

# You Can't Always Say What You Want

Can Freedom of Expression/Speech Co-exist with the Refusal to Register Trade Marks that are Offensive to Morality and Public Order?



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## **1. Introduction**

The notion of ‘trade mark’ as found in Article 3 of the Directive 2015/2436 states that a trade mark shall exist where the signs are ‘capable of distinguishing the goods or services of one undertaking from those of other undertakings’.<sup>1</sup> Hence, businesses are involved in intense competitions to build, grow and strengthen their trade marks. This perpetuates the need to attract potential customers and even retain the current ones pushing brands to create a logo or tagline that ‘shocks’ customers as they are capable of leaving a lasting impression due to its controversial nature. In other words, ‘being rude or immoral’ may be financially profitable.<sup>2</sup>

It is inevitable that we are constantly faced with brands advertising their products along busy shopping streets, on buses and even in our homes through the television. Taking a stroll down Piccadilly Circus in London or through Times Square in New York can leave a person feeling overwhelmed with the amount of ‘in your face’ advertisement that goes on particularly at night with flashing lights on larger than life screens. Since trade marks have weaved itself into the daily lives of people, it has become essential that regulation of it is a necessary companion. This is done in the interest of protecting the public at large from ‘disturbing, abusive, insulting or even threatening trade marks’.<sup>3</sup>

### **1.1 The Problem**

However, the nebulous law prohibiting marks contrary to public policy and morality coupled with diverging standards of morality are the culprits of the existing ambiguity in the law and unpredictability of court decisions. The varying and constantly shifting boundaries of morality makes having a precise definition of morality available in the law. Hence, the examiners and judges are aided by the EUIPO’s guidelines which dictates that the examination process is a objective one. Nevertheless, there are instances one when is tempted to call foul the system for its subjectivity. The presence

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<sup>1</sup> Regulation 2015/2424, Article 4

<sup>2</sup> Gordon Humphreys, ‘Freedom of speech and trademarks: Gauging public sensitivities or curtailing civil liberties?’ (2009), available at [http://fordhamipconference.com/wp-content/uploads/2010/08/Gordon\\_Humphreys\\_Freedom\\_of\\_Speech\\_and\\_Trademarks.pdf](http://fordhamipconference.com/wp-content/uploads/2010/08/Gordon_Humphreys_Freedom_of_Speech_and_Trademarks.pdf) (last accessed June 14, 2016)

<sup>3</sup> R 495/2005-G – SCREW YOU, paragraph 14

of inconsistent decisions does not bode well for claiming objectivity. However, that can once again be attributed to the shifting boundaries of morality.

The water is muddied further when the notion of free speech is thrown into the discussion. Applicants who have been denied registration often appeal on the basis of freedom of expression/speech. The courts have deliberately skirted the issue and argued that denial of registration is not equivalent to denial of use of the trade mark. The applicant may use the trade mark but without legal protection.

However, the Courts need to realize that skirting the issue of freedom of expression/speech does not eliminate the question. Future applicants need the clarity, which the law desperately needs. It is clear that the freedom of expression and the offensive trade marks do conflict.

Therefore the main contention of this thesis is that the EU Courts fail to consider the freedom of expression questions which has led to them to deliver inconsistent decisions. The Courts need to start giving thought to the legitimate questions that are raised under freedom of expression in offensive trade mark cases.

## **1.2 Research Methodology**

The research methodology is largely doctrinal and theoretical, consisting of legislations, case laws, journals and books. Unfortunately, there is a dearth of case laws in this area of law and this thesis will attempt to present an updated record of the principles amid new case laws and hopefully contribute some insight to the available body of jurisprudence.

## **1.3 The Scope**

Hence the aim of this thesis is to analyse how the refusal to register offensive trade mark impinges on freedom of expression and how they should ideally interact.

Central to the thesis is the refusal to register trade marks based on public policy and trade marks and its operation in the EU and the Member States. The thesis also draws references from US academics and case laws. However, the intention is not to compare and contrast the two jurisdiction but rather to aid in analyzing and providing

a fruitful discussion. In light of the impending Regulation 2015/2424, this thesis will adopt the new terms of European Union Trade Mark (EUTM) and European Union Intellectual Property Office (EUIPO) throughout.<sup>4</sup> However, the main provision that it focuses on is Article 3(f) of Directive 2008/95/EC (Trademark Directive) which is Article 4(f) in the new Directive 2015/2436.

#### **1.4 Outline**

Chapter 2 of the thesis will present a brief outline of European Trade Mark law and the factors that are considered in deeming a Trade Mark inappropriate for registration under the offense to public morality and public order clause. Chapter 3 will discuss the problems with morality. Chapter 4 will scrutinize how the limitation impinges on Freedom of Expression as provided by under the Charter of Fundamental Rights and/or the Human Rights Convention. Chapter 5 will conclude the thesis with recommendations to supplement the current law with the hopes of creating a reliable and sound system of law for Trade Mark applicants and examiners.

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<sup>4</sup> Regulation 2015/2424

## **2. Public Policy And Morality As Limits On Registration Of Trade Marks**

Article 3 of Directive 2015/2436 outlines primarily what constitutes a trade mark. It states that the mark should be capable of graphical representation and capable of distinguishing the goods or services of one undertaking from another.

### **2.1 What's In A Name? The Economics Of Trade Mark Registration**

Upon registration, the trade mark owner will have exclusive use of the registered trade mark in the class that it was registered for. The rights conferred by the trade mark is outlined in Articles 10-18 of Directive 2015/2436. This includes allowing the owner to prevent other businesses from misappropriating the protected mark.

The function of a trade mark is not to reflect the level of quality of a product but rather to identify the maker of the good.<sup>5</sup> Consumers often gather information about a product by 'remembering his/her previous experience'.<sup>6</sup> Overtime, the two have assimilated to one. A trade mark nowadays is synonymous with the quality of the product. For example, a mere mention of luxury brands like Louis Vuitton and Burberry directly indicates uncompromised quality. Needless to say, these are expensive products which are often more accessible to those with more disposable income. On the other hand, brands like Primark does not evoke the same awe in people as luxury brands. This is simply because everyone understands that Primark is not know for its quality but rather its astonishingly low prices which can sacrifice quality.

However, the cause for registration goes beyond 'pure quality considerations'.<sup>7</sup> Consumers often rely on brands to differentiate themselves from their competitors and thus 'product differentiation strategies' are essential in retaining customers. It allows a

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<sup>5</sup> Caststen Fink, Beata Smarzynska Javorcik and Mariana Spatareanu 'Income-Related Biases in International Trade: What do Trademark Registration Data Tell Us? (2003) World Banking Policy Research Working Paper No 3150 <<http://ssrn.com/abstract=636569>> [Accessed: 23 June 2016]

<sup>6</sup> Nicholas Economides 'Trademarks' in Peter Newman *The New Palgrave Dictionary of Economics and the Law* (Palgrave Macmillan UK 1998)

<sup>7</sup> Fink, C., Javorcik B.S., Spatareanu, M.,



firm to ‘recoup investments in marketing’.<sup>8</sup> It protects the owner from ‘misappropriation by pirates and cheats’.<sup>9</sup>

It also enables the consumers to ‘identify the unobservable features of the trademarked product’.<sup>10</sup> This is because the devil is in the detail and consumers may often be tricked into buying an inferior good when it looks largely the same but differs on small but important features of the product. Nevertheless, the importance of an original trade mark is the first hurdle that needs to be overcome before it can be analyzed in detail.

Hence, new and emerging brands often focus on capturing the wider market. Therefore, brands get caught up in the pursuit of creating a trade mark to leave a lasting impression either by shocking or coaxing a chuckle out of its consumers. In doing so, the brands may not necessarily reflect on the offensive nature of their trade mark.

## **2.2 Trade Mark Registration And Article 4(F)**

The Trade Mark Directive (TMD) ‘did not establish a particular law to govern trademark issues’<sup>11</sup> but rather it is to be used as a yardstick of the standards to be achieved among members of the European Union. Applicants send their request for approval to the European Intellectual Property Office (EUIPO). It is an ‘all or nothing deal’ which means that successful applicants will have rights in all 28 member states (or 27 once the UK leaves the EU).<sup>12</sup> A specific application for a specific country can also be made at that country’s national office. A successful application may be renewed indefinitely every 10 years.<sup>13</sup>

EUIPO provides guidelines on the procedures and examination of trade marks for approval. It also has released specific guidelines on the examination in relation to

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<sup>8</sup> Ibid

<sup>9</sup> Economides, N.

<sup>10</sup> Ibid

<sup>11</sup> Timothy W Blakely ‘Beyond The International Harmonization Of Trademark Law: The Community Trade Mark As A Model Of Unitary Transnational Trademark Protection’ [2000] 149 *Transnational Trademark Protection* 309

<sup>12</sup> ‘Trade marks in the European Union’ <<https://euipo.europa.eu/ohimportal/en/trade-marks-in-the-european-union>> [Last Accessed 2 July 2016]

<sup>13</sup> Ibid

absolute grounds of refusal.<sup>14</sup> These guidelines are merely persuasive and thus are not strictly adhered to. Acknowledgment must be given to the margin of appreciation that pervades EU laws. Consequently, it leads to a variation of interpretation of the laws among Member States.

Article 3(f) of the Trade mark Directive states the absolute grounds of refusal to register a trade mark are based on trade marks which are contrary to public policy or to accepted principles of morality.<sup>15</sup> It is identical to Article 7(1)(f) of the European Trade Mark Regulation (EUTMR).

### **2.2.1 Public Policy and Morality**

The EUIPO has released a handbook on the examination of all the absolute grounds of refusal including how to assess trade marks that might be contrary to public order and public morality<sup>16</sup>. First and foremost, the Office considers the two concepts as overlapping.<sup>17</sup>

The handbook explains that assessment of a trade mark must be made in relation to the ‘intrinsic qualities of the trade mark applied for’ and ‘that circumstances relating to the conduct of the person applying’ is irrelevant.<sup>18</sup> The court further clarified that ‘particular circumstances of Member States which are likely to influence the perception of the relevant public within those states’ are factors to be considered.<sup>19</sup>

At the onset, Article 7(1)(f) EUTMR is meant to prevent controversial trade marks from exploiting the benefits of registration and ebbing away the moral fabric of the

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<sup>14</sup> EUIPO ‘Guidelines for examination Trade mark, Part B Examination – Absolute Grounds of Refusal’ (24 May 2016) <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_LR\\_2016/Part-B/04-part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal/TC/part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal\\_tc\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_LR_2016/Part-B/04-part_b_examination_section_4_absolute_grounds_for_refusal/TC/part_b_examination_section_4_absolute_grounds_for_refusal_tc_en.pdf)> [Last Accessed 3 July 2016]

<sup>15</sup> Article 3(f) - Directive 2008/95/EC

<sup>16</sup> EUIPO ‘Guidelines for examination Trade mark, Part B Examination – Absolute Grounds of Refusal’ (24 May 2016) <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_LR\\_2016/Part-B/04-part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal/TC/part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal\\_tc\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_LR_2016/Part-B/04-part_b_examination_section_4_absolute_grounds_for_refusal/TC/part_b_examination_section_4_absolute_grounds_for_refusal_tc_en.pdf)> [Last Accessed 8 July 2016]

<sup>17</sup> Ibid

<sup>18</sup> T-140/02, ‘Intertops’, para. 28

<sup>19</sup> T-232/10 Soviet Coat of Arms para 34

society. However, it would be prudent to note that the guidelines awkwardly steers clear of the uncomfortable task of pinpointing the exact relevant considerations and its attempts to appease the critics results in a haphazard and poor guideline.

### **2.2.1.1 Public Policy / Public Order**

Historically, the word public order found in the Convention was a direct translation of the French word *ordre public* which was later replaced with the preferred use of public policy. The handbook defines ‘Public Policy’ as the structure of law that maintains ‘legal order’ as defined by Treaties and secondary EU legislation which presupposes to safeguard and ‘reflect a common understanding’ of primary principles essential to the EU. Individual national laws are indicative of the ‘perception of the relevant public in those member states’.<sup>20</sup> Article 3(f) [Article 4(f)] has its roots in the Paris Convention which mentions the word public order.

The EUIPO gives some examples of what may be prohibited from registration including any EU Trade Mark appearing to ‘support or benefit an individual or a group’ that are involved with terrorist groups.<sup>21</sup>

Trade marks that allude to sensitive topics particular to the EU specifically Nazi symbolism and names of unconstitutional parties or organisations (eg The Nazi Party) are prohibited in Germany and Austria<sup>22</sup> while in Hungary, the sickle, hammer and the five pointed red star symbol is banned as it is representative of despotism.<sup>23</sup> These are banned in an effort to prevent the ‘dignity of victims of totalitarian regimes’ from being offended and to protect their sanctity.<sup>24</sup>

### **2.2.1.2 Accepted Principles of Morality**

Morality is a principle that is difficult to define and as Kant pointed out, it is a subjective notion based on relativity.<sup>25</sup> Therefore, the onus is on the examiner to

<sup>20</sup> EUIPO Guidelines for Examination

<sup>21</sup> Case R0176/2004-2 BIN LADIN para 17

<sup>22</sup> § 86a dt. StGB (German Criminal Code), BGBl. Nr. I 75/1998)

<sup>23</sup> Case T-232/10 Couture Tech Ltd v OHIM at para 59-63

<sup>24</sup> [https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/trade\\_marks/Draft\\_Guidelines\\_WP\\_2\\_2016/T\\_C/10\\_part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal\\_wp2\\_tc\\_en.pdf](https://euiipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/Draft_Guidelines_WP_2_2016/T_C/10_part_b_examination_section_4_absolute_grounds_for_refusal_wp2_tc_en.pdf)

<sup>25</sup> Lara Denis, ‘Kant and Hume on Morality’ *Stanford Encyclopedia of Philosophy* [2008; revised in 2012] <<http://plato.stanford.edu/entries/kant-hume-morality/>> [Last Accessed 18 July 2016]

ensure that an objective assessment of the trade mark is carried out. Unsurprisingly, the guide mentions that some trade marks are explicitly excluded by Article 4(f) from registration if it includes ‘blasphemous, racist, discriminatory or insulting words or phrases, but only if that meaning is clearly conveyed in an unambiguous manner’.<sup>26</sup> It is also essential to identify the target group for which the trade mark is targeted at as the threshold for offensive words and symbols may elicit varied response among the public.<sup>27</sup> The yardstick for measurement of the tolerance of the public is that of the ‘reasonable consumer with average sensitivity’.<sup>28</sup> Overall, the vague concept of morality is taken to be:

‘the belief that some behavior is right and acceptable whereas other behavior is wrong, this belief being founded on the totality of the accepted norms which are deeply rooted in a particular culture ... the culture in question is the culture inherent in European society and civilization’<sup>29</sup>

The Courts have also stated that causing offence to a ‘small minority’ of the public does not warrant denial of registration of the trade mark.<sup>30</sup> On the other hand, registration of a trade mark should not occur merely because it does not offend the small minority at the other end of the morality spectrum.<sup>31</sup>

It is also vital to consider the context in which the trade mark was registered for and the situations in which it may be encountered in presuming normal use of the trade mark with regards to the use of the goods and services. Nevertheless, the scope of goods and services alone should not be the sole measurement of the perceived tolerance but rather be prudent extend the potential exposure of the brand to beyond just the consumer base. The Court has stated that the ‘relevant public is not

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<sup>26</sup> Ibid

<sup>27</sup> Case R0495/2005-G SCREW YOU para 29 ‘a person who is sufficiently interested in [sex toys] to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations.’

<sup>28</sup> T-417/10, ‘¡Que bueno ye! Hijoputa’, para. 21)

<sup>29</sup> T356/93 *PLANT GENETIC SYSTEMS/Glutamine synthetase inhibitors* [1995] EPOR 357; The case concerned patents however the issue of morality cuts across the different branches of intellectual property.

<sup>30</sup> R 0495/2005-G – SCREW YOU, para. 21

<sup>31</sup> Ibid

necessarily only that which buys the goods and services covered by the mark<sup>32</sup> thus indicating that potential exposure to non-intended consumers is a consideration that may be factored in. The EUIPO is also of the view that the youth and children should also be protected even though they may not be the ‘relevant public of the goods and services’.<sup>33</sup>

While dictionary definitions may be employed as a litmus test for offensiveness of a word in the relevant language, it is the ‘perception of the relevant public as to how and where the mark is encountered’ that is the ultimate determinant.<sup>34</sup>

The guidebook also throws somewhat of a curveball when it states that even signs that have ‘highly positive connotation’ could be offensive which could carry a ‘religious meaning or national symbols with a spiritual and political value’.<sup>35</sup>

In spite of these comprehensive guidelines, the jurisprudence in this area of law fail to measure up as it is riddled with inconsistent case laws. A simple search on the EUIPO register would expose the fallacies. The trade mark ‘FUCKING FREEZING’ is listed as an example of a unregistrable trade mark in the guidelines. But in the trade mark registry, ‘JUST A FUCKING T-SHIRT’ was ironically allowed for the same classes of goods as the former. Furthermore, while the trade mark ‘FUCK CANCER’ was denied, other trade marks like ‘STARFUCKER’ and ‘FUCK LUCK’ were allowed. That is just the tip of the iceberg as further anomalies exist in the trade mark register. ‘I AM A WHORE HEAR ME ROAR’ was rejected owing to its offensive words however, ‘SLUT’ which is a well known derogatory term for women was allowed to be registered in 2005 in English for perfumes, candles and jewellery without any resistance and was granted renewal in 2014.<sup>36</sup> These glaring inconsistencies are unintentionally ostentatious consequentially questioning the integrity of the process of

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<sup>32</sup> T-526/09, ‘Paki’

<sup>33</sup> EUIPO Guidelines for Examination

<sup>34</sup> R 0168/2011-1 – ‘Fucking Freezing! by TÜRPIZ’, para. 25

<sup>35</sup> R 2613/2011-2 – ATATURK, para. 31

<sup>36</sup> SLUT trade mark number 003705084; a search of various dictionary definitions all point to the feminine aspect of this derogatory term.

examination. It makes the process appear arbitrary and analogous to ‘a lottery subject to the vagaries of the examining office’.<sup>37</sup>

### **2.3 Summary**

Trade mark registration marks an important step in allowing a business to communicate itself to the public. That communication to the public needs to be made with respect to public policy and accepted standards of morality. While the scope of public policy is easily defined, the same cannot be said for the concept of morality. The lack of a precise definition owing to its fluid nature makes it harder to define its scope. Consequentially, there is a lack of uniform understanding of what may be considered offensive and what is not. The test then is wholly dependent on what the public *may* perceive as offensive and pandering to their prudishness. Consideration of the category could allow the offensive trade mark to be registered if doing so would exclude the easily offended groups of people such as the elderly and the young and impressionable children.

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<sup>37</sup> Colin Davies, ‘For FOOK’s Sake’ (2004) 169 *Trademark World* 24, 26 this statement was originally made in relation to the inconsistencies in decisions decided at the UKIPO. However, a similar parallel can also be drawn here.

### **3. The Fluidity of Morality**

From the comprehensive discussion in the previous chapter, it is indisputable that both public policy and morality overlap. In *Phillips v Remington*, Jacob J stated that public policy is ‘confined to matters involving some sort of question of morality’.<sup>38</sup> This chapter aims to unpack the fluidity of morality and the difficulty in defining accepted principles of morality. The chapter will conclude that the razor thin line that separates the subject-matter that is objectionable and reprehensible to morality and that which is simply distasteful is challenging to define and that the law could aid in providing a better direction to those relying on the law.

In *Hallelujah*, the residing judge stated that the “phrase “contrary to morality” should be considered by the generally accepted standards of today and not by those of “1938”.”<sup>39</sup> Furthermore, in 1938 the sign ‘MADONNA’ was used for wines which was deemed ‘scandalous’ but has been lawfully registered by the famous pop star whose sacrilegious antics, enough to make any good Christian turn in his/her grave, has attracted more controversy than having the name of Jesus’s mother connected to wine. The word ‘MECCA’<sup>40</sup> which refers to the Islam’s holy city has been allowed for registration as well. The point to note here is that both ‘MADONNA’ and ‘MECCA’ were initially rejected for registration but were eventually registered at a later date.<sup>41</sup> This illustrates the changing nature of morality in modern societies. Whether this change is a progression or erosion of moral values is another debate.

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<sup>38</sup> *Phillips Electronics NV v Remington Consumer Products Ltd* [1998] ETMR 124 para 153

<sup>39</sup> See *HALLELUJAH Trade Mark Application* [1976] 22 R.P.C. 605, 607 (U.K.)

<sup>40</sup> Multiple registrations were found in the EUIPO for goods ranging from leather goods, clothing and watches to meat, baking products and agricultural products with the latter even having a picture of the Kaaba which is part of the mosque in the real physical place of Mecca, the holiest place according to the Islam religion.

<sup>41</sup> Enrico Bonadio, ‘Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks’ (2015) 19(1) *Marquette Intellectual Property Law Review* 43-60

However, one must be careful not to paint all societies with the same brush. As mentioned earlier, the relevant public where the trade mark is registered for is an important factor in allowing for registration. ‘MECCA’ was allowed for registration in Australia, where the percentage of Muslim is a mere 2.09%.<sup>42</sup> The author is of the opinion that it may not necessarily be successful in a Muslim dominated country as religious organisations may decry blasphemy. While, this essay does not advocate for the tyranny of the majority, this example is being used to illustrate that perhaps the nature of morality is dependent on different aspects of the society. The above shows that religion was considered, but other aspects such as race and history of the country (i.e Hungary where symbols of despotism may be offensive) may be relevant factors depending on what is being registered.

However, the opposite may also occur, where recent events attach a sensitive element to a word. This is evident in the trade mark ‘BIN LADEN’ which was registered before the reprehensible terrorist attacks on the Twin Towers which has come to be known as ‘9/11’. The fact that the Saudi Arabian company had been conducting business in Europe had become irrelevant as the general public will now associate the name ‘BIN LADEN’ with the leader of a terrorist group.<sup>43</sup> Unsurprisingly the registration was refused as it is ‘absolutely contrary to the ethical and moral principles recognized in the Member States of the EU and all civilized nations’.<sup>44</sup> However, the Swiss government eventually allowed the registration for ‘BIN LADIN’ after initial revocation citing that approval of the trade mark is not akin to its endorsement of terrorist attacks.<sup>45</sup>

On a similarly grim and related note, Disney attempted to register ‘SEAL TEAM 6’ with respect to the group that assassinated Osama Bin Ladin shortly after the world

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<sup>42</sup>Population of Muslims - <http://www.islamicweb.com/begin/population.htm>

<sup>43</sup> Case R-176/2004-2 Falcon Sporting Goods v OHIM (2004) refusal to register Bin Ladin

<sup>44</sup> Ibid

<sup>45</sup> Christoph Gasser & Lorenz Ehrler ‘SWITZERLAND: BIN LADIN Trademark Upheld’ (2005) 60(2) *INTA Bulletin*

<<http://www.inta.org/INTABulletin/Pages/BINLADINTrademarkUpheld.aspx>> [Last Accessed 21 July 2016];

A search on the Swiss Database shows that the trade mark had expired in 2011 and has been extracted on 2016 for non-use



learnt of the news.<sup>46</sup> Disney eventually withdrew their application after being criticized for attempting to profit from someone else's success.<sup>47</sup> Perhaps, this why the notion of 'public morality' has been consciously left broad to enable oscillating and polarizing standards of morality to reflect the attitudes of the appropriate time period and landscape.<sup>48</sup>

While there are obvious advantages to the mutable nature, it would also appear to be its Achilles' heel as the alterable nature can be blamed for its lack of certainty and raises question on the supposed accepted principles of morality. It was stated in *French Connection Ltd's Trade Mark Application* that clarity is essential to prevent arbitrariness and loss of faith in the system. The responsibility of making concrete and reliable principles becomes magnified when it could potentially infringe on the freedom of expression which will be discussed in the next chapter.

### **3.1 What is Morality and Accepted Principles?**

The failure of Article 3(f) can be attributed to the lack of a more precise meaning of morality. It appears that "in lieu of a defined scope of what it means to be "contrary to public morality", decision makers have often hidden behind the veil of their discretion."<sup>49</sup> Morality is also difficult to define as it will always remain to be a subjective, relative and situational notion. It is a widely accepted fact that a 'single definition of morality will be applicable to all moral discussions'.<sup>50</sup> Furthermore, the situation is not aided by the historical documentation by the EPC Working Party which concedes that 'there was no European definition of morality'.<sup>51</sup> The members further unanimously espoused that the 'interpretation of the concept of morality

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<sup>46</sup> Ethan Smith & Julian E. Barnes 'Walt Disney Surrenders to Navy's SEAL Team 6' (2011) *The Wall Street Journal* < <http://www.wsj.com/articles/SB10001424052702304066504576345752703592770>> [Last Accessed 21 July 2016]

<sup>47</sup> Ibid

<sup>48</sup> Kerly on Trademarks and Tradenames (Sweet and Maxwell 8-193)

<sup>49</sup> Sarah A Hinchliffe, 'Defining the Boundaries of a Scandalous Mark – Perspectives from Australia, the United States, and the United Kingdom' (2014) [Last Accessed 21 July 2016] [https://www.law.berkeley.edu/files/Hinchliffe\\_Sarah\\_IPSC\\_paper\\_2014.pdf](https://www.law.berkeley.edu/files/Hinchliffe_Sarah_IPSC_paper_2014.pdf)

<sup>50</sup> Bernard Gert & Joshua Gert, 'The Definition of Morality' *Stanford Encyclopedia of Philosophy* (2016) <<http://plato.stanford.edu/entries/morality-definition/>> [Last Accessed 23 July 2016]

<sup>51</sup> Decision on the invalidation of the Trade Mark see document IV/2767/61-E, page 7 <<https://www.ipo.gov.uk/t-challenge-decision-results/o13706.pdf>> [Last Accessed 21 July 2016]

should be a matter for European institutions'<sup>52</sup> The same is to be applied to the concept of 'ordre public'.<sup>53</sup>

It is precisely this interpretation that sometimes causes disagreements among the examiners and the public and as discussed earlier may lead to an uncertainty in the law. While perusing the guidebook released by the EUIPO, one would come across 'FUCK CANCER' as a rejected trademark due to the use of an offensive word. It is considered to be contrary to Article 7(1)(f) CTMR.

However, it could also be seen as a motivational slogan which is precisely the intention of the owners of the trademark in Canada who wanted to educate the public about cancer.<sup>54</sup> This thesis is of the opinion that slogans like these could aid in helping a cancer patient overcome his situation. It has a motivational undertone to it and could be perceived as encouraging the patient to overcome cancer mentally and emotionally. The word 'FUCK' would cease to have a vulgar effect in relation with the word cancer and is transformed to channel the patient's anger at cancer.<sup>55</sup> It is unfortunate that the prudishness of the examiners is victorious over the needs of the unfortunate. However, the author is eager to know how ready the prudish parents will be when they come across registered trade marks such as 'FUCKING HELL'<sup>56</sup>, 'COMMES DES FUCKDOWN'<sup>57</sup> and 'FUCK LUCK'.<sup>58</sup> A search for 'FUCKING HELL' showed a "similar" trade mark 'I FUCKING HATE DRUMMERS' which is currently undergoing examination in the UK. While the law may be uncertain, the author is rather confident that the US registered trade mark is unlikely to be successful due to the harsh and vulgar undertone it carries. Similar types of trade marks that had such undertones were not allowed for registration in the UK such as 'www.standupifyouhateanu.com'.<sup>59</sup>

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<sup>52</sup> Ibid

<sup>53</sup> Ibid page 8

<sup>54</sup> Jason Proctor, 'F--k Cancer's Yael Cohen loses obscenity trademark battle'

<http://www.cbc.ca/news/canada/british-columbia/f-k-cancer-s-yael-cohen-loses-obscenity-trademark-battle-1.2832808> [Last Accessed 25 July 2016]

<sup>55</sup> This thesis is not concerned about the court battle that surrounded the trademark due to 'Fuck Charities' existing but instead would like to focus on the purpose of having the slogan.

<sup>56</sup> Trade mark EU006025159

<sup>57</sup> Trade mark EU011408572

<sup>58</sup> Trade mark EU007024631

<sup>59</sup> CDW Graphic Design Limited v Manchester United Merchandising Ltd [2000] *Challenge Decision Results* <https://www.ipo.gov.uk/t-challenge-decision-results/o46402.pdf> [Last Accessed 25 July 2016]

However, there is indeed a valid argument that children may be exposed to the vulgar word in that phrase. However, the author is confident that dutiful parents will be quick to explain its novel meaning and in doing will be educating the children in the process. Furthermore, what was once considered to be salty language has now found its place in everyday mainstream colloquialism. The word ‘shit’ has commonplace on TV shows and movies and the word ‘fuck’ though used sparingly in the media does not even raise an eyebrow which would have caused an uproar in earlier times.

Even then, the guidelines have made a necessary blanket ban on racially offensive mark regardless of goods and services.<sup>60</sup> An outright rejection is also given where the offensive trade mark is registered for classes that target children such as toys and games.

However, the continued vagueness in the definition of morality could pose a danger to having extremely offensive trade marks being registered. While the EU system has shown that there are inconsistencies, it fortunately has not found itself in the shoes of the US. Apparently offensive trade marks like ‘DANGEROUS NEGRO’ for shirts, ‘SHANK THE B!T@H’ for board games and ‘TAKE YO PANTIES OFF’ for clothing have been registered.<sup>61</sup> There glaringly offensive trade marks have the potential to be exposed to the vulnerable.

While the EU system adopts a strict approach; it does however appear to have cracks in it as well which needs some addressing. After all, the objective of this ground is an *absolute* ground of refusal and not one which panders to arbitrariness which could ironically compromise the morality of which they were meant to protect.

In recent years, the world unfortunately has had to witness a myriad of tragic and terrorist attacks which has spawned numerous opportunists seeking to trade mark slogans related to the tragic events such as ‘Je Suis Charlie’ in response to the tragic mass shooting at Charlie Hebdo in Paris 2015. OHIM responded by stating that any

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<sup>60</sup> EUIPO Guidelines for Examination

<sup>61</sup> Luke O’ Neil ‘A List of Trademarks the Redskins Claim Are Just as Offensive as Their Own’ (2015) <http://www.esquire.com/sports/a39397/washington-redskins-defend-logo/> [Last Accessed 25 July 2016]

such attempts to trade mark the slogan will probably not be successful as it is considered to be of ‘overriding public interest’.<sup>62</sup> Apart from it being ‘contrary to public policy and to accepted principles of morality’, it also lacks distinctive character.<sup>63</sup>

Ultimately, the duty of the trade mark examiners is to preserve the social order by ensuring that offensive trade marks are not registered. The onus is on them not to allow their personal opinions/beliefs to influence their examination process and each trade mark is therefore to be assessed objectively.

It is possible that the relevant trade marks under this provision be divided into seven categories: “(1) those with a religious nexus; (2) those consisting of or comprising racial slurs or epithet; (4) those consisting of or comprising vulgar matter; (5) those relating to sexuality; (6) those involving innuendo; (7) those suggesting or promoting illegal activity”.<sup>64</sup> However, it can be observed that while the cases decided under each category are all decided on the same legal basis, it is unmistakable that varying standards have been applied contingent on the category.<sup>65</sup>

While this author has no qualms about the current classifications, he is of the opinion that two more categories could be added: marks insulting to nationality, and marks exploiting tragic events. Relevant cases will be discussed under each category.

#### **a) Religious Nexus**

Religion is an integral part of any society and its importance is reflected by the European Convention of Human Rights (ECHR) Article 9 which states that:-

‘Everyone has the right to freedom of thought, conscience and religion; this right includes freedom to change his religion or belief and freedom, either

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<sup>62</sup> OHIM News (2015)

[https://euipo.europa.eu/ohimportal/en/news?p\\_p\\_id=csnews\\_WAR\\_csnewsportlet&p\\_p\\_lifecycle=0&p\\_p\\_state=normal&p\\_p\\_mode=view&p\\_p\\_col\\_id=column-1&p\\_p\\_col\\_pos=1&p\\_p\\_col\\_count=3&newsQueryString=je%20suis%20charlie&journalId=1787585&journalRelatedId=manual/](https://euipo.europa.eu/ohimportal/en/news?p_p_id=csnews_WAR_csnewsportlet&p_p_lifecycle=0&p_p_state=normal&p_p_mode=view&p_p_col_id=column-1&p_p_col_pos=1&p_p_col_count=3&newsQueryString=je%20suis%20charlie&journalId=1787585&journalRelatedId=manual/) [Last Accessed 29 July 2016]

<sup>63</sup> Ibid

<sup>64</sup> Stephen R. Baird, ‘Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks’ (1993) 83 *Trademark Rep.* 661, 704

<sup>65</sup> Ibid

alone or in community with others and in public or private, to manifest his religion or belief, in worship, teaching, practice and observance.’

Furthermore, the nexus of some society hinges on religion alone and unlike some ‘European states who were expressly founded upon the principle of secularism’.<sup>66</sup> Hence, trade marks that include symbols of religious significance are highly sensitive and may provoke greater offence than mere distaste.

In the UK, the application for the mark ‘JESUS’ for various classes associated with clothing was rejected on the basis that a substantial population of the general public would associate that name with Jesus in Christianity.<sup>67</sup> It was also stated in the case that:

“JESUS was the ultimate Christian name and commanded the highest degree of reverence and respect amongst committed Christians. The view that their religious beliefs should be respected was deep-seated and widespread and the very idea that the name JESUS should be appropriated for general commercial use as a trade mark was anathema both to the believers and those who believed in the need to respect the religious sensibilities of others [...] The power of the word JESUS to give rise to the relevant concern was not diminished by the nature of the goods in the different categories specified by the applicant”<sup>68</sup>

It is apparent from the above that religious symbols can ruffle some feathers among the general population. While it is argued that it is not in the spirit of the law to reject a registration if it only affects a small group of people, it however was not the case here as the majority of the population that would be exposed to the trade mark would be Christians. It was noted that in the UK that a ‘higher degree of outrage or censure amongst a small section of the

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<sup>66</sup> Jim Murdoch, ‘Protecting the right to freedom of thought, conscience and religion under the European Convention on Human Rights’ *Council of Europe Human Rights Handbooks* (Strasbourg 2012)

<sup>67</sup> SA Trade mark Application Number: 689374

<sup>68</sup> *Basic Trademark SA’s Trade Mark Application* [2005] RPC 25

community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice’<sup>69</sup>

The ruling in UK however does not mean that it will not be registered in other parts of Europe as it remains registered in countries like Italy and Luxembourg.<sup>70</sup> It would therefore appear that the UK government has a much stricter approach to its examination process. Ironically, trade marks such as ‘JESUS JEANS FOLLOW ME’ had been registered in 2012 by the same company that sought and failed to register ‘JESUS’ for the same classes of clothing. This behavior is unaccounted for by the UKIPO. One can only hope that they had seen the light to realize that perhaps they have been uptight in their examination process previously.

In Switzerland, ‘MADONNA’ and ‘BUDDHA-BAR’ were denied registration. In Germany, ‘BUDDHA’, ‘DALAILAMA’ and ‘CORAN’ have been denied registration for using religion related symbols, names and titles.<sup>71</sup>

On the other hand, trade marks such as ‘JESUS 2000’ and ‘CHRIST’ have been registered products ranging from perfume to leather goods without any objection.

But the mark ‘JOHANNES PAUL II’ which was the name of the Pope was not granted registration for mineral waters, non-alcoholic drinks, alcoholic beverages, tobacco and smoker’s articles.<sup>72</sup>

The inconsistencies are proof that there needs to be clearer definition of what is allowed. Furthermore, the UKIPO needs to have a more accountable system

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<sup>69</sup> Ibid [20]

<sup>70</sup> Marius Meland, ‘U.K. Rejects Jesus as Trademark for Jeans’ (2003) , <<http://www.law360.com/articles/574/u-k-rejects-jesus-as-trademark-for-jeans>> [last accessed 31 July 2016]

<sup>71</sup> Standing Committee on the Law of Trade marks, Industrial Designs and Geographical Indications, Grounds for Refusal of All Types of Marks, WIPO, August 30, 2010, [http://www.wipo.int/sct/en/meetings/pdf/wipo\\_strad.inf\\_5.pdf](http://www.wipo.int/sct/en/meetings/pdf/wipo_strad.inf_5.pdf)

<sup>72</sup> Johannes Paul II Trade Mark Application number 000958280

**b) Racial Slurs**

The adage, ‘Sticks and stones may break my bones but names will never hurt me’ appears to lose its meaning and truthfulness and makes it appear to be nothing more than an expression to boost someone’s morale in the present context. The blanket ban on racially offensive trade marks does not help either. Humor aside, racial slurs are a serious matter and is not to be taken lightly. There has been an increasing trend to being politically correct and to avoid using derogatory terms. Hence the same attitude needs to be adopted towards registration of trade marks otherwise, the authorities would appear to be tolerating racially offensive trade marks and giving their approval indirectly.<sup>73</sup> The government should not be actively assisting applicants who wish to further their business opportunities by benefitting from a racially insensitive trade mark that goes against the moral fiber of the society.<sup>74</sup>

The German word ‘RASSISMUS’ (which means ‘racism’ in English) was not granted registration<sup>75</sup>. The word ‘PAKI’ has been refused trade mark registration for its racially offensive nature.<sup>76</sup> ‘PAKI’ is a slang word for people from Pakistan and is used as a racial slur instead of being used as a noun. The General Court also clarified that no evidence is require to show that the applicant intended to ‘shock or offend’ consumers as the objective view that the trade mark is capable of such response is sufficient to refuse registration.<sup>77</sup> OHIM had on its part rejected the ‘SUDACA’<sup>78</sup> a derogatory term used to refer to South Americans. Ironically, the company was of Chilean origin.

Racism persists because people allow it to appear in the media which allows them to have a voice. Branding is one such medium which can be harnessed easily for the wrong reasons. Small gestures like refusing racist trade marks

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<sup>73</sup> Stephen R. Bard, ‘Moral Intervention’ page 714

<sup>74</sup> Case R 495/2005-G Application of Kenneth (trading as Screw You) [2007] ETMR 7 at [H7]

<sup>75</sup> Rassismus Trade mark Application Number: 2994499

<sup>76</sup> Case T-526/09 PAKI Logistics GmbH v OHIM (5 October 2011)

<sup>77</sup> PAKI Logistics GmbH v. OHIM [2011] Dec. T-526/09 (Fr.); *see also* Birgit Clark, *General Court refuses ‘racist’ PAKI trade mark*, 7 *Journal of Intellectual. Property Law & Practice* 392, 392–94 (2012).

<sup>78</sup> Sudaca Trade mark Applicatoin Number: 2843829

definitely aids in making racism less acceptable. Racists will now have one less avenue to spread hate.

**c) Vulgar Matter, Sexual Content, Innuendo**

Trade marks of this nature have become increasingly common place and unsurprisingly makes the bulk of registration faced by Intellectual Property Offices. While the trade mark is to be assessed for its scandalous, considering the class it is being registered for could also be a determining factor of the registrability. It should also be noted that the line dividing between registrability and unregistrability has shifted over time as society progressed.<sup>79</sup>

Vulgarity and profane matters have huge overlaps in terms of what is considered to be offensive. It appears that trade marks under this limb are often enshrouded in controversy. An often cited well-known culprit is 'FCUK' which is often referred to as an offensive trademark had been granted registration since 1999.<sup>80</sup> It has also gone to be one of the most successful brands in the world.<sup>81</sup> The acronym stands for French Connection United Kingdom. However, it must be noted that it is 'not as innocent as its high street neighbors 'HMV' and 'DKNY'.<sup>82</sup> The trade mark is a wordplay on the word 'fuck'. Hence, the younger generations get a thrill of knowing that it could offend, annoy or shock the older or conservative members of the society.<sup>83</sup> Furthermore, the moron in a hurry might interpret it as the vulgar word 'fuck' instead of 'FCUK' causing him/her to do a double take and re read the word properly. This could be the underlying motive for the company's branding – giving a shock factor. On the other hand, trade marks that had the 'C' and 'U' switched around to 'reveal' the vulgarity were

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<sup>79</sup> M. Christopher Bolen, Richard J. Caira, Jr. And Jason S. Wood, 'When Scandal Becomes Vogue: The Registrability Of Sexual References In Trademarks And Protection Of Trademarks From Tarnishment In Sexual Contexts' (1999) 39 *IDEA: The Journal of Law and Technology* 435

<sup>80</sup> FCUK, Trade mark Application Number: 2184549, Case: 0-137-06

<sup>81</sup> Colin Davies, Rhiannon Davies, 'Fighting Controversy in the UK: Morality and a trade mark application' [2003] *Business Law Review*, 137 at 137

<sup>82</sup> Ibid

<sup>83</sup> Patricia Louise Loughlan, 'OH YUCK! The Registration of Scandalous Trade Marks' (2005) Sydney Law School Research Paper No. 06/40 [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=939948](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=939948) [Last Assessed 1 Aug 2016]



unceremoniously denied. These included ‘JUST FUCKING’<sup>84</sup>, ‘FIT FUCKER’<sup>85</sup> AND ‘MACHOFUCKER’<sup>86</sup> to name a few.

A trade mark is also capable of rejection if it is aurally/orally similar to a swear word. This was captured squarely by the ‘FOOK’<sup>87</sup> trade mark application. It was argued that pronouncing the trade mark would be akin to saying the word ‘fuck’ in certain parts of the UK. It was therefore dismissed under the grounds of ‘likely to cause justifiable outrage amongst a significant section of the public’<sup>88</sup> However, it appears that such trade marks are not too common and this example should serve as a forewarning to future applicants.

The trademark ‘SCREW YOU’ had to be rejected as it conveys the same meaning and is considered to be as equally abusive as ‘fuck you’ and thus offensive.<sup>89</sup> The category of goods for which the trade marks are registered for can be the saving grace of a trade mark. In this instance, the trade mark was allowed for a specific type of goods such as condoms, contraceptives, sex toys, artificial breasts and breast pumps sold exclusively in sex shops where the general public do not encounter such goods especially children and the elderly.<sup>90</sup>

However, ‘FUCKING HELL’ was allowed to be registered on the basis that ‘FUCKING’ was an actual village in Austria and the German phrase ‘ein helles bier’ conveys the meaning of ‘a pale beer’ which is the description of the product.<sup>91</sup> In that sense, the trade mark may not be considered as a profanity. The Board of Appeal deliberated and decided that the trade mark was capable of registration.

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<sup>84</sup> Just Fucking Trade mark Application Number: 08123961

<sup>85</sup> Fit Fuckers Trade mark Application Number: 07497795

<sup>86</sup> MachoFucker Trade mark Application Number: 09938119

<sup>87</sup> Fook Trade mark Application O-182-05

<sup>88</sup> Ibid

<sup>89</sup> Case R 495/2005-G *Application of Kenneth (trading as Screw You)* [2007] E.T.M.R. 7 at [22]

<sup>90</sup> Ibid

<sup>91</sup> Fucking Hell Trade mark Case: R0385/2008-4 OHIM Board of Appeal

But we must remind ourselves that not everybody may know that fucking is actually a name of a village in Austria. Thus while the freedom of expression is seen to prevail here, it also fails to consider the possible negative effect it may have when it is being used in the commercial sense. Consumers may mischievously use the term as a form of swear word but instead retreat to referring to the village in Austria when being confronted. While it is not the job of the trade mark registry to police the use of language. They do bear the burden of what may be allowed commercially and how its use may affect people.

Apart from the obvious vulgarity contained in trade marks, there are also implicitly vulgar trade marks such as the figurative sign which included ‘the sickle, the hammer and the five point red star...which are considered to be signs of depotism’.<sup>92</sup> OHIM rightly rejected the trade mark due to it being ‘contrary to public policy and to accepted principles of morality’. The figurative sign was vulgar in the sense that it boldly included symbols that will remind people of the Soviet regime. The Court clarified that it took into consideration the relevant public that will be exposed to the offensive trade mark when arriving at its decision. The relevant public in this instance were the countries that had been under the ruthless regime.

Sexual content and innuendos are everywhere and constantly shoved in our faces (no pun intended) on every form of medium possible. The increasing exposure and subsequently tolerance to sexual imagery and language has led to and perhaps even encourage applicants to push the boundaries of registrability.<sup>93</sup>

OHIM was confronted with the application of ‘DICK & FANNY’<sup>94</sup> for a trade mark registration. The application was initially refused for its slang reference to the male and female genitalia and citing it to be ‘contrary to public order and the accepted principles of morality’. It is a conceivable consequence as

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<sup>92</sup> Case T-232/10 Couture Tec Ltd v OHIM (20 September 2011)

<sup>93</sup> Bolen, Caira & Wood

<sup>94</sup> Dick Lexic Limited’s Application (Dick& Fanny) Case: R111/2002-4, OHIM Board of Appeal

consumers who understand English may be understandably offended. The applicants successfully argued that the words maybe seen as the shortened versions of the names of ‘Richard and Frances’. The court also considered that although the words had sexual connotations, the mark failed to convey an offensive message. It was accepted that trade mark is ‘considered more playful and at most in poor taste’.<sup>95</sup> The court came to the conclusion that if the forenames could be seen as referring to a couple and in doing so would eliminate the sexual undertones.

This author is of the opinion that while the court is right not to deny registration of the trade mark as it may only be in poor taste, he is of the view that the court’s view that the trade mark could be seen as forenames of a couple is a rather huge extrapolation. It is clear that the trade mark was created with the intention to coax a chuckle out of the average consumer. The average consumer will not invest the time to come to the conclusion that the trade mark could be viewed as shortened names of ‘Richard’ and ‘Frances’.

Europe’s position is clear that trade marks with sexual undertones will not be registered as it is ‘contrary to public order or morality’. Hence it is unsurprising that trade marks such as ‘KUNT’<sup>96</sup>, ‘FUCK & FUN’<sup>97</sup> and ‘CLITORIS ALLSORTS’<sup>98</sup> The trade mark ‘TINY PENIS’ was refused registration in the UK was against the order of morality. It was held that the trade mark has the potential to cause more offence than mere distaste to those who were exposed to it. The case raised an important issue of the degree of offence. The judge in the case rightfully pointed out that the trade mark law was not ‘concerned with political correctness but rather with principles of morality of a different and less readily invoked standard’.<sup>99</sup> This value lies in the belief that the correct anatomical terms for parts of the genitalia should be

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<sup>95</sup> Ibid

<sup>96</sup> Kunt Trade mark Application Number: 04164431

<sup>97</sup> Fuck & Fun Trade mark Application Number: 09220831 and 09247289, OHIM Board of Appeal

<sup>98</sup> Clitoris Allsorts Trade mark Application: 04252821

<sup>99</sup> Ghazilian’s Trade mark Application [2002] ETMR 63

reserved for serious use and should not be debased by use as a smutty trade mark for clothing.<sup>100</sup>

On a side note, the fact that ‘COMFYBALLS’ has been refused registration in the US despite the trade mark’s lack of vulgarity is laughable considering that the US Trademark Registry is riddled with much more vulgar and sexual trade marks. The lame reasoning behind the refusal was that the application of S1052(A) of the Lanham Act which opposes ‘immoral, deceptive or scandalous matter’ gives the word ‘balls’ an offensive meaning.<sup>101</sup> The trade mark however has been successfully registered in the EU without any objection.

#### **d) Suggesting or Promoting Illegal Activity**

Under the final limb of categories suggested by Baird, the propensity for rejection is rather high. The reason for rejection would fall under the realm of public policy. Failure to do so could be misconstrued as the government’s passive approval of illegal activity.

The UK took the conservative approach of refusing to grant application for ‘*www.standupifyouhateamanu.com*’<sup>102</sup> on its potential to cause a ruckus between football fans and the danger is more apparent at football stadiums. It is public knowledge that the sport of football has some of the fiercest rivalries. Hence allowing the registration of seemingly innocent domain is likely to result in unwanted consequences as a banner with the trade mark is likely to result in chaos. The world has witnessed some of the most shocking fan rivalry outside the stadium without the use of such hate inciting trade marks. Hence, the approval of such trade marks is only likely to worsen the situation. Furthermore, if were to be granted registration, it is likely that more enraged fans will flood the register with similar trade mark registration. Hence, it was

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<sup>100</sup> Ibid

<sup>101</sup> Gavin Stenton, ‘Are you sitting comfortably? US Patent and Trademark Office says "pants" to Comfyballs trade mark application’ (2015) <<http://www.lexology.com/library/detail.aspx?g=3c64a558-f1a6-41a6-a692-e487c546dc63>> [Last Accessed 1 Aug 2016]

<sup>102</sup> CDW Graphic Design Ltd's Trade Mark Application [2003] R.P.C. 30

wise that the UKIPO rejected the antagonistic trade mark before getting involved in with football fan's petty revenge attempts.

Toke was also refused registration on the basis that it meant 'to take a draw on a cannabis cigarette' and could be misconstrued as encouraging the use of drugs.<sup>103</sup> However, there is potential for the trade mark to be registered in the USA. Some states in the US have long legalized medical marijuana and the number is growing. Although approval of the trade mark before the trend towards legalization of medical marijuana in the US becomes widespread will not be a surprise either considering its disturbing examination process for including offensive trade marks as seen earlier. Toke could perhaps be registered easily.

'EXTASY IF YOU TASTE IT, YOU'LL BE ADDICT'<sup>104</sup> was a trade mark that was refused registration for its obvious reference to drug consumption. In Latvia, the trade mark 'LIVE LIGHT'<sup>105</sup> was refused registration for tobacco on the basis that it contradicted public policy and morality with respect to tobacco and inadvertently smoking.<sup>106</sup> It could be seen as encouraging smoking.<sup>107</sup> Critics might argue that the trade mark in Latvia should have been granted registration as it does not promote an illegal activity.

The EUIPO Examination Guidelines provides a reference on what trade marks have been rejected in the past which is to be used as a guide on what will be rejected in the future as well. The guideline also warns that any trade mark that mentions a link to terrorist organizations and personnel<sup>108</sup> will be rejected.<sup>109</sup> The Board has proved this in its rejection of *Bin Laden*<sup>110</sup> as a

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<sup>103</sup> Toke UK Ltd's Application [2007] E.T.M.R. 9

<sup>104</sup> Extasy if you taste it, you'll be addict trade mark application, France court of Appeal of Paris 2008

<sup>105</sup> Live Light, Trade mark Application M-99-87

<sup>106</sup> WIPO - Standing Committee on the Law of Trademarks, Industrial

Designs and Geographical Indications 'Grounds For Refusal Of All Types Of Marks' (2010)

<[http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo\\_strad\\_inf\\_5.pdf](http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_5.pdf)> [Last Accessed 4 August 2016]

<sup>107</sup> Ibid

<sup>108</sup> List of terrorist organization and personnel <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:023:0025:0029:EN:PDF> [Last Accessed 4 August 2016]

<sup>109</sup> EUIPO Guidelines for Examination

trade mark. Sensitive matters such as this necessitates a strict approach especially since terrorist attacks are becoming increasingly rampant. Approving a trade mark related to such organizations or personnel will be seen as a passive tolerance to such illegal activities which are offensive to public policy and to a certain extent morality.

One anomaly that may be noticed is the fact that in the previous chapter the Swiss government reportedly allowed the registration of ‘BIN LADEN’ for business purposes. While that the government is not aiding illegal activities, the little known fact that the company existed before the terrorist attacks might do very little to change the minds of people.

**e) Insults to Nationality**

It is a widely known and accepted fact that a majority of our products are made in china. That very fact had prompted a registration for ‘NOT MADE IN CHINA’<sup>111</sup> in the EU. The trade mark was rejected as it was deemed offensive to the Chinese public. It was seen as an ‘offensive and a discriminatory act of unfair market practice’ designed to espouse the ‘desirability of avoiding Chinese-made goods’.<sup>112</sup> However, it was most likely meant to inject some humor to the market which has unfortunately backfired. It was seen as mocking the quality of products made in china as it casts ‘an unpleasant slur upon the reputation of Chinese workmanship’<sup>113</sup> Furthermore, granting registration of the mark could inadvertently also harm Sino-Europeans which was cited as a reason to dismiss the trade mark.<sup>114</sup> Hence, it is imperative that examiners be discerning enough to acknowledge the potential harmful effects some trade marks are able to cause.

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<sup>110</sup> Falcon Sporting Goods

<sup>111</sup> Not Made in China Trade mark Application Number: 04631966 and 04631305

<sup>112</sup> Guillermo Criado & Alicia Martin-Santos, ‘NOT MADE IN CHINA Trademark Rejected for Moral Grounds by European Trade Mark Office’ <<http://www.chinaipmagazine.com/en/journal-show.asp?id=320>> [Last Accessed 4 August 2016]

<sup>113</sup> Ibid

<sup>114</sup> Ibid

Similar trade marks have been submitted for registration previously in the US such as ‘NOT MADE IN FRANCE’<sup>115</sup> in a humorous reference to its declining relationship with the US. In that instance it was held that the trade mark was not registrable due to its lack of distinctiveness. Interestingly no other reasons were cited for its refusal.<sup>116</sup>

#### **f) Exploitation of Tragic Events**

Heartless people have often sought to ‘capitalize on misery and misfortune’<sup>117</sup> Days after when the World Trade Center collapsed, when the writers of the free press were unceremoniously killed in cold blood in Paris and more recently when the disturbing news of flight MH17’s disappearance perturbed everyone on the how a massive object could still be missing after all these years, the trade mark registries were flooded with applications to register trade marks such as ‘9/11 MEMORIAL’, ‘JE SUIS CHARLIE’,<sup>118</sup> ‘MH17’<sup>119</sup> and ‘MH170’. Greed has reared its ugly head once again.

The entities that rushed to register the trade mark do so as some jurisdiction follow the rule that the first to file (such as China) and where the idea of defensive trade marks do not exist (such as the UK).<sup>120</sup> The eventual owner of the trade mark ‘exploits[s] licensing opportunities’ which will unjustly enrich the rogue who registered it. It is sometimes incomprehensible as to how the human psyche works as ‘profiteering from the massacre seems as sickening as

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<sup>115</sup> Not made in France Trade mark Application: 78263738

<sup>116</sup> World Trademark Review ‘Legal Updates’

<<http://www.worldtrademarkreview.com/Daily/Detail.aspx?g=60f79c4b-d33c-446a-8d4e-6394dd5a2c48>> [Last Accessed 5 August 2016]

<sup>117</sup> Chris Vindurampulle ‘Je suis Cecil: trademark law and distasteful capitalism’ (2015)

<<http://www.lexology.com/library/detail.aspx?g=5e94eff9-b1db-4f1e-bb47-60a912a309e8>> [Last Accessed 5 Aug 2016]

<sup>118</sup> Je Suis Charlie Trade mark Application: 1668521

<sup>119</sup> MH17 Trade mark Application: 013092937

<sup>120</sup> Tim Lince, ‘Trademarking a tragedy: the need to defend against rogue trademarks of tragic events’ (2014) <<http://www.worldtrademarkreview.com/Blog/Detail.aspx?g=ee50c570-641f-41ee-a0dc-a2fb78239f7d>> [Last Accessed 5 August 2016]

the massacre itself'.<sup>121</sup> The creator of the '*Je Suis Charlie*' created the slogan to show solidarity with the innocent writers as well as stand up for free speech but it has since had more than '50 French trade mark applications for the phrase' of which none are connected with the creator.<sup>122</sup> IP wise, it is conceivable that issues surrounding any trade mark that are related to tragic events should be considered to be of overriding public interest.

It is rather deplorable that human greed has pushed 'trade mark strategy' into discussions of disaster management.<sup>123</sup> It has become a necessity to register trade mark applications to pre-empt rogue applications and 'even domain name disputes'<sup>124</sup>. Clicking on links which are supposedly related to the Malaysia Airlines tragedies diverts the user to a possibly harmful website. It seems that tragedies bring out the worst in people and there are 'individuals see tragic events as a commercial opportunity'.<sup>125</sup> Hence, it would be advisable that a blanket ban mirroring the one put in place for racial slurs be implemented as well.

### **3.3 Summary**

Hence, it is evident that the razor thin line that separates the subject-matter that is objectionable and reprehensible to morality and that which is simply distasteful is challenging to define and the law could aid in providing a better direction to those relying on the law. The various categories have seen their fair share of cases which are difficult to reconcile. It would thus be useful if the authorities could provide a proper definition of morality since it is often referred to and cited as a reason for not registering offensive trade marks.

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<sup>121</sup> Darren Olivier, 'Just how strong is public sentiment?' (2015) 10(5) *Journal of Intellectual Property Law & Practice* 317

<sup>122</sup> Mike Wendling, '#JeSuisCharlie creator: Phrase cannot be a trademark' (2015) BBC News 14 January 2015

<sup>123</sup> Lince

<sup>124</sup> Ibid

<sup>125</sup> Ibid



#### **4. The Dichotomy Between Freedom Of Expression/Speech And Law Of Trade Marks**

Trade marks are considered to be a form of ‘commercial expression’<sup>126</sup> as it enables the proprietors to ‘build a reputation and image around the mark’.<sup>127</sup> Hence, it might be challenging to fathom that such ‘expression attracts some form of protection’,<sup>128</sup> as it is only a reflection of the brand. However, commercial expression falls under the ambit of Article 10 of the ECHR and therefore warrants protection in Europe.<sup>129</sup>

Perhaps there is a discrepancy between the expectations and the actual function of Article 10 by the general public. It has been put forth by Mills that there should be ‘absolute freedom of opinion and sentiment on all subjects, practical or speculative, scientific, moral or theological’.<sup>130</sup> Such a statement is all encompassing and includes immoral marks under its ambit. However, Mills also added that the state should only interfere where the speech causes harm to others.

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<sup>126</sup> Bonadio pp 55

<sup>127</sup> Ilanah Simon Fhima, ‘Trade marks and Free Speech’ (2013) 44(3) *International Review of Intellectual Property and Competition Law* 293-321

<sup>128</sup> Bonadio pp 55

<sup>129</sup> Ibid

<sup>130</sup> John Stuart Mill, ‘On Liberty’ (1869) <  
<http://socserv2.socsci.mcmaster.ca/econ/ugcm/3ll3/mill/liberty.pdf>> [Last Accessed 23 August 2016]

Such a revelation means that there are bound to be conflicts between the freedom of expression and the laws of trade mark and/or copyright. However, it is easy to forget that the freedom of expression/speech is not an absolute right and that it is subject to limitations. Increasingly, there has been academic discourse on the need to reconcile ‘expanding trade mark rights and fundamental freedoms’.<sup>131</sup> It is neither the aim of this chapter nor this paper to reconcile the two.

This chapter will seek to analyze the interaction between the freedom of expression and the limits it places on the law of trade marks particularly the public policy and morality clause. In doing so, it will discuss the framework and purpose of Article 10 of the ECHR. Although a popular concept, the idea of trade marks as a property right<sup>132</sup> will not be discussed due to the limitations of this thesis.

#### **4.1 You May (Not) Speak Freely – An Analysis Of The Interaction Between Article 10 And Trade Mark Laws**

Article 10 of the ECHR reads as follows:-

‘1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.’

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<sup>131</sup> Martin Senftleben & others, ‘Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law’ (2015) 37(6) *European Intellectual Property Review* 337-343

<sup>132</sup> Protocol 1, Article 1 of the ECHR

This widely enjoyed fundamental right is layered and can be unpacked further from the given provision. First and foremost, the right allows an individual to speak freely. It preserves our right to speak freely without being discriminated. Secondly, the notion covers not just ‘information’ or ‘ideas’ that are positive and neutral but also speech/expressions that could ‘offend, shock or disturb’.<sup>133</sup> Lastly, the right is not an absolute right as evidenced by the existence of a caveat in Article 10(2). Therefore, it is clear that any restriction must be prescribed by law. Additionally, any restriction placed must be examined by a two-pronged approach before implementation. The first hurdle to overcome is necessity. The measure taken must have been necessary in order to meet a ‘pressing social need and the restriction must be proportionate to that aim’.<sup>134</sup> The second requires that the measure was implemented in ‘pursuit of a legitimate aim’.<sup>135</sup> Contextually, that would refer to the restrictions on the registration of immoral trade marks and the need to protect public order and accepted principles of morality. The hallmark of a functioning democracy is unfettered expression/speech. It was held that ‘the authorities of a democratic state must tolerate criticism, even if it may be regarded as provocative or insulting’.<sup>136</sup> The list of exceptions in Article 10(2) is a closed list.

The court has also clarified that it makes no conscious distinction between different types of speech.<sup>137</sup> Hence, in theory, various forms of expressions, including political, artistic and commercial expressions are protected.

In the case *Casado Coca v Spain*<sup>138</sup> where the European Court of Human Rights (ECtHR) held that an applicant’s name, occupation, address and contact number was commercial expression under Article 10 as it conveyed useful information to the public. Hence, it is highly likely that the same approach will be adopted towards trade marks that are capable of conveying equally useful information to the consumers.

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<sup>133</sup> *Zana v Turkey* (1999) 27 EHRR 667, para 50; *Lehideux and Isornia v France* (2000) 30 EHRR 665 para 55

<sup>134</sup> *Simon Fhima*

<sup>135</sup> *Ibid*

<sup>136</sup> *Özgür Gündem v. Turkey*, No. 23144/93, judgment of 16 March 2000, Reports 2000-III, §43.

Although the case is a non-IP related case, it highlights the impartial attitude that states must adopt even towards insulting speech falling short of hate speech which may be regulated by laws.

<sup>137</sup> *Müller v. Switzerland* [1988] 13 EHRR 212, para 27

<sup>138</sup> *Spain* (1994) 18 EHRR 1 at [37]

The ECHR interprets Article 10 as ‘imposing positive obligations only in extreme cases’.<sup>139</sup> In *Ozgur Gundem v Turkey*<sup>140</sup>, the applicant newspaper’s personnel were attacked by unidentified men causing them serious injuries. The State did not offer help, despite knowledge of the circumstances, was held to constitute a violation of Article 10<sup>141</sup>. In less severe situations, the Court has been ‘reluctant to impose positive obligations’.<sup>142</sup> In *Appleby v United Kingdom*, it was stated that there was no violation of the right to freedom of expression/speech when the state did not assist in securing ‘access for protestors to a privately-owned shopping center’.<sup>143</sup> While the context from the cases may differ from the nature of this article, it nevertheless illustrates the Court’s unwillingness to impose positive obligations save for situations where the ‘essence of the right’<sup>144</sup> in Article 10 is affected.

EU being a non-signatory to the ECHR, although a large proportion of EU Member States are, is a surprising revelation.<sup>145</sup> The future does not bode well either as future accession to the ECHR will prove difficult in light of Opinion 2/13.<sup>146</sup> However there has been recognition of the freedom of expression/speech issues in trade mark registration given that the right is also enshrined in the Charter. Furthermore, by virtue of the Member States being signatories to the ECHR, rest assured that they need to comply with the Articles strictly thereby erasing doubts of uniform rights throughout Europe.

#### **4.2 A Trade Marks Paints A Thousand Words – An Analysis Of Trade Marks As Expressions/Speech**

In the myriad of cases we have seen above, trade marks had been refused registration on the basis of it being offensive to ‘public policy and accepted principles of

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<sup>139</sup> Jonathan Griffiths, ‘Is there a right to an immoral trade mark?’ (2009) *Intellectual Property and Human Rights* (P Toremans (ed) Kluwer Law International) pp 309-334

<sup>140</sup> (2001) 31 EHRR 49

<sup>141</sup> Griffiths (n 138)

<sup>142</sup> Ibid

<sup>143</sup> (2003) 37 EHRR 38.

<sup>144</sup> Ibid

<sup>145</sup> Simon Fhima

<sup>146</sup> Opinion 2/13 on the Draft Agreement on the Accession of the European Union to the European Convention for the Protection of Human Rights and Fundamental Freedoms EU:C:2014:2454; unreported 18 December 2014 (ECJ);

The Draft accession agreement was found to be incompatible with EU law.

morality'. However, some of the trade marks could have been registered. The freedom of expression/speech notion appears to be side-lined to cater to society's needs. While prioritising the public policy and morality is a valid reason, the modus operandi of it has been less than consistent. Some of the banned phrases could have been registered and by not doing so amounts to an infringement on the freedom of expression/speech.

#### **4.2.1 Interference**

A large proportion of the cases have attempt to avoid the awkward predicament of answering to Article 10 by dismissing the possibility of infringement with the freedom of expression/speech. The rationale is that refusal of registration is not akin to prevention of use of the trade mark and therefore does not impede on the applicant's freedom of expression/speech.<sup>147</sup> Similar arguments were made across the Atlantic where the US courts can be accused of bypassing the challenging question.<sup>148</sup> It would be however be more critical to observe the 'chilling effect' that the laws may have on the notion of expression in trade mark. 'A chilling effect is where the activity in question may not in fact be illegal, but uncertainly regarding its legality deters actors from engaging in it'.<sup>149</sup> Hence, the very act of refusing registration to trade marks causes skepticism on the validity of freedom of expression/speech. This section will review the freedom of expression/speech aspect in terms of the categories put forth by Baird.

##### **a) Religious nexus**

Apparently, a 'free speech-friendly approach' was taken in *Basic's Trade Mark Application*'.<sup>150</sup> In that case, 'JESUS' was being registered as a trade mark for various classes of goods such as clothing. Article 10 was acknowledged as 'providing the disciplined approach that would ensure the that the analysis of (im)morality was objective'.<sup>151</sup> It was also submitted that a trade mark will have to be deeply disturbing for it to be refused registration. It

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<sup>147</sup> *Ghazilian's Trade Mark Application* [2005] ETMR 57 at [22];

<sup>148</sup> Stephen Baird "Re McGinley glosses over a difficult constitutional question when it suggested that First Amendment interests are not implicated by Section 2(a) because the "refusal to register mark does not affect his right to use it""

<sup>149</sup> Illanah Simon Fhima footnote 58; See further, Note, "The Chilling Effect in Constitutional Law"

69 *Columbia Law Review* 808 (1969).

<sup>150</sup> [2006] ETMR 24

<sup>151</sup> Simon Fhima; *Basic's Trade Mark Application* [2006] ETMR 24 paras 31

was held by the UK court that usage of the ‘ultimate Christian name’ might be viewed as ‘anti social by reason of its ability to undermine an accepted social and religious value’.<sup>152</sup> It was extrapolated that religious groups may view the use of a religious icon for commercial purposes to be unacceptable. However, it also put forth the applaudable view that ‘any doubt must be resolved in favour of free speech’.<sup>153</sup>

However, the same trade mark was allowed registration by the Benelux Bureau for Intellectual Property Office (BBIP). The countries that belong to the Benelux are Belgium, Netherlands and Luxembourg. However, it is disturbing to note that the three countries and the UK are under the EU and are signatories to the ECHR. All of them are predominantly Christian and yet the UK refused registration of the same Italian brand that was allowed in the Benelux. There is an obvious difference in the way both groups had treated the same trade mark. The argument used in the UK of offending a large group of Christians is not necessarily applicable as the Benelux is also predominantly Christian. The refusal of registration in the UK is difficult to reconcile with that in the Benelux and eventually Article 10.

The word ‘HALLELUJAH’ is another word that belongs to the nexus of Christianity. The word however is often used as an interjection or to show gratitude and rarely used in a full sentence. Nevertheless, it is a word that is so specific to Christianity that any consumer will immediately recognize it as a word belonging to that religion. The words ‘HALLELUJAH’ was sought for registration for Class 25 which includes but are not limited to clothing, footwear and swimwear. The UK once again refused registration on the basis of it being ‘contrary to public policy and accepted principles of morality’. A recent search on the UK registry yields 4 trade marks with ‘HALLELUJAH’. However, none of them are registered for Class 25 per se but instead registered for Class 9: audio accessories, Class 31: rose plants and related products but has a protected status.

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<sup>152</sup> Ibid

<sup>153</sup> Ibid

The search also showed a long text trade mark which includes the words ‘HALLELUYAH’<sup>154</sup>. Although it has a different spelling, the pronunciation is essentially the same. Currently the trade mark has been published, whether it will be successful for registration remains to be seen. An inkling is that it may be registered as the applicant is a family church in the UK as opposed to a non-Christian/Catholic organization. It also raises questions as to whether the same standard may be applied or will a religious organization be allowed greater freedom. If the later results, then the question of consistency in the application of the ‘offensive to public order and accepted principles of morality’ understanding arises. The quest for freedom of expression/speech will also be tainted with yet another decision that will not make legal sense. It will seem that preferential treatment is given to particular organisations.

A closer analysis yields nothing but weak reasoning and shameful paternalism on the part of the UK where the freedom of expression/speech ends up being the unwilling and innocent victim.

#### **b) Racial Slurs**

Favor to society was indeed being done when OHIM placed a blanket on racial slurs. While racist remarks may have been acceptable in the earlier part of the twentieth century, ‘an era politically and economically dominated by white men’,<sup>155</sup> society has also progressed to be more inclusive and racist slurs let alone racist trademarks should not have a place in today’s multi-cultural society.

However, racism can also exist in different permutations. With the growing suspicion of Muslims, Islam has been wrongly demonized. Islamophobia has been ‘denied as a problem and defended as a practice’.<sup>156</sup> Condemning bad-mouthing of Muslims is often counter claimed as ‘they [Muslims] are not a

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<sup>154</sup> HALLE NIGHT, A NIGHT OF GRAND COMMUNITY PRAISE, WHY HALLOWEEN WHEN YOU CAN HALLELUYAH, HALLELUYAH NIGHT Trade mark Application: UK00003163576

<sup>155</sup> Bonadio

<sup>156</sup> S Sayyid, ‘Racism and Islamophobia’ (2011) <  
<https://www.unisa.edu.au/Documents/EASS/MnM/commentaries/sayyid-racism-islamophobia.pdf>>  
 [Last Accessed 23 August 2016]

race'.<sup>157</sup> While it may be true, racism 'does not depend on the actual existence of races'.<sup>158</sup> Looking back at history, the German Jews and Bosnian Muslims are still considered to be 'racist genocidal violence' and in either case it was not about being advocating their beliefs or being involved in a religious rituals.<sup>159</sup> It is unfortunate that a woman who dons the hijab is automatically subjected to dirty looks or threats of violence and anything in between. As it is, the current atmosphere in the world has been fragile lately and the world could do without an extra avenue for racists to exploit. Hence the blanket exclusion espoused by OHIM is a saving grace amidst their (including other decision making authorities) lack of recognition of freedom of speech/expression.

**c) Vulgar Matter, Sexual Content And Innuendo**

The phrase 'FUCK CANCER' is one such example. While the word 'FUCK' alone attracts intense emotions usually of the negative kind, it may not necessarily be always the case. When our favorite swear word<sup>160</sup> is paired with the right word, it can cushion the impact of the word or even detract attention from it to form a phrase that has almost no vulgar value. Hence the phrase 'FUCK CANCER' could almost be seen as a motivational phrase to show solidarity with those battling cancer. Such motivational phrases should therefore be allowed registration if not for its vulgar language at least for the fundamental right to freedom of expression. Such freedom of expression is lost to the prudishness of the examiners.

The decisions churned out by the authorities continue to puzzle those who encounter it to the extent that it is almost laughable. In the UK, registration

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<sup>157</sup> Ibid

<sup>158</sup> Ibid

<sup>159</sup> Ibid

<sup>160</sup> Leo Benedictus, 'What are the most popular swearwords on Twitter?' (23 February 2014) *The Guardian* <<https://www.theguardian.com/technology/shortcuts/2014/feb/23/most-popular-swearwords-on-twitter>> [Last Accessed 9 August 2016]

A research has shown that in Twitter-verse, the word 'fuck' was used a total of 51 million times which accounts for 34.7% and a far second was 'shit' (15.0%) and 'ass' (14.5%) of all swear words. See also Kate Knibbs, 'Curses! People swear a lot on twitter and here are the most popular words' (2014) <<http://www.digitaltrends.com/social-media/popular-curse-words-twitter/>>



was refused for the trade mark ‘TINY PENIS’ for various articles of clothing. It was held that it is likely to undermine ‘current religious, family or social values’<sup>161</sup> as the public may view it.

However, if one were to contrast some of the authorities’ decisions particularly OHIM’s refusal to register trademarks carrying ‘strong sexual undertones’ with that of the BBIP, one would see a striking contrast. The BBIP has allowed registration of the following word marks: FUCK ME Dans la mousse<sup>162</sup> and FUCK<sup>163</sup> (the word ‘FUCK’ has been registered as a design in the EU for only towels with a picture of a bee flipping the finger as shown below). Additionally, the following figurative marks have also been registered: ‘and PUSSY LOUNGE’ ‘FUCK ME I AM FAMOUS’ and ‘LULLIG’ (as shown below). However, ‘FIST FUCKER’<sup>164</sup> and ‘FUCKINGMACHINES’ were denied registration. The irony in their denial was that it lacked distinctiveness instead of the often-cited approved textbook reasoning of ‘being contrary to public order or morality’.

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<sup>161</sup> Bonadio, footnote 14: U.K. Trademark Application Serial No. 2232411 (filed May 13, 2000); *application denied*, p. 2 (Jan. 9, 2001).

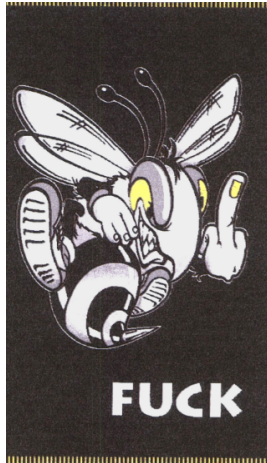
<sup>162</sup> Trade mark Application Number: 0867955

<sup>163</sup> Trade mark Application Number: 000109376-0001(EU); 0779197 (Benelux)

<sup>164</sup> Tom Reingraber, ‘Public order and morality as grounds for refusal within trademark law: European and comparative approach’(2011/2012)

<[https://euipo.europa.eu/knowledge/pluginfile.php/...data/.../REINGRABER\\_Tom.pdf](https://euipo.europa.eu/knowledge/pluginfile.php/...data/.../REINGRABER_Tom.pdf)> [Last Accessed 13 August 2016] see footnote 332

This trademark application was part of a series of fictional trademark applications, filed at the launch of the Benelux Trademark Bureau in 1996, which is now part of the Benelux Bureau for Intellectual Property (cfr. supra paragraph 4). These fictional trademark applications were non-official applications, filed in order to examine the scope and limits of contradiction to public order and morality as grounds for refusal (cfr. infra paragraph 98) However, since this trademark application is not official, it is impossible for me to refer to an official application number or an official decision of the former Benelux Trademark Bureau. Nonetheless, the existence of the fictional trademark application ‘FIST FUCKER’ as well as its refusal due to its descriptiveness has been confirmed by several authors. Cfr. T. COHEN JEHOAM, C.J.J.C. VAN NISPEN and J.L.R.A. HUYDECOPER, *Industriële eigendom Deel 2: Merkenrecht*, Kluwer, Deventer, 2008, 211 and B. KIST and W. HEEMSKERK, “Lul de behanger en andere dubieuze merken”, *BMM Bulletin* 2008, nr. 1, 15 - 16.



Fuck as a design



Pussy lounge wild for women only' as a figurative trademark<sup>165</sup>



'Fuck me I am famous!' as a figurative trademark<sup>166</sup>



'lullig' as a figurative trademark<sup>167</sup>

<sup>165</sup> This trademark was allowed for goods and services such as clothing, footwear, headgear; paper, cardboard materials, office supplies; catering services; managing and exploiting intellectual property rights.

<sup>166</sup> This trademark was allowed for goods and services such as paper, cardboard materials, office supplies; clothing, footwear, headgear; advertising

While this may be a cry that freedom of expression/speech exists, it has reached the point of absurdity where all predictability has been lost on what is permissible and what is not. Less vulgar trade marks have been rejected while offensive ones have been given the nod.

It appears that the threshold for offensive trade marks is higher in some Member States than others. The decisions are difficult to reconcile. The lack of uniformity is a worrying factor for freedom of speech/expression fundamentalists not only with regards to trade marks but presumably generally.

**d) Suggesting or promoting illegal activity**

A similar approach has been taken in this aspect as that with racial slurs. Freedom of expression should be a priority however it comes with caveats that should be respected. Furthermore as opined earlier, the state may be seen as promoting illegal activity if trade marks of this nature are registered.

**e) Insults to nationality**

An application to register the trade mark ‘Not Made in China’ was rejected by OHIM. The application drew outrage and the Chinese expressed their disgust by sending in over 10,000 signatures from individuals and companies. OHIM assessed the trade mark against ‘public policy and accepted principles of morality’. It was also determined that it could potentially ‘harm Sino-European diplomatic ties’.<sup>168</sup>

However, from the freedom of speech/expression viewpoint, it is supposed to be humorous jab since most products are made in China and could be seen as a ‘tribute to the success of Chinese goods’ as most goods are made in China.<sup>169</sup> Hence, it seems that the Chinese population that were offended blew the issue out of proportion. The right to freedom of speech/expression suffers a blow merely because some of them are unable to take a joke in their stride.

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<sup>167</sup> This trademark was allowed for goods and services such as paper, cardboard materials, postcards, posters; household equipment; mouse mats, bags, backpacks.

<sup>168</sup> Criado & Martin-Santos

<sup>169</sup> Ibid

However, perhaps the conflict between trade mark law and freedom of expression/speech may be warranted. The fact that there is a remote possibility that Sino-European relations can be harmed is contrary to public order which is part of the exceptions in Article 10(2).

#### **f) Exploitation Of Tragic Events**

The freedom of expression argument is a tricky one to utilize in this category. There are widespread opinions that rogue trade mark applications should be rejected but the difficulty in detecting them will make it a heavy handed task. Hence the easy way out will be to reject most of the trade marks that come through. This approach will give/gives no regard to the freedom of speech/expression.

After the Charlie Hebdo attacks, there was a rush to register ‘*Je Suis Charlie*’ as a trade mark. The French IP office alone has thrown out at least 50 such applications.<sup>170</sup> One of the many reasons for the rejection was that it lacked distinctive character. However it appears that the French Trademark Office was sidestepping the issue to discuss whether the trade mark was indeed contrary to public order or accepted principles of morality.

Nevertheless, ‘on the face of it there is nothing disparaging or offensive’ about the coined phrase.<sup>171</sup> In addition, the phrase has a ‘positive connotation’ as it is relevant to the ‘freedom of expression movement that happened after the tragic events’.<sup>172</sup>

In response to that, it has been argued that not granting registration based on the application being against public order and morality was valid because “free riding on a catastrophic happening and claiming a monopoly on use of a

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<sup>170</sup> Tim Lince, ‘Trademarked or not, ‘*Je Suis Charlie*’ commercialization steps up’ (2014) *World Trademark Review* <<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=d4bcc4d6-b033-4740-9bfb-5d4c81b59490>> [Last Accessed 15 August 2016]

<sup>171</sup> Ibid

<sup>172</sup> Tim Lince, ‘*Je suis* a trademark? Slogan-related application just the latest in a growing trend’ (2015) *World Trademark Review* <<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=1518ebee-cf96-404c-b248-375a69c86e0b>> [Last Accessed 5 August 2016]

slogan incorporating one of the main rights of the Convention for the Protection of Human Rights and Fundamental Freedoms (ie, the freedom of speech) can be considered as immoral<sup>173</sup>

#### **4.2.2 Overall**

The difference in the standards of the freedom of expression can be attributed to the wide margin of appreciation the ECtHR accords to national authorities. Furthermore, it can be derived from the evidently contradicting registrations peppered throughout Europe that some countries give more consideration to the freedom of expression/speech element. It would also seem that the applicant has to study the various systems in Europe and register at the ‘correct’ one to ensure a higher likelihood of success.

It is also conceded that there are valid rationales for the authorities to limit freedom of expression/speech to pursue more pertinent aims. However, the attitudes of the authorities are uptight and their prudishness may inadvertently undermine the right to freedom of expression/speech.

Before moving on to the next chapter, here is some food for thought. A refusal of registration does not prevent the trade mark from being used. A refusal of registration merely means that owners of the mark are not able to seek legal redress if someone copies their mark without permission, as the mark is not given legal protection. Hence, it is possible that the mark may be used even more widely than intended due to the prevalence of copying. The opposite effect of the aim of the authorities, which was to prevent the public from viewing it, may ironically actually occur. In that instance, the trade mark owners may actually seek legal redress through the tort of passing-off. Although there is a dearth of case laws in this specific area, it will not be a surprise if the passing off action fails as allowing them to be successful would produce assumed tolerance of the offensive trade mark encouraging the trade mark owners to be steadfast in their fight to keep their offensive trade mark alive; a

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<sup>173</sup> Tim Lince, ‘*Je suis* a trademark? Slogan-related application just the latest in a growing trend’ (2015) *World Trademark Review* <<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=1518ebee-cf96-404c-b248-375a69c86e0b>> [Last Accessed 5 August 2016]

situation the authorities may want to avoid. However, if the passing off action fails, it would then raise questions of the integrity of the passing-off actions.

### **4.3 Summary**

There is a clear conflict between the notion of public policy and accepted principles of morality and the right to freedom of speech/expression. The conflict could be attributed to existing flimsy definition of public policy and morality. It could also be due to the fact that there is a variation in the threshold of tolerance of offensive material in public. With both of these factors combined, the deciding authorities such as OHIM and the various courts need to balance the right to of freedom/expression against that of the need to allow people to express themselves through trade marks. A strict approach could muzzle the right to freedom of expression which may unwittingly stifle creativity. On the other hand, ‘an overly liberal approach could cause outrage and moral indignation’.<sup>174</sup> It is important to approach this issue with reasonableness against the background of national contexts.

Nevertheless, there remains a need to preserve the public order and morality which is recognized by Article 10(2). There will always be a pandemonium with regards to offensive trade marks and the freedom of expression/speech and the Courts/OHIM have the difficult task of balancing the both.

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<sup>174</sup> Humphreys

## **5. A Look Across the Atlantic**

Looking across the Atlantic to the US, there is a wealth of cases in this aspect of the law to draw from. The American have been known to be proud of their strong tradition of free speech which is enshrined in the First Amendment and is almost untouchable. The chapter will briefly look at how the US balances the right to freedom of speech/expression with offensive trade marks. This chapter will conclude by showing how the law of trade marks and the freedom of expression/speech provisions should ideally interact.

### **5.1 The First Amendment**

The First Amendment in the Bill of Rights is:-

‘Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of

the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.’<sup>175</sup>

The First Amendment was initially thought to be absolute but the Supreme Court has made necessary additions or rather exclusions to the freedom of expression. It is stated that some categories are prohibited in its entirety such as ‘obscenity, child pornography and speech that constitutes so-called “fighting words” or “true threats”<sup>176</sup> In addition, there will be ‘less than full protection to commercial speech, defamation (libel and slander), speech that may be harmful to children, speech broadcast on radio and television (as opposed to speech transmitted via cable or the Internet), and public employees’ speech’.<sup>177</sup>

## **5.2 The Lanham Act**

Their equivalent provision for protecting trade marks is found in the Lanham Act (15 USC §§ 1051-1127). The specific statute relevant to the thesis can be found in Section 2(a) of the Lanham Act which states:-

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –

- (a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection

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<sup>175</sup> First Amendment - Bill of Rights <<https://www.billofrightsinstitute.org/founding-documents/bill-of-rights/>> [Last Accessed 15 Aug 2016]

<sup>176</sup> Kathleen Ann Ruane, ‘Freedom of Speech and Press: Exceptions to the First Amendment’ (2014) *Congressional Research Service* <<https://www.fas.org/sgp/crs/misc/95-815.pdf>> [Last Accessed 15 August 2016]

<sup>177</sup> Ibid



with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

While it may appear that the provision prevents the use of disparaging trade marks, in reality, only the registration is not permitted. There is no provision barring the use of the trade mark. This parallels the European idea where trade marks need not be registered for use. A registration only merely protects the trade mark by allowing right owners prevent others from using the trade mark. The equivalent provision for unregistered trade mark can be found in Section 43(a) of the Lanham Act (15 U.S.C. 1125(a) (1998), which prohibits the use of marks, registered or not, which may cause confusion as to origin, sponsorship, or approval of goods or services.

### **5.3 The Collision Course: Case Analysis**

There have been numerous cases that have constantly challenged the boundaries of the First Amendment in the US. This sub-chapter will look at 3 different cases briefly and the importance the case highlights.

‘QUAKER’, a brand known for its oats, challenged a bill that would ‘criminalize future use of QUAKER as a trade mark’.<sup>178</sup> The oats company was also being challenged by The Society of Friends who are also commonly known as Quakers. The Quakers denomination were offended by use of its ‘nickname and its and its good character, as a trademark to sell goods’.<sup>179</sup> It was also argued that a majority of the American population was not offended hinting that it was the general population’s opinion mattered more than the ‘referenced group’.<sup>180</sup> The oats company also highlighted that ‘QUAKER’ has other meanings as well hinting at the possibility that the American population may not even link Quaker oats with the easily offended group.

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<sup>178</sup> Jasmine Abdel-kalik, ‘Disparaging Trademarks: Who Matters’ (2015) 20(2) *Michigan Journal of Race and Law* 288-319

<sup>179</sup> Ibid see footnote 1: *Use of Name of Religious Organizations: Hearings on H.R. 15401 Before the H. Comm. on the Judiciary*, 63rd Cong., 3d Sess. 16 (1914)

<sup>180</sup> Ibid

However, the image that accompanies the trade mark belies that possibility. The cases reminds us of the European ideology of offending a small group of people and that a trade mark does not need to be rejected because it offends the minority. This case also ask the important question of ‘who matters’<sup>181</sup> which mimics the equivalent concern in Europe of who the public/ target audience is. This case shows that the US perspective do occasionally struggle with the notion of the public as well.

A discussion on American perspective that lacks mentioning the high profile case of the REDSKINS is without merit. The trade mark law case has been a longtime in the making. It has been the ‘subject of organized protests since 1968 and ongoing litigation in US courts since 1992’.<sup>182</sup> The ‘REDSKINS’ trade mark, which belongs to the Washington National Football League (NFL) team was unceremoniously cancelled in 2014.<sup>183</sup> For the uninitiated, the term Redskin is offensive to Native Americans and is tantamount to calling an African American ‘Nigger.’ It perpetuates negative stereotypes of Native Americans and is therefore considered to be racist and degrading.

Five Native-American petitioners filed for the cancellation. The NFL team has since argued that the cancellation amounts to improper penalization ‘based on the content of the team’s speech in violation of the First Amendment’<sup>184</sup> with particular reference to ‘The Congress shall make no law...abridging the freedom of speech’.<sup>185</sup> The lawyers for NFL have also rightly pointed out the numerous offensive trade marks that sit on the register that are far more disparaging and offensive that ‘REDSKINS’. The Trademark Trial and Appeal Board (TTAB) that cancelled their trade mark and reasoned that the mark ‘still retained it derogatory meaning’ although the public usually associates it with the NFL team.<sup>186</sup> A positive outcome of this case resulted in allowing the majority white population in American to understand why the term

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<sup>181</sup> Ibid

<sup>182</sup> see footnote 2 in Christine Haight Farley, Registering Offense: The Prohibition of Slurs as Trademarks’ in Irene Calboli & Srividhya Ragavan (eds) *Diversity in Intellectual Property: Identities, Interests and Intersections* (Cambridge University Press, 2015) pp5-129

<sup>183</sup> *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (Lexis) 1080, 1082 (T.T.A.B. 2014)

<sup>184</sup> Hammad Rasul, ‘The Washington Redskins’ Deflating

Hope: The Lanham Act Survives The

First Amendment Challenge’ (2015) 26(1) *Marquette Sports law Review* 159-179

<sup>185</sup> US Constitution, First Amendment

<sup>186</sup> Farley (n 185)

‘REDSKINS’ may be disparaging and offensive to them.<sup>187</sup> However, the decision has attracted criticism that the First Amendment has been violated. This argument has been put forth on the basis that the NFL use of the term ‘REDSKINS’ falls under commercial use and is thus protected under the First Amendment.<sup>188</sup> It has also been argued that while the legitimate aim of denying the registration for the purposes of racial harmony is valid, it is tough for the government to prove that their action would ‘materially advance that interest’.<sup>189</sup> As the case continues to play out in front of the courts and the media simultaneously, there is yet another case that could potentially help the ‘REDKINS’ in their arguments.

*In re Tam*<sup>190</sup>, an Asian-American rock band’s attempt to trade mark their band name ‘THE SLANTS’ was denied registration on the ground that the name was ‘a highly disparaging reference to people of Asian descent’.<sup>191</sup> Section 2(a) of the Lanham Act was invoked. The band, which is made up of Asians, saw (pun unintended) things differently. They came up with the name in a bid to ‘reclaim and take ownership’ instead of being ‘offended by stereotypical descriptions’.<sup>192</sup> The US Court made a familiar argument that has been echoed by Europe courts before – that denial of registration of the trade mark does not prevent the trade mark from being used and does not ‘implicate the First Amendment’.<sup>193</sup> Such an approach shows the shameful cowardice that the Courts have displayed in their sloppy attempt to avoid implicating the First Amendment.

The claimants then appealed to the Appeals Court which rightly pointed out that it is the ‘bedrock principle underlying the First Amendment that the government may not penalize private speech merely because it disapproves the message it conveys’ and goes on to state that ‘the First Amendment protects even hurtful speech’.<sup>194</sup> The close reading provided by the US Court of Appeals for the Federal Circuit provides an

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<sup>187</sup> Ibid

<sup>188</sup> Jeffrey Lefstin, ‘Does the First Amendment Bar Cancellation of Redskins?’ (2000) 52(3) *Stanford Law Review* 665-708

<sup>189</sup> Ibid

<sup>190</sup> [2015] 785 F.3d 567; 2014-1203

<sup>191</sup> Global Freedom of Expression, ‘Case Analysis’ *Columbia University* (2016)

<<https://globalfreedomofexpression.columbia.edu/cases/in-re-simon-shiao-tam/>> [Last Accessed 18 August 2016]

<sup>192</sup> *In re Simon Shiao Tam* [2015] 2014-1203

<sup>193</sup> Ibid

<sup>194</sup> Ibid

epiphany. Perhaps the federal circuit courts knew that the registration may not be denied although it is inherently racist. The judges thus allowed their convictions to get better of them and ahead of the law. While the federal court judges may have reached their decision with the greater good of the society in mind, it must be highlighted that ‘it should be up to the public, not the government, to drive bad ideas from the marketplace’.<sup>195</sup>

Thus, the Court of Appeals’ action in overturning the decision from the lower court and allowing the registration of ‘THE SLANTS’ is a boost for free speech. The Court also labeled the group’s decision to register the name as private speech thus forbidding the government to intervene merely because they ‘disapprove the message it conveys’.<sup>196</sup> A victory on this front could lend some motivation for the legal team over at Washington Redskins which will be buoyed by the success of ‘THE SLANTS’ due to the similarities in the nature of the cases. The ‘REDSKINS’ have also made similar arguments to that found in ‘THE SLANTS’. The case will allow the ‘REDSKINS’ to demonstrate that the name is indeed not offensive after battling for close 50 years. One has to keep in mind that ‘THE SLANTS’ were not registered initially whereas ‘REDSKINS’ were registered and opposition to the name only came thereafter causing some cancellation of their marks. Although the decision is not binding, it remains persuasive. Nevertheless, it is a breakthrough decision that will shatter opinion held by the majority that ‘the federal government can refuse registration or use of a trade mark based on whether certain groups find the mark to be disparaging’.<sup>197</sup>

In filing their appeal for the six cancelled trade marks, ‘REDSKINS’ pointed to the trade mark register which hosts a slew of rude and vulgar trade marks far more offensive than ‘REDSKINS’. These include ‘TAKE YO PANTIES OFF’ clothing, ‘SLUTSSEEKER’ dating services and ‘MILFSDOPORN.COM’ pornography.

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<sup>195</sup> Lee Rowland & Samia Hossain ‘The Government’s Trying to Sell a New Slant on the First Amendment. We’re Not Buying It. (Updated)’ (2015) *American Civil Liberties Union* < <https://www.aclu.org/blog/speak-freely/governments-trying-sell-new-slant-first-amendment-were-not-buying-it-updated>> [Last Accessed 18 August 2015]

<sup>196</sup> *In re Simon Shiao Tam* [2015] 2014-1203

<sup>197</sup> Richard Sandomir, ‘Ruling Could Help Washington Redskins in Trade mark case’ *New York Times* (New York, 22 December 2015) < [http://www.nytimes.com/2015/12/23/sports/football/washington-redskins-trademark-nickname-offensive-court-ruling.html?\\_r=0](http://www.nytimes.com/2015/12/23/sports/football/washington-redskins-trademark-nickname-offensive-court-ruling.html?_r=0)> [Last Accessed 18 August 2016]

Although it may be argued that the list is largely compiled from the adult entertainment industry, it does not mean that the vulnerable section of the society such as children and the conservatives may not stumble upon the rude trade marks. Since protection may be granted for far more offensive trade marks surely, 'REDSKINS' may be granted protection.

It should be noted that trade marks such as 'THE SLANTS' OR 'REDSKINS' do not fall under the excluded ambit of the First Amendment which constitutes 'libel, incitement to violence, obscenity, child pornography, fighting words, or false advertising'. A critic of the 'REDSKINS' decision succinctly captured the how the interaction of the law of trade marks and the First Amendment (Article 10 of the ECHR is relevant here as well) should ideally interact:-

Rather than artificially manipulating trademark law to eliminate marks that “may disparage,” sound First Amendment policy recommends that the marketplace solve the problem. Thus, if enough people refuse to support The Slants or Washington Redskins—or any other marks that “may disparage”—due to their objections to the offensive nature of those names or images, that conduct (i.e., refusal of support), and not an abridgement of the First Amendment, will provoke change.<sup>198</sup>

Many will wait eagerly in anticipation for the outcome of the 'REDSKINS' decision now that 'THE SLANTS' have been granted registration. Essentially, the 'THE SLANTS' has widened the scope of the First Amendment.

#### **5.4 Summary**

The American system on the law of trade marks poses disturbing questions as to the existence of extremely vulgar trade marks in the system and the rejection of lesser vulgar ones. Although the registration appears more polarized than in Europe, there is a little more freedom in the way people may express themselves. Although the right is not absolute in either the US or Europe, There is a much higher degree of importance

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<sup>198</sup> Russ VerSteeg, 'Blackhawk Down or Blackhorse Down? The Lanham Act's Prohibition of Trademarks that "May Disparage" & the First Amendment' (2016) 68(4) *Oklahoma Law Review* 677-771

given to the freedom of expression/speech in the US. The Americans have also showed us how the freedom of expression and the law on trade marks should ideally interact.

## **6. Recommendations**

Any analysis of a problem should always be accompanied by a proposition of solution(s) and that is precisely the aim of this chapter. While this thesis does not claim to be able to solve the problems, it will nevertheless attempt to provide an understanding of the different approaches that may be taken. This thesis will not engage in frivolous and overly ambitious measures. It will however try to reconcile the gaps in the EU law and make some humble suggestions to overcome them.

The thesis will look into how the law can be improved to provide more certainty to the often used ‘public policy and accepted principles of morality’. There is also a need for the EU to learn from the America on giving greater importance to the freedom of expression/speech.

### **6.1 A More Certain System**

The EU system will greatly benefit from having clear boundaries for the term ‘public policy and accepted principles of morality’. As discussed earlier, ‘public policy’ is a

non-issue. Hence, the problem lies with defining morality. Morality is a notion that can never be defined easily. Owing to the lack of a clear definition, trade marks that are concerned with morality have resulted in the authorities churning out inconsistent decisions.

In conservative Singapore, where there is a similar clause on public policy and morality, the Intellectual Property Office of Singapore (IPOS) has released a guide which includes elaborations of marks that may be considered to be contrary to public policy or morality.<sup>199</sup> The comprehensive IPOS manual outlines a non-exhaustive category of marks that would be contrary to morality. Within each category, there are detailed explanations of how the trade mark may be negatively perceived and its possible catastrophic effects on society. The categories identified by IPOS are largely similar to those identified in Chapter 3 of this thesis and these are: a) religious connotations b) racial, ethnic, religious or gender disparagement c) profane content d) vulgar content e) sexual content f) innuendo g) suggesting or promoting illegal activity.<sup>200</sup>

Each category is spelt out in detail with the appropriate standards to abide by. They are far less ambiguous compared to the EUIPO's guidelines. Nevertheless, the EUIPO provides the reader more insight into the examination process and includes examples of rejected trade marks that contravened the public policy and accepted principles of morality clause. However, it must be criticized for its poor presentation thus potentially causing difficulty for the man on the street to understand the contents. Hence, there are clear advantages from adopting a straightforward and clear method of classifying the categories and being transparent about the relevant standards that should be applied to each one. Thus supplementing the existing EUIPO guidelines with the version by IPOS would greatly benefit the system. This area of law will continue to remain very relevant and important as we have seen from the discussion. There are an increasing number of applications made for trade marks as evidenced by the surge in registrations post-Charlie Hebdo and other tragic events.

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<sup>199</sup> IPOS Trade Marks Work Manual Chapter 9 version 2 (Jan 2015) page 5-6, [http://www.ipos.gov.sg/Portals/0/resources/Jan15TMRes/9%20Marks%20contrary%20to%20public%20policy%20or%20morality\\_Jan2015.pdf](http://www.ipos.gov.sg/Portals/0/resources/Jan15TMRes/9%20Marks%20contrary%20to%20public%20policy%20or%20morality_Jan2015.pdf) [Last Accessed 19 August 2016]

<sup>200</sup> Ibid

It is no mean feat to arrive at a uniform standard of morality that can be easily applied and assimilated to the various law systems in Europe. The idea of a one size fits all standard of morality is neither a realistic nor a practical aim. However, that does not warrant that the authorities resign themselves to fate and not attempt to improve the system. The effort from the EUIPO in designing the guidelines is an applaudable action. However, the guidelines are only but guidelines and have no legal power. Hence the courts and authorities are not bound to follow them. From our discussion, it is obvious that having such classifications is highly useful and translating them to legislations would bestow trade marks law with certainty and thus more authority. As a reminder, the categories are a) those with a religious nexus; b) those consisting of or comprising racial slurs; c) those consisting of or comprising vulgar matter, sexual content or innuendo; d) those suggesting or promoting illegal activity; e) those insulting to nationality; and f) those exploiting tragic events.

A practical reason to adopt the above into legislation would be the compelling reason that it is somewhat tried-and-tested method of assessing trade marks. Hence, there transition period for adopting it into the respective national legislations will be seamless. It will allow the examiners and courts to identify the type of moral principles that have been infringed upon instead of muddling it up with standards of poor taste. Since the different categories have varying standards of morality attached to them, providing a comprehensive guide on them will allow the examiners to be more competent at identifying the applicable moral principles and the relevant standards to be applied for each category. In addition, the non-exhaustive nature of the categories ensures flexibility in applying the law thus avoiding a restrictive approach and allowing reasonable decisions to be made. It also assists future applicants in making the right decisions for their trade mark so that the applied trade mark will not be denied registration.

Nevertheless, it is conceded that there are limitations to this suggestion notably the fluctuating and shifting moral boundaries that could contribute to some uncertainty in the law. However, if such a suggestion could aid in reduction the uncertainty and inconsistent decisions that has plagued the system, then it is a measure worth pursuing. More importantly, it will preserve the freedom of expression of the applicants who may not be able to afford the expensive litigation procedure.



However, having such a fixed law may not be beneficial as there is a lack of flexibility. Free speech may suffer as courts may be tempted to draft ‘speech-harmful trade mark laws’.<sup>201</sup> Introduction of a trade mark legislation as suggested above may also not entirely eradicate the unintentional subjectivity that accompanies offensive trade marks. Hence it is important to maintain some flexibility when the EUIPO guidelines are given the legal stamp.

## **6.2 Freedom of Expression**

The freedom of expression/speech and trade marks dichotomy has resulted in the confusing decisions from the court. In some cases, there is genuine engagement with Article 10 whereas it seems to be ‘misplaced lip-service’ in others.<sup>202</sup>

The question of whether interference of Article 10 is valid by law has been addressed in much earlier. The requirements are for the need to have ‘pressing social need’, the measure must be proportionate and finally it must have been the least restrictive measure available. As apparent from the discussion thus far, in spite of the ‘disciplined scrutiny apparently demanded by such a test’, the ECHR has disturbingly applied ‘varying levels of scrutiny to different forms of communication under Article 10(2)’.<sup>203</sup> It is argued that even if a trade mark falls foul of the public policy and morality clause, it is unlikely that Article 10 will be invoked. A possible explanation could be that registration of a trade mark meant for mundane things like clothes and drinks may not have been the objective when Article 10 was drafted. In spite of the extent of protection given to trade marks, it is necessary to balance it against the as freedom of expression. However, this may be a mammoth task as the there is a continuous change in what is socially permissive speech. It appears that the

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<sup>201</sup> Lisa P Ramsey, ‘Increasing First Amendment Scrutiny’ (2008) 61 *Southern Methodist University Law Review* 381-457

<sup>202</sup> Griffiths (n 138)

<sup>203</sup> Ibid

boundaries of free speech and expression seem to be pegged with the moral standards of a particular time.

A reminder of an earlier example would be the loose use of the word ‘fuck’. The word used to make people twitch and churn their stomachs. However, society has since progressed and the once forbidden word has now become a part of mainstream language. It is indeed a tall order to constantly revise on what is considered to be protected speech. While it may be argued that the word ‘fuck’ still remains an offensive word and should not be allowed protection, the cases we have encountered thus have proven otherwise.

Nevertheless, the onus is on the European courts to give the freedom of expression/speech more thought as exemplified by their American counterparts. However, that could lead to an increase of offensive trade marks occupying the registry. Ultimately, the test of proportionality, which European courts appear to apply in almost every aspect of law, will be the guiding principle to determine if intervention against the right freedom of expression/speech is needed.

With the recent EU recommendations in trade mark law that have been passed in 2015, it is likely that the freedom of expression tenet may be acknowledged in EU trade mark law. Recital 21 of EUTMR as well as the mirror provision of Recital 27 of the TMD states: “this [Regulation / Directive] should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression.”<sup>204</sup> It must be noted that it is specifically referring to the use of EU trade marks by third parties with respect to honest practices in industrial and commercial matters. Nevertheless, it draws attention to the aspect of freedom of expression/speech which are often neglected in trade mark legislations.

Since the reforms are still in its infancy, the laws remain to be effectively tested and the outcome to be seen. The author remains hopeful that freedom of expression/speech will indeed be given greater weight in future decisions.

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<sup>204</sup> EUTMR 2015/2424 recital 21; TMD 2015 recital 21

### **6.3 Summary**

In this chapter we have taken a look at the recommendations that are feasible to adopt. It has been suggested that for a more certain system, the EUIPO guidelines should be conferred legal status by way of drafting them into legislations. However, with the margin of appreciation that allows some discrepancy between the 28 Member States (27 once UK exits), the threshold of public policy and morality will differ thus making it difficult to have a uniform legislation. A regulation which has a direct effect will not account for those differences and may be overly restrictive for more liberal countries or less restrictive for conservative countries.

The recognition of the freedom of expression in cases before the courts is a welcome move however its effectiveness remains to be seen. Furthermore, the new laws may not achieve its desired effect immediately as it takes time for the dust to settle.

### **7. Conclusion**

Unique and impressionable branding is key to staying ahead of the competition for businesses even more so when the market is saturated. Consumers will always remember the impact the trade mark had on them hence businesses are literally taking the liberty and constantly pushing boundaries of the freedom of expression. 'FCUK' has always been a brand of controversy and is often brought up in courts for its purposeful misspelling of the offensive word 'fuck'. Hence, considerable importance must be given to trade marks and how it is legislated.

It does not help that the guidelines regulating offensive trade marks are vague and unclear. This has contributed to the frustratingly inconsistent decisions that plague his area of law. The fluid nature of morality makes it difficult to attribute a specific standard for morality to abide by. This is compounded by the fact that every society boasts of being multicultural and multiracial which makes it a minefield for legislators.

The law also has to grapple with the need to observe the freedom of expression/speech. This need is further agonized by the reluctance of the court to address the issue and side stepping it by stating that denying registration is does not

infringe the freedom of expression/speech as the applicants are still ironically free to use the trade mark. While the applicants may resort to the tort of passing off for claims against infringers, their initial failure of registration for the offensive trade mark does not bode well for the success of their passing-off claim.

The brilliant categorization by Baird is a useful tool that should be employed by the legislators to alleviate the confusion that pervades the system. It could also help bring much needed clarity on how successful an applicant's trade mark may be. How precaution must be taken to ensure that the system does not become overly restrictive and stifle creativity and free speech. This is definitely not an active encouragement for more offensive trade marks to appear in the registry. Should some offensive trade marks appear in the system, we can be contented that it has passed through the rigor of the examiner.

In addition, giving Article 10 the attention it deserves inadvertently produces a more principled approach of objectivity and consistency although care must be exercised due existence of the margin of appreciation that exists in Europe. While the US provides a solid case study for the Europeans to work from, it must be noted that America is one nation whereas the EU is made up of different countries each with their system of law. With all due respect, tending the law to Europe is a harder task than in the US.

Eventually it is understood that public policy and morality does need to be given weight as it concerns the society at large and the fabric of the society may be damaged easily. Nevertheless, the courts should not be over zealous which sees the freedom of expression/speech becoming the sacrificial lamb.

Suggesting, implementing and changing solutions are part and parcel of moving towards a more all-encompassing legal system. Hence, the humble solutions proposed in this thesis are neither the perfect solution nor the end point. It is only a starting point to ensure that the trade mark laws respect its boundaries and acknowledge the legitimacy of the freedom of expression/speech argument. It appears that it is not only the law that will be a work in progress but sometimes our morals as well.

## **7. Bibliography**

### Legislations

§ 86a dt. StGB (German Criminal Code), BGBl. Nr. I 75/1998)

Bill of Rights

Directive 2008/95/EC

Regulation 2015/2424

### Cases

#### US Cases

Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d (Lexis) 1080, 1082 (T.T.A.B. 2014)

*In re Simon Shiao Tam* [2015] 2014-1203

#### UK Cases

*Basic Trademark SA's Trade Mark Application* [2005] RPC 25

CDW Graphic Design Ltd's Trade Mark Application [2003] R.P.C. 30

Ghazilian's Trade mark Application [2002] ETMR 63

*Müller v. Switzerland* [1988] 13 EHRR 212,

*Philips Electronics NV v Remington Consumer Products Ltd* [1998] ETMR 124

Toke UK Ltd's Application [2007] E.T.M.R. 9

*Zana v Turkey* (1999) 27 EHRR 667

#### EU Cases

R0176/2004-2 BIN LADIN

R111/2002-4, OHIM Board of Appeal (Dick and Fanny)

R 0168/2011-1 – 'Fucking Freezing! by TÜRPIITZ'

R 0495/2005-G – SCREW YOU

R 2613/2011-2 – ATATURK

T-140/02, Intertops

T-232/10 Soviet Coat of Arms

T-232/10 Couture Tech Ltd v OHIM

T356/93 *PLANT GENETIC SYSTEMS/Glutamine synthetase inhibitors*

T-417/10, '¡Que bueno ye! Hijoputa'

R 495/2005-G *Application of Kenneth (trading as Screw You)*

T-526/09 PAKI Logistics GmbH v OHIM

Journal articles

Abdel-kalik, J., 'Disparaging Trademarks: Who Matters' (2015) 20(2) *Michigan Journal of Race and Law* 288-319

Baird, S.R., 'Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks' (1993) 83 *Trademark Rep.* 661, 704

Blakely, T.W., 'Beyond The International Harmonization Of Trademark Law: The Community Trade Mark As A Model Of Unitary Transnational Trademark Protection' [2000] 149 *Transnational Trademark Protection* 309

Bolen M.B., Caira Jr, R.J., And Wood, J.S., 'When Scandal Becomes Vogue: The Registrability Of Sexual References In Trademarks And Protection Of Trademarks From Tarnishment In Sexual ContextS' (1999) 39 *IDEA: The Journal of Law and Technology* 435

Bonadio, E., 'Brands, Morality and Public Policy: Some Re ections on the Ban on Registration of Controversial Trademarks' (2015) 19(1) *Marquette Intellectual Property Law Review* 43-60

Clark, B., *General Court refuses 'racist' PAKI trade mark*, 7 *Journal of Intellectual Property Law & Practice*

Davies, C., 'For FOOK's Sake' (2004) 169 *Trademark World* 24

Davies, C., Davies, R., 'Fighting Controversy in the UK: Morality and a trade mark application' [2003] *Business Law Review*, 137 at 137

Fhima, I.S., 'Trade marks and Free Speech' (2013) 44(3) *International Review of Intellectual Property and Competition Law* 293-321

Lefstin, J., 'Does the First Amendment Bar Cancellation of Redskins?' (2000) 52(3) *Stanford Law Review* 665-708

Lince, T., ‘*Je suis* a trademark? Slogan-related application just the latest in a growing trend’ (2015) *World Trademark Review*

<<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=1518ebee-cf96-404c-b248-375a69c86e0b>> [Last Accessed 5 August 2016]

Olivier, D., ‘Just how strong is public sentiment?’ (2015) 10(5) *Journal of Intellectual Property Law & Practice* 317

Rasul, H., ‘The Washington Redskins’ Deflating Hope: The Lanham Act Survives The First Amendment Challenge’ (2015) 26(1) *Marquette Sports law Review* 159-179

Senftleben M., & others, ‘Recommendation on Measures to Safeguard Freedom of Expression and Undistorted Competition in EU Trade Mark Law’ (2015) 37(6) *European Intellectual Property Review* 337-343

Smith, E., & Barnes, J.E., ‘Walt Disney Surrenders to Navy's SEAL Team 6’ (2011) *The Wall Street Journal* <  
<http://www.wsj.com/articles/SB10001424052702304066504576345752703592770>>  
[Last Accessed 21 July 2016]

VerSteeg, R., ‘Blackhawk Down or Blackhorse Down? The Lanham Act’s Prohibition of Trademarks that “May Disparage” & the First Amendment’ (2016) 68(4) *Oklahoma Law Review* 677-771

### Books

Economides, N., ‘Trademarks’ in Peter Newman *The New Palgrave Dictionary of Economics and the Law* (Palgrave Macmillan UK 1998)

Kerly on Trademarks and Tradenames (Sweet and Maxwell 8-193)

Griffiths, J., ‘Is there a right to an immoral trade mark?’ (2009) *Intellectual Property and Human Rights* (P Toremans (ed) Kluwer Law International) pp 309-334

Miscellaneous

Benedictus, L., ‘What are the most popular swearwords on Twitter?’ (23 February 2014) *The Guardian*

<<https://www.theguardian.com/technology/shortcuts/2014/feb/23/most-popular-swearwords-on-twitter>> [Last Accessed 9 August 2016]

CDW Graphic Design Limited v Manchester United Merchandising Ltd [2000] *Challenge Decision Results* <https://www.ipo.gov.uk/t-challenge-decision-results/o46402.pdf>

Criado, G., & Martin-Santos, A., ‘NOT MADE IN CHINA Trademark Rejected for Moral Grounds by European Trade Mark Office’

<<http://www.chinaipmagazine.com/en/journal-show.asp?id=320>> [Last Accessed 4 August 2016]

Decision on the invalidation of the Trade Mark see document IV/2767/61-E, page 7 <<https://www.ipo.gov.uk/t-challenge-decision-results/o13706.pdf>> [Last Accessed 21 July 2016]

Denis, L., ‘Kant and Hume on Morality’ *Stanford Encyclopedia of Philosophy* [2008; revised in 2012] <<http://plato.stanford.edu/entries/kant-hume-morality/>> [Last Accessed 18 July 2016]

EUIPO ‘Guidelines for examination Trade mark, Part B Examination – Absolute Grounds of Refusal’ (24 May 2016) <[https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/law\\_and\\_practice/trade\\_marks\\_practice\\_manual/WP\\_LR\\_2016/Part-B/04-part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal/TC/part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal\\_tc\\_en.pdf](https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/trade_marks_practice_manual/WP_LR_2016/Part-B/04-part_b_examination_section_4_absolute_grounds_for_refusal/TC/part_b_examination_section_4_absolute_grounds_for_refusal_tc_en.pdf)> [Last Accessed 3 July 2016]

Fink, C., Javorcik, B.S., and Spatareanu, M., ‘Income-Related Biases in International Trade: What do Trademark Registration Data Tell Us?’ (2003) World Banking Policy



Research Working Paper No 3150 <<http://ssrn.com/abstract=636569>> [Accessed: 23 June 2016]

Gasser, C., & Ehrler, L., 'SWITZERLAND: BIN LADIN Trademark Upheld' (2005) 60(2) *INTA Bulletin*  
<<http://www.inta.org/INTABulletin/Pages/BINLADINTrademarkUpheld.aspx>> [Last Accessed 21 July 2016]

Gert, B., & Gert, J., 'The Definition of Morality' *Stanford Encyclopedia of Philosophy* (2016) <<http://plato.stanford.edu/entries/morality-definition/>> [Last Accessed 23 July 2016]

Global Freedom of Expression, 'Case Analysis' *Columbia University* (2016)  
<<https://globalfreedomofexpression.columbia.edu/cases/in-re-simon-shiao-tam/>>  
[Last Accessed 18 August 2016]

Hinchliffe, S.A., 'Defining the Boundaries of a Scandalous Mark – Perspectives from Australia, the United States, and the United Kingdom' (2014) [Last Accessed 21 July 2016]

[https://www.law.berkeley.edu/files/Hinchliffe\\_Sarah\\_IPSC\\_paper\\_2014.pdf](https://www.law.berkeley.edu/files/Hinchliffe_Sarah_IPSC_paper_2014.pdf)

Humphreys, G., 'Freedom of speech and trademarks: Gauging public sensitivities or curtailing civil liberties?' (2009), available at [http://fordhamipconference.com/wp-content/uploads/2010/08/Gordon\\_Humphreys\\_Freedom\\_of\\_Speech\\_and\\_Trademarks.pdf](http://fordhamipconference.com/wp-content/uploads/2010/08/Gordon_Humphreys_Freedom_of_Speech_and_Trademarks.pdf) (Last Accessed June 14, 2016)

IPOS Trade Marks Work Manual Chapter 9 version 2 (Jan 2015) page 5-6,  
[http://www.ipos.gov.sg/Portals/0/resources/Jan15TMRes/9%20Marks%20contrary%20to%20public%20policy%20or%20morality\\_Jan2015.pdf](http://www.ipos.gov.sg/Portals/0/resources/Jan15TMRes/9%20Marks%20contrary%20to%20public%20policy%20or%20morality_Jan2015.pdf) [Last Accessed 19 August 2016]

Knibbs, K., 'Curses! People swear a lot on twitter and here are the most popular words' (2014) <<http://www.digitaltrends.com/social-media/popular-curse-words-twitter/>>

Lince, T., 'Trademarking a tragedy: the need to defend against rogue trademarks of tragic events' (2014)  
<<http://www.worldtrademarkreview.com/Blog/Detail.aspx?g=ee50c570-641f-41ee-a0dc-a2fb78239f7d>> [Last Accessed 5 August 2016]

Lince, T., 'Trademarked or not, 'Je Suis Charlie' commercialization steps up' (2014)  
*World Trademark Review*  
<<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=d4bcc4d6-b033-4740-9bfb-5d4c81b59490>> [Last Accessed 15 August 2016]

Loughlan, P.L., 'OH YUCK! The Registration of Scandalous Trade Marks' (2005)  
Sydney Law School Research Paper No. 06/40  
[http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=939948](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=939948) [Last Assessed 1 Aug 2016]

Meland, M., 'U.K. Rejects Jesus as Trademark for Jeans' (2003) ,  
<<http://www.law360.com/articles/574/u-k-rejects-jesus-as-trademark-for-jeans>> [last accessed 31 July 2016]

Mill, J.S., 'On Liberty' (1869) <  
<http://socserv2.socsci.mcmaster.ca/econ/ugcm/3ll3/mill/liberty.pdf>> [Last Accessed 23 August 2016]

Murdoch, J., 'Protecting the right to freedom of thought, conscience and religion under the European Convention on Human Rights' *Council of Europe Human Rights Handbooks* (Strasbourg 2012)

O' Neil, L., 'A List of Trademarks the Redskins Claim Are Just as Offensive as Their Own' (2015) <http://www.esquire.com/sports/a39397/washington-redskins-defend-logo/> [Last Accessed 25 July 2016]

OHIM News (2015)

[https://euipo.europa.eu/ohimportal/en/news?p\\_p\\_id=csnews\\_WAR\\_csnewsportlet&p\\_p\\_lifecycle=0&p\\_p\\_state=normal&p\\_p\\_mode=view&p\\_p\\_col\\_id=column-1&p\\_p\\_col\\_pos=1&p\\_p\\_col\\_count=3&newsQueryString=je%20suis%20charlie&journalId=1787585&journalRelatedId>manual/](https://euipo.europa.eu/ohimportal/en/news?p_p_id=csnews_WAR_csnewsportlet&p_p_lifecycle=0&p_p_state=normal&p_p_mode=view&p_p_col_id=column-1&p_p_col_pos=1&p_p_col_count=3&newsQueryString=je%20suis%20charlie&journalId=1787585&journalRelatedId>manual/) [Last Accessed 29 July 2016]

Opinion 2/13 on the Draft Agreement on the Accession of the European Union to the European Convention for the Protection of Human Rights and Fundamental Freedoms EU:C:2014:2454; unreported 18 December 2014 (ECJ)

Reingraber, T., 'Public order and morality as grounds for refusal within trademark law: European and comparative approach'(2011/2012)  
<[https://euipo.europa.eu/knowledge/pluginfile.php/...data/.../REINGRABER\\_Tom.pdf](https://euipo.europa.eu/knowledge/pluginfile.php/...data/.../REINGRABER_Tom.pdf)  
f> [Last Accessed 13 August 2016]

Rowland L., & Hossain, S., 'The Government's Trying to Sell a New Slant on the First Amendment. We're Not Buying It. (Updated)' (2015) *American Civil Liberties Union* <<https://www.aclu.org/blog/speak-freely/governments-trying-sell-new-slant-first-amendment-were-not-buying-it-updated>> [Last Accessed 18 August 2015]

Ruane, K.A., 'Freedom of Speech and Press: Exceptions to the First Amendment' (2014) *Congressional Research Service* <<https://www.fas.org/sgp/crs/misc/95-815.pdf>> [Last Accessed 15 August 2016]

Sandomir, R., 'Ruling Could Help Washington Redskins in Trade mark case' *New York Times* (New York, 22 December 2015) <[http://www.nytimes.com/2015/12/23/sports/football/washington-redskins-trademark-nickname-offensive-court-ruling.html?\\_r=0](http://www.nytimes.com/2015/12/23/sports/football/washington-redskins-trademark-nickname-offensive-court-ruling.html?_r=0)> [Last Accessed 18 August 2016]

Sayyid, S., 'Racism and Islamophobia' (2011) <<https://www.unisa.edu.au/Documents/EASS/MnM/commentaries/sayyid-racism-islamophobia.pdf>> [Last Accessed 23 August 2016]

Standing Committee on the Law of Trade marks, Industrial Designs and Geographical Indications, Grounds for Refusal of All Types of Marks, WIPO, August 30, 2010, [http://www.wipo.int/sct/en/meetings/pdf/wipo\\_strad\\_inf\\_5.pdf](http://www.wipo.int/sct/en/meetings/pdf/wipo_strad_inf_5.pdf)

Stenton, G., 'Are you sitting comfortably? US Patent and Trademark Office says "pants" to Comfyballs trade mark application' (2015)  
<<http://www.lexology.com/library/detail.aspx?g=3c64a558-f1a6-41a6-a692-e487c546dc63>> [Last Accessed 1 Aug 2016]

Trade marks in the European Union <<https://euipo.europa.eu/ohimportal/en/trade-marks-in-the-european-union>> [Last Accessed 2 July 2016]

Population of Muslims, <http://www.islamicweb.com/begin/population.htm>

Proctor, J., 'F--k Cancer's Yael Cohen loses obscenity trademark battle'  
<http://www.cbc.ca/news/canada/british-columbia/f-k-cancer-s-yael-cohen-loses-obscenity-trademark-battle-1.2832808> [Last Accessed 25 July 2016]

Vindurampulle, C., 'Je suis Cecil': trademark law and distasteful capitalism' (2015)  
<<http://www.lexology.com/library/detail.aspx?g=5e94eff9-b1db-4f1e-bb47-60a912a309e8>> [Last Accessed 5 Aug 2016]

Wending, W., '#JeSuisCharlie creator: Phrase cannot be a trademark' (2015) BBC News 14 January 2015

WIPO - Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications 'Grounds For Refusal Of All Types Of Marks' (2010)  
<[http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo\\_strad\\_inf\\_5.pdf](http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_5.pdf)>  
[Last Accessed 4 August 2016]

World Trademark Review 'Legal Updates'  
<<http://www.worldtrademarkreview.com/Daily/Detail.aspx?g=60f79c4b-d33c-446a-8d4e-6394dd5a2c48>> [Last Accessed 5 August 2016]