

O/0833/23

CONSOLIDATED PROCEEDINGS

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS. UK00003582450,
UK00003580681 & UK00003679741
BY JANUS INTERNATIONAL GROUP LLC
TO REGISTER:**



AND

JANUS

AND



AS TRADE MARKS IN CLASSES 6, 9 & 37

AND

**IN THE MATTER OF THE OPPOSITIONS THERETO
UNDER NOS. 424414, 424432 & 429766 BY
BKS GMBH**

BACKGROUND AND PLEADINGS

1. These consolidated proceedings relate to the following trade marks that have been applied for by Janus International Group LLC (“the applicant”):

No:	Reg. no:	Trade mark:	Filing date:	Publ. date:
1.	3582450		21.01.2021	12.03.2021
2.	3580681	JANUS	18.01.2021	12.03.2021
3.	3679741		10.08.2021	01.10.2021

2. The applicant seeks to register the above marks for an identical set of goods and services, namely:

Class 6: Metal doors; doors made principally of metal; rolling doors made of metal; metal door frames; metal door panels; metal door trim; metal hinges; metal tensioners; metal door closers; latches and locks; metal drums; metal springs; metal door stops; metal hoists and metal tension adjusters; metal commercial overhead roll-up doors and roll-up door components therefor; metal storage tanks; metal modular building units; storage containers made of metal; parts and fittings of the aforesaid.

Class 9: Electric door opening and door closing mechanisms; electric locks; parts and fittings for all the aforesaid goods.

Class 37: Installation, repair and maintenance for manual and automatic doors; installation, repair and maintenance of storage units; information and advisory services relating to the aforesaid.

3. For the remainder of this decision, I will refer to the above marks by their corresponding number in the table provided i.e. the applicant's first, second and third marks.
4. On 12 May 2021, the applicant's first and second marks were opposed by BKS GmbH ("the opponent"). The opponent also sought to oppose the applicant's third mark on 30 December 2021. While all three oppositions are based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), I note that the opposition against the applicant's second mark is also based on sections 5(1) and 5(2)(a) of the Act.
5. In respect of all oppositions, the opponent relies on the following marks:



UK registration no: 91154713¹

Filing date 31 August 2012; registration date 28 January 2013

Relying on all goods and services, namely:

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

¹ The opponent's mark is a comparable trade mark based on a pre-existing EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs.

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.

("the opponent's first mark"); and

janus

International registration number: 661739

International registration date 17 May 1996; Date protection granted in the UK 24 October 1997

Priority date 7 December 1995

Relying on all goods, namely:

Class 6: Keys, non-electrical metal closure systems essentially composed of cylindrical locks and keys.

Class 7: Closing cylinders.

("the opponent's second mark")

6. The opponent's case in respect of the oppositions aimed at the first and third marks is that the marks are similar. However, in respect of the opposition aimed at the second mark, the opponent's case is that the marks are identical but, if not, they are similar. In respect of the goods and services at issue, the opponent claims is that they are identical and/or similar. In all circumstances, the opponent argues that there exists a likelihood of confusion including a likelihood of association.
7. The applicant filed counterstatements wherein it denied the claims against it and requested that the opponent provide proof of use for its marks.
8. On 25 September 2022, 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.
9. The opponent is represented by Withers & Rogers LLP and the applicant is represented by Walker Morris LLP. Both parties filed evidence. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
10. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

11. During the evidence rounds, the opponent filed three separate witness statements in support of its opposition. The first was the witness statement of Mr Robert Rossall dated 24 November 2022. Mr Rossall is the managing director of G-U, a position that he has held since 2015. His evidence sets out that G-U is the UK affiliate of the opponent. Mr Rossall's statement is accompanied by two exhibits,

being those labelled RR1 and RR2. The second was the witness statement of Mr Lutz Lueke dated 13 December 2022. Mr Lueke has been the sales director of the opponent since 2021, prior to which he was the sales manager between 2016 and 2020. Mr Lueke's statement is accompanied by three exhibits, being those labelled LL1 to LL3. Given that Mr Lueke's evidence includes evidence in a foreign language, the opponent also filed the witness statement of Mr Scott Gareth Tatchell dated 11 January 2023. 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.

12. The applicant filed evidence in the form of the witness statement of Ms Sarah Williams dated 13 March 2023. Ms Williams 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. Ms Williams' statement is accompanied by six exhibits, being those labelled SW1 to SW6.

13. I do not intend to summarise the evidence or submissions of the parties at this stage but will, where appropriate, discuss them further below.

PRELIMINARY ISSUES

Evidence of actual confusion

14. The applicant has filed evidence that it claims to support an argument that the marks have been co-existing in the market place since 2002. It claims that the applicant has significant sales and if it was the case that there was a likelihood of confusion, the opponent would have been able to provide evidence of such. While I will discuss the position regarding peaceful co-existence at the conclusion of this decision (at paragraphs 95 to 97), I wish to address the latter point here. Evidence of actual confusion is not a requirement for the existence of a likelihood of confusion. While I appreciate that such evidence may be of assistance, the

opponent failing to file evidence of actual confusion has no bearing on the notional assessment that I must make in respect of a likelihood of confusion.

State of the register

15. In its submissions, the applicant argues that there are over 40 'live' trade marks registered for or including the word 'JANUS'. Aside from a broad claim that the state of the register is relevant, no express reason has been provided as to why that is the case. On this point, I note that it is common in proceedings before this Tribunal that this type of argument is raised in support of a case that the distinctive character of the opponent's mark has been diminished by the widespread existence of other marks that include the same word. If that is the case here, it is of no relevance. On this point, I refer to the case of *In Zero Industry Srl v OHIM*, Case T-400/06, wherein the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II-4865, paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71)."

16. Firstly, I note that this point was raised in written submissions and no evidence has been submitted of the existence of these marks on the UK trade mark register. Even if it had, there is no evidence before me to the existence of any of the 40 marks on the marketplace. Without such, such a claim has no bearing on the

assessment that I must make and I will say no more about it. In the event that this argument was raised by the applicant to support an alternative claim, I note that I have nothing before me to suggest what that argument is. If this was the case then it was for the applicant to expressly raise the same.

The applicant's submissions

17. As above, the applicant has filed submissions. It is noted that some of these submissions seek to introduce evidence of fact into these proceedings.² On this point, I note that the applicant has filed evidence of online searches that it claims to show that the opponent's use of its mark is in conjunction with the branding 'BKS' (which I note is the name of the opponent). It appears to me that such an argument may be used in support of a claim that the opponent has not used its mark as registered. Such an argument is of no assistance,³ however, the attempt to file evidence of such at such a late stage (and outside of the evidential rounds) is not appropriate without first having requested permission to do so. No such request was forthcoming and while these submissions are now before me in these proceedings, I will consider them only insofar as they consist of submissions. Where the submissions refer to any evidence of fact, they will be disregarded.

The opponent's submissions

18. Further to the comments in the preceding paragraph, I note that the opponent also filed submissions that sought to include evidence in the form of a Wikipedia print-out. As was the case with the applicant's submissions above, I will only give due consideration to the opponent's submissions insofar as they cover submissions and not evidence of fact.

² See, for example, paragraph 15 wherein the applicant referred to dictionary evidence.

³ See the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12 wherein it was found that use of a mark generally encompasses both its independent use and its use as part of another composite mark, which would, in my view, be the case here.

DECISION

Proof of use

19. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

20. The relevant statutory provisions are as follows:

“Section 6A

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),

(b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) 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

(b) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

21. As the opponent’s first mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) 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 section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

22. Section 100 of the Act is also relevant, which reads:

“100. 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.”

23. Given their filing dates, the opponent’s marks qualify as earlier trade marks under the above provisions. Further, both marks have completed their registration processes over five years prior to the filing dates of the applicant’s marks. Therefore, the opponent’s marks are subject to the proof of use assessment. As set out above, the applicant requested that the opponent provide proof of use in respect of the same. As a result, the opponent’s marks are subject to the proof of use assessment in respect of the goods and services relied upon.

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), 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 Bunderversammlung 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], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG*

[EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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].”

25. As the opponent's first mark is a comparable mark based upon an earlier EUTM, use of that mark in the EU prior to IP Completion Day (being 31 December 2020)

is relevant to the present assessment.⁴ On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

26. In respect of the opponent’s second mark, this is an international registration that designates the UK. As a result, the relevant territory for this mark is the UK only. The relevant periods for the proof of use assessment will differ for each opposition. For the opposition against the first mark, the relevant period is 22 January 2016 to 21 January 2021. For the opposition against the second mark, the relevant period is 19 January 2016 to 18 January 2021. Lastly, for the opposition against the third mark, the relevant period is 11 August 2016 to 10 August 2021. While each period

⁴ See paragraph 4 of Tribunal Practice Notice 2/2020

is different, they overlap significantly and I am of the view that is the use provided is sufficient to prove use for one period, it will be sufficient for all others.

27. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”⁵ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

Form of the marks

28. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under section 46(2) of the Act.⁶ He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hyphen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative

⁵ *Jumpman* BL O/222/16

⁶ Although it applies equally to proof of use assessments in respect of the form of the mark at issue.

elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

29. In its written submissions, under the section discussing the distinctive character of the opponent’s marks, the applicant raises arguments in respect of the form of the mark as shown in the opponent’s evidence. The applicant’s argument is that the way in which the opponent has used its marks is not use of acceptable variants of the same. The arguments refer to a decision of the UK IPO wherein the Hearing Officer considered various composite marks containing the word ‘NORTHERN’. The reference given to this decision was opposition number 98908⁷ and is not in a format that I recognise (such as BL O/999/23, for example). Having searched the

⁷ See paragraph 23 of the applicant’s written submissions in lieu of a hearing

UK IPO and trade mark decisions database, I am unable to trace the decision referred to. In any event, decisions of UK IPO Hearing Officers are not binding on me.

30. Having considered the evidence, I fail to see what the applicant is driving at in raising the argument that the form of the mark used is not acceptable. I note that not all examples of use shown are in the form of the marks as registered such as, for example, invoices showing the marks presented in a word only format and brochure and website evidence showing the mark presented in the same form as the opponent's second mark and not the first mark and vice versa. However, just because the marks are not presented as registered, that does not mean that they cannot be acceptable variants of the same (as per the case law cited above).

31. In considering the distinctive character of both marks, they are clearly dominated by the word 'JANUS' with the device elements in the first mark having very limited impact on the distinctive character of that mark. None of the uses shown in the evidence can be said to alter the distinctive character of either mark and I, therefore, accept them as being valid variants of the same. On this point, I remind myself of the case of *Hyphen GmbH v EU IPO*, Case T-146/15, wherein the GC set out that the addition of a border element did not alter the distinctive character of the mark as registered and, conversely, I am of the view that the removal of the same would not alter the distinctive character either (in the case of the horizontal lines being removed from the opponent's first mark, for example).

Sufficient use

32. I have set out above that the opponent's evidence came in the form of witness statements from Mr Rossall and Mr Lueke. Upon review of this evidence, Mr Rossall's statement covers the opponent's use in the UK whereas Mr Lueke's covers use in Germany. Given that the opponent's second mark requires proof of use in the UK only, only Mr Rossall's evidence can be said to be relevant to that mark. As for the opponent's first mark, use of the same in the UK and the EU (prior to 31 December 2020 only) is relevant. As a result, I consider it necessary to break

my assessment up into two parts, the first being whether there is use in the UK and the second being whether there is use in the EU.

Use of the opponent's second mark in the UK

33. Firstly, I note that the evidence in respect of the UK comes from Mr Rossall of G-U. As set out above, G-U is a UK affiliate of the opponent and, as such, I consider that any use by G-U is with the consent of the opponent thereby satisfying the requirements sets out at section 6A(3)(a) of the Act (cited above). The evidence from Mr Rossall sets out that G-U has been promoting and selling locking mechanisms bearing the opponent's marks since 1996.⁸ The narrative evidence sets out that the opponent enjoys commercial success in the UK in respect of these sales. While noted, the total annual wholesale figures put forward by Mr Rossall are severely limited. Since 2017, Mr Rossall sets out that the annual wholesale figures relating to sales of goods bearing the opponent's marks are as follows:

Year:	Total (£):
2017	3,734.10
2018	-
2019	140.00
2020	296.96

34. This represents £4,171.06 in total sales during the relevant period in the UK. In support of the total sales, Mr Rossall has provided invoices covering sales of the products to customers in the UK.⁹ I note that of the 12 pages of invoices provided, there are only five separate customers.

35. In addition, Mr Rossall has provided print-outs from the G-U website that he claims to show use of the earlier marks of the opponent. In total, there are 229 pages

⁸ I note that there is no reference to the provision of services in his narrative evidence and I note that the print-out evidence provided at RR2 cover over 200 pages of documentation and I am of the view that if it was the case that such evidence pointed directly the provision to the opponent's class 37 services, the narrative evidence should have guided me directly to it.

⁹ RR1

worth of print-outs and I note that while the opponent's goods are shown throughout, there is limited reference to 'JANUS' branded products. For example, I note that the only products that are shown bearing these marks includes locking mechanisms that are referred to as double cylinder locks, half cylinder locks, cylinder with thumb turn locks, padlocks, cabinet locks, cylinder cam locks.¹⁰ I note that there are locks under the 'JANUS' description of goods but I note that the keys show only a BKS logo and seemingly make no reference to the 'JANUS' branding.¹¹ In addition to the references to 'JANUS', there are various references to other brands under the opponent's range of products, including Livius, Helius, DetectE and PZ 88. None of these marks are at issue so this evidence is of no relevance here. In considering these print-outs, outside of demonstrating precisely what goods the opponent's sells, I fail to see how it provides any further assistance beyond the turnover figures provided.

36. I note that there is no evidence in respect of market share held by the opponent, the amount spent on marketing the mark or examples of any advertising undertaken in the UK. As such, the only evidence I have upon which to pin a finding of genuine use is the turnover figures. Put simply, the turnover for the UK over a five year period is vanishingly small, with the largest annual turnover coming in 2017, being towards the beginning of the relevant period. This is followed by just £436.96 over the succeeding three years. I note that the witness does state that the opponent's goods did enjoy a level of commercial success but the evidence does not support such a statement. Without anything further, I am not willing to accept that the evidence reflects an objective level of commercial success. On the point of the low level of use, I remind myself that use does not need to be quantitatively significant for it to be considered genuine. However, the evidence before me is far from sufficient and without anything further in support of use of the mark, I am of the view that, on the basis of the turnover alone, the opponent has failed to demonstrate that it has genuinely used its second mark in the UK. As a result, I find that the evidence from Mr Rossall is of no assistance meaning that the opponent's reliance upon its second mark must fail.

¹⁰ See page 6 of RR2

¹¹ See page 19 of RR2

Use of the opponent's first mark in the relevant territories.

37. Mr Lueke's evidence sets out that the products sold by the opponent include keys and lock cylinders of metal. He also confirms that these bear the trade mark 'JANUS' and he also specifically refers to use of the opponent's first mark as it is registered. In respect of use in Germany, Mr Lueke confirms that the opponent has continued to use its mark since at least 2012 and, in respect of the period between January 2016 and January 2020, he confirms that the wholesale figures for the sale of products under the earlier marks are as follows:

Year	Total (£)
2016	4,783,000
2017	5,125,000
2018	4,670,000
2019	4,740,500
2020 (January only)	411,300

38. The above figures cover total sales of £19,729,800 during the relevant period. Sample invoices have been provided in support of the same¹² and I note that a sample translation of just one invoice is provided.¹³ Being the only invoice that I am able to consider (as it is the only one before me in the English language), I note that it only covers sales of lock cylinders and one key. Having said that, even without the translations, it is clear that they cover sales of goods bearing the 'JANUS' brand in Germany.

39. Mr Lueke's statement also includes product brochures that he states were distributed in Germany in 2016 and in 2019 for products bearing the opponent's marks.¹⁴ These are in the German language. Having reviewed the translations of the same,¹⁵ I note that they only cover 'JANUS locking cylinders' and what is

¹² LL1

¹³ SGT1

¹⁴ LL2

¹⁵ SGT2

referred to as a reversible key system which, to me, appears as if it is a type of lock cylinder. There are also a range of keys shown, being the 'JANUS' 43, 45 and 46 keys.¹⁶ While Mr Lueke claims that these brochures were distributed in 2016 and 2019, I have nothing to suggest how many copies were issued. That being said, based on the level of sales referred to above, I am willing to infer that the brochures did enjoy a reasonable level of distribution across Germany.

40. Lastly, there is evidence of advertising campaigns that were run during the 2016 European Football Championship and the 2018 Football World Cup.¹⁷ Mr Lueke states that these are advertising flyers but it is not stated how many flyers were distributed or how widely they were distributed. Having said that, the evidence still demonstrates that the opponent sought to make an attempt to advertise its goods under the marks at issue during the relevant period.

41. In considering the evidence as a whole, I note that I have no evidence as to the size of the market for the opponent's goods in the EU. Without such, I am of the view that, given the size of the territory, the relevant market for the opponent's goods is a sizable one with annual turnover in excess of billions of pounds per annum. So while the turnover of the opponent may be sizable, it is still low in relation to the relevant market at issue. Having said that, and as mentioned above, use does not need to be quantitatively significant in order for it to be deemed genuine. While I have little evidence beyond the turnover figures provided, I am of the view that a wholesale turnover in excess of £14 million over a period of five years in Germany is sufficient to warrant a finding that the opponent has genuinely used its first mark. I make this point particularly on the basis that, as far as I understand it, lock cylinders and keys are not particularly expensive and, as such, over £14 million worth of sales over five years reflects a suitable amount of sales.

42. On the point of the opponent's use, I note that it covers Germany only, being just one territory within the EU (albeit a large one).¹⁸ In considering this point, I remind

¹⁶ Page 12 of SGT2

¹⁷ See LL3 and its translation at SGT3

¹⁸ I note that the applicant's submissions, at paragraph 26 set out that the evidence relates only one a single EU territory and, as such, would not be deemed to be evidence of genuine use.

myself that, as per *Leno Marken* (cited above), use of a mark in one jurisdiction within the EU can constitute use of that mark across the entire territory. As a result, just because the mark has only been used in Germany does not mean that there cannot be genuine use of the same.

43. While I have found there to be genuine use for the opponent's first mark only, the issue I must now consider is the fair specification of the same. In light of the evidence before me, I do not consider it necessary to conduct a full assessment in respect of this point. Instead, I am of the view that the evidence before me is only sufficient to demonstrate genuine use of metal keys and metal lock cylinders. I note that the opponent's specification includes the term "keys and lock cylinders of metal" and I consider that the evidence before me is suitable to demonstrate genuine use of the same.

44. On the point of a fair specification, I note that the narrative evidence only refers to the sale of products and makes no mention of the provision of any installation services under the 'JANUS' branding. If it was the case that the opponent did offer such a service, I consider it appropriate for the opponent to have directly referred me to evidence of such.

45. To confirm, this opposition may only proceed in respect of the term "keys and lock cylinders of metal" and it is not permitted to rely on any of the remaining goods or services in its specification.

My approach

46. Given that the opponent's reliance upon its second mark fails, I wish to confirm that, for the avoidance of doubt, I will proceed with the remainder of this decision by referring to the 'opponent's first mark' as just 'the opponent's mark'.

47. As I have set out above, the opposition aimed at the applicant's second mark not only relies upon section 5(2)(b) of the Act, but also 5(1) and 5(2)(a). For the purpose of this decision, I will proceed with considering the 5(2)(b) grounds of all

oppositions first and, if necessary, will consider the 5(1) and 5(2)(b) oppositions against the applicant's second mark further below.

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

48. Section 5(2)(b) of the Act reads as follows:

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

(a) ...

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

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

49. Section 5A of the Act states as follows:

“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.”

50. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P 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

51. As the applicant’s specifications across its three marks are identical, I will refer to them in the singular. The competing goods and services of the parties are as follows:

The opponent’s goods	The applicant’s goods and services
<p><u>Class 6</u> Keys and Lock cylinders of metal</p>	<p><u>Class 6</u> Metal doors; doors made principally of metal; rolling doors made of metal; metal door frames; metal door panels; metal door trim; metal hinges; metal tensioners; metal door closers; latches and locks; metal drums; metal springs; metal door stops; metal hoists and metal tension adjusters; metal commercial overhead roll-up doors and roll-up door components therefor; metal storage tanks; metal modular</p>

	<p>building units; storage containers made of metal; parts and fittings of the aforesaid.</p> <p><u>Class 9</u> Electric door opening and door closing mechanisms; electric locks; parts and fittings for all the aforesaid goods.</p> <p><u>Class 37</u> Installation, repair and maintenance for manual and automatic doors; installation, repair and maintenance of storage units; information and advisory services relating to the aforesaid.</p>
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52. When making the comparison assessing the similarity of the goods and services, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“[...] 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”.

53. 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.

54. The applicant has denied that the goods and services of the parties are identical or similar. On this point, I note that the applicant's submissions set out that the opponent has not provided any evidence to show that the goods at issue are identical or similar. While evidence can be of assistance in pointing to goods or services being identical or similar, it is not fatal to a claim of identity/similarity if none is provided. The goods and services comparison I must make is a notional assessment based on the factors set out in the case law cited above. Therefore, the applicant's claim that the opponent failing to prove its claim of identity or similarity is of no relevance.

55. As for the opponent, I note that it has filed submissions in respect of the identity and/or similarity of the goods and services at issue. It is noted that some of the goods and services mentioned in these submissions did not survive the proof of use assessment above so those submissions are of no relevance here. While I do not intend to reproduce the opponent's submissions here, I can confirm, for the avoidance of doubt, that I have taken them into account in making the following assessment.

56. As per section 60A of the Act, goods and services are not to be regarded as being similar just because they fall in the same class. Conversely, section 60A also states

that goods and services are not to be found dissimilar from each other on the ground that they appear in different classes. So while the parties' marks include goods registered in class 6 and also goods/services across different classes, this does not mean that those goods/services are automatically similar/dissimilar.

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.

57. The opponent's goods, being "keys and lock cylinders of metal" can reasonably be said to be goods that form the part of a door. The above goods of the applicant are all types of doors. On this point, I remind myself that just because the opponent's goods are components of the applicant's goods, this is not sufficient by itself to find that these goods are similar.¹⁹ In considering the *Treat* factors, I am of the view that these goods can be said to overlap in user on the basis that someone looking to install one of the applicant's doors is also likely to buy a key and lock cylinder of metal for said door. Having said that, the nature, methods of use and purposes of the goods are plainly different. As for trade channels, it is my understanding that the provider of a door is different from the provider of the lock mechanism used on that door. On this point, I note that I have nothing before me by way of evidence to suggest that it is common in the trade for an undertaking that produces various types of metal doors to also produce the lock used within it. I consider it reasonable to expect that, if it was the case that this practice was common in the trade, evidence of such should have been provided. Without it, I am not willing to conclude as such. Having said that, it may be the case that the distribution channels overlap on the basis that the goods are all likely to be sold via the same retailers. The goods are clearly not competitive; however, I do consider that there is some degree of complimentary between them.²⁰ This is on the basis that that the metal doors

¹⁹ *Les Éditions Albert René v OHIM*, Case T-336/03

²⁰ Based on the test set out in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-325/06

covered by the applicant's goods are likely to be the type of doors that are locked.²¹ As such, a locking cylinder and key are important and/or indispensable to those doors. While I have found no overlap in trade channels, I am of the view that when the metal door is installed with a lock, the end consumer will believe that those goods are from the same undertakings. While that belief may not necessarily be correct, the end consumer will still believe them to be complimentary as they are unlikely to consider the components any further beyond that initial impression. Taking all of the above into account, I am of the view that the goods are similar to a low degree.

Metal door frames; metal door panels; metal door trim.

58. While I appreciate that these goods are component parts for doors, I see no reason why they would be similar to any degree with the opponent's goods. I appreciate that there may be some overlap in user, however, none of the other factors can be said to overlap and neither are the goods competitive or complimentary in nature on the basis that I do not consider that the average consumer would believe that the goods derive from the same undertaking (I appreciate that this is in contrast with what I have said above, however, these goods are different in nature from the completed door type goods assessed above). As such, I consider that these goods are dissimilar.

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

59. The above goods, like the opponent's, can all be said to be component parts of a door. As such, I consider that there is some degree of overlap in nature between the above goods and the opponent's. Further, I consider that, for the same reasons set out in paragraph 57 above, these goods are likely to overlap in user. As for trade channels, I see no reason why the same undertaking would produce all of these goods but I appreciate that the goods are likely to be sold via the same

²¹ On this point, I note that metal doors are commonly external doors or industrial doors used in factories (for example) that require locking. This is opposed to, say, a wooden door that may not necessarily be locked meaning that the important/indispensable relationship may not exist. However, that discussion is not relevant here.

distributor and will likely be found on the same shelves or in the same aisles as each other. I do not consider that these goods overlap in method of use or purpose and neither are the competitive or complimentary. Taking all of this into account, I am of the view that these goods are similar to between a low and medium degree.

Latches and locks.

60. If the above goods are not identical to the opponents' goods on the basis that they cover locking cylinders,²² then I find that they are similar to a high degree. This is on the basis that they overlap in nature, methods of use, purpose, user and trade channels.

Metal drums; metal springs; metal hoists and metal tension adjusters; metal storage tanks; metal modular building units; storage containers made of metal.

61. While the above goods are made of metal, I see no obvious reason as to why there would be any degree of similarity between these goods and those of the opponent. As a result, I consider that these goods are dissimilar.

Parts and fittings of the aforesaid.

62. I have found some of the above goods to be identical and/or similar and I am of the view that a similar finding (or a more advantageous one, for that matter) will apply to the parts and fittings of the same. For example, I note that I have found metal doors to be low in similarity with the opponent's goods, however, the opponent's goods are parts and fittings for doors so can realistically be said to be identical to the applicant's above term (insofar as it relates to doors). For the avoidance of doubt, where I have found goods to be dissimilar, the same outcome applies in respect of the parts and fittings in respect of the same.

²² See *Gérard Meric v Office for Harmonisation in the Internal Market* which sets out that if goods fall into the broader category of another set of goods, they are considered identical

Class 9

Electric door opening and door closing mechanisms; parts and fittings for all the aforesaid goods.

The above goods relate to the opening and closing mechanisms used to control doors. While the above term relates to doors and the same can be said to the opponent's goods, I consider that this is where the similarity ends. I see no obvious reason as to why the natures, method of use, purposes or trade channels would overlap. I appreciate that there may be some overlap in user but this alone is not sufficient to warrant a finding of similarity. As a result, I consider that these goods are dissimilar.

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

63. Given that the above goods cover locks, I am of the view that they are similar to the opponent's goods. While a metal lock cylinder is not an electric lock, it does have a similar nature, method of use and purpose. While the users may not directly overlap, I am of the view that the goods are competitive as someone looking for a lock may elect to choose an electronic one or a metal lock cylinder. As a result, I consider that these goods are similar to a high degree.

Class 37

Installation, repair and maintenance for manual and automatic doors; information and advisory services relating to the aforesaid.

64. The above services clearly do not overlap in nature, method of use or purpose with the above goods. Further, the goods and services are not competitive and neither are they complimentary. As for user, I appreciate that someone looking for the above installation services may also wish to install a lock cylinder on the door. As such, I consider that there is an overlap in user between these goods and services. While I appreciate that an undertaking that installs, repairs and maintains a door is also likely to install the lock cylinder for said door, I am not convinced that they

would produce them and that is the consideration relevant here. As such, I fail to see that these services overlap in trade channels with the opponent's goods. Taking all of the above into account, these goods and services are dissimilar.

Installation, repair and maintenance of storage units; information and advisory services relating to the aforesaid.

65. I have found in the preceding paragraph that the opponent's goods are dissimilar to the installation, repair and maintenance of doors. The above services of the applicant are even further removed from the opponent's goods than those services previously considered. Therefore, it follows that the above goods are also dissimilar to the above services.

66. As some degree of similarity between goods and services is necessary to engage the test for likelihood of confusion, this means that the opposition aimed against those goods or services will fail.²³ Given my findings above, the oppositions against some of the goods and services fails at this stage. For the avoidance of doubt, those goods for which the oppositions may proceed are set out as follows:²⁴

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.

²³ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

²⁴ The construction of these terms is set out whilst bearing in mind the comments I have made at paragraph 50 above.

The average consumer and the nature of the purchasing act

67. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

68. It is my view that the goods at issue are, for the most part, likely to be selected by users in the trade who will install them on behalf of the end consumer. Having said that, I consider that there is a specific sub-set of the general public such as DIY enthusiasts who will look to buy the goods at issue and install them themselves. I am of the view that the goods at issue will be available via specialist retailers or large DIY retailers where the goods will be displayed on shelves and self-selected by the consumer. The goods may also be selected via those retailers' websites and the selection process will follow a similar pattern in that they will be selected after viewing an image of the goods online. As a result, I consider that the selection process of the goods at issue will be dominated by the visual component. Having said that, I do not discount the aural component such as word of mouth recommendations or advice from sales assistants.

69. The price of the goods at issue is likely to vary from relatively inexpensive goods such as keys, to goods such as electronic locks which, while more expensive, will not

be considerably so. The goods are likely to be purchased relatively frequently by members of the trade but for members of the general public, it will be less frequent. Regardless of who the average consumer is, I am of the view the same factors are likely to be considered during the purchasing process and this may include factors such as security of the lock and ease of installation. The applicant submits that the average consumer will pay a higher than medium degree but I do not consider that this will be the case. While I appreciate that the goods may relate to the security of a premises, the factors that will be considered are not particularly involved. With this in mind, I consider that the average consumer will pay a medium degree of attention during the purchasing process.

Comparison of the marks

70. It is clear from *Sabel 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.




71. 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.”

72. 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.

73. The respective trade marks are shown below:

The opponent's mark	The applicant's marks
	<div style="text-align: center;">  <p>("the applicant's first mark")</p> </div> <div style="text-align: center;"> <p>JANUS</p> <p>("the applicant's second mark")</p> </div> <div style="text-align: center;">  <p>("the applicant's third mark")</p> </div>

74. I have submissions from the parties in respect of the comparison of the marks at issue. I have considered these submissions in full and while I do not intend to reproduce these here, I will, if necessary, refer to them below.

Overall Impression

75. The opponent's mark is a figurative mark that consists of a word element, being the word 'janus' which is presented in a fairly standard, grey typeface with the dot above the 'j' being red. In addition, there are horizontal lines above and below the word 'janus' (although these lines do not extend to cover the letter 'j'). The mark is dominated by the word element with the figurative elements having a negligible impact by virtue of being banal line elements.

76. The applicant's first mark is a figurative mark that consists of two word elements, being the word 'JANUS' presented in a large blue standard typeface. This sits above the second word element, being the words 'INTERNATIONAL EUROPE' in the same blue standard typeface but presented much smaller. To the left of the words is an orange square device within which sits a white profile image of a man's head. Given its presence as the largest word element, I find that 'JANUS' will play the greater role in the overall impression of the mark with the device element playing a lesser role. While the words 'INTERNATIONAL EUROPE' will not be overlooked, I am of the view that, for reasons I will come to discuss further below, they have very little impact on the mark as a whole. The applicant's second 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. Save for the omission of the words 'INTERNATIONAL EUROPE', the applicant's third mark is the same as its first mark. Following my comments in relation to that mark, I find that the word 'JANUS' plays the greater role in the overall impression of the mark with the device element playing a lesser role.

Visual Comparison

77. For reasons that will become obvious below, I will begin by comparing the opponent's mark with the applicant's third mark, followed by its first mark and, finally, its second mark.

The applicant's third mark and the opponent's mark

78. Visually, the above marks share the common element of 'JANUS', albeit presented differently across all marks. While the presentation of this element differs, it remains a significant point of similarity by virtue of being the dominant element of both marks. The marks differ further with the presence of a red dot above the letter 'j' and the horizontal lines in the opponent's mark and the orange square head device in both applicant's mark. The figurative elements of the opponent's mark have a negligible impact on the visual comparison; however, the orange head device will have some impact by virtue of its placement at the beginning of the

applicant's mark, being where the average consumer tends to focus.²⁵ Taking all of this into account, and bearing in mind the overall impressions of the marks as wholes, I am of the view that these marks are visually similar to a high degree.

The applicant's first mark and the opponent's mark

79. These marks share the same points of similarity and difference as those discussed in the preceding paragraph. However, one additional point of difference is the addition of the words 'INTERNATIONAL EUROPE' in the applicant's first mark. This is presented in a very small typeface and while it has a limited impact on the mark itself, it still acts as a point of visual difference, albeit, in my view, a slight one. Taking into account the finding made in the preceding paragraph and bearing in mind the additional (albeit limited) point of visual difference, I find that these marks are similar to between a medium and high degree.

The applicant's second mark and the opponent's mark

80. While 'janus' is the dominant element of the opponent's mark, it is the sole element of the applicant's second mark. As a word only mark, the applicant's second mark is capable of being presented in either uppercase, lower case or any customary combination of the same. Further, it is capable of being presented in any standard typeface and in any colour. Given that the typeface used in the opponent's mark is fairly standard, I am of the view that the notional and fair use of the applicant's second mark covers the same typeface as that used by the opponent in its mark (albeit without the red dot above the letter 'j' and the horizontal lines). As such, I consider that these marks are visually similar to a very high degree.

Aural Comparison

81. Before considering the aural comparison, I wish to discuss the presence of the words 'INTERNATIONAL EUROPE' in the applicant's first mark. Given its

²⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

placement and the fact that it is simply a reference to the nature of the undertaking responsible for the mark, I am of the view that it will not be pronounced by the average consumer.²⁶ As a result, all of the applicant's marks will be pronounced as two syllables, being 'JAN-US' or 'YAN-US'. Either way, the way in which consumers pronounce the applicant's marks will be identical to the way in which they pronounce the opponent's mark. Therefore, I consider that all of the marks at issue are aurally identical.

Conceptual Comparison

82. I will first, briefly consider the words 'INTERNATIONAL EUROPE' in the applicant's first mark. These words will simply be understood as a reference to the fact that 'JANUS' is an international European company and, therefore, will be seen purely as an indicator of the nature of the company. Average consumers are, in my view, accustomed to trade marks featuring such indications regarding the nature of the undertakings responsible for them and, therefore, I do not consider that they would attribute any meaningful concept to these words. Instead, the concept of that mark will be dominated by the word 'JANUS', which is also the case for the remaining marks of the applicant. I will, therefore, address the conceptual comparison together.

83. The comparison at issue here is between the identical words 'JANUS'. The applicant's position in respect of this point is that 'JANUS' will be understood as a reference to '*the God of beginnings, gates, and doorways*'²⁷ and, as such, it is a generic and descriptive term in relation to the goods and services at issue. As a result, the applicant submits that this means that the marks are only conceptually similar to a very low degree. While noted, such an argument cannot be sustained. I will come to discuss the perceived concept of 'JANUS' below but, for now, I will state that it cannot follow that if 'JANUS' was understood as having this meaning,²⁸

²⁶ For the avoidance of doubt, I make this finding whilst bearing in mind the case of *Purity Hemp Company Improving Life as Nature Intended*, Case BL O/115/22, wherein Mr Philip Harris, sitting as the Appointed Person, found that descriptiveness of an element does not necessarily make it aurally invisible

²⁷ A similar submission as to the meaning of 'JANUS' is also submitted by the opponent

²⁸ It is noted that the opponent submits that it will be understood as the Roman God, Janus, and, therefore the marks are conceptually identical.

then the parties' shared use of the same would only result in a very low level of conceptual similarity. Regardless of any alleged descriptiveness of this element, the concept attributed to the marks would be the same, resulting in conceptual identity.

84. All of the above being said, I do not consider that a significant proportion of average consumers would understand what is meant by the word 'JANUS'. While I appreciate that some consumers may understand the reference to the Roman God, I do not consider that those consumers would constitute a significant proportion. Instead, I am of the view that 'JANUS' will be seen as either a made-up or foreign language word with no obvious meaning. As for the device in the applicant's first and third marks, I do not consider that any immediately graspable concept will be associated with this either. As such, it will have no real conceptual impact on those marks. Given that I do not consider that any of the marks at issue have an identifiable concept, I do not consider that a conceptual comparison is possible.

Distinctive character of the opponent's mark

85. 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 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been

registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

86. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up 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 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, however, it has filed evidence of use. In proceedings before the Tribunal, it is not necessary for an opponent to specifically plead enhanced distinctiveness at the outset of a matter and, therefore, such an issue may be live regardless of the pleadings. Having said that, the issue as to enhanced distinctive character is based on the UK average consumer and given the very limited evidence in respect of the UK market referred to above, I fail to see how 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. On this point, I note that the opponent submits that its mark is inherently distinctive to a high degree.

87. Before moving to consider the distinctiveness of the opponent’s mark, I wish to address the submissions of the applicant wherein it accepted that the opponent’s mark was considered to have had the required level of distinctiveness to be granted trade mark protection at the time of filing. However, the applicant argues that the opponent’s mark is a cloned EU registration and, as such, may not have been accepted by the UK IPO. While noted, this argument is mere speculation and, in any event, I do not consider that it carries any weight. Put simply, the opponent’s mark exists on the UK trade mark register and is, therefore, to be treated as a

validly registered trade mark and I must assess its distinctiveness on that basis, which is in the ordinary way.²⁹

88. I have set out above that the applicant's position is that the word 'JANUS' is descriptive of the goods at issue on the basis that 'JANUS' is the Roman God of beginnings, gates and doorways. I have found that those consumers who understand such a meaning do not form a significant proportion of average consumers so they are irrelevant for the purposes of this decision.³⁰ Therefore, the word 'JANUS' in the opponent's mark will be perceived as either a made-up or foreign language word with no obvious meaning. It is neither descriptive nor allusive of the goods at issue and, following what I have said in the preceding paragraph, I find that it is inherently distinctive to a high degree.

Likelihood of confusion

89. 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 mark, 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

²⁹ On this point, I remind myself of the case of *In Formula One Licensing BV v OHIM*, Case C-196/11P wherein the CJEU found that a registered trade mark must have at least some distinctive character

³⁰ This is on the basis that in order to satisfy the test for a likelihood of confusion, a significant proportion of consumers must be confused. As this consumer base does not form a significant proportion, it does not assist the position as to confusion. On this point, see paragraph 34 of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41.

trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

90. I have found the parties' goods at issue range from being identical to similar to a low degree. I have found that the average consumer base will consist of both members of the trade and members of the general public who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention during the selection process for the goods at issue. I have found that the opponent's mark is inherently distinctive to a high degree. In respect of the similarity of the marks at issue, I have found that the opponent's mark is visually similar to between a medium and high degree with the applicant's first mark, visually similar to a very high degree with the applicant's second mark and visually similar to a high degree with the applicant's third mark. I have found that all of the marks are aurally identical and I have also found that due to the unknown meaning of 'JANUS', a conceptual comparison cannot be made.

91. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that the common use of the word 'JANUS' will result in the consumer misremembering and/or inaccurately recalling the parties' marks for one another. I appreciate that while there are differences across the marks at issue, this comes in their presentation. On this point, I remind myself that consumers are rarely able to compare marks side by side and, as such, are likely to forget which marks had the device element of an orange head, which included the banal elements 'INTERNATIONAL EUROPE' and which ones did not. Instead, the average consumer will simply seek to remember the marks by recalling the shared dominant and distinctive element, being 'JANUS'. Further, I consider that the stylistic differences between the marks are not particularly striking and, as such, those elements are also likely to be misremembered. While I appreciate that no conceptual comparison could be made, the marks share the identical element of 'JANUS' and, regardless of its meaning, the average consumer will not be able to recall which marks belonged to the applicant and which belonged to the opponent. Consequently, I consider that there exists a likelihood of direct confusion

between the marks at issue. Given the level of similarity across the marks at issue, I am of the view that this finding applies regardless of the level of similarity between the goods.

92. I turn now to consider a likelihood of indirect confusion. I am reminded of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein 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)".

93. 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. This is on the basis that the marks are all dominated by the distinctive word 'JANUS' and I do not consider that the shared use of the same is something that the average consumer would consider to be coincidental use. It is neither descriptive or allusive to the goods at issue and is, instead, high in inherent distinctive character to the point that its use in the applicant's marks would be linked to the same (or economically linked) undertaking as that responsible for the opponent's mark, or vice versa. It is my view that the stylistic differences between the marks are such that they either point to alternative marks used by the same undertakings or will be seen as logical indicators consistent with a re-branding. Even considering the words 'INTERNATIONAL EUROPE' in the applicant's first mark, I am of the view that if this is noticed, it will simply be seen as alluding to the nature of the undertaking responsible in that it is a European company that operates internationally and therefore, is not sufficient to point away from the above conclusions. Consequently, I consider that there is a likelihood of indirect confusion between the marks at issue and, as was the case above, this finding applies to all goods for which I have found there to be a level of similarity.

94. For the avoidance of doubt, if I was wrong to find that the set of consumers that understood 'JANUS' as being a reference to the Roman God did not make up a significant proportion of consumers, then I find that the above conclusions would still have been reached. This is on the basis that the marks would be conceptually identical to one another (as opposed to no conceptual comparison being possible), thereby pointing to an identical conceptual hook across all marks, further pointing

to the existence of confusion. Moreover, even if it could be said that the reference to the Roman God reduced the inherent distinctive character of the opponent's mark, it would not be to the point that the shared use of 'JANUS' would be considered coincidental. As a result, I consider that the findings made throughout the likelihood of confusion assessment would still be applicable regardless of the perceived meaning of 'JANUS'.

Honest Concurrent Use

95. As I have set out above, the applicant's evidence consists of evidence that it claims to support an argument on peaceful co-existence or honest concurrent use of the marks at issue. On this point, I note that the applicant's evidence sets out that:

- a. The applicant is a global market leader in self-storage solutions that has been using the trade mark 'JANUS' in the US since it began trading in 2002;
- b. In 2015, the applicant acquired the business 'Steel Storage', being a company that started trading in the UK in 1990. The supporting evidence sets out that Steel Storage continued to operate as a separate company;³¹
- c. Use of the applicant's mark in the UK has been mostly undertaken by the company Janus International Europe Limited, which is a subsidiary of the applicant;
- d. The evidence sets out that the applicant offers a range of goods and services including, but not limited to, unit partitions, doors, locks and latches, entries systems, mezzanines, external units and the corresponding design, manufacturing and installation services;
- e. Between 2016 and 2021, turnover figures have been provided. These show that Janus International Europe Limited (formerly Steel Storage Limited) generated turnover figures of £13,334,766 in 2016, £15,047,522 in 2017, £15,619,094 in 2018, £25,520,579 in 2019, £22,313,789 in 2020 and £34,439,238 in 2021. This represents a total turnover of £126,274,988 over a six year period. I note that year end Companies House accounts have been

³¹ SW2

provided in support of this evidence.³² The accounts show that the turnover provided in the narrative evidence is made up of three categories, being the UK, the EU and the rest of the world.³³ It appears from this breakdown that the bulk of the turnover provided actually stems from EU use; and

- f. The applicant and its subsidiaries/employees have been nominated for awards in the UK including the Manufacturer MZ and Make UK Award and SocEnv Registrant Newcomer of the Year Award. Details of which are provided.³⁴ I note that the evidence sets out that these awards are from 2022, being after the relevant date. Further, there is nothing to suggest the awareness of these awards amongst the average consumers and how they were voted on (be that publicly voted awards or awards selected by a specialist panel, for example).

96. While I appreciate that the turnover figures provided are significant, I have several issues with them. Firstly, as I have set out above, the bulk of the turnover appears to stem from EU sales and the issue of honest concurrent use is based on co-existence within the UK. Secondly, I note that the supporting evidence of the applicant (being that referred to at point b. above) appears to suggest that, at least for some time, the operations continued under the previous branding, being 'Steel Storage'. It is, therefore, unclear when (or if at all) the use covered by the turnover was under the 'JANUS' branding or under the previous branding. Thirdly, the evidence sets out that the applicant's operations cover, but are not limited to, unit partitions, doors, locks and latches, entries systems, mezzanines, external units and the corresponding design, manufacturing and installation services. This is a broad set of goods/services and given that the goods at issue under the present assessment relate to just a limited set of these goods, it is not possible for me to determine any precise level of sales associated with the relevant goods. I also note that no specific breakdown is provided to assist me in doing so.

97. Taking all of the above into account, I am not convinced that the evidence points to the peaceful co-existence of the marks at issue. My primary finding is that this

³² SW4

³³ See, for example, pages 70, 107 and 144 found at SW4

³⁴SW6

argument fails for these reasons. However, even if I were to consider the evidence in full, it would offer no real support to warrant a finding on peaceful co-existence/honest concurrent use. On this point, I remind myself that the test for proving peaceful co-existence is onerous in that it requires evidence that the competing entities have co-existed honestly on the marketplace for a long period of time.³⁵ Even if it could be said to wholly relate to sales in the UK for the goods at issue (which it cannot), it is not evidence of long standing use. As a result, I find that the applicant's claim to have peacefully co-existed in the UK with the opponent fails. Therefore, the findings made above in respect of the existence of a likelihood of confusion are unaffected.

FINAL REMARKS

98. I set out above that I would return to address the 5(1) and 5(2)(a) grounds at the conclusion of my decision, if necessary. While further consideration is not necessary given the outcome of the 5(2)(b) ground (on the basis that the additional grounds provide no further advantage for the opponent), I do wish to discuss them briefly here.

99. Given that I have found that the applicant's second mark is only very highly similar to the opponent's mark (and not identical), it follows that the 5(1) and 5(2)(a) grounds would have failed. This is on the basis that it is a pre-requisite for the success of those grounds is that the marks be identical. Without such, they are bound to fail. However, in the event that I was wrong to determine the marks to only be very highly similar, I do not consider it controversial to suggest that, in light of my findings in respect of the 5(2)(b) ground, the 5(1) and 5(2)(a) grounds would have succeeded against the applicant's second mark in respect of any identical (for the 5(1) ground only) and/or similar goods.

³⁵ See the case of *Budejovicky Budvar NP v Anheuser-Busch Inc*, Case C-482/09 wherein co-existence involved use of the marks for almost 30 years in the UK.

CONCLUSION

100. The opposition has succeeded in respect of some goods meaning that the applications will, subject to any appeal, be refused registration 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.

101. However, the opposition has failed in respect of some goods and services and the applications will, again, subject to any appeal, proceed to registration for the following goods and services:

Class 6: Metal door frames; metal door panels; metal door trim; metal drums; metal springs; metal hoists and metal tension adjusters; metal storage tanks; metal modular building units; storage containers made of metal; parts and fittings of the aforesaid.

Class 9: Electric door opening and door closing mechanisms; parts and fittings for all the aforesaid goods.

Class 37: Installation, repair and maintenance for manual and automatic doors; installation, repair and maintenance of storage units; information and advisory services relating to the aforesaid.

COSTS

102. While the opposition has succeed in part, I am of the view that, on balance, the parties have enjoyed a roughly equal degree of success. Taking this into account, I do not consider that a costs award is necessary. As a result, I hereby make no order as to costs and instead direct that the parties bear their own costs of these proceedings.

Dated this 1st day of September 2023

A COOPER

For the Registrar