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# A Critical Study of the Concept Public Order/Ordre Public and Morality as a Bar in Trademark Registration

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## ABSTRACT

*Trade marks are distinct from other forms of intellectual property, in that the subject matter that they seek to protect is reputation, created through effort, as opposed to a pure creation of mind. Nevertheless, they have become an integral part of the intellectual property regime. This is because of the ease of protection of trade marks through a registration scheme under IP laws, as opposed to common law protection through the tort of passing off.*

*However, protection under the IP regime requires that a trade mark overcome several grounds on the basis of which they may be refused. These grounds have emerged through deliberation by legislatures and in various landmark judgments. 'Public ordre and morality' forms one of these grounds, however the scope of this ground is ambiguous, largely because the nature of morality is ambiguous. It differs from culture to culture, generation to generation.*

*Trade however, is global. Expansion of businesses into various countries other than their own has brought up some intriguing questions regarding the acceptability, and validity of the ground of 'public ordre and morality as a bar to registration. While some jurisdictions have dealt admirably with the meaning and scope of this term, a greater and uniform understanding of the term would be invariably beneficial to global business prospects.*

**Keywords:** *Intellectual Property Rights, Trademarks, Morality, Ordre Public Trademark Registration.*

## I. INTRODUCTION

It is the creation of our minds and intellect that forms the subject matter of Intellectual Property. An individual is entitled to the fruits of his labor, both physical and mental, when it is the society benefits from it. However, there are times when these fruits are not palatable to the tastes of the society. This is because the social mores regarding offensive and scandalous content are flexible according to the personal experiences of the individual, so that the majority's experience and

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beliefs dictate what is appropriate and inappropriate. This does not mean that these dictates are in themselves rigid for all time. They are subject to change as the society evolves.

However, these social mores do end up acting as barriers against individuals owning rights over their intellectual property. We know these barriers under the general term of ‘Public ordre and morality’. ‘Public Ordre and Morality’ is a term that forms an essential part of the governing structure of Intellectual Property laws, but has such inherent ambiguity in it that despite established precedents, does not lead to predictability in registration process.

As mentioned above, the social beliefs and moral dictates of the time define what is appropriate for public consumption. Due to variation in perspectives of ‘public ordre and morality’ with respect to different intellectual properties, the degree and kind of the former varies. In patent, concerns regarding ‘public ordre and morality’ renders an invention not patentable, and are more related to ethical and humane considerations regarding higher life forms, whereas, under copyright, these concerns matter not at all when granting protection. When considering trademarks, these concerns form grounds to deny registration of the mark under domestic laws, and here, they are related to vulgarity, and hurt social, ethnic, racial, or religious sentiments of different sections of society.

The vague nature of morality and public ordre brings with it, its own concerns, the chief being its conflict with freedom of speech. Is it fair for society to stop an individual from expressing him/herself, when what they are saying, while being hurtful to some sections of the society, may only be an opinion that attempts to foster conversation around that controversial subject? This issue has been grappled with in many courts, and remains undecided.

However, that is not the only issue with ‘public ordre and morality’. We must not forget that intellectual property is a commercial resource. As such, its main focus is on monetization and profit by attempting to fulfill the needs of the society. In furtherance of that goal, the IP structure in most domestic systems is based on registration process, (except that of copyright), which guarantees automatic state protection without having to prove the three ingredients of passing off<sup>2</sup>. Thus, registration gives the edge to players in the market enabling them to compete. ‘Public ordre and morality’ in this respect acts as an unpredictable barrier in the discretionary hands of the registrar, especially in case of trade marks.

A study of previous cases<sup>3</sup> would show that trade mark registrations are the worst affected by the ‘public ordre and morality’ exception, due to wide discretion in the hands of the registrar in

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<sup>2</sup>Teresa Scassa, *Antisocial Trademarks*, 103 Trademark Rep. 1172, 1213 (2013)

<sup>3</sup> See, Anne Gilson LaLonde; Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*,

determining what would constitute a threat, as well as different standards of morality and tolerance around the world. While FCUK enjoys well known status in India due to being registered abroad, in the Indian jurisdiction, it would never have cleared the barrier created by ‘public order and morality’ exception. Should then, it be entitled to the equivalent level of safeguard that it would otherwise never have had?

This project attempts to study the ‘public order and morality’ exception in relation to trade marks in order to identify and categorize all the issues that arise due to ambiguous standards of this exception. It is a comparative study, so that the disparities arising in trade mark protection due to difference in moral standards and tolerance levels will be highlighted. Judicial precedents have been relied upon as indicators of social beliefs, and the paper strives to reach to a conclusion that would enable more predictability and comparative standards in the registration process, despite differences in jurisdiction.

## II. TRADEMARKS

WIPO explains that “a trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.”<sup>4</sup> The owner of a trademark then has an exclusive right to use it in connection to the goods or services to which it is associated. The trademark allows the consumer to know who the manufacturer is and what quality is involved. Although a trademark does not in itself ensure quality, character or consistency (as this is not a requirement for protection), the trademark owner wishes to build the expectation that the trademark can be trusted to identify consistent quality and consistency.<sup>5</sup>

There are two categories of trademarks specifically, individual and collective marks. Individual trademarks are already described above whereas, Collective marks can be defined as those signs which differentiate the geographical origin, manner of manufacture, material or other shared attributes of goods or services of distinct enterprises using the collective mark.<sup>6</sup> Collective marks are commonly used to endorse products which have similar characteristics for a given region. The holder of the collective mark may be either an association of which those enterprises are members or any other entity, including a public institution or a cooperative. The holder of the collective mark requires to confirm compliance with certain standards (generally fixed in

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101 Trademark Rep. 1476, 1545 (2011); See also, Griffiths, Jonathan, *Is There a Right to an Immoral Trade Mark?* Intellectual Property & Human Rights P. Torremans, ed., Kluwer Law International, pp. 309-334, 2008. Available at SSRN: <https://ssrn.com/abstract=1492117> [accessed 13 February 2019]

<sup>4</sup> See: <http://www.wipo.int/trademarks/en/> (last accessed: 11 February 2019).

<sup>5</sup> S. ANG, *Moral Dimensions of Intellectual Property Rights*, Glos UK, Edward Elgar, 2013, 168-169.

<sup>6</sup> See: [http://www.wipo.int/sme/en/ip\\_business/collective\\_marks/collective\\_marks.htm](http://www.wipo.int/sme/en/ip_business/collective_marks/collective_marks.htm) (last accessed: 11 February 2019); Article 2.34 BVIE; Article 74 EUTMR.

the guidelines concerning the use of the collective mark) by its members. Protection of collective marks exists under the intellectual property law regime of most countries. Other countries might provide a sui generis protection for the geographical origin, mode of manufacture, material or other common characteristic of the goods or services

In order to achieve trademark protection, registration must be sought with the relevant authorities of the country or group of countries where trademark protection is desired. There is also unregistered trademark protection in Common Law countries. However, such unregistered marks are less strong, as it must be proved that i) the mark is his, ii) he created the good will associated with the mark, and iii) he did so by using the mark in another way was injured.

### **III. THE CONCEPTS PUBLIC ORDER/ORDRE PUBLIC AND MORALITY IN TRADEMARK REGISTRATION**

The majority of jurisdictions provide for the exclusion from registration of those trademarks that are contrary to public order/public policy and/or (to accepted principles of) morality. The reasoning behind such a provision is to preclude those trademarks from getting registration, in cases where granting a monopoly (via registration of the trademark) would flout the state of law or would be perceived by the relevant public as going directly not in favor of the basic moral norms of society.<sup>7</sup> It is to be observed that “public policy” and “morality” are in verity concepts of unwritten law having an open character and are being used in trademark law as a catch-all condition to outlaw all trademarks which, according to prevailing social norms, are too objectionable to be granted a right.<sup>8</sup>

Article 6 quinquies of the Paris Convention<sup>9</sup> facilitates the states to decline registration or to abrogate trademarks if they are “contrary to morality or public order and, in particular, of such a nature as to deceive the public”.<sup>10</sup> This provision is fascinating, as it affiliates concerns over the concept of morality in trademark law with one of its principal objects, i.e. avoiding the deception of the trademarks to the public. The TRIPS Agreement in Article 15(2) does not

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<sup>7</sup> EUIPO, Guidelines for Examination in the Office, Part B Examination, Alicante, EUIPO, Version 1.0, 11.02.2019,

<sup>8</sup> C. GEIGER and L. PONTES, Trademark registration, public policy, morality and fundamental rights, Centre for International Intellectual Property Studies Research Paper No. 2017-01, 12.

<sup>9</sup> Paris Convention for the Protection of Industrial Property, 20 March 1883 (as revised at Brussels on 14 December 1900, at Washington on 2 June 1911, at The Hague on 6 November 1925, at London on 2 June 1934, at Lisbon on 31 October 1958, and at Stockholm on 14 July 1967, and as amended on 28 September 1979), online World Intellectual Property Organization: <[http://www.wipo.int/treaties/en/ip/paris/trtdocs\\_wo020.html](http://www.wipo.int/treaties/en/ip/paris/trtdocs_wo020.html)> [Paris Convention].

<sup>10</sup> Article 6 quinquies goes on to state: “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.”

enhance any additional notion with regard to morality. It merely authorizes the states to forbid registration to trademarks on the foundations that do not derogate from those in the Paris Convention.<sup>11</sup> Neither the Paris Convention nor TRIPS are dictatorial in this regard, as, both approves, but do not necessitate, the states to bar from registration those marks that are impertinent to public order or morality. This is in contrast with NAFTA, under which parties have a compulsion to decline registration to those trademarks that “entail of or comprise immoral, deceptive or scandalous matter, or matter that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or any Party's national symbols, or bring them into contempt or disrepute.”<sup>12</sup>

Provisions regarding public order and morality are distinctive from those which are regarding deceptive trademarks and these provisions have been affected although in different ways in the trademark legislation of various jurisdictions. Thus, public order and morality concerns are much more universal when it comes to trademarks than they are in comparison with either in patent or in copyright law.

#### **(A) Treatment of Scandalous marks in UK and the European Community**

Due to Paris Convention<sup>13</sup>, TRIPS<sup>14</sup>, and the Trade Mark Directive<sup>15</sup> the intellectual property law is largely harmonised in the European Union. As such, UK's Trade Marks Act 1994<sup>16</sup>, reflects the same through its provisions. Section 3(3)(a) of the Trade Marks Act states that

“A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality...”

Under Article 7(1)(f), the Community Trade Mark Regulation<sup>17</sup> has a parallel provision:

“The following shall not be registered: ...

(f) trademarks which are contrary to public policy or to accepted principles of morality...”

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<sup>11</sup> OTRIPS, supra note 10, article 15(2). Article 15(1) states that it “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)”.

<sup>12</sup> NAFTA, supra note 9, art 1708(14). Note that this language is taken directly from s. 2(a) of the Lanham Act 1946 (60 Stat. 427).

<sup>13</sup> Paris Convention for the Protection of Industrial Property, as last revised at Stockholm, 21 UST 1583, available at <https://wipolex.wipo.int/en/details.jsp?id=12633> [accessed 13 February 2019]

<sup>14</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, 1869 UNTS 299, available at [http://www.wto.org/english/tratop\\_e/trips\\_e/t\\_agm0\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm) [accessed 13 February 2019]

<sup>15</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015L2436&from=EN> [accessed 13 February 2019]

<sup>16</sup> United Kingdom's Trade Marks Act 1994, available at: <http://www.legislation.gov.uk/ukpga/1994/26/contents>

<sup>17</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council, available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:32017R1001&from=EN> [accessed 13 February 2019]

The meaning of ‘contrary to public policy’ and ‘accepted principles of morality’ has come up for discussion in various cases. Both the UK Courts and Trade Mark Registry, as well as Office of Harmonization in the Internal Market, its Board of Appeal, Court of first instance, and the Court of Justice, have discussed the boundaries of these phrases. Interestingly, both the Courts have also attempted to harmonize their interpretation of ‘public policy’ and ‘morality’ as applied to trade mark law, with Article 10 of ECHR<sup>18</sup> which guarantees freedom of speech and expression<sup>19</sup>.

Section 3(3) of Trade Marks Act 1994, was first discussed in *Phillips Electronics NV v Remington Consumer Products*<sup>20</sup> wherein the defendant had argued that allowing the registration of the shape mark of the three headed rotary shavers was opposed to public policy. This was because once an IP [in this case, a patent] in an object has expired, it cannot be protected again by virtue of another IP [the shape mark]. The Court dismissed this argument holding that the term ‘public policy’ in the above section does not have economic connotations, i.e. objections on economic grounds do not come within the purview of this head. Rather, its meaning is in line with the french term *ordre publique*, which has aspects of morality attached to it.

#### a. Sexual Connotations and Innuendos

The aspects of morality first came under discussion in *Ghazilian’s Application*<sup>21</sup>, a case which arose due to the refusal of registration to the mark TINY PENIS, in respect of clothing, on grounds of ‘public policy’ and ‘morality’. The registrar considered the mark to be offensive to a significant number of people, and hence denied registration to it. On appeal, this refusal was upheld. In dismissing the appeal, the Court followed the standard set in *Masterman’s design application*<sup>22</sup>, wherein analogous provisions (public ordre and morality) were in question. This standard was that of the “right thinking member of the public”, i.e. if according to this member of the public, the ‘accepted principles of morality’ are being offended by a mark, then it should be denied registration.

The court however cautioned against a too high threshold of morality. According to it, “mere

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<sup>18</sup> Council of Europe, European Convention for the Protection of Human Rights and Fundamental Freedoms, as amended by Protocols Nos. 11 and 14, 4 November 1950, ETS 5, available at: <https://www.refworld.org/docid/3ae6b3b04.html> [accessed 13 February 2019]

<sup>19</sup> Griffiths, Jonathan, Is There a Right to an Immoral Trade Mark? Intellectual Property & Human Rights P. Torremans, ed., Kluwer Law International, pp. 309-334, 2008. Available at SSRN: <https://ssrn.com/abstract=1492117> [accessed 13 February 2019]

<sup>20</sup> Koninklijke Philips Electronics NV v. Remington Consumer Products (C-299/99) [2002] I ECR 5475 (para 18) available at: <http://curia.europa.eu/juris/showPdf.jsf?docid=102106&doclang=EN> [accessed 13 February 2019]

<sup>21</sup> ETMR 57[2002].

<sup>22</sup> RPC 89[1991].

offence to a section of public, in the sense that the mark is distasteful to them”<sup>23</sup>, is not an acceptable ground for denial of registration. There are certain standards of behaviour, morality, and conduct which are widely shared amongst the populace, which uphold social, filial, and/or religious values. When these are undermined, only then will a mark be against ‘accepted principles of morality.’ The mark TINY PENIS was thus liable to be refused as

“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.”<sup>24</sup>

Another mark which had sexual innuendo within it, came up before the Court in *Scranage’s Application*<sup>25</sup>. Here, the applicant had sought to register the mark FOOK in respect of clothing, headgear, and footwear. It was refused registration on the grounds that it was phonetically similar to ‘fuck’, which was against the ‘accepted principles of morality’. The Court upheld the refusal following the reasoning of *Ghazilian’s Application*, saying that “use of the mark at issue in this case was likely to be indistinguishable from use of the word, ‘fuck’ and would therefore cause equal offence and outrage”<sup>26</sup>.

However, in *French Connection Ltd.’s Trade Mark Registration*<sup>27</sup> the validity of the registration of mark FCUK was upheld. Its validity was challenged on the basis of section 3(3)(a) in public interest, and the Court held that as opposed to the case in *Scranage’s application*<sup>28</sup> here, there is no phonetic similarity between the mark and the word ‘fuck’. The Court examined the previous cases, and came to the conclusion that for the ground of contrariness to ‘public policy and morality’ to apply, there must be “a generally accepted moral principle which would be contravened by the use of the mark”<sup>29</sup>. The use of the mark must be likely to significantly undermine the current social, religious, and filial values, so that there would be justifiable censure and outrage in an identifiable section of the population. Mere distaste is not enough.

In this case, while there was visual similarity between FCUK and ‘fuck’, there was ample evidence to support the conclusion that the mark had been generally accepted by the public, as

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<sup>23</sup> Id. at 11

<sup>24</sup> Ibid.

<sup>25</sup> O/182/05, 23rd June 2005, <https://www.ipo.gov.uk/t-challenge-decision-results/o18205.pdf> [accessed on 13th Feb 2019].

<sup>26</sup> Ibid. at p. 5.

<sup>27</sup> ETMR 8 [2007].

<sup>28</sup> Id. at 15.

<sup>29</sup> Id. at 17.



well as the industry regulators. Furthermore, it was an acronym of the owner's trade name, and thus, on an objective basis, it could be held that there is no reason for justifiable censure or outrage, or even distaste.

The distinction between 'distaste' and 'offence to generally accepted moral principles' was further discussed in *Dick Lexic Ltd's Application*<sup>30</sup> wherein the refusal of registration of the mark 'Dick & Fanny' in respect of various goods was overturned by the OHIM's Board of Appeal. The examiner had refused the application as the words were a coarse sexual slang and liable to offend English speaking people. The Board of Appeal however held that mere sexual connotation alone was not enough to justify the refusal. The mark did not 'proclaim an opinion', 'contain incitement', or 'convey insult'.<sup>31</sup> In formal English, it was merely a shortened form of two names - Richard and Frances. To fall within the scope of Article 7(1)(f), the mark has to go beyond merely designating things; it has to transmit a message that would offend morality or public opinion.

This explanation becomes clearer by the Board of Appeal's discussion related to the morality and public policy exclusion in *Application of Kenneth* (trading as Screw You).<sup>32</sup> The mark in question was SCREW YOU in respect of various products, and the application was refused by the examiner. The Board of Appeal upheld this refusal. It discussed the Dick Lexic application<sup>33</sup> and the parameters of the morality and public policy exclusion, and held that while 'slightly rude words and mild sexual innuendo' might be registered, signs that are manifestly profane, obscene, and hurt religious sensibilities of a substantial part of the population cannot be. The standard of judging is a reasonable person with normal levels of sensitivity and tolerance.<sup>34</sup> Moreover, the context of the use of the mark is also relevant.

The board thus upheld the refusal in respect of goods which fall within the ordinary scope of encounter of a reasonable person with normal sensitivity and tolerance. Such a mark in respect of say, clothing would be offensive to a large number of people as the term 'SCREW YOU' is a crude insult that denigrates sexuality with contempt and loathing, particularly the board felt, parents. However, in respect of goods that were to be sold to a specific clientele, such as that of a sex shop, the registration was allowed.

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<sup>30</sup>ETMR 99 [2005].

<sup>31</sup>Ibid.

<sup>32</sup>ETMR 7[2007].

<sup>33</sup>Id. at 29.

<sup>34</sup>Id. at 31.

### **b. Religious Sensibilities**

The question of religious sensibilities and their interaction with ‘public policy’ and ‘morality’ came up in *Basic Trademark SA’s Application*<sup>35</sup> where the issue was of denial to register the mark JESUS in respect of a wide range of goods. The denial was on grounds of violation of section 3(3)(a), i.e. ‘accepted principles of morality’ and ‘public policy’. The Court held that while religious significance alone does not preclude a mark from registration, the mark here, i.e. JESUS was such that if allowed to be used for commercial purposes, the sensibilities of the believers, as well as those who believe in respecting the religious sensibilities of the others, would be offended<sup>36</sup>.

Here, the concern was not just of offending morality, but also that of prevention of disorder. The use of the mark, in the opinion of the court, regardless of the nature of goods in respect of which its use was proposed, “had the ability to undermine accepted social and religious values”<sup>37</sup>. Thus, following the reasoning in *Ghazilian’s Application*<sup>38</sup>, the denial of registration was upheld.

### **c. Public Policy**

An example of a mark which is contrary to ‘public policy’ was seen in *CDW Graphic Design Ltd’s application*<sup>39</sup>, for registration of ‘www.standupifyouhatemanu.com’ for goods falling with classes 16, 21, and 25. The registration was refused on the grounds of *inter alia* contrariness to public policy. This was because the mark was likely to incite football related violence and criminal behavior. It was not necessary that such violence and disorder actually happen for this ground to become a valid ground of refusal, only that this result be highly likely<sup>40</sup>.

Similarly *Sporting Kick Ltd’s application*<sup>41</sup> for registration of the mark consisting of the words INTER CITY FIRM, letters ICF, symbol of ‘British Rail’ and two crossed hammers was refused on the grounds of contrariness to ‘public policy’. The registrar found that INTER CITY FIRM and ICF used to be a symbol of violent supporters of the West Ham Football Club. The use of the mark thus, was liable to be seen as a mark of allegiance to this criminal gang, and may result in increase of football related violence, which would be contrary to public policy.

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<sup>35</sup> ETMR 24[2006].

<sup>36</sup> Ibid.

<sup>37</sup> Ibid.

<sup>38</sup> Id. at 20.

<sup>39</sup> RPC 30 [2003].

<sup>40</sup> Ibid.

<sup>41</sup> ETMR 10[2007].

It is obvious that holding of the Board of Appeal's decision in Application of Kenneth<sup>42</sup> i.e. that the context in which the mark will be encountered is relevant, is relevant for determining cases of both morality as well as public policy. This does not mean that there will be always be goods for which the use of the mark will be appropriate. However, the effect of the use of the mark in respect of the goods for which it is sought to be registered, along with the socio-cultural and religious ethos surrounding the use of the mark are certain vantage points from which the degree of offence to accepted principles of morality and/or public policy may be judged.

**(B) Treatment of Trademarks contrary to public ordre/ morality in United States**

United States law<sup>43</sup> clearly authorizes the United States Patent and Trademark Office ("USPTO") to deny registration to a trademark or to repudiate an already registered trademark if they are contrary to morality. It is stated in the section 2 of the Lanham Act that, "no trademark . . . shall be refused registration on the principal register on account of its nature unless it . . . consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute..."<sup>44</sup> Section 14 of the Lanham Act provides that a registered trademark may be cancelled at any time if the registered mark's registration was obtained contrary to the provisions of Section 2.<sup>45</sup>

In the United States, one of the famous case laws on disparaging trademark is *Harjo v. Pro-Football*,<sup>46</sup> in this case some native American petitioners challenged the trademark "REDSKINS", which was registered by the well-known American football team. The Board of The United States Patent and Trademark Office (USPTO) initially rescinded the registration on the justifications that it might denigrate or criticize native Americans and therefore, may bring them into disdain or disrespect, but the USPTO Board negated the petitioner's allegation that the sign was scandalous.<sup>47</sup> The Court of Appeals for the District of Columbia Circuit, then discovered that the disparagement and contempt claims were forbidden by laches<sup>48</sup>. In a succeeding proceeding connected to the similar sign, the USPTO Board held that the trademark "REDSKINS" was denigrating and thus, revoked nearly six registrations.<sup>49</sup>

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<sup>42</sup> Id. at 31.

<sup>43</sup> Trademark law in the United States is governed by the Lanham Act of 1946, 15 U.S.C. § 1051 et seq.

<sup>44</sup> 15 U.S.C. § 1052.

<sup>45</sup> 15 U.S.C. § 1064

<sup>46</sup> *Harjo v. Pro-Football, Inc*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999), rev'd, 284 F. Supp. 2d 96, 68 U.S.P.Q.2d 1225 (D.D.C. 2003), remanded to 415 F.3d 44, 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005).

<sup>47</sup> Ibid.

<sup>48</sup> Ibid.

<sup>49</sup> Ibid.

A series of case laws, also regarded that sexual messages contained in the trademarks were disparaging, therefore, refused to grant or revoked the registration, if in case already granted. In *McGinley case*<sup>50</sup> the symbol included a snapshot of an undressed man and woman kissing and cuddling in a way seeming to reveal the male genitalia (the artifact was a newsletter which dealt with sexual issues). The trademark was considered invasive to the propriety, morality, decency, as well as outrageous to the moral sense of the members of the society.<sup>51</sup> However, a contradictory inference was reached in both *Old Glory Condom*<sup>52</sup> and *Mavety*.<sup>53</sup> In the prior case the mark was "a pictographic depiction of a condom adorned with stars and stripes in a way to indicate the American flag." The Trademark Trial and Appeal Board, discarded the examiner's contention that the majority of the public would be offended and affronted by the association of the American flag and commodities related to sexual activity. It is supposed that the Board's finding was prejudiced by its endorsement of the implication that the applicant was intending to convey, that it is Americans' patriotic duty to combat AIDS by practicing safe sex.<sup>54</sup> In *Mavety*<sup>55</sup> the publisher of an adult magazine showcasing naked African and American was allowed to register the title "Black tail". The mark was not debarred under the immoral or scandalous exclusion as the people would generally suppose that the expression "tail" denotes to buttocks and not to a female sex object.<sup>56</sup>

However, in the past, the United States Patent and Trademark Office could deny to register any offensive or derogatory trademark. This has now changed as there have been some recent case laws which held that Section 2(a)'s prohibition on disparaging registrations "violates "a core of First Amendment principle, i.e." speech may not be banned on the premise that it expresses ideas that offend." In *Matal v. Tam*<sup>57</sup> concerning the trademark application for registration of the mark "The Slants" for an Asian- American rock band, the Supreme Court collectively held that the "disparagement clause" in Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), violates the Free Speech Clause of the First Amendment.<sup>58</sup> The United States Supreme Court thus holds that one can acquire trademark registration for an offensive mark or term. In the same line of inference, a three-judge panel of the U.S. Court of Appeals for the Federal Circuit smacked

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<sup>50</sup> In re McGinley, 660 F.2d 481, 482 (C.C.P.A. 1981).

<sup>51</sup> Ibid.

<sup>52</sup> In re Old Glory Condom Corp., 26 U.S.P.Q. 2d 1216 (T.T.A.B. 1993).

<sup>53</sup> Ibid.

<sup>54</sup> Ibid,

<sup>55</sup> Id at 14.

<sup>56</sup> In re Mavety Media Group, 33 F.3d 1367, 1369, 1373, 31 U.S.P.Q.2d 1923 (Fed. Cir. 1994) (stating that the case was vacated and remanded to deduce if the Board could support its reasoning for believing the mark was immoral or scandalous).

<sup>57</sup> 582 U.S. 15-1293 (19 June 2017),

<sup>58</sup> Ibid; see also C. GEIGER et al., Trademark registration, 13-16.

down the Lanham Act's ban on "scandalous and immoral" marks as unconstitutional in violation of the First Amendment.<sup>59</sup> In March 2018, the US Government (USPTO/Department of Justice) has petitioned for en banc review of the decision – arguing that the immoral/scandalous prohibition should stand.

In *Matal v. Tam*<sup>60</sup>, the Supreme Court had further held that the disparagement clause polices the expressive constituent of trademarks. Subsequently, it was held that trademarks cannot be considered as commercial speech.<sup>61</sup> Thus, it can be stated that forthcoming interpretation of the Lanham Act in future will express that the Lanham Act will restricts registration of debatable trademarks. In the past, it was held that non-commercial speech does not receive protection under the First Amendment if it is "obscene"<sup>62</sup> or nothing more than "fighting words"<sup>63</sup>, so it is expected that still part of Section 2(a) of the Lanham Act will have a function.<sup>64</sup>

### (C) Indian Position on Trademarks contrary to Public Ordre and Morality

Section 9(2)(b) and (c) of the Trade Marks Act, 1999<sup>65</sup> consists of the equivalent 'morality and public order' clause in the Indian legislation. An interesting feature of the Indian legislation is that unlike the US and EU provisions, (where 'public policy and morality' are a catch all for all marks which offend general sensibilities), the grounds for refusal are bifurcated into marks which hurt religious susceptibilities of any section or class of citizens, and marks which are scandalous or obscene in nature. Prevention of disorder, which also forms a part of the public policy exclusion in EU and US, is not specifically mentioned in this Act.

An examination of the judicial discussion on such marks reveals that the Court hardly ever takes recourse to these grounds of refusal. For example, in *Lal Babu Priyadarshi v Amrit Pal Singh*<sup>66</sup> the appellant had applied for registration of the mark RAMAYAN in respect of fragrant incense

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<sup>59</sup> In re: Brunetti (trademark FUCTION), No. 2015-1109 (D.C. Cir. Dec. 15, 2017): the U.S. Court of Appeals for the Federal Circuit held that the scandalous provision 15 U.S.C §1052(a) violates the Free Speech Clause of the First Amendment. Accordingly, that a mark "consists of or comprises immoral, deceptive, or scandalous matter" is no longer a valid ground on which to refuse registration or cancel registration.

<sup>60</sup> Id at 24.

<sup>61</sup> Supra at 5.

<sup>62</sup> See Decision of the Supreme Court of the United States of 21 June 1973, *Miller v. California*, 413 U.S. 15 (1973).

<sup>63</sup> See Decision of the Supreme Court of the United States of 9 March 1942, *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571-73 (1942) (The Supreme Court has defined "fighting words" as words "which by their very utterance inflict injury or tend to incite an immediate breach of the peace").

<sup>64</sup> A. MARTINEZ, *The Act of Registering a Trademark: Commercial Speech, Non-Commercial Speech, or a Combination of Both?* 2017 Ladas Memorial Award Winners, 2017, 14, Available via: [https://www.inta.org/Academics/Documents/2017/Martinez\\_%20Student%20Winner.pdf](https://www.inta.org/Academics/Documents/2017/Martinez_%20Student%20Winner.pdf) (last accessed: 11 February 2019)

<sup>65</sup> Trade Marks Act, 1999, available at: <http://ipindia.nic.in/writereaddata/Portal/ev/TM-ACT-1999.html> [accessed on 13 Feb, 2019]

<sup>66</sup> 16 SCC 795(2015).

sticks. This application was opposed by the respondent, however, the Registrar allowed registration, finding the mark to be capable of distinguishing goods. On appeal however, the registration was set aside, as the Board felt that the mark RAMAYAN is the name of a holy book, and thus one person should not be given monopoly over its use. Thereafter, the appellant approached the Supreme Court, wherein the question was, whether this mark violated the grounds given in section 9(2) of the Act?

The Court upheld the board's decision that the appellant could not use the mark. It did so on the grounds that as per the Eighth Report on Trade Mark Bill, 1993, any symbol ordinarily representing Gods, Goddesses, places of worship, religious texts, should not be registered as trademarks<sup>67</sup>. However, in order to preserve the integrity of the market, such marks which are already existing should be allowed to continue, and if a complaint arises that such marks are hurting religious sensibilities, appropriate action should be taken by the Government<sup>68</sup>.

The Court held that giving monopoly over such marks to one person is inappropriate, as these religious words are accessible to all. Their distinguishing characteristic, would thus be hard to discover. The Court however went on to say that if there is an addition of prefix or suffix to such word, and the length and design/characteristics of this prefix and suffix is the same as that of the word, then the word may lose its religious significance, and become registrable.

In *Ravindra Singh Kushwaha v Union of India*<sup>69</sup> the issue was not strictly regarding registration of a scandalous mark. The petitioner had preferred a writ petition against Patanjali Ayurveda Ltd. to restrain them from using the mark OM with a photograph of Baba Ramdev within it, in respect of toiletry products. The petitioner contended that the word of OM cannot be appropriated in such a manner as it is a sacred symbol in Hinduism, Sikhism, Jainism, and Buddhism. Such use is objectionable and thus prevented by section 9(2)(b) of Trade Marks Act, 1999, as well as section 295A of IPC [Deliberate and Malicious Acts which hurt Religious Sentiments].

The Court however dismissed this petition. Most of the discussion was focused on applicability of section 295A of IPC, however, it is relevant in respect of section 9(2)(b) as the discussion centered on the conflict between restrictions on such use and the freedom of speech, and to what extent such restriction is reasonable. The Court held that through previous cases<sup>70</sup>, a clear distinction has been made between words that are insulting but do not constitute a deliberate

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<sup>67</sup> Ibid. at p. 802

<sup>68</sup> Ibid.

<sup>69</sup> (PIL) No. 17568 of 2017; MANU/UP/0913/2017.

<sup>70</sup> *Ramji Lal Modi v State of UP*, AIR 1957 SC 620.

and malicious attempt to incite public disorder, and words that do. The restriction on speech only covers the latter kind; the former is unregulated.

Words and expressions that are unwittingly insulting and have no intention to hurt the religious sentiments of that class are not subjects to section 295A<sup>71</sup>. The petitioner failed to demonstrate that there was any such deliberate and malicious intention to outrage the sensibilities of a religious section of population. Thus, the petition was dismissed and Patanjali Ayurveda Ltd. was allowed to continue with its use of the mark

Another case law, the Attukal Bhagavathy Temple in Thiruvananthapuram, one of the ancient temples of South India, is regulated by the Attukal Bhagawathy Temple Trust. In 2009, the Attukal Bhagawathy Temple Trust in Kerala secured trademark protection for the picture of its deity Kannagi, a legendary figure from the Tamil epic the Silappathikaram (Trademark No. 1420800) and the title 'Sabarimala of Women' (Trademark No. 1420799) under Class 42 – a residuary clause (for temple Services, social services, welfare services and cultural activities) because it “would help to prevent unauthorised use of the picture and title.” The Division Bench of the Kerala High Court initiated Suo Motto case against the aforesaid registrations in early 2009 based on a petition faxed by *Mr. Praveen Raj*.<sup>72</sup> In this case various issues were raised, firstly, the Instant Marks, being marks in the public domain, cannot be granted registration on this, the Court relying on the single bench judgement in *Bhole Baba Milk Food Industries Ltd. v. Parul Food Specialities (P) Ltd*<sup>73</sup>, that “the name of a deity, which is in the public domain, cannot be monopolized,” therefore, rejected the contention that the Instant Marks, being in the public domain, cannot be monopolized and cannot be granted trademark protection. The second issue was that, whether the Trust is the proprietor of the mark or not. The Court relying upon the decision of the Supreme Court in *Ratilal Panachand Gandhi v. State of Bombay*,<sup>74</sup> that “*religious practices or performances of acts in pursuance of religious belief are as much a part of religion as faith or belief in particular doctrines*” held that the Trust cannot claim exclusive title over temple services, social services, welfare services and cultural activities carried out pursuant to the religious faith as the devotees have equivalent stake as the Trust has in the said services. Thus, the Trust is not a proprietor of the Said Services and therefore, cannot enjoy exclusive right over the Instant Marks and according to the judgment, the Trust stands in the status of the manager of the estate of the idol (a perpetual minor). The other issue was that whether the registration would prohibit the worship of the deity of the temple unless authorize

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<sup>71</sup> Mahendra Singh Dhoni v Yerraguntla Shyam Sunder, 7 SCC 760(2017).

<sup>72</sup> MANU/KE/0776/2013: 2013 (4) KHC 1, 2013(4) KLT66, MIPR2013(3)151.

<sup>73</sup> MANU/DE/4050/2011: 2011 (48) PTC 235 (Del).

<sup>74</sup> MANU/SC/0138/1954: AIR 1954 SC 388.

by the trust or not. The Trust on the *above* issue contended that “*it is not their intention to restrict the rights of the devotees to worship the deity of the temple and that it was only their intention to prohibit the use of the picture of the deity and the appellation for services protected under the registration.*” Consenting to the arguments of the respondent as well as relying on the submissions done by the Amicus Curiae, the Court *noted that “Trust in their counter affidavit would not cause any prejudice to any devotee or any member of the public....Worship is personal and the registration is inconsequential as far as the belief of a devotee is concerned and it has no effect, material or spiritual, on the deity.”* Another issue that was raised in this case was *whether the registration of the Instant Marks violate the Constitution of India or not. On this issue, the Court, without much exposition, held that the exclusivity for the services does not fall foul of the tenets of Articles 25 and 26 of the Constitution of India.*

#### IV. CONCLUSION

A general theme that is visible in cases discussed above that the courts have repeatedly mentioned that denying registration to such scandalous marks does not prevent their use in the market. It merely allows the State to deny them privileges which are available to registered marks.

“...the rationale of the provision is that the privileges of trade mark registration should not be granted in favour of signs that are contrary to public policy or the accepted principles of morality. In other words, the organs of government and public administration should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilized society...”<sup>75</sup>

Thus, denying registration to scandalous marks does not necessarily restrict freedom of speech as has been contended in various cases. In the Indian scenario, a plain examination of the case law depicts that in case of objectionable marks also, freedom of speech is restricted only to the extent of restrictions allowed in Article 19(2) of the Constitution.

However, there are certain concerns that remain unaddressed, that arise from the global character of trade in our world. As we have seen from the above discussion, the standard of ‘public ordre and morality’ in India differs from that followed in other jurisdictions such US and Europe. The latter jurisdictions have developed a standard where marks that cause mere

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<sup>75</sup> Id. at 22.



distaste are allowed. Such marks however, due to cultural and religious differences, may readily offend Indian sensibilities.

At the same time, due to our TRIPS<sup>76</sup> obligations, India is required to protect well known marks in India. Therefore, marks such as SCREW YOU, and DICK & FANNY, which would otherwise have been denied the privileges of registration, will be entitled to that level of protection once they acquire sufficient level of well-knownness in India. On the other hand, the same level of protection would be denied to an Indian mark that is unregistered due to not qualifying the grounds mentioned in section 9(2), even if it has acquired tremendous popularity in the market.

The reason for this disparity is the vast difference in cultural and religious sensibilities of different societies; nevertheless, it may be prudent to develop a standard for ‘public order and morality’ that would be acceptable to all societies, and reduces subjectivity in deciding whether to allow registration to the mark. This would help in bringing parity in the level of protection available to businesses worldwide.

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<sup>76</sup> TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994)