

## **Case-law Research Report – Trade marks contrary to public policy or accepted principles of morality**

October 2021

## TABLE OF CONTENTS

<b>1. INTRODUCTION</b> .....	<b>3</b>
<b>2. LEGAL FRAMEWORK</b> .....	<b>3</b>
2.1 EU law .....	3
2.2 Other instruments .....	5
<b>3. CASE-LAW ANALYSIS</b> .....	<b>5</b>
3.1 Definition .....	5
3.1.1 Open legal concepts .....	5
3.1.2 Typical case categories .....	6
3.2 The factors of assessment .....	6
3.2.1 The relevant public .....	6
3.2.2 The meaning and perception of the mark by the relevant public .....	7
3.2.3 The goods and services .....	8
3.2.4 Prior use of the sign on the market and the social context .....	10
3.2.5 The applicant's identity, intentions and conduct .....	11
3.2.6 Freedom of expression and freedom to conduct a business .....	11
3.3 Public policy and the cannabis cases .....	12
<b>4. CONCLUSIONS</b> .....	<b>15</b>
<b>ANNEX</b> .....	<b>17</b>

## 1. Introduction

- 1 The report on *Trade marks contrary to public policy or accepted principles of morality* is a compilation of case-law from the General Court (GC), the Court of Justice (CJ) and the Boards of Appeal (the Boards or BoA), drawn up with the aim of identifying and analysing the relevant case-law and trends on the topic.
- 2 The purpose is to further support the work of the Boards with a view to maintaining and enhancing the **consistency** of its decision-making practice with the case-law of the European Courts and among the Boards themselves. As such it contributes to improving the **predictability** of decisions and legal certainty in general. Through divulging relevant legal information, it also serves to increase **knowledge, awareness and transparency** among the various BoA stakeholders.
- 3 It is a working document that reflects the existing case-law and the result of discussions within the Consistency Circles and the General Consistency Meeting of the BoA at the given date of the report and should **not be considered to have any binding effect on the BoA**. It has been made available to staff of the BoA and the public in general for information purposes only.

## 2. Legal Framework

### 2.1 EU law

- 4 Article 7(1)(f) EUTMR mirrors Article 6*quinquies* of the Paris Convention of 20 March 1883 (as revised at Stockholm on 14 July 1967) which provides for the refusal of trade mark applications and the invalidation of registrations where trade marks are ‘contrary to morality or public order’.
- 5 Article 7(1)(f) EUTMR – ‘Absolute grounds for refusal’:  
*‘1. The following shall not be registered:  
(f) trade marks which are contrary to public policy or to accepted principles of morality;’*
- 6 Article 7(2) EUTMR:  
*‘Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.’*
- 7 Article 59(1)(a) EUTMR – ‘Absolute grounds for invalidity’:  
*‘1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:  
(a) where the EU trade mark has been registered contrary to the provisions of Article 7;’*

8 The same provision as in the EUTMR is reflected in Article 4(1)(f) of the Trade Mark Directive<sup>1</sup>.

9 Article 4 of the Trade Mark Directive – ‘Absolute grounds for refusal or invalidity’:

*‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:*

*(f) trade marks which are contrary to public policy or to accepted principles of morality;’*

*‘3. Any Member State may provide that a trade mark is not to be registered or, if registered, is liable to be declared invalid where and to the extent that:*

*(a) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Union;*

*(b) the trade mark includes a sign of high symbolic value, in particular a religious symbol’*

10 Recital 21 of the Preamble of the EUTMR:

*‘...this Regulation should be applied in a way that ensures full respect for fundamental rights and freedoms, and in particular the freedom of expression.’*

11 Article 10 of the European Convention on Human Rights:

*‘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.’*

12 Article 11 of the Charter of Fundamental Rights of the European Union:

*‘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.’*

13 Article 16 of the Charter of Fundamental Rights of the European Union:

*‘The freedom to conduct a business in accordance with Union law and national laws and practices is recognised.’*

---

<sup>1</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks

## 2.2 Other instruments

- 14 The Office's Guidelines deal with this absolute ground for refusal in Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 7, Trade marks contrary to public policy or accepted principles of morality (Article 7(1)(f) EUTMR).

## 3. Case-law analysis

### 3.1 Definition

#### 3.1.1 Open legal concepts

- 15 'Public policy' and 'accepted principles of morality' are open legal concepts that are not defined in law.
- 16 As to **public policy**, the GC stated in **Cannabis Store Amsterdam**<sup>2</sup> that '*EU law does not impose a uniform scale of values and acknowledges that the requirements of public policy may vary from one country to another and from one era to another. Member States essentially retain the freedom to determine what constitutes those requirements in accordance with their national needs*' (§ 71). '*[...] public policy is a **normative vision of values and goals**, defined by the relevant public authority, to be pursued now and in the future, that is, prospectively. Public policy [...] thus expresses the public regulator's wishes as to **the norms to be respected in society***' (§ 72).
- 17 As to **accepted principles of morality**, the CJ stated in **Fack Ju Göhte**<sup>3</sup> that it refers to the '***fundamental moral values and standards to which a society adheres to at a given time**. Those values and norms, which are likely to change over time and vary in space, should be determined according to the social consensus prevailing in that society at the time of the assessment. In making that determination, due account is to be taken of the social context, including, where appropriate, the cultural, religious or philosophical diversities that characterise it, in order to assess objectively what that society considers to be morally acceptable at that time*' (§ 39).
- 18 In general, it appears from case-law that 'public policy' entails an **objective assessment** made in relation to imperative legislative or administrative norms, while for 'accepted principles of morality', a **subjective assessment** is to be made in relation to normal, accepted conduct in a society at a certain point in time.
- 19 In some cases, the judgments specify which one of the two apply<sup>4</sup>. In others, no clear distinction has been made, but a mere general reference to both situations is provided using the disjunctive conjunction 'or'<sup>5</sup>. Nonetheless, the Boards' recent case-law shows

<sup>2</sup> 12/12/2019, T-683/18, CANNABIS STORE AMSTERDAM (fig.), EU:T:2019:855

<sup>3</sup> 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118

<sup>4</sup> In 26/09/2014, T-266/13, CURVE, EU:T:2014:836, 'accepted principles of morality'; in 15/03/2018, T-1/17, La Mafia SE SIENTA A LA MESA, EU:T:2018:146, 'public policy'.

<sup>5</sup> 05/10/2011, T-526/09, Paki, EU:T:2011:564, § 15 ; 20/09/2011, T-232/10, Representation of the Soviet coat of arms, EU:T:2011:498, § 72

an endeavour to specify which of the two concepts applies, wherever a clear distinction is possible, as a logical first step that allows a better and more concrete assessment<sup>6</sup>.

### 3.1.2 Typical case categories

20 Some of the recurring categories of signs caught by the application of Article 7(1)(f) EUTMR that emerge in case-law are those that:

- a) transmit or incite hate and/or a degrading message towards a particular group, institution, belief or national symbol;
- b) transmit an insult even if it is not targeting a particular group;
- c) employ vulgar and offensive language, often with a strong sexual connotation;
- d) transmit or incite or trivialise criminal activity or activities against public safety, including the promotion of the use of illegal narcotic substances;
- e) trivialise a well-known tragedy or convey an immoral message about it;
- f) praise or trivialise the message or impact of a well-known movement of a certain significance (such as the ideology of a totalitarian regime).

## 3.2 The factors of assessment

21 There are several factors to be taken into account in the assessment of whether a mark is contrary to public policy or accepted principles of morality. These factors do not apply in isolation but interplay with each other, depending on the circumstances of the case.

### 3.2.1 The relevant public

22 When assessing **accepted principles of morality**, the relevant consumer is a reasonable person with an average threshold of sensitivity and tolerance that cannot be easily offended<sup>7</sup>. However, in contrast with other absolute grounds for refusal, the relevant public consists not only of the consumers targeted by the goods and services at issue, but also any other person who might encounter the mark incidentally in day-to-day life<sup>8</sup>.

23 It is also sufficient that the mark is offensive for only a relevant part of the European public for it to be refused under Article 7(1)(f) EUTMR (see, for example, **CURVE**<sup>9</sup>,

---

<sup>6</sup> For example, 23/04/2021, R 459/2020-5, BOY LONDON (fig.), § 47 (pending before the GC under T-439/21). See also Opinion of the Advocate General, 02/07/2019, C-240/18 P, Fack Ju Göhte, EU:C:2019:553, § 75-83.

<sup>7</sup> 06/07/2006, R 495/2005-G, SCREW YOU, § 21 ; 09/03/2012, T-417/10, ¡Que bueno ye! Hijoputa (fig.), EU:T:2012:120, § 21

<sup>8</sup> 05/10/2011, T-526/09, Paki, EU:T:2011:564, § 18; 14/11/2013, T-52/13, Ficken, EU:T:2013:596, § 19

<sup>9</sup> 26/09/2014, T-266/13, CURVE, EU:T:2014:836

meaning ‘prostitutes’ in Romanian and, therefore, offensive only to the Romanian-speaking public).

- 24 When assessing **public policy**, a trade mark might be found to be contrary to public policy even when it does not address a specific public or a given group of consumers. What is relevant is that it encourages, promotes or at least trivialises an infringement of a fundamental interest of the concerned Member State, according to its own system of values<sup>10</sup>.

### 3.2.2 *The meaning and perception of the mark by the relevant public*

- 25 ‘Public policy’ and ‘accepted principles of morality’ are not necessarily identical in all the Member States, due to their linguistic, historical, cultural and social differences<sup>11</sup>. As a sign may have a different connotation in the different Member States, it may be perceived to be contrary to public policy or accepted principles of morality only in certain Member States. Due to the unitary character of the EU trade mark system, a trade mark must be refused registration if it is contrary to the public policy or accepted principles of morality in only one Member State.
- 26 Furthermore, values and norms, and thus, perceptions, are likely to change over time which must also be taken into account in the examination.
- 27 It is not sufficient for a mark to be merely of ‘bad taste’ in order to be caught by the prohibition of registration<sup>12</sup>. It must be **directly offensive** to at least a significant part of the public of an average degree of sensitivity.
- 28 It has also been established that if at least one of the meanings of the mark is offensive, indecent or repulsive, then the mark is subject to an objection pursuant to Article 7(1)(f) EUTMR as long as at least a relevant part of the relevant public will perceive it as such<sup>13</sup>. It is not important that a part of the public perceives the mark as inoffensive because, for instance, it lost its vulgarity over time<sup>14</sup>.
- 29 It is important to assess the offensive meaning of a sign exclusively from the perspective of the relevant language-speaking public and not make linguistic analogies. In **CURVE**, the GC discarded the applicant’s argument that just as the word ‘Hure’ – the German ‘corresponding’ expression of the Romanian word ‘curve’ (meaning ‘prostitutes’) – had lost to a great extent its offensive connotation in Germany, so had the contested mark in Romania<sup>15</sup>.
- 30 The fact that a mark consists of more than just one (offensive) element might help to avoid a refusal as long as the additional (neutral) elements can nuance its offensive character. This may be illustrated by cases including the word ‘curve’ (meaning ‘prostitutes’ in Romanian). In the past, the Boards have refused the mark **Metallic**

<sup>10</sup> 15/03/2018, T-1/17, La Mafia SE SIENTA A LA MESA, EU:T:2018:146, § 40.

<sup>11</sup> 20/09/2011, T-232/10, Representation of the Soviet coat of arms, EU:T:2011:498, § 31-33

<sup>12</sup> 26/09/2014, T-266/13, CURVE, EU:T:2014:836, § 19; 14/11/2013, T-52/13, Ficken, EU:T:2013:596; § 22

<sup>13</sup> 14/11/2013, T-52/13, Ficken, EU:T:2013:596; § 38

<sup>14</sup> 26/09/2014, T-266/13, CURVE, EU:T:2014:836, § 26

<sup>15</sup> 26/09/2014, T-266/13, CURVE, EU:T:2014:836, § 30

**Curve**<sup>16</sup> for 'phone accessories' as being contrary to accepted principles of morality. However, in more recent decisions (**Procurve**; **Kaffe Curve**; **CURVES MAGAZIN EST. 2011 soulful driving (fig.)**)<sup>17</sup> the Boards have acknowledged that the word 'curve' blended into a new word or into a combination of words that neutralised its original offensive meaning and allowed the marks to proceed to registration. In the same vein, in **Procurve**, the Board held that the fact that the sign is an entirely coincidental combination which may have an additional unfortunate connotation ('double entendre') may not be sufficient to make it highly offensive, vulgar and obscene, in consideration of the specialised public for 'communication software' (see next point concerning the relevance of the goods and services).

- 31 Vocabularies and dictionaries are the most common tools used to understand the meaning of the sign<sup>18</sup>. In addition to vocabularies and dictionaries, studies and expert opinions<sup>19</sup> can also be used by decision-takers in order to understand how the mark is perceived by the relevant public. Usually, these sources define the word contained in the contested mark as offensive or vulgar, therefore, providing arguments against its registration.
- 32 However, the CJ emphasised in **Fack Ju Göhte** that the perception of the relevant public is determined **not only by dictionary definitions** but also **by other contextual elements** that may influence considerably the perception of the public. That assessment is not abstract, but has to be tailored to each and every case: *'due account is to be taken of the social context, including, where appropriate, the cultural, religious or philosophical diversities that characterise it, in order to assess objectively what that society considers to be morally acceptable at that time'* *'[it] requires an examination of all the elements specific to the case in order to determine how the relevant public would perceive such a sign if it were used as a trade mark for the goods or services claimed'*<sup>20</sup>.

### 3.2.3 The goods and services

- 33 The nature of the goods and services applied for is a factor that has an important impact in the assessment of whether a sign is contrary to public policy or accepted principles of morality. When the goods and services are mass-consumption goods available in non-specialised stores and aimed at the public at large, it is more likely that a great number of people (including children) will come across the potentially offensive trade mark.
- 34 On the contrary, when the goods and services to which a sign refers belong to a 'niche' market, it is most likely that only a specific target public will come into contact with the mark which will not be particularly surprised by it. The Grand Board explains in **Screw You**<sup>21</sup> how this factor applies. The mark had been considered suitable for registration for

<sup>16</sup> 29/01/2016, R 562/2015-1, Metallic Curve

<sup>17</sup> 25/05/2020, R 2994/2019-4, Procurve; 14/02/2021, R 846/2020-2, Kaffe curve; 17/12/2019, R 601/2019-2, CURVES MAGAZIN EST. 2011 soulful driving (fig.)

<sup>18</sup> 05/10/2011, T-526/09, Paki, EU:T:2011:564, § 22; 14/11/2013, T-52/13, Ficken, EU:T:2013:596, § 37; 09/03/2012, T-417/10, ¡Que bueno ye! Hijoputa (fig.), EU:T:2012:120, § 17, 21

<sup>19</sup> 05/10/2011, T-526/09, Paki, EU:T:2011:564, § 27

<sup>20</sup> 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 39-40

<sup>21</sup> 06/07/2006, R 495/2005-G, SCREW YOU, § 27-29



‘sex toys’ and ‘contraceptives’ as the public at large would not come across the mark, for instance in a supermarket. On the other hand, the mark was refused for goods such as ‘clothing’ which targets the public at large.

- 35 In **REVA The electriCity Car**<sup>22</sup>, the Board found that in the context of electric cars and in combination with the English words ‘The ElectriCity Car’, the Finnish public will not consider the expression ‘reva’ (vulgar for ‘vagina’ in Finnish) to be intentionally abusive, but as an unfortunate choice of brand of foreign origin. *‘From time to time, the general public encounters words on imported goods and services which, if used conversationally in its own language, might be found shocking. Nevertheless, they are understood for what they are, namely as neutral foreign words carrying an unfortunate meaning in the native tongue.’*
- 36 Similarly, in **SKYLLA**<sup>23</sup>, considering also that the word had multiple meanings in Greek, only one of which was considered to be mildly offensive (‘prostitute’), the Board found that the sign would not be perceived to be offensive in relation to ‘boats’ (other meanings being a female dog as well as a mythological sea monster). Likewise, in **PICA**<sup>24</sup> (where the mark meant ‘penis’ in Croatian), the Board considered that it was unlikely that consumers would understand it as offensive for ‘magnets’ and ‘stationery’. Interestingly, the assessment was based more on the pronunciation of the mark (it was pronounced as ‘pizza’) than on how it could be seen in writing by the consumer. The Boards also allowed the registration of the trade mark **CUR**<sup>25</sup> (Romanian slang for ‘butt’) stating that the mark would not be found to be offensive in relation to IT-related specialised services, but rather as *‘a slightly embarrassing or even humorous example of how English-speaking undertakings can occasionally commit a linguistic ‘faux pas’ when selling their branded products globally’* (§ 16). Moreover, the fact that the word did not address anybody in particular was also considered decisive in the assessment. In a series of cases concerning the word ‘Viola’ (Romanian for ‘rape’) (**Viola, Viola Group, Viola fintech, Viola partners, Viola credit, Viola Growth**<sup>26</sup>) the Boards held, relying also on feedback received from the Boards of Appeal of the Romanian Intellectual Property Office, that the goods and services at issue discouraged any immediate association with the negative connotation of the marks and that the Romanian public would not associate any offensive meaning with the marks in relation to administration, financial and other business services.
- 37 In **SULA**<sup>27</sup>, (vulgar for ‘penis’ in Romanian), the Board confirmed the refusal of the application as the goods (milk and derivatives) applied for did not avoid, but in certain cases even enhanced, the link with such a sexual connotation.

<sup>22</sup> 18/07/2006, R 558/2006-2, REVA The electriCity Car (fig.), § 11-12

<sup>23</sup> 09/12/2020, R 487/2020-1, SKYLLA (fig.)

<sup>24</sup> 14/12/2015, R 1627/2015-4, Pica

<sup>25</sup> 22/04/2021, R 35/2021-4, Cur

<sup>26</sup> 18/11/2019, R 1202/2019-2, Viola; 18/11/2019, R 1201/2019-2 Viola GROUP (fig.); 18/11/2019, R 1205/2019-2, Viola fintech; 18/11/2019, R 1203/2019-2, Viola partners; 18/11/2019, R 1207/2019-2, Viola credit; 18/11/2019, R 1206/2019-2, Viola growth

<sup>27</sup> 07/07/2020, R 2388/2019-4, Sula (fig.) and 07/07/2020, R 2387/2019-4, SULA (fig.)

- 38 In **Kona**<sup>28</sup>, (where the differently spelt word ‘cona’ is vulgar for ‘vagina’ in Portuguese), the Board considered the sign to be an offensive vulgar expression for the Portuguese public, notwithstanding that the goods applied for were ‘automobiles’.
- 39 Finally, it must be noted that, in **PAKI**<sup>29</sup>, the GC confirmed the Board’s assessment that, in view of the particularly offensive meaning of the word (racist and degrading for people originating from Pakistan or, generally, from the Indian continent, and residing in the United Kingdom), the sign had to be refused registration **irrespective of the goods and services** applied for (Classes 6, 20, 37 and 39). The GC also endorsed the Board’s refusal in **FICKEN**<sup>30</sup> (meaning ‘fuck’ in German, for goods in Classes 25, 32 and 33) and in **CURVE**<sup>31</sup> (meaning ‘prostitutes’ in Romanian, for a range of medical goods and services in Classes 5, 10, 35, 38, 41, 42, 44 and 45).

### 3.2.4 *Prior use of the sign on the market and the social context*

- 40 As seen above in **Screw you**, the result of the assessment can vary, depending on the context in which consumers can come across the mark. It is more likely that the mark will escape a refusal when the goods and services are sold or offered in a specific context for a specific public that is unlikely to be offended<sup>32</sup>.
- 41 The **prior use of the trade mark on the market** is another important factor to be taken into account. In **Die Wanderhure**<sup>33</sup> (German for ‘street whore’, mark applied for, for a wide range of goods and services in Classes 9, 16, 35, 38 and 41) the Board took into account, in particular, the success of the homonymous book and film adaptation and the fact that nobody complained about the title being offensive or vulgar. Similarly, in **Jewish Monkeys**<sup>34</sup> (for a range of goods and services in Classes 9, 25, 38 and 41), the Board considered that the success of the homonymous musical group proved that its fans were neither shocked nor offended by that name and in that context the term ‘Monkeys’ had no connotation of being an insult but the English term for a funny or undisciplined person. It is interesting to note the reference in the decision to the ‘fans’ of the musical group, whereas the goods and services at issue concerned the public at large.
- 42 In **Corona**<sup>35</sup>, the Board found the mark not to be contrary to accepted principles of morality in relation to ‘furniture’ as the consumer would not think about the coronavirus but rather the Corona stool designed by the applicant and which has enjoyed a huge success on the market since the 1970s.
- 43 The importance of the social context was emphasised by the CJ in **Fack Ju Göhte**. Contrary to the Board and the GC, in finding that the mark at issue was not contrary to Article 7(1)(f) EUTMR, it referred to the **relevance of the other contextual elements**, namely, that (i) the mark consisted of the title of a German film appreciated by the public

<sup>28</sup> 20/06/2019, R 1363/2018-1, Kona

<sup>29</sup> 05/10/2011, T-526/09, Paki, EU:T:2011:564, § 15-19

<sup>30</sup> 14/11/2013, T-52/13, Ficken, EU:T:2013:596, § 22

<sup>31</sup> 26/09/2014, T-266/13, CURVE, EU:T:2014:836, § 29

<sup>32</sup> 06/07/2006, R 495/2005-G, SCREW YOU, § 21

<sup>33</sup> 28/05/2015, R 2889/2014-4, DIE WANDERHURE, § 9

<sup>34</sup> 02/09/2015, R 519/2015-4, JEWISH MONKEYS, § 12

<sup>35</sup> 29/06/2021, R 587/2021-4, corona, § 12

and the critic; (ii) nobody complained about that title being offensive; (iii) the film was promoted by the Goethe Institute (Cultural Institute of the Federal Republic of Germany) and (iv) the offensive content of the expression 'Fack Ju' was not perceived by the German consumer as strong as the corresponding English expression 'fuck you'<sup>36</sup>. Particularly, regarding the relationship between Article 7(1)(f), and 7(3), EUTMR, the CJ stated that *'the relevance of the success of the eponymous comedies as one of the contextual factors is in no way invalidated by the fact that the absolute ground for refusal in Article 7(1)(f) EUTMR cannot be overcome by proof of the distinctive character acquired through use, within the meaning of Article 7(3) EUTMR, of the mark applied for. Indeed, the success of the eponymous comedies with the relevant public and, in particular, the absence of controversy as regards their title must be taken into account in order to determine whether the relevant public perceives the mark applied for as contrary to accepted principles of morality and, therefore, to establish whether that absolute ground for refusal precludes its registration, and not with a view to disregarding that ground once its applicability to the case in point has been established'* (§ 70).

### 3.2.5 *The applicant's identity, intentions and conduct*

- 44 The applicant's intentions with the filing of the trade mark application are irrelevant in the assessment of whether the sign is contrary to Article 7(1)(f) EUTMR. It is not the applicant's intentions, but the public's perception that matters in that assessment.
- 45 Furthermore, in **Intertops**<sup>37</sup>, the GC held that whether or not a mark is contrary to public policy or accepted principles of morality must be determined by the intrinsic qualities of the mark applied for, and not by the circumstances relating to the conduct of the person applying for the trade mark. Accordingly, it rejected the argument that the applicant did not hold the necessary license to offer gambling services.

### 3.2.6 *Freedom of expression and freedom to conduct a business*

- 46 In reply to an objection under Article 7(1)(f) EUTMR, applicants often claim a violation of their freedom of expression pursuant to Article 10 of the European Convention on Human Rights and Article 11 of the Charter of Fundamental Rights of the European Union, or a violation of their freedom to conduct a business pursuant to Article 16 of the Charter of Fundamental Rights of the European Union.
- 47 The CJ reminded in **Fack Ju Göhte**<sup>38</sup> that the EUTMR (including Article 7(1)(f) EUTMR) has to be applied in such a way as to *'ensure full respect for fundamental rights and freedoms, in particular the freedom of expression'* enshrined in Article 11 of the Charter of Fundamental Rights of the European Union, as recital 21 of the Preamble of the EUTMR also provides.
- 48 In any event, it is settled case-law that the refusal of a trade mark application under Article 7(1)(f) EUTMR does not limit the applicant's freedom of expression. The GC and the Grand Board have pointed out that **it is not necessary to register a sign for it to**

<sup>36</sup> 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 51-53

<sup>37</sup> 13/09/2005, T-140/02, Intertops, EU:T:2005:312, § 28

<sup>38</sup> 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 56

**be used for commercial purposes** and that the goal of Article 7(1)(f) EUTMR is not to filter out signs whose use in commerce must at all cost be prevented<sup>39</sup>. In that sense, the Board reiterated in **Boy London** that the application of Article 7(1)(f) EUTMR is not a constraint to anybody's freedom of expression, because the applicant is not prevented from using the sign but is simply refused its registration<sup>40</sup>.

### 3.3 Public policy and the cannabis cases

- 49 Regarding signs specifically in breach of **public policy**, a considerable amount of case-law has accumulated around cannabis-related trade marks.
- 50 First, it is worth clarifying that a sign is not objectionable under Article 7(1)(f) EUTMR, where it merely refers to 'hemp', a botanical class of *Cannabis sativa cultivars*, grown specifically for industrial or medicinal use. An objection under that provision is appropriate though when that term is used in combination with other elements that refer to the recreational use of the illicit substance 'marijuana'.
- 51 The signs in **Cannabis Store Amsterdam**<sup>41</sup> and **Bavaria Weed**<sup>42</sup> both refer to the plant 'cannabis' ('weed' in slang) and, consequently, implicitly, to the illicit substance 'marijuana'.



- 52 While 'Cannabis Store Amsterdam' was filed for food and beverages (including beer) and related services, 'Bavaria Weed' was filed for services consisting of or related to the therapeutic use of the substance (among others, research and development, packaging and retail services). Notwithstanding the different specifications, both signs were refused registration pursuant to Article 7(1)(f) EUTMR for being contrary to public policy.
- 53 In **Cannabis Store Amsterdam**, the GC found that the sign as a whole would be understood by the English-speaking consumer as a clear reference to coffee shops in Amsterdam where cannabis is sold for recreational purposes. The cannabis leaf in the background of the sign confirmed such reading as it is the emblematic symbol of marijuana, universally known as a reference to the substance (§ 65). The food and beverages and related services also contributed to that understanding, as marijuana can be smoked but also eaten as a cake (§ 68). The GC found the sign to be contrary to the fundamental interests of those Member States where the consumption of drugs is not

<sup>39</sup> 09/03/2012, T-417/10, ¡Que bueno ye! Hijoputa (fig.), EU:T:2012:120, § 26; 06/07/2006, R 495/2005-G, SCREW YOU, § 13


<sup>40</sup> 23/04/2021, R 459/2020-5, BOY LONDON (fig.) (pending before the GC under T-439/21)

<sup>41</sup> 12/12/2019, T-683/18, CANNABIS STORE AMSTERDAM (fig.), EU:T:2019:855

<sup>42</sup> 12/05/2021, T-178/20, Bavaria Weed (fig.), EU:T:2021:259

liberalised and to the fight against illicit drug trafficking (interests also protected by Article 83 TFEU) (§ 75-77). The harm caused by such a trade mark to the system of values of these Member States is a public policy matter (§ 74).

- 54 In **Bavaria Weed**, the GC found that the term ‘weed’ and the small cannabis leaf contain a clear reference to the illicit drug ‘marijuana’. The fact that the services indicated a therapeutic use is not, alone, enough to diminish the association created by the presence of the term ‘weed’ and the cannabis leaf. The GC also confirmed the approach taken in **La Mafia se sienta a la mesa**<sup>43</sup> (§ 40) that a mark could be contrary to public policy even when it does not offend a specific group of consumers of a given public. In fact, the assessment of whether a sign is contrary to public policy is not limited solely to signs which are likely to shock or offend **the relevant public**, but also applies to those which are likely to encourage, promote or at least trivialise an infringement of **an interest which the Member State concerned regards as fundamental** according to its own system of values (§ 55).
- 55 The Boards have ruled in several further cases that have not been appealed to the GC regarding marks consisting of or including elements that refer to marijuana. In **Well Weed**<sup>44</sup>, the Board found that the word ‘weed’ was a synonym for ‘marijuana’ and essentially referred to the recreational use of the substance, which was far from being neutral. Here, the Board made an important point about the argument brought by the applicant that hemp can be marketed in the EU, if meeting specific legal requirements (THC content less than 0.2%). Such a claim was supported by the ‘CBD’ judgment of the CJ<sup>45</sup>, by an Italian law that allows the cultivation of hemp in given conditions and by a legislative proposal brought before the EU Parliament to modify those legal limits in a more favourable way for the sector (§ 25). The Board rejected that reasoning by referring to **Cannabis Store Amsterdam** (namely, § 68 thereof) and found that the assessment of the registrability of the sign must rely on the intrinsic characteristics of the mark and on how the public perceives it. ‘Well Weed’ (‘Good Cannabis’) unquestionably calls into the mind the recreational use of marijuana. The Board also specified that the sign was contrary to public policy – and not to accepted principles of morality – as the prohibition to sell or consume marijuana is a fundamental interest of the system of values of several Member States (§ 40).

- 56 In **4.20 Hemp Fest**<sup>46</sup> (  ), the Board found that the mark referred to a festival that ‘promoted’ the recreational use of marijuana (§ 40). The blurred figurative element representing the date 4.20 (the 20<sup>th</sup> of April being the so-called Marijuana Day) and the word ‘fest’ make it clear that ‘hemp’ does not have a neutral meaning. In **Cannatonic**<sup>47</sup>, the term ‘canna’ is a slang word for ‘joint’ in Italian, and therefore, in conjunction with the double reference to ‘cannabis’, the trade mark showed a semantic connection with the illicit substance marijuana.

<sup>43</sup> 15/03/2018, T-1/17, La Mafia SE SIENTA A LA MESA, EU:T:2018:146

<sup>44</sup> 04/03/2021, R 213/2021-5, WELL WEED

<sup>45</sup> 19/11/2020, C-663/18, Marketing du cannabidiol - CBD, EU:C:2020:938

<sup>46</sup> 16/06/2020, R 2158/2019-2, 4.20 Hemp Fest (fig.)

<sup>47</sup> 05/07/2021, R 2160/2020-2, Cannatonic

- 57 In the same vein, the Boards also confirmed the examiner's refusal of the signs **THE TERPS DONUT**<sup>48</sup> and **TERPS ARMY**<sup>49</sup>:



- 58 Terp, is a slang word for 'terpene' which is the way cannabis smells and tastes. The use of that term in combination with the figurative elements do trigger the association with the recreational use of the illicit substance marijuana.
- 59 In **Wild hemp**<sup>50</sup> (for non-medicated body care preparations and electronic cigarettes) and **Pure Hemp**<sup>51</sup> (for rolling paper), the Boards confirmed the first instance decisions to refuse the marks under Article 7(1)(b) and (c) EUTMR, and not under Article 7(1)(f) EUTMR.
- 60 In **Green Gelato**<sup>52</sup>, **Amnesia Haze**<sup>53</sup>, **Exodus Cheese**<sup>54</sup>, **Northern Lights**<sup>55</sup>, **White Widow**<sup>56</sup> and **Green Crack**<sup>57</sup> (all applied for tobacco and tobacco products, such as electronic cigarettes and liquid therefor), the signs identified a number of commercial denominations or a specific type of marijuana, without explicitly referring to marijuana. The Boards refused all these applications as being contrary to public policy, stating that these names are known to the relevant public (as demonstrated by consumers' comments about these varieties posted on specialised websites) as names of varieties of marijuana. Interestingly though, the applications in **Green Gelato** and **Amnesia Haze** were also rejected due to them being descriptive and non-distinctive.

<sup>48</sup> 09/02/2021, R 2890/2019-1, THE TERPS DONUTS (fig.)

<sup>49</sup> 09/02/2021, R 2888/2019-1, TERPS ARMY (fig.)

<sup>50</sup> 23/11/2020, R 470/2020-1, Wild hemp

<sup>51</sup> 21/10/2020, R 853/2020-1, Pure Hemp (fig.) (pending before the GC under T-17/21)

<sup>52</sup> 05/07/2021, R 2157/2020-2, Green gelato

<sup>53</sup> 05/07/2021, R 2158/2020-2, Amnesia Haze

<sup>54</sup> 13/05/2021, R 1789/2020-2, Exodus cheese

<sup>55</sup> 08/04/2021, R 1757/2020-2, Northern Lights

<sup>56</sup> 10/12/2020, R 812/2020-2, White widow

<sup>57</sup> 10/12/2020, R 813/2020-2, Green crack

#### 4. Conclusions

- 61 The analysis has shown that the Boards' decision-making practice is highly consistent with the case-law of the European Courts and amongst the Boards themselves. The Boards have always been confirmed by the GC in the application of Article 7(1)(f) EUTMR, with the sole exception of the **Fack Ju Göhte** judgment.
- 62 The following conclusions can be drawn in order to maintain that high level of consistency.
- (i) Public policy and accepted principles of morality are different but are often overlapping concepts. Although there is not always an obligation to specify which one of them applies when reasoning under Article 7(1)(f) EUTMR, **identifying which of the two systems of values is affected, is a logical first step** that allows a better and more concrete assessment, wherever a clear distinction is possible. While 'public policy' entails an **objective** assessment in relation to imperative legislative or administrative norms, the examination of 'accepted principles of morality' is, on the other hand, a **subjective** assessment in relation to normal, accepted conduct in a society at a certain point in time.
  - (ii) The meaning and perception of the mark by the relevant public are fundamental in assessing whether the relevant public would be offended by it. The CJ clarified in **Fack Ju Göhte** that beyond the dictionary meaning of a potentially offensive word in the mark applied for, it is incumbent on the Office to carefully examine all **other contextual elements** relevant in the specific circumstances of the case, including any prior use of the sign not causing any offense.
  - (iii) The possible offensive meaning of a sign must be assessed **specifically from the perspective of the relevant language-speaking public** and not by reference to corresponding expressions in other languages that may have different connotations. In the case of signs that are difficult to be understood by non-native speakers it may be pertinent to seek the opinion of the relevant national IP Office in order to properly assess whether the sign is contrary to public policy and/or accepted principles of morality.
  - (iv) To be caught by the prohibition of registration under Article 7(1)(f) EUTMR, a sign must be **directly offensive** to at least a significant part of the public of an average degree of sensitivity. It is, therefore, not sufficient that the sign is of mere 'bad taste', amusing, unfortunate or embarrassing.
  - (v) In the assessment of whether a sign consisting of or including a possibly offensive word is caught by Article 7(1)(f) EUTMR, it must be taken into account that the sign may be encountered by a **wider public than is specifically targeted by the goods or services** at issue. Therefore, the mere fact that the specific public for the goods and services at issue would not consider the sign offensive, is not a sufficient ground for allowing the registration of the sign, if, on the other hand, a sufficiently significant part of the public that may also come into contact with the sign would be offended. Also, it is not appropriate to allow the registration of a vulgar and offensive expression solely on the basis that it is not addressed to any specific group.

- (vi) It must also be carefully considered whether (i) the particular goods and services at issue, (ii) any neutral element used in combination with the offensive word or symbol, or (iii) any misspelling or unusual variation in syntax could **mitigate any immediate association with the negative connotation of the sign**. As a result of that overall assessment, it may be justified to find that the sign at issue is contrary to public policy or accepted principles of morality for **all or part only of the goods and services**.
- (vii) The CJ's statement in **Fack Ju Göhte** that the application of the EUTMR, including Article 7(1)(f) thereof, must ensure full respect for fundamental rights and freedoms, in particular the freedom of expression, has to be read in the specific context of the case that concerned a sign which was originally a film title. It is settled case-law that the application of Article 7(1)(f) EUTMR is **not a constraint to the freedom of expression or to the freedom to conduct a business** because, while the mark may be refused registration or cancelled, the applicant or proprietor is not prevented from using it in the course of trade.
- (viii) Signs consisting of or including a **reference to 'marijuana'** and its recreational use will usually not be allowed registration as they are contrary to public policy in several Member States. On the other hand, signs applied for which make a neutral reference to the plant 'hemp' (cannabis) as such are usually allowed to proceed to registration, unless that reference recalls the illicit use of the prohibited substance 'marijuana'.



**Annex**  
**List of reviewed cases**

**Court of Justice and General Court**

27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118

12/05/2021, T-178/20, Bavaria Weed (fig.), EU:T:2021:259  
12/12/2019, T-683/18, CANNABIS STORE AMSTERDAM (fig.), EU:T:2019:855  
15/03/2018, T-1/17, La Mafia SE SIENTA A LA MESA, EU:T:2018:146  
24/01/2018, T-69/17, Fack Ju Göhte, EU:T:2018:27  
26/09/2014, T-266/13, CURVE, EU:T:2014:836  
14/11/2013, T-52/13, Ficken, EU:T:2013:596  
09/03/2012, T-417/10, ¡Que bueno ye! Hijoputa (fig.), EU:T:2012:120  
05/10/2011, T-526/09, Paki, EU:T:2011:564  
20/09/2011, T-232/10, Representation of the Soviet coat of arms, EU:T:2011:498  
13/09/2005, T-140/02, Intertops, EU:T:2005:312

**Boards of Appeal**

30/01/2019, R 958/2017-G, BREXiT (fig.)  
06/07/2006, R 495/2005-G, SCREW YOU

05/07/2021, R 2160/2020-2, Cannatonic  
05/07/2021, R 2157/2020-2, Green gelato  
05/07/2021, R 2158/2020-2, Amnesia Haze  
29/06/2021, R 587/2021-4, corona  
13/05/2021, R 1789/2020-2, Exodus cheese  
23/04/2021, R 459/2020-5, BOY LONDON (fig.) (pending before the GC under T-439/21)  
22/04/2021, R 35/2021-4, Cur  
08/04/2021, R 1757/2020-2, Northern lights  
04/03/2021, R 213/2021-5, WELL WEED (fig.)  
14/02/2021, R 846/2020-2, Kaffe curve  
09/02/2021, R 2888/2019-1, TERPS ARMY (fig.)  
09/02/2021, R 2890/2019-1, THE TERPS DONUTS (fig.)  
10/12/2020, R 812/2020-2, White widow  
10/12/2020, R 813/2020-2, Green crack  
09/12/2020, R 487/2020-1, SKYLLA (fig.)  
23/11/2020, R 470/2020-1, Wild hemp  
21/10/2020, R 853/2020-1, Pure Hemp (fig.) (pending before the GC under T-17/21)  
27/07/2020, R 2878/2019-1, Unfucked  
07/07/2020, R 2388/2019-4, Sula (fig.)  
07/07/2020, R 2387/2019-4, SULA (fig.)  
16/06/2020, R 2158/2019-2, 4.20 Hemp Fest (fig.)  
28/05/2020, R 2535/2019-1, Devin  
25/05/2020, R 2994/2019-4, Procurve

22/01/2020, R 1458/2019-5, Bavaria Weed  
17/12/2019, R 601/2019-2, CURVES MAGAZIN EST. 2011 soulful driving (fig.)  
18/11/2019, R 1201/2019-2, viola GROUP (fig.)  
18/11/2019, R 1205/2019-2, Viola fintech  
18/11/2019, R 1203/2019-2, Viola partners  
18/11/2019, R 1206/2019-2, Viola growth  
18/11/2019, R 1202/2019-2, Viola  
28/10/2019, R 776/2019-4, Narcos  
13/09/2019, R 2419/2018-2, LLIBERTAT PRESOS POLITICS OMNIUM LLENGUA  
CULTURA PAIS (fig.)  
20/06/2019, R 1363/2018-1, Kona  
29/04/2019, R 131/2019-4, VITUS (fig.)  
08/04/2019, R 1566/2018-5, Novichok  
16/03/2018, R 2103/2017-4, CURVE-O (3D)  
29/01/2016, R 562/2015-1, Metallic Curve  
10/09/2015, R 510/2013-1, REPRESENTATION D'UNE CROIX (fig.)  
02/09/2015, R 519/2015-4, JEWISH MONKEYS  
28/05/2015, R 2889/2014-4, DIE WANDERHURE  
14/12/2015, R 1627/2015-4, Pica  
18/07/2006, R 558/2006-2, REVA The electriCity Car (fig.)