

Freedom of speech and trademarks:
Gauging public sensitivities or curtailing civil liberties?

Introduction

Control is in the nature of registration authorities. In most trade mark systems, virtually anyone of sound mind and enjoying legal rights as a citizen of a recognised country can apply to protect any sign he or she chooses for any goods or services. But not all such applications can proceed to registration. Age-old prohibitions exist for registration of signs that are descriptive or generic for the goods or services they seek to protect or otherwise lack the requisite level of distinctiveness. Ironically, it is precisely those signs that are most attractive to the advertising industry since little investment is needed to convey a promotional message to target consumers. Much litigation centres on the dividing line between allusive or suggestive marks and those which are unregistrable.

Exploring other avenues, advertising gurus have become increasingly interested in other attention seeking devices. Signs that seek to shock are particularly appealing to young people and are potentially a good source of income. But while it may, in some circumstances, 'pay to be rude', profane or distasteful for commercial purposes, legislation exists to place some limits on this practice.

Basic rights

Article 10 of the European Convention for the Protection of Human Rights and Fundamental Freedoms ('ECHR') recognizes that 'everyone has the right to freedom of expression ... without interference by public authority'. However, that article also acknowledges that such freedom brings with it 'duties and responsibilities', regulated by certain 'formalities, conditions, restrictions or penalties' that are 'necessary in a democratic society, in the interests of ... the protection of ...morals'. Freedom of expression exists and is enshrined in law but it is not unfettered.

The freedom of expression circumscribed by the provisions of Article 10 also extends to commercial expression¹. In the specific context of Community trade mark law, that circumscription of freedom is embodied in Article 7(1)(f) CTMR², which prohibits registration of signs that are 'contrary to public policy or to accepted principles of morality'. In fact, the legislative need to uphold this particular public interest is not recent. This is borne out by the fact that the wording of Article 7(1)(f) CTMR mirrors that of Article 6 *quinquies* of the Paris Convention³.

¹ See *Casado Coca v Spain* (1984) 18 EHRR 1, paragraphs 33-37, in which it was also acknowledged that such freedom should be circumscribed by certain limitations, including the prevention of disorder and the protection of morals. Considerations of morality and public order are also present in Article 53 (a) of the Munich Convention on European Patents and Articles 30, 39, 46 and 58 of the EC Treaty.

² Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended ('CTMR').

³ Paris Convention of 20 March 1883 (as revised at Stockholm on 14 July 1967).

Balancing act

While traders have a right to use the words and images of their choosing in the registration of trade marks, the Community legislature has placed a burden on OHIM⁴ to protect the ‘right of the public not to be confronted with disturbing, abusive, insulting or even threatening trade marks⁵’ on the Community Trade Mark register. While OHIM is master of that register, it falls to the Member States to regulate the *use* of both registered and unregistered marks. This may be done under the civil, administrative or criminal law of a Member State⁶.

Since registration is not a prerequisite for use, the legislature’s incursion into the territory of freedom of expression is somewhat relative. Nevertheless, ‘business may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection’⁷. Thus, the practical effect of the legislative prohibition may be significant.

It also follows that OHIM is called upon to act as a moral arbiter. In so acting it has a margin of discretion in determining what is contrary to accepted principles of morality⁸. Since morality is seen as a fundamental interest of society, OHIM ‘should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilized society’⁹. However, OHIM must act wisely in the way it applies such a prohibition. Too strict an approach would unduly curtail the right of freedom of expression. On the other hand, an overly liberal approach could cause outrage and moral indignation. What then is the *juste milieu* between these two extremes?

Standards and tests

The Community trade mark regulations do not lay down any tangible test for the application of Article 7(1)(f) CTMR. Over the past few years, the OHIM’s Boards of Appeal have struggled to shed light on the notion of ‘accepted principles of morality’. While some marks are so distasteful that they may give offence to a broad spectrum of society, others may have double meanings or innuendos that may cast doubt on the likelihood of deep offense.

It is evident that signs that depict gross obscenity or refer to a known terrorist have no place on the register. The Second Board thus had little difficulty rejecting two applications to register the sign ‘BIN LADIN’ (in both Latin and Arabic script)¹⁰ for various goods and services in Classes 9, 12, 14, 18, 25, 28, 35 and 41. However, the complicating factor in this case was that the application to register the mark was filed four months prior to the events of 9/11. It was argued that the name ‘BIN LADIN’ was that of a reputable Saudi company that had done business in various parts of Europe over a number of years. At the date of filing, the name ‘BIN LADEN’ was not

⁴ Office for Harmonization in the Internal Market (Trade Marks and Designs).

⁵ Decision of 6 July 2006 – R 495/2005-G – SCREW YOU, paragraph 14.

⁶ Article 106(2) CTMR.

⁷ See decision in SCREW YOU, cited above, at paragraph 15.

⁸ Decision of 29 September 2004 – R 176/2004-2-BIN LADIN, at paragraph 28.

⁹ See decision in SCREW YOU, cited above, at paragraph 13.

¹⁰ Decision in BIN LADEN, cited above.

known to the general public and would only have been recognizable to experts on Islamic terrorism.

The Board found that the trade mark application was manifestly contrary to public order and morality, since acts of terrorism are absolutely contrary to the ethical and moral principles recognized in the Member States of the European Union and all civilized nations¹¹. The name would be known by the public as that of the leader of the Al Qaeda organization and had universally notoriety as a result of 9/11. Fundamental considerations of human dignity, liberty, equality and solidarity prevented affording legal protection to a name that is that of the leader of a terrorist group, responsible for the death of thousands of persons. There could be no doubt that society as a whole would be deeply offended and scandalized if the mark applied for were to be registered in the Community¹². Even if the name were a trade name, this would not prevent the application of Article 7(1)(f) CTMR.

On slightly less firm ground, the Board stated that the sign was widely known as the name of a terrorist even before 9/11 because of the acts of terrorism perpetrated on 7 August 1998 in Nairobi (Kenya) and Dar-es-Salam (Tanzania) and resulting in a UN Security Council Resolution in 1999. Accordingly, there was no question of retrospective application of absolute grounds¹³.

On the other hand, the Fourth Board in its decision of 25 March 2003 – DICK & FANNY, doubted that ‘the mere fact that the two words have, alone or in combination with each other, a sexual connotation should not be regarded as “offensive” ... [because] these words merely designate things but do not transmit any message’¹⁴. The sign simply designates anatomical parts without proclaiming an opinion, containing an incitement or conveying an insult. As such, the sign raises ‘a question of taste, but not one of public policy or morality’¹⁵. Furthermore, the Board was influenced by the fact that the particular combination could reduce any sexual innuendo of informal speech and could instead allude to a couple (just as Tom & Jerry or Bonnie & Clyde in an English-language context).

Picking up on the idea of ‘context’, in its decision of 18 July 2006 – REVA¹⁶, the Second Board noted that the meaning of the word ‘reva’ in Finnish was not clear cut. While it could be regional slang in the Helsinki area for female genitalia, it could also have less offensive meanings. In any event, when seen in the context of a mark for an electric car, it ‘does not look like a form of words which is intended to insult or shock. At worst the mark might carry an element of unintentional bad taste, but nothing more’¹⁷. Thus no one in Finland would be likely to believe that the trade mark

¹¹ Decision in BIN LADIN, cited above, at paragraph 17.

¹² It is thus regrettable that names such ESCOBAR (Pablo Escobar, a Columbian drug trafficker), POT (Pol Pot, Cambodia), LENIN, CASTRO, MAO and DADA (Idi Amin Dada, Uganda) have found there way on to the Community register.

¹³ Both decisions were appealed to the Court of First Instance of the European Communities. However, the appeal was subsequently withdrawn. There must, none the less, be some doubt whether the name ‘BIN LADIN’, written in Arabic, would have been understood by ordinary Community consumers and thus have been able to give offence.

¹⁴ R-111/2002-4, at paragraph 9.

¹⁵ Decision in DICK & FANNY, cited above, at paragraph 10.

¹⁶ R-558/2006-2,

¹⁷ Decision in REVA, cited above, at paragraph 11.

applicant was being intentionally abusive, even if some consumers could feel ‘embarrassed’ or ‘uncomfortable’ and others, ‘amused’ or ‘puzzled’.

Although the Boards recognized quite early on that assessment of ‘acceptable principles of morality’ involved shifting paradigms, clarity was only brought to the problem in the Grand Board’s decision – SCREW YOU¹⁸. In that decision, the Grand Board recognized that words that ‘would never have been intentionally broadcast on prime-time ... television a few decades ago are now considered permissible¹⁹’. Looking at the question of the level of vulgarity, profanity or insult of the expression for which registration was sought, the Grand Board limited its analysis to the perspective of citizens of the United Kingdom and Ireland²⁰. It noted that this same form of words had in more recent times been broadcast on British television in the soap ‘EastEnders’ and the animated show ‘The Simpsons’. But although public swearing and cursing is undoubtedly more acceptable now than it was 20 or 30 years ago, the Grand Board believed that when used in the context of art or literature, circumscription of such use would be made with great reluctance in democratic and open societies. Accordingly, the fact of the expression at issue having been broadcast on early evening television was not conclusive.

Having established, by reference to dictionaries that the sign applied for was generally recognized as a vulgar interjection, it looked more specifically at the word from the perspective of British and Irish ‘citizens with a normal level of tolerance and sensitivity ... whose values and standards are representative of society as a whole²¹, to see whether it would be viewed by them as offensive and objectionable. It concluded that for ordinary people, and in particular, adults with young children and the elderly, the words would be ‘offensive and objectionable, especially if they encountered them as a trade mark in ordinary shops to which children have access, or if they were advertised on television at a time when children were likely to be watching or if they were displayed prominently on clothing worn in the street or visible in shop windows²²’.

The Grand Board came to the realization that, when considering questions of moral offence or shock, the identity of the ‘ordinary citizen’ depends on the goods and services at issue. It is evident that for ordinary goods and services sold and supplied by ordinary outlets and suppliers, the ordinary person would be concerned by the mark. Accordingly, Article 7(1)(f) CTMR prevented registration of goods in Classes 9, 25, 28 and 33. On the other hand, a number of the goods for which protection was claimed under the mark were either, by their very nature, intended for consumers who would be less easily shocked, or, would be retailed in outlets frequented by people less likely to take offence at the mark in question.

¹⁸ Decision of 6 July 2006, cited above. In the BIN LADIN decision, the Second Board recognized that standards of public morality varied from country to country. That decision also had to overcome the problem of temporal considerations of morality (in that case the events of 9/11).

¹⁹ See paragraph 23 of the decision.

²⁰ The existence of an absolute ground in one part of the Community is enough to prevent registration of a Community Trade Mark pursuant to Article 7(2) CTMR.

²¹ See paragraph 26.

²² See paragraph 26.

Applying these criteria, it was obvious that the purchasers of 'sex toys', found only in sex shops or specialist web sites, would 'by definition [be] unlikely to be offended by a trade mark which contains crude, sexually charged language'²³. Similarly, although 'condoms' are sold in supermarkets and even advertised on television (at times when children are not likely to be watching), the Grand Board considered that prospective purchasers would be 'unlikely to be offended by a term with crude sexual connotations'²⁴.

Somewhat more controversially, the Grand Board imposed a rewording of the specification of 'breast pumps' and 'artificial breasts', rejecting registration of these items under Article 7(1)(f) CTMR in so far as they were not of a type normally sold exclusively in sex shops. The reasoning was simply that while lactating mothers and mastectomy patients would be deeply offended by the mark applied for, sex shop customers would not.

Conclusion

Balancing freedom of commercial expression in trade mark matters against the need to protect accepted principles of morality is a delicate operation. It is one which is imposed by legislation and therefore is mandatory in nature. Considerations of reasonableness are paramount in this balancing exercise and depend on national contexts, the goods and services concerned, temporal contexts as well as, more generally the need to constantly measure and check liberalism versus conservatism. The perceived intention of the trade mark applicant can, in very specific circumstances relating to minority languages, also be a further relevant consideration.

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²³ See paragraph 29.

²⁴ See paragraph 29 of the decision.