

**0/102/20**

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**-and-**

**IN THE MATTER OF TRADE MARK APPLICATION 3284035**

**in the name of KELLY MARKEY**

**to register the trade mark**

**HOUSE OF MERINO**

**As a trade mark in classes 24, 25 and 35**

**-and-**

**OPPOSITION NO. 413017**

**by MERINOS HALI SANAYI VE TICARET ANONIM SIRKETI**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MR OLIVER  
MORRIS, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF  
TRADE MARKS DATED 3 JUNE 2019**

**DECISION OF THE APPOINTED PERSON**

1. The Opponent, Merinos Hali Sanayi Ve Ticaret Anonim Sirketi, brings this appeal from a Decision of the Hearing Officer, Mr Oliver Morris, dated 3 June 2019.
2. The mark under Opposition is:

**House of Merino**

Registered in classes 24, 25 and 35 in respect of the following:

24: textile goods of wool, namely blankets, cushions, bedrunners, textiles and textile goods, all of the aforementioned made from merino wool or fleece

25: clothing, footwear and headgear, all being made from merino wool or fleece

35: textile goods of wool, namely blankets, cushions, bedrunners; retail services and wholesale services in connection with textiles and textile goods, namely blankets, cushions and headgear. All of the aforementioned being made from merino wool or fleece.

3. As the Hearing Officer pointed out, there is obviously an error in respect of the first line of the class 35 registration, since this lists goods rather than services (inappropriately for class 35), and replicates some of the goods listed under class 24. This line should plainly be deleted in any event.
  
4. The Opponent opposed the application under s5(2)(b), based on its own mark for the stylized word 'merinos' and under s3(1)(b) and (c). Before me, however, it limited its appeal to the s3(1)(b) and (c) grounds, based on Article 3(1)(b) and (c) of the Trade Marks Directive. Section 3(1)(b) prohibits the registration of a sign which is *'devoid of any distinctive character'*. Section 3(1)(c) prohibits the registration of signs which *'consist exclusively of signs or indications which may serve in trade to designate the kind, quality, intended purpose...or other characteristics of goods or services.'* As the CJEU remarked in the Postkantoor case C-363/99, there is a *'clear overlap in scope'* between the two provisions. Indeed, in Agencja Wydawnicza Technopol v OHIM C-51/10P, the CJEU made clear at [33] that a mark which had descriptive character sufficient to fall into the prohibited area of Article 3(1)(c) would for that reason be devoid of distinctive character under Article 3(1)(b).

5. There was no dispute that the Hearing Officer properly set out the law in respect of both provisions. In relation to Article 3(1)(c) he cited passages from the decision of Arnold J in Starbucks v BSB [2012] EWHC 3074 (Ch) including those citing the decision of the CJEU in Agencja Wydawnicza referred to above. This included [50] of that case:

*'the signs referred to in Article 7(1)(c) [the equivalent of 3(1)(c)] are merely those which serve to designate a property, easily recognizable by the relevant class of persons, of the goods or the services in respect of which registration is sought...a sign can be refused registration...only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics.'*

6. Arnold J went on to point at at [92] that a sign is caught by the exclusion *'if at least one of its possible meanings designates a characteristic of the goods or services concerned.'*

7. As the Hearing Officer pointed out, the objection to the present mark under both sections was that the mark was:

*'no more than a description of an undertaking supplying goods made to raw materials associated with a specific breed of sheep.'*

Before me, Mr Buehler of Beck Greener LLP, appearing for the Appellant, maintained the objection to the mark on essentially the same basis. If correct, this would plainly render the mark invalid under either or both sections.

8. The Hearing Officer upheld the mark. In his view, although the word HOUSE might be understood in some contexts to mean a business or undertaking, and the word MERINO might be understood to indicate wool from the Merino breed of sheep, the phrase HOUSE OF MERINO was not natural or apt to describe a business supplying goods made of Merino wool. The natural use of 'HOUSE OF X' in English would be to indicate a

house 'belonging to X'. Whilst he provided no such examples in normal non-trade mark usage, he pointed out that the trade mark HOUSE OF FRASER would fall into this category. It does not appear that any examples of normal usage of 'HOUSE OF X' in English were provided in the evidence or arguments in the case. Certainly there were no examples of HOUSE OF X being used in ordinary speech to indicate a business selling X or materials made from X.

9. In the circumstances, the Hearing Officer considered that the combination which is the subject of the mark applied for would not be recognised by the average consumer as indicating a business providing the services covered by the mark, and indeed that the combination was not one which needed to be kept free for other traders. Rather it was merely 'allusive' to the business being provided under it.
  
10. The issue which arises in this case is a relatively common one under s3(1)(b)/(c), namely whether a combination of words which is not in ordinary use but alludes in some way to the goods and services supplied under it would be taken by the average consumer as indicative of trade origin, or whether it would be taken as describing those goods or services or the business supplying them. This issue was characterized by Geoffrey Hobbs QC sitting as the Appointed Person in Cycling Is...[2002] RPC 37 at [69] as:

*'whether the perceptions and recollections the signs would trigger in the mind of the average consumer of the specified goods and services would be origin specific or origin neutral'*

11. In the present case, I agree with the decision of the Hearing Officer that the average consumer would understand the mark HOUSE OF MERINO as origin-specific. I say this for the following reasons:

- (i) The phrase HOUSE OF MERINO is made up of three words which have an English meaning but which no English speaking person would ever use in ordinary speech
- (ii) Whilst the word HOUSE is sometimes used to indicate a trading enterprise, this meaning is quite antiquated and its usage is now limited in practice to certain specific types of institution. Thus one may speak naturally of a 'publishing house', an 'investment house', a 'fashion house'. But the word cannot as a matter of ordinary English simply be attached to any form of trade with the same effect. For example one would never speak of the solicitors at Herbert Smith LLP working for a 'law house', or the founders of Leon setting up a 'fast food house'.
- (iii) The phrase HOUSE OF would never be used in ordinary speech as a generally applicable phrase to indicate a trading enterprise. The only instance of such usage of which I am aware is the phrase HOUSE OF COUTURE which was considered by the Hearing Officer Mr George Salthouse in O-292-10. It may be noted that Mr Salthouse in that case heard evidence of the common use of that specific phrase in the fashion trade to indicate a high end designer fashion business (see paragraph (8) of the Decision).
- (iv) The existence of trade marks such as HOUSE OF FRASER or HOUSE OF HOLLAND does not assist the Opponent, because they comprise the phrase HOUSE OF attached to a personal name and are obviously origin-specific trade marks.
- (v) The attachment of HOUSE OF to a physical commodity (as opposed to an individual name or a type of business) makes the phrase even less descriptive of a business. If anything the natural meaning of HOUSE OF X where X is a physical commodity would be a house actually made of that commodity ('house of stone', 'house of wood' etc.).

12. The purpose of the objection under s3(1)(b) is to ensure that marks are only registered if they can fulfil the essential function of a trade mark which (as stated for example by the CJEU in Libertel C-104/01 at [62]) is to

*'guarantee the origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin.'*

A test commonly applied in the CJEU (see for example EUROCOOL T-34/00 at [37]) in relation to marks said to be devoid of distinctive character is therefore whether they are capable of:

*'identifying the commercial origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition.'*

13. In the present case, I see no difficulty with the mark HOUSE OF MERINO fulfilling that role for any of the goods and services covered by the Application.

14. Nor do I see any invasion here of the general interest protected by s3(1)(c) namely that of:

*'ensuring that descriptive signs relating to one or more characteristics of the goods and services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services'*

[see for example Agencja Wydawnicza v OHIM C-51/10 P at 37.]

The phrase HOUSE OF MERINO is not in my view one which traders would ever use or legitimately wish to use for descriptive purposes to indicate the goods or services for which it is applied.

15. On this Appeal, Mr Buehler placed considerable reliance on the alleged inconsistency between the Hearing Officer's decision and the findings of the General Court in a case involving a mark of similar type - HOUSE OF CARS Case T-364/17.
16. Whilst it is understandable that an Opponent wishes to draw attention to a decision in which a mark of similar type was refused, there is no point in citing a decision unless it establishes or supports a particular proposition of law. So far as I can see, there is nothing in HOUSE OF CARS which breaks new ground so far as the law is concerned. So far as the factual basis of the refusal of the mark in that case is concerned, it may be noted from paragraph [27] of the General Court's Judgment that the Board of Appeal (with whom the Court agreed) proceeded on the basis of an online dictionary extract according to which the word HOUSE was said to be 'synonymous' with a number of words including 'business' and 'group of undertakings'. As will be apparent, I do not believe that is an accurate or complete account of the way the word HOUSE is used in ordinary English outside certain specific phrases and types of business.
17. I therefore reject this Appeal.

**IAIN PURVIS QC**  
**THE APPOINTED PERSON**  
**18 February 2020**