

BL O/0558/25

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,679,741 IN THE NAME OF JANUS INTERNATIONAL GROUP LLC

AND IN THE MATTER OF THE OPPOSITION UNDER NO 429,804 IN THE NAME OF GROSVENOR TECHNOLOGY LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF TERESA PERKS (O/1120/24) DATED 30 DECEMBER 2024

DECISION

Introduction

1. This is an appeal from the decision of Teresa Perks, for the Registrar, dated 20 December 2024 (O/1120/24). Grosvenor Technology Limited opposed the application of Janus International Group LLC under sections 5(2)(b) of the Trade Marks Act 1994. The opposition was largely successful and Janus International appeals.
2. Janus International applied to register the following mark (No. 3,679,741):



3. The application was made in relation to goods and services in Classes 6, 9 and 37. The opposition was unsuccessful in relation to some goods in Class 6 (and so these goods are not relevant to this appeal) and so the appeal relates to the following goods:

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.

4. The Respondent opposed the registration based on its earlier word mark JANUS C4 (No. 3,402,046) which covers the following goods and services:

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.

Standard of appeal

5. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer's findings were rationally insupportable. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch), [24] and in relation to findings of fact this should now be read in light of the summary of Arnold LJ in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, [110] and in terms of evaluative decisions the Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8, [49] where it stated that:

...on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

6. I also remind myself of the guidance from Arnold LJ in *Extreme Networks Ltd v Extreme E Ltd* [2024] EWCA Civ 1386, [31] about the need for appellate modesty in reviewing a Hearing Officer's assessment of the similarity of goods or services.
7. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Grounds of appeal

8. The Appellant challenges the Hearing Officer's decision on five grounds. First, the Hearing Officer is said to have erred in her assessment of the similarity of the goods and services. Secondly, it is submitted that her assessment of the overall impression of the mark was flawed. Thirdly, the Hearing Officer is said to have erred in her determination of the distinctiveness of the earlier mark. The fourth and fifth grounds of appeal follow from the first three grounds in that it is said the assessment of the likelihood of confusion was wrong because of earlier mistakes and that the totality of the errors by the Hearing Office means that the decision reached was rationally insupportable. I will consider each ground in turn.

Ground 1: Similarity of goods and services

9. Ms Watkinson, for the Appellant, directed me to two well-known cases on assessing the similarity of goods and services. The first, *C-39/97 Canon Kabushiki Kaisha v MGM* [1998] ECT I-5507 at [23] held:

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 end users [should read ‘intended purpose’] and their method of use and whether they are in competition with each other or are complementary.

10. And the second being the judgment of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 296-7:

Thus I think the following factors must be relevant in considering whether there is or is not similarity:

- (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.

11. Further, while not mentioned by the Appellant, it is provided in section 60A of the Trade Marks Act 1994 that goods or services are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification. I will therefore move on to consider the Hearing Officer’s findings on the similarity of the goods and services.

Metal door frames; metal door panels; metal door trim; metal springs; metal hoists and metal tension adjusters; parts and fittings of the aforesaid

12. In relation to the following Class 6 goods “Metal door frames; metal door panels; metal door trim; metal springs; metal hoists and metal tension adjusters; parts and fittings of the aforesaid” the Hearing Officer found that the Respondent’s Class 9 goods (“Access control and security system devices and apparatus; access control and security system hardware; computer software for access control and security systems”) have a different nature, purpose and method of use, and are neither complementary nor interchangeable nor in competition (Decision, [26]). However, she went on to find that they would have the same user and share the same trade channels (Decision, [27]). She concluded therefore that there was a low degree of similarity between the respective goods.
13. Ms Watkinson’s primary submission is that if the nature and purpose of goods is different then those goods should be treated as dissimilar. This was developed before me to be an argument that because there were more *British Sugar* factors directing away from the similarity of goods (factor (a), (c), (e) and (f)) than towards it (factor (b) and (d)) this should mean the goods were dissimilar.
14. It is well established that assessing the similarity of goods or services is a multifactorial evaluation (see *Extreme* [2024] EWCA Civ 1386, [33]) and so merely counting the number of *British Sugar* factors which point each way is entirely the wrong approach. Further, there are no trump cards amongst these factors and so, in principle, the fact the

nature and purpose of the goods is different cannot in itself mean the goods should be seen as dissimilar.

15. It is also suggested by Ms Watkinson that the factors relating to both channels of trade and users of the goods should be given less weight than the other factors. In some cases, this might be the correct approach. For instance, where the relevant user is taken to be the general public, the “user” factor may (possibly) be given less weight due to the diversity of the general population than it might be when the “user” is a highly specialised professional. Likewise, the trade channels may be less important where the goods are routinely sold in a supermarket (although in such a case factor (e) becomes more important), rather than in specialist stores or on specialist websites.
16. I also entirely accept that there will be goods which share users and trade channels and which should properly be considered dissimilar. But as would be expected, there are other goods where there can be some degree of similarity, based on these two factors alone. This just highlights the evaluative nature of the assessment of each factor. Depending on the type of goods or services being considered, some factors might be given more weight by the Hearing Officer than others. Indeed, this is why a simple counting the factors approach is entirely inappropriate.
17. In reality, Ms Watkinson is asking me to reconsider the Hearing Officer’s finding on similarity to find the goods to be dissimilar and thereby avoiding any assessment of likelihood of confusion (see C-106/03 *Vedial* [2004] ECR I-9573, [51 to 54]). It is my view, however, that the Hearing Officer gave proper weight to the limited evidence before her and then made appropriate factual findings before properly evaluating the similarity. In short, the conclusion that there is a low degree of similarity between the goods was one that she was entitled to make.

Metal modular building units; storage containers made of metal; parts and fittings of the aforesaid

18. In relation to “Metal modular building units; storage containers made of metal; parts and fittings of the aforesaid” the Hearing Officer concluded these were similar to “access control and security system devices and apparatus” to a low degree (Decision, [29]). In coming to this conclusion, the Hearing Officer found that the goods shared trade channels and users, and that they were complementary to each other, but that the nature and purposes of the two goods were different.

19. The Appellant’s case for these goods was more or less the same as for Metal door frames & c and so I uphold the Hearing Officer’s decision for the same reason.

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

20. The Hearing Officer found “Electric door opening and door closing mechanisms; parts and fittings for all the aforesaid goods” in Class 9 to be identical to “Access control and security system devices and apparatus; access control and security system hardware” (Decision, [34]). In doing so, she accepted the Opponent’s (now Respondent’s) submission that the goods have the same intended purpose and that access control

systems are often part of door mechanisms (Decision, [33]). She made an alternative finding that if she was wrong about the goods being identical then, because the goods are highly complimentary, target the same users, and are likely to be sold and installed together by the same companies, they are highly similar.

21. Ms Watkinson makes a very courageous submission. Not only are the goods not identical, she says, but they are in fact dissimilar. I reject this submission entirely. I tend to prefer the view that the goods are identical to their being highly similar for the reasons the Hearing Officer gives, but even if we are both wrong it is unarguable that these goods are dissimilar.

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

22. The Hearing Officer found the installation, repair and maintenance services in Class 37 are similar to a high degree to the Opponent's goods in Class 9; and information services in Class 37 are similar to a medium degree to those goods (Decision, [36 and 37]). In have upheld the Hearing Officer's findings in relation to Class 9, and for the reasons she gives I also uphold her findings in relation to the related services.

23. I therefore reject the Appellant's first ground of appeal in its entirety.

Ground 2: Meaning of Janus and the distinctive elements of the mark

24. The Appellant's second ground of appeal is that that the Hearing Officer was wrong to find that the relevant public would consider the word Janus to be an invented word (Decision, [47]). Instead, Ms Watkinson submits, the Hearing Officer should have accepted the dictionary evidence that the relevant public would know that Janus is the (two faced) Roman God of beginnings, gates, and doorways.
25. There is no dispute between the parties that Janus is the name of a Roman God and that this is clear from a dictionary, rather the issue is whether the Hearing Officer was right in her finding that the relevant public would not know this fact (even though it is in a dictionary). There was no evidence before the Hearing Officer as to what the relevant public actually knew about the word Janus on the relevant date and so she was reliant on making a decision based on her own knowledge and assumptions (there is nothing in the decision to suggest whether she had personally known the Olympian origins of the word Janus before hearing the case).
26. Clearly, a Hearing Officer is not bound to conclude that the relevant public knows the existence (and meaning) of every word in the dictionary or indeed every proper noun. This is not affected by the fact that the goods in question (relating to gates and doorways) might be within the sphere of Janus's divine control. In Roman mythology there was a large number of Gods and demi-gods. The *di consentes* were the twelve main deities and these do not include Janus (Livy:XXII.10.9). I doubt many members of the general public would know more than a few of the *di consentes*, let alone Gods, like Janus, falling in the wider category of divine beings. Accordingly, I think the Hearing Officer's conclusion that the public would not link the word Janus to the dictionary meaning presented is perfectly

reasonable. She was therefore entitled to treat the relevant public as believing the word Janus to be invented (even if, as Ms Watkinson say, it looks like a word).

27. Further, even where I have a different view, I should be slow to substitute my view for that of the Hearing Office as Daniel Alexander QC, sitting as the Appointed Person, said in *O2 Holdings Ltd's Trade Mark Application* [2011] RPC 22, [60]:

In the context of an appeal, once an experienced Hearing Officer has made an evaluation, an appellate tribunal needs to have very sound reasons for substituting its own view and implicitly thereby saying that it is better equipped with knowledge of the relevant field of commerce to evaluate the mark than the Registrar.

28. I therefore reject the Appellant's challenge to this finding.

29. The Appellant also suggests that the Hearing Officer was wrong to find the word Janus, rather than the face device, to be the most distinctive element of the Respondent's mark. While the Hearing Officer put it as "words speak louder than devices" (Decision, [47]), it has long been established that verbal elements of marks are usually more distinctive than devices: T-312/03 *Wassen International* [2005] ECR II-2897, [37]; T-412/08 *Trubion Pharma*, EU:T:2009:507, [45].

30. With this in mind, I find that the Hearing Officer was entitled to find that the word Janus is a more distinctive element of the Respondent's mark than the device. Accordingly, I reject this aspect of the Appellant's appeal as well.

31. I therefore dismiss the Appellant's second ground of appeal.

Ground 3: Distinctiveness of Janus

32. The Appellant's third challenge is to the Hearing Officer's finding that the earlier mark JANUS C4 would be inherently distinctive to a high degree: Decision, [52]. Ms Watkinson submits that because the relevant public would know that Janus was the god of gates and doorways the word would be allusive in relation to the relevant goods. And so the mark could not be highly distinctive.

33. This ground of appeal was, therefore, predicated on the Hearing Officer having erred in her finding that the relevant public would see Janus as an invented word. I have already held that this was an acceptable finding and so the third ground of appeal falls away.

34. I will however address one point made by Ms Watkinson. She submits that if Janus was not an invented word it would *necessarily* be less distinctive than if it were an invented word. I do not accept this submission. There is no reason why arbitrary marks (ie existing words used as trade marks) cannot be inherently distinctive to a high degree or why invented (fanciful) marks cannot have a lower degree of distinctiveness. The level of inherent distinctiveness will depend on the mark in question and its relationship to the goods or services.

35. I therefore dismiss the third ground of appeal.

Grounds 4 and 5: Indirect confusion and totality of errors

36. The success of the Appellant's other grounds of appeal was dependent on one or more of the earlier grounds being successful. As I have dismissed these, the Appellant cannot succeed on the final two grounds of appeal either.

Conclusion

37. I uphold the Hearing Officer's decision and dismiss the appeal.

38. I order the Appellant to pay the Respondent £2,500 as a contribution toward the costs of this appeal (along with the £1,300 order by the Hearing Officer) by 4pm on 10 July 2025.

PHILLIP JOHNSON
THE APPOINTED PERSON
19 June 2025

Representation

For the Appellant: Kendal Watkinson (instructed by Walker Morris LLP)

For the Respondent: Tom Robson (of Reddie & Grosse LLP)