

O-395-13

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2648997

BY SUPERCREASE LTD TO REGISTER THE FOLLOWING MARK IN CLASS 25:

STAY SHARP

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NUMBER 2648997
BY SUPERCREASE LTD
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASS 25:**

STAY SHARP

Background

1. On 23 January 2013, Supercrease Ltd ('the applicant') applied to register trade mark application number 2648997 consisting of the phrase 'STAY SHARP' for the following goods in class 25:

Clothing footwear and headgear

2. On 7 February 2013, the examiner at the IPO issued her examination report stating that the sign is devoid of distinctive character under section 3(1)(b) of the Trade Marks Act 1994 ('the Act') for "*clothing which enables the wearer to stay stylish or clothing which retains sharp lines*". I will return to this wording in due course as it seems to me that the grounds of objection under section 3(1)(c) are conflated with those of section 3(1)(b). To support her objection, the examiner adds that Collins English Dictionary defines the word 'sharp' as meaning 'stylish'. For the record, the material entry reads as follows:

sharp 14. Informal a) stylish.b) too smart.¹

3. From this, it can be appreciated that the word 'sharp' has many meanings and is used in many contexts, being adjectival as well as used as an adverb, a verb and a noun. The particular meaning cited above is number 14 of 22 and was no doubt chosen by the examiner as the most apt in relation to the particular goods of the application. It is nonetheless important to recognise that, in this particular context related to clothing and fashion, the dictionary treats the word as being 'informal'.
4. In response to the examination report and in correspondence, the attorney acting for the applicant said the words are not typically used in a trade mark sense in relation to clothing. It was submitted that the word 'sharp' is more distinctive than 'stylish' when used in relation to clothing. In addition, the word 'stay', argued the attorney, is not descriptive of any type of clothing, even clothing which retains sharp edges.
5. In further correspondence, the examiner then produced the results of an Internet search on the phrase 'clothing with a sharp look', which purportedly show use of the word 'sharp' in the context of clothing. For the record, I place no reliance on these hits for the purposes of this decision.

¹ Collins English Dictionary © HarperCollins Publishers 2000

6. The matter came to me for a hearing on 14 May 2013 by telephone at which Mr Paul Stephenson of Bailey Walsh represented the applicant.
7. In summary, Mr Stephenson submitted the message sent by the words is allusive rather than direct or obviously relating to clothing. The words can therefore be registered. He also mentioned that the expression 'STAY HIP' has been registered, although, on further examination, I have noted that this acceptance is by the European Trade Mark Office, OHIM (CTM 1004977). Nonetheless Mr Stephenson is entitled to draw it to my attention, and it is an undoubted comparator.
8. At the hearing, I deferred my decision until 15 May 2013, whereby I refused the application under section 3(1)(b) but confirmed that I had waived any possible objection under section 3(1)(c). By way of a form TM5 which was submitted on 11 June 2013, I have been asked to provide a full statement of grounds which I now give. Only the *prima facie* position has been considered, as no evidence of acquired distinctiveness was put before me.

Decision

9. 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.
10. The relevant parts of Section 3 of the Act read as follows:

"3.-(1) The following shall not be registered –

 - (a) ...
 - (b) trade marks which are devoid of any distinctive character,
 - (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
 - (d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) 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.”

11. The above provisions mirror Article 3(1)(b) and (c) of First Council Directive 89/104 of 21 December 1988 (subsequently codified). The proviso to section 3 is based on the equivalent provision of Article 3(3). 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).

Legal principles

12. The Court of Justice of the European Union (CJEU) has repeatedly emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) and Article 7(1), the equivalent provision in Council Regulation 40/94 of 20 December 1993 on the Community Trade Mark, in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, paragraph 59 and the case law cited there and, more recently, Case C-273/05P *Celltech R&D Ltd v OHIM*).
13. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above) the Court has held that “...*the public interest... is, manifestly, indissociable from the essential function of a trade mark*” (Case C-329/02P, *SAT.1 Satelliten Fernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see paragraph 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function.
14. Section 3(1)(c) on the other hand pursues an aim which reflects the public interest in ensuring that descriptive signs or indications may be freely used by all - see *Wm Wrigley Jr v OHIM* (*Doublemint*), C-191/0P paragraph 31.
15. In terms of the relationship between sections 3(1)(b) and (c), a sign which is subject to objection under section 3(1)(c) as designating a characteristic of the relevant goods or services will, of necessity, also be devoid of distinctive character under section 3(1)(b) - see to that effect paragraph 86 of Case C-363/99 *Koninklijke KPN Nederland NV v Benelux – Merkenbureau* (*Postkantoor*). But plainly, and given the public interest behind the two provisions, they must be assessed independently of each other as their scope is different. That is to say that section 3(1)(b) will include within its scope marks which, whilst not designating a characteristic of the relevant goods and services, will nonetheless fail to serve the essential function of a trade mark in that they will be incapable in the *prima facie* of designating origin.

16. In my opinion, though, I agree with Mr Stephenson that the sign in question here does not have the requisite quality or degree of specificity, whereby it could be said to *designate a characteristic of the goods*. The word 'designate' suggests that a direct, immediately comprehensible and objective characteristic is being used. For example, in the relevant field, the words 'creased' or 'permanent crease' would convey immediately, and without ambivalence, a type or kind of trouser, namely creased trousers.
17. In contrast, and as submitted by Mr Stephenson, the words 'STAY SHARP', have a measure of informality, colloquialism and 'other meaning' about them which, in my opinion, takes the sign outside the scope of section 3(1)(c). It must be recognised that section 3(1)(c) must be interpreted in a trading context and not everyday speech. In this regard, and so far as I am aware, there is no genus of trouser, for example, that would be known as a 'stay sharp' trouser. There is no obvious case, then, for the term to be kept free for other traders to use. Insofar as the examiner had raised section 3(1)(c) as a ground of objection this was waived at the hearing and confirmed in writing afterwards.
18. To return to the theoretical overlap of section 3(1)(b) and (c), in the UK as well as at European level, the relationship between the two sections has also been commented upon. For example, in the case of BL O/313/11 (*Flying Scotsman*), at paragraph 19, the Appointed Person notes that:

“Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registrability of a sign under section 3(1)(b), see Case C-104/00 P Deutsche Krankenversicherung AG v. OHIM ('Companyline')[2002] ECR I-7561 at paragraph [20], it is not necessary to dwell on the question of how far section 3(1)(b) may go in preventing registration beyond the scope of section 3(1)(c). It is sufficient to observe that a sign may be:

(1) distinctive for the purposes of section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of section 3(1)(c) and must be unobjectionable on both bases; or

(2) neither distinctive for the purposes of section 3(1)(b), nor descriptive for the purposes of section 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 section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under section 3(1)(b).”

In this particular case, it is the circumstances in (2) above that apply.

16. The question then arises as to how distinctiveness is assessed for the purposes of section 3(1)(b). Paragraph 34 of the *Postkantoor* case reads as follows:

“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 Linde and Others [2003] ECR I-3161, paragraph 41, and Case C-104/01 Libertel [2003] ECR I-3793, paragraphs 46 and 75).”

17. So the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for *and* the perception of the average consumer for those goods. I should add also that the ‘devoid’ does not represent an objective standard but is based on an assessment which concludes that the sign presented for registration is ‘unpossessed’ of distinctive character from the perspective of the average consumer. Since, in the relevant authorities’ assessment, the sign is unpossessed of distinctive character (this has been, in turn, paraphrased as being ‘origin-neutral’ as distinct from ‘origin-specific’), the sign is not considered capable of performing the essential function of a trade mark.
18. In applying that assessment to this case, it is important I am convinced the objection applies to all the goods applied for. If there are goods specified which are free of objection under section 3(1)(b) then they must be allowed to proceed. In the case of European Case of Justice Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* the question being referred to the court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The court answered (paragraph 38), saying that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all the goods and services concerned. This guidance by the European authorities has, of course, been applied and interpreted in relation to the approach to be taken by the relevant UK authorities, for which see the latest iteration in Tribunal Practice Notice (‘TPN’) 1/2012 headed ‘Partial Refusals’.
19. A further principle is that I am entitled to consider use of the sign in relation to the goods, not just in the context of being affixed in some way to the goods, but also as it may be used in advertising or in other contexts.
20. Finally, I need to identify who, in my opinion, the average consumer is in this case. Given the range of goods listed, it will be the clothes buying general public; these are not specialist items.

Application of the legal principles

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 non-distinctive 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.
25. I attached to my post-hearing decision internet hits from the first two pages of a GOOGLE search for the words 'sharp clothes', showing adjectival usage of the word 'sharp' in the context of fashion and clothes. These are likewise attached to this decision. But, like the internet hits produced by the examiner, this case, for me, rests on the normal and natural meaning the sign would convey to the average consumer in relation to the goods specified. I am mindful the applicant has not been given the opportunity to comment on these hits during the process and I attach them for the record. That said, I regard such material as, essentially, supportive only of the

view I have taken on the meaning of the words, rather than, in and of themselves, decisive of the objection. The fact then, that the applicant has not commented on, or not had the opportunity to comment on the hits ought not to be considered fundamentally prejudicial; even without the hits I would have come to the same decision.

26. Finally, I should say I have considered the comparison mark referred to me by Mr Stephenson (i.e. 'Stay Hip') to enable me to determine if the 'bar has been set too high' in this case. I may mention that this argument amounts to a plea of, what before OHIM and its appeal bodies would constitute an argument of 'equal treatment'. Each case is inevitably fact specific and I am not persuaded the bar has been set too high. I would add at this point that I do not feel constrained to provide the rationale for the prior acceptance and thereby explain exactly why this case is different. For one thing, I am not privy to such deliberations as may have taken place at a different time and in another jurisdiction. I have, then, simply asked myself the question whether I have unreasonably set the bar too high in regard to the prior acceptance and answered that question, as I have said, in the negative².
27. For the above stated reasons, the application is refused in its entirety under section 3(1)(b).
28. In this statement of grounds I have taken account of the papers on file and submissions made.

Dated this 3rd day of October 2013

Edward Smith
For the Registrar
The Comptroller-General

² The appointed person, in, eg FEEDBACKMATTERS (BL O/185/12 at paras 63-69) adopts the same test.



sharp clothes



Web Images Maps Shopping More Search tools

About 88,600,000 results (0.15 seconds)

Sharp Clothing — Home

sharpclothing.bigcartel.com/

At Sharp, we use the highest quality of materials for each tee, cut and sew each pocket by hand which gives a great unique look.

How to Dress Sharp: 9 Tips for Young Men - Real Men Real Style

www.realmenrealstyle.com · All Articles-Podcasts-Videos

Too many young men are starting their professional lives without a clue as to how to dress. This needs to change; young men are the future leaders of society ...

Images for sharp clothes - Report images



STYLISH & SHARP || CLOTHES - Pinterest

pinterest.com/amgowen/stylish-sharp-clothes/

name that tune! Amanda is using Pinterest, an online pinboard to collect and share what inspires you.

dress sharp - WordReference Forums

forum.wordreference.com · English Only · English Only

Jan 12, 2010 - 11 posts - 7 authors

Hello, what does it mean to "dress sharp"? Is it like wearing very elegant and chic clothes? I don't have much context, just that "girls like that ...

The Key To Being A Sharp Dressed Man » Everyguyed – Men's ...

everyguyed.com/fashion-101/importance-sharp-dressed-man/

How To Dress For A Formal Event [...] ... How To Wear A Double Breasted Suit [...] ... Another important aspect of being a sharp dressed man is that it can help you ...

Sharp Aim Dress in Clothes at Nasty Gal

www.nastygal.com/product/sharp-aim-dress

White hot body-con dress featuring sharp cutouts at neckline and back. Cap sleeves, exposed zip closure at back. Super stretch fabric, partially lined. Looks chic ...

Sharp Clothing, Sharp Apparel, Sharp Clothes & Fashion - Zazzle

www.zazzle.com/sharp+clothing

60+ items – Customizable sharp apparel from Zazzle.com - Choose your ...

Lilo & Stitch Stitch excited T-shirts \$18.95 disney
Sharp Objects Tshirts \$23.95 NursesStation

sharp clothes | eBay

www.ebay.com/sch/i.html?_kw=sharp+clothes

50+ items – Visit eBay for great deals on a huge selection sharp clothes.

JACK NICKLAUS" MOISTURE WICKING SHORT SLEEVE POLO ... 3 bids
Donna Sharp Handbag Big Matching Wallet Set Lot Purse Tote Bag ... 1 bid

Sharp Clothes | Facebook

www.facebook.com/pages/Sharp-Clothes/378154677415

Sharp Clothes. 10 likes · 0 talking about this. ... Related Searches. sharp clothes steamer · sharp clothes · sharp clothes for men · sharp clothes for young men ...

What does it mean to "Dress sharp"? - Yahoo! Answers

answers.yahoo.com · ... · Beauty & Style · Fashion & Accessories

May 27, 2011 – It means nice clothes. Wear slacks and a nice button up shirt with dress shoes.

Searches related to sharp clothes

- sharp clothes dryer
- sharp clothes for men
- woolies sharp
- emily sharp clothing

1 2 3 4 5 6 7 8 9 10 Next

Advanced search Search Help Send feedback Google.com

Google Home Advertising Programmes Business Solutions Privacy & Terms About Google

Ads

Clothing at ASOS.

www.asos.com/_Clothing

378 reviews for asos.com

Shop Next Season's Clothing. Discover Clothing. Free Delivery! ASOS has 1,575,173 followers on Google+

Mens Clothing In M To 5XL

www.jacamo.co.uk/Clothing

Top Brands In All The Right Sizes Next Day Delivery & Free Returns

Fashion Clothing All £5

www.everything5pounds.com/

1,359 seller reviews

UK's Only £5 Clothing Website. New Arrivals, Updated Daily. 128 people +1'd this page

Cheap Womens Clothes Sale

www.bangomango.co.uk/

Buy Womens Dress at Wholesale Price Next Day Deliveries. £5 Clothing

Up to 25% off Dresses

www.debenhams.com/SummerSpectacular

Shop Dresses & Save up to 25%! Free Delivery, Order Online Now. Debenhams has 55,909 followers on Google+

Sharp Suits at Amazon

www.amazon.co.uk/sharp+suits

Low Prices on Sharp Suits. Free UK Delivery on Amazon Orders

Cheap Designer Clothes

www.brandalley.co.uk/Clothes

71 seller reviews

Get up to 75% off designer clothes now. Hurry, limited stock

Sharp Clothing

www.ebay.co.uk/sporting_goods

540 reviews for ebay.co.uk

Huge selection of Sharp Clothing. Find everything you need on eBay!

See your ad here >

+You **Search** Images Maps Play YouTube News Gmail More -

Sign in



sharp clothes

Web Images Maps Shopping Videos More Search tools

Page 2 of about 88,600,000 results (0.19 seconds)

Ad related to **sharp clothes**

Men's Clothes In M To 5XL - Top Brands In All The Right Sizes

www.jacamo.co.uk/Clothing

Get 10% Off Your First Order Today!

Shop The TV Ad - Jacamo By Flintoff - Printed T-shirts - Chinos

sharp adjective (FASHIONABLE) - definition in British English ...

dictionary.cambridge.org/dictionary/british/sharp_6?topic...clothes

sharp adjective (FASHIONABLE) - definition, audio pronunciation, synonyms and ...

You are looking at an entry to do with Style & appearance of **clothes**, but you ...

Look Sharp Clothes - eBay Shops

stores.ebay.co.uk > eBay Shops

Buy Look **Sharp Clothes**, New Mens Clothing Ebay Store items on eBay. Find a huge selection of Nautica Polo Calvin Klein Perry Ellis Timberland IZOD, ...

Lace up, look sharp || Style Blog || Quiz Clothing

blog.quizclothing.co.uk/latest-fashion-trends/lace...sharp/801581191

May 3, 2013 – Lace can be worn in the summer too, just opt for lighter fabrics and colours.

Fix Up Look Sharp | Shop Dress, Shirt, Skirt, Crop top, Jumper ...

<https://marketplace.asos.com/boutique/fix-up-look-sharp>

We can make you look **sharp**..... Create **outfits** and share looks on our Fashion Finder site. Blog · What is Marketplace? You can now easily jump between all ...

Sharp Clothes / Sharper Beaks: Blues: Amazon.co.uk: MP3 ...

www.amazon.co.uk/Sharp-Clothes-Sharper-Beaks/dp/B0075UCS08

Sharp Clothes / Sharper Beaks: Blues: Amazon.co.uk: MP3 Downloads.

Pearl Sharp - Clothes Shop in S70 1SY - 192.com

www.192.com > ... > Barnsley businesses > Clothes Shop in Barnsley

Contact details for Pearl **Sharp** in Barnsley S70 1SY from 192.com Business Directory, the best resource for finding **Clothes** Shop listings in the UK.

sharp clothes - WordReference Forums

forum.wordreference.com/showthread.php?t=921929 > Translate this page

Apr 19, 2008 - 4 posts - 3 authors

Hola! What's the Spanish form for "**sharp clothes**"? Desde ya, muchas gracias! LN.

Do You Need Money to Dress Sharp? - Mens Fashion Advice - Male ...



www.youtube.com/watch?v=i0Xmkhagfa8

Sep 8, 2011 - Uploaded by RealMenRealStyle

<http://www.realmenrealstyle.com/free-ebook/> Click this link for a FREE 47 page eBook on men's style and fashion.

More videos for **sharp clothes** »

Trevor Povey's life in sharp clothes - Heritage Plus

www.memorywall.org.uk > Your memories > Clothes and Fashion

Mar 4, 2008 – 'Trevor Povey's life in **sharp clothes**' by Nicola Bengel from Memory Wall.

Looking Sharp While Traveling the World | The Art of Manliness



www.artofmanliness.com/2011/01/25/stylish-travel-clothing/

by Antonio Centeno - in 335 Google+ circles

Jan 25, 2011 – Image from Modern Mechanix Why "Stylish" Travel **Clothing**?

Traveling used to be a glamorous endeavor. As it was more rare than it is today, ...

Ads related to **sharp clothes**

Clothing at John Lewis

www.johnlewis.com/clothing

Shop our latest collection online. Free Delivery on orders over £50.

Sharpe Clothes

www.cafepress.co.uk/

Unique T-Shirts & Other Apparel for **Sharpe** Fans. Buy Now!

CafePress has 770 followers on Google+

Searches related to **sharp clothes**

[sharp clothes dryer](#)

[sharp clothes for men](#)

[woolies sharp](#)

[emily sharp clothing](#)

[Previous](#) 1 **2** 3 4 5 6 7 8 9 10 [Next](#)

[Advanced search](#) [Search Help](#) [Send feedback](#) [Google.com](#)

[Google Home](#) [Advertising Programmes](#) [Business Solutions](#) [Privacy & Terms](#) [About Google](#)