

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION m 2112448  
BY WHITELINE WINDOWS LIMITED  
TO REGISTER THE TRADE MARK



AND

IN THE MATTER OF OPPOSITION BY  
BY BRÜGMANN FRISOPLAST GMBH  
THERE TO UNDER OPPOSITION m 46745

## DECISION

Whiteline Windows Limited applied on 10 October 1996 to register the above mark for goods in Class 19: 'PVC-U windows, doors, patio doors and conservatories; double-glazed sealed units.'

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The application is opposed by Brüggmann Frisoplast GmbH on the following grounds:

- ! s 5(2) in that the Applicants mark is similar to the Opponents' earlier mark and is to be registered for similar goods;
- ! s 5(4)(a) because use of the Applicants mark is liable to be prevented by virtue of the law of passing-off;
- ! s 3(6) because of the conduct of the Applicants, the nature of the Mark and the use that may already may have been made of it.

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The Opponents made a Community trade mark application (No. 172,163) on 1 April 1996 for 'plastic profiles for doors and windows':



15 A counter statement is provided by the Applicants denying the grounds of opposition, though no evidence was filed in reply. Both Opponents and Applicants ask for their costs. No hearing was requested and a Decision has been made from the evidence submitted.

### The Evidence

20 The Opponents enclose a statutory declaration from Rudolf Brickenstein the Managing Director of Brüggmann Frisoplast GmbH. Mr Brickenstein says that his Company is the Applicant for Community Trade Mark shown above. A photocopy of the application form for the mark is enclosed in evidence.

25 Mr Brickenstein says that his Company sells plastics profiles for doors and windows and evidence of the range of products they produce is provided. He points to use of the words GOLDEN LINE and their trade mark throughout this literature, in close proximity, but also alone (Exhibits RB2, RB4 and RB6). He says that there are clear references in the evidence to use of GOLDEN LINE as a trade mark for his Company, and gives an example as an extract

from what I take to be a trade journal called 'Building Design'. This states 'In the main body of the show, new products will include...Golden Line PVCU from Brugmann,.'

Mr Brickenstein says that when the system was designed in 1986/87 it was decided to have in  
5 '...the frame profile inserted a yellow gold filler profile as the distinctive character for the  
profiles and the system', and this gave the product its name. Distribution agreements were  
also apparently made with two UK firms in 1989 and 1990 for products made in Germany,  
and from 1996 products produced in Ireland were 'sold all over Europe, including England.'  
Though no evidence of direct sales to consumers in the UK is provided, a letter is enclosed  
10 from Mr P Marland, who worked for one of the distributors, and states:

'I can confirm that the Company Graham-Holmes Plastics Limited was an authorised  
Brugmann Systems fabricator from 1978 but under the new agreement signed in August  
1989 this company used the Golden Line Window System from Brugman as its main  
window profile until 1994 and during that time undertook both large and small contracts.'

15 Mr Brickenstein says that the date of first use for products with the Opponent's mark was in  
1990. Invoices from 1993 are provided in evidence. He says that in 1992 his Company  
achieved a DM2.45 million turnover in the UK for the profile system under the trade mark  
GOLDEN LINE, and provides, in Exhibit RB5 a balance sheet for his Company's main  
customer in the U.K. for the year 1992, evidencing a DM 2.4 million turnover in 1992. There  
20 is no specific reference to the Golden Line system on this document. He also provides  
turnover figures, for recent years including 1992 as:

Year	DM
1991	2,620,000
1992	2,193,000
1993	2,450,000
1994	1,330,000
1995	153,000
1996	348,000
1997 - August 97	576,000

Mr Brickenstein refers to advertising activities and Exhibit RB6 contains examples of press  
releases, advertisements and articles which have appeared apparently in UK publications.  
He also alludes to an exhibition called Glassex which, he says, his Company promoted its  
25 activities in 1995, 1996 and 1997. Finally a 1991 price list for the GOLDEN LINE products  
is included in evidence.

As stated above, the Applicants submitted no evidence.

### The Decision

Turning to the first ground of opposition, section 5(2) of the Act reads:

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

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

An earlier trade mark, for the purposes of this case, is defined in s 6(1)(a) and s 6(2) as:

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

(a) a registered trade mark, international trade mark (UK) or **Community trade mark 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.

The Opponents mark was applied for on 1 April 1996, while the application in suite was filed on 10 October 1996. This defines the Opponents’ mark as being an earlier mark, ‘subject to it being so registered’. I have no evidence that this mark has proceeded to registration and grounds successfully raised against the Applicants’ mark will be conditional upon the Opponents’ earlier application proceeding to registration.

S 5(2)(b) of the Act partially implements Article 4(1)(b) of the Directive. In the BALMORAL<sup>1</sup> Decision Mr Geoffrey Hobbs, acting as the Appointed Person, referred to the SABEL v PUMA<sup>2</sup> case when interpreting the expression “a likelihood of confusion on the part of the public”:

‘Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant

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<sup>1</sup>Trade Marks Act 1994: In the matter of Application no. 2003949 to register a trade mark in class 33 in the name of ROSEMOUNT ESTATES PTY LIMITED; Decision of the Appointed Person, 18 August 1998 (unpublished).

<sup>2</sup>European Court of Justice in Case C-251/95 *SABEL BV v. PUMA AG* [1998] RPC 199.

components. The wording of Article 4(1)(b) of the Directive - “there exists a likelihood of confusion on the part of the public” - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally  
5 perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either  
10 *per se* or because of the reputation it enjoys with the public.’

Mr Hobbs then went on to construct the following query:

‘The tenth recital to the Directive and these observations of the Court of Justice indicate that an objection to registration under Section 5(2) of the Act should be taken to raise a single composite question: are there similarities (in terms of marks and goods or services)  
15 which would combine to create a likelihood of confusion if the ‘earlier trade mark’ and the sign subsequently presented for registration were used concurrently in relation to the goods or services for which they are respectively registered and proposed to be registered?’

This ‘single composite question’ requires an assessment of the similarity of the goods in question. The tests established in *TREAT*<sup>3</sup> have been confirmed in *CANON*<sup>4</sup>:

20 ‘In assessing the similarity of the goods or services concerned... all the relevant factors relating to those goods or services themselves should be taken into account...includ[ing], *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary..’

It is clear that the Opponents, Brüggmann, manufacture a ‘window system’ under the Golden  
25 Line name from which ‘a wide range of window options can be manufactured’, including ‘windows, residential doors, French doors, patio doors’. Brüggmann sell their products (mainly ‘profiles’) to fabricators and not the general public. It appears from the evidence that ‘profiles’ are the plastic (PVC) structures used in the construction of, for example, PVC windows, doors, patio doors, conservatories and double-glazed sealed units. ‘Profiles’ are  
30 ordered by fabricators who will use them to assemble such final products. However, the Opponents’ products are distinctive. Mr Brickenstein states: ‘..the frame profile inserted a yellow gold filler profile as the distinctive character for the profiles..’ and it is clear this is visible in the finished product (see examples in Exhibit RB6).

35 The Applicants mark is proposed to be registered for the following goods: ‘PVC-U windows, doors, patio doors and conservatories; double-glazed sealed units.’ The Opponents application is for: ‘plastic profiles for doors and windows’. These products are not identical,

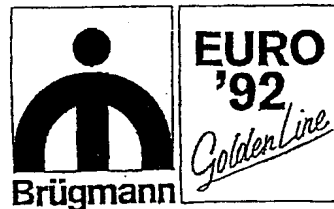
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<sup>3</sup>(1996) RPC 9, page 296, line 35ff

<sup>4</sup>*CANON KABUSHIKI KAISHA v. METRO-GOLDWYN-MAYER INC.* Court of Justice of the European Communities (Case C-39/97), September 29 1998.

but I do consider them to be similar, as profiles form a major component of the finished product.

S 5(2)(b) is applied on the basis of the query stated above.



5 The only similarity are the words GOLDEN LINE and GOLDLINE. There are obvious visual differences between these elements - GOLDEN as opposed to GOLD - and that one consists of one word and the other of two, and the font style is different. On the other hand, these features of the marks are orally and conceptually similar, both carry a laudatory element in the combination of the words 'golden' and 'gold' (suggesting value) together with 'line', that is, a range of products. In this sense the words are conceptually similar, but perhaps less  
10 distinctive as a result. However, I am not asked to compare these elements of the marks alone. Both carry a strong device element, and I think it is this that finally dominates and leads me to the conclusion that confusion, including association, is unlikely and I must conclude that the opposition under this ground fails.

Turning now, to the grounds under s 5(4)(a) this states:

15 '(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting a  
unregistered trade mark or other sign used in the course of trade..'

20 Geoffrey Hobbs QC, acting as the 'Appointed Person', summed up the current law under Section 5(4)(a) of the Act in the *WILD CHILD*<sup>5</sup>. He stated that:

25 'A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd -v- Borden Inc* [1990] RPC 341 and *Erven Warnink BV -v- J Townend & Sons (Hull) Ltd* [1979] ACT 731 is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or

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<sup>5</sup>*Wild child* [1998] 14 RPC, 455.

reputation in the market and are known by some distinguishing feature;

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- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
  - (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

10 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to  
15 exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House"

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that;

20 "To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

25 (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

30 While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

35 (a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

5 (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

10 In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.” ’

15 In summary, to succeed in a passing off action, it is necessary for the Opponents to establish that at the relevant date (10 October 1996): (i) they had acquired goodwill under their mark, (ii) that use of the other mark would amount to a misrepresentation likely to lead to confusion as to the origin of their goods; and (iii) that such confusion is likely to cause real damage to their goodwill.

I need to begin by assessing from the evidence submitted the extent of the Opponents goodwill in UK at the relevant date (the time of application) of 10 October 1996. The evidence of use is summarised above; I regard the following as significant:

20 ! One of the two parties stated as being distributors for Brüggmann products confirms they fabricated goods using the Opponents Golden Line ‘profiles’ from 1989 to 1994.

! Brochure and some invoice evidence some shows supply of Golden Line products to this distributor in 1993 (Exhibit RB4).

25 ! Though there is no specific reference to the Golden Line system invoices are provided showing a DM 2.4 million turnover in 1992 (Exhibit RB 5). Significant turnover figures for the Golden Line system as traded in the UK from 1991 to 1997 are provided (see above).

! Exhibit RB6 contains examples of press releases, advertisements and articles which have appeared in UK publications. Some of these appeared after the relevant date.

30 The evidence provided in Exhibit RB6 clearly shows that the Opponents’ Golden Line system was promoted to the trade in the UK some months before the Application was filed. Aside from this promotion, the Opponents’ product carries the highly characteristic ‘gold strip’ which, according to Mr Brickenstein, resulted in the products name. A review of the Exhibit RB6 shows that the Opponents have used GOLDEN LINE as a separate mark in the UK, albeit often in conjunction with other marks, and it seems clear to me ‘that a name, mark or  
35 other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons’ and that goodwill in their business is clearly established, and that this is associated with the GOLDEN LINE name.



The next issue is whether this goodwill may be damaged by confusion with the Applicants' mark. Despite the device element in the Applicants' mark, it is the word 'GOLDLINE' that dominates and this is very similar to the Opponents' GOLDEN LINE. Though the latter is use in conjunction with other marks as stated above - typically the Brüggmann device or name -  
5 there is well established guidance in trade mark registration cases in relation to house marks<sup>6</sup>, that suggests confusion is still possible and in my view it is a very real likelihood in this case.

In a passing off case, where the defendant (even inadvertently) represents his goods as those of the plaintiff, the simplest damage to the business of the plaintiff can occur where sales are lost by substitution of the plaintiff's goods with those of the defendant. It seems to me that  
10 this is possible here. Brüggmann supply 'profiles' and 'window systems', as discussed above and sell (based on their evidence) to fabricators, who than supply to the public or to others in the trade (see Exhibit RB 6, the advert for FENLAND CLASSIC LTD, towards the end of that exhibit). From the Applicants' specification they make finished products, though I have no information on their customers base, I assume this consists of the general public, though  
15 they may sell to the trade as well. It seems to me possible that confusion, leading to a lose of sales, could occur at a number of points in the chain of supply, including the final customer, that is, members of the public. Mr Brickenstein makes this very point:

'I know of no other person, firm or company that has, or would have, a bonafide claim to be entitled to use the Trade Marks BRUGMANN & Device GoldenLine or Golden Line in  
20 relation to the goods covered by this Application. I am concerned that Whiteline Windows Limited have adopted GOLDLINE as part of the Mark ... and believe that this will give rise to confusion in the marketplace.

This is because it is my understanding that Whiteline Windows Limited's goods are finished (completed) PVC-U windows, doors, patio doors and conservatories as well as  
25 double-glazed sealed units. My Company's products are profiles and people would believe, therefore, that the goods of interest to the applicants sold under the W GOLDLINE & Device Trade Mark were made up from my Company's components.'

In view of these considerations, I believe that confusion between the Applicants' mark and the name GOLDEN LINE is likely, and that this will lead to damage of the Opponents goodwill  
30 established in this name. The grounds for opposition under s 5(4) are therefore successful.

Finally, the Opponents plead 'bad faith' under s 3(6), which reads:

'A trade mark shall not be registered if or to the extent that the application is made in bad faith'

The Act does not indicate what is meant by 'bad faith' and it must therefore be for the Registrar or the Court to decide in a particular case what this amounts to. In their counter  
35 statement the Opponents say this ground applies 'because of the conduct of the Applicants, the nature of the Mark and the use as may already may have been made of it'. However, they do not provide any evidence or argument to support this proposition. I therefore find the

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<sup>6</sup>*Bulova Accutron* (1969) RPC 12).

Opponents unsuccessful in their opposition under Section 3(6) of the Act.

The Opponents having been successful in these proceedings, are entitled to a contribution towards their costs. I therefore order the Applicants to pay them the sum of £535.00

**Dated this 26th day of April 1999**

5 **Dr W J Trott**  
**Principal Hearing Officer**  
**For the Registrar, the Comptroller-General**