

IN THE MATTER OF REGISTERED TRADE MARK NO. 2184549 IN THE
NAME OF FRENCH CONNECTION LIMITED

AND IN THE MATTER OF APPLICATION FOR A DECLARATION OF
INVALIDITY THEREOF NO. 81862 BY DENNIS WOODMAN

DECISION

Introduction

1. French Connection Ltd is the registered proprietor of UK Registered Trade Mark No. 2184549 comprising the mark FCUK registered as of 16 December 1998 in respect of the following goods in Class 14:

Watches, clocks, horological and chronometric apparatus and instruments; watch straps, watch bands; jewellery; costume jewellery; key rings, key holders, key-chains, necklaces, bracelets, earrings, brooches and rings; containers adapted to carry the aforesaid goods; parts and fittings for all the aforesaid goods.

Registration No. 2184549 is a one of a number of UK and Community registrations of the mark FCUK for a variety of goods and services owned by French Connection.

2. On 20 September 2004 Dennis Woodman applied for a declaration that the registration be declared invalid on the ground that the registration was contrary to section 3(3)(a) of the Trade Marks Act 1994. This provides that:

A trade mark shall not be registered if it is ... contrary to public policy or accepted principles of morality.

3. Mr Woodman contends that FCUK is contrary to accepted principles of morality. He has no commercial interest in the registration. He is acting, as he sees it, in the public interest. Nothing turns on this since an application for a declaration of invalidity may be made by any person: section 47(3) of the 1994 Act. Counsel for Mr Woodman told me that the present application was a test case, which if successful would be used as a springboard for applying for declarations that French Connection's other registrations of the mark FCUK were also invalid on the same ground.
4. In a written decision dated 20 December 2005 (O/330/05) Mike Foley acting for the Registrar dismissed the application. Mr Woodman now appeals.

The law

5. Counsel for Mr Woodman accepted that the hearing officer had directed himself correctly as to the law in his decision. Nevertheless he submitted that the hearing officer had wrongly applied the law to the facts of the present case. His submissions and those of counsel for French Connection in response revealed certain differences between the parties as to the nuances of the law. Partly for that reason and partly because I have found some difficulty in understanding precisely how the law is to be applied in a case such as this, I consider that it is appropriate to begin by reviewing the law.

Legislation

6. Section 3(3)(a) of the 1994 Act derives from Article 3(1)(f) of Council Directive 89/104/EC of 21 December 1998 to approximate the laws of the Member States relating to trade marks ("the Trade Marks Directive") which is in essentially identical terms. Section 3(3)(a) and Article 3(1)(f) of the Directive also correspond to Article 7(1)(f) of Council Regulation 40/94/EEC of 20 December 1993 on the Community trade mark ("the CTM Regulation"). It appears that the expression "public policy" which is used in the English texts of Article 3(1)(f) of the Trade Marks Directive and Article 7(1)(f) of the CTM Regulation is an attempt at an idiomatic translation of the expression

“*ordre public*” which appears in the French text (see *Philips Electronics NV v Remington Consumer Products Ltd* [1998] RPC 283 at 310 lines 8-12).

7. Article 3(1)(f) of the Trade Marks Directive and Article 7(1)(f) of the CTM Regulation in turn have their origin in Article 6*quinquies* paragraph B(3) of the Paris Convention for the Protection of Industrial Property of 1883 (Stockholm Act 1967). This provides:

Trademarks covered by this Article may be neither denied registration nor invalidated except in the following cases: ... when they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the legislation on marks, except if such provision itself relates to public order.

It appears that the expression “public order” in this official English translation of the authentic French text is a word-for-word translation of *ordre public*.

8. The provision contained in Article 6*quinquies* paragraph B(3) was not new to the Stockholm Act. It has its origins in Article 6 paragraph 5 of the original Convention of 1883.
9. Prior to the enactment of the 1994 Act, section 11 of the Trade Marks Act 1938 provided:

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Save for the addition of the words “or cause confusion”, this provision repeated section 11 of the Trade Marks 1905. Section 11 of the 1905 Act in turn was in very similar to section 73 of the Patents, Designs and Trade Marks Act 1883 (as amended in 1888) save for the addition of the words “or would be contrary to law or morality”. It appears that those words were inserted into

the 1905 Act with a view to the United Kingdom complying with its obligations under the Paris Convention.

10. The ability of Members of the World Trade Organisation (“WTO”), to deny registration on the ground specified in Article 6*quinquies* paragraph B(3) of the Paris Convention is preserved by Article 15(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights of 1994 (“TRIPs”), which provides:

Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).

11. Although the Paris Convention contains no comparable provision to Article 6*quinquies* B(3) with respect to patents, Article 2(a) of the Strasbourg Convention on the Unification of Certain Points of Substantive Law on Patents for Invention of 1963 provides:

The Contracting States shall not be bound to provide for the grant of patents in respect of ... inventions the publication or exploitation of which would be contrary to ‘*ordre public*’ or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by a law or regulation.

12. Consistently with Article 2 of the Strasbourg Convention, Article 53(a) of the European Patent Convention of 1973 provides:

European patents shall not be granted in respect of ... inventions the publication or exploitation of which would be contrary to ‘*ordre public*’ or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States.

13. The ability of Members of the WTO to deny patentability on this ground is substantially preserved by Article 27(2) of TRIPs, which provides:

Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is

necessary to protect *ordre public* or morality, including to protect human, animal or plant life or health or avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

14. Consistently with Article 27(2) of TRIPs, Article 6(1) of European Parliament and Council Directive 98/44/EC of 6 July 1998 on the legal protection of biotechnological inventions (“the Biotechnology Directive”) provides:

Inventions shall be considered unpatentable where their commercial exploitation would be contrary to *ordre public* or morality; however exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.

15. Purportedly consistently with Article 27(2) of TRIPs and Article 6(1) of the Biotechnology Directive, section 1(3) and (4) of the Patents Act 1977 (as amended by the Patents Regulations 2000, SI 2000 No. 2037) provide:

- (3) A patent shall not be granted for an invention the commercial exploitation of which would be contrary to public policy or morality.
- (4) For the purposes of subsection (3) above, exploitation shall not be regarded as contrary to public policy or morality only because it is prohibited by any law in force in the United Kingdom or any part of it.

I note that in these provisions the term “public policy” has been substituted for the term *ordre public* even though it is the latter which is used in both TRIPs and the English text of the Biotechnology Directive.

16. Previously, section 1(3)(a) of the 1977 Act provided that:

A patent shall not be granted ... for an invention the publication or exploitation of which would be generally expected to encourage offensive, immoral or anti-social behaviour.

I note that this legislative formulation bears some similarity to the European Patent Office’s Guidelines for Examination Chapter IV Part C paragraph 3.1, which deals with the application of Article 53(a) EPC:

The purpose of this is to exclude from protection inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour ...; one obvious example of subject-matter which should be excluded is a letter-bomb. This provision is likely to be invoked only in rare and extreme cases. A fair test to apply is to consider whether it is probable that the public in general would regard the invention as so abhorrent that the grant of patent rights would be inconceivable. If it clear that this is the case, objection should be raised under Art. 53(a); otherwise not.

17. Going back before the 1977 Act, section 75 of the Patents and Designs Act 1907 provided:

The comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion be contrary to law or morality.

Similarly, section 10(1)(b) of the Patents Act 1949 provided:

If it appears to the comptroller in the case of any application for a patent ... that the use of the invention in respect of which the application is made would be contrary to law or morality ... he may refuse the application.

It would appear that these provisions were based on section 11 of the 1905 and 1938 Acts.

18. Article 8 of European Parliament and Council Directive of 13 October 1998 on the legal protection of designs (“the Designs Directive”) provides:

A design right shall not subsist in a design which is contrary to public policy or to accepted principles of morality.

Article 9 of Council Regulation No. 6/02/EC of 12 December 2001 on Community designs is in corresponding terms. So far as I am aware, these provisions do not originate from any international convention. I assume that they were inspired by Article 3(1)(f) of the Trade Marks Directive and Article 7(1)(f) of the CTM Regulation.

19. Section 1D of the Registered Designs Act 1949 (as amended by the Registered Designs Regulations 2001, SI 2001 No. 3949) is in essentially identical terms to Article 8 of the Designs Directive. Previously, section 43(1) of the 1949 Act provided:

Nothing in this Act shall be construed as authorising or requiring the registrar to register a design the use of which would, in his opinion, be contrary to law or morality.

I have set out section 75 of the 1907 Act above.

20. So far as I have noticed, neither the Berne Convention of 1886 (Paris Act 1971) nor TRIPs nor the WIPO Copyright Treaty of 1996 contains any comparable provision with regard to copyrights. Instead, Article 17 of the Berne Convention provides:

The provisions of this Convention cannot in any way affect the right of the Government of each country of the Union to permit, to control, or to prohibit, by legislation or regulation, the circulation, presentation, or exhibition of any work or production in regard to which the competent authority may find it necessary to exercise that right.

This provision is generally understood to preserve the ability of countries of the Union to control or prohibit the circulation etc of works in order to maintain public order: see Ricketson and Ginsburg, *International Copyright and Neighbouring Rights* (2nd ed) §§13.88-13.89.

21. Section 171(3) of the Copyright, Designs and Patents Act 1988 provides:

Nothing in this Part affects any rule of law preventing or restricting the enforcement of copyright, on grounds of public interest or otherwise.

Case law under legislation other than section 3(3)(a) of the 1994 Act and its counterparts

22. The relevant part of section 11 of the 1905 and 1938 Acts seems to have generated few reported cases. Indeed, I am only aware of one case in which an

application to register a trade mark was refused on this ground. In *HALLELUJAH Trade Mark* [1976] RPC an application to register the mark HALLELUJAH for “articles of clothing for women” was refused on this ground, and also in the exercise of the Registrar’s discretion under section 17(2) of the 1938 Act. The hearing officer Mr Myall said at 607 line 28 – 608 line 5:

Section 11 of the Trade Marks Act 1938 prohibits, so far as relevant to this case, the registration as a trade mark of any matter the use of which would be ‘contrary to morality’. I find very little guidance in reported cases for determining what meaning is to be attributed to this phrase. The dictionaries give the meaning of ‘morality’ as ‘Moral principles or rules; moral conduct’ and of ‘moral’ as ‘concerned with the distinction between right and wrong, virtuous, righteous’. At present we live in what is commonly called the ‘permissive age’, where previously accepted moral standards are undergoing change. There have been similar periods in the past and no doubt there will follow in due course a return to stricter standards as the historical wheel turns full circle. However, it is well established that the registrability of a trade mark must be judged as at the date of its application. I conclude that the phrase ‘contrary to morality’ falls to be considered by the generally accepted standards of today and not by those of 1938. The difficulty is to be sure what those are, and more particularly, where the line is to be drawn between marks whose registration is prohibited by the section and those where it is not. When religious and moral standards are changing, sometimes quite rapidly, it seems to me that the Registrar should only follow where other have given a clear lead. While he must not remain isolated from the day-to-day world, frozen in an outmoded set of moral principles, he must equally not presume to set the standard. He must certainly not act as a censor or arbiter of moral, nor yet as a trendsetter. He must not lag so far behind the time that he appears to be out of touch with reality, but he must at the same time not be so insensitive to public opinion that he accepts for registration a mark which many people would consider offensive.

23. Later in his decision Mr Myall quoted two passages from the judgment of Evershed J in *La Marquise Footwear Inc.’s Application* (1946) 64 RPC 27 at 30 and 32. In that case Evershed J overturned the Registrar’s refusal to register the trade mark OOMPHIES for shoes. One of the bases on which the Registrar had refused the application was in the exercise of his discretion under section 17(2). It was with this question that the passages quoted by Mr Myall were concerned, and not with section 11. Moreover, it was in that context that Mr

Myall referred to them. Nevertheless the first of these passages has been referred to in subsequent cases on the present topic, and so I shall quote it here:

I must wholeheartedly accept the proposition that it is the duty of the Registrar (and it is my hope that he will always fearlessly exercise it) to consider not merely the general taste of the time, but also the susceptibilities of persons, by no means few in number, who still may be regarded as old fashioned and, if he is of opinion that the feelings or susceptibilities of such people will be offended, he will properly consider refusal of the registration. I should certainly hope that, in taking, as I do take in this case, a different view from him, I am in no way debasing the standard which, as a servant of the State, he should exercise and maintain in his jurisdiction....

24. Section 75 of the 1907 Act and section 10(1)(b) of the Patents Act 1949 seem to have generated even less in the way of reported authority. In *A and H's Patent Application* (1924) 44 RPC 298 the examiner refused a patent application for an improved contraceptive device on this ground. The applicants' appeal to the Solicitor-General was dismissed, but the ground on which Sir Thomas Inskip dismissed the appeal was not that the invention was contrary to morality, as to which he expressed no opinion, but that the Comptroller should refuse to grant a patent for the invention in the exercise of the Crown's discretion under section 97 of the 1907 Act. This practice was still being followed at time of *Riddlesbarger's Patent Application* (1935) 53 RPC 57.
25. In *Masterman's Design* [1991] RPC 89 the applicant applied to register a design for a furry doll with what was described as an "apron". The apron was akin to a sporran, and when lifted up it revealed objects resembling (and clearly intended to resemble) male genitalia. The examiner objected to the application both under section 43(1) of the Registered Designs Act 1949 and in the exercise of the Registrar's discretion under section 3(3) of that Act (section 3(5) of the Act as subsequently amended by the 1988 Act). The hearing officer held that registration of the design was not precluded by section 43(1), but nevertheless held that it should be refused under section 3(3) on ground that "registration would be likely to offend the susceptibilities of a

not insubstantial number of persons”. The applicant’s appeal to the Registered Designs Appeal Tribunal was allowed by Aldous J.

26. In his judgment Aldous J first considered whether the Registrar had a discretion to refuse the application under section 3(3) even if the design complied with the requirements for registration, and in particular did not offend against section 43(1). Having considered the legislative history, the terms of the subsection and the authorities concerning section 17(2) of the 1938 Act, he concluded that the Registrar did have such a discretion.
27. Aldous J next considered whether the hearing officer had exercised his discretion on the correct basis, and concluded that he had not. His reasons for that conclusion at 102 line 31-103 line 1 are of some interest:

I have read the passage from the decision where the Superintending Examiner gave his reasons, showing the matter that he took into account when exercising his discretion. In that passage he refers to the line that has been taken by the Registry that representations of male genitalia were not registrable as they were considered to offend the susceptibilities of a not insubstantial section of the public. He concluded that sheet 5 shows male genitalia and that a not insubstantial number of person were likely to be offended by the registration.

There is no reason why the Registry should not have guidelines, but they must be no more than guidelines. The discretion given by the Act should not be fettered by such guidelines; each case must be dealt with on its merits. Further, the Superintending Examiner stated that the firm line taken by the Registry was based upon the conclusion that representation[s] of genitalia were considered to offend. That may have been right in the past, but is not necessarily so today. This emphasises the difficulty of applying a guideline in this sort of case as attitudes change.

I have come to the conclusion that the Superintending Examiner when exercising his discretion paid too much attention to a guideline of the Registry, which may have been applicable in the past. Further, he appears to have taken that guideline as a general rule rather than a guideline against which the facts of each case must be considered. Each case must be considered on its merits, taking into account the nature of the design, the size and depiction of the genitalia and all the surrounding circumstances.

28. Finally, Aldous J considered whether, exercising the discretion afresh, the application should be refused. His conclusion was that it should not. Despite its length, the key passage in the judgment at 103 l. 20 - 105 l. 4 is worth quoting in full:

There can be no doubt that many designs, which could have shocked the public in the past, would not do so today and I believe it right that, when exercising my discretion, I should take that into account. That discretion is unfettered, in the sense that it is not limited to any particular type of consideration but must be exercised on reasonable grounds. Each case must be considered separately, taking into account all the circumstances. The question to be considered is whether there are real grounds for refusing the applicant the proprietary right which would be given by registration.

The Superintending Examiner held that a not insubstantial number of persons were likely to be offended by the requested registration. I am not sure in what sense he was using the word 'offended'. Many designs would give offence to a not insubstantial number of persons, but those persons would consider that such designs should be given the benefit of protection. For instance, a design for a sculpture showing nudity or perhaps a scene involving bull fighting would be considered offensive by some persons, in the sense that they considered the design to be distasteful. However, I do not believe that such persons would believe that such designs should be restricted in use nor that they should not be protected by law. There are, however, other designs of nudes which would be or tend to be pornographic, which would also give offence, and sections of the public would believe that they should not be for public display and should not have the protection of property rights provided by Parliament. A similar view would be taken of designs which had racist connotations. Thus I conclude that the test to be applied cannot be solely whether a section of the public would be offended. Such a conclusion would not, in my view, amount to a proper ground for refusing an applicant the proprietary right given by the Act.

The Superintending Examiner's reliance upon a finding that the design would offend a section of the public appears to stem from the judgment of Evershed J in the *La Marquise Footwear* case. The judge did not explain what he meant by the word "offended" and had no need to do so, in that he held that the trade mark OOMPHIES had a signification of sex appeal, but was acceptable for registration.

There is also a suggestion in the decision that registration should be refused, otherwise the act of registration would be seen as giving the design the stamp of approval of the Registrar. I cannot accept that as a valid consideration. The Registrar, when exercising his discretion, is acting in a judicial capacity, not in an administrative capacity. Thus a

decision to register is a judicial decision that the design is registrable, not that the Registrar approves of the design.

I am of the view that guidance as to the principles upon which the Registrar must act when exercising his discretion can be derived from the purpose of the Act. The Registered Designs Act was enacted to encourage designers and prevent others taking the fruits of their labour. Thus I should consider whether the design is of the kind that should be given the protection of the law including whether the design of such a nature that its use would offend moral principles of right-thinking members of the public, such that it would be wrong for the law to protect it.

As I have said, each design has to be considered individually and in the context of what reasonable use would be made of it, and it must be judged against the background of public opinion at the date of application. It is also necessary to consider the attitude of Parliament as reflected by legislation and also weigh up any conflicting opinions that various sections of the public may have. For instance, the design for which registration is sought would be thought by many members of the public to be a clever and humorous design, giving no offence, whereas others might find a distasteful joke. The extent of that latter view must be weighed against the legitimate views of others and a decision reached as to whether there are real grounds for preventing the designer from having the proprietary right given by the Act to protect his work.

It is not possible to envisage all the types of design which might be sought to be protected under the Act. But I find it difficult to see how a design of the type in question could be refused, unless its use would be contrary or at least would be seen by a section of the public to be contrary to morality.

The design for which registration is sought shows in sheet 5 a mimic of male genitalia. It does not arouse sexual feelings nor is it likely to lead to any offensive behaviour. Some members of the public would find the doll offensive, in the sense that they would consider that it was distasteful. Others would consider the doll to be amusing and in no way offensive. I cannot believe that any reasonable person would believe that dolls incorporating the design should not be freely sold. Such dolls, even if seen by children, would not have any adverse effect on them. I suspect that the public would believe that such dolls were harmless, particularly when compared with toys used in violent play. Further, although Parliament has enacted legislation which restricts the dissemination of pornographic material, there is no legislation which would restrict the sale of dolls incorporating this design.

I am not in a position to judge the novelty of the design, but it appears to have involved skill and labour to produce. Sheet 5 shows an element of the design which would attract certain members of the public to buy

dolls made according to that design. I can see no reason why others should be permitted to copy the design in the form sought to be registered, nor why the law should not protect the labour and skill involved in producing it. Courts of Equity have in the past refused to grant injunctions to protect copyright in scandalous and pornographic works, but I cannot envisage that a Court of Equity would refused to grant an injunction to protect the design in question.

I have not been able to identify any reason for refusing registration of the design, save that a section of the public would find it distasteful, and that is not, in my view, a valid reason when weighed against the other matters I have referred to.

29. Although *Masterman* was a decision under section 3(3) of the Registered Designs Act 1949, it can be seen that Aldous J held that the design should not be refused registration unless its use would be, or at least would be seen by a section of the public to be, contrary to morality. It is clear that he concluded that this would not be the case. His judgment on the exercise of discretion therefore provides guidance on the proper approach to objections on the basis that a design or trade mark is contrary to morality.
30. In Case T356/93 *PLANT GENETIC SYSTEMS/Glutamine synthetase inhibitors* [1995] EPOR 357 Greenpeace opposed the grant of a patent for genetically engineered plants and seeds which resistant to a particular class of herbicides on various grounds, including under Article 53(a). Technical Board of Appeal 3.3.4 of the EPO rejected the ground of opposition under Article 53(a).
31. In its decision the Board stated:
 4. As is apparent from the historical documentation, the EPC Working Party recognised that ‘there was no European definition of morality’. Its members were, therefore, unanimously of the opinion that the ‘interpretation of the concept of morality should be a matter for European institutions (see document IV/2767/61-E, page 7). The same applied to the concept of ‘*ordre public*’ (*ibid*, page 8). Thus, prior to any assessment of the patentability of the claimed subject-matter under Article 53(a) EPC, the meaning of these concepts must be defined by way of interpretation.

5. It is generally accepted that the concept of '*ordre public*' covers the protection of public security and the physical integrity of individuals as part of society. This concept encompasses also the protection of the environment. Accordingly, under Article 53(a), inventions the exploitation of which is likely to breach public peace or social order (for example, through acts of terrorism) or seriously to prejudice the environment are to be excluded from patentability as being contrary to '*ordre public*'.
6. The concept of morality is related to the belief that some behaviour is right and acceptable whereas other behaviour is wrong, this belief being founded on the totality of the accepted norms which are deeply rooted in a particular culture. For the purposes of the EPC, the culture in question is the culture inherent in European society and civilisation. Accordingly, under Article 53(a) EPC, inventions the exploitation of which is not in conformity with the conventionally accepted standards of conduct pertaining to this culture are to be excluded from patentability as being contrary to morality.
7. The second half-sentence of Article 53(a) EPC contains the qualification 'that the exploitation shall not be deemed to so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States'. This qualification makes clear that the assessment of whether or not a particular subject-matter is to be considered contrary to either '*ordre public*' or morality is not dependent on any national laws or regulations. Conversely, and by the same token, the Board is of the opinion that a particular subject-matter shall not automatically be regarded as complying with the requirements of Article 53(a) merely because its exploitation is permitted in some or all of the Contracting States. This, approval or disapproval of the exploitation by national law(s) or regulation(s) does not constitute *per se* a sufficient criterion for the purpose of examination under Article 53(a) EPC....
15. ... Like national law(s) and regulation(s) approving or disapproving the exploitation of an invention (see point 7 above), a survey or an opinion poll showing that a particular group of people or the majority of the population of some or all of the Contracting States opposes the granting of a patent for a specified subject-matter cannot serve as a sufficient criterion for establishing that the said subject-matter is contrary to '*ordre public*' or morality.
32. In *Hyde Park Ltd v Yelland* [2001] Ch 143 the claimant claimed that its copyright in certain videos had been infringed by the publication of two stills in *The Sun*. The defendants contended that they had a defence of fair dealing and also a public interest defence. The claimant argued that that there was no public interest defence to a claim for copyright infringement. The Court of

Appeal rejected that argument, but held that the defendants did not have a public interest defence on the facts of the case. The public interest defence advanced by the defendant in that case was based on the right to freedom of expression, it being asserted that the purpose of the publication in question was to refute alleged lies told by the person who controlled the claimant, rather than upon considerations of *ordre public* or morality. Nevertheless some of the observations of Aldous LJ on that question are of interest for present purposes.

33. Aldous LJ began by observing:

44. The courts have an inherent jurisdiction to refuse to allow their process to be used in certain circumstances. It has long been the law that the courts will not give effect to contracts which are, for example, illegal, immoral or prejudicial to family life because they offend against the policy of the law. In my view that inherent jurisdiction can be exercised in the case of an action in which copyright is sought to be enforced as is made clear by section 171(3) of the 1988 Act....

45. As Mr Bloch submitted, that subsection should not be interpreted so as to interfere with a private property right without compensation as no clear intention to that effect is expressed. I also accept Mr Bloch's submission that refusal of relief upon equitable principles is not a defence to an action for infringement of copyright under the 1988 Act.

46. The judge [Jacob J] set out examples in his judgment which he said established the need for a public interest defence. He said [1999] RPC 655, 670:

'One can also legitimately test the whole question of the existence of a public interest defence, and the suggestion that there can be a restriction on enforcement only in respect of discretionary remedies against extreme examples. This is because the question is not limited to any particular sort of case. Thus, take a case where a document, carefully researched and compiled by a team of bank robbers, indicated the precise weaknesses of the security systems of each of the branches of a major bank. Copyright is normally accorded to carefully and skilfully compiled lists as being original works. But it can hardly be the law that the police could not make copies of the list to give to the bank and its security advisors. Nor does it make sense to say that the robbers could sue at least for nominal damages if the police did so. Or suppose the police obtained from a security video a picture of a bank robber. Do they really have to get the permission of a copyright owner

(perhaps not readily identifiable in a hurry) before showing the picture of the robber on television when seeking the help of the public to track him down? And if they do not do so, could the copyright owner really sue for nominal damages? The questions only have to be asked to be answered. Other extreme cases come readily to mind.'

47. Mr Bloch submitted that those extreme examples did not show the need for a public interest defence. They were perhaps examples of the defence of necessity that was recognised in actions of tort.
48. In my view the examples given to the judge do show why the courts refuse in certain circumstances to enforce copyright. To enforce copyright in a document prepared for a bank robbery would offend against principles of public order and morality and a court would be amply justified in refusing to enforce copyright in such a document under its inherent jurisdiction. Such an exercise of the court's inherent jurisdiction would be akin to a refusal to enforce an agreement which was illegal. As to the right of the police to publish a picture of a robber without permission of a copyright owner, I have some doubts as to whether in all cases they could lawfully do so, but no court would allow its process to be used to obstruct the course of justice. A court has, under its inherent jurisdiction, the right to refuse to enforce an action for infringement of copyright just as it can refuse to enforce a contract or other cause of action which offends against the policy of the law. The more difficult question is to define the circumstances when that is the appropriate course.
34. Aldous LJ then said at [49] that there had been a number of cases where the courts had refused to enforce copyright as the works in question were considered libellous, immoral, obscene, scandalous or irreligious, but that it was not necessary to consider those cases. Instead, he proceeded to consider *Beloff v Pressdram Ltd* [1973] 1 All ER 241, *Initial Services Ltd v Putterill* [1960] 1 QB 396, *Hubbard v Vosper* [1972] 2 QB 84, *Fraser v Evans* [1969] 1 QB 349, *Woodward v Hutchins* [1977] 1 WLR 760, *Lion Laboratories Ltd v Evans* [1985] QB 526, *Express Newspapers plc v News (UK) plc* [1991] FSR 36 and *Attorney-General v Guardian Newspapers Ltd (No 2)* [1990] 1 AC 109. He concluded:
66. The circumstances where it is against the policy of the law to use the court's procedure to enforce copyright are, I suspect, not capable to definition. However it must be remembered that copyright is assignable and therefore the circumstances must derive from the work in question, not ownership of the copyright. In my view a court would be entitled to refuse to enforce copyright if the work is: (i) immoral,

scandalous or contrary to family life; (ii) injurious to public life, public health and safety or the administration of justice; (iii) incites or encourages others to act in a way referred to in (ii).

35. For completeness, I should record that the Court of Appeal revisited this question in the subsequent case of *Ashdown v Telegraph Group Ltd* [2001] EWCA Civ 1142, [2002] Ch 149. Lord Phillips of Worth Matravers MR, delivering the judgment of the Court, concluded:

58. ... we do not consider that Aldous LJ was justified in circumscribing the public interest defence to breach of copyright as tightly as he did. We prefer the conclusion of Mance LJ that the circumstances in which public interest may override copyright are not capable of precise categorisation or definition. Now that the Human Rights Act is in force, there is the clearest public interest in giving effect to the right of freedom of expression in those rare cases where this right trumps the rights conferred by the Copyright Act. In such circumstances, we consider that section 171(3) of the Act permits the defence of public interest to be raised.

36. The cases referred to Aldous J towards the end of *Masterman* and by Aldous LJ in *Hyde Park* at [49] are discussed in *Copinger & Skone James on Copyright* (15th ed) at §§3.260-3.262. The learned editors divide them into two classes, (i) works which are immoral, scandalous or contrary to family life and (ii) works which are injurious to public life, public health and safety or the administration of justice. Many of the decisions, particularly in the first class, are of some antiquity. Among the more modern decisions of this kind, the best known is probably *Glyn v Weston Feature Film Co Ltd* [1916] 1 Ch 261. In that case Younger J held that a film produced by the defendant did not infringe the copyright in a novel entitled *Three Weeks* written by the claimant, the author Elinor Glyn. He also held *obiter* that the claimant should in any event be denied on the ground that the novel was “grossly immoral” because it “advocates free love and justifies adultery where the marriage tie has become merely irksome” (see 269). He also held for good measure that the film was equally disentitled to protection.

37. More recently, Sir Nicolas Brown-Wilkinson V-C commented on that decision in *Stephens v Avery* [1988] Ch 449 at 453F-G and 454B as follows:

I entirely accept the principle stated in that case, the principle being that a court of equity will not enforce copyright, and presumably also will not enforce a duty of confidence, relating to matters which have a grossly immoral tendency. But at the present day the difficulty is to identify what sexual conduct is to be treated as grossly immoral. In 1915 there was a code of sexual morals accepted by the overwhelming majority of society. A judge could therefore stigmatize certain sexual conduct as offending that moral code. But at the present day no such general code exists. There is no common view that sexual conduct of any kind between consenting adults is grossly immoral. I suspect the works of Elinor Glyn if published today would be widely regarded as, at the highest, very soft pornography...

If it is right that there is now no generally accepted code of sexual morality applying to this case, it would be quite wrong in my judgment for any judge to apply his own personal moral views, however strongly held, in deciding the legal rights of the parties. The court's function is to apply the law, not personal prejudice. Only in a case where there is still a generally accepted moral code can the court refuse to enforce rights in such a way as to offend that generally accepted code.

Case law under section 3(3)(a) of the 1994 Act and its counterparts

38. Turning to the 1994 Act, it should be noted that, unlike the 1938 Act, this does not confer any discretion on the Registrar to refuse registration if the requirements for registration are met: *Procter & Gamble Ltd's Trade Mark Applications* [1999] RPC 673 at 675 lines 37-40.
39. In *Ghazilian's Trade Mark Application* [2002] RPC 33 the applicant applied to register the mark TINY PENIS for various articles of clothing. The hearing officer, having directed herself in accordance with *HALLELUJAH*, held that registration was precluded by section 3(3)(a). The applicant's appeal to the Appointed Person was dismissed by Simon Thorley QC.
40. Mr Thorley observed at [14] that it was unfortunate that the hearing officer had not been referred to *Masterman* (which he mistakenly referred to as a decision on section 43(1) of the Registered Designs Act 1949). Having cited two passages from the section of Aldous J's judgment quoted in paragraph 28 above, Mr Thorley continued in a section of his decision which it is again worth quoting in full:

17. Similar considerations apply to trade marks. As a general rule, a trader is free to adopt whatever trade mark he feels is best calculated to enhance the sale of his goods. If that trade mark qualifies for registration by reason of its inherent distinctiveness or has become distinctive by reason of its use, *prima facie* he is entitled to have the mark registered so as to protect his business from the competition of rival traders who adopt similar marks. If the goods are calculated to appeal to a certain section of the community such that the choice of a distasteful mark is, in that trader's view, calculated to enhance sales, then so be it. The trader selects the mark, gains his customers and is entitled to protection.
18. I therefore propose to apply the reasoning of Aldous J in *Masterman* particularly his direction to consider the concept of right-thinking member of the public when seeking to apply section 3(3)(a).
19. Further, I have concluded that there is a slight difference in approach between Aldous J and Mr Myall in *HALLELUJAH* which drew upon the observations of Evershed J [in] *La Marquise*. I prefer the approach of Aldous J. The interpretation placed by Mr Myall on the language of Evershed J may lead to an over-cautious approach to section 3(3)(a).
20. Section 3(3)(a) refers to 'accepted principles of morality'. In any given social group, there are certain standards of behaviour or moral principles which society requires to be observed and there are standards of conduct which are widely shared. Society requires this so as to ensure that religious, social or family values are not unreasonably undermined. Accordingly it is right that in an exceptional case where the trade mark selected contravenes these standards it should be denied registration. Since however the primary objective of the system of registration of trade marks is to protect both traders and the public and since the system does not prevent a trader using a mark but merely denies him the protection of registration, it is only in cases where it is plain that an accepted principle of morality is being offended against that registration should be denied. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough.
21. I turn then to Mr Engleman's submissions based on the Human Rights Act. It was, I believe, common ground that the right of freedom of expression would only be interfered with on the ground of the protection of morals insofar as there was a pressing social need for that interference. Mr Alexander made the point that the refusal of registration of a trade mark could not be said to place any restriction on Mr Ghazilian's right of expression. He could continue to use the trade mark. I do not find it necessary to enter this debate. Section 3(3) indicates that the Registrar should refuse registration where the mark is contrary to accepted principles of morality. To redefine this as saying that he should only refuse registration where there is a pressing social need to do so, is, to my mind, merely a matter of words. The same

principles are at work. There must be a clearly identified aspect of morality which exists and which would be undermined by the registration.

22. This does not however assist in defining the dividing line between cases where registration should be allowed or refused.
23. In his skeleton Mr Alexander sought to assist me in this regard by reference to the Registry Work Manual and to the OHIM Examination Guidelines. The former are guidelines put forward by the UK Registry to assist practitioners and the latter are put forward to indicate the approach which will be taken by OHIM (The European Trade Mark Registry) under Article 7(1)(f) of the Regulation.
24. The Registry Work Manual suggests that marks which encourage or promote drugs, counterfeiting, pornography, criminal activity, and the like would be refused under the provisions of section 3(3) as being contrary to public policy, whereas fairly mild bad language, fairly, or relatively inoffensive expressions and fairly mild slang expressions would not be considered to be contrary to accepted principles of morality. The OHIM Guidelines provide in paragraph 8.7 as follows:

‘Words or images which are offensive, such as swear words or racially derogatory images, or which are blasphemous are not acceptable. There is a dividing line between this and trade marks which might be considered in poor taste. The latter do not offend.’
25. As a result of this Mr Alexander suggested in his skeleton that the test should be whether use of the mark would cause offence to a section of the public. The section of the public, he said, must be sufficiently substantial. A likelihood of offence to a few particularly susceptible people would not suffice, although strong offence to a particular section of the public might do – for example a minority with strong religious beliefs. Poor taste, he accepted, would not suffice.
26. I find difficulty with the word ‘offence’. In *Masterman’s Design*, Aldous [J] held that some members of the public would find the doll offensive, in the sense that they would consider that it was distasteful. Nonetheless registration was permitted.
27. In his address to me Mr Alexander refined this a little by submitting that the test must be:

‘That a substantial number of reasonable people will be significantly offended.’
28. Whilst that is moving in the right direction, I do not believe it is an adequate direction.

29. Mr Engleman, on the other hand, proposed a test which revolved around determining whether or not the words in question were vulgar. If they were, he contended that there should be a presumption against registration unless the applicant could adduce evidence that, in context, the vulgarity was not such as to cause disproportionate offence whereas if the words used were not vulgar, the contrary would apply. I cannot accept this. There are a number of well known euphemisms for a penis which would be considered vulgar; cock, dick, prick, tool, willy. I do not believe that any fundamentally different considerations should apply in assessing whether the mark TINY PENIS should be registered than would apply to the marks TINY TOOL or BIG DICK.
30. In my judgment the matter should be approached thus. Each case must be decided on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.
31. Aldous J in *Masterman* invoked the concept of right-thinking members of the public. I believe this is a helpful approach. A right-thinking member may himself or herself not be outraged but will be able, objectively, to assess whether or not the mark in question is calculated to cause the 'outrage' or 'censure' that I have referred to amongst a relevant section of the public. This is the function of the hearing officer. The matter must be approached objectively. It does not matter whether the hearing officer finds the mark personally unacceptable.
32. It seems to me that this degree of offence is what OHIM had in mind when writing their guidelines. Section 3(3) is not concerned with political correctness, it is concerned with principles of morality, a different and less readily invoked standard. The Registrar's hearing officers cannot be expected in all cases to form a view without the assistance of evidence. This does not mean that they must have evidence. They are entitled to draw upon their own knowledge of words and upon their own perception of the way in which those words can be used without offending against public morality. They must however be careful not to allow their personal views to deflect them from approaching the matter on the basis of the 'right-thinking' person.
41. Mr Thorley went on to uphold the hearing officer's decision for reasons which he expressed as follows:

49. Placing myself in the shoes of the ‘right-thinking’ member of the public in the way I have indicated above, I have concluded that this trade mark would cause greater offence than mere distaste to a significant section of the public. The offence resides in the fact that an accepted social and family value is likely to be significantly undermined. This value lies in the belief that the correct anatomical terms for parts of the genitalia should be reserved for serious use and should not be debased by use as a smutty trade mark for clothing.
42. In Case R 111/2002-4 *Dick Lexic Ltd’s Application* [2005] ETMR 99 the applicant applied to register the mark DICK & FANNY for various goods in Classes 9, 16 and 25. The examiner refused the application pursuant to Article 7(1)(f) of the CTM Regulation. The Fourth Board of Appeal of OHIM annulled the decision.
43. In its decision the Board stated:
7. The contested decision was based on the particular meaning of the words in English slang. Yet, as the appellant argues, the same words have another meaning when employed in less informal speech. Dick and Fanny are the diminutive forms of the English first names Richard and Frances (the latter being the feminine version of Francis), respectively. Thus, the words express different meanings depending on whether standard or informal language is used and the sexual connotation is only present in the latter.
 8. The Board concedes that the liability of a word mark to the absolute grounds of Article 7(1)(f) CTMR must be assessed on the basis of any usage, not necessarily formal, that the public makes of a given language. Therefore, the meaning of a word in slang may, in principle, lead to an objection, even if in normal usage it does not have an unfavourable connotation.
 9. However, the Board doubts that the mere fact that the two words have, alone or in combination with each other, a sexual connotation should be regarded as ‘offensive’ and that it justifies the rejection of the mark on account of public policy or accepted principles of morality. There are two reasons for this: firstly, these words merely designate things but they do not transmit any message; secondly the association of the two words does not necessarily reinforce the connotation of the mark.
 10. As regards the first reason, the words admittedly designate, in a particularly inelegant (or tasteless) manner, anatomical parts that are rarely mentioned in ordinary speech – whether formal or informal. In principle, the mark does not proclaim an opinion, it contains no incitement, and conveys no insult. In the Board’s opinion, in these

circumstances, the mark should not be regarded as contrary to either public policy or accepted principles of morality. For this reason, the Board would agree with the appellant that the mark may, at most, raise a question of taste, but not one of public policy or morality.

11. As regards the second reason, the Board denies that the association of the two words reinforces the sexual connotation of the mark. There would be good arguments in support of the opposite view as well. As a combination of the diminutive form of forenames, the association of 'Dick' with 'Fanny' could, in fact, reduce that connotation and allude instead to a couple. This sort of combination of names, particularly in their diminutive form, is rather widespread even in an English-language context (Tom & Jerry, Bonnie & Clyde, to name just a few).
 12. All in all, the Board considers that the mark has, in nonformal English usage, a rather smutty flavour but, since it does not convey any additional message and has a neutral meaning in formal English usage, it falls short of being contrary to public policy or accepted principles of morality.
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44. In Case T-224/01 *Durferrit GmbH v OHIM, Kolene Corp Intervening* [2003] ECR II-1589 the Court of First Instance held at [76] that Article 7(1)(f) "does not cover the situation in the trade mark applicant acts in bad faith" since it refers to "the intrinsic qualities of the mark claimed and not to circumstances relating to the conduct of the person applying for the mark". The CFI reiterated this proposition in Case T-140/02 *Sportwetten GmbH Gera v OHIM, Intertops Sportwetten GmbH Intervening* [2006] ETMR 15 at [27]-[29].
 45. In *Basic Trademark SA's Trade Mark Application* [2005] RPC 25, the applicant applied to register the mark JESUS for various goods in Classes 3, 9, 14, 16, 18, 24, 25 and 28. The hearing officer refused the applicant pursuant to section 3(3)(a) of the 1994 Act. The applicant's appeal to the Appointed Person was dismissed by Geoffrey Hobbs QC.
 46. In his decision Mr Hobbs said:
 3. Both as a matter of national law (see section 3 of the Human Rights Act 1998) and on the basis that measures incompatible with observance of the European Convention on Human Rights are not acceptable under Community law (Case C-112/00 *Schmidberger Internationale Transporte und Planzuge v Austria* [2003] 2 CMLR 34 at [71]-[74]) it is necessary to interpret and apply the prohibition in

section 3(3)(a) of the Act consistently with the provisions of the Convention ('ECHR').

4. Consistently with Article 10 ECHR it must be recognised that the right to freedom of expression (including commercial expression: *Casado Coca v Spain* (1994) 18 EHRR 1 at [33]-[37]) is exercisable subject only 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 or impartiality of the judiciary.'

5. Consistently with Article 14 ECHR it must be recognised that the aims and objectives of Article 10 are to be secured

'without discrimination on any ground such as sex, race, colour, language, religion, political or other opinion, national or social origin, association with a national minority, property, birth or other status.'

6. Section 3(3)(a) seeks to prohibit registration in cases where it would be legitimate for the 'prevention of disorder' or 'protection of ... morals' to regard use of the trade mark in question as objectionable in accordance with the criteria identified in Article 10 ECHR. It does so in terms which disclose no intention to prohibit registration in cases where use of the relevant trade mark would not be objectionable under Article 10 on either or both of those bases. The problem of anti-social branding is, in part, addressed under section 3(3)(a) by accommodating the concept of '*ordre public*' within the 'prevention of disorder' (in the French text of the Convention '*à la défense de l'ordre*') under Article 10. That makes it legitimate, for example, to treat the display of

'any writing, sign or other visible representation which is threatening, abusive or insulting within the ... sight of a person likely to be caused harassment, alarm or distress thereby'

as objectionable: see section 5(1)(b) of the Public Order Act 1986. However, the right to freedom of expression must always be taken into account without discrimination under section 3(3)(a) and any real doubt as to the applicability of the objection must be resolved by upholding the right to freedom of expression, hence acceptability for registration.

47. Later in his decision Mr Hobbs returned to this aspect of the matter:

22. I fully accept that ‘in a democratic society subscribing to the rule of law, no determination that is arbitrary can ever be regarded as lawful’: *Winterwerp v Netherlands* (1979) 2 EHRR 387 at [39]. As I have already made clear, I also accept that the disciplined approach required by Article 10 ECHR is applicable to the determination of objections under section 3(3)(a). In that connection it is sufficient to refer to the summary of the relevant criteria given in paragraph 79 of the Judgment of the ECJ in *Schmidberger* (above):

‘... it nevertheless follows from the express wording of para. 2 of Arts. 10 and 11 of the Convention that freedom of expression and freedom of assembly are also *subject to certain limitations justified by objectives in the public interest, in so far as those derogations are in accordance with the law, motivated by one or more of the legitimate aims under those provisions and necessary in a democratic society, that is to say justified by a pressing social need and, in particular, proportionate to the legitimate aim pursued.*’ [emphasis added]

23. The fact that the determination which has to be made under section 3(3)(a) calls for the exercise of judgment in an area where there may well be room for more than one view does not, of itself, render the decision taking process arbitrary, nor does the fact that the determination depends on the decision taker’s assessment of the effect that use of the trade mark in question is liable to have upon other people. The requirement for use of the trade mark to be seriously troubling in terms of the public interest in the ‘prevention of disorder’ or ‘protection of morals’ under Article 10 ECHR provides, in my view, a proper basis for objective determination of the legal rights of persons applying for registration. Lack of objectivity in the decision taking process is a ground for appeal, not a reason for depriving the relevant prohibition of content and effect.

48. Having quoted two passages at [20] and [30] from the section of Mr Thorley’s decision in *Ghazilian* which I have set out above, Mr Hobbs commented:

8. I believe that Mr Thorley’s concern as to the justifiability of the anticipated reaction is an important factor in his reasoning. It allows for the possibility that the anticipated reaction might be an undue response to a legitimate exercise of the right to freedom of expression. It does so by maintaining the requirement for objectivity and non-discrimination on the part of the decision taker. Otherwise there would be a risk that the vociferousness of those with an axe to grind might illegitimately diminish the free speech rights of those whose views they oppose.

49. Having quoted the passage from *Dick Lexic* which I have set out above, Mr Hobbs commented:

11. I do not understand the Board to have decided that sexual connotations can never render a trade mark objectionable. Cruder verbalisations of the anatomical connotations of the words DICK & FANNY would surely have been open to objection, as would explicit pictorial representations. I think the proposition that the trade mark conveyed no ‘additional message’ was invoked for the purpose of emphasising the need for use of the mark in issue to have a seriously troubling effect. The bracketing together of the words DICK & FANNY, TOM & JERRY and BONNIE & CLYDE appears to me to have been intended to emphasise that the mark in issue was not seriously offensive. Likewise the credit given for the absence of any transmission of opinion, incitement or insult.

12. In a comprehensive review of cases decided under the parallel provisions of federal trade mark law in the United States, *Moral Intervention in the Trademark Arena: Barring the Registration of Scandalous and Immoral Trademarks* (1993) 83 TMR 661 by Stephen R. Baird, it is noted at 704 that the questioned trade marks could be divided into 7 categories: (1) those with a religious nexus; (2) those consisting of or comprising racial slurs or epithets; (3) those consisting of or comprising profane matter; (4) those consisting of or comprising vulgar matter; (5) those relating to sexuality; (6) those involving innuendo; (7) those suggesting or promoting illegal activity. As he says:

‘Although the decisions in each category purport to interpret the same [legislative] terminology, there appears to be more than one standard applied, the choice of which appears to vary according to the category involved’.

That, to my mind, reflects the fact that each category relates to a different type of transgression and also that social, linguistic and cultural conditions are apt to make it easier for trade marks to be regarded as acceptable in some of those categories and more difficult in others.

13. Relatively few trade marks appear to have been excluded from registration as Community trade marks under Article 7(1)(f) CTMR. The list of instances at http://oami.eu.int/search/legaldocs/la/EN_Refused_index.cfm indicates that objection was raised in the following cases: CASTRO (Application 2932986); RASSISMUS (German word for racism) (Application 2994499); IPARRETARRAK REKORDS (Iparretarrak being the name of an organisation declared illegal in Spain in 1978) (Application 2677565); OPIUM (Application 2481935); BOLLOCKS FAKOV (Application 1672518); SMS2TV (Application 2334951);

FIDEL CASTRO (Application 921155); BILLCLINTON (Application 956540); JOHANNES PAUL II (Application 958280); FUCK OF THE YEAR (Application 306399); BOLLOX (Application 499103); BALLE (German word for testicles) (Application 65839). These examples illustrate the difficulty (probably the impossibility) of formulating an all-purpose test for determining when the relevant prohibition is applicable.

50. Mr Hobbs expressed his reasons for upholding the decision as follows:

20. I agree with the proposition advanced on behalf of the Applicant to the effect that religious significance is not always or necessarily sufficient to render a mark unregistrable under Section 3(3)(a). However, branding which employs words or images of religious significance can quite easily have a seriously troubling effect on people whose religious beliefs it impinges upon and others who adhere to the view that religious beliefs should be treated with respect in a civilised society....
25. The power of a trade mark to produce a reaction inevitably varies according to the nature and intensity of the perceptions and recollections triggered by the relevant mark. JESUS is the ultimate Christian name. It commands the highest degree of reverence and respect among committed Christians. The view that their religious beliefs should be respected is, I am sure, deep-seated and widespread. The very idea that the name JESUS should be appropriated for general commercial use as a trade mark is, I am equally sure, anathema to believers and those who believe in the need to respect the religious sensibilities of others. Their reactions would no doubt vary in terms of the way in which they handled their thoughts and feelings. I think the common response among such people would be a mixture of anger and despair according to temperament.
26. It follows, in my view, that the Hearing Officer was right to conclude that use of the word JESUS as a trade mark would cause greater offence than mere distaste and do so to a significant section of the general public. The use of it as a trade mark should – to use the expression I have used several times already - be regarded as seriously troubling in terms of the public interest in the '*prevention of disorder*' and '*protection of morals*' under Article 10 ECHR. It is legitimate to apply the prohibition in section 3(3)(a) of the 1994 Act to branding which is anti-social by reason of its ability to undermine an accepted social and religious value to a significant extent. That is the position here. There will be cases where the need to adopt a proportionate response to the problem of antisocial branding requires less than 100% rejection of the request for registration. This is not one of them. The power of the word JESUS to give rise to the relevant concern is not diminished by the nature of the goods in the different categories specified by the Applicant in the present case.

51. In *Scrannage's Trade Mark Application* (O/182/05) the applicant applied to register the mark FOOK for clothing, footwear and headgear. The hearing officer refused the application pursuant to section 3(3)(a). The applicant's appeal to the Appointed Person was dismissed by David Kitchin QC.
52. In his decision Mr Kitchin quoted from *Ghazilian* at [21] and [31] and the passage from *Dick Lexic* that I have set out above. Having cited *Basic*, he commented:
8. I do not detect any aspect of the reasoning in *Ghazilian* or in *Dick Lexic* which is inconsistent with Article 10 of the European Convention on Human Rights. Registration is not to be refused on the grounds of taste. For the prohibition to operate a mark must be one which will justifiably cause outrage or be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values.
53. Mr Kitchin expressed his reasons for dismissing the appeal as follows:
10. To my mind, however, the acceptance by the appellant that the word FOOK would be pronounced FUCK in various different regions of the United Kingdom places an insuperable difficulty in the path of the application for the following reasons.
11. First, I have no doubt that it would not be appropriate to allow registration of the word FUCK. Although it may be used commonly it is, nevertheless, a swear word and deeply offensive and insulting to many people. It is more than distasteful or smutty. The general use of the word is likely to cause justifiable outrage amongst a significant section of the public. I can see no justification based on the right to freedom of expression or otherwise to allow such a word to proceed to registration.
12. Secondly, trade marks on t-shirts and other garments are frequently referred to orally and may be advertised by radio, recommended by word of mouth or asked for in a shop. There is therefore ample scope for the mark FOOK to be used in circumstances where it would be indistinguishable from the word FUCK. Accordingly I believe that the mark FOOK has, at least in oral use, the same capacity to cause offence and outrage as the word FUCK. In the context of this application such oral use cannot be disregarded.

Discussion

54. I have to say that I do not find it easy to understand the rationale which lies behind provisions such as section 3(3)(a) of the 1994 Act. There is a paradox which both Aldous J in *Masterman* and Mr Thorley in *Ghazilian* touched on: refusal to grant an intellectual property right pursuant to such provisions does not prevent the applicant from using the subject matter of the right in commerce. Refusal of the design sought to be registered in *Masterman* would not have prevented the applicant from making and selling dolls of that design, and refusal of the application in *Ghazilian* did not prevent the applicant from using the words TINY PENIS as a trade mark for clothing. The effect of refusal is to withhold legal protection from the applicant for the subject matter of the intellectual property right in question. The same is true of upholding a public interest defence to copyright infringement. If legal protection is withheld, however, that means that the subject matter can be copied by others with impunity. Thus withholding protection is, at least in principle, more likely to result in that subject matter being widely disseminated than if protection were conferred. If the subject matter is objectionable, I would have thought that the policy of the law would be to adopt measures which reduced the likelihood of it being disseminated. The problem with measures such as section 3(3)(a), unlike say Article 17 of the Berne Convention, is that they do not address the dissemination of the subject matter itself.
55. The paradox is exacerbated in the case of provisions like Article 53(a) EPC which provide that the subject matter is not to be refused protection merely because its exploitation is prohibited by law. As the decision in *PLANT GENETIC SYSTEMS* makes clear, protection can be conferred even if exploitation of the subject matter is illegal, yet protection may be withheld for subject matter the exploitation of which is lawful.
56. A possible rationale for refusing to grant intellectual property rights for subject matter that is contrary to *ordre public* or morality is that registration would amount to an official seal of approval. As Aldous J pointed out in *Masterman*, however, registration of a design or trade mark does not connote

approval of the design or trade mark by the Registrar, merely a decision that the design or trade mark complies with the statutory requirements for registration. Moreover, it is difficult to see how this rationale could apply to section 171(3) of the 1988 Act.

57. I consider that the clearest rationale for such provisions is that alluded to by Aldous J in *Masterman* and explained more fully by Aldous LJ in *Hyde Park*. In certain circumstances exemplified by the bank robbery plan the enforcement of an intellectual property right would operate contrary to the public interest, and in such circumstances a court would be justified in refusing to enforce that right. The purpose of provisions such as section 3(3)(a), I would suggest, is to prevent the conferring of intellectual property rights which a court would refuse to enforce.
58. I note that, in contrast with provisions such as Article 53(a) EPC, section 3(3)(a) refers to the *trade mark* being contrary to *ordre public* or morality rather than its *use*. In my view this is not inconsistent with the foregoing analysis. Trade marks are registered with a view to being used. Furthermore, it is not easy to see how a trade mark can be contrary to *ordre public* or morality as a thing in itself considered in the abstract rather than by reason of the effect of its use.
59. It is clear on the face of section 3(3)(a) that it addresses two different types of case: (i) trade marks that are contrary to *ordre public* and (ii) trade marks that are contrary to morality. It is fairly obvious that different considerations apply to these two types of case. In my view this is supported by the analysis above.
60. So far as trade marks that are contrary to morality are concerned, I derive the following propositions from the case law reviewed above:
- (1) The applicability of section 3(3)(a) depends on the intrinsic qualities of the mark itself and not on circumstances relating to the conduct of the applicant (*Durferrit* at [76], *Sportwetten* at [27]-[29]).

- (2) As with any other absolute ground of objection, the applicability of section 3(3)(a) is to be assessed as at the date of application (*Ghazilian* at [44]).
- (3) Section 3(3)(a) should be interpreted and applied consistently with Article 10 ECHR. It follows that registration should be refused only where this is justified by a pressing social need and is proportionate to the legitimate aim pursued. Furthermore, any real doubt as to the applicability of the objection should be resolved by upholding the right to freedom of expression and thus by permitting the registration (*Basic Trademark* at [3]-[6]).
- (4) Section 3(3)(a) must be objectively applied. The personal views of the tribunal are irrelevant (*Ghazilian* at [31], *Basic Trademark* at [8,] [23], *Stephens v Avery* at 454B).
- (5) While section 3(3)(a) may apply to a mark whose use would not be illegal, the legality or otherwise of use of the mark is a relevant consideration (*Masterman* at 104 ll. 16-17, 38-40).
- (6) For section 3(3)(a) to apply, there must be a generally accepted moral principle which use of the mark would plainly contravene (*Ghazilian* at [20]).
- (7) Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough for section 3(3)(a) to apply (*Masterman* at 103 ll. 28-43, *Ghazilian* at [20]).
- (8) Section 3(3)(a) does apply if the use of the mark would justifiably cause outrage, or would be the subject of justifiable censure, amongst an identifiable section of the public as being likely significantly to undermine current religious, family or social values (*Ghazilian* at [30], *Scranage* at [8]).

- (9) In the case of a word mark, it is necessary to consider the applicability of section 3(3)(a) on the basis of any usage that the public makes of the word or words of which the mark is comprised. Thus the slang meaning of a word may lead to an objection even if its normal meaning does not (*Dick Lexic* at [8]).
- (10) A mark which does not proclaim an opinion, or contain an incitement or convey an insult is less likely to be objectionable than one that does (*Dick Lexic* at [10], *Basic Trademark* at [11]).
- (11) Different considerations apply to different categories of marks (*Basic Trademark* at [12]).
61. To my mind, there is a tension between proposition (8) and some of the other propositions, in particular proposition (6). In resolving this tension, I consider that proposition (11) is important. As Mr Hobbs explained, the reason why different considerations apply to different categories of marks is that they relate to different types of transgression. That is to say, they offend against different moral principles. It is therefore important to be clear as to the applicable moral principle. The generally accepted moral principle applied in *Basic Trademark* was that of respect for religious beliefs. The generally accepted moral principle applied in *Scranage* was the prohibition on the use of swear words, and in particular their use in contexts where children may be exposed to them. By contrast, it is less clear that the “social and family value” invoked by Mr Thorley in *Ghazilian*, namely “the belief that the correct anatomical terms for parts of the genitalia should be reserved for serious use” is a generally accepted moral principle. I believe that is for this reason that that decision has proved somewhat controversial (e.g. it is described as “a good example of ‘how not to do it’” by Professor Jeremy Phillips in his book *Trade Mark Law: A Practical Anatomy* at §4.37).

The role of evidence

62. There was some debate at the hearing before me as to the role of evidence in a case such as this. It is obvious that the Registrar will sometimes be called upon to assess the applicability of section 3(3)(a) without the benefit of evidence. Moreover, it is clear from the case law reviewed above that the Registrar's hearing officer is entitled to use his own knowledge of words and of the moral principles which are generally accepted in our society. It is also clear, however, that the Registrar is entitled to receive evidence. Furthermore, I consider that the less obvious the conclusion is, the more the hearing officer should be guided by evidence rather than relying upon his own knowledge.
63. This is particularly true in the case of an application for a declaration of invalidity such as the present, where the mark has been in use on a substantial scale for a considerable period of time. In such circumstances the proposition that, viewed as at the application date, the mark was contrary to morality because use of it was liable to cause significant offence can be tested in the light of actual experience.

The hearing officer's decision

64. The hearing officer directed himself as to the law in accordance with the guidance provided by Mr Kitchin in *Scranage*. Furthermore, he proceeded on the basis that *Scranage* established that the word FUCK would be prohibited from registration as a trade mark by virtue of section 3(3)(a).
65. He then said:
35. This brings me to the nub of the issue; is FCUK likely to cause offence because it will be seen as the swear word FUCK? The *FOOK* case turned on the fact that when spoken in the local accent of various regions of the United Kingdom, the word would be phonetically indistinguishable from FUCK. In the *Tiny Penis* and *Jesus* trade mark cases referred to above, the potential for offence is plain to see; no interpretation, intentional or otherwise is required. The position with FCUK is somewhat different. It is not a word with a meaning. When

referred to in speech it will, in my view, be enunciated as the letters F-C-U-K, as it consistently was throughout the hearing. But it is not in oral use that there is a potential for offence, but in a visual misconstruing of the letters.

66. As to the potential for such visual misconstruing, the hearing officer said this:
43. ... Mr Woodman says that the eye has a natural ability to correct mistakes, and to sort out and reorder letters, the correction to the word in this case being trivial. Whilst there is no scientific evidence to back-up Mr Woodman's claims in this respect, I believe that he finds support in two areas. It is not uncommon when entering text via a keyboard, that keys will be depressed out of synch. I know from personal experience that when proof reading such material, in particular, written by oneself, typographical errors such as misplacing of letters are overlooked because the eye sees what was intended or expected rather than what is actually written. However, the difference between FCUK and FUCK is unlikely to be overlooked in such a short word unless there are positive efforts to approximate the two words.
67. In the course of his decision the hearing officer referred to a number of points established by the evidence which I would summarise as follows. First, he accepted French Connection's evidence that FCUK was first used as an internal reference to denote the UK division of the company following its international expansion. In March 1997 French Connection decided, in conjunction with its advertising agency, to launch FCUK as a brand name. The hearing officer noted that it was accepted by French Connection that it "knew at the outset the potential for the FCUK brand as a word play". The hearing officer held that it was clear from the evidence that French Connection had made considerable use of this potential for "word play" in its advertising.
68. Secondly, he noted that French Connection's advertising had generated a number of complaints to the Advertising Standards Authority, some of which had been upheld. He noted, however, that there had not been any adjudication in which the ASA had upheld a complaint against FCUK on its own. He concluded from this and from two letters from the ASA which are in evidence that the ASA did not consider the use of FCUK on its own to be a problem. He also concluded that the position of the Committee on Advertising Practice was the same.

69. Thirdly, he noted that the Driver and Vehicle Licensing Agency did not issue certain combinations of letters on registration numbers, such as FUK and FCK. He also noted that considerations applied by the DVLA in its code of practice were different to those which he had to apply, particularly because the public had been educated to replace missing letters when they saw a personalised number plate.
70. Fourthly, he noted that French Connection had adduced evidence of widespread use and promotion of FCUK by retailers, and others, that would be considered to be “bastions of respectability”. It had also adduced evidence from a number of such retailers expressing surprise that FCUK could be considered to be offensive and stating that they would not be associated with it if they considered that it would cause offence to their customers. In relation to this, he said that the evidence as to how such traders had used the mark suggested to him that there might have been careful management of its presentation, but that there was little evidence that it had been used by traders in a context likely to lead the person viewing it to see it as the expletive. The hearing officer went on to conclude that, although there was evidence from one retailer that FCUK advertising had generated one or two complaints, there was no evidence that the trade in FCUK branded goods had caused outrage amongst a widespread or even a limited section of the public.
71. Finally, he held that it was clear from the evidence that FCUK was a brand directed at younger persons, who were less likely to be offended by the “word play”, but that this was not a relevant consideration since the mark would be seen by people of all ages and backgrounds.
72. The core of the hearing officer’s reasoning is contained in the following passage in his decision:
48. There can be no doubt that use of the word ‘fuck’ would cause a high degree of offence to a significant number of people, but the trade mark in question is not the swear word. The offence is not caused by FCUK itself, but rather that through word play, mistake, or misconstruing of the letters, the mark is capable of being seen as the word. Should I

consider a mark open to objection because it is capable of being seen as something it is not? I do not think that that would be right. There is no evidence that establishes that the trade mark FCUK *solus* is seen as the expletive amongst an identifiable section of the public.

49. There is nothing that I can see in Section 47 that allows for a mark to become objectionable on absolute grounds post application through the use that may have been made of it. The position should, as I stated earlier, be assessed on the facts as at the time that the application to register the mark was made. This being the case, the fact that French Connection may, through contextual use, have educated the public to regard the trade mark as an objectionable word should not have a bearing on my decision. However, the manner in which a mark is used may change the public perception, and it is quite possible that the contextual use of FCUK may have caused contamination such that, even if the public did not see the connection with the expletive at the relevant date, they may well do now, and if I was considering the question of offence at some later date I would have to take this into consideration.
50. I do not see that there can be any better barometer of the impact of a mark on the public perception than evidence resulting from the actual use in the market. Respectable traders have been involved in a significant trade in FCUK branded goods with an almost complete absence of adverse reaction from their customers, although again I acknowledge that the actual number of complaints is unlikely to be representative of the number actually offended. However, any offence that has been caused has not been as a result of the use of FCUK per se, but rather by the context in which the trader has chosen to use the letters in their promotional activities, and for which they have been the subject of censure. On the facts before me I consider that whilst I can understand and appreciate the basis for the objection, I do not consider that this is a sufficient basis on which to declare the trade mark registration invalid, and the application fails.

Standard of review

73. This appeal is a review of the hearing officer's decision. Counsel were agreed that the hearing officer's decision involved an assessment of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applied:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

The appeal

74. Counsel for French Connection did not challenge the hearing officer's conclusion that the word FUCK would be unregistrable by virtue of section 3(3)(a). As noted above, this is because it offends against the generally accepted moral principle prohibiting the use of swear words, and in particular their use in contexts where children may be exposed to them. It is worth considering this point in a little more detail, given that it is an incontrovertible fact that, since Kenneth Tynan became the first person to utter the word on television on 13 November 1965, use of the word in public discourse has become increasingly common. It has been used, for example, in a well-known poem (*This Be The Verse* by Philip Larkin), on stage, radio and television and in newspapers (including on the front cover of the G2 section of *The Guardian* newspaper). Nevertheless it is clear that a very substantial section of the public believes that such swear words should not be used in public discourse, and is seriously offended if they are used.
75. In a report entitled *Delete expletives?* dated December 2000 by Andrea Millwood-Hargrave, the author analysed the results of consumer research commissioned jointly by the Advertising Standards Authority, British Broadcasting Corporation, Broadcasting Standards Commission and Independent Television Commission and carried out by NOP. In the executive summary the author stated *inter alia*:

Participants say they have noticed an increase in the use of swearing and offensive language in daily life. It was generally disliked, but participants did not feel there was much they could do about it outside their home. However, their acceptance of 'strong' language did not signal an approval of it.

The use of 'strong' language in the presence of children was especially frowned upon and, within their homes, participants sought to keep it at bay. Many talked of 'house rules' which forbade the use of such language at home.

As part of the home environment, television was expected to follow certain conventions which would conform to these 'house rules', especially when children were likely to be watching television.

Key among these conventions was adherence to the principle of the Watershed at 9:00 pm. Respondents generally did not accept the use of swear words and terms of abuse before this time, as they expected children to be in the audience....

Other conventions were based on the expectations created by the genres of programming, the channel of transmission and the editorial context....

Those who took part in both the qualitative and quantitative research were asked about their attitudes towards the use of swear words and offensive language in advertisements. While many respondents thought all media should operate under similar rules, it was clear that advertisements provoked particular concerns.

The majority of respondents (92%) thought that the current convention that television advertisements should not include any 'strong' language was appropriate. Most respondents (81%) said this rule should apply even if the advertisements were transmitted after the Watershed.

Most respondents (86%) expressed a dislike of such language in poster advertising because large poster sites could not be avoided. Ninety five per cent said that this was because of a desire to protect children.

Press advertising, both in newspapers and magazines aimed at specific readership groups, was also discussed. While most respondents thought these media should be treated similarly in terms of regulating the use of swear words or offensive language, the qualitative research suggested that advertising in targeted magazines could be easily controlled by the purchaser.

Access to cinema advertising was thought to be more easily controlled, as the age classifications for films were thought to act as good guidance to viewers who wished to avoid hearing inappropriate language....

76. The report includes as Figure 1 a table ranking swear words and offensive terms such as "Paki" according to their perceived severity. The word FUCK is ranked third most severe, and the table records that it held the same place in a similar survey conducted in 1997.
77. Counsel for Mr Woodman submitted that the hearing officer had erred in principle because he had proceeded on the basis that FCUK was not objectionable in itself but "through word play, mistake or misconstruing of the letters" was capable of being seen as FUCK. Counsel argued that FCUK was

so close to FUCK that almost everyone would see the connection, which was transparent, obvious and intended. He therefore argued that the hearing officer was wrong to hold that FCUK was capable of being seen as the word FUCK: it effectively was the word FUCK. It followed that this was a clear case of a mark that was contrary to morality, and that the hearing officer's decision was plainly wrong.

78. Counsel relied in support of this argument upon certain observations of Rattee J in *French Connection Ltd v Sutton* [2000] ETMR 341. In that case French Connection applied for summary judgment in a claim for passing-off against a man who had registered the domain name "fcuk.com". Rattee J refused the application. In the course of his judgment he made the following observations at 343, 345 and 346 respectively:

French Connected Limited (the claimant) runs a chain of fashion stores selling clothing under the name 'French Connection', and in about February 1997 it conceived the idea of using the letters FCUK (which it points out stands for French Connection UK, although that is not the name of the claimant) in the context of advertising casual clothes and, in particular, T-shirts which its shops sold. There is no doubt, and this is not disputed by Ms Vitoria on behalf of the claimant, that the object of the advertising campaign, if that is the right word for it, was to make use of the fact that, at any rate some people, on seeing the letters FCUK in that order, would be struck by their similarity to the obscene expletive F-U-C-K, which itself was prohibited for use in public advertising material by standards adopted by the Advertising Standards Agency....

The defendant's case is that he had two purposes in registering the domain name fcuk.com. One was that, according to his evidence, in the field of internet consultants in which he worked, although one may think it is surprising, it is apparently regarded as somewhat clever to register oneself with a domain name (and therefore an internet address) containing such an obvious reference to the obscene expletive without actually using it....

I cannot help commenting that I find the case of both parties in this litigation unpalatable in the extreme, having regard to its subject matter, but that is not something, of course in which, sitting this court, I can make any ruling, or on which I can properly base any decision on the issues which I have to decide.

79. In my judgment these observations are of very little assistance on the question which I have to decide. Although it appears from Rattee J's judgment at 360-361 that the defendant argued that one reason why the claim should be subject to a trial was that there was a counterclaim for revocation of a registration of FCUK on the ground that that registration offended public policy and that the same argument would or might provide a defence to the passing-off claim, it does not appear that the merits of the counterclaim were canvassed before Rattee J. In particular, it does not appear that Rattee J was taken to the relevant statutory provisions or case law. Nor does it appear that evidence directed to the counterclaim had been adduced. This is not surprising since the counterclaim was not before him. Furthermore, Rattee J expressed no view on the merits of the counterclaim. Thus the observations upon which counsel for Mr Woodman relies were not directed to the applicability of section 3(3)(a). In addition, they were clearly coloured by the evidence as to the manner in which French Connection had used FCUK in some of its advertising. In any event, Rattee J himself expressly acknowledged that he could not rule upon the "unpalatability" of the parties' cases.
80. Counsel for Mr Woodman also relied upon the *Delete expletives?* report. A diagram on page 8 of the report shows the perceived severity of various different types of language from baby talk, puns, rhyming slang and double entendres at one end to racial abuse and abuse of other minority groups at the other end. In the middle of the diagram, and ranked equally with blasphemy and "(black) Americanism[s]" are "abbreviations" examples of which are "b*****s" and "f.c.u.k.". Curiously, there does not appear to be any reference to f.c.u.k. (or FCUK) anywhere else in the report.
81. Without further explanation, it is difficult to know what to make of this. "f.c.u.k." is not an "abbreviation" of FUCK, but I presume that the author is using the term "abbreviation" to include disguised versions of swear words. Accordingly, this entry is undoubtedly some evidence that at least some members of the public find "f.c.u.k." offensive because they regard it as a disguised version of FUCK. By contrast with many of the terms in Figure 1, however, the report contains no information as to how many respondents

found this term offensive. Moreover, it is at least possible given the date of the report that the term was included because of its use in French Connection's advertising. In any event, this evidence has to be set against the other evidence referred to in the hearing officer's decision.

82. Counsel for Mr Woodman also submitted that the present case was indistinguishable from *Scranage*. Just as in that case the mark FOOK was objectionable because in oral use in some circumstances it would be taken as FUCK, so he argued that in the present case FCUK was objectionable because in visual form in some circumstances it would be taken as FUCK.
83. I do not accept this submission. In my judgment the present case is distinguishable from *Scranage*. The reason why FOOK was objectionable was that in certain circumstances FOOK was phonetically identical to FUCK. By contrast, it cannot be said that FCUK is either phonetically or visually identical to FUCK.
84. In my judgment the hearing officer was correct to proceed on the basis that FCUK was not the swear word, but was capable of being seen as the swear word. Whether and to what extent it will be seen as the swear word depends on the manner and circumstances of its use.
85. It is clear that French Connection has used FCUK in some of its advertising in a manner which was intended to, and did, evoke the swear word in readers' minds. I do not doubt that some people, including Mr Woodman, have been deeply offended by this. It does not follow from this, however, that it is an intrinsic quality of the mark FCUK that it will always evoke the swear word in consumers' minds regardless of how it is used. It is quite possible to conceive of FCUK being used in a manner which tended to suppress, rather than evoke, that connotation, in particular use which emphasised that the letters FCUK stood for French Connection UK. Indeed, French Connection's evidence in this case includes illustrations of use of FCUK in its stores and in other retailers which I consider achieves this effect.

86. I would compare the situation with another example which was discussed at the hearing, CNUT. Cnut Sweinson, a Dane, was King of England from 1016 to 1035. His name (which used to be misspelt as “Canute”) is well known to school children because of an incident in which he is supposed to have commanded the tide to turn back, either out of *folie de grandeur* or (more likely) to demonstrate the limits of his powers. CNUT is registered as a trade mark in a number of classes, including Class 25. The registered proprietor of the Class 25 registration, Cnut Ltd, operates a website at www.kingcnut.com from which it sells t-shirts bearing the name “king cnut” together with a symbol of a crown. The website displays the slogan “KING CNUT MAY NOT HAVE BEEN ABLE TO TURN BACK THE TIDE IN 1016. BUT HE DOES MAKE EXCEEDINGLY GOOD T-SHIRTS. PROBABLY THE BEST T-SHIRTS IN THE WORLD.” While these uses of the word CNUT may evoke another swear word in some readers’ minds, it seems to me that they are more likely to bring other connotations to mind.
87. It may be objected that the difference between these two cases is that CNUT is an established word with its own meaning whereas FCUK is not. This is undoubtedly true, but nevertheless it would be quite easy to imagine “word play” involving CNUT that brought the swear word to mind rather than the English King.
88. What in my view this example demonstrates is the importance of context. A mark that used in one way is relatively innocuous may become quite offensive if used in a different way and vice-versa. In particular, a mark of the sort presently under consideration may provoke quite different responses depending on whether the consumer is led to regard it as an anagram on the one hand or as an acronym (or a set of letters) on the other hand. A mark is only objectionable under section 3(3)(a), however, if its use would contravene a generally accepted moral principle by reason of its intrinsic qualities. The reason for this is that, even if the applicant intends to use it in a particular way, his intention may change. Furthermore, the application or registration may be assigned to someone else. Thus the manner in which the mark is subsequently used can neither infect the mark with, nor immunise it from, objectionability.

89. In my judgment the hearing officer made no error of principle in his decision. Indeed, I would go further. I consider that his decision was correct. I agree with him that the intrinsic qualities of the mark FCUK are not such as to render it objectionable. It is not the swear word even though it can be used, and has been used, to evoke the swear word. Accordingly the generally accepted moral principle prohibiting the use of swear words does not apply to it. This conclusion is supported by the evidence that, not only have both the UK Trade Marks Registry and OHIM accepted the mark FCUK for registration, but also none of the regulators who have considered the mark have judged it to be objectionable if used in ways that do not evoke the swear word. Thus the ASA has rejected complaints about French Connection advertisements featuring (a) “Vive le FCUK” (b) “eau de FCUK” and (c) FCUK shown on the pocket of a pair of jeans, concluding in each case that the advertisement was unlikely to cause serious or widespread offence. A striking instance of this is Ofcom, which approved the use of the name FCUK FM for a radio station (and even wished it luck).
90. Furthermore, I agree with the hearing officer that the best barometer of public perception is evidence resulting from actual use in the market. In the present case, apart from the mysterious reference in the *Delete expletives?* report, the evidence resulting from actual use is really all one way. By January 2005 over 16 million items of FCUK branded clothing had been sold. In addition the brand had been licensed for use on a variety of other products, and there had been retail sales of over £60 million of FCUK branded products other than clothing in the year ending January 2005 alone. It was estimated that by that date FCUK products were on sale in over 6,300 stores in the UK. These outlets included Boots, House of Fraser, John Lewis, Harrods and Selfridges. There has been widespread poster, print, television and cinema advertising of the brand. FCUK has been used in connection with sponsorship of ballet, theatre and other cultural events. FCUK branded clothing has even been shown in a photograph on the front page of *The Daily Telegraph* newspaper. With exposure on this scale, if the mark FCUK was significantly offensive to a section of the public, there would be evidence of this. There is not. On the contrary, French Connection’s evidence includes a series of letters from a

number of prominent retailers and licensees commenting on Mr Woodman's application. The comments of David Kneale, the Chief Commercial Officer of Boots, are representative:

Neither I nor my colleagues have ever considered the FCUK brand in bad taste, let alone offensive...

If we felt that being associated with the brand FCUK as licensees of the brand or stockists would be detrimental to the Boots brand we would not have entered into that association let alone given the FCUK products the significant prominence we have in our stores, catalogues and advertising.

A number of the retailers expressly state that they have had no complaints from their customers. The same is said by Alexandra Shulman, the editor of *Vogue* magazine, which by November 2004 had carried FCUK advertising for over seven years.

Conclusion

91. The appeal is dismissed.

Costs

92. French Connection did not ask the hearing officer for an award of costs in its favour having regard to the fact that Mr Woodman was not commercially motivated. It does seek an order for costs in respect of the appeal in the normal way. I see no reason not to make such an order. Accordingly I order Mr Woodman to pay French Connection the sum of £1,500 as a contribution to its costs of the appeal.

17 May 2006

RICHARD ARNOLD QC

Malcolm Chapple, instructed by Gillhams, appeared for Mr Woodman.

Daniel Alexander QC, instructed by Bristows, appeared for French Connection Ltd.