BL O/0316/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF UK REGISTRATION NO. 4004175
IN THE NAME OF JANUS INTERNATIONAL GROUP LLC

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NUMBER 448524
BY BKS GMBH

AND

IN THE MATTER OF UK REGISTRATION NO. 911154713
IN THE NAME OF BKS GMBH

AND

IN THE MATTER OF THE APPLICATION FOR THE REVOCATION THEREOF
UNDER NO. 508607
BY JANUS INTERNATIONAL GROUP LLC

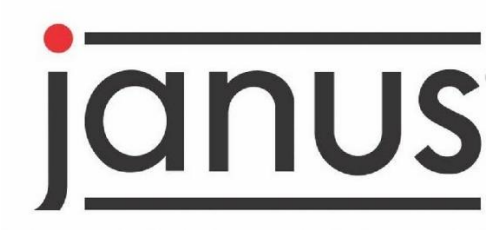
BACKGROUND AND PLEADINGS

1. This matter involves one revocation action based on non-use and an opposition.

Revocation Action 508607

2. BKS GmbH ("BKS") is the registered proprietor ("the proprietor") of the following UK Trade Mark ("UKTM"):

UKTM no. 911154713[1]



Filing date 31 August 2012; registration date 28 January 2013. For goods/services in classes 6, 7, 9, 20, 42 and 45[2].

("the BKS mark")

3. On 30 May 2023, Janus International Group LLC ("Janus"), applied to revoke the contested mark in accordance with section 46(1)(b) of the Trade Marks Act 1994 ("the Act"). Revocation is sought in respect of the specification in its entirety in the five-year period from 30 May 2018 to 29 May 2023 with an effective date of revocation of **30 May 2023**.

4. BKS filed a defence and counterstatement in these proceedings, defending use of its trade mark in the period claimed.

Opposition proceedings no. 448524

[1] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all rights holders with an existing EU trade mark ("EUTM"). As a result of the proprietor having an EUTM protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable trade mark shown here is now recorded on the UK trade mark register, and has the same legal status as if it had been applied for and registered under UK law, and retain its original EUTM filing dates as set out above.

[2] The specification is set out in full in Annex 1 attached to this decision.

5. On 19 January 2024, Janus applied to register JANUS as a trade mark in the UK (UK trade mark ("UKTM") no. 4004175). It was accepted and published in the Trade Marks Journal on 12 April 2024 and registration is sought for the following goods:

> Class 6 – Metal doors; doors made principally of metal; rolling doors made of metal; metal commercial overhead roll-up doors and roll-up door components therefor; metal hinges; metal tensioners; metal door closers; metal door stops; latches and locks; parts and fittings of the aforesaid.
>
> Class 9 - Electric locks; parts and fittings for all the aforesaid goods.

6. On 11 July 2024, BKS opposed the trade mark on the basis of Section 5(1), 5(2)(a) and 5(2)(b) of the Act. This is on the basis of its earlier comparable mark as set out in paragraph 2, above.

7. Janus filed a defence and counterstatement seeking proof of use of BKS' trade mark registration for all the goods relied upon.

REPRESENTATION

8. BKS is represented by Withers & Rogers LLP. Janus is represented by Walker Morris LLP. Only BKS filed evidence in these proceedings, which it has stated applies to both the revocation and opposition proceedings. No hearing was requested; however, both parties filed written submissions in lieu of the same.

RELEVANCE OF EU LAW

9. 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.

EVIDENCE AND SUBMISSIONS

10. The opponent's evidence consists of the following witness statements:

- Mr Robert Rossall, dated 24 November 2022, which is accompanied by two exhibits (RR1 – RR2). Mr Rossall is the Managing Director of Gretsch-Unitas Limited, which is the UK affiliate of BKS.

- Mr Lutz Lueke, dated 15 December 2022, which is accompanied by three exhibits (LL1 – LL3). Mr Lueke is the Sales Director of BKS.

- Mr Scott Gareth Tatchell, dated 11 January 2023, which is accompanied by three exhibits, (SGT1 – SGT3), which are a translation of Mr Lueke's statements and exhibits, above.

- Ms Stephanie Davies, dated 15 November 2024. Ms Davies is a Trade Mark Attorney at Withers & Rogers LLP.

- A second statement of Mr Lutz Lueke, dated 27 November 2024, accompanied by one exhibit (LL4).

11. Both BKS and Janus filed written submissions dated 15 October 2025.

12. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions to the extent that it is necessary in my decision.

PRELIMINARY ISSUES AND MY APPROACH

13. On 11 March 2025, the representative for Janus emailed the Registry stating as follows:

> "As part of the process in finalising the submissions for the above matter, I have been reviewing our records and other cases regarding the marks in question. I note that we filed a revocation action against the mark which has been used as the basis for this opposition (UK00911154713) in May 2023. It would appear that this revocation action was then not forwarded to the TM Owner or their representative by the IPO. The representative for the TM Owner was copied into the correspondence at the time of filing the action.
>
> I am attaching a copy of the submission of the form and the receipt of the form by the IPO. A copy of this form was also attached to the submissions filed in a

previous opposition case dated 30 May 2023. Again, both of which were copied to the TM Owner's representative.

The attached revocation action was filed at the same time as the corresponding cancellation action no. CA000506152. The mark in this regard was subsequently revoked in the UK. I have checked our records and a fee of £200 was deducted from our deposit account with the IPO in respect of both actions".

The opposition proceedings were then suspended to investigate the above. The Tribunal confirmed that the revocation proceedings were filed on 30 May 2023. However, due to an administrative error the proceedings had not been actioned. The revocation proceedings were admitted on 14 March 2025, with BKS given a deadline of 14 May 2025 to submit their Form TM8(N). On 13 May 2025 BKS filed their TM8(N) along with correspondence stating that the proceedings should not be allowed to continue due to the delay in Janus raising the same.

14. On 18 June 2025, the Tribunal wrote to the parties and directed that, in accordance with Rule 62(1)(g) of the Trade Marks Rules 2008, these proceedings were to be consolidated.

15. I note that the revocation proceedings were commenced correctly by Janus, and the delay in admitting the revocation proceedings was due to an administrative error by the Tribunal. Therefore, the revocation proceedings must be allowed to continue.

16. I shall deal with the revocation action first in my decision as this will impact and/or limit the extent of the earlier rights upon which BKS may rely in the opposition proceedings.

EVIDENCE

17. BKS has filed the evidence below in relation to both the revocation and opposition proceedings. For the purposes of the revocation, the relevant period is from 30 May 2018 to 29 May 2023. As the BKS mark is a comparable mark, BKS can rely upon use of the mark in the EU for any and all parts of the relevant periods which fall prior to IP Completion Day, namely, 31 December 2020.[3]

[3] paragraphs 7 and 8 of Part 1 Schedule 2A of the Act.

18. I note that BKS has filed some evidence which falls outside of the relevant period within the proceedings. I will not consider this evidence unless it is relevant to the operation of section 46(3) or explains what the position was during the relevant period.

Witness statement of Mr Robert Rossall dated 24 November 2022

19. Mr Rossall states as follows:

a. Mr Rossall is the Managing Director of Gretsch-Unitas Limited ("G-U"), which is the UK affiliate of BKS. He has worked for G-U since 1996.

b. G-U is a sales and distribution business and operates in the architectural ironmongery sectors promoting and selling locking mechanisms of various specifications, and has done so since 1996.

c. Mr Rossall states that for the UK "the total annual wholesale figures for the sale of the Products under the Earlier Trade Mark since 2017 are set out in the table below"[4]:

Annual Sales of Products Bearing the Earlier Trade Marks	Total £
2017	£3734.10
2018	-
2019	£140
2020	£296.96

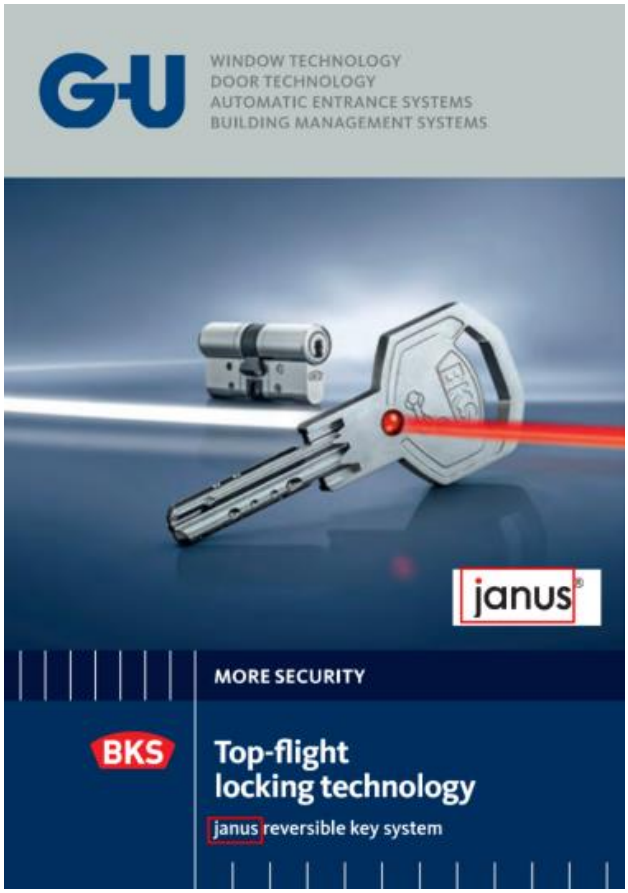
d. Mr Rossall has provided ten invoices[5] dated between 25 April 2017 and 18 December 2020, which represent a selection of invoices to support the above figures. Two of these invoices fall outside of the relevant period and will therefore be disregarded. The invoices all have "G-U" in the header and amount to £1,389.68 in total. I note the figures in the table above; however, I have invoices before me for the value of £336.02

[4] Witness statement of Robert Rossall, para 2
[5] Exhibit RR1

in 2019 and £1,053.66 in 2020, which is in excess of the amounts cited for those years in the table. The invoices are all addressed to customers within the UK. I note that the invoices are for various types of plates, metal key systems, keys, and knobs.

e. Mr Rossall has also provided printouts of web pages from the G-U website showing use of the mark[6]. Again, some of the evidence in this exhibit falls outside of the relevant period and will therefore be disregarded. I note the following:

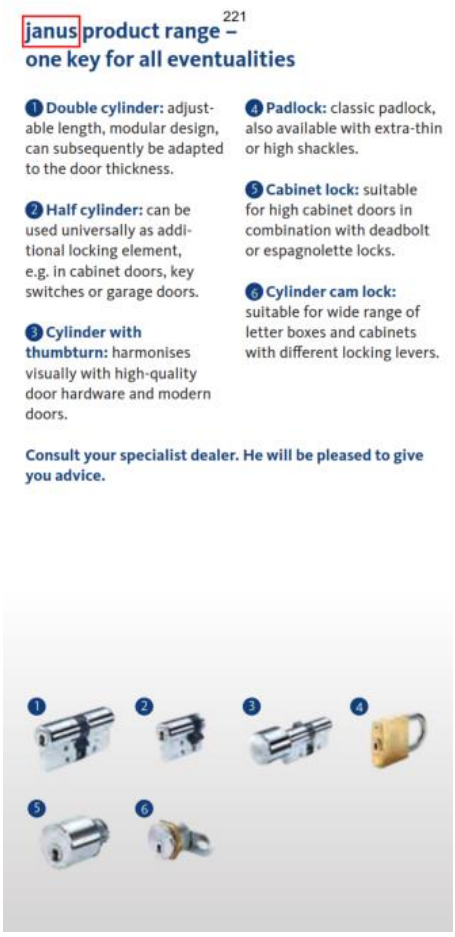
    i. A catalogue has been provided advertising "top-flight lock technology". The catalogue also shows locks for commercial properties. This is dated September 2019 and features the mark in use:



[6] Exhibit RR2

ii. A press release from the G-U website stating that the BKS brand is celebrating its birthday in May 2018. I note that the article mentions the Janus brand was launched in 2015. The article was printed on 17 November 2022 but is undated.

iii. A further print out is provided regarding the Janus brand and product range. As well as featuring various types of lock fittings for doors, BKS also provide locking mechanisms for cabinet doors, key switches and garage doors. This is dated September 2019 and features the mark in use:


janus product range – 221
one key for all eventualities

1 **Double cylinder:** adjustable length, modular design, can subsequently be adapted to the door thickness.

2 **Half cylinder:** can be used universally as additional locking element, e.g. in cabinet doors, key switches or garage doors.

3 **Cylinder with thumbturn:** harmonises visually with high-quality door hardware and modern doors.

4 **Padlock:** classic padlock, also available with extra-thin or high shackles.

5 **Cabinet lock:** suitable for high cabinet doors in combination with deadbolt or espagnolette locks.

6 **Cylinder cam lock:** suitable for wide range of letter boxes and cabinets with different locking levers.

Consult your specialist dealer. He will be pleased to give you advice.

iv. A press release from the G-U website regarding the refurbishment of the City hall of Düren, which I note took place between 2012 and 2015. I note that the article mentions the Janus brand which was used throughout the renovation of the building including “478 Vertical-Pivot windows, 2 automatic sliding doors,

250 ixalo SE locks, 56 double knob cylinders, 30 wall readers, master key system consisting of 300 janus cylinders". The article was printed on 17 November 2022 but is undated.

v. A press release from the G-U website regarding Grimmwelt Kassel, an exhibition building that celebrates the works of the Brothers Grimm, in which the Janus mechanical master key system and panic locks were used for one and two-leaf doors. The article was printed on 17 November 2022 but is undated.

Witness statement of Mr Lutz Lueke dated 15 December 2022

20. Mr Lueke states as follows:

a. Mr Lueke is the Sales Director of BKS, a role he has held since 2021, and prior to this time he was the Sales Manager of BKS between 2016 – 2020.

b. BKS is a manufacturer of mechanical and electronic locks and locking systems. The company's foundation dates back to 1903 and has used the mark in Germany since 2012. The total annual wholesale figures for the sale of the products under the mark are as follows[7]:

Year	Total EURO (EUR)/British Pound (£)
2016	EUR 6,163,503/£ 4,783,000
2017	EUR 5,888,250/£ 5,125,500
2018	EUR 5,342,096/£ 4,670,000
2019	EUR 5,349,981/£ 4,740,500
January 2020	EUR 480,905/£ 411,300

c. Mr Lueke has provided five invoices dated between 9 August 2018 and 28 January 2020[8]. The invoices are in German and addressed to

[7] Witness statement of Lutz Lueke, para 2
[8] Exhibit LL1

customers within Germany. All of the invoices refer to Janus products; however, the amount of each invoice is redacted.

d. Mr Lueke has provided extracts from product brochures[9] which are distributed in Germany. These are written in German and two of the brochures are dated outside the relevant period.

e. The products have been advertised in Germany, and an advert which bears the mark has been provided to link in with the 2018 Football World Cup[10]. I have no details as to where the advert was used or how many people it was distributed to.

Witness statement of Mr Scott Gareth Tatchell, dated 11 January 2023.

21. Mr Tatchell is a translator at RWS and his statement includes three exhibits, being those labelled SGT1 to SGT3. I note that these exhibits are the English translations of excerpts taken from the exhibits included within Mr Lueke's evidence, above. I do not take anything further from the statements than that which I have already referred to.

Ms Stephanie Davies, dated 15 November 2024.

22. Ms Davies states as follows:

a. Ms Davies is a Chartered Trade Mark Attorney at the applicant's representative firm and is, therefore, duly authorised to file evidence on the applicant's behalf.

b. Ms Davies' statement makes reference to previous decisions of both the EUIPO and UKIPO, in which BKS was successful in opposing other applications. I am not bound by the past decisions of either office when making this decision and will say no more about this.

Second statement of Mr Lutz Lueke, dated 27 November 2024

[9] Exhibit LL2
[10] Exhibit LL3

23. Mr Lueke states as follows:

a. Referencing his earlier witness statement, Mr Lueke notes that he had included the wholesale figures for the sale of the products. The figures for 2020 only included those sales made in January of that year. Mr Lueke states that the overall annual wholesale figure for 2020 was €5,058,180 / £4,600,400[11].

b. Mr Lueke has provided a further product catalogue dated October 2019. This is in German but shows various types of keys, metal locks and locking mechanisms are available[12].

c. Sales invoices are provided which are dated between 19 June 2020 and 5 November 2020. These are addressed to customers in Germany and are written in German, although I note that there is repeat custom. The amounts of the invoices have been redacted[13].

d. A seminar leaflet has been provided which is dated December 2019. Mr Lueke states that this was distributed to German customers of BKS. Mr Lueke states that seminar leaflets for 2020 are not available due to the Covid-19 pandemic and any seminars which were conducted were at short notice[14].

DECISION

Revocation proceedings

24. Section 46 of the Act is relevant to the revocation proceedings, which states:

> "46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

[11] Second witness statement of Lutz Lueke, para 3
[12] Exhibit LL4
[13] Exhibit LL4
[14] Second witness statement of Lutz Lueke, para 4

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) […]

(d) […]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date."

25. As the marks are comparable marks, paragraph 8 of part 1, schedule 2A is relevant. It reads:

"8. Non-use as defence in infringement proceedings and revocation of registration of a comparable trade mark (EU)

(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the "five-year period") has expired before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before [IP completion day]—

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM ; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union".

26. Section 100 of the Act states:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

GENERAL PRINCIPLES

27. In *easyGroup Ltd v Nuclei Ltd & Ors [2023]* EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439*,* Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV [EU:C:2012:816], Case C-609/11 Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU [EU:C:2020:854].*

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at[36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: Ansul at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns*: Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

28. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

"22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100

of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

29. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me, and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the contested mark.

FORM OF THE MARK IN USE

30. Before I move on to assess the sufficiency of the evidence, I shall begin by addressing the way in which the BKS mark has been displayed in relation to the relevant goods and services in evidence.

31. The mark as registered is a figurative mark and is presented as follows:

The mark is also presented throughout the evidence as a word mark, JANUS / janus. The registered mark is a figurative mark; however, I find the distinctive character of the mark as a whole to reside in the word itself, with the figurative elements being decorative/stylistic. Therefore, the word version of the mark, which is presented throughout the evidence, whilst lacking the figurative elements, does not alter the distinctive character of the mark as a whole[15]. I therefore find that the word version of the mark is an acceptable variation of the mark and is use upon which BKS can rely.

[15] T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30].

GENUINE USE

Assessment of Evidence

32. With regard to the evidence of use submitted, I must now consider if it sufficiently demonstrates genuine use, whilst reminding myself that use does not have to be quantitatively significant to be genuine. The burden is on the registered proprietor to prove that it has used its mark within the relevant period. Therefore, it was the registered proprietor's responsibility to provide proof that the mark was used within the EU/UK during the relevant period.

33. Whether the evidence is sufficient for this purpose will depend on whether it demonstrates that there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods and services at issue in the relevant territory during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods for which use has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

34. The evidence before me does have its limitations. There are no details in relation to the size of the relevant market, and neither do I have information of the spend on marketing activities. There is also no evidence of use after IP Completion Day in either the UK or the EU, although I note that the mark has been used within both territories up until this time, and, in principle, use prior to IP Completion Day alone may be sufficient to prove use overall.

35. Upon considering the evidence as a whole, I note that Mr Rossall has provided the UK turnover figures for the mark, however, the value of the invoices that I have before me from Mr Rossall is greater than the figures in the table at paragraph 19(c). Mr

Lueke has provided turnover figures for the EU, which I note run into the millions. I accept the figures that Mr Lueke has provided as being reflective of the turnover overall. Mr Lueke does not comment on the geographical coverage of his turnover figures; however, I understand these figures to include turnover from within both Germany (a territory within the EU) and the UK, and this is use upon which BKS can rely.

36. I have been provided with a number of invoices by both Mr Rossall and Mr Lueke. Both witnesses state that the invoices provided are samples. The invoices provided by Mr Rossall are all addressed to UK customers, whereas those provided by Mr Lueke are addressed to German customers, albeit that these are dated prior to IP Completion Day and therefore can be relied upon. I note that the invoices provided by Mr Lueke are redacted.

37. BKS have provided evidence of the mark being used as part of their marketing strategy by promoting the products through catalogues, and I also have before me a seminar leaflet. I also have screenshots of articles taken from the G-U website which mention the Janus brand, however, these are undated. There is also evidence of an advertising campaign that was run during the 2018 Football World Cup. I note that I have no information relating to BKS' financial investment in advertising and promotion. The mere existence of leaflets and screenshots from websites and brochures in isolation, are of little evidentiary value without any supporting information such as an indication as to how many people viewed this information, over what period, the location of those people, the volume of custom generated as a result, or the extent that the relevant consumer had been exposed to the mark by viewing this material. These details have not been provided. As some of this evidence is undated it cannot be attributed to any of the relevant periods.

38. Although the evidence is lacking in some areas, when taking the evidence as a whole, I am satisfied that the evidence shows that the mark has been used either as registered or in the acceptable variations as outlined. The turnover figures are in the millions per annum, and BKS has clearly taken steps to promote the products sold under its mark and to maintain a share in the market. Whilst the use within the EU is limited to two territories (the UK and Germany), as per *Leno Merken BV v Hagelkruis*

Beheer BV[16]*,* this can constitute use of the mark across the entire territory. I am therefore satisfied that the earlier mark has been put to genuine use.

FAIR SPECIFICATION

39. I must now consider whether, or the extent to which, the evidence shows use of the mark at issue in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,[17] Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

40. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 the Court of Appeal set out the proper approach to partial revocation, as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.
>
> 247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So, care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for

[16] [EU:C:2012:816], Case C-609/11
[17] BL O/345/10

goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

41. This approach was endorsed by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36:

"261. … First, there can be no doubt that an application to register a mark in respect of a broad category of goods or services may be made *partly* in bad faith in so far as the broad description includes distinct sub-categories of goods or services in relation to which the applicant never had any intention to use the mark, whether conditionally or otherwise. In my view, that emerges clearly from the decision of the CJEU in this case. The approach to be adopted in such a case was explored and explained by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp* [2017] EWCA Civ 1834; [2018] ETMR 10, at paras 241-2491 and, so far as I am aware, that approach has proved workable and appropriate and has stood the test of time, save that it must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v*

DU (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

42. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch) at [47], the late Carr J pointed out that it is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do; for example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally.

43. BKS' specification is as follows:

> Class 6 Non-electric and non-electronic locks of metal (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), each consisting of non-electric and non-electronic locks of metal; Keys and Lock cylinders of metal; key blanks of metal.
>
> Class 7 Electric motor drives for locks.
>
> Class 9 Electric and electronic locks; Electric and electronic locking systems and multi-point locks, each consisting of electric and electronic locks; Electric and Electronic lock cylinders; Transponders for actuating electric and Electronic locks, Locking systems and multi-point locks; Electronic keys having an inbuilt transponder of the aforesaid kind; Electronic apparatus for controlling access to buildings; Electronic surveillance apparatus and electronic control apparatus for window and door locks; Chip cards and magnetic cards for actuating electronic control apparatus for window and door locks.
>
> Class 20 Non-electric and non-electronic locks of plastic (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), consisting of non-electric and non-electronic locks of plastic; Keys and Lock cylinders of plastics; Key blanks of plastic.

Class 42 Consultancy relating to and calculation of locking systems, door locking systems, door control systems, locks, lock cylinders, panic/anti-panic locks, code locks and door drive units.

Class 45 Consultancy in the field of security, in particular for buildings; Safety inspection of factories.

44. From BKS' evidence, it is clear that their JANUS products are differing types of metal lock and key systems for residential and commercial properties, and this is reiterated throughout the evidence. However, the evidence does not extend to some of the specific goods/services that they have within their specification. The only evidence that I have before me relating to electronic locking systems is from a catalogue provided in evidence by Mr Rossell, however, this is dated February 2016 and therefore falls outside of the relevant period. I have no other evidence before me to support the fact that BKS use the mark for electronic locks or any form of plastic lock. Similarly, I do not consider that the evidence before me shows that BKS has used the mark in relation to *electric motor drives for locks*.

45. Further, there is no sufficient evidence which shows that consultancy services are provided by BKS. Whilst they may provide consultancy for locking systems and security, I have no evidence before me to illustrate that these services are offered alongside the goods.

46. Having considered the specification, I consider that the below is a fair specification of the goods upon which BKS may rely:

Class 6

Non-electric and non-electronic locks of metal (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), each consisting of non-electric and non-electronic locks of metal; Keys and Lock cylinders of metal;

Opposition Proceedings

54. I now turn to firstly consider the opposition under section 5(2)(b). This is because BKS' claim under sections 5(1) and 5(2)(a) require both the marks to be identical and

the goods to be identical/similar for a claim under these grounds to succeed, whereas under section 5(2)(b) the marks need only be similar. I shall return to this position, if necessary, later in my decision.

DECISION

Section 5(2)(b)

55. Section 5(2)(b) of the Act states 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.

56. Section 5A of the Act reads as follows:

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

PROOF OF USE

47. Section 6A sets out the relevant provision of the Act in relation to proof of use. The relevant period for assessing proof of use is the five-year period ending with the date of the application for registration of the mark, namely 20 January 2019 to 19 January 2024. This is a different relevant period to the relevant period for the purposes of the revocation action, but there is overlap between the two. I note however, that earlier in my decision, I found non-use for some of BKS' terms and consequently, I partially revoked BKS' marks for those goods as at the effective date of revocation following

the end of the relevant period being 30 May 2023. Given the wording of section 5(2)(b) of the Act, BKS is only able to rely upon those goods for which the earlier marks are protected as at the relevant date, in this case 19 January 2024. Consequently, given that the revocation date predates the application for registration, BKS may not rely upon those goods/services which have been revoked as per paragraph 46 for the purposes of its opposition.[18]

48. For the reasons already provided, I am satisfied that genuine use has been shown for the BKS mark within the proof of use relevant period. I adopt my earlier findings, and BKS may rely on it for the purposes of its opposition.

THE PRINCIPLES

49. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

> (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

[18] See Riveria Trade Mark decision [2003] RPC 50 (O/104/03 and O/214/03); *T-Mobile(UK) Limited v O2 Holdings Ltd*, O/088/07 and later on appeal O/364/07; *Tax Assist Direct Limited v Mr Nasratul Ameen* on appeal, O/220/12 (Tax Assist Trade Mark) and *PT MRI Indonesia v Dr Curtis N Rhodes, Jr* O/0689/25 (TM Moores Rowland).

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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and

(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

50. In light of my findings above the competing goods are as follows:

BKS' goods	Janus' goods
Class 6 - Non-electric and non-electronic locks of metal (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), each consisting of non-electric and non-electronic locks of metal; Keys and Lock cylinders of metal;	Class 6 – Metal doors; doors made principally of metal; rolling doors made of metal; metal commercial overhead roll-up doors and roll-up door components therefor; metal hinges; metal tensioners; metal door closers; metal door stops; latches and locks; parts and fittings of the aforesaid.
	Class 9 - Electric locks; parts and fittings for all the aforesaid goods.

51. 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 of its judgment 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."

52. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

> (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.

53. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, the General Court 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."

54. Janus has denied that the goods and services of the parties are identical or similar. Janus has also stated that BKS did not provide evidence to show that the goods were identical/similar. The goods and services comparison is a notional assessment based on the factors set out above. Therefore, the fact that BKS has provided no evidence in order to prove the identity/similarity of the goods at issue has no bearing on my decision.

55. BKS submits that the goods applied for are identical and/or similar to its goods and services. I remind myself that some of the goods/services have not survived my assessment of genuine use, above. Therefore, I will proceed to undertake my assessment based upon the specification as it now stands.

Class 6

Metal doors; doors made principally of metal; rolling doors made of metal; metal commercial overhead roll-up doors and roll-up door components therefor;

56. BKS' goods in class 6, *keys and lock cylinders of metal*, are fittings which form part of a door, whereas Janus' above goods include the doors themselves. I note that in *Les Éditions Albert René v OHIM*[19] it was found that just because a particular good is used as a part, element or component of another does not mean that the goods are similar. The nature and method of use will plainly differ, as one of the goods is a hinged or sliding barrier at an entrance which is used to secure or close off a space whereas the other is a mechanism used to keep a door or window fastened, usually with a key. However, there will be an overlap in user, as someone who is purchasing a door may also require a locking mechanism and key to secure it. I consider that trade channels will overlap in some circumstances, as it is likely that some undertakings will produce both the door and the door furniture and locks, however, this will not always be the case. I accept that both may be sold by the same retailers. The goods are not competitive; however, I do find that there is an element of complementarity as one is important or indispensable to the other, and I accept that consumers may believe that in instances where the goods are sold and installed as the finished product, the average consumer will assume that the responsibility of the goods lies with the same undertaking, particularly as they will not proceed to analyse the component parts[20]. I find the goods to be similar to a low degree.

Metal hinges; metal tensioners; metal door closers; metal door stops;

57. Janus' above goods are all component parts / fittings for doors. Therefore, I find that there is an element of overlap in the nature of the parties' goods. I find that the goods are likely to overlap in user. As per my findings above, I do not find that the same undertaking would produce all of the above goods and BKS' goods, however, they may be sold by the same retail outlets and will be displayed near to each other in stores. I do not consider that these goods overlap in method of use or purpose and

[19] Case T-336/03
[20] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

neither do I find them to be competitive or complimentary. I find these goods are similar to between a low and medium degree.

Latches and locks;

58. BKS' goods in class 6 include *non-electric and non-electronic locks of metal*. I consider this to be encompassed by the above *locks* in Janus' specification and is therefore identical on the principles outlined in *Meric*.

59. *Locks* and *latches* are similar in purpose and use, as both are used to secure things in a closed position, although locks typically add an extra level of security, while latches are usually simpler. As a result, users may overlap, as will trade channels. There may be a level of competition, as it is possible that a consumer may choose a latch over a lock, or vice versa. I do not find complementarity. Overall, I find that they are similar to a high degree.

Parts and fittings of the aforesaid.

60. I have found BKS' goods to be fittings which form part of a door. I therefore find that Janus' above term may encompass BKS' goods and will therefore be identical on the principles outlined in *Meric*.

Class 9

Electric locks; parts and fittings for all the aforesaid goods.

61. BKS' specification includes the term *keys and lock cylinders of metal* in class 6. Both terms include locks, albeit that one is mechanical, and one is electric. Whilst these are not identical, the purpose and nature of the goods will be the same or similar. I also find that the method of use will be the same or similar. Users may overlap. I find the goods to be competitive as someone seeking to purchase a lock may consider the merits of both an electric lock and a metal mechanical lock when making their decision. I do not find complementarity. I find these goods are similar to a high degree.

THE AVERAGE CONSUMER AND THE PURCHASING ACT

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

63. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

> (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
>
> (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
>
> (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
>
> (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by and enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
>
> (e) The average consumer’s level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

64. The goods at issue will be purchased by both members of the general public who are carrying out DIY, and professionals, such as door fitters, locksmiths and contractors on building and refurbishment projects. The goods will be available to purchase in-store at places such as trade, hardware and home improvement outlets and online. I consider that the selection process will be predominantly visual, although I do not discount an aural component, allowing for word-of-mouth recommendations or advice from sales assistants.

65. The price of the goods is likely to vary from relatively inexpensive goods, such as keys, to those which are more expensive, such as metal doors and electronic locks (although not significantly so). The goods will be purchased relatively infrequently by members of the general public, but relatively frequently by trade persons. Both groups of consumers will consider factors such as security, longevity (such as product guarantees) and ease of installation. Janus submits that the average consumer will utilise a "higher degree of care and attention and making comparisons for the goods for sale". I appreciate that the goods may relate to security of a premises, for example; however, I do not find that the considerations of the general public will be particularly complex when regarding these goods. However, there are goods, namely *Metal commercial overhead roll-up doors and roll-up door components therefor*, where the end-consumer will be a business, but I cannot see that they would fit the goods themselves, and in these instances a higher level of attention would be paid. With this in mind, I consider that the general public will pay a medium degree of attention. The professional consumer will pay a higher degree of attention (although not the highest).

COMPARISON OF MARKS

66. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The

CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

67. It would be wrong, therefore, to dissect the trade marks artificially, 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.

68. The respective trade marks are shown below:

BKS' trade mark	Janus' trade mark
janus	JANUS

69. Both parties have made submissions regarding the comparison of the marks. I have considered these submissions in full and will refer to them where necessary.

Overall impression

70. BKS' trade mark is a figurative mark which consists of the word 'janus' in a basic black typeface. The dot above the 'j' is red. There are horizontal lines above the top and bottom of the word (although they do not cover the letter 'j'). The dominant and distinctive element of the mark is the word, 'janus', with the other elements being purely decorative.

71. Janus' mark is a word only mark that consists solely of the word 'JANUS'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself.

Visual comparison

72. I have found that 'janus' is the dominant and distinctive element of BKS' mark, and the only element of Janus' mark. I remind myself that a word only mark, is capable of being presented in any casing, typeface or colour. The typeface used in the BKS mark appears to be a standard font, and therefore Janus' mark could be presented in the same typeface as that used by BKS, albeit without the decorative features. I consider that the marks are visually similar to a high degree.

Aural comparison

73. Since no articulation will be given to the decorative elements of Janus' mark, each mark will be referred to by reference to the words only. Both marks will be pronounced as two syllables, being 'JAN-US' or 'YAN-US'. As the word in each mark is the same, I find that the marks are aurally identical.

Conceptual comparison

74. Janus submits:

> "Conceptually, the Earlier Trade Mark and the mark of the Application both contain the words "JANUS". As set out in paragraph 30, above, the term "JANUS" is defined in the Cambridge dictionary as "*the God of beginnings, gates and doorways. He is often shown with two faces, one looking forward and one looking backward*". It is a generic and descriptive term in relation to the goods and services in question. As such, overall, the marks are only conceptually similar to a very low degree".

75. BKS submits:

> "Janus is the name of the Roman god of beginnings, gates, transitions, time, duality, doorways, passages, frames and endings
> …

> Visually, aurally and conceptually, each mark shares the common distinctive element “janus” and they are identical, or, if not identical, highly similar on this basis”

76. Whilst both parties submit that JANUS is the name of the Roman God, I do not consider that a significant proportion of consumers would be aware of this meaning when considering the marks. Whilst I accept that some consumers may be aware of this reference, I consider that a significant proportion will view JANUS as either being a made-up word, or a word from another language. As I have found the additional elements to BKS’ mark to be decorative, this will not impact the conceptual assessment of the mark. Therefore, I find that the average consumer will not understand the marks to have an immediately graspable concept, and as such I find them to be conceptually neutral.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

77. 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 C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section

of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

78. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

79. BKS submits as follows:

> "The word Janus enjoys a high level of inherent distinctiveness in respect of the goods and services covered by Party B's registrations…The meaning of the word has no connection to the goods and services and is not in common parlance it is memorable to the average consumer and highly distinctive"

80. Janus submits as follows:

> "Party A submits that although the Earlier Trade Mark was considered to have the required level of distinctive character to be granted trade mark protection at the time of filing, it should be noted that UK00911154713 is actually a cloned EU registration and as such may not have been accepted by the UK office".

81. I will firstly deal with Janus' submission, above. The opponent's mark exists on the UK trade mark register and is, therefore, a validly registered trade mark. I remind myself of the case of *Formula One Licensing BV v OHIM*[21] in which it is stated that a registered trade mark must be assumed to have "at least some distinctive character" and I must assess its distinctiveness in the ordinary way.

82. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent did not specifically plead that its mark enjoys an enhanced degree of distinctive character as a result of the use made of it (albeit I note that it has pleaded that the mark is inherently distinctive to a high degree), however, it has filed evidence

[21] Case C-196/11P

of use. The issue as to enhanced distinctive character is based on the UK average consumer and the evidence before me in respect of the UK market is very limited, as discussed above. Therefore, I do not consider that the evidence filed could be said to enhance the distinctive character of the opponent's mark. As a result, I have only the inherent position to consider.

83. As above, whilst both the parties have made submissions that JANUS is a Roman God, I have found that a significant proportion of consumers would not attribute this meaning to the word, and would find the word to be made-up, or from a foreign language. As the average consumer will not attribute a meaning to the word, it is not allusive or descriptive of the goods at issue, and therefore, I find it to be inherently distinctive to a high degree.

LIKELIHOOD OF CONFUSION

84. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade marks, the average consumer for the goods 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.

85. I remind myself that I made the following findings:

- That the goods at issue range from being identical to similar to a low degree;

- I have identified that the average consumer will be a member of the general public and professionals who will select the goods primarily by visual means, although I do not discount an aural component;

- I have concluded that the general public will pay a medium degree of attention. The professional consumer will pay a higher degree of attention (although not the highest).

- The contested mark is visually similar to the earlier mark to a high degree;

- The marks are aurally identical;

- I have found the contested mark and the earlier mark to be conceptually neutral;

- I have found the earlier mark overall to be inherently distinctive to a high degree.

86. I begin by considering a likelihood of direct confusion. The competing marks share the word JANUS; however, the BKS mark also includes decorative elements, including a red dot over the 'j' and a black line above and below the word (not including the 'j'). In this instance, I find JANUS to be the dominant and distinctive element of the BKS mark, as the additional elements are decorative and play only a weak role in the overall impression of the mark. As both marks share the word, JANUS, this gives rise to a high level of visual and aural similarity, even when considering the simple stylisation of the BKS mark. I have found the marks to be conceptually neutral, however, regardless of the meaning of JANUS, the average consumer will not be able to recall which mark belongs to Janus and which belongs to BKS. Taking all the above into account and bearing in mind the principle of imperfect recollection and that the marks will not be considered side by side, I consider that there exists a likelihood of direct confusion for all goods for which I have found identity/similarity, and notwithstanding a high level of attention paid for those goods that would only be purchased by professionals.

87. For completeness, I will move on to consider whether there is indirect confusion. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

88. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal[22]. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark; this is mere association not indirect confusion[23]. The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a "proper basis" for finding indirect confusion[24].

89. In the event that the average consumer notices the differences between the marks at issue and uses them to accurately recall which mark was which, I am of the view that they will consider them to originate from the same or economically linked undertakings. Upon considering the stylisation of the earlier marks, the average consumer will go through the mental process outlined in *L.A Sugar*. I have found that the figurative element of the BKS mark will be seen as decorative. In this instance I consider that the average consumer is likely to find the figurative BKS mark and the Janus mark to be different versions of the same mark, i.e. one used on packaging or advertising for example, as opposed to the word only version which might be seen as one used in text or in publications, with both marks belonging to the same owner. Therefore, if the average consumer recognises that the marks are different, there is a likelihood of indirect confusion.

90. As the opposition has been wholly successful under section 5(2)(b), there is no need to go consider the grounds 5(1) and 5(2)(a).

FINAL OUTCOME

Revocation proceedings

91. With effect from **30 May 2023**, UKTM no. 911154713 is partially revoked for the following goods/services:

Class 6 Key blanks of metal.

[22] *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207
[23] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17
[24] *Liverpool Gin Distillery*

Class 7 Electric motor drives for locks.

Class 9 Electric and electronic locks; Electric and electronic locking systems and multi-point locks, each consisting of electric and electronic locks; Electric and Electronic lock cylinders; Transponders for actuating electric and Electronic locks, Locking systems and multi-point locks; Electronic keys having an inbuilt transponder of the aforesaid kind; Electronic apparatus for controlling access to buildings; Electronic surveillance apparatus and electronic control apparatus for window and door locks; Chip cards and magnetic cards for actuating electronic control apparatus for window and door locks.

Class 20 Non-electric and non-electronic locks of plastic (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), consisting of non-electric and non-electronic locks of plastic; Keys and Lock cylinders of plastics; Key blanks of plastic.

Class 42 Consultancy relating to and calculation of locking systems, door locking systems, door control systems, locks, lock cylinders, panic/anti-panic locks, code locks and door drive units.

Class 45 Consultancy in the field of security, in particular for buildings; Safety inspection of factories.

UKTM no. 911154713 shall remain registered for the following terms:

Class 6 Non-electric and non-electronic locks of metal (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), each consisting of non-electric and non-electronic locks of metal; Keys and Lock cylinders of metal;

Opposition proceedings

92. The opposition succeeds under section 5(2)(b). Therefore, subject to any successful appeal, the application will be refused registration.

COSTS

93. Both parties have achieved a degree of success, and I therefore find that each party should bear its own costs.

Dated this 14th day of April 2026

LA Bailey

For the Registrar

Annex 1

Class 6 Non-electric and non-electronic locks of metal (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), each consisting of non-electric and non-electronic locks of metal; Keys and Lock cylinders of metal; key blanks of metal.

Class 7 Electric motor drives for locks.

Class 9 Electric and electronic locks; Electric and electronic locking systems and multi-point locks, each consisting of electric and electronic locks; Electric and Electronic lock cylinders; Transponders for actuating electric and Electronic locks, Locking systems and multi-point locks; Electronic keys having an inbuilt transponder of the aforesaid kind; Electronic apparatus for controlling access to buildings; Electronic surveillance apparatus and electronic control apparatus for window and door locks; Chip cards and magnetic cards for actuating electronic control apparatus for window and door locks.

Class 20 Non-electric and non-electronic locks of plastic (not for vehicles); Locking systems (not for vehicles) and multi-point locks (not for vehicles), consisting of non-electric and non-electronic locks of plastic; Keys and Lock cylinders of plastics; Key blanks of plastic.

Class 42 Consultancy relating to and calculation of locking systems, door locking systems, door control systems, locks, lock cylinders, panic/anti-panic locks, code locks and door drive units.

Class 45 Consultancy in the field of security, in particular for buildings; Safety inspection of factories.