O/1220/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003679741
BY JANUS INTERNATIONAL GROUP LLC
TO REGISTER:

AS A TRADE MARK IN CLASSES 6, 9 AND 37

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 429804
BY GROSVENOR TECHNOLOGY LIMITED

BACKGROUND AND PLEADINGS

1. On 10 August 2021, Janus International Group LLC ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 1 October 2021 in respect of a range of goods and services in classes 6, 9 and 37. Following the outcome of a previous opposition (no. 429766),[1] the applied-for specification stands now as follows:[2]

> **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.*

2. On 4 January 2022, the application was opposed by Grosvenor Technology Limited ("the opponent") based upon Sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). However, the opponent subsequently confirmed that it withdrew its reliance on the grounds of opposition based upon Section 5(4)(a) of the Act;[3] hence, the proceedings have now a single basis, namely Section 5(2)(b) only.

3. The opponent relies on the following trade mark and all of the goods and services covered by the same, as shown below:

[1] See Decision BL-O-833/23
[2] As confirmed in the official letter of 06 November 2023
[3] See the opponent's written submissions in lieu at paragraph 5.

UK00003402046

JANUS C4

Filing date: 24 May 2019

Registration date: 23 April 2021

Class 9: *Access control and security system devices and apparatus; access control and security system hardware; computer software for access control and security systems; readers for access control and security systems; card and token readers; biometric readers.*

Class 37: *Installation of access control and security systems; maintenance and repair of access control and security systems.*

4. The opponent states that the marks are highly similar and that the goods and services are either identical or highly similar leading to a likelihood of confusion.

5. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an "earlier mark" in accordance with Section 6 of the Act. As the opponent's earlier mark had not been registered for five years or more at the filing date of the applied-for mark, it is not subject to proof of use. Consequently, the opponent may rely on all of the goods and services it has identified without demonstrating that it has used the mark.

6. The applicant filed a counterstatement, denying the claims made.

7. The opponent is represented by Reddie & Grose LLP. The applicant is represented by Walker Morris LLP.

8. Only the opponent filed evidence. This consists of a witness statement in the name of Thomas Robson, dated 11 December 2023, with eight exhibits (TR1-TR8). Mr Robson is Trade Mark Attorney employed by the opponent's representatives in these proceedings and his evidence goes to the similarity of the parties' goods and services.

9. No hearing was requested and both parties filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

10. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> > (a)…
> >
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

12. Section 5A of the Act is as follows:

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

13. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case

C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, 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

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

"In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary."

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

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16. In *Gérard Meric v OHIM* Case T- 133/05, the General Court ("GC") stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysterne v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

17. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM,* Case T-325/06, the GC stated that "complementary" means:

"[…] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

18. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different. The purpose of examining whether there is a complementary relationship between goods and services is to assess whether the relevant public are liable to believe that responsibility for the goods and services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander QC noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes."

19. Whilst on the other hand:

> "[…] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

20. The competing goods and services of the parties are as follows:

The applied-for goods and services	The opponent's goods and service
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 9:** *Access control and security system devices and apparatus; access control and security system hardware; computer software for access control*

	and security systems; readers for access control and security systems; card and token readers; biometric readers.
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.*	**Class 37:** *Installation of access control and security systems; maintenance and repair of access control and security systems.*

21. In its notice of opposition, the opponent states that the competing goods and services relate to security systems and apparatus, and the installation, maintenance and repair of such systems and apparatus. It argues that, for example, doors and locks, and control mechanisms for doors and locks, are integral components of security and access control systems and that the goods are identical or similar because they coincide with regard to their nature, intended purpose, relevant public, channels of trade and producers, and are complementary.

22. In support of its claim that the goods are similar, Mr Robson provided the following screenshots showing the results on online searches he had conducted:

- TR1: consists of printouts from the website www.lathamssteeldooors.co.uk, a UK company which is said to retail doors, door frames, door panels and other parts and fittings for security doors. The retailed goods include security doors, a replacement code lock, door panels and a spring stay.

- TR2: consists of printouts from the website www.securitydoorcompany.com, a company which is said to retail security doors and other parts and fittings for security doors. The retailed goods include a digit-door lock for doors and a steel security door.

- TR3: consists of a printout from Wikipedia showing the definition of 'Access control'. It states:

> “The term access control refers to the practice of restricting entrance to a property, a building, or a room to authorized persons. Physical access control can be achieved by a human (a guard, bouncer, or receptionist), through mechanical means such as locks and keys, or through technological means such as access control systems like the mantrap. Within these environments, physical key management may also be employed as a means of further managing and monitoring access to mechanically keyed areas or access to certain small assets.
>
> […]
>
> Electronic access control (EAC) uses computers to solve the limitations of mechanical locks and keys. It is particularly difficult to guarantee identification (a critical component of authentication) with mechanical locks and keys. A wide range of credentials can be used to replace mechanical keys, allowing for complete authentication, authorization, and accounting. The electronic access control system grants access based on the credential presented. When access is granted, the resource is unlocked for a predetermined time and the transaction is recorded. When access is refused, the resource remains locked and the attempted access is recorded. The system will also monitor the resource and alarm if the resource is forcefully unlocked or held open too long after being unlocked.”

- TR4-TR5: consist of printouts showing various goods retailed by Janus International Europe from their website www.januseurope.com. The retailed goods include an access control system which is used to lock and gain access to storage facilities, as well as door latches and storage units with lockers.

- TR6: consists of printouts from the website www.safefence.co.uk, a company which is said to supply temporary fencing, barriers, scaffolding and groundworks equipment. The retailed goods include mesh doors and lockers.

- TR7: consists of a printout from the website www.bgdoor.com showing goods described as “hoist up doors”.

- TR8: consists of a printout from the website www.steelrollupdoors.com, which is described as a US retailer of roll up doors and components. It shows a roll up door with door components listed as curtain panels, tension adjusters, axle drums, tracks, stiffeners, springs, latches, and hardware kits.

23. The opponent did not explain the relevance of this evidence when it filed it. Further, there was nothing at all in Mr Robson’s witness statement which gave any clue as to what matters his evidence aims to establish. It was not until its submissions in lieu, that the opponent discussed the evidence filed pointing to specific aspects of it which were relied upon to support the claim that the goods are similar. I will address these aspects as I come to below.

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.

24. The opponent states that the applied-for *metal door frames; metal door panels; metal door trim; metal springs; metal hoists and metal tension adjusters; parts and fittings of the aforesaid* are complementary to the earlier *access control and security system devices and apparatus; access control and security system hardware; computer software for access control and security systems; readers for access control and security systems; card and token readers; biometric readers* in class 9 because the former are intrinsic elements to a door to which the latter provide access to. In this connection, the opponent relies on exhibit TR8 which lists a ‘tension adjuster’ and ‘springs’ as parts of the roll-up door storage product featuring on the website of a retailer. Further, the opponent argues that there is an overlap in trade channels, relying on exhibit TR1 which shows that the same company retailing door frames, panels and a metal tension adjuster (listed as a ‘spring stay’) also offer a ‘Borg Code Lock’ designed to be used as an ‘access control device’ for a door.

25. The evidence from Wikipedia is helpful in that it provides an aid to the interpretation of the opponent's terms ***Access control*** *and security system devices and apparatus;* ***access control*** *and security system hardware; computer software for* ***access control*** *and security systems* (in class 9). In this connection, whilst I bear in mind that Wikipedia is an open-source encyclopaedia website that can be edited or amended by anyone (and so it might not be 100% reliable), I see no reason to dispute the definitions given and the applicant has not raised an argument on this point. Hence, based on that evidence, the opponent's access control and security system devices, apparatus and hardware include electronic access control mechanisms for opening and closing doors such as digital or electric door locks.

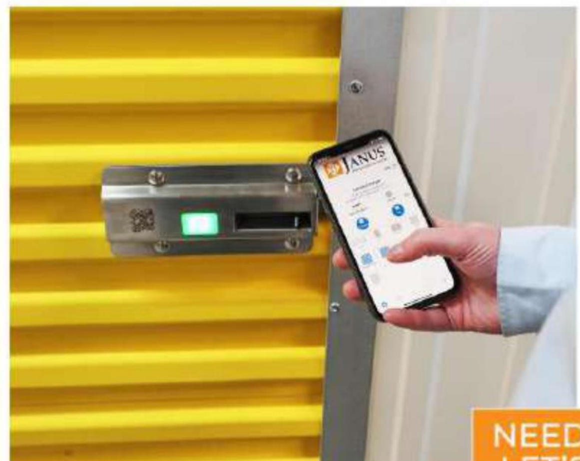
26. Even considering that the applied-for goods include door components, these goods are not strictly complementary to the opponent's access control and security system devices, apparatus, hardware and software because the connection between the goods is not such that customers may think that the responsibility for those goods lies with the same undertaking. Whilst access control and security systems might be fitted to a door to control access to a space/building, there is no evidence that manufacturers of doors components also manufacture access control and security system devices, apparatus, hardware or software. The goods have a different nature, purpose and method of use, and are neither complementary nor interchangeable or competitive.

27. Nevertheless, to the extent that the evidence indicates that retailers of the applied-for door components might also sell the opponent's digital door locks (which fall within the opponent's terms ***access control*** *and security system devices, apparatus and hardware*), I find that the applied-for *metal door frames; metal door panels; metal door trim; metal springs; metal hoists and metal tension adjusters* are similar to a low degree to the opponent's goods. This is all the more so since the applicant's door component goods are made of metal and the evidence indicates that steel doors are sold as high security doors, so the respective goods are likely to target the same users and be distributed by retailers who specialise in security doors and security door components and might also offer the opponent's access control devices (like digital door locks) for extra security. I find that these goods and the corresponding *parts and fittings of the aforesaid* are similar to the opponent's goods to a **low degree.**

28. Turning to *metal modular building units; storage containers made of metal,* the opponent states that they are complementary to the earlier *access control and security system devices and apparatus* and are likely to share the same trade channels, referring to exhibit TR4, which shows that the applicant retails both metallic storage units and a Bluetooth controlled electronic access control system. I agree. The applicant's metal modular building units and storage containers made of metal can be secured by using the opponent's access control and security system devices. The goods target the same users and are complementary; although their nature and purpose are different, they are also likely to be distributed through the same channels. Admittedly, the opponent provided only one example of the goods being sold through the same trade channels, however the closeness of the goods is such that in my view is likely to reflect a general trend for the goods concerned:

ACCESS CONTROL SYSTEM

Our Nokē™ Smart Entry System is truly changing the self storage access control game. The Bluetooth electronic lock is cloud-based and designed specifically for the self storage industry. This secure system allows tenants to easily enter your self storage facility and their unit from a smart device.



29. Accordingly, I find that the applicant's *metal modular building units; storage containers made of metal*, and the corresponding parts and fittings of the aforesaid are similar to the opponent's goods to a **low degree.**

30. Lastly, the opponent relies on exhibit TR6 insofar as it shows that a retailer of metal drums also retails metal storage containers with lockers. However, metal drums and metal storage containers are both goods listed in the applicant's specification so I do not understand how this can assist the opponent's argument that metal drums are similar to the earlier goods as this evidence does not show that retailers of metal drums also sell access control and security system devices, apparatus or hardware

separately (in the evidence presented the lockers are parts of the metal storage containers and are not sold separately). An example of metal drums from the evidence is shown below:

31. *Metal storage tanks* are similar to metal drums insofar as they are both used for storing liquids and gases. Whist I accept that both goods can have application in industries such as gasoline, chemicals and food, there is no evidence that the content of these tanks or drums is secured through the use of the opponent's access control and security system devices, apparatus or hardware. The nature, purpose and methods of use of the goods is different, the users/uses are different, the goods are neither complementary nor in competition and do not share trade channels. They are **dissimilar.**

Class 9

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

32. The earlier goods in class 9 include *Access control and security system devices and apparatus; access control and security system hardware; computer software for access control and security systems; readers for access control and security systems; card and token readers; biometric readers.*

33. The opponent states that the parties' goods in class 9 are similar as they have the same intended purpose of allowing/restricting access through a door. It also states that the class 9 goods of the earlier mark will be intrinsic to the applied-for *electric door opening and door closing mechanisms*, giving the example of *computer software for access control and security systems* being the method which powers the opponent's mechanism. Finally, the opponent refers to the evidence from Wikipedia showing a 'biometric reader' (in the form of a hand geometry reader) which can be used as part of an electric door opening mechanism.

34. I agree. The Wikipedia extract establishes that the term *Access control* encompasses electronic access control mechanisms and software for opening and closing doors. Consequently, I find that the applied-for *Electric door opening and door closing mechanisms* are encompassed by the opponent's *Access control and security system devices and apparatus; access control and security system hardware*. These goods are **identical** *(Meric).* If I am wrong, these goods are **highly similar** to the opponent's *computer software for access control and security systems,* because the goods are highly complementary, target the same users are likely to be sold and installed together by the same companies.

35. Since I found that *Electric door opening and door closing mechanisms* are identical to the opponent's access control and security system devices, apparatus and hardware or highly similar to the opponent's software for access control, I find that the applicant's *parts and fittings for electric door opening and door closing mechanisms* are similar to a **medium degree** to the opponent's goods, as they target the same users, are complementary and are likely to be distributed through the same trade channels.

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.

36. The earlier services in class 37 include *Installation of access control and security systems; maintenance and repair of access control and security systems.* The

opponent's services encompass installations, maintenance and repair of *access control and security systems* for doors and storage units. On that basis, I find that the services have a similar nature, all being installation, repair and maintenance services aimed at ensuring the functionality of doors and storage units. Further, the services target the same users, are likely to be provided by the same undertaking and are complementary. I find these services to be similar to a **high degree.**

37. The applicant's *information and advisory services relating to the aforesaid,* relate to services which I found to be highly similar to the opponent's services. This results inevitably in a degree of overlap. I find these services to be similar to **a medium degree.**

38. In *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA, Lady Justice Arden stated that:

> "49........... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

39. Accordingly, since some similarity of goods is essential, the opposition under Section 5(2)(b) fails in relation to the goods which I found to be dissimilar, namely:

> **Class 6:** *metal drums; metal storage tanks; parts and fittings of the aforesaid.*

Average consumer

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership*

(Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

41. The parties agree that the average consumer for their goods and services will be a member of the general public. In addition, businesses might seek to purchase the goods and services concerned for their business premises. When selecting the goods and services, the consumer will take a number of factors into account, such as price and functionality. Consequently, I consider that at least a medium degree of attention will be paid during the purchasing process, with business consumers deploying an above medium degree of attention.

42. The goods are likely to be selected from the shelves or floor displays of retail outlets (or their online equivalents) or following the perusal of marketing material. The services are likely to be selected from promotional material (in hard copy and online), and signage appearing on vans or websites. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that aural components may play a part as word-of-mouth recommendations may be made.

Comparison of marks

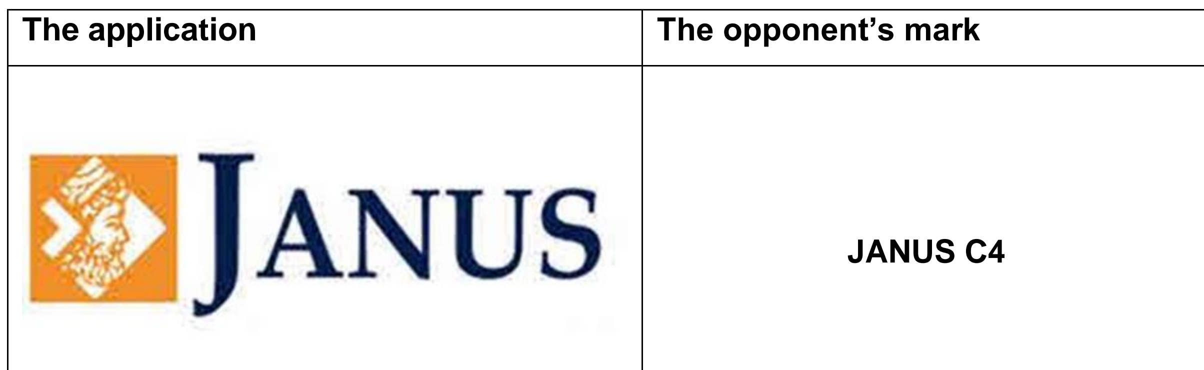
43. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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

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

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

44. 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.

45. The respective marks are shown below:

The application	**The opponent's mark**
	**JANUS C4**

46. The parties made submissions regarding the comparison of the marks, which I will refer to where relevant.

Overall impression

<u>The applicant's mark</u>

47. The applicant's mark is a figurative mark that consists of the word 'JANUS' presented in capital letters in a large dark blue standard typeface. To the left of the word 'JANUS' is an orange square incorporating a white and orange profile image of

a man's head. Whilst the figurative element is placed before the word 'JANUS', it does not overcome the basic tenet that words speak louder than devices. In this connection, the applicant argued that the element 'JANUS' is non-distinctive because in Roman mythology is the god of beginnings, gates, and doorways and provided an extract from Cambridge online dictionary confirming such definition. I reject the submission. The fact that an online dictionary provides a definition of 'JANUS', does not prove that the average consumer in the UK will be aware of that definition. This is all of the more so since there is no evidence that the UK relevant public is familiar with Roman mythology. Accordingly, I find that 'JANUS' will be perceived as an invented word and plays the greater role in the overall impression of the mark with the device element playing a lesser role.

The opponent's mark

48. The applicant's mark consists of the words 'JANUS C4' in word-only format. In my view, the respective elements, namely 'JANUS' and 'C4' do not combine to form a unitary phrase. Instead, these elements will retain their independent distinctive character. The 'C4' element is comprised of a letter from the English alphabet combined with a basic numeral. Collins online dictionary provides the definition of C4 as "a type of plastic explosive", however, there is no evidence that this definition is known by a significant section of the public for the goods and services concerned and I agree with the opponent that it will likely be seen as a product code or a category. The word 'JANUS' will be perceived as invented and it is placed at the beginning of the mark; bearing in mind that the beginnings of marks[4] are more focused upon and that 'JANUS' is inherently highly distinctive, it has more impact than the element 'C4'. While the second element 'C4' is not entirely non-distinctive, it is much shorter and will play a reduced role in the overall impression of the mark.

Visual, aural and conceptual similarity

49. Given the presence of the dominant and distinctive element 'JANUS' in both marks, but taking into account the visual differences introduced by the figurative

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

element in the application and the element ‘C4’ in the earlier mark, I find the marks to be visually similar to a medium degree. Aurally, the figurative element will not be articulated, and the marks coincide in the sound of the word ‘JANUS’ but differ in the sound of the shorter element ‘C4’ giving rise to a high degree of aural similarity. Conceptually, most consumers will see ‘JANUS’ as an invented word, meaning that the conceptual position is neutral. The letter C4 in the opponent’s mark will convey no memorable concept whilst the figurative element in the mark will be seen as decorative.

Distinctive character of earlier mark

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

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

51. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

52. The earlier mark 'JANUS C4' will be perceived as made up of an invented word followed by a letter and a number. It is inherently distinctive to a high degree.

Likelihood of confusion

53. 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 marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

54. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark,* BL O/375/10, where Iain Purvis Q.C. (as he then was) 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).”

55. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis’s formulation but added:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must

be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

56. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

57. Earlier in this decision I found that:

a) The goods and services vary from being identical to being similar to a low degree.

b) The average consumer for the goods and services is a member of the general public or a business user, who will pay a medium or above medium degree of attention during the purchasing process, respectively.

c) The purchasing process is predominantly visual, although I do not discount an aural component to the purchase.

d) The competing marks are visually similar to a medium degree and aurally similar to a high degree. The shared word 'JANUS' will be perceived as invented, conveying no concept, whilst the concept conveyed by the other elements of the marks are weakly distinctive.

e) The earlier mark is distinctive to a high degree.

58. I keep all these findings in mind when considering whether a likelihood of confusion exists.

59. Whilst the visual impact created by the figurative element of the application and the element C4 of the earlier mark are sufficient to avoid the average consumer directly mistaking one mark for the other, that is not sufficient to avoid indirect confusion. Taking into account the presence of the identical, distinctive and dominant word 'JANUS' in both marks, the independent trade mark significance carried by this element in each mark, and the weakly distinctive character of the differentiating

elements of the marks, the average consumer is likely to put the difference between the marks down to the later mark being a variant of the earlier mark used by the same (or an economically connected) undertaking. As it will be recalled, I have concluded that the element C4 in the earlier mark is likely to be seen as an indication of a specific designation of a class or category of goods (and related installation, maintenance and repair services) to the 'JANUS' brand. It follows that the absence of that element in the later mark will not prevent the average consumer from perceiving the later mark as another mark coming from the same user and focusing on the main brand JANUS rather than on a more specific subset of goods or services. There is a likelihood of indirect confusion for the goods and services which I found to be similar.

OUTCOME

60. The opposition is partially successful in relation to the following goods and services for which the application is refused registration:

> **Class 6:** *Metal door frames; metal door panels; metal door trim; metal springs; metal hoists and metal tension adjusters; 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.*

61. The opposition fails in relation to the following goods which can proceed to registration:

> **Class 6:** *metal drums; metal storage tanks; parts and fittings of the aforesaid.*

COSTS

62. The opponent has been more successful than the applicant and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,300, calculated as follows:

Preparing a statement and considering the other side's statement: £300
Preparing the evidence: £600
Preparing written submissions: £300
Official fees: £100
Total: £1,300

63. I therefore order Janus International Group LLC to pay Grosvenor Technology Limited the sum of £1,300. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 30th day of December 2024

TERESA PERKS
For the Registrar