



Intellectual
Property
Office

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World Intellectual Property
Organisation (WIPO)
International Bureau
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Your Reference:
International Registration No:
WO0000001664659
Examiner: Sarah Adam-Smith
Direct Telephone: +44(0)1633813573
Date: 14 February 2023

Intl Reg No: WO0000001664659
Mark: Solar-Zip
Holder: BHG
Class(es): 6, 7, 9, 19, 20

**Notification Of A Provisional Total Refusal Of Protection Based On An
Opposition By The United Kingdom Intellectual Property Office In
Accordance With Article 5 Of The Madrid Protocol**

I am writing to inform you that following receipt of an opposition to the above trade mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and **return it to this office** within **two months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at ipo.gov.uk/tmforms

The TM8 should be received on or before the date requested above unless a cooling off period is entered into by the parties.

The holder of the International Registration may also provide an address for service on form TM33 within the period provided to file the TM8. Please note that

a valid address for service is an address in the United Kingdom, Gibraltar or the Channel Islands as set out in rule 11(4).

If the holder files Form TM8 within this two month period without providing a valid address, further directions will be issued. These will provide the holder with a further period of one month to file a suitable address.

Sarah Adam-Smith
Trade Marks Registry

[Skip to main content](#)

Intellectual Property Office

Trade mark number

UK00003589580

Status

Registered

Overview

Trade mark



Dates

Filing date

03 February 2021

Date of entry in register

03 September 2021

Renewal date

03 February 2031

Goods and services

Classes and terms

Class 20

Window blinds; indoor window blinds [furniture]; interior blinds for windows; holders for use in securing blinds; indoor screens in the form of blinds; slatted indoor blinds; blinds for protection against light; slatted blinds; roller

blinds; operating devices for blinds; window furniture; blinds; shades; window shades; window blinds for indoor use; indoor blinds for protection against light; slatted blinds for indoor use; roller blinds for indoor use; operating devices for indoor blinds; indoor window furniture; indoor blinds and shades; indoor window shades; external window furniture; external shades; external window shades; parts and fittings for all of the aforesaid goods.

Class 22

Window blinds; outdoor window blinds [furniture]; exterior blinds for windows; holders for use in securing blinds; outdoor screens in the form of blinds; slatted outdoor blinds; blinds for protection against light; slatted blinds; roller blinds; operating devices for blinds; blinds; window blinds for external use; external blinds for protection against light; slatted blinds for external use; roller blinds for external use; operating devices for external blinds; external blinds; parts and fittings for all of the aforesaid goods.

Names and addresses

Owner(s) name

Ideas by Design Ltd.

2b Dunhams Lane, Letchworth, SG6 1BE, United Kingdom

Country of Incorporation

United Kingdom

IPO representative name

Maguire Boss

24 East Street, St. Ives, Cambridge, PE27 5PD, United Kingdom

Publications

First advert

Journal

2021/021

Date of publication

21 May 2021

Intellectual Property Office is an operating name of the Patent Office

[Skip to main content](#)

Intellectual Property Office

Trade mark number

UK00003589580

Status

Registered

Overview

Trade mark



Dates

Filing date

03 February 2021

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Renewal date

03 February 2031

Goods and services

Classes and terms

Class 20

Window blinds; indoor window blinds [furniture]; interior blinds for windows; holders for use in securing blinds; indoor screens in the form of blinds; slatted indoor blinds; blinds for protection against light; slatted blinds; roller

blinds; operating devices for blinds; window furniture; blinds; shades; window shades; window blinds for indoor use; indoor blinds for protection against light; slatted blinds for indoor use; roller blinds for indoor use; operating devices for indoor blinds; indoor window furniture; indoor blinds and shades; indoor window shades; external window furniture; external shades; external window shades; parts and fittings for all of the aforesaid goods.

Class 22

Window blinds; outdoor window blinds [furniture]; exterior blinds for windows; holders for use in securing blinds; outdoor screens in the form of blinds; slatted outdoor blinds; blinds for protection against light; slatted blinds; roller blinds; operating devices for blinds; blinds; window blinds for external use; external blinds for protection against light; slatted blinds for external use; roller blinds for external use; operating devices for external blinds; external blinds; parts and fittings for all of the aforesaid goods.

Names and addresses

Owner(s) name

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Intellectual
Property
Office

26/09/2022

£100.00

OP000436491

IP0088460

Form TM7

Notice of opposition and statement of grounds

Fee ☒ £100 Opposition based on Section 5(1) and/or 5(2) ONLY

☐ £200 Opposition based on, or including, any other grounds

Note: If you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200

Use this form to notify of an opposition to a trade mark application or international registration and to set out the grounds on which you are basing this opposition.

Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2): use Form TM7F.

1. Trade mark number

Number of the trade mark you are opposing. If the opposition concerns an International Registration, help us identify the correct trade mark by adding "IR".

WO0000001664659

2. Full name of applicant/holder

Whose trade mark you are opposing.

BHG

3. Full name of opponent

Ideas by Design Ltd.

Address

If the address is not within the United Kingdom, Gibraltar or the Channel Islands you must have a representative in one of these regions and complete section 4 below.

2b Dunhams Lane

Letchworth

PLEASE NOTE: Publication of name and address and other information you provide. We publish the owner's name and address and other information you provide in our searchable records. You should provide a business or PO Box address if you do not want your home address published.

A copy of this form will also be sent to the trade mark applicant/holder.

United Kingdom

Postcode SG6 1BE

If you are opposing on the basis of a comparable mark, please refer to TPN 2/2020 for information about the address for service that will apply to you.

ADDITIONAL INFORMATION: It will no longer be possible for two (or more) parties to jointly oppose a trade mark based on earlier marks/rights that they each own, unless the parties jointly own the relevant earlier marks/rights. Separate oppositions will now be required. See section 38(2A) of the Act.

Email address

In order to enable us to correspond with you by email, please provide an email address to be used for the purposes of these proceedings and any subsequent appeal to the Appointed Person.

4. Representative name

If you have no representative, go to section 5.

Maguire Boss

Address

The address provided in this section must be within the United Kingdom, Gibraltar or the Channel Islands.

If you are opposing on the basis of a comparable mark, please refer to TPN 2/2020 for information about the address for service that will apply to you.

NOTE: We will communicate with the representative if this section has been completed.

24 East Street

St Ives

Cambridge

Postcode PE27 5PD

Email address

Complete if you would like us to correspond with you by email.

tmarks@maguires.co.uk

5. Related proceedings

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.

☐ IPO Registry

☐ UK Courts

☐ EUIPO

Number

6. Opposition notification date

If you have informed the applicant/holder of an intention to oppose the trade mark application, designation – enter the date you notified them.
[**See Note]

12 July 2022

****Note:** An opposition launched without giving the applicant or holder a reasonable opportunity to withdraw the application, international designation or amendment may result in the opponent being ineligible for an award of costs.

7. Declaration

I believe that the facts stated in this form and the attached statement of grounds are true.

Signature

Maguire Boss

Name

(BLOCK CAPITALS)

MAGUIRE BOSS

Date

26 September 2022

8. Your reference

Complete if you would like us to quote this in communications with you, otherwise leave blank.

G4553-DT

Contact details

Name, daytime telephone number of the person to contact in case of query.

David Tate - 01480 301 588

Number of sheets attached to this form

23

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)

☒

Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> COMPLETE SECTION A

☐

Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION B

☐

Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION C

☐

Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION D

☐

Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION E

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number

Your trade mark.

UK00002525552A

Type of mark

Please tick.



UK

☐ International UK

Please note, tick the "UK" box above if your mark is a national UK mark, a comparable mark deriving from a registered EUTM or IR(EU), or a national UK mark which constitutes a re-filing of a pending EUTM – please see TPN 2/2020 for further information.

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

ZIP (please see "Attachment 1")

Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?



Yes



No > GO TO Q4

Q3. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?



Yes



No > GO TO Q3b

Please note: If you are relying on a comparable mark please see TPN 2/2020 for when it may be permissible to rely on use in the EU rather than solely in the UK.

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

> GO TO Q4.

Q3b. Please state any proper reasons for non-use.

DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar.

Please see "Attachment 3"

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number

Your trade mark.

UK00003589580

Type of mark

Please tick.



UK

☐ International UK

Please note, tick the "UK" box above if your mark is a national UK mark, a comparable mark deriving from a registered EUTM or IR(EU), or a national UK mark which constitutes a re-filing of a pending EUTM – please see TPN 2/2020 for further information.

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

ZIP (figurative) (please see "Attachment 2")

Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

<input checked="checked" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?

☐

Yes

☒

No > GO TO Q4

Q3. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☐

Yes

☐

No > GO TO Q3b

Please note: If you are relying on a comparable mark please see TPN 2/2020 for when it may be permissible to rely on use in the EU rather than solely in the UK.

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

<input type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

> GO TO Q4.

Q3b. Please state any proper reasons for non-use.

DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar.

Please see "Attachment 3"

Fees and payment

We will only process the form with this section completed (one form per payment)

To check the correct fee for this form, search on [GOV.UK](https://www.gov.uk) for 'trade mark forms and fees'

Total Fee Paying (£)

100.00

Your own reference (Optional)

G4553-DT

Your contact details should we have a query

Name

James Nichols

Email

james@maguires.co.uk

Phone

01480 301 588

How would you like to pay?

Tick one

☐

Using a debit or credit card – you will need the internet to pay by card

- 1 Go to our secure website – <https://fees.ipo.gov.uk/pay>
- 2 Enter your name, email address and total amount to pay from above
- 3 As proof of payment, write below the 10-character reference code displayed from the online payment screen.
DO NOT write your debit/credit card number



Deduct from IPO deposit account

IPO deposit account number

D02824

☐

Cheque – make payable to 'Intellectual Property Office'.

☐

Bank transfer

Reference – use your IPO deposit account number if you have one or an application number or your name if you don't.

Use the following bank account details

Sort code	20-18-23
Account number	80531766
Account name	Intellectual Property Office
SWIFT code	BARCGB22
IBAN number	GB92 BARC 2018 2380 5317 66

ATTACHMENT 1

[Skip to main content](#)

Intellectual Property Office

Trade mark number

UK0002525552A

Status

Registered

Overview

Trade mark

ZIP

Dates

Filing date

07 September 2009

Date of entry in register

05 August 2011

Renewal date

07 September 2029

Goods and services

Classes and terms**Class 20**

Interior window blinds; interior blinds for protection against light; interior slatted blinds; interior roller blinds; interior operating devices for blinds; interior window furniture; interior blinds; interior shades; interior window shades; parts and fittings for all of the aforesaid goods.

Names and addresses

Owner(s) name**Ideas by Design Ltd**

2B Dunhams Lane, Letchworth, Herts, SG6 1BE, United Kingdom

10

IPO representative name

Maguire Boss

24 East Street, St. Ives, Cambridge, PE27 5PD, United Kingdom

Publications

First advert

Journal

6817

Date of publication

01 January 2010

Intellectual Property Office is an operating name of the Patent Office

ATTACHMENT 2

[Skip to main content](#)

Intellectual Property Office

Trade mark number

UK00003589580

Status

Registered

Overview

Trade mark



Dates

Filing date

03 February 2021

Date of entry in register

03 September 2021

Renewal date

03 February 2031

Goods and services

Classes and terms

Class 20

Window blinds; indoor window blinds [furniture]; interior blinds for windows; holders for use in securing blinds; indoor screens in the form of blinds; slatted indoor blinds; blinds for protection against light; slatted blinds; roller

blinds; operating devices for blinds; window furniture; blinds; shades; window shades; window blinds for indoor use; indoor blinds for protection against light; slatted blinds for indoor use; roller blinds for indoor use; operating devices for indoor blinds; indoor window furniture; indoor blinds and shades; indoor window shades; external window furniture; external shades; external window shades; parts and fittings for all of the aforesaid goods.

Class 22

Window blinds; outdoor window blinds [furniture]; exterior blinds for windows; holders for use in securing blinds; outdoor screens in the form of blinds; slatted outdoor blinds; blinds for protection against light; slatted blinds; roller blinds; operating devices for blinds; blinds; window blinds for external use; external blinds for protection against light; slatted blinds for external use; roller blinds for external use; operating devices for external blinds; external blinds; parts and fittings for all of the aforesaid goods.

Names and addresses

Owner(s) name

Ideas by Design Ltd.

2b Dunhams Lane, Letchworth, SG6 1BE, United Kingdom

Country of Incorporation

United Kingdom

IPO representative name

Maguire Boss

24 East Street, St. Ives, Cambridge, PE27 5PD, United Kingdom

Publications

First advert

Journal

2021/021

Date of publication

21 May 2021

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ATTACHMENT 3

TRADE MARKS ACT 1994


International Registration No.
1664659 Solar-Zip (UK
Designation) in Classes 6, 7, 9,
19 & 20 in the name of BHG

- and -

Opposition thereto by Ideas by
Design Ltd.

STATEMENT OF GROUNDS

1. The Opponent, Ideas by Design Ltd. ("the Opponent"), is the owner of the following trade mark registrations, hereinafter referred to as "the Earlier Registrations":

No.	Trade Mark	Class(es)
UK 2525552A	ZIP	20
UK 3589580		20 & 22

2. The trade marks registered under the Earlier Registrations are hereinafter referred to as "the Earlier Trade Marks".
3. The contested designation, IR(UK) No. 1664659 Solar-Zip, is hereinafter referred to as "the Contested Application".
4. The details of the Contested Application are as follows:

No.	Trade Mark	Classes
IR(UK) No. 1664659	Solar-Zip	6, 7, 9, 19 & 20

5. The trade mark for which protection is sought under the Contested Application is hereinafter referred to as "the Contested Sign".

6. The goods covered by the Earlier Registrations which are relied upon in the opposition are as follows (“the Opponent’s Goods”):

i) UK 2525552A

Class 20:

“Interior window blinds; interior blinds for protection against light; interior slatted blinds; interior roller blinds; interior operating devices for blinds; interior window furniture; interior blinds; interior shades; interior window shades; parts and fittings for all of the aforesaid goods.”

ii) UK 3589580

Class 20

“Window blinds; indoor window blinds [furniture]; interior blinds for windows; holders for use in securing blinds; indoor screens in the form of blinds; slatted indoor blinds; blinds for protection against light; slatted blinds; roller blinds; operating devices for blinds; window furniture; blinds; shades; window shades; window blinds for indoor use; indoor blinds for protection against light; slatted blinds for indoor use; roller blinds for indoor use; operating devices for indoor blinds; indoor window furniture; indoor blinds and shades; indoor window shades; external window furniture; external shades; external window shades; parts and fittings for all of the aforesaid goods.”

Class 22

“Window blinds; outdoor window blinds [furniture]; exterior blinds for windows; holders for use in securing blinds; outdoor screens in the form of blinds; slatted outdoor blinds; blinds for protection against light; slatted blinds; roller blinds; operating devices for blinds; blinds; window blinds for external use; external blinds for protection against light; slatted blinds for external use; roller blinds for external use; operating devices for external blinds; external blinds; parts and fittings for all of the aforesaid goods.”

7. The goods covered by the Contested Application against which the opposition is directed are as follows (“the Contested Goods”):

Class 6

“Metal closing devices for buildings, namely shutters, rolling shutters, drop-leaf shutters, roofing shutters, doors, garage doors, windows, builder's hardware.”

Class 7

“Motors for all closure types, such as swivel shutters, rolling shutters, windows, revolving, overhead and sliding doors, curtains, gates; electric systems for automatically opening all types of closing devices such as swivel shutters, rolling shutters, windows, revolving, overhead and sliding doors, curtains and gates.”

Class 9

“Software and applications for mobile telephones, tablets, connected watches and video cameras, software for home automation system control, home automation control devices, autonomous information devices for controlling home automation systems, wireless communication devices for data transmission.”

Class 19

“Closing devices of wood, of plastic for building, namely shutters, rolling shutters, drop-leaf shutters, roofing shutters, doors, garage doors, windows.”

Class 20

“Fittings for windows, doors and shutters not of metal, building hardware of wood and plastic.”

Section 5(2)(b) Trade Marks Act 1994 – General Principles

8. The following principles are set out in the judgments of the 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 greater 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.

Section 5(2)(b) Trade Marks Act 1994

Comparison of Marks

9. Visually, the respective marks ZIP / Zip (figurative) and Solar-Zip coincide in the identical word ZIP, and differ in the presence of the word SOLAR at the start of the Contested Sign, and in the presence of some figurative elements in the Opponent's figurative mark.
10. The word SOLAR in the Contested Sign merely indicates that the goods in question give protection against the sun and/or that they are solar-powered. Consequently, the word SOLAR has comparatively little impact in the Contested Sign.
11. The additional element SOLAR in the Contested Sign would therefore not detract consumers' attention away from the distinctive word element ZIP, and the respective marks are therefore closely similar visually.
12. Aurally, the word ZIP would be pronounced identically in the respective marks. The descriptive word SOLAR does not appear in the Opponent's marks, but this is unlikely to have any significant impact in any event for the reasons discussed above. Consequently, the respective marks are closely similar aurally.
13. Conceptually, the respective marks are identical or closely similar on account of the coincidence within them of the distinctive word ZIP, and by virtue of the fact that the additional word SOLAR in the Contested Sign is unlikely to have any significant impact, and merely indicates that the goods in question give protection against the sun and/or that they are solar-powered.
14. Taking into account the abovementioned visual, aural and conceptual coincidences and similarities, it is submitted that the respective marks ZIP / Zip (figurative) and Solar-Zip are closely similar.

Comparison of Goods

15. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) case T-133/05*, the General Court stated as follows:

“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 the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”
16. The Holder’s Class 20 goods fall within or overlap with the scope of the Opponent’s Class 20 goods, and vice versa, and the respective Class 20 goods can therefore be considered identical.
17. Further, or in the alternative, the respective Class 20 goods are closely similar.
18. The respective goods (i.e. the Opponent’s Goods and the Contested Goods) all perform essentially the same broad purpose, which is to shelter, protect (e.g. against sun or wind) and/or conceal, and they are either in competition (e.g. a shutter in Class 19 may be used as an alternative to an interior blind in Class 20 or an exterior blind in Class 22) or are complementary (e.g. control and closure devices and applications in Classes 6, 7 and 9 may be used in conjunction with window furniture in Classes 20 and 22).
19. The respective goods also coincide in their nature, methods of use (e.g. a Class 19 shutter is used in much the same way as a Class 20 window blind or a Class 22 exterior blind), distribution channels, relevant public and producers. Also, the Opponent’s “operating devices” in Classes 20 and 22 are clearly similar to the Holder’s goods in Classes 6, 7 and 9, which are all used for operating or controlling shutters and similar goods.
20. In the light of the above, it is submitted that the respective goods are identical, closely similar, or similar.

Distinctiveness of the Earlier Trade Marks

21. The distinctiveness of the earlier marks is one of the factors to be taken into account in the global assessment of the likelihood of confusion.
22. In the present case, the Earlier Trade Marks have no meaning for any of the goods in question, and their distinctiveness must therefore be seen as at least normal to high. Further, it is submitted that the Earlier Trade Marks have an enhanced level of distinctiveness through use.

Global Assessment, Other Arguments and Conclusion

23. The matter must be judged through the eyes of the average consumer of the goods and 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 and services in question.
24. In the present case, the goods in question include, inter alia, relatively low-cost products directed at the public at large, and the degree of attention paid by the relevant public for those types of goods will be low-to-average.
25. Given that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa, the close similarity of the respective goods in the present case offsets any differences between the respective marks, and vice versa.
26. The word ZIP is the distinctive and dominant component of the Earlier Trade Marks, and it is also the distinctive and dominant component of the Contested Sign, given that the word SOLAR merely indicates that the goods in question give protection against the sun and/or that they are solar-powered.
27. Further, as mentioned above, the Earlier Trade Marks have a high distinctive character for the relevant goods.
28. Considering all of the above, and in particular bearing in mind imperfect recollection, there is clearly a likelihood of confusion on the part of the public, which includes the likelihood of association.
29. With regard to the nature of the confusion on the part of the public, this would include both direct and indirect confusion. That is, the relevant consumers would either mistake one mark for the other (direct confusion), or, if they perceive differences between the respective marks, they would recognise the common element ZIP and assume that the Contested Sign Solar-Zip is part of or relates to the Opponent's ZIP lines of products (indirect confusion).

30. As a consequence of the above, registration of the Contested Sign would be contrary to the provisions of Section 5(2)(b) of the Trade Marks Act 1994 in that the mark applied for is identical with or similar to the Earlier Trade Marks and is sought to be protected in relation to goods identical with or similar to the goods covered by the Earlier Trade Marks, such that there exists a likelihood of confusion on the part of the public, including a likelihood of association.

Conclusion

31. For the reasons set out above, we respectfully request that International Registration No. 1664659 Solar-Zip (UK Designation) be refused protection in its entirety, and that an award of costs be made in favour of the Opponent.

MAGUIRE BOSS

Subject : TM7 - WO0000001664659 - G4553

Received : 2022-09-26 16:30:58

From Address : David@maguires.co.uk

To Address : Forms@ipo.gov.uk

Dear Sirs

International Registration No. 1664659 (UK Designation)

SOLAR-ZIP (Classes 6, 7, 9, 19 & 20)

BHG

Our Ref: G4553

Opposition thereto by Ideas by Design Ltd.

Please find attached Form TM7 in relation to the above-referenced matter.

Yours faithfully

David Tate
MAGUIRE BOSS

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