

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**UK TRADE MARK APPLICATION 2648997 BY SUPERCREASE LIMITED**

**TO REGISTER THE SIGN STAY SHARP**

**IN CLASS 25**

---

**DECISION**

---

**Introduction**

1. In the present case the Registrar of Trade Marks has refused the request of Supercrease Limited (*‘the Applicant’*) to register the trade mark:

**STAY SHARP**

for use in relation to the following goods in class 25:

Clothing footwear and headgear

2. On the 7 February 2013, the examiner at the UK IPO issued an examination report stating that the sign was not acceptable as there was an objection under Section 3(1)(b) of the Trade Marks Act 1994 (*‘the Act’*). The objection by the examiner (1) was supplemented by a reference to the mark’s capacity to be used in respect of clothing which “enables the wearer to stay stylish” and which “retains sharp lines”; and (2) made reference to the Collins dictionary in which ‘sharp’ is defined as ‘stylish’.
3. Subsequently the attorney acting for the applicant and the examiner entered into correspondence. In the course of that correspondence the examiner produced the results of an internet search on the phrase ‘clothing with a sharp look’ which purportedly showed use of the word ‘sharp’ in the context of clothing.
4. A hearing was requested which took place on 14 May 2013 by telephone before Mr Edward Smith. At the hearing the Hearing Officer deferred his decision until 15 May 2013 when he refused the application under Section 3(1)(b) of the Act but confirmed that any possible objection under Section 3(1)(c) of the Act were waived.
5. By way of a form TM5, that was submitted on 11 June 2013, a full statement of grounds was requested from the Hearing Officer.

**The Hearing Officer’s decision**

6. The reasons for refusal of the application in its entirety on the grounds of Section 3(1)(b) of the Act were given in a decision issued by Mr Smith on 3 October 2013 (BL O-395-13).

7. In paragraph 9 of the Decision the Hearing Officer stated as follows:

By way of preface, it seemed clear to me, as I have said, that the examination report had, in fact, conflated the provisions of section 3(1)(b) and (c) of the Act. That is to say, although the examiner had cited only section 3(1)(b), the actual wording of the objection focussed not just on a promotional or motivational meaning of the words, ‘stay sharp’, in relation to fashion and clothing at large (in effect, a section 3(1)(b) objection), but also the prospect that the words may ‘designate a characteristic’ of clothes which have ‘sharp lines’ (in effect, a section 3(1)(c) objection). This state of affairs required some clarification and I proceeded on the basis that, based on her wording of the objection, the examiner’s intention was to raise objection on both grounds and that both grounds, insofar as they had independent application in the specific case, had to be addressed.

8. At paragraph 11 of his Decision the Hearing Officer went on to state that “*At this point I should mention that whilst I acknowledge that objection in this case is only in relation to section 3(1)(b), I have nevertheless recited section 3(1)(c) as it is often helpful to understand how the two grounds relate to each other and potentially overlap. I also feel it would be helpful in this case to explain why, in particular, I waived the objection in relation to section 3(1)(c), but maintained it under section 3(1)(b).*”

9. On this basis the Hearing Officer identified the legal principles with which he was concerned. Those legal principles were, in my view, correctly identified in paragraphs 12 *et seq* of the Decision. He went on to apply those legal principles to the application before him at paragraphs 21 to 26. In particular at paragraphs 21 to 24 he stated as follows:

21. In this case, the sign possesses no particular stylisation or device elements; it is word only. Both words are in grammatically correct order and recognisable, even if they are ‘informal’. Together, the words take the form of an injunctive phrase as far as the consumer would be concerned - ‘stay sharp’. Although injunctive phrases are common in advertising, the fact that a phrase in injunctive may not, of itself, render the sign nondistinctive in relation to clothing. However, when the phrase in question has such an obvious connection with, and

application to, the goods in question, its capacity to perform the essential function of a trade mark must be called into question. In the performance of that essential function and when judged in the *prima facie*, it has been said in the past that linguistic features such as e.g. unusual juxtaposition, quirkiness or surprise may be said to tilt the balance in favour of registration. In this case, I do not believe such features exist in this sign in the *prima facie*, such that the average consumer could latch onto them in some way as to create the necessary resonance, or whatever other word one chooses to describe the function of a trade mark.

22. It must also be remembered that my assessment must take account of all circumstances where the sign may be used in relation to goods, whether that be affixed to the goods or in a promotional and advertising context. As regards the latter in particular, the purely promotional nature of the phrase is amplified. In other words, the message received by the consumer is that the applicant is simply saying that its clothes are the means by which the consumer ‘stays sharp’.

23. I accept in this case that the dictionary definition quoted above is a true reflection of one of the meanings of the word ‘sharp’, namely, an informal alternative for the word ‘stylish’. More importantly, I also believe that this meaning will be readily understood and comprehended by the average consumer when used in relation to the goods intended for protection. Such a phrase would, in my opinion, be regarded by the consumer as origin-neutral rather than origin-specific.

24. Given the very broad meaning of ‘sharp’, it would be very difficult to imagine a category of clothing, even underwear, where such a phrase would have no application whatsoever; in other words, even underwear can be stylish. In view of the obligation referred to in paragraph 18 above, I have carefully considered whether there may be categories of clothing, footwear or headgear for which the sign could be registered and have concluded that there are none.

10. In paragraph 27 of the Decision the Hearing Office concluded that “*the application is refused in its entirety under section 3(1)(b)*”.
11. There are two further points that it is appropriate to note at this stage (1) no evidence of distinctiveness acquired by use was filed on behalf of the Applicant (see paragraph 8 of the Decision) and therefore the Hearing Officer was concerned only with the *prima facie* case; and (2) the Hearing Officer took no account in reaching his Decision of the results of the internet search referred to in paragraph 3 above (see paragraphs 5 of the Decision).

## Standard of review

12. The appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
13. More recently in Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said at paragraph [50]:

The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. . . .

14. This approach was reiterated by the Court of Appeal in Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115]. Moreover in paragraph [115] Lord Justice Lewison said:

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: see *Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55;

*Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

15. On appeals of this nature, it is necessary to bear these principles in mind.

### **The Grounds of Appeal**

16. The Applicant appealed to the Appointed Person under section 76 of the Trade Marks Act 1994. In the Form TM55 it was stated as follows:

The Hearing Officer erred in the assessment that the mark applied for is devoid of distinctive character. Whilst we agree that the Hearing Officer identified the correct legal principles in his [sic] decision, the error lies in the application of those principles to the mark applied for.

17. What the Applicant contended in substance was that the errors in the application of the principles to the mark applied for were:
- (1) That the Hearing Officer failed to take into account his finding in relation to his assessment under Section 3(1)(c) of the Act that the words STAY SHARP have a measure of informality and colloquialism and ‘other meaning’ about them when making his assessment; and
  - (2) That the Hearing Officer’s failed to make his assessment on the basis of the mark as a whole but rather focussed on the word ‘SHARP’ being only one element of the mark.
18. These points were developed in the skeleton argument and oral submissions on behalf of the Applicant at the hearing before me.
19. Mr Abraham on behalf of the Registrar maintained in his skeleton of argument and oral submissions at the hearing before me that no error of principle had been identified; that the Hearing Officer was not clearly wrong; and that in any event the Hearing Officer had made a full, proper and correct assessment on the basis of the submissions and materials before him. Further in this connection Mr Abraham, quite rightly stated, as was acknowledged on behalf of the Applicant, that the Hearing Officer below had “*Put much of his time and effort both at the ex parte hearing and in the subsequent full written decision into clarifying, explaining and to some extent reconfiguring, the nature of the section 3(1) objection*” (paragraph 10 of his skeleton of argument).

## Decision

20. As correctly set out in paragraph 12 of the Decision, the Court of Justice of the European Union has repeatedly emphasised the need to interpret the grounds of refusal for registration under Article 3(1) of codifying Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks and Article 7(1) being the equivalent provision of codifying Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark, in the light of the general interest underlying them: Case C-37/03P BioID AG v. OHIM [2005] ECR I-7975 at paragraph [59] and the case law cited therein.
21. Section 3(1)(b) of the Act provides that “*The following shall not be registered - . . . trade marks which are devoid of any distinctive character*”.
22. Again, as correctly identified in paragraph 13 of the Decision, the general interest underlying an objection under Section 3(1)(b) of the Act and the equivalent provision of the Community Trade Mark Regulation, is that the trade mark must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish the goods or services from those of other undertakings: Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd [2003] Ch 159, [2002] ECR I-5475. That is to say that the “*general interest . . . is manifestly, indissociable from the essential function of a trade mark*” Case C-37/03P BioID AG v. OHIM (supra) at paragraph [60] and the case law cited therein.
23. The assessment under Section 3(1)(b) is different to the general interest underlying an objection under Section 3(1)(c) of the Act which is, as correctly identified in paragraph 14 of the Decision, to ensure that descriptive signs or indications may be freely used by all.
24. The present appeal is concerned only with the assessment by the Hearing Officer under Section 3(1)(b) of the Act. As indicated above there is no suggestion that the Hearing Officer failed to identify the relevant legal principles.
25. In my view it is quite clear that when making his assessment under Section 3(1)(b) the Hearing Officer had in mind that the words that were the subject of the application had a measure of informality or alternative meaning. In paragraph 21 of the Decision the Hearing Officer expressly found that “*Both words are in grammatically correct order and recognisable, even if they are ‘informal’*”. He went on to find at paragraph 23 that “*one of the meanings of the word ‘sharp’, namely, an informal alternative for the word ‘stylish’*”. He made those findings in the context of his view that as far as the consumers were concerned the words would be perceived as an injunctive phrase.

26. In these circumstances, I do not accept that the Hearing Officer did not have in mind that the words STAY SHARP have a measure of informality and colloquialism and ‘other meaning’ about them so far as was relevant when making his assessment under Section 3(1)(b) of the Act.
27. Moreover, the fact that he may have expressed himself differently in his assessment of the words that made up the sign under Section 3(1)(c) of the Act, where the underlying policy reasons and the basis for assessment are different do not, in my view, impact upon his assessment under Section 3(1)(b) of the Act and his findings in relation to the two sections of the Act are not to be characterised, as submitted on behalf of the Applicant, as inconsistent.
28. I am confirmed in this view by the observations of Geoffrey Hobbs QC (sitting as the Appointed Person) in Nmsi Trading Ltd’s Trade Mark Application [2012] RPC 7 at paragraph [19] where he stated:
- . . . a sign may be:
- (1) distinctive for the purposes of s.3(1)(b) , with the result that it cannot be regarded as descriptive for the purposes of s.3(1)(c) and must be unobjectionable on both bases; or
- (2) neither distinctive for the purposes of s.3(1)(b) , nor descriptive for the purposes of s.3(1)(c) , with the result that it must be objectionable on the former but not the latter basis; or
- (3) descriptive for the purposes of s.3(1)(c) , with the result that it cannot be regarded as distinctive for the purposes of s.3(1)(b) and must be objectionable on both bases.
29. Neither do I accept the criticism that the Hearing Officer failed to make his assessment on the basis of the mark as a whole. In my view, whilst there are certainly references to the word SHARP alone in certain of the paragraphs in the Decision they are made in a context which make clear that the Hearing Officer was considering the “*injunctive phrase*” or “*phrase*” being the two words STAY SHARP for the purposes of the assessment that he had to make under Section 3(1)(b) of the Act.
30. With particular reference to the GOOGLE searches referred to in paragraph 25 of the Decision the Hearing Officer made clear that: (1) such material was only supportive of his view of “*the normal and natural meaning the sign would convey to the average consumer in relation to the goods specified*”; and (2) he would have reached the same conclusion in the absence of such material.

## **Conclusion**

31. In the end, it is in my view clear that each case must be determined on its own facts and in accordance with the law. The Hearing Officer, having correctly identified the relevant law, decided that the mark would be regarded by the average consumer as ‘origin neutral’ and not as an indicator of origin. He therefore found that the application was excluded from *prima facie* acceptance under section 3(1)(b) of the Act.
32. The Applicant has not persuaded me that the Hearing Officer was wrong to refuse the application for the reasons he gave in his decision. In my view it was open to the Hearing Officer to come to the conclusion that he did.
33. In the circumstances the request for the sign in issue stands refused. The appeal from the Hearing Officer’s Decision is dismissed. In accordance with the usual practice, the appeal is dismissed with no order as to costs.

Emma Himsworth Q.C.

9 January 2015

Philip Stephenson of Bailey Walsh & Co. LLP appeared on behalf of the Applicant.

Mr. Nathan Abraham appeared on behalf of the Registrar.