

PUBLIC POLICY AND MORALITY IN TRADE MARKS: Gauging Badness

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Boards of Appeal
26 September 2023

PROGRAMME

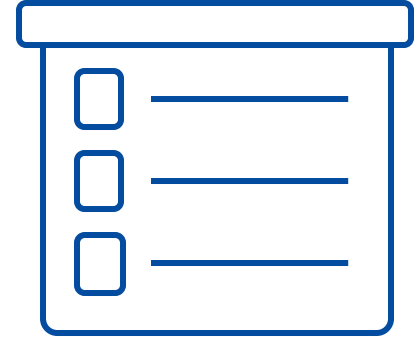
50'
Presentation

- **Introduction**
- **Structure** : definition/assessment of the signs/overlap between public policy and accepted principles of morality / freedom of expression/ examples of signs falling under Art. 7(1)(f) EUTMR

10'
Questions and answers

INTRODUCTION

- **European cooperation in CP14**
- **General considerations**



THE NECESSITY OF THE CP14 PROJECT

Public policy and accepted principles of morality

The EUTMR does not include a definition of public policy and accepted principles of morality

.....

Nor an indication of the criteria for its assessment

Guidance provided by recent case-law

EU case-law has established some guidance on this topic (e.g. *Fack Ju Göhte*)

.....

Risk of different IPOs interpreting it differently

Increase in the number of cases

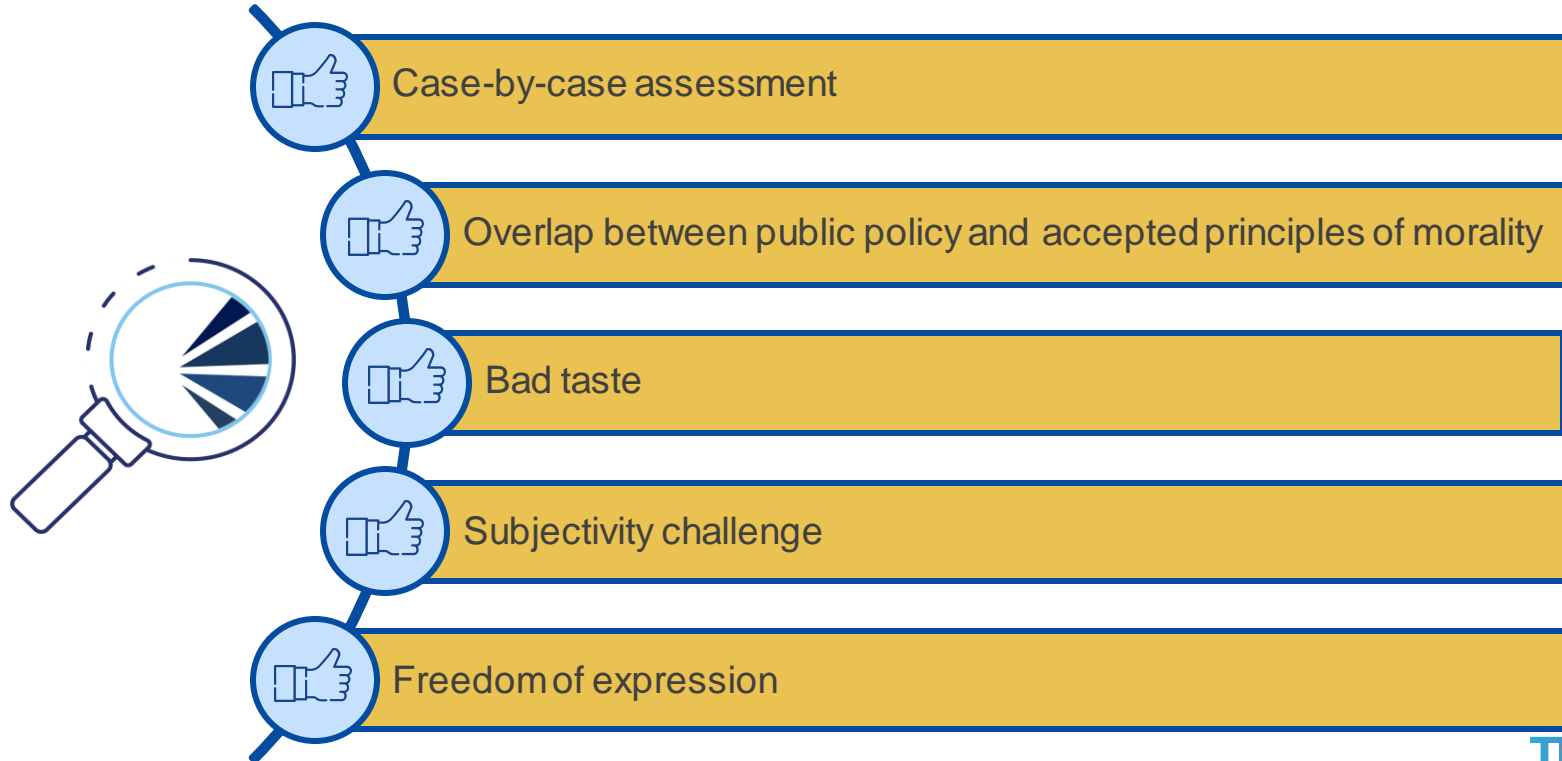
Recent events (*COVID-19, Brexit*)

.....

Well-known tragic events (*BLACK LIVES MATTER, Je suis Charlie*)

Art.151-2 EUTMR; Art. 51-52 TMD => promotion of convergence

GENERAL CONSIDERATIONS



STRUCTURE

Definition

- Public policy
- Accepted principles of morality

Assessment of signs contrary to public policy and/or to accepted principles of morality

- The sign itself and the relevant date
- Relationship between the G&S and the sign/relevant public
- Determination of the reliable and objective sources from which public policy can be ascertained
- Identification of the applicable moral values and standards

Overlap between public policy and accepted principles of morality

Freedom of expression

Examples of signs falling under Art. 7(1)(f) EUTMR

- Illicit substances
- Public safety risks
- Religious or sacred nexus
- Vulgar elements (swear words, offensive gestures or uses, etc.)
- Obscenity, sexuality and innuendo
- Disparaging or slurring a particular group
- Criminal activities
- Well-known tragic events
- Historical figures, national/EU symbols and personalities held in high esteem

1 DEFINITION

DEFINING PUBLIC POLICY



Set of **fundamental norms, principles and values** of societies in the European Union at a given point in time. Includes:

- the **universal values** of the EU – e.g. CFREU
- the **principles of democracy and the rule of law**

Its content should be ascertainable from reliable and objective sources.



Top-down guidance on matters such as human rights, freedom, equality, solidarity, democracy and the rule of law



Reliable and objective sources

COMMON UNDERSTANDING OF ACCEPTED PRINCIPLES OF MORALITY



Accepted principles of morality refer to the **fundamental moral values, standards and convictions accepted** by a society in the EU– or the EU as a whole - at a given time.



**Religious, cultural
and social values,
etc.**



**Empirical
assessment**

02/07/2019, **'Fack Ju Göhte'**, C-240/18 P, AG Bobek's opinion

2

ASSESSMENT OF SIGNS CONTRARY TO PUBLIC POLICY AND/OR TO ACCEPTED PRINCIPLES OF MORALITY

ASSESSMENT OF SIGNS CONTRARY TO PUBLIC POLICY

**A sign will be
contrary to
public policy**

- **If it contravenes and/or incites, glorifies, trivialises or justifies the violation of a fundamental norm, principle and/or value, ascertained from any of the reliable and objective sources**
- **It must affect an interest that the EU/MS(s) concerned consider(s) to be fundamental under its value system.**



- **Promotes a criminal organization**
- **Word elements convey a message of conviviality and trivialize 'la mafia'**
- **Violates the respect for human dignity and freedom**

15/03/2018, T-1/17 - LA MAFIA SE SIENTA A LA MESA

ASSESSMENT OF SIGNS CONTRARY TO ACCEPTED PRINCIPLES OF MORALITY

**A sign will be
contrary to accepted
principles of morality**

If a fundamental moral value or standard is violated through being perceived to be insulted, disparaged, discriminated against, degraded, denigrated or trivialised in a manner that causes offence.



- "Hijoputa" is an **offensive/insulting expression** in Spanish (Diccionario de la lengua española)
- Term has the intrinsic capacity to **offend any normal person** who encounters it and understands its meaning
- Particularly, **average consumer of the goods** covered by the mark, who is representative of a public morality far **removed from extremes**

ASSESSMENT OF SIGNS CONTRARY TO PUBLIC POLICY AND/OR TO ACCEPTED PRINCIPLES OF MORALITY

- 1 • Assessment of the sign itself
- 2 • Assessment of the relationship between the goods and services and the sign/relevant public
- 3 • Identification of the reliable and objective sources
- 4 • Identification of the applicable fundamental moral values and standards

ASSESSMENT OF THE SIGN ITSELF

DICK & FANNY

Cl. 9,16 and 25

25/03/2003 –

R 111/2002-4

- **The sign could refer to:**
 - ✓ **The first names Richard and Frances**
 - ⚠ **Coarse slang with a sexual connotation**

ASSESSMENT OF THE SIGN ITSELF



- **Misspellings** are sometimes used to try to mitigate any immediate association with a problematic connotation of the sign
- This will often not avoid the application of Art. 7(1)(f) where, the pronunciation of the sign remains identical to the objectionable term or expression. However, there are exceptions.

FACK JU GÖHTE

Case C-240/18 P

27/02/2020

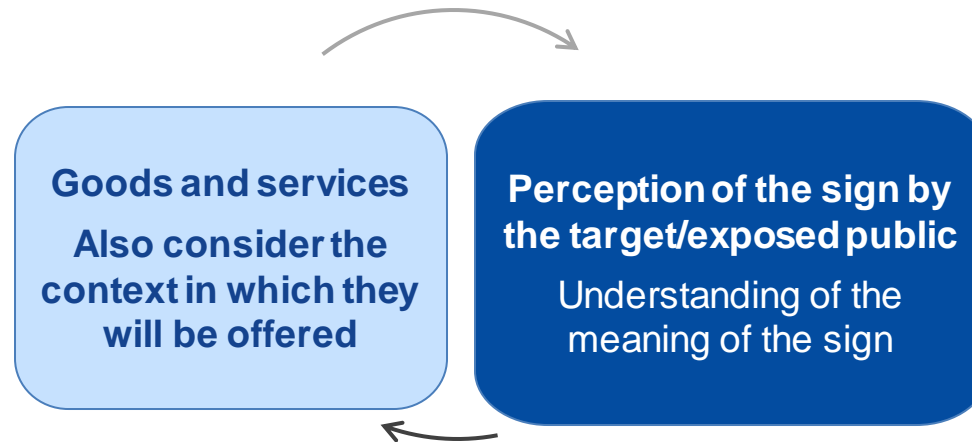
ASSESSMENT OF THE SIGN ITSELF

- In some cases, **additional verbal or figurative elements may reinforce the objectionable meaning of the sign.**

Cl. 30, 32 and 43
T-683/18, T-683/18



ASSESSMENT OF THE RELATIONSHIP BETWEEN THE GOODS AND SERVICES AND THE SIGN / RELEVANT PUBLIC



ASSESSMENT OF THE RELATIONSHIP BETWEEN THE GOODS AND SERVICES AND THE SIGN / RELEVANT PUBLIC

- There may be cases in which the **meaning of the sign and/or the message conveyed by it is so strong** that it would be **rejected irrespective of the goods and/or services** applied for.

Pablo Escobar
21/02/2023,
R 1364/2022-5



ASSESSMENT OF THE GOOD & SERVICE AND THE SIGN / RELEVANT PUBLIC

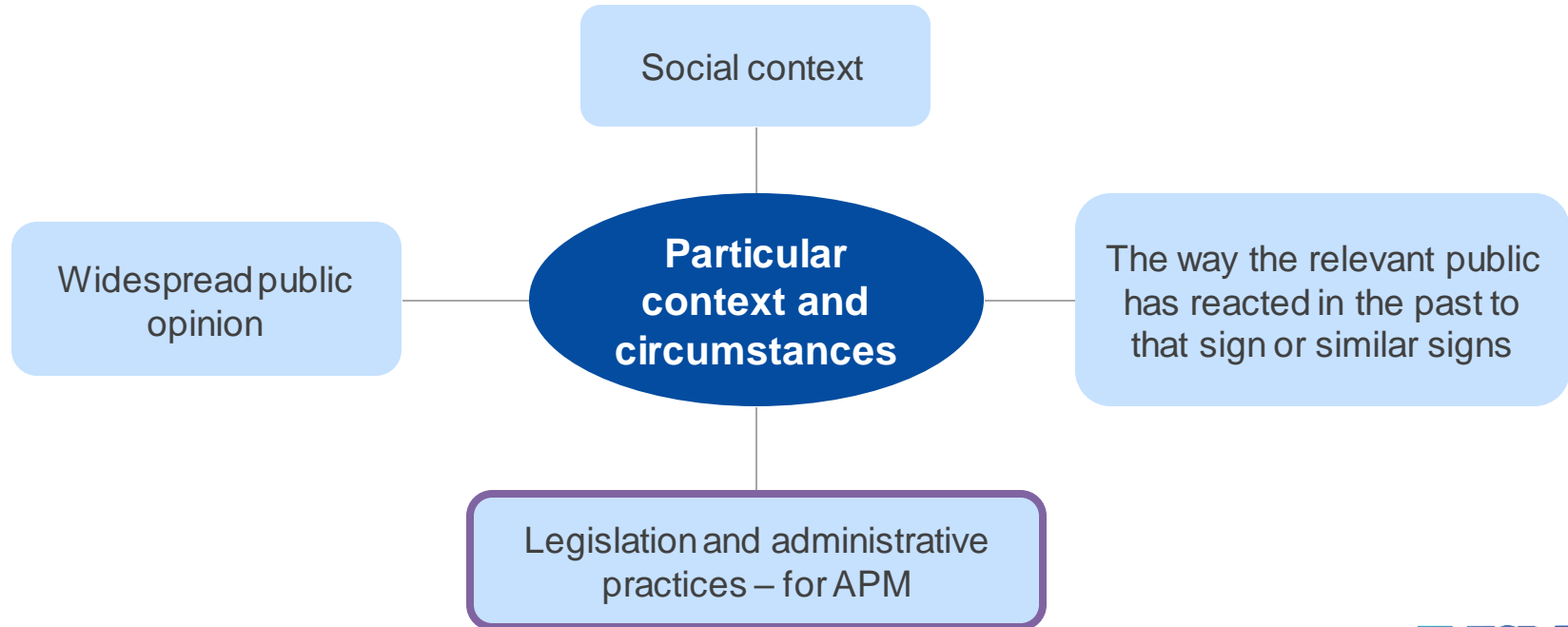
- The **goods and services** and the **context in which they will be offered** can impact the perception of the relevant public by accentuating the **objectionability** of the sign



| Contested EUTM | Goods |
|----------------|--|
| ATATURK | Classes 3, 5, 25, 29, 30 and 32 Including bleaching preparations, preparations for destroying vermin, beers |

17 /09/ 2012 – R 2613/2011-2 – ATATURK

ASSESSMENT OF THE RELATIONSHIP BETWEEN THE GOODS AND SERVICES AND THE SIGN/RELEVANT PUBLIC



DETERMINATION OF THE RELIABLE AND OBJECTIVE SOURCES FROM WHICH PUBLIC POLICY CAN BE ASCERTAINED

General principles of law

EU treaties

EU case-law

International treaties and conventions

EU legislation

MS legislation

20/09/2011, Case T-232/10



EXAMPLES FROM CASE-LAW



**SCREW YOU
BLACK LIVES MATTER**



IDENTIFICATION OF THE APPLICABLE FUNDAMENTAL MORAL VALUES AND STANDARDS

Verifiable information
rather than theory or logic

Examiners must provide objective
statements of reasons

Applicant may submit evidence to
provide counter-demonstration

Σκύλα (skýla)

09/12/2020, R 487/2020-1,

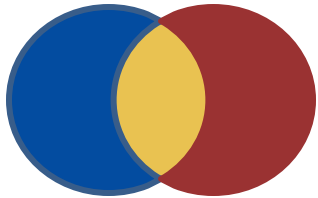
SKYLLA

3

OVERLAP BETWEEN PUBLIC POLICY AND ACCEPTED PRINCIPLES OF MORALITY

OVERLAP BETWEEN PUBLIC POLICY AND ACCEPTED PRINCIPLES OF MORALITY

Two different concepts
that often overlap



Scenarios where a sign could be contrary to both concepts:

Human rights

Illegal substances which target vulnerable groups (e.g. illicit drugs or substances forbidden for underage people)

Religion

Criminal activities/organisations (e.g. terrorism, the mafia)

4

FREEDOM OF EXPRESION

FREEDOM OF EXPRESION

Freedom of expression must be taken into account according to CJEU in the Fack Ju Göhte case

The impact of this principle on the assessment of Article 7(1)(f) TMD is currently not settled in EU trade mark law

Reference to the Fack Ju Göhte case

Art. 10 ECHR and Art 11 CFREU

R-260/2021-G



5

EXAMPLES OF SIGNS FALLING UNDER ART. 7(1)(F) EUTMR

CASE LAW EXAMPLES OF SIGNS FALLING UNDER ARTICLE 7(1)(F) EUTMR

BIN LADIN



BLACK LIVES MATTER



SIGNS FALLING UNDER ARTICLE 7(1)(f) EUTMR

Signs including/related to illicit substances

**WHAT TYPE OF
SIGNS DOES
THIS GROUP
COMPRISE?**

- **Illegal substances** in the EU and/or MS, or **substances used in an illegal manner** according to the relevant EU or MS regulations

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) TMD

Signs including/related to illicit substances



R-2888/19-1

Various G&S incl. tobacco and vapes

The overall composition is perceived by the relevant public as promoting, encouraging, and/or trivialising the recreational consumption of recreational cannabis

➤ **Contrary to public policy under Article 7(1)(f) EUTMR**



12/05/2021; T-178/20

Services related to therapeutic cannabis

TAKE-AWAYS



- Avoid drug-related symbols and imagery
- Don't use slang or common usage terms for recreational cannabis
- Minimize or omit references to 'cannabis' or 'hemp', focus on individualization instead
- Registration doesn't guarantee usability
- Legislative evolution may be determinative of filing strategy

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) EUTMR

Signs referring/related to health risks

**WHAT TYPE OF
SIGNS DOES
THIS GROUP
COMPRISE?**

- **Promoting and/or trivialising a health risk and/or the consequences arising from it**

R-260/2021-G



SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) EUTMR

Signs with a religious or sacred nexus



- Is the use of the sign on banal goods/services which are not related to religious activities offensive to the religious sacredness of the emblem?
- Will the mark be perceived as offensive by a substantial part of the relevant public with an average threshold of tolerance and sensitivity in at least one MS?
- Held: **Not contrary to accepted principles of morality**

CI. 03 09 14 18 26
06/07/2015; R1727/2014-2

Sufi School's sign



SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) EUTMR

Signs with a religious or sacred nexus

- Held: **Not contrary to accepted principles of morality**

SAINT CONSTANTIN BRÂNCOVEANU

Cl. 33

17/06/2022; R748/2022-5



SIGNS THAT COULD FALL UNDER ARTICLE 4(1)(f) TMD

Signs including/related to vulgar elements

**WHAT TYPE OF
SIGNS DOES
THIS GROUP
COMPRISE?**

➤ **Swear words**

➤ **Offensive gestures or uses**

➤ **Insults**

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) TMD

Signs including/related to vulgar elements



- The use of the 'F' word is abusive, insulting, and offensive, particularly since it will be displayed in shops accessible to the general public.

- The sign is **contrary to accepted principles of morality**

Cl. 18 and 25

01/09/2011

R0168/2011-1



Unregistrable under Article
7(1)(f) EUTMR

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) EUTMR

Signs disparaging or slurring a particular group

**WHAT TYPE OF
SIGNS DOES
THIS GROUP
COMPRISE?**

➤ **Offensive stereotypes**

➤ **Terms or messages that incite hate, prejudice, aversion, or exclusion towards a group**



Maricón perdido

Case pending before the Grand Board

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) EUTMR

Signs disparaging or slurring a particular group

- Terms or messages that incite hate, prejudice, aversion, or exclusion towards a group

PAKI

Cl. 6, 20, 37 and 39

05/10/2011

T-526/09

SIGNS FALLING UNDER ARTICLE 7(1)(f) TMD

Signs referring to: criminal activities, crimes against humanity, racist and totalitarian and extremist regimes, organisations and movements

MECHANICAL APARTHEID

- Trivialize a racist and inhuman regime and offends the victims of the 'Apartheid' system.
- Terror, torture and the denial of human dignity are in diametric opposition to the idea of 'games and entertainment'.
- Contradicts the indivisible, universal values on which the Union is founded - human dignity, freedom, physical integrity, equality and solidarity, and the principles of democracy and the rule of law

Cl. 9, 16 and 4
R2804/2014-51
06/02/2015



The sign is **contrary to public policy**

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) TMD

Signs referring/related to well-known tragic events

**WHAT TYPE OF
SIGNS DOES
THIS GROUP
COMPRISE?**

- Tragic events
- The victims that resulted from the tragic event
- The consequences that resulted from the tragic event

- Nature of the event
- The historical and national context
- The sensitivity or perception of the public
- The effect or impact on a community
- The time elapsed between the tragic event and the examination
- If the word related to the tragedy has acquired a secondary meaning

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) TMD

Signs referring/related to well-known tragic events

Black lives matter

EUTM 018255264;
10/11/2020

Various G&S incl.
'sex toys, sports equipment, games,
drinks and telecoms'

- The use of the mark applied for of **in relation to erotic, sexual or contraceptive articles would be perceived by the average European consumer as an offensive trivialization** of the 'BLACK LIVES MATTER' movement and the values it represents.
- Through intense use in the media and social networks in relation to human tragedy, the sign will be perceived by the general public merely as a slogan for freedom of expression and anti-racist struggle, and not as an indicator of commercial origin of the applied-for goods and services.



The sign is **contrary to accepted principles of morality and devoid of distinctiveness**

Refused under Article 7(1)(b) and (f) EUTMR

SIGNS THAT COULD FALL UNDER ARTICLE 7(1)(f) TMD

Signs including/related to historical figures, national/EU symbols and/or personalities held in high esteem

**WHAT TYPE OF
SIGNS DOES
THIS GROUP
COMPRISE?**

➤ **Historical figures**

➤ **Figures** that are **considered national or EU symbols**

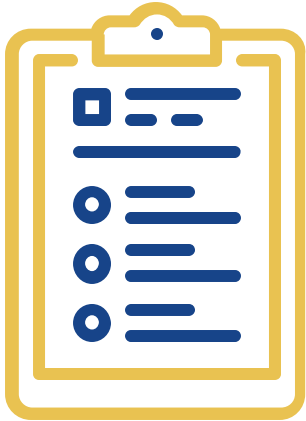
➤ **Personalities** that are held in **high esteem** in all or part of the EU, or in a Member State

17 /09/ 2012 – R 2613/2011-2 – **ATATURK**

10/04/2008 -R1227/2006-1 - **HILDEGARD VON BINGEN**

06/05/2015, EUTM 013733704, **HITLER**

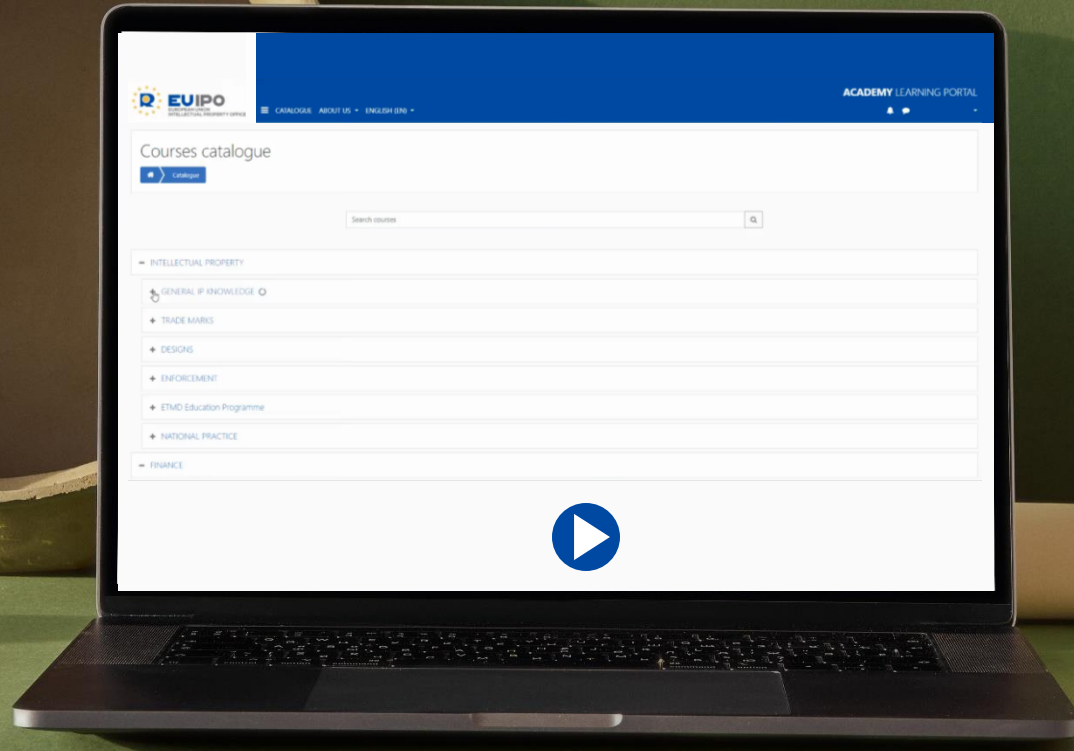
CONCLUSIONS



- Public policy and morality are separate heads of the same ground
- Statements of reasons must be sufficient
- Context is all important (language, goods & services, laws/regs)
- Depending on the goods & services, slang terms may be risky
- Watch out for other grounds of refusal (individualize)
- Public Policy and morality evolve (refiling considerations)



Keep in touch with the EUIPO Academy





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