

**O/1166/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001664310**

**DESIGNATING THE UK**

**BY ROOFIT SOLAR ENERGY OÜ**

**ROOFIT.SOLAR**

**IN CLASSES 4, 6, 9, 19, 37, 40 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 439328**

**BY LINDAB AB**

## BACKGROUND AND PLEADINGS

1. International trade mark 1664310 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Roofit Solar Energy OÜ. The IR is registered with effect from 14 January 2022. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The mark also claims priority from 14 July 2021.

2. The request to protect the IR was published on 25 November 2022. On 22 February 2023 Lindab AB (“the opponent”) fully opposed the protection of the IR in the UK based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). However, on 27 March 2023, the opponent limited the extent of the opposition, and is no longer opposing some of the holder’s terms within classes 9 and 42. Therefore the remaining goods and services that are being opposed are contained within Annex 1 of this decision.

3. At the hearing, Mr Carter, Counsel for the opponent, stated that they will only be pursuing the opposition under section 5(2)(b). Therefore, under section 5(2)(b), the opponent relies upon the following mark:

# Roofit

Comparable UK trade mark (EU) registration no. UK00917315581<sup>1</sup>

Filing date 10 October 2017.

Registration date 5 February 2018.

Relying upon some of the goods for which the earlier mark is registered, namely:

Class 6      Building material and building components of metal.

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<sup>1</sup> Following the end of the transition period of the UK’s withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

4. The opponent claims there is a likelihood of confusion because of the identity and high distinctive character of the ROOFIT element in both marks and the identity and similarity of the goods and services.

5. The holder filed a counterstatement denying the claims made.

6. A hearing took place before me on 11 September 2024. The opponent was represented by Sam Carter of Hogarth Chambers instructed by Zacco UK Limited. The holder was represented by Becky Knott of Hogarth Chambers, instructed by Boulton Wade Tennant LLP. I make this decision having taken full account of their oral submissions and of all the papers, referring to them below as necessary.

## **RELEVANCE OF EU LAW**

7. 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.

## **DECISION**

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

8. Section 5(2)(b) reads as follows:

“5(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.”

9. The opponent’s earlier mark had not completed its registration process more than five years before the relevant date (the priority date of the IR in issue). Accordingly, the use provisions at s.6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used the mark.

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

10. The following principles are gleaned from the decisions 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 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 goods and services**

11. The opponent's and holder's competing goods and services are contained within a table at Annex 2 of this decision.

12. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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 are complementary.”

13. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

14. In *Gérard Meric v OHIM*, 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.”

15. I bear in mind the following applicable principles of interpretation of terms within a specification from the judgement of *Sky v Skykick* [2024] UKSC 36:

“365. I agree with Sir Christopher Floyd and the other members of the Court of Appeal on this issue. The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

16. For the purposes 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 and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

17. 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:

“... 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 the responsibility for those goods lies with the same undertaking.”

18. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. (as he then was) noted, as the Appointed Person, in *Sandra Amalia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”  
Whilst on the other hand: “... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

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### Preliminary issue

19. At the hearing, it was clear that the interpretation of the applicant’s class 19 terms “materials for building and construction, not of metal, containing solar panels” and

“materials for building and construction, not of metal, containing solar cells” was in contention between the parties.

20. Mr Carter’s primary submissions on these terms were threefold:

1. The word “containing” in the holder’s terms “materials for building and construction, not of metal, *containing solar panels*” and “materials for building and construction, not of metal, *containing solar cells*” in class 19 is analogous to the word “including”.
2. The word “including” is used within specifications to list examples of what falls within that broader term (but are not completely limited to those goods).
3. Therefore the holder’s class 19 building and construction goods (not of metal) should be read to include solar panels and solar cells.

21. However, as highlighted by the holder’s specification, solar panels and solar cells belong to class 9.

22. In *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34, the Court of Appeal decided that “*the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods.*”

23. I also bear in mind that in *Pathway IP Sarl (formerly Regus No. 2 Sarl) v Easygroup Ltd (formerly Easygroup IP Licensing Limited)*, [2018] EWHC 3608 (Ch), the late Mr Justice Carr considered whether it was appropriate to take the class(es) in which the trade mark was registered into account in revocation or invalidation proceedings when deciding whether a description covered the goods/services shown in the evidence. After considering the judgments of the High Court in the *Omega 1* [2010] EWHC 1211 (Ch) and *Omega 2* cases [2012] EWHC 3440 (Ch), the judge stated that in his (provisional) view, the class number should be taken into account where the meaning of the disputed term is not otherwise sufficiently clear and precise. In particular the judge stated that where “*the words chosen may be vague or could refer to goods or*

*services in numerous classes [of the Nice classification system], **the class may be used as an aid to interpret what the words mean with the overall objective of legal certainty of the specification of goods and services.***

24. I therefore consider that it would be nonsensical to conclude that class 9 goods, solar panels and solar cells, would fall within the holder's class 19 term "materials for building and construction, not of metal".

25. At the hearing, Ms Knott submitted that the holder's terms "materials for building and construction, not of metal, *containing solar panels*" and "materials for building and construction, not of metal, *containing solar cells*" should be interpreted as mounting frames in which the solar panels or solar cells could be affixed to. However, use of the word "containing" seems to suggest that the solar panels and cells are a part of the material already. Under WIPO's Nice Classification, it lists "roofing, not of metal, *incorporating photovoltaic cells*" as an example of what class 19 would cover. Therefore, taking all the above into account, I will be interpreting the holder's terms to mean that the materials for building and construction, not of metal, *contain* the solar panels and cells within them, for example, a plastic sheet for construction that has a solar panel incorporated within it. I note that this finding reflects Mr Carter's secondary submission on the interpretation of the holder's terms (which he stated he would rely upon if I were not to agree with his primary argument above). At the hearing Mr Carter confirmed that if I were interpret the term in this way, that this would not affect his submissions on the goods and services comparison.

26. In his skeleton argument, and at the hearing, Mr Carter also submitted that the applicant's class 9 goods, solar panels and cells, are essentially building components, and thus would fall within the opponent's class 6 term "building material and building components of metal" (under the principle outlined in *Meric*). However, the goods cannot be found to be identical as they fall within different classes. Furthermore, I consider that the natural and ordinary meaning of the opponent's term means that it includes metals and metal items which are used in the construction of buildings, such as poles and beams, cladding and sheets. Solar panels and cells are predominantly made from silicon and glass, and are not specifically used to construct buildings, but are items that can be affixed to, for example, a roof, and is used specifically to convert

sunlight into electrical energy. On this basis, I do not consider them to be classified or categorised as building materials and components. Moreover, I note that the opponent's term would not include such goods which have solar panels contained within them, as I find that this is a step too far removed from what "building material and building components of metal" would encompass. I find that to conclude such goods would be covered by the opponent's term would be broadening the protection of the specification, allowing it to cover terms wider than its literal meaning. For the sake of completeness, I consider that the opponent's term would need to explicitly state that its building materials and components contain solar panels, such as, for example, "building material and building components of metal, including building material and building components of metal containing solar panels", for me to conclude that the opponent has protection for these specific types of goods.

#### Class 4

*Electrical energy; electrical energy form solar power.*

27. At the hearing, Mr Carter submitted that holder's above goods are similar to the opponent's class 6 "building material and building components of metal". This was on the basis that the goods are complementary because "building materials (e.g. solar panels) may be used to generate electrical energy".<sup>2</sup> However, as noted above, solar panels and solar cells belong to class 9, and therefore would not fall within the opponent's class 6 specification. I also note that the opponent's term does not specifically state that its building materials and components "include solar panels" (which, as noted above, would need to be explicitly stated for me to conclude that the opponent has protection for these specific types of goods).

28. On this basis, I do not consider that the holder's electrical energy overlaps in nature with the opponent's metal building materials. The goods will clearly be used in different ways, and do not overlap in purpose, as energy is used to power lights and appliances (such as ovens, TVs and refrigerators) and building materials are used to construct buildings. Therefore, the goods clearly do not overlap in trade channels because the

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<sup>2</sup> Paragraph 24 of Mr Carter's skeleton argument

holder's goods would be supplied by electrical energy undertakings, and the opponent's goods would be sold by builder's merchants and DIY retail outlets. The goods are not in competition, nor are they complementary, as they are neither important nor indispensable to one another, and the consumer would not believe that all of the goods originate from the same undertaking. Whilst there may be a general overlap in user, I note that this is not enough on its own to establish similarity between them. Therefore, taking all of the above into account, I consider that the parties' goods are dissimilar.

### Class 6

*Roof coverings of metal containing solar cells; roof coverings of metal containing solar panels.*

29. Using the interpretation set out in paragraph 25, the holder's above goods are roof coverings of metal which have solar cells and solar panels incorporated within them.

30. Mr Carter submits that the holder's above goods are *Merici* identical to the opponent's "building material and building components of metal". Whilst I appreciate that roof coverings are a type of building material or component, the holder's goods specifically state that they contain either solar cells or solar panels. I therefore do not consider that the opponent's term would cover the holder's goods, which are more specialist in nature and have a different purpose. For the sake of completeness, I consider that the opponent's term would have to be worded as, for example, "building material and building components of metal *containing solar panels/cells*" in order for the goods to be *Merici* identical.

31. Whilst all of the goods would be used in building and construction, a specific purpose of the holder's goods is to provide solar power to generate electricity. The goods therefore slightly differ in purpose and nature. Without any evidence before me, I do not consider that a builder's merchant or DIY retail store (which would sell the opponent's goods) would sell the holder's goods, which are more likely to be sold by solar panel and cell specialists, and electrical energy undertakings. The goods are not complementary; however, they may be in competition, with the user choosing either

to use building materials with or without solar panels incorporated into them. Ms Knott stated that the holder accepts that there is a low degree of similarity between the goods, and I agree on this level of similarity.

#### Class 9

*Solar cells; solar batteries; solar panels; solar modules; solar panels for electricity generation; photovoltaic inverters; photovoltaic apparatus and installations for generating solar electricity; photovoltaic apparatus for converting solar radiation to electrical energy.*

32. I do not consider that the holder's above goods are similar to the opponent's "building material and building components of metal". The goods clearly do not overlap in nature, method of use and purpose, because the holder's goods are used to convert the sun's energy into electricity, whereas the opponent's goods are used for constructing buildings. The goods clearly do not overlap in trade channels, as the holder's goods would be provided by solar cell and panel specialists, or electrical energy undertakings, whereas the opponent's goods would be sold by builder's merchants and DIY retail stores. The goods are clearly neither in competition, nor are they complementary, because they are neither important or indispensable to one another, and the consumer would not believe that the goods originate from the same undertaking. Whilst there may be an overlap in user, this is not enough on its own for a finding of similarity. Thus I find the goods are dissimilar.

#### Class 19

*Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; transportable buildings, not of metal.*

33. I note that Ms Knott accepted that there is some similarity between the holder's above goods and the opponent's "building material and building components of metal". I note that all of the goods are materials used for constructing buildings and therefore they overlap in purpose and method of use. However, the nature does not overlap as the holder's goods are not made from metal whereas the opponent's goods are. I

consider that there would be an overlap in trade channels with the goods all being sold in builder's merchants and DIY retail stores. The goods are not complementary, but they may be, to some extent, in competition. I therefore find that the goods are similar to a medium degree.

*Materials for building and construction, not of metal, containing solar panels; materials for building and construction, not of metal, containing solar cells; roof coverings, not of metal, containing solar cells; roof coverings, not of metal, containing solar panels.*

34. Based on my previous interpretation of the holder's terms, I consider that the above terms cover building materials, not of metal, which have solar cells or panels incorporated into them. I therefore consider that the same comparison applies in paragraphs 30 and 31 above. Ms Knott stated that the holder accepts that there is a low degree of similarity between the goods, and I agree on this level of similarity.

### Class 37

*Construction services.*

35. At the hearing, Mr Carter submitted that the holder's above services were highly similar to the opponent's "building material and building components of metal". However, the goods and services clearly do not overlap in nature and method of use. There may be very minimal overlap in purpose to the extent that they are all used for the construction of buildings, however, the opponent's goods all have specific purposes (such as to build walls and roofs, to provide drainage through metal pipes etc.).

36. The goods and services are clearly not in competition, nor are they complementary. Whilst it could be arguable that the holder's services may be facilitated using the opponent's "building material and building components of metal", the average consumer would not believe that the goods and services originate from the same undertaking. The holder's services would be provided by construction companies. The opponent's goods would be sold in builders' merchants or DIY home improvement retailers, which can be bought and directly assessed by the general

public. Consequently, the user would know that the goods and services are provided by different trade channels. Furthermore, I note that it is unlikely that the manufacturers of “building material and building components of metal” would offer installation services for these goods, or more widely, construction services. However, even if they did, I do not consider that this on its own is enough to establish similarity between the goods and services. Taking all of the above into account, I consider that the holder’s construction services and the opponent’s building materials are dissimilar.

*Roofing installation.*

37. The holder’s above roofing installation services clearly do not overlap in purpose, nature and method of use with the opponent’s “building material and building components of metal”. The goods and services are clearly not in competition, nor are they complementary in the way described by the case law cited above.

38. Whilst it could be arguable that the holder’s services may be facilitated using the opponent’s “building material and building components of metal”, the average consumer would not believe that the goods and services originate from the same undertaking. The holder’s services would be provided by roofing installers whereas the opponent’s goods would be sold in builders’ merchants. Moreover, I consider it is unlikely that the manufacturers of “building material and building components of metal” would offer roofing installation services for these goods. However, even if an undertaking did manufacture the goods and provide installation services for them, I do not consider that this on its own is enough to establish similarity between them. Therefore, taking all of the above into account, I find the holder’s roofing installation services and the opponent’s metal building materials are dissimilar.

*Construction of utility solar installations; installation of residential solar panel power systems; installation of non-residential solar panel power systems; maintenance and repair of solar power installations; repair or maintenance of power distribution or control machines and apparatus; maintenance, servicing and repair of power generating apparatus and installations; servicing of power generating apparatus and installations; installation of power generating apparatus; electrical installation services; installation of electric light and power systems; servicing of mains services;*

*maintenance and repair of energy generating installations; installation of energy-saving apparatus; repair of energy supply installations; installation of non-residential solar panel power systems; installation of solar powered systems; maintenance and repair of solar thermal installations; installation and maintenance of solar thermal installations; installation of solar heating systems; providing information relating to the installation of electrical apparatus.*

39. I note that the holder's above services are specifically in relation to the installation, repair, maintenance and servicing of goods which produce electricity and energy (including solar energy). I therefore do not consider that these services overlap with the opponent's "building material and building components of metal" (which as highlighted in my comparisons above, would not cover metal building materials and components which incorporate solar cells/panels etc.). The goods and services clearly do not overlap in nature and method of use. They also do not overlap in purpose, as the holder's services provide the user with electricity and energy whereas the opponent's goods are used for the construction of buildings. They will not overlap in trade channels, as the holder's services would be provided by solar cell and panel specialists, or electrical energy undertakings, whereas the opponent's goods would be sold by builder's merchants and DIY retail stores. The goods and services are neither in competition nor complementary, and whilst there may be an overlap in user, this is not enough on its own to establish similarity. Consequently, I find the goods and services are dissimilar.

*Installation and repair services of roofs and solar energy equipment.*

40. I consider that the holder's above term covers the installation and repair of roofs and the installation and repair of solar equipment. For the holder's installation and repair of roofs services, I consider the same comparison and finding applies in paragraphs 37 and 38 above.

41. For the installation and repair of solar equipment, I do not consider that these services overlap in nature and method of use with the opponent's "building material and building components of metal". The goods and services clearly do not overlap in purpose, nor would they overlap in trade channels as the opponent's goods would be

sold by builder's merchants and DIY retail stores and the holder's services would be provided by solar cell and panel specialists, or electrical energy undertakings. The goods and services are neither in competition nor complementary, and whilst there may be an overlap in user, this is not enough on its own to establish similarity. Consequently, I find the goods and services are dissimilar.

#### Class 40

*Custom manufacture of prefabricated construction elements, including prefabricated building elements containing solar cells or solar panels.*

42. I note that the word "including" used within the holder's above term does not limit the preceding term, but is used to list examples of goods that fall within it. I therefore consider that this term is similar to the opponent's "building material and building components of metal". Whilst the goods and services clearly do not overlap in nature and method of use, the end purpose of them is to construct buildings. I also note that the goods and services would be provided by the same undertakings, which would be sold to the same users. The goods and services are not complementary, but they may be in competition, with the user choosing either custom or non-custom construction elements to use when constructing their buildings. Taking all of the above into account, I find the goods and services are similar to between a low and medium degree.

*Energy production; electricity generating; generation of electricity from solar energy; rental of energy and electricity generating equipment, including rental of solar panels; consultancy services relating to the generation of energy and electrical power; custom manufacture of energy and electricity generating equipment, including solar panels.*

43. The holder's above services are all used for producing or generating electricity. I therefore do not consider that these services are similar to opponent's "building material and building components of metal" (which as highlighted in my comparisons above, would not cover metal building materials and components which incorporate solar cells/panels etc.). The goods and services clearly do not overlap in purpose, nature and method of use, nor do they overlap in trade channels as the holder's services would be provided by electrical energy undertakings whereas the opponent's

goods would be sold by builder's merchants and DIY retail stores. The goods and services are neither in competition nor complementary. Moreover, if there is an overlap in user, this is not enough on its own to establish similarity. The goods and services are clearly dissimilar.

#### Class 42

*Development of power assemblies; engineering services relating to energy supply systems; design and development of energy distribution networks.*

44. Mr Carter submitted that the holder's above services are similar to the opponent's "building material and building components of metal", because the opponent's term would cover "power assemblies", "energy supply systems" and "energy distribution networks". However, these goods are used for the conversion, distribution and supply of energy, and are, therefore, clearly not building materials or components.

45. I consider that the holder's above services and the opponent's building goods clearly do not overlap in purpose, nature or method of use. There will not be an overlap in trade channels because the holder's specialist services would be provided by electrical energy undertakings and the opponent's goods would be sold by builder's merchants and DIY retail stores. The goods and services are neither in competition nor complementary in the way described by the case law cited above. I note that if there is an overlap in user, this is not enough on its own to establish similarity. Therefore, taking all of the above into account, I find the parties goods and services are dissimilar.

*Consultancy in the field of energy-saving; technical advice in connection with energy-saving measures; advisory services relating to the use of energy; technological consultancy in the fields of energy production and use; advisory services relating to energy efficiency; conducting research and technical project studies relating to the use of natural energy; provision of information concerning research and technical project studies relating to the use of natural energy; professional consultancy relating to the conservation of energy; professional consultancy relating to energy efficiency in*

*buildings; providing technical advice relating to energy-saving measures; technological consulting services in the field of alternative energy generation.*

46. The holder's above consultancy, advisory and technical advice services are all in relation to energy. These services clearly do not overlap in nature, method of use, purpose, or trade channels with the opponent's class 6 "building material and building components of metal". The goods and services are neither in competition nor complementary. They are clearly dissimilar.

*Certification services for the energy efficiency of buildings; recording data relating to energy consumption in buildings.*

47. The holder's certification and data recording services are all in relation to energy efficiency and consumption. These services clearly do not overlap in nature, method of use, purpose, or trade channels with the opponent's class 6 "building material and building components of metal". The goods and services are neither in competition nor complementary. I find they are clearly dissimilar.

*Design and development of software for control, regulation and monitoring of solar energy systems; monitoring of network systems.*

48. The holder's above services are technical in nature and relate to software and network systems. I therefore do not consider that these overlap in nature, method of use, purpose, or trade channels with the opponent's class 6 "building material and building components of metal". The goods and services are neither in competition nor complementary. They are clearly dissimilar.

49. It is a prerequisite of section 5(2)(b) that the goods and services be identical or at least similar. The opposition will, therefore, fail in respect of the goods and services that I have found to be dissimilar.<sup>3</sup>

50. The opposition under section 5(2)(b) fails for the following goods and services:

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<sup>3</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

- Class 4 Electrical energy; electrical energy form solar power.
- Class 9 Solar cells; solar batteries; solar panels; solar modules; solar panels for electricity generation; photovoltaic inverters; photovoltaic apparatus and installations for generating solar electricity; photovoltaic apparatus for converting solar radiation to electrical energy.
- Class 37 Construction services; installation and repair services of roofs and solar energy equipment; construction of utility solar installations; installation of residential solar panel power systems; installation of non-residential solar panel power systems; maintenance and repair of solar power installations; repair or maintenance of power distribution or control machines and apparatus; maintenance, servicing and repair of power generating apparatus and installations; servicing of power generating apparatus and installations; installation of power generating apparatus; electrical installation services; installation of electric light and power systems; servicing of mains services; maintenance and repair of energy generating installations; installation of energy-saving apparatus; repair of energy supply installations; roofing installation; installation of non-residential solar panel power systems; installation of solar powered systems; maintenance and repair of solar thermal installations; installation and maintenance of solar thermal installations; installation of solar heating systems; providing information relating to the installation of electrical apparatus.
- Class 40 Energy production; electricity generating; generation of electricity from solar energy; rental of energy and electricity generating equipment, including rental of solar panels; consultancy services relating to the generation of energy and electrical power; custom manufacture of energy and electricity generating equipment, including solar panels.
- Class 42 Development of power assemblies; consultancy in the field of energy-saving; technical advice in connection with energy-saving measures; advisory services relating to the use of energy; technological

consultancy in the fields of energy production and use; advisory services relating to energy efficiency; engineering services relating to energy supply systems; design and development of energy distribution networks; certification services for the energy efficiency of buildings; recording data relating to energy consumption in buildings; conducting research and technical project studies relating to the use of natural energy; provision of information concerning research and technical project studies relating to the use of natural energy; professional consultancy relating to the conservation of energy; professional consultancy relating to energy efficiency in buildings; design and development of software for control, regulation and monitoring of solar energy systems; providing technical advice relating to energy-saving measures; technological consulting services in the field of alternative energy generation; monitoring of network systems.

### **The average consumer and the nature of the purchasing act**

51. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 (as he then was) 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.”

52. The average consumer for the goods and services will be members of the general public, as well as professionals who work in the building or construction industry. The cost of purchase is likely to vary. The frequency of the purchase is also likely to vary, although it is unlikely to be particularly regular. I bear in mind that the average consumer will take various factors into consideration such as the material of the goods, durability, quality, cost, location and the reputational standing of the provider. Consequently, I consider that at least a medium degree of attention will be paid by the average consumer when selecting the parties' class 6, 19 and 40 goods and services.

53. The goods are likely to be obtained by self-selection from the shelves of a builders' merchants or DIY home improvement retailer, and their online equivalents. The services are likely to be purchased from construction companies. Alternatively, the goods and services may be purchased following perusal of advertisements or inspection of a catalogue. Visual considerations for both are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

### **Comparison of the trade marks**

54. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 the trade 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.”

55. 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.

56. The respective trade marks are shown below:

Opponent's trade mark	Holder's trade mark
<b>RooFit</b>	<b>ROOFIT.SOLAR</b>

57. The opponent's word mark consists of the 6-letter word "RooFit". The mark as currently registered capitalises the letters "R" and "F", which will lead the average consumer to see the invented word as consisting of two words; "Roo" and "Fit". However, normal and fair use of the opponent's word mark means that it may be used in any standard typeface, as well as in all upper or lower-case lettering. Regardless, I consider that the overall impression of the mark lies in the word itself.

58. The holder's IR consists of the words "ROOFIT" and "SOLAR" which are separated by a full stop. I note that the average consumer may see the invented word "ROOFIT" as consisting of two words; "roof" and "it" or "roo" and "fit". I also note that some of the holder's goods and services contain solar panels/cells and therefore the "SOLAR" element will be descriptive of those goods and services only. However, I also bear in mind that regardless of whether the "SOLAR" element is descriptive, "ROOFIT" is an invented word and therefore will play a greater role in the overall impression, with the full stop and the word "SOLAR" playing a lesser role.

59. Visually, the marks coincide in the letters R, O, O, F, I and T. These appear at the beginning of the holder's IR, which as noted by Mr Carter, is a position to which the average consumer pays more attention.<sup>4</sup> However, the holder's IR ends in the ".SOLAR" element, which acts as a visual point of difference.

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

60. Ms Knott stated that “conspicuous irregular capitalisation” within the opponent’s mark would reduce its visual similarity to the holder’s IR, and footnoted the cases of *Easygroup Ltd v Beauty Perfectionists Ltd* [2024]<sup>5</sup> and *easyGroup Ltd v Easylife Ltd (formerly Easylife Group Ltd)* [2021]<sup>6</sup> within paragraph 59 of her skeleton argument. However, both of the parties’ marks are word only marks, and as noted above, normal and fair use of the opponent’s word mark (and applicant’s) means it may also be used in all upper and lower-case lettering.<sup>7</sup> As such, I agree with Mr Carter that it is well established that the use of different cases is of no impact to the visual comparison. Therefore, taking all of the above into account, bearing in mind that the opponent’s “RooFit” mark is wholly contained at the beginning of the holder’s IR, I consider that the marks are visually similar to at least a medium degree.

61. Aurally, the opponent’s mark as currently registered is presented with the letters “R” and “F” capitalised and therefore is likely to be pronounced by the average consumer as ROO-FIT. However, as noted above, ordinary and fair use of the mark allows the opponent to also present it in all upper or lower-case, which may result in the consumer pronouncing the mark as ROOF-IT.

62. In the holder’s IR, Mr Carter submits that the “.SOLAR” element may not be articulated. However, just because a word may be descriptive, it does not mean that it is aurally invisible.<sup>8</sup> I therefore consider that the word “SOLAR” will be pronounced. Consequently, as a whole, I consider that the holder’s IR is likely to be pronounced as either ROOF-IT SO-LAR or ROO-FIT SO-LAR.

63. I note that pronunciation of either ROO-FIT and ROOF-IT in both marks is very minimal, as they only slightly differ in the position of the syllable break, but this break is so tiny that you barely notice the difference. Therefore, taking all of the above into account, I consider that the marks are aurally similar to at least a medium degree.

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<sup>5</sup> EWHC 1441 (CH)

<sup>6</sup> EWHC 2150 (CH)

<sup>7</sup> I also bear in mind the case of *Mr Heron* BL O/954/22 where at paragraph 15 Mr Iain Purvis KC stated that the monopoly of a word mark is not limited by any features such as fonts or capitalisation appearing on the Register, listing MR HERON, mr heron, Mr Heron, Mr HERon, and Mr HERON (in a stylised typeface) as all being identical to the word mark “mr heron”.

<sup>8</sup> *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) quoting Mr Phillip Harris, as the Appointed Person

64. Conceptually, Mr Carter submitted that the word “RooFit/ROOFIT” in the parties’ marks is a “fanciful and made-up word with no English language meaning”. However, I bear in mind that in *Usinor SA v OHIM*, Case T-189/05, the GC found that:

“62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Lloyd Schuhfabrik Meyer*, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).

65. Ms Knott submitted that the opponent’s mark, “due to its irregular capitalisation” would be perceived as a combination of the word “Roo” (the abbreviation of the word kangaroo) and “Fit”. She also submitted that the holder’s IR will be perceived as a combination of the words “ROOF” and “IT” (with “SOLAR” at the end).

66. I agree with Ms Knott, that if the opponent’s mark is presented how it is registered, that the average consumer will see its conceptual meaning as deriving from the words “Roo” and “Fit”. However, as noted above, fair and notional use of the opponent’s word mark means it could also be presented in all upper or lower-case. On this basis, the average consumer may also perceive that opponent’s mark as evoking the concept of the ordinary dictionary words “roof” and “it”.

67. I consider that both above sets of conceptual meanings could also be seen within the “ROOFIT” element at the beginning of the holder’s word IR.<sup>9</sup> I also note that the “.SOLAR” element at the end of the holder’s IR will be recognised as an ordinary dictionary word which describes things relating to the sun, including power, which

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<sup>9</sup> *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch) . Arnold J considered at some length whether there was a "single meaning rule" in trade mark law under which the court had to identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly. At paragraph 213 he found there is no such rule.

creates a conceptual point of difference. On this basis, I consider that the marks are conceptually similar to at least a medium degree.

### **Distinctive character of the earlier trade mark**

68. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

69. 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

70. As the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

71. Mr Carter submitted that the opponent's "RooFit" mark is a "fanciful and made-up word with no English language meaning", it is inherently distinctive to a high degree. However, as noted in paragraph 66 above, the average consumer may perceive the mark as being the combination of the words "roo" and "fit" or "roof" and "it".

72. If the average consumer sees the word "roo" (abbreviation of the word kangaroo) and the ordinary dictionary word "fit", neither of which are allusive or descriptive of the opponent's goods, then the mark is inherently distinctive to between a medium and high degree. However, if the average consumer sees the ordinary dictionary words "roof" and "it", then they will understand the mark as a whole to mean "to roof it", which will be allusive of the opponent's "building material and building components of metal" which can be used for roofing. This results in the opponent's mark being inherently distinctive to between a low and medium degree.

### **Likelihood of confusion**

73. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. 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. The first 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive 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 he has retained in his mind.

74. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the parties' marks to be visually, aurally and conceptually similar to at least a medium degree.
- I have found the earlier mark to be inherently distinctive to between a medium and high degree, or to between a low and medium degree, depending on how the consumer perceives the mark.
- I have identified the average consumer as the general public, and professionals who work in the building or construction industry, who will select the goods and services primarily by visual means, although I do not discount an aural component.
- I have concluded that at least a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods and services to be similar to a medium degree, between a low and medium degree, or similar to a low degree.

75. Taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that the opponent's word mark is wholly contained at the beginning of the holder's word IR, a position to which the consumer pays more attention to, I consider that there is a likelihood of direct confusion. Whilst the opponent's "RooFit" mark and the "ROOFIT" element at the beginning of the holder's IR are presented in different cases as registered, as noted above, normal and fair use of the opponent's word mark means it could be presented in all upper or lower-case. On this basis, the use of different cases has been of no impact to my visual, aural and conceptual comparison. Thus the only difference between the marks is the ".SOLAR" element at the end of the holder's IR, which would be easily overlooked or misremembered by the average consumer when used on the holder's goods and services which contain solar panels/cells (making it a descriptive element). Consequently, I consider that there is a likelihood of direct confusion on these goods and services, even those which are similar to a low degree, due to the effect of the interdependency principle.

76. For the holder's remaining goods, where the word SOLAR is not descriptive, being "materials, not of metal, for building and construction", "rigid pipes, not of metal, for building" and "transportable buildings, not of metal" in class 19, I do not consider there to be a likelihood of direct confusion on the basis that the SOLAR element is unlikely to be overlooked as it is neither descriptive or allusive of the goods and services.

77. I will also assess if there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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."

78. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

79. I consider that the shared common use of "RooFit/ROOFIT" in the parties' word marks will lead the average consumer to conclude that they originate from the same or economically linked undertakings, when being used on the holder's goods and

services which contain solar panels/cells. This is on the basis that whilst the holder's IR ends in the ".SOLAR" element, this is descriptive of these goods and services. Therefore, I find that the average consumer will view the holder's IR as an alternative mark being used on similar goods and services, by the same or economically linked undertakings, perhaps denoting a specialist range of building goods and services which contain solar panels and solar cells, or it could be viewed as being an updated version of the same mark and therefore indicative of re-branding. I consider that it is not uncommon for undertakings re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, I consider there to be a likelihood of indirect confusion on these goods and services, even those which are similar to a low degree, due to the effect of the interdependency principle.

80. For the holder's remaining goods, for which the word SOLAR is neither descriptive or allusive, being "materials, not of metal, for building and construction", "rigid pipes, not of metal, for building" and "transportable buildings, not of metal" in class 19, I do not consider there to be a likelihood of indirect confusion. This is on the basis that the addition of the SOLAR element would not be a natural variant, nor a logical or consistent brand extension, when being used on goods for which solar energy, power, cells or panels are not being used. Even if the opponent's mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. I find there is no likelihood of indirect confusion.

## **CONCLUSION**

81. The opposition is partially successful in respect of the following goods and services, for which the applications are refused:

Class 6      Roof coverings of metal containing solar cells; roof coverings of metal containing solar panels.

Class 19      Materials for building and construction, not of metal, containing solar panels; materials for building and construction, not of metal, containing solar cells; roof coverings, not of metal, containing solar cells; roof coverings, not of metal, containing solar panels.

Class 40 Custom manufacture of prefabricated construction elements, including prefabricated building elements containing solar cells or solar panels.

82. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 4 Electrical energy; electrical energy form solar power.

Class 9 Solar cells; solar batteries; solar panels; solar modules; solar panels for electricity generation; photovoltaic inverters; photovoltaic apparatus and installations for generating solar electricity; photovoltaic apparatus for converting solar radiation to electrical energy.

Class 19 Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; transportable buildings, not of metal;

Class 37 Construction services; installation and repair services of roofs and solar energy equipment; construction of utility solar installations; installation of residential solar panel power systems; installation of non-residential solar panel power systems; maintenance and repair of solar power installations; repair or maintenance of power distribution or control machines and apparatus; maintenance, servicing and repair of power generating apparatus and installations; servicing of power generating apparatus and installations; installation of power generating apparatus; electrical installation services; installation of electric light and power systems; servicing of mains services; maintenance and repair of energy generating installations; installation of energy-saving apparatus; repair of energy supply installations; roofing installation; installation of non-residential solar panel power systems; installation of solar powered systems; maintenance and repair of solar thermal installations; installation and maintenance of solar thermal installations; installation of solar heating systems; providing information relating to the installation of electrical apparatus.

Class 40 Energy production; electricity generating; generation of electricity from solar energy; rental of energy and electricity generating equipment, including rental of solar panels; consultancy services relating to the generation of energy and electrical power; custom manufacture of energy and electricity generating equipment, including solar panels.

Class 42 Development of power assemblies; consultancy in the field of energy-saving; technical advice in connection with energy-saving measures; advisory services relating to the use of energy; technological consultancy in the fields of energy production and use; advisory services relating to energy efficiency; engineering services relating to energy supply systems; design and development of energy distribution networks; certification services for the energy efficiency of buildings; recording data relating to energy consumption in buildings; conducting research and technical project studies relating to the use of natural energy; provision of information concerning research and technical project studies relating to the use of natural energy; professional consultancy relating to the conservation of energy; professional consultancy relating to energy efficiency in buildings; design and development of software for control, regulation and monitoring of solar energy systems; providing technical advice relating to energy-saving measures; technological consulting services in the field of alternative energy generation; monitoring of network systems.

83. The opposition was not directed against the following goods and services for which the application can proceed to registration:

Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus for recording, transmitting, reproducing sound or images; magnetic data carriers, recording discs; CDs, DVDs and other digital storage media; coin-operated mechanisms;

cash registers, calculators, information processing equipment and computers; recorded computer software and downloadable computer software; software for mobile devices; software for tablet computers; software for smartphones; databases (electronic); computer software applications, downloadable; computer software platforms; electricity measuring instruments; electric control apparatus; electric control apparatus for the supply and consumption of electricity; energy control devices; apparatus for monitoring electrical energy consumption; electric control devices for energy management; energy system regulators; monitoring apparatus, other than for medical purposes.

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis, industrial research and industrial design services; quality control and authentication services; design and development of computer hardware and software; rental of computer software; providing temporary use of on-line non-downloadable software; software as a Service [SaaS]; platform as a service [PaaS]; cloud computing; application service provider services; application service provider [ASP], namely, hosting computer software applications of others; computer programming for the energy industry; development of energy and power management systems; technological analysis relating to energy and power needs of others; consultancy relating to technological services in the field of power and energy supply; creation of control programs for electric operation control and drive modules; designing of electrical systems; energy auditing; programming of energy management software; design and development of energy management software.

## **COSTS**

84. In these proceedings, the holder has enjoyed a greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the holder the sum of **£800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a counterstatement	£200
Preparation for and attendance at hearing	£600
<b>Total</b>	<b>£800</b>

85. I therefore order Lindab AB to pay Roofit Solar Energy OÜ the sum of £800. This sum is to 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 10<sup>th</sup> day of December 2024**

**L FAYTER**

**For the Registrar**

## ANNEX 1

### Class 4

Electrical energy; electrical energy form solar power.

### Class 6

Roof coverings of metal containing solar cells; roof coverings of metal containing solar panels.

### Class 9

Solar cells; solar batteries; solar panels; solar modules; solar panels for electricity generation; photovoltaic inverters; photovoltaic apparatus and installations for generating solar electricity; photovoltaic apparatus for converting solar radiation to electrical energy.

### Class 19

Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; transportable buildings, not of metal; materials for building and construction, not of metal, containing solar panels; materials for building and construction, not of metal, containing solar cells; roof coverings, not of metal, containing solar cells; roof coverings, not of metal, containing solar panels.

### Class 37

Construction services; installation and repair services of roofs and solar energy equipment; construction of utility solar installations; installation of residential solar panel power systems; installation of non-residential solar panel power systems; maintenance and repair of solar power installations; repair or maintenance of power distribution or control machines and apparatus; maintenance, servicing and repair of power generating apparatus and installations; servicing of power generating apparatus and installations; installation of power generating apparatus; electrical installation services; installation of electric light and power systems; servicing of mains services; maintenance and repair of energy generating installations; installation of energy-saving apparatus; repair of energy supply installations; roofing installation; installation of non-residential solar panel power systems; installation of solar powered

systems; maintenance and repair of solar thermal installations; installation and maintenance of solar thermal installations; installation of solar heating systems; providing information relating to the installation of electrical apparatus.

#### Class 40

Energy production; electricity generating; generation of electricity from solar energy; rental of energy and electricity generating equipment, including rental of solar panels; consultancy services relating to the generation of energy and electrical power; custom manufacture of prefabricated construction elements, including prefabricated building elements containing solar cells or solar panels; custom manufacture of energy and electricity generating equipment, including solar panels.

#### Class 42

Development of power assemblies; consultancy in the field of energy-saving; technical advice in connection with energy-saving measures; advisory services relating to the use of energy; technological consultancy in the fields of energy production and use; advisory services relating to energy efficiency; engineering services relating to energy supply systems; design and development of energy distribution networks; certification services for the energy efficiency of buildings; recording data relating to energy consumption in buildings; conducting research and technical project studies relating to the use of natural energy; provision of information concerning research and technical project studies relating to the use of natural energy; professional consultancy relating to the conservation of energy; professional consultancy relating to energy efficiency in buildings; design and development of software for control, regulation and monitoring of solar energy systems; providing technical advice relating to energy-saving measures; technological consulting services in the field of alternative energy generation; monitoring of network systems.

## ANNEX 2

Opponent's goods	Applicant's goods and services
<p><u>Class 6</u> Building material and building components of metal.</p>	<p><u>Class 4</u> Electrical energy; electrical energy form solar power.</p> <p><u>Class 6</u> Roof coverings of metal containing solar cells; roof coverings of metal containing solar panels.</p> <p><u>Class 9</u> Solar cells; solar batteries; solar panels; solar modules; solar panels for electricity generation; photovoltaic inverters; photovoltaic apparatus and installations for generating solar electricity; photovoltaic apparatus for converting solar radiation to electrical energy.</p> <p><u>Class 19</u> Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; transportable buildings, not of metal; materials for building and construction, not of metal, containing solar panels; materials for building and construction, not of metal, containing solar cells; roof coverings, not of metal, containing solar cells; roof coverings, not of metal, containing solar panels.</p>

	<p><u>Class 37</u></p> <p>Construction services; installation and repair services of roofs and solar energy equipment; construction of utility solar installations; installation of residential solar panel power systems; installation of non-residential solar panel power systems; maintenance and repair of solar power installations; repair or maintenance of power distribution or control machines and apparatus; maintenance, servicing and repair of power generating apparatus and installations; servicing of power generating apparatus and installations; installation of power generating apparatus; electrical installation services; installation of electric light and power systems; servicing of mains services; maintenance and repair of energy generating installations; installation of energy-saving apparatus; repair of energy supply installations; roofing installation; installation of non-residential solar panel power systems; installation of solar powered systems; maintenance and repair of solar thermal installations; installation and maintenance of solar thermal installations; installation of solar heating systems; providing information relating to the installation of electrical apparatus.</p>
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	<p><u>Class 40</u></p> <p>Energy production; electricity generating; generation of electricity from solar energy; rental of energy and electricity generating equipment, including rental of solar panels; consultancy services relating to the generation of energy and electrical power; custom manufacture of prefabricated construction elements, including prefabricated building elements containing solar cells or solar panels; custom manufacture of energy and electricity generating equipment, including solar panels.</p> <p><u>Class 42</u></p> <p>Development of power assemblies; consultancy in the field of energy-saving; technical advice in connection with energy-saving measures; advisory services relating to the use of energy; technological consultancy in the fields of energy production and use; advisory services relating to energy efficiency; engineering services relating to energy supply systems; design and development of energy distribution networks; certification services for the energy efficiency of buildings; recording data relating to energy consumption in buildings; conducting research and technical project studies relating to the</p>
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	<p>use of natural energy; provision of information concerning research and technical project studies relating to the use of natural energy; professional consultancy relating to the conservation of energy; professional consultancy relating to energy efficiency in buildings; design and development of software for control, regulation and monitoring of solar energy systems; providing technical advice relating to energy-saving measures; technological consulting services in the field of alternative energy generation; monitoring of network systems.</p>
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