

O-292-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION  
No. 2493356 BY HOUSE OF COUTURE LIMITED  
TO REGISTER THE TRADE MARK  
HOUSE OF COUTURE  
IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No. 98356 BY  
COUTURE POUR HOMME LIMITED**

## **BACKGROUND**

- 1) On 22 July 2008, House of Couture Limited (hereinafter the applicant), applied to register the trademark HOUSE OF COUTURE for the following goods “Occasional Wear, Bridal Wear, Clothing, footwear, headgear”.
- 2) The application was examined and accepted. The trade mark was subsequently published for opposition purposes on 5 September 2008 in Trade Marks Journal No.6751.
- 3) Couture Pour Homme Limited (hereinafter the opponent), filed a notice of opposition, subsequently amended, dated 1 December 2008. The grounds of opposition are in summary that the mark offends against Section 3(1)(b) and 3(6). Prior to the hearing the opponent withdrew the ground of opposition under Section 3(6).
- 4) On 16 February 2009 the applicant filed a counterstatement which denied the opponent’s claim.
- 5) Both sides filed evidence, and both parties seek an award of costs in their favour. The matter came to be heard on 29 July 2010. At the hearing, the opponent was represented by Ms Szell of Messrs Venner Shipley, the applicant was represented by Ms Susan Goodchild.

## **OPPONENT’S EVIDENCE**

- 6) The opponent filed two witness statements. The first, dated 7 July 2009 by Stephen Alexander Goodchild the sole director and shareholder of the opponent company. Mr Goodchild was, until 2004, married to Susan Goodchild. He describes the divorce as “acrimonious”. As all of his evidence goes to the bad faith ground which has now been abandoned I shall not summarise his statement.
- 7) The second witness statement, dated 7 July 2009, is by Edward Carstairs, the opponent’s Trade Mark Attorney. He provides the following assessment of the word COUTURE:

“4. The application at issue includes the word “couture” which means “the design and manufacture of fashionable clothes to a client’s specific requirements and measurements” (The New Oxford Dictionary of English; Clarendon Press, Oxford 1998, copy at page 1 of EC1). The attention of consumers of the products specified by the applicant will be high because it is common for consumers to carefully consider their options when purchasing clothing, footwear and headgear, and particularly in terms of bridal wear and occasion wear. As a result, consumers will recognise that the word “couture” describes that the clothing, for example, is designed and manufactured to their specific requirements. Therefore, the word “couture” is non-distinctive in respect of goods specified by the applicant.”
- 8) Mr Carstairs also refers to a recent exhibition at the “V&A Museum” where the word “couture” was used in a descriptive manner such as “for France, the couture industry was vital to the economy”. He states that the term “House of couture” is usually used in association with the

name of a famous designer. At exhibit EC1 he provides copies of internet searches for the term along with the names of a number of famous designers such as Dior, Givenchy and Guy Laroche. On each search the narrative states that the named designer “established his house of couture in Paris” or very similar wording. It is clear, he asserts, that it is the name of the designer that is distinctive and designates trade origin, not the term “House of Couture”. He contends that the term “House of Couture” merely informs the public of a characteristic of the goods, namely that it has been custom fitted. He states that the mark in suit is laudatory and descriptive, informing the public that the goods are from a high-end fashion house and custom fitted rather than off the peg.

### **APPLICANT’S EVIDENCE**

9) The applicant filed a witness statement, dated 29 January 2010, by Susan Janet Goodchild the sole director of the applicant company. Ms Goodchild states that the trade mark in suit was first used in the UK in 1992 when the company was incorporated although it began trading as House of Couture Ltd in 1994. Later in her statement she states that she wishes to register the mark to “secure our trade name of more than 17 years”, presumably referring back to the incorporation date. She states that the mark in suit has been used on a wide range of ladies and children’s wear.

10) She provides the following turnover figures which, I presume refer to the goods and services (design tailoring etc) provided which would include sales of dresses under both her own brands and the brands of others:

Year	Turnover £
1995	61,183
2001	184,016
2004	313,183
2005	189,478
2006	184,978
2007	176,701

11) Ms Goodchild claims that advertising is said to be approximately 5% of turnover. She claims that “couture” is French for “the design and manufacture of fashionable clothes to client’s requirements”, and “house of” describes the home of. She contends that when she started using the mark it was unusual to mix English and French words and it was grammatically incorrect. She also refers to other marks registered or state of the register evidence. I note from the evidence that the applicant was also using “Femme” and “Femme Couture” as trade marks on clothing. It is contended that the applicant’s website receives a significant number of “hits” per day, in January 2001 said to be 300,000 per day. However, I am aware that as used in relation to the World Wide Web, “hit” means a single request from a web browser for a single item from a web server; thus in order for an individual’s web browser to display a page that contains three graphics, 4 “hits” would occur at the server: one for the HTML page itself, and one for each of the three graphics displayed on that page. So a user downloading a single web page with many graphic elements will generate many hits. She also provides the following exhibits:

- Exhibit SG1: copies of pages from the web, there is a date which shows “weddings dresses for 2009-2010”, another refers to a preview of the 2009 dresses. Both are after the relevant date.
- Exhibit SG2: copy of a page from a website for “House of Couture” which shows a “created” date of 13 August 1998, and an updated date of 12 August 2008. So the actual date of the page shown is after the relevant date.
- Exhibits SG3 & 4: These are said to be invoices which show the mark “House of Couture” on the top in relation to the sale of two wedding dresses, both in January 2002.
- Exhibits SG5 & 6: These consist of two photographs of shop fronts. The first, said to date from 1993, shows use of the marks “Couture pour Femme” and “Couture Design by Sue Goodchild”. The second photograph said to date from January 2010 shows “House of Couture” with the initial downward stroke of the letter “H” in “House” and the letter “T” in “Couture” having a female shape within them. The second photograph is after the relevant date.
- Exhibit SG7: This is the “story” of the applicant taken from the website. I note that it states that her line of dresses is sold under the “Femme” and “Femme Couture” labels. It refers to “For the couture bride.” The pages from the applicant’s website are undated.

## **OPPONENT’S EVIDENCE IN REPLY**

12) This is a second witness statement, dated 15 April 2010, by Stephen Goodchild. Much of the statement and a number of the exhibits relate to the issue of bad faith and are not germane to my decision. The statement also contains submissions on the issues which I shall not summarise. At exhibit SAG11 he provides a copy of his witness statement and exhibits dated 13 April 2010, which was filed in the opposition case 98386 filed by Mr Gordon Selvage against the application which is the subject of the instant decision. Mr Goodchild provides copies of documents filed at the time of his divorce signed by Ms Goodchild which state that from 1997 she was semi retired, and that the company House Of Couture Ltd was owned by her daughter, this contradicts the opening statement in Ms Goodchild’s witness statement (above) although it might be that things have changed since the filing of the Court papers. Mr Goodchild also states that prior to meeting Mr Selvage, Ms Goodchild never used the mark “Femme” on any of the bridal wear she sold, nor in connection with her business. He states that in 2003 he erected a sign over both shops (17-19 Billet Lane) with the word “Couture” in the middle and over his shop the words “Pour Homme” and over Ms Goodchild’s shop the words “Par Femme”. He states that in 2005 he removed the signage over both shops and put up new signage on his shop. He claims that Ms Goodchild’s shop did not replace the signage until August 2009. He states that the new sign was “House of Couture” which he states was previously only used on the shop’s website.

## **APPLICANT’S FURTHER EVIDENCE**

13) Along with her submissions for the hearing Ms Goodchild also provided further exhibits which she claims shows the use made by her of the mark in suit. Although the opponent had very

little time to view these and no opportunity to respond I decided, in this case, to allow the documents into the case as evidence. This consists of five exhibits which are described below:

- EXA: This is a copy of a web page from an archive site which shows “House of Couture” used in relation to clothing on 11 April 2001.
- EXB: Court papers dated 4 December 2006 in relation to the divorce of Mr And Mrs Goodchild which refers to Mrs Goodchild retaining the business “House of Couture”.
- EXC: An extremely bad photograph of two shop fronts which shows the word “Couture” on the fascia above both shops.
- EXD: This photograph shows one shop with the words “Couture Pour Homme” on the fascia whilst the other has “URE Par Femme”. This is after the fascia was cut in half by Mr Goodchild in 2008.
- EXE: An email from Mr Goodchild to Ms Goodchild indicating that he has been in contact with Mr Selvage.

14) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

15) The sole ground of opposition is under Section 3(1)(b) which reads:

“3(1) The following shall not be registered ...

(b) trade marks which are devoid of any distinctive character...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b) ... . above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

16) When considering the issue of distinctiveness under Section 3(1) (b) of the Act I adopt the approach summarised by the ECJ in its judgment in *Linde AG, Windward Industries Inc and Rado Uhren AG* Joined Cases C-53/01 to C- 55/01:

“37. It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods and services of one undertaking from those of other undertakings.

.....

39. Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40. For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41. In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C- 210/96 *Gut Springenheide and Tusky* [1998] ECR I- 4657, paragraph 31, and *Philips*, paragraph 63).

.....

47. As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.”

17) I must determine whether the trade mark applied for is capable of enabling the relevant consumer of the goods in question to identify the origin of the goods and thereby to distinguish them from other undertakings. In *SAT.1 Satelliten Fernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-329/02* the ECJ provided the following guidance:

“41 Registration of a sign as a trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings.”

18) In *Cycling Is... Trade Mark*, [2002] R.P.C. 37, Mr Hobbs QC stated:

“67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the minds of the relevant class of persons or at least a significant proportion thereof.

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the minds of the relevant class of persons.

69. The difference between these two positions resides in the question 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.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.”

19) I must therefore consider the issue from the perspective of someone who encounters the mark “House of Couture” used in relation to, broadly, clothing, footwear and headgear and determine how that person would react. The evidence shows that the words “house”, “of” and “couture” are all recognised words used in the English language and found in any dictionary. The applicant’s point regarding “couture” being of French origin is accepted as with most of our language it has been adopted and is now an “English” word. When used in relation to clothing etc the words “House of” have resonance for the average consumer as they are used to refer to “fashion houses” where the word “house” refers to the establishment or enterprise. As the evidence also shows references to such establishment are usually have the designer’s name as a prefix or suffix. The term “house of couture” also appears in the evidence again with a particular designer’s name acting as the indicator of origin, usually just the surname such as Dior or Givenchy. The mark in suit merely conveys the meaning of an establishment where clothing etc is tailored to your specific requirements, it does not act as an indicator of origin.

20) To my mind the average consumer “who does not know there is a question” would consider HOUSE OF COUTURE to be devoid of any distinctive character for all the goods applied for and would be asking whose house of couture it was. They would not find that it functioned as an indication of origin. As such, I find that the ground based upon Section 3(1) (b) of the Act must succeed.

21) Having made this finding I now turn to consider the issue of whether the applicant’s mark has acquired distinctiveness through use. Although not originally pleaded in the counterstatement it was clear from both the counterstatement and the evidence filed subsequently that it was a position which the applicant was adopting. In this case, I am therefore willing to consider the issue despite it not being explicitly pleaded.

22) It is clear from all of the evidence that the sign above the shop was until after the relevant date, 22 July 2008, the word “Couture” or part of the word “ure”. In addition the fascia had the words “par femme”. It is also clear that the applicant’s goods carried a label of either “femme” or “femme couture”. In addition the shop also sold goods from other manufacturers under different brands. The only use of the mark applied for prior to the relevant date would appear to be on the website for the business. The turnover and advertising figures do not relate solely to the mark in suit or indeed to the goods applied for bearing in mind the applicant offers a design service and also tailoring services. In my opinion the applicant has not demonstrated that the mark in suit has acquired any distinctiveness. The ground of defence therefore fails.

## **COSTS**

23) As the opponent has been successful it is entitled to a contribution towards costs. I take into account the fact that the opponent only dropped the ground of opposition under Section 3(6) after all of the evidence rounds were complete. I order the applicant to pay the opponent the sum of

£1,200. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16 day of August 2010**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**