



Public policy and morality in trade marks: Gauging badness

Tuesday 26 September 2023
10.00 to 11.00 (CEST)

Speaker:

Gordon HUMPHREYS – Boards of Appeal, EUIPO

Disclaimer

** This document contains the answers to questions submitted by the audience during the webinar that could not be answered during the live session.*

** The views expressed are strictly personal and should not be attributed to the EUIPO. Nor shall the EUIPO be held responsible for the opinions expressed or advice given in the videos and presentations.*

Questions and answers – Public policy and morality in trade marks: gauging badness

Have the EUIPO's assessment of morality changed over the years?
Considering the change of views of society



Yes

This is the nature of accepted principles of morality. **They shift and evolve over time.**

A good example is the use of the 'F' word and its registrability.

Questions and answers – Public policy and morality in trade marks: gauging badness

What is the stance of the European Union Intellectual Property Office (EUIPO) regarding trademarks seeking protection for products or services associated with recreational cannabis use?

It will depend on the representation of the sign and not just the goods and services it covers.

For example, if the sign contains a depiction of cannabis leaves, uses the word ‘weed’ or shows intoxicated individuals and covers cannabis goods, it will almost invariably be rejected as contrary to public policy.

Questions and answers – Public policy and morality in trade marks: gauging badness


Trademarks with middle finger representation are in principle refused by the EUIPO. However, this gesture has become common

- also in uses by children / young public (cartoons, emojis...). Is this the role of the EUIPO to censor such trademarks?

Plus, I have found several EU trademarks including a middle finger (009820333, 018657363, 018492726, 018025038 ...) - those were accepted.

If such gesture is perceived as shocking, should not these trademarks be cancelled by the EUIPO?

This issue is analogous to registration of signs using the ‘F’ word.

The approach throughout Europe and at the EUIPO has not always been consistent and it is argued that societal mores have evolved. Simply put, such marks are no longer shocking. This is especially so since the CJEU has itself recognized that the a sign containing the ‘F’ word is not one likely to offend the German-speaking public (*see ‘Fack Ju Göthe’ judgment*), although the Court acknowledged that non-native speakers may be less sensitive to potentially offensive terms in another language than mother tongue speakers of that language. Given the complexities of this polemic, the Office and its Boards have increasingly begun to refuse such marks as being devoid of distinctiveness. This approach has recently been approved by the General Court (*see ‘Fucking Awesome’ judgment*). The same approach has been taken in respect of emojis (*see Case R 2305/2022 Käselow Holding GmbH (1 June 2023)* ).

My personal opinion (which is of course not necessarily that of the EUIPO or its Boards) is that signs representing the middle finger are also objectionable as being devoid of distinctive character and that this is the most clear-cut approach to tackling such marks. Accordingly, such marks that are already on the register are vulnerable but whether such vulnerability transforms into cancellation will depend on the actions of third parties.

Questions and answers – Public policy and morality in trade marks: gauging badness

How will CP14 impact the decisions in Covidiot and Maricon Perdido? Do you think CP14 will make deciding these cases easier for the Grand Board and, if so, how/why?

The 'Covidiot' decision will discuss inter alia the issue of whether that expression is objectionable under Article 7(1)(f) EUTMR but nevertheless justifiable as political or commercial freedom of expression and thus registrable.

'Maricon Perdido' will, among other issues, look at whether denigratory or discriminatory terms can be reappropriated or rehabilitated, especially where the applicant himself is a member of the minority which is the target of the denigration or discrimination.

EU trade mark law is not developed or settled in this area. The only indication that the CJEU has given is contained in the *Fack Ju Göthe* judgment which simply states that freedom of expression has a role to play in EU trade mark law. The Advocate-General in that case was a little more expansive on this subject, but this was not taken up by the CJEU in its judgment.

In view of the two cases that are pending before the Grand Board and the lack of case law on the matter, the CP14 project decided to exclude the role of freedom of expression from its scope. There is, however, an annex to the project paper that gives some source information of potentially relevant case law from the European Court of Human Rights and the relevant articles of ECHR and CFREU. The Grand Board will certainly be considering the pertinent case law of the European Court of Human Rights and the relevant articles of ECHR and CFREU in its decisions.

Questions and answers – Public policy and morality in trade marks: gauging badness

What angles can be explored via academic research in regard to marks and morality standards?

Some ideas are:

- balancing public policy and morality with freedom of expression;
- cannabis trade marks – legality, use and registration.

Questions and answers – Public policy and morality in trade marks: gauging badness

How does government assess and make decisions on the level of vulgarity in Trademarks? Is this surveyed with the general public? or is the threshold decided using wider societal organized behavior and religion as a guideline? What other factors influenced the decisions?

Government, as such, does not assess trade marks.

However, **trade mark offices throughout the EU are public bodies**, usually under the portfolio of the ministry of justice or commerce/economy, depending on the Member State in question.

The EUIPO is an EU agency.

Vulgarity is assessed in relation to societal norms at the time of filing of the trade mark. Depending on the level of vulgarity, the trade mark may be objectionable on both public policy and morality grounds.

Please refer to the judgment and Advocate General's opinion in *Fack Ju Göhte*, C-240/18 P, for more details on this matter.

Questions and answers – Public policy and morality in trade marks: gauging badness

Would EUIPO accept a trademark registration that had a common term accompanied by a swastika?

For example, an Indian Coffee Shop called "Namaskar Coffee" and the logo is a coffee mug and a swastika somewhere.

Where does EUIPO draw the line? One can argue that using a swastika lacks taste, moral values and so on. But one can also argue that this is a Hindu symbol that means prosperity and good luck and has been used for thousands of years.

If faced with strong arguments, would EUIPO grant a trademark with these elements?

Public policy and accepted principles of morality **are evaluated from the perspective of persons of normal levels of tolerance and sensitivity within the EU.**

Since Nazi symbols are contrary to the law in certain Member States (including Germany), this indicates that they are considered unacceptable in the perception of that portion of the EU public.

This is analogous to the Hammer & Sickle (USSR symbol) judgment. It is highly unlikely that the Hindu symbolism of the sign would permit it to be registered in the EU.

Questions and answers – Public policy and morality in trade marks: gauging badness

What is considered ‘bad taste’ when it comes to trademarks?

This point is explained in the presentation by reference to the Dick & Fanny Board of Appeal case.

Questions and answers – Public policy and morality in trade marks: gauging badness

What are the factors that would be considered in determining if a trademark offends public policy?

Please refer to the presentation and to the judgment and Advocate General's opinion in Fack Ju Göhte, C-240/18 P.

Questions and answers – Public policy and morality in trade marks: gauging badness

Was the TSUE's judgment in F*** YOU GOETHE case a game changer from the point of view of morality principles ?

It is an **important judgment on various levels** (including accepted principles of morality), as was explained in the presentation.

However, the **circumstances of the case are quite unusual** (German phonetic transliteration of an English swear word targeted at the German-speaking public rather than the English-speaking one).

Questions and answers – Public policy and morality in trade marks: gauging badness

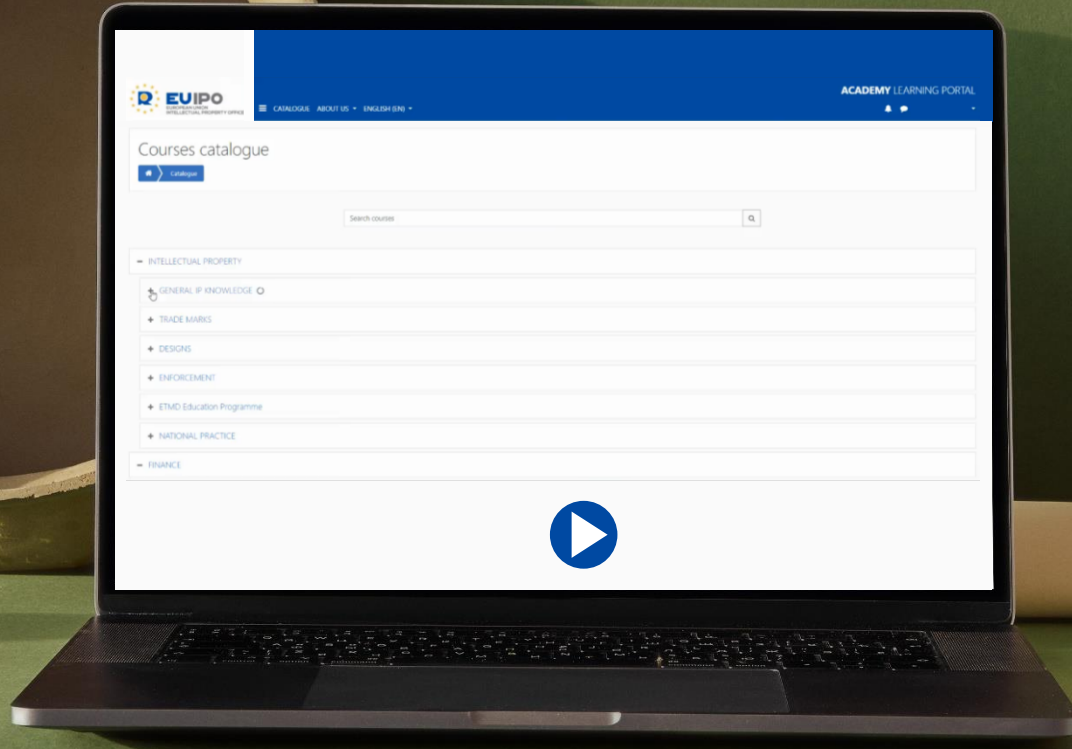
If the trade mark insults the group of people that not live in Europe, would the trademark be rejected?
If the trademark insults just a family or one person , would the trademark be rejected?

This is hard to answer in the abstract.

The **examiner** (and, by extension, EU public) **must be aware of the group of people in a third country that risk being offended.**

Racial insults or discrimination are contrary to the principles of the CFEU. Insults to third country revered historical personalities are likely to be objected (see the Attaturk case referred to in the presentation). Trivialization of shocking criminal behaviour is likewise unacceptable even where in a third country (Pablo Escobar case referred to in the presentation).

Keep in touch with the EUIPO Academy





EUIPO

EUROPEAN UNION
INTELLECTUAL PROPERTY OFFICE

www.euipo.europa.eu



[@EU_IPO](https://twitter.com/EU_IPO)



[EUIPO](https://www.linkedin.com/company/euipo)



[EUIPO.EU](https://www.facebook.com/EUIPO.EU)

THANK YOU