

**O/562/17**

**TRADE MARKS ACT 1994**

**APPLICATION No. 3160294 BY KENNETH TURNER LIMITED**

**TO REGISTER A TRADE MARK IN CLASSES 3, 4, 21 & 35**

**AND**

**OPPOSITION No. 407520**

**BY NEILL STRAIN FLORAL COUTURE LIMITED**

## Background and pleadings

1. This is an opposition by Neill Strain Floral Couture Limited (“the opponent”) to an application filed on 19<sup>th</sup> April 2016 (“the relevant date”) by Kenneth Turner Limited (“the applicant”) to register the mark shown below.



2. The application covers goods/services in classes 3, 4, 21 and 35. The full list of goods and services is set out in annex A. It is sufficient to note that it includes services in class 35 for the retailing of flowers and various goods that are, or could be, fragranced with flowers, or used to hold or display flowers.

3. The opposition is based on the opponent’s claim to an earlier right in the words FLORAL COUTURE or FLORAL COUTURE LONDON, as a result of the use of those words (in conjunction with the name Neill Strain) since April 2008 in relation to goods/services which are the same or similar to those in the application.

4. According to the opponent, use of the contested mark would amount to a misrepresentation to the public which would damage the goodwill generated under its unregistered trade marks. The opponent therefore asks for the application to be refused under s.5(4)(a) of the Trade Marks Act 1994 (“the Act”).

5. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular, that the applicant denied that either of the signs relied on by the opponent was distinctive of the opponent’s business.

## The evidence

6. The opponent's evidence consists of a witness statement by Neill Strain, who is the creative director and founder of the opponent.

7. The applicant's evidence consists of a witness statement by Harry Nugent, who is the managing director of the applicant's company.

8. Mr Strain's evidence is that he:

- came up with the name FLORAL COUTURE in or around July 2007;
- was inspired by the term 'haute couture' that is used in the fashion industry to refer to the highest quality fabrics and designs;
- wanted a brand name that imported the same high quality and high standards into the floral industry;
- was not aware of any previous use of FLORAL COUTURE in the floral industry;
- considered the juxtaposition of these words unique and unnatural;
- began trading as a florist under the earlier marks in April 2008;
- incorporated the opponent in 2010 and continued trading through that company.

9. Mr Strain further says that:

- the opponent is predominantly a provider of floral design services;
- this includes ready-to-buy bouquets and floral displays, but also bespoke floral design services for homes, venues and events, such as weddings;
- the opponent also sells a large range of related goods, such as candles, candle vessels, table decorations, Christmas decorations and plant accessories such as vases and pots;
- the opponent sells its goods and provides its services from a boutique in Belgravia, London, called 'Neill Strain Floral Couture London';

- the opponent also sells its goods via its website at neillstrain.com;
- the website received around 1200 visitors in March 2016 and over 2000 in April 2016;
- the opponent also promotes its business through social media; it has over 10k 'likes' and followers on Facebook;
- the opponent works for private clients and celebrities, such as Lady Gaga, Donatella Versace and the royal families of four Middle Eastern countries.

10. The opponent's turnover in 2014 was over £700k. In 2015 it rose to over £900k.

11. In 2014 the opponent spent around £40k on sales promotions and £700 on advertising. In 2015 it spent £35k on sales promotions and around £9k on advertising. This included PR and media services (61%), printed promotional materials (22%) and social media (10%).

12. Mr Strain exhibits various material showing how the marks claimed as earlier rights are used. These include examples of the mark(s) on bags used to deliver flowers,<sup>1</sup> candles,<sup>2</sup> pages from the opponent's website,<sup>3</sup> extracts from the opponent's social media sites<sup>4</sup> and invoices sent to customers.<sup>5</sup> In each case the opponent is identified by this mark.



13. The opponent's social media sites also include the same words written in standard script, i.e. with the words FLORAL COUTURE in the same size letters as those used for the other words in the mark.

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<sup>1</sup> See NS1

<sup>2</sup> See NS2

<sup>3</sup> See NS3

<sup>4</sup> See NS4

<sup>5</sup> See NS7

14. The opponent's shop in Belgravia looks like this:



15. As can be seen, the words Neill Strain are again the most prominent identifier of the opponent's business. I also note that, unlike the name London, the words 'floral couture' have all their letters in lower case. They do not look like a name of the business.

16. However, Mr Strain states that:

“[The opponent] has also featured on Channel 4 in a television programme called "The World's Most Expensive Christmas". The programme was first broadcast on 14 December 2015, and was re-broadcast in December 2016. The programme was about how UK-based millionaires and billionaires celebrate Christmas, and in particular their spending habits. [The opponent] featured as we provided floral services to a Middle Eastern couple in respect of their London home with a budget of £250,000. [The opponent's] business was referred to as "Floral Couture" both throughout the programme and in the accompanying programme guides. The programme was the 4th most watched programme on Channel 4 in the week it was first broadcast. Exhibit NS10 hereto consists of a print from Channel 4's website relating to that show and an article from the production company Twofour.”

17. The programme itself is not in evidence, but an extract from Channel 4's online press information about its Christmas 2015 programmes is in evidence.<sup>6</sup> The last entry relating to the programme 'The World's Most Expensive Christmas' refers to the opponent's business. It says:

"Neill Strain, of Floral Couture, is a florist to some of Belgravia's elite. Neill specialises in private clients, who retain his services on a weekly basis all year-round, some paying as much as £10,000 to £20,000 every week for his floristry delights."

18. A similar article appeared on the production company's website under a picture of Mr Strain.<sup>7</sup> The Channel 4 programme was the subject of an article on the website of the Daily Mail, which described Mr Strain and his business in identical terms. Mr Strain says that this shows that 'Floral Couture' identifies his business.

19. In support of this claim Mr Strain exhibits the results of searches he conducted on Google in 2016 for 'floral couture' and 'floral couture London'.<sup>8</sup> He points out that most (although not all) of the results on the first 2 pages relate to his business.

20. As to the applicant, Mr Strain states that:

- Kenneth Turner, the former principal of the applicant has worked in the floral industry since around 1970;
- prior to April 2016 neither the applicant, nor Mr Turner, had used the sign FLORAL COUTURE;
- on 29<sup>th</sup> April 2016 the applicant announced that it was re-branding and intended to use the contested mark;
- given the opponent's reputation in the floral industry, the applicant must have chosen the contested mark with the intention of trading off the opponent's goodwill.

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<sup>6</sup> See NS10

<sup>7</sup> See NS10

<sup>8</sup> See NS13

21. In support of this claim, Mr Strain points out that, in his view, the styling of the contested mark is similar to the opponent's logo mark (as shown at paragraph 12 above). In particular:

- the arrangement of the words in a tiered format with the name at the top, the words FLORAL COUTURE on the line below, and the word LONDON at the bottom;
- the highly similar font used by the applicant, "*featuring clean lines, without serifs, and more prominent first letters*" together with the similar relative sizes of the words;
- The use of a floral design in conjunction with the words, despite the fact that the applicant does not currently sell flowers (according to Mr Strain, it is "*a retailer of florist-themed homewares*").

22. Finally, Mr Strain stated that, as a back-up position, if the Tribunal does not agree that the opponent's goodwill is distinguished by the words FLORAL COUTURE [LONDON], then he says that it is distinguished by NEILL STRAIN FLORAL COUTURE. This is how the opponent's suppliers refer to it.<sup>9</sup> In that event, use of the contested mark by the applicant would still constitute a misrepresentation to the public.

23. Mr Nugent has 13 years' experience in the flower business. According to Mr Nugent, the annual retail market for flowers in the UK is worth £2.2 billion. In that context, the opponent's market share is miniscule. Additionally, Mr Nugent points out that, as Mr Strain admits in his "Backup Position", the use of FLORAL COUTURE the opponent relies upon is tied to the use of the name NEILL STRAIN.

24. Mr Nugent exhibits 29 documents illustrating third party uses of FLORAL COUTURE, which he says, "*demonstrate that no one person could possibly claim exclusivity in the common phrase FLORAL COUTURE.*"

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<sup>9</sup> See NS8

25. It is not necessary to describe each of these documents. The most relevant are as follows.

- Undated pages from the website wildfloralcouture.co.uk showing a business trading under that name and selling floral wedding packages;<sup>10</sup>
- Undated pages from a UK website for 'Willcox Tuckey Floral Couture' who sell flowers for weddings;<sup>11</sup>
- A Facebook page for a florist in Lancashire called 'Honey's Hideaway Floral Couture';<sup>12</sup>
- An extract from a website (in 2017) showing that 'Pure Bliss Floral Couture' advertises floral displays for UK events;<sup>13</sup>
- A similar website extract showing that 'Do Boutique' uses 'floral couture' as a description and provides "*cutting edge floral design, styling and set design*";<sup>14</sup>
- A webpage for 'Beaufort Blooms Floral Couture' in the Cotswolds, which provides bridal flowers;<sup>15</sup>
- An extract from The English Wedding Blog with an entry from 'Rosalind Miller Cakes' for wedding cakes with flowers marketed as the 'Floral Couture Collection 2014';<sup>16</sup>
- An advertisement from a website called 'Chelsea Fringe' for an "*Evening of Floral Couture and Cocktails*" on 3<sup>rd</sup> June 2015 featuring "*alternative floristry*";<sup>17</sup>
- A UK webpage for 'Floral Today' on which 'Floral Couture' appears to be used as a descriptive heading amongst other similarly descriptive headings;<sup>18</sup>
- The Facebook page of 'Keziah Rose Floral Couture' (plainly UK) showing numerous pictures of flowers above the apparent description 'Floral Couture'.<sup>19</sup>

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<sup>10</sup> See HN7

<sup>11</sup> See HN8

<sup>12</sup> See HN11

<sup>13</sup> See HN13

<sup>14</sup> See HN14

<sup>15</sup> See HN19, page 3

<sup>16</sup> See HN19, page 4

<sup>17</sup> See HN10, page 6

<sup>18</sup> See HN19, page 7

<sup>19</sup> See HN19, page 12

## **Representation**

26. The applicant is represented by Dolleymores, trade mark attorneys. The opponent is represented by Kyriakides & Braier, solicitors. A hearing took place on 2<sup>nd</sup> November 2017 at which David Ivison appeared as counsel for the applicant. Charlotte Blythe appeared as counsel for the opponent.

## **Pleading point**

27. It became apparent at the hearing that the opponent was seeking to rely on three earlier rights, including NEILL STRAIN FLORAL COUTURE. This sign was not pleaded as an earlier right in the notice of opposition. When I pointed this out, Ms Blythe asked for leave to amend her client's pleadings so as to add this further claimed earlier right. In this connection, Ms Blythe pointed out that the opponent had signalled its intention to rely on this third earlier right by the reference in Mr Strain's witness statement to the opponent's 'backup' position.

28. Mr Ivison resisted the amendment. He submitted that it was made too late.

29. I noted that the applicant's witness had commented upon the opponent's 'backup' position in the evidence filed in response to Mr Strain's statement. Therefore, there was no question of the amendment taking the applicant by surprise. Further, the additional earlier right depended on the same evidence. What it added was purely a matter of law. And one that was closely linked to the existing pleaded case. Further, it is preferable, in principle, that all the potential issues between the parties are settled in one go. I could see no prejudice to the applicant in permitting the amendment. I therefore allowed it.

## **The law**

30. Section 5(4)(a) states:

“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 an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

31. The basic requirements to establish a passing off right are well established and are not in dispute. They are, essentially, (1) goodwill in a business identified by a sign, (2) a misrepresentation (or prospective misrepresentation) by the defendant through the use of a sign similar enough to the claimant’s sign to mislead (intentionally or otherwise) a substantial number of the claimant’s customers or potential customers into believing that the defendant’s goods or services are those of the claimant, or are connected with the claimant, and (3) damage to the claimant’s goodwill caused by the defendant’s misrepresentation.

32. There is no dispute that the opponent operates a business and no real dispute that the business has acquired sufficient goodwill to justify protection under the law of passing off. The issue between the parties is whether FLORAL COUTURE is distinctive of that business (or any similar business).

33. The opponent submits that although FLORAL COUTURE is made up of everyday English words, the combination is new and unique. Mr Strain’s evidence is that he was not aware of any use of that term when he coined it in 2007. Therefore the term is more than the sum of its parts and conveys the impression of flowers of the highest quality and of exemplary fashion-led design.

34. The opponent does not accept that the distinctiveness of the term is undermined by the applicant’s evidence of third party uses of FLORAL COUTURE. Insofar as they relate to the UK at all, the opponent points out that the uses are (mostly) parts of trade names. If anything, this suggests that the term is seen by those in the

floristry industry as capable of distinguishing one business from another. Further, there is no evidence as to the size or length of the third party businesses in question. In any event, the opponent points out that it is not necessary to show that the term FLORAL COUTURE is exclusively distinctive of its business. In this connection, the opponent relies on the statement of the law by Laddie J. in *Associated Newspapers Ltd v Express Newspapers*,<sup>20</sup> where the judge stated that:

“28. .... there is no requirement in the law of passing off that the claimant's reputation has to be exclusive. There have been a number of cases where a claimant has succeeded even though he was not the only trader with a reputation in the mark. A newcomer who adopts a mark employed by more than one competitor and thereby deceives the public harms each of them. There is no reason in principle and no authority which suggests that because a number of proprietors are harmed, none of them can seek to restrain the interference with their trade.”

35. According to the opponent, the words FLORAL COUTURE have acquired a secondary meaning as the name of its business. It is submitted that this can be seen from the way in which the business was described in the Channel 4 TV programme broadcast in December 2015, and in the associated press article in the Daily Mail. Both of these referred to “*Neill Strain of Floral Couture.*” (Emphasis added)

36. The applicant submits that FLORAL COUTURE is, at least, highly allusive to the high fashion connotations of the word ‘couture’, which the Shorter Oxford Dictionary defines as follows:

**“couture**

Dressmaking; (the design and making of) fashionable garments, esp. French ones.

Haute Couture, Maison de couture

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<sup>20</sup> [2003] FSR 51

- **couturier** ... **noun** a fashion designer, esp a leading French one  
... **couturiere** ... **noun** a female dressmaker or couturier”

37. According to the applicant, this means that:

“...the use of the word “couture” in relation to floristry, or events or products which involve the use of flowers, will signify to the reader that the flowers have been used in an artful way, and will lead to an association with the concept of famous “haute couture” fashion designers and houses, and consequentially with an air of exclusivity and luxury.”

38. In this connection, the applicant points out that Mr Strain himself states in his witness statement that:

*“...I came up with the term FLORAL COUTURE. To me, it perfectly suited and subtly reflected the fact that my flowers are the “haute couture” of flowers.”*

39. The applicant relies on the use of the same term in analogous ways by third parties as indicating that the public will understand the term as meaning ‘the haute couture of flowers’.

40. As to the opponent’s claim that FLORAL COUTURE has acquired a secondary meaning as the name (or at least a name) for its business, the applicant submits that the ways in which the opponent has used the term and the far greater prominence given to the name Neill Strain, and indeed to Mr Strain himself, in the promotion of the business undermines any argument that FLORAL COUTURE has become distinctive of the opponent’s business through use.

41. In my view, although the words FLORAL COUTURE are not a literally or grammatically correct description of a floristry business, the term is nevertheless (at least) highly allusive of high-end flower arrangements/decorations and associated floral design services. Depending on how they are used, these words are capable of sending a purely descriptive message. Looking at the ways in which the opponent

has used the term within its business name, I have no doubt that that is how it would have been perceived by the opponent's customers and potential customers.<sup>21</sup>

42. I agree with the applicant that this analysis is consistent with the way that third parties in the flower business have used the term.

43. As to the use of "*Neill Strain of Floral Couture*" in the Channel 4 TV show and associated press report, I note that:

- (1) This is an (or possibly two) isolated example(s) of third parties using Floral Couture apparently as a name of the business;
- (2) The uses are by journalists, not customers of the opponent;
- (3) The use in the Daily Mail adopted the wording of Channel 4's description of Mr Strain and his floristry business.

44. In my judgment, this evidence comes nowhere near establishing that the opponent's customers or potential customers regarded FLORAL COUTURE as the name of, or as being otherwise distinctive of, the opponent's business. The only evidence in the case which sheds direct light on the significance that the opponent's customers attached to the term FLORAL COUTURE comes from a post on the opponent's Facebook site.<sup>22</sup> It was posted by Andrew Wright on 17<sup>th</sup> May 2014. He wrote that Neill Strain had provided exquisite creations for a friend's birthday party. In Mr Wright's view, "*Neill Strain is one of the chicest floral couturiers in London.*" Mr Wright obviously considered FLORAL COUTURE as descriptive of the opponent's business. Looking at the way that the opponent has used the term, this is exactly the reaction I would have expected. Ms Blythe pointed out that Mr Wright's post was but a single instance of a customer using *floral couturiers* in a descriptive sense. That is true, but it is one instance more than any customer using FLORAL COUTURE in a distinctive sense. Ms Blythe also pointed out that Mr Wright's post was made nearly two years prior to the relevant date. That is true. However, as the nature of the opponent's use of FLORAL COUTURE remained the same up until the relevant

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<sup>21</sup> See, by analogy, the decision of Phillip Johnson as the Appointed Person in *Mariage Frères v TWG Tea Company Pte Ltd*, BL O/358/17 at paragraphs 44, 45 and 58.

<sup>22</sup> See NS4, page 1

date, I see no reason why Mr Wright would have thought any different at the later date.

45. I conclude that the evidence does not establish that FLORAL COUTURE or FLORAL COUTURE LONDON was distinctive of the opponent's business at the relevant date. This applies whether I consider the position in the UK as a whole, or just in London. It follows that the opposition under s.5(4)(a) based on these signs is rejected.

46. Turning to the opponent's third claimed earlier right – NEILL STRAIN FLORAL COUTURE – there is no dispute that this name is associated with the opponent's goodwill.<sup>23</sup>

47. However, given my finding that FLORAL COUTURE is not distinctive of the opponent's business, it is hard to see why the use of these words in the contested mark should mislead any of the opponent's customers or potential customers into assuming that there is a connection between the parties. After all, the dominant (because it appears first and usually in larger letters) and obviously distinctive element of NEILL STRAIN FLORAL COUTURE, is NEILL STRAIN. By contrast, the dominant and distinctive elements of the contested mark are plainly the name KENNETH TURNER and the floral K device. The words FLORAL COUTURE are relatively much smaller. They barely constitute a secondary element of the mark. And in context in which they appear, they look descriptive.

48. The opponent submits that the public may believe that common use of FLORAL COUTURE indicates that the applicant is another branch of the opponent's business, or that the opponent has endorsed the applicant. However, these points depend upon the public perceiving FLORAL COUTURE as a distinctive sign. For the reasons I have given, I find that the public would regard those words as merely descriptive of the opponent's goods and services. Therefore no one would have cause to believe that the applicant's use of those words indicated a trade connection with the opponent. Additionally, one would have thought that if someone of Mr Strain's

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<sup>23</sup> See paragraph 19 of the skeleton argument served on behalf of the opponent.

apparent status as a florist wanted to endorse another trader in the same field, or selling spin-off products, the normal way to do that would be to lend his name or image. In my view, both the suggested possible causes of misrepresentation are unlikely to the point of being farfetched. I reject them.

49. In reaching these conclusions I have taken into account the opponent's argument, set out at paragraph 21 above, that the applicant must have copied its unregistered mark. The applicant's witness did not specifically deny copying. In essence, Mr Nugent's response was simply one of incredulity that the opponent could claim an exclusive right to FLORAL COUTURE. I have considered the opponent's argument about copying against this background, but I see nothing in it. This is because the presentation of words on three tiers is not unusual in logo type marks. To my eye, the font used for the applicant's mark does not look particularly similar to the font used for the opponent's logo mark, and neither font is unusual or striking. The use of larger letters for the first letter of the parties' names is hardly original or distinctive. And the fact that the applicant has not yet used the mark in relation to the sale of flowers is irrelevant.

50. I am left with the impression that the opponent believes that as Mr Strain coined the term FLORAL COUTURE he, or now it, is entitled to a quasi-copyright in the combination of those words. However, this is a misconception. Intellectual property law does not create rights every time two existing words are used together for the first time. If it did, the language would quickly become propriety and inaccessible. The law of passing off protects signs used to distinguish a business. I am not satisfied that the words FLORAL COUTURE have served that purpose.

## **Outcome**

51. The passing off right claim fails. The opposition is rejected in total.

## **Costs**

52. I gave the parties an outline of my decision at the conclusion of the hearing. This prompted Mr Ivison to ask for off-scale costs on the grounds that his client had been

put to significant cost defending a hopeless opposition that ought never to have been brought. However, he stopped short of characterising the opponent's actions as vexatious.

53. Ms Blythe submitted that costs should be awarded on the usual scale. She said that the opponent had a genuine belief in his case and had acted accordingly.

54. I see merit in Mr Ivison's submission. This is one of the weakest passing off type cases I have dealt with. However, I see nothing to indicate that it was vexatious or that the opponent did not have a genuine belief in its case. Misjudging the strength of one's case does not constitute unreasonable behaviour such as to justify off-scale costs. And absent exceptional circumstances, parties have a right to expect that costs awards will reflect the published scale. I will therefore stick to scale costs, but use the discretion provided by Tribunal Practice Notice 2/2016 in order to compensate the applicant as fairly as possible.

55. I calculate costs as follows.

£600 for considering the notice of opposition and filing a counterstatement;  
£2000 for filing evidence and considering the opponent's evidence;  
£1000 for attending a hearing and preparing a skeleton argument.

56. I therefore order Neill Strain Floral Couture Limited to pay Kenneth Turner Limited the sum of £3600. This to be paid within 14 days of the end of the period allowed for appeal.

**Dated this 8<sup>th</sup> day of November 2017**

**Allan James  
For the Registrar**

## **ANNEX A**

### **Class 3**

Soaps; perfumery; essential oils; cosmetics; hair lotions; shampoo; conditioner; bath gel; shower gel; bath oil; body lotion; eau de toilette; cotton wool; bath salts; handwash; pot pourri; pot pourri refresher oil; perfumed room sprays; room fragrances; room fragrancing preparations; room fragrancing products; room fresheners; room scenting sprays; skincare preparations; haircare preparations; parts and fittings for all the aforementioned.

### **Class 4**

Candles; wax; wicks; candle assemblies; parts and fittings for all the aforementioned.

### **Class 21**

Household or kitchen utensils and containers (not of precious metal or coated therewith); articles for cleaning purposes; glassware, porcelain and earthenware not included in other classes; bone china and china, porcelain, ceramics, tableware and decorated tableware, plates, cups, mugs, saucers, crystal, vases, glasses; candle holders; candle sticks; candelabras; bowls; ice buckets; candle snuffers; parts and fittings for all the aforementioned.

### **Class 35**

Retail services relating to the sale of figurines, works of art, bottle stoppers, hand tools, hand implements, wick trimmers, scissors, candle sharpeners, lighters, candle lighters, matches, flowers, plants, preserved and dried flora, plant parts, bark, leaves, roots, foliage, mosses, lichens, grasses, fruits and vegetables, flower decorations, soaps, perfumery, essential oils, cosmetics, hair lotions, shampoo, conditioner, bath gel, shower gel, bath oil, body lotion, eau de toilette, cotton wool, bath salts, handwash, pot pourri, pot pourri refresher oil, perfumed candles, perfumed room sprays, room fragrances, room fragrancing preparations, room fragrancing products, room fresheners, room scenting sprays, skincare preparations, haircare preparations, candles, wax, wicks, candle assemblies, household or kitchen utensils and containers, articles for cleaning purposes, glassware, porcelain and

earthenware, bone china, china, porcelain, ceramics, tableware, plates, cups, mugs, saucers, crystal, vases, glasses, candle holders, candle sticks, candelabras, bowls, ice buckets, candle snuffers and parts and fittings for all the aforementioned.