. The professional purchaser of these goods will be concerned with the nature, purity and quality of the goods, and the level of attention will be higher than average.

27. For the remaining goods, the average consumer will be a member of the general public. The purchasing process will vary from average to higher than average, depending on the importance and cost of the item. For example, greater care will be employed when purchasing, such as articles of precious metals, precious jewellery or collectible coins, as opposed to a low-cost jewellery or bracelets (faux bijoux). Further, the average consumer may examine the products to ensure that they select the correct type, size/fit, materials, quality, and aesthetic appearance. Such goods can be selected from stores, including specialist ones, brochures and catalogues, and online. In retail premises, the goods will be displayed on display cabinets, where they will be viewed and self-selected by consumers. Although I consider this purchasing act to be primarily visual, aural considerations will not be ignored in the assessment.


### **Comparison of Trade Marks**

28. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] 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.”

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

30. The marks to be compared are:

The Earlier Mark	Applicant's Mark
	<b>Hi Ho Silver</b>

#### Overall Impression

31. The contested mark is a word only mark capitalised and in a standard typeface. Registration of a word mark protects the words in the mark which can be used in any standard font or case.<sup>3</sup> The overall impression resides in the three words with less weight given to the word “SILVER” for those goods that are made of silver.

<sup>3</sup> See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

32. The earlier mark contains the word “Hiho”, which is presented in a purple stylised font. I also concur with the opponent’s submissions and note that the mark could also be seen as two words, “Hi ho”, based on its visual presentation. The overall impression resides in the word/words. Although the stylisation and colour contribute to the overall impression, they play a lesser role.

### Visual Comparison

33. Bearing in mind, as a rule of thumb, that the beginnings of marks tend to have more impact than the ends,<sup>4</sup> the marks overlap in the first element, “Hi Ho”, with the presentation as one or two words making little difference. The contested mark includes the word “Silver”, which is a point of difference. In addition, the use of colour and stylisation in the earlier mark will add to the visual differences between the marks. Taking into account the above and the overall impressions of the marks, I find that the competing marks are visually similar to between a medium and high degree.

### Aural Comparison

34. The earlier mark will be pronounced as “HI-HO” and the contested as “HI-HO-SIL-VUH”. The marks share the same first two syllables. However, there are no phonetic counterparts of the syllables “SIL-VUH” in the earlier mark. I find that the competing marks are aurally similar to between a medium and high degree.

### Conceptual Comparison

35. The opponent submits that:

“14. Neither mark has an overall defined meaning and so no conceptual meaning is possible. To the extent that the consumer sees

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<sup>4</sup> See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

a meaning in the combination of the words “Hi Ho”, the meaning will be the same for both marks.”

36. I agree with the opponent’s submissions. Both the earlier mark and the first two words of the contested mark “Hi Ho”, whether presented as one word or two words, have no clear concept other than an expression/exclamation. As such, this shared element in the trademarks will be regarded as invented words. The word “Silver” will be understood as a precious metal, and it will possess descriptive qualities in the context of the goods. Considering the above factors and overall impressions, there is no clear concept in the element “Hi Ho” rendering the competing marks conceptually neutral.

### **Distinctive Character of the Earlier Trade Mark**

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

38. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
39. I have only the inherent distinctiveness of the earlier mark to consider as the opponent did not file evidence. As described above in this decision, the earlier mark contains the stylised word element which will be perceived as an invented word. The earlier mark has no real suggestive or allusive significance in relation to the goods for which it is registered. I find that the level of inherent distinctiveness will be high.

### **Likelihood of Confusion**

40. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.<sup>5</sup> It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

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<sup>5</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>6</sup>

41. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
42. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., (as he then was) sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark

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<sup>6</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>7</sup>

43. Earlier in this decision I have concluded that:

- the goods at issue range from identical to similar to a low degree;
- the average consumer for the goods "*Silver; Silver bullion*" will be a professional user, without excluding members of the general public as well as collectors and investors, and the level of attention will be higher than average. The selection process is predominantly visual without discounting aural considerations. For the remaining goods, the average consumer will be a member of the general public. The level of attention paid will range from average to higher than average, and the selection process is predominantly visual without discounting aural considerations;
- the competing marks are visually and aurally similar to between a medium and high degree, and conceptually neutral;
- the earlier mark has a high degree of inherent distinctiveness.

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<sup>7</sup> See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

44. Considering the above factors and the identical goods in play, there is a likelihood of direct confusion. This is due to the high distinctiveness of the earlier mark and the principle of imperfect recollection, where the shared element of the competing marks, “Hi Ho”, will likely remain in the mind of the average consumer, leading them to imperfectly recall or misremember one mark for the other. I recognise that the average consumer will pay an average to a higher than average degree of attention during the purchasing process, but, given that consumers rarely have a chance to compare marks side by side, they may not differentiate between the shared common element being one or two words. Further, the word element “Silver” in the contested mark will be seen simply as descriptive of silver-made items without indicating origin. Notwithstanding the conceptual neutrality, the visual and aural similarities between the marks and the high degree of distinctive character of the earlier mark will lead the average consumer to directly confuse the marks.
45. If I am wrong in the above finding, I consider that there is a likelihood of indirect confusion for the respective identical goods. It is my view that the contested mark could be perceived as a variation of the earlier mark, perhaps as a co- or sub-brand. In particular, while the average consumer will recognise the differences between the marks, namely the stylisation and use of colour in the earlier mark and the additional word “Silver” in the contested mark, the shared element at the beginning of the marks is likely to lead a significant proportion of consumers to conclude that the marks originate from the same or economically linked undertakings. In these circumstances, the addition of the word “Silver” is likely to be viewed as indicating a part of the same business, or a related business, that specialises in goods made of silver. As a result, I find there is a likelihood of indirect confusion.
46. This finding extends to the rest of the goods that I found to be similar at a low degree.

## Outcome

47. The opposition under Section 5(2)(b) of the Act is **successful in its entirety**. Therefore, subject to appeal, the application will be refused.

## Costs

48. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs as follows:

Official opposition fee	<b>£100<sup>8</sup></b>
Preparing a statement and considering the counterstatement	<b>£250</b>
Preparing and filing submissions, and considering the evidence filed by the applicant	<b>£300</b>
Total	<b>£650</b>

49. I, therefore, order David Devine to pay Hi Ho Silver Limited the sum of £650. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 9<sup>th</sup> day of October 2023**

**Dr Stylianos Alexandridis  
For the Registrar,  
The Comptroller General**

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<sup>8</sup> I am only awarding £100 official fee rather than the £200 paid as the opponent withdrew the Sections 5(3) and 5(4)(a) grounds.