

THE PATENT OFFICE

Room 2A,
Harmsworth House,
13-15 Bouverie Street,
London, EC4Y 8DP.

Monday, 17th July 2000

Before:

MR SIMON THORLEY QC
(The Appointed Person)

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In the Matter of **THE TRADE MARKS ACT 1994**

and

In the Matter of Trade Mark Application No: 2112448 in the
name of **WHITELINE WINDOWS LIMITED** to register the trade mark
GOLDLINE in Class 19

and

Opposition thereto under No: 46745 by
BRUGMANN FRISOPLAST GmbH

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**An appeal to the Appointed Person from the decision of
Dr W J Trott of 26th April 1999**

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd.,
Midway House, 27-29 Cursitor Street, London EC4A 1LT.
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MR S WALTERS (of Messrs Trade Mark Consultants Co) appeared as
Agent on behalf of the Appellant/Applicant.

THE RESPONDENT/OPPONENT did not appear and was not represented.

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D E C I S I O N
(As approved by the Appointed Person)

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1 MR THORLEY: This is an appeal from the decision of Dr Trott
2 dated 26th April 1999 in opposition proceedings. The
3 opposition is to the registration of trade mark application
4 number 2112448 by Whiteline Windows Limited to register a
5 trade mark which consists of a stylised version of the capital
6 letter W in a rectangular box, underneath which is the word
7 "Goldline".

8 This application is opposed by a German company, Brugmann
9 Frisoplast GMBH who are themselves the applicants for a
10 Community trade mark, number 172163, which was applied for on
11 1st April 1996. This mark, which is reproduced in Dr Trott's
12 decision, consists (amongst other things) of the words "Golden
13 Line" in a distinctive script.

14 The trade mark opposed was applied for on 10th October
15 1996 and opposition was lodged on the basis of section 5(2),
16 section 5(4)(a) and section 3(6). Dr Trott rejected the
17 opposition based under section 5(2) in that he held the mark
18 applied for was not confusingly similar to the opponents'
19 mark. He also rejected the opposition under section 3(6).
20 However, he found in favour of the opponents under section
21 5(4)(a) holding that the use of the applicants' mark would be
22 liable to be prevented by virtue of the law of passing off,
23 having regard to the opponents' established reputation in the
24 words "Golden Line". It is from that part of the decision that
25 this appeal arises.

26 The statement of grounds of appeal and statement of case
are dated 13th August 1999, some three and half months after

1 the date of the decision. An extension of time was granted by
2 Mr Parker acting on behalf of the Registrar so as to permit
3 the late filing of this appeal. Whilst I accept that the
4 Registry has power under the Trade Marks Rules 1994, rule 62
5 and under the current Trade Marks Rules 2000, rule 68, to
6 extend the time of 28 days provided for an appeal, this is a
7 matter which must be approached with the greatest caution so
8 as to ensure that the exercise of discretion does not
9 undermine the purpose underlying the statutory provision.
10 Appeals create uncertainty and it is in the interests of
11 everyone that appeals are disposed of timeously. Extensions
12 of time in which to enter notices of appeal are therefore not
13 to be encouraged.

14 In the present case there has been no appeal against Mr
15 Parker's decision to grant, what I regard as being an
16 extraordinary length of extension of almost three months. It
17 is therefore not necessary for me to comment further save to
18 draw attention to the fact that I should not like it to be
19 thought that extensions of time for serving appeal documents
20 will be granted lightly. I turn then to the substance of the
21 appeal.

22 Mr Walters, who appeared before me on behalf of the
23 applicants, accepted that the appropriate law was that set out
24 by Dr Trott in his decision, which consisted of citations
25 extensively from Mr Hobbs QC's decision in **Wild Child** [1998]
26 R.P.C. 455. What Mr Walters contended was that the onus was
on the opponents to establish the necessary reputation for the

1 purposes of bringing successful proceedings under the law of
2 passing off and to establish the necessary misrepresentation.
3 He contended that in both those respects the evidence was
4 insufficient to justify Dr Trott's finding of reputation and
5 misrepresentation.

6 Agents acting for the opponents, Forrester Ketley & Co.,
7 indicated by letter dated 30th November 1999 that the
8 opponents did not wish to be represented at the appeal hearing
9 and they drew attention to the fact that no evidence had been
10 filed in support of the application.

11 As I have indicated, Mr Walters' attack on Dr Trott's
12 decision focused on the inadequacy, so he alleged, of the
13 evidence filed on behalf of the opponents. This evidence
14 consists of the declaration of Rudolf Brickenstein of 10th
15 December 1997. Mr Walters took me through both the
16 declaration and the exhibits in some detail and drew attention
17 in particular to the relevant dates. The relevant date for
18 the purpose of assessing the reputation and likelihood of
19 confusion is, as he correctly submitted, 10th October 1996,
20 the date of application for the mark opposed. He submitted
21 that the evidence failed to show sufficient evidence of
22 reputation in the words "Golden Line" by October 1996.

23 I do not propose to recite the whole of the evidence, but
24 I think it is important to consider not only the statements in
25 the declaration, but also the material which supports those
26 statements. It is also important when assessing written
evidence of this nature to separate true facts from statements

of opinion by the witnesses.

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2 In paragraph 4 of his declaration Mr Brickenstein states
3 as follows:

4 "My Company carries on the business of selling plastic
5 profiles for doors and windows and there is now produced
6 and shown to me marked Exhibit RB2 literature
7 illustrating the range of products provided.

8 It can be seen from the literature forming Exhibit RB2
9 that the elements forming the subject of Community Trade
10 Mark Application No. 172,163, namely BRUGMANN & Device
11 and the words "Golden Line" are used throughout the
12 literature and that, although used in close proximity to
13 each other, Golden Line also appears on its own.

14 This can be seen from Exhibits RB2, RB4 and RB6 to my
15 Declaration. Others clearly refer to my Company's Trade
16 Mark as Golden Line as can be seen, in particular, from
17 Exhibit RB6 to this, my Declaration - for example in the
18 extract entitled "that eighties feeling" from "Building
19 Design". I would therefore contend that my Company's
20 Trade Mark is known as Golden Line and Golden Line is
21 used in isolation as a Trade Mark.

22 The system Golden Line was designed in 1986/87 and the
23 contract between Brugmann Frisoplast GmbH and J.E.Lesser
24 & Sons Ltd. was closed for this system on September 4
25 1987.

26 During the construction it was decided to have in the
frame profile inserted a yellow gold filler profile as

1 the distinctive character for the profiles and the
2 system. Since that time the system was because of that
3 called Golden Line.

4 After the tools were ready, the Company J.E. Lesser &
5 Sons Ltd. came into difficulties so that the system had
6 to be produced in Germany. Therefore, two distribution
7 agreements of August 22 1989 between Brugmann Frisoplast
8 GmbH and J.E. Lesser & Sons Ltd, and of June 4 1991
9 between Brugmann Frisoplast GmbH and Graham Holmes
10 Plastics Ltd. have been closed. The basis for the prices
11 for 1991 was the price list in German of February 1 1991
12 which is referred to further below and also forms Exhibit
13 RB7 to my Declaration.

14 The original licensee of Brugmann Frisoplast GmbH in
15 England was Hepworth Ltd. Hepworth Ltd. sold to Graham
16 Holmes Plastics Ltd., Graham Holmes Plastics Ltd. sold to
17 J.E.Lesser & Sons Ltd., Lesser went bankrupt and Graham
18 Holmes Plastics Ltd. took over again from J.E. Lesser &
19 Sons Ltd., so that finally during these years the same
20 people were the customers and used the Brugmann systems
21 and especially the Golden Line system.

22 Since 1996 the products are produced by the group Bantry
23 Plastics Ltd. in Ireland which belongs to Brugmann and
24 are sold all over Europe, including England.

25 There is now produced and shown to me marked Exhibit RB3
26 a statement from the Chairman of Graham-Holmes Astraseal
confirming that his Company was an authorised fabricator

1 from 1989 until 1994 for the Golden Line window system.
2 The date of first use in the United Kingdom in relation
3 to the range of products provided under the Trade Mark
4 BRUGMANN & Device GoldenLine or the Trade Mark Golden
5 Line was in 1990 and there is now produced and shown to
6 me marked Exhibit RB4 a copy of a 1993 order from Graham-
7 Holmes Plastics Limited, together with a copy of the
8 invoice despatched to them, and my Company's catalogue.
9 All article numbers refer to products sold under the
10 Trade Mark Golden Line as referred to in the catalogue."

11 He continues in paragraph 7 by setting out evidence of
12 sales of the Golden Line system which show that in 1990 sales
13 figures of some 2.5 Deutsche Marks were achieved, but this
14 then decreased so as to reduce in 1994 to DM153,000. There
15 were no sales in 1995 and in 1996 the sales increased to
16 DM348,000.

17 In paragraph 8 Mr Brickenstein gives evidence of some
18 press releases and advertisements that have appeared in UK
19 publications.

20 Turning to look at the exhibits, Mr Walters is correct,
21 in my judgment, when he submits that the documents forming
22 exhibit RB2 are either undated or are dated in August 1996 and
23 therefore do not provide any support for the contention that
24 there was a reputation in the words "Golden Line" prior to
25 August 1996. In so far as there is a document dated August
26 1996, that is a product range brochure and only contains a
reference to the words "Golden Line" as part of the title

1 Brugmann PVC-U Window System, Golden Line. I do not believe
2 that use of the words "Golden Line" in that context can be
3 said to contribute any weight to an assertion of reputation in
4 the words "Golden Line" alone as at October 1996.

5 Exhibit 3 is a letter from Mr Marland, the Chairman of
6 Astraseal, who in that letter confirms that the company,
7 Graham Holmes Plastics Limited was Brugmann's authorised
8 systems fabricator from 1978 and that from August 1989 the
9 Golden Line window system from Brugmann was used as its main
10 window profile. However, this letter gives no indication of
11 the amount of business conducted in such profiles and, much
12 more importantly, gives no evidence of the way in which the
13 words "Golden Line" were used by and in relation to the trade
14 and the public in this country.

15 Exhibit 4 repeats part of the documents exhibited as
16 exhibit 2, but includes a further part of the product range
17 brochure of August 1996 which includes a reference to the word
18 GoldenLine separate from Brugmann PVC-U Window System.

19 I turn then to exhibit 5 which contains details of
20 supplies to Graham Holmes Plastics from the opponents in the
21 years 1990 to 1994. This document contains no reference
22 whatever to the use of the words Golden Line and therefore
23 cannot assist.

24 Finally, I turn to exhibit 6. This exhibit contains a
25 large number of press cuttings and advertisements relating to
26 the activities of the opponents at an exhibit called the
27 Glassex Exhibition in 1996. It took place, I believe, in

1 either March or April of 1996. It is abundantly clear from
2 reading these documents that whatever trade had been carried
3 on using the Golden Line name prior to 1996, the opponents
4 believed the reputation was such that in truth there was no
5 established reputation at that date. I say this because the
6 whole emphasis of the advertising shown in exhibit 6 is that
7 this is the launch of a new product range under a mark
8 containing the words "Golden Line". I take as an example an
9 advertisement in a magazine called Building Design of March
10 1996 which states:

11 "In the main body of the show, new products will include
12 an integrated 70mm window and door suite from Spectus,
13 the Security EH tilt & turn/tilt & slide patio door
14 system from Maco UK, Golden Line PVC-U systems from
15 Brugmann...." and so on.

16 Equally, in the journal Building Management & Maintenance of
17 5th May 1996 it is stated:

18 "The new Brugmann Golden Line PVC-U window and door
19 system, with its wide variety of opening styles and
20 finishes is now available in the UK. Brugmann is one of
21 the largest extrusion companies in Germany."

22 I do not propose to cite from any more of these documents. In
23 my judgment it is quite clear that as at the spring of 1996
24 the opponents did not believe they had an established
25 reputation in the words "Golden Line" as denoting their goods.
26 The question is therefore whether, on the evidence, between
the spring of 1996 and October 1996 any sufficient reputation

has been established?

1 The task facing the opponents is to establish that in a
2 short period of time a descriptive mark, Golden Line, has been
3 so used by them that it has become, to a substantial number of
4 traders and relevant public, distinctive of their goods. Mr
5 Walters drew my attention to a number of occasions in the
6 documents when the words had been used by the opponents in a
7 descriptive rather than a distinctive manner, although I think
8 it is fair to say in other circumstances the words are plainly
9 being used as being distinctive of a range of products
10 marketed by Brugmann.

11 The only evidence that I have is the evidence of Mr
12 Brickenstein. Dr Trott concluded in his decision that the
13 evidence was adequate. On page 7 of his decision he stated as
14 follows:

15 "I need to begin by assessing from the evidence submitted
16 the extent of the Opponents' goodwill in the UK at the
17 relevant date (the time of application) of 10 October
18 1996. The evidence of use is summarised above; I regard
19 the following as significant.

20 One of the two parties stated as being distributors of
21 Brugmann products confirms they fabricated goods using
22 the Opponents Golden Line "profiles" from 1989 to 1994.
23 Brochure and some invoice evidence some show supply of
24 Golden Line products to this distributor in 1993 (Exhibit
25 RB4).

26 Though there is no specific reference to the Golden Line

1 system invoices are provided showing a DM2.4 million
2 turnover in 1992 (Exhibit RB5). Significant turnover
3 figures for the Golden Line system as traded in the UK
4 from 1991 to 1997 are provided (see above).

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

9 The evidence provided in Exhibit RB6 clearly shows that
10 the Opponents' Golden Line system was promoted to the
11 trade in the UK some months before the Application was
12 filed. Aside from this promotion, the Opponents' product
13 carries the highly characteristic "gold strip" which,
14 according to Mr Brickenstein, resulted in the product's
15 name. A review of the Exhibit RB6 shows that the
16 Opponents have used GOLDEN LINE as a separate mark in the
17 UK, albeit often in conjunction with other marks, and it
18 seems clear to me 'that a name, mark or other distinctive
19 feature used by the plaintiff has acquired a reputation
20 among a relevant class of persons' and that goodwill in
21 their business is clearly established, and that this is
22 associated with the GOLDEN LINE name."

23 Dr Trott therefore relies on four matters. First, the
24 fabrication in the UK from 1989 to 1994, but, as I have
25 indicated, there is no evidence which shows how those profiles
26 were promoted to the relevant market. Second, he relies on
the brochure and invoice evidence showing the supply of Golden

1 Line. Again, however this shows no evidence of use of the
2 words Golden Line. Thirdly, he relies upon the significant
3 turnover, but again there is no evidence showing how the words
4 "Golden Line" were used in relation to the product, the
5 subject of those invoices.

6 On analysis therefore, the only weight that can be placed
7 upon the evidence is the weight that can be placed upon the
8 documents in exhibit RB6 which, as Dr Trott properly
9 concludes, clearly show the Golden Line system was promoted in
10 early 1996 to the trade.

11 I have gone through this review of the evidence in some
12 detail because where it is suggested that reputation has been
13 established in a very short time in a mark which is prima
14 facie a descriptive mark, the evidence supporting this
15 suggestion should be scrutinised with care. In my judgment,
16 it will be rare that in a period of six months this Tribunal
17 will be satisfied that a sufficient reputation has been
18 established in a mark such as Golden Line based solely upon
19 the evidence of the person using the mark with a limited
20 number of press cuttings. I do not believe such evidence is
21 adequate.

22 In the present case, it is not sufficient to satisfy me
23 that by October 1996 the opponents had enjoyed any
24 sufficiently significant reputation in the words "Golden Line"
25 simpliciter amongst the relevant trade or public in this
26 country. Such a reputation is essential to form the
foundation of an action in passing off and is therefore

1 essential to found a successful opposition under section
2 5(4) (a) of the Trade Marks Act 1994.

3 It is not for me to indicate what further evidence would
4 have been necessary. In my judgment the evidence put forward
5 is inadequate to meet the onus which resides on the opponents.

6 I have therefore concluded that Dr Trott was wrong in his
7 analysis of the evidence and that therefore the decision under
8 appeal should be set aside.

9 Dr Trott went on, having concluded that there was an
10 adequate reputation, to consider whether or not there was
11 sufficient evidence of likelihood of confusion to satisfy the
12 requirement of misrepresentation. I do not propose to deal
13 with that. Once one has concluded that the evidence as to
14 reputation is insufficient, it becomes almost impossible to
15 hypothesise as to whether, if the evidence of reputation was
16 sufficient, there would be confusion. However, on the basis
17 that the evidence filed does not satisfy me that the opponents
18 had the relevant reputation in October 1996, this appeal will
19 be allowed and the opposition will be dismissed.

20 Do you have any application with regard to costs?

21 MR WALTERS: I do not know. We did not file any evidence.
22 Obviously, we had to deal with the correspondence and this
23 appeal. They should pay the same amount, but it is up to you
24 to decide what you are doing to do with that.

25 MR THORLEY: So far as concerns costs, Dr Trott ordered that the
26 applicants should pay the sum of £535, they being successful,
but only successful on one of the three grounds raised.

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There was no oral hearing before Dr Trott and I have no doubt his assessment of the correct contribution took that into account.

I should also note that Mr Parker ordered the applicants to pay an award of costs of £200 to the opponents for the costs of the interlocutory hearing relating to the extension of time. Nothing that I say hereafter affects that order, which must stand. In my judgment plainly the order that the applicants should pay the opponents a sum should be set aside. The applicants have succeeded before Dr Trott on two of the three grounds raised against their application and they have succeeded before me on the third.

The opponents have not sought to be represented at this appeal and to that extent there has been a saving of costs. However, I have to take account of the fact that the opponents brought this opposition and they have wholly failed. In my judgment the correct order to make, both on the application and the appeal, taking the two as one, is that the opponents should pay to the applicants the sum of £750 by way of a contribution to their costs, against which, of course, the sum of £200 can be set off if it has not already been paid.

Is there anything else?

MR WALTERS: No, I do not think so.

MR THORLEY: Thank you very much for your help.

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