

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION
of the Grand Board
of 6 July 2006**

In Case R 495/2005-G

Jebaraj Kenneth trading as Screw You

21 Springrice Road
Hither Green
London SE13 6HS
United Kingdom

Appellant

represented by J. A. Kemp & Co, 14 South Square, Gray's Inn, London WC1R 5JJ,
United Kingdom

APPEAL relating to Community trade mark application No 3888344

THE GRAND BOARD

composed of P. Maier (Chairperson), D.T. Keeling (Rapporteur), Th. Margellos,
T. de las Heras, D. Schennen, G. Humphreys, W. Peeters, Ph. von Kapff and
U. Wennermark (Members)

Registrar: E. Gastinel

gives the following

Decision

Summary of the facts

- 1 On 21 June 2004 the appellant filed an application to register the word mark

SCREW YOU

as a Community trade mark ('CTM') for:

- Class 9 – Sunglasses, spectacle frames, spectacle cases, spectacles, swimming jackets, weights.
 - Class 10 – Condoms, contraceptives, breast pumps, artificial breasts, sex toys (vibrators, dolls).
 - Class 25 – Clothing, footwear, headgear.
 - Class 28 – Bags, balls for games, baseball gloves, bats for games, belts for weight lifting, boxing gloves, games, guns (paint ball), sporting apparatus, ice skates, rackets, roller skates, skates (ice), surf boards, weight lifting belts (sports articles).
 - Class 33 – Alcoholic beverages (except beers), beverages containing fruit (alcoholic), bitters, brandy, cider, cocktails, gin, liqueurs, rum, spirits (beverages), vodka, whisky, wine.
- 2 By letter dated 3 November 2004 the examiner informed the appellant that the trade mark was not eligible for registration pursuant to Article 7(1)(f) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR') (OJ EC 1994 No L 11, p. 1; OJ OHIM 1/95, p. 52). The examiner stated that the word 'screw' was, among other things, a coarse slang term equivalent to the word 'fuck' and the expression SCREW YOU was a profane expression used to insult a person.
 - 3 By letter of 1 March 2005 the appellant requested the examiner to reconsider her objection to the application. It argued that the mark SCREW YOU originated in the United Kingdom and that there had never been any complaints from the general public there. On the contrary, in the applicant's experience consumers of all ages found the mark amusing. It noted that the term SCREW YOU had been used a few times on the popular television soap 'EastEnders', which is a programme aimed at a family audience and which undertakes various checks before airing an episode in order to avoid causing widespread offence to viewers. The applicant argued that nowadays the term SCREW YOU would not be considered morally inappropriate by the general public in the United Kingdom. It cited several marks which appeared to be of greater moral concern than the sign SCREW YOU, including, among others, FCUK, Criminal, Virgin, Suck it & See, Cock, and Wet'N Wild.
 - 4 By letter of 3 March 2005 the examiner notified the appellant of her decision ('the contested decision') that the trade mark was not eligible for registration under Article 7(1)(f) CTMR on the grounds stated in the examiner's previous letter. The examiner responded to the appellant's submissions by reiterating

that the Office could not accept for registration a trade mark which offends public decency or generally accepted principles of morality. She stated that the Office was not obliged to apply the same rules or criteria when assessing the eligibility of the mark for registration as the producers of a British prime-time television programme when deciding whether to air an episode which includes the term SCREW YOU.

- 5 On 27 April 2005 the appellant filed a notice of appeal against the contested decision. The statement of the grounds of appeal was filed on 4 July 2005.
- 6 The appeal was submitted to the examiner for revision under Article 60 CTMR on 21 July 2005. In the absence of any express response by 22 August 2005, revision was deemed not to have been granted.
- 7 By decision of 17 May 2006 the Second Board of Appeal referred the case to the Grand Board.

Grounds of appeal

- 8 In its grounds of appeal the appellant repeats the arguments it made before the examiner. In addition it makes the following points:
 - The word ‘screw’ is not synonymous with the word ‘fuck’. The words have similar meanings but the latter is far more offensive than the former. Likewise, the term ‘fuck you’ is much more offensive than the term ‘screw you’. While the expression SCREW YOU has been used on both ‘EastEnders’ and ‘The Simpsons’ television programmes on British television without apparent upset, the word ‘fuck’ caused great offence to many when broadcast on an early evening television programme featuring an interview with The Sex Pistols punk band in the United Kingdom in 1976.
 - The practice of broadcasting services in the United Kingdom in deciding the appropriateness of language is a good indication of which words and expressions are likely to cause offence to the British public.
 - A list of ‘Seven Dirty Words’(later extended to ten) that were prohibited from use in the broadcasting media in the United States was drawn up by George Carlin and gives an indication of which words would be most offensive to an English-speaking public. The word ‘screw’ does not appear on the list.
- 9 On 30 May 2006 the appellant informed the Board that SCREW YOU had been registered in the United Kingdom on 28 April 2006 for the following goods:
 - Class 10 – Condoms.
 - Class 32 – Beers, minerals and aerated waters and other non-alcoholic drinks, fruit drinks, and fruit juices, syrups and other preparation for making beverages.

Reasons

- 10 The issue to be decided is whether the application to register SCREW YOU as a trade mark in respect of the goods listed at paragraph 1 above should be refused pursuant to Article 7(1)(f) CTMR.
- 11 Article 7(1)(f) CTMR prohibits the registration of ‘trade marks which are contrary to public policy or to accepted principles of morality’. By virtue of Article 7(2) CTMR, the grounds of non-registrability set out in Article 7(1) do not have to exist throughout the EU; it is sufficient if they ‘obtain in only part of the Community’. In the present case it is implicit in the contested decision that the term SCREW YOU is objected to mainly because of the way that it is likely to be perceived in the United Kingdom and Ireland. The registration of SCREW YOU as a trade mark for certain goods in the United Kingdom is therefore a relevant consideration but it is not decisive. The Board is not bound by the decision of a national trade mark authority but must make its own assessment on the basis of its best understanding of the relevant legislation.

The rationale behind Article 7(1)(f) CTMR

- 12 The provisions of Article 7(1)(f) CTMR mirror those of Article 6 *quinquies* B(3) of the Paris Convention of 20 March 1883 (as revised at Stockholm on 14 July 1967), which provides for the refusal of trade mark applications and the invalidation of registrations where trade marks are ‘contrary to morality or public order’.
- 13 The question whether a trade mark can be registered under Article 7(1)(f) is separate from the question whether it can be used. No provision of the CTMR (or of Community law in general) says that a trade mark which has been refused registration under Article 7(1)(f) cannot be used; that is essentially a matter for national law. Conversely, when the Office decides to accept a trade mark that is in dubious taste, the mere fact that it has been registered as a CTM does not mean that its use cannot be prohibited in the Member States, for example under the laws on obscenity. Article 106(2) CTMR expressly safeguards the right to prohibit the use of a registered CTM under the civil, administrative or criminal law of a Member State. It follows that the purpose of Article 7(1)(f) is not to identify and filter out signs whose use in commerce must at all costs be prevented; rather 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 civilised society.

The application of Article 7(1)(f) CTMR: a balancing exercise

- 14 The wording of Article 7(1)(f) CTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to be confronted with disturbing, abusive, insulting and even threatening trade marks.
- 15 If the provision is interpreted too widely, so as, for example, to include anything which a section of the relevant public is likely to find offensive, there is a risk that commercial freedom of expression in relation to trade marks would be unduly curtailed. While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration because the Office regards them as immoral or offensive in the eyes of the public.
- 16 It is also necessary to have regard to Article 10 of the European Convention for the Protection of Human Rights and Fundamental Freedoms ('ECHR'), which provides:
- ‘(1) Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.
- (2) The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.’
- 17 The right to freedom of expression embodied in Article 10 ECHR includes commercial expression and is subject to limitation only for specific purposes, which include the prevention of disorder and the protection of morals (see *Casado Coca v Spain* (1994) 18 EHRR 1, paragraphs 33-37).
- 18 If the Office construed Article 7(1)(f) too narrowly, by for example refusing to register only those signs which violate the criminal law, the Office would effectively abrogate its responsibility to ensure that the privileges of trade mark registration are not extended to trade marks which are deeply offensive,

disgusting and potentially capable of causing outrage, but whose use is not actually prohibited under national law. It would also amount to ignoring the spirit of the provision, which refers to ‘accepted principles of morality’. Article 7(1)(f) clearly imposes a duty on the Office to exercise a degree of moral judgment in assessing the suitability of signs to be granted trade mark protection.

- 19 It can be extremely difficult to ascertain when a sign crosses the boundary from being merely irreverent or distasteful to being seriously abusive and likely to cause deep offence. Signs which contain slightly rude words or mild sexual innuendo might not be refused, but signs which contain manifestly profane language or depict gross obscenity have no place on the register. An example of the former is to be found in Case R 111/2002-4 DICK & FANNY. By the same token, signs which invoke, for example, what most people would consider to be mildly pejorative terms such as ‘Pommy’ or ‘Yank’ ought to present no bar to registration under Article 7(1)(f), whereas obviously malevolent racial and cultural slurs, whether by word or pictorial representation, should not be allowed on a trade mark register.
- 20 Signs which severely offend the religious sensitivities of a substantial group of the population are also best kept off the register, if not for moral reasons, at least for reasons of public policy, namely the risk of causing public disorder. Few would question that signs which appear to glorify terrorism or offend the victims of terrorism should not be registered: see, for example, Case R 176/2004-2 BIN LADEN.
- 21 In deciding whether a trade mark should be barred from registration on grounds of public policy or morality, the Office must apply the standards of a reasonable person with normal levels of sensitivity and tolerance. The Office should not refuse to register a trade mark which is only likely to offend a small minority of exceptionally puritanical citizens. Similarly, it should not allow a trade mark on the register simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. Some people are easily offended; others are totally unshockable. The Office must assess the mark by reference to the standards and values of ordinary citizens who fall between those two extremes. It is also necessary to consider the context in which the mark is likely to be encountered, assuming normal use of the mark in connection with the goods and services covered by the application. If the goods are of a type that are only sold in licensed sex shops, a more relaxed attitude may be appropriate. If the goods are likely to be advertised on prime-time television or worn in the street with the trade mark prominently displayed, a stricter approach may be justified. It is also necessary to bear in mind that, while broad-minded adults may enjoy bawdy humour in a particular context, they might not wish to be exposed to material with explicit sexual content when walking down the street or watching television in the company of their children or elderly parents.

The mark applied for

- 22 In the present case, the sign falls within the domain of vulgarity, insult and profanity. The question is, just how vulgar, insulting and profane is the expression SCREW YOU in the English language? Both as a verb and as a noun, the word ‘screw’ has entirely innocent meanings. It is, however, one of a number of coarse terms used in the English language to refer to copulation. The *New Shorter Oxford English Dictionary* lists the verb ‘screw’ as a synonym of ‘fuck’ and describes the expression as ‘coarse slang’. According to *Webster’s Third New International Dictionary*, the word is ‘usually considered vulgar’ when it has the meaning ‘copulate’. The *Cambridge Advanced Learner’s Dictionary* has a specific entry for ‘screw it/you/them, etc.’. It describes these expressions as ‘offensive’ and says that they are ‘used when expressing extreme anger or annoyance’. According to *Collins Cobuild English Dictionary*, some people use expressions such as ‘screw you’ to express contempt for someone. The dictionary says that the expression is ‘rude and offensive’ and that its use should be avoided.
- 23 The appellant has argued that SCREW YOU is less offensive and insulting than the term ‘fuck you’, which is undoubtedly true, despite the fact that both terms convey the same abusive message and employ the same sexual connotation. It is also fair to say that society has altered to the point where public swearing and cursing is now generally more acceptable than it was 20 or 30 years ago. Certain expressions that would never have been intentionally broadcast on prime-time British television a few decades ago are now considered permissible and for that reason it has been possible to use the term SCREW YOU on the popular early evening British television soap ‘EastEnders’ and on the American animated show ‘The Simpsons’ when broadcast in the United Kingdom.
- 24 It is significant, however, that as a matter of public policy, freedom of artistic expression is regarded as a higher priority than freedom of commercial expression and consequently it is more fiercely protected. The use of profanities in the name of art and literature is circumscribed with great reluctance in democratic and open societies. The same is true in relation to expressing opinions. A militant atheist may write an article for public consumption ridiculing religion, for example, and the State will not intervene. But a trade mark mocking, or exploiting the name of, the founder of a major world religion might none the less be kept off the register: see the decision of 18 January 2005 of Mr Geoffrey Hobbs, as Appointed Person, concerning an application to register JESUS as a trade mark (www.patent.gov.uk/tm/legal/decisions/appeals2005.htm).
- 25 Therefore, the fact that the term SCREW YOU is occasionally heard spoken on British television programmes at family viewing times is not decisive when assessing the level of offence it may cause the public or determining whether the degree of displeasure felt by the public would be greater when repeatedly exposed to the term through advertisements.
- 26 The term SCREW YOU is undoubtedly a profanity. It is an insult which would cause hurt to anyone on the receiving end of it (unless, perhaps, it were clearly

spoken in jest). It may not be the coarsest term in the English language but it is none the less a vulgar interjection which uses sexuality for the purpose of expressing contempt and loathing. It is probable that a substantial number of citizens with a normal level of sensitivity and tolerance would be upset by regular commercial exposure to the term. This is especially so for parents with young children and for the elderly, who may well have grown up regarding such expressions as deeply unpleasant, not to say disgusting. In the Board's opinion, a substantial proportion of ordinary citizens in Britain and Ireland whose values and standards are representative of society as a whole would find the words SCREW YOU offensive and objectionable, especially if they encountered them as a trade mark in ordinary shops to which children have access, or if they were advertised on television at a time when children were likely to be watching or if they were displayed prominently on clothing worn in the street or visible in shop windows.

The goods applied for

- 27 The goods listed in the application under Classes 9, 25, 28 and 33 are ordinary items marketed in outlets used by the general public. The use of the trade mark SCREW YOU in relation to such goods would inevitably cause a significant section of that public to be upset and affronted. The Board therefore upholds the examiner's objection in relation to those goods.
- 28 As regards 'artificial breasts' in Class 10, the appellant has not distinguished between the type of artificial breasts that are normally sold exclusively in sex shops and the type of artificial breasts that might be purchased by women who have undergone a mastectomy. The use of an offensive term such as SCREW YOU in connection with the latter type seems particularly objectionable. Similarly, as regards 'breast pumps' in Class 10, the appellant has not distinguished between the type of pump that is used for the purpose of stimulating lactation and the very different goods used to cause sexual arousal. SCREW YOU is clearly not an appropriate trade mark for the first type of pump.
- 29 In relation to artificial breasts and breast pumps of a type that is normally sold exclusively in sex shops, the Board considers that the relevant consuming public is unlikely to be perturbed by the use of the term SCREW YOU as a trade mark. The same reasoning applies to 'sex toys (vibrators, dolls)', which are likely to be found only in sex shops or on web sites specialising in sex products. A person who enters a sex shop or visits a web site devoted to sex products is, by definition, unlikely to be offended by a trade mark which contains crude, sexually charged language. Condoms are of course now sold in supermarkets and advertised on television, though not at a time when children are likely to be watching. A person who is sufficiently interested in such items to notice the trade marks under which they are sold is unlikely to be offended by a term with crude sexual connotations.

Conclusion

- 30 For the above reasons the Board dismisses the appeal in relation to the goods in respect of which coverage is sought in Classes 9, 25, 28 and 33. The appeal is allowed in respect of ‘condoms, contraceptives, sex toys (vibrators, dolls)’. The application may also proceed as regards ‘artificial breasts’ and ‘breast pumps’ in Class 10, provided that the specification is modified so as to cover only artificial breasts and breast pumps of a type that is normally sold exclusively in sex shops.

Order

On those grounds,

THE BOARD

hereby:

- 1. Upholds the appeal as regards ‘Condoms, contraceptives, sex toys (vibrators, dolls)’ in Class 10;**
- 2. Declares that the CTM application may proceed in respect of ‘artificial breasts’ and ‘breast pumps’ in Class 10, provided that the specification is modified so as to cover only artificial breasts and breast pumps of a type that is normally sold exclusively in sex shops;**
- 3. Dismisses the appeal as regards the remainder of the goods applied for.**

P. Maier

D.T. Keeling

Th. Margellos
(Article 6 Commission
Regulation (EC) No 216/96)

T. de las Heras

D. Schennen

G. Humphreys

W. Peeters

Ph. von Kapff
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Regulation (EC) No 216/96)

U. Wennermark
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Regulation (EC) No 216/96)

Registrar:

E. Gastinel

(Article 6 Commission Regulation
(EC) No 216/96)

(Article 6 Commission Regulation
EC) No 216/96)