

On one view, Arnold L.J.'s decision on partial invalidity signals to brand owners that, under the CJEU's bad faith test, specifications like "computer software" might not be tolerated. But whether this does enough to deter companies from filing broad specifications or, once registered, from using trade marks purely as a "legal weapon" is questionable. In this case, the factual findings against Sky were serious, revealing a deliberate strategy of making trade mark applications so that they could subsequently be wielded against third parties in threatened or actual legal proceedings. However, the only consequence flowing from this conduct was that its registrations were eventually whittled down in court insofar as bad faith could be proved. Time will tell whether this continues to be the approach taken in bad faith cases. From a UK perspective, the CJEU judgment binds domestic courts and tribunals for the time being, despite the UK's withdrawal from the EU. However, the position could well change in the future pursuant to the European Union (Withdrawal) Act 2018, s. 6 (as amended by the European Union (Withdrawal Agreement) Act 2020, s. 26), especially if bad faith is considered by the Supreme Court.

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"FACK JU GÖHTE": OR WHEN IS A TRADE MARK OFFENSIVE?

THE question raised in Judgment of 27 February 2020, *Constantin Film Produktion GmbH v EUIPO*, Case C-240/18, EU:C:2020:118, is whether it is possible to assume that people, in this case relevant average consumers in the EU, will have shared moral values or whether what people find immoral at any particular time and place can be ascertained only empirically. The question arises because Article 7(1)(f) of Council Regulation (EC) No 207/2009 (OJ 2009 L 78 p.1) ("TMR 2009") (now Council Regulation (EU) No 2017/1001 (OJ 2017 L 154 p.1) ("TMR 2017")) presents an absolute bar to registration of trade marks which are contrary to "accepted principles of morality". And this applies even if the ground for refusal obtains in only part of the EU (TMR 2009, Art. 7(2)). *Constantin* was the first case to offer the CJEU the opportunity to clarify the legal test for determining whether a trade mark offends against morality.

The facts of *Constantin* are these. In 2013, a film entitled *Fack Ju Göhte*, a deliberate misspelling of "Fuck you, Goethe", opened in Germany. The film, a comedy, followed the misadventures of a reformed bank robber at a chaotic German high school. The film was the most popular of its year and second and third instalments followed which have been seen by many millions of people. In 2015, the producer, Constantin, filed an

application for registration of the words “Fack Ju Göhte” as an EU trade mark for a wide range of goods and services. The application was denied by the European Intellectual Property Office (EUIPO) on the grounds set out in Article 7(1)(f). The applicant unsuccessfully appealed to the Board of Appeal (BA) and the General Court (GC) and eventually and successfully to the CJEU.

According to the BA of the EUIPO’s decision of 1 December 2016, R 2205/2015-5, the relevant public whom the sign would address were German speaking consumers in the EU. The Board took the view that this group would understand “Fack ju” as “Fuck you” and that even if the term had no sexual connotations nonetheless the relevant public would see it as “an insult in bad taste, shocking and vulgar” (at [26]). The Board did not believe the offensiveness of the sign was mitigated by the addition of the word “Göhte”. Indeed to the contrary. According to the Board, “the fact that a writer as respected as Johann Wolfgang von Goethe was insulted posthumously in such a degrading and vulgar manner, and, moreover, with incorrect spelling, did nothing to temper the character of the insult. Rather, it could constitute an additional level of breach of acceptable principles of morality” (at [31]). The GC agreed: Judgment of 24 January 2018, T-69/17, EU:T:2018:27.

Before the CJEU, the applicant argued that the words, “fuck you” were no longer perceived as vulgar and that other trade marks including the word “fuck” had been registered. Further, the GC had not been cautious or objective enough in applying Article 7(1)(f) and this raised the possibility that a mark may be denied registration because it was “not to the personal taste of the person carrying out the registration” (at [25]). This was true not least because the GC reached its decision in an abstract manner and not through an empirical examination of the actual perception of the relevant public. The CJEU’s decision was in two parts. The first set out to establish an authoritative general test for applying Article 7(1)(f). The second was a final judgment on the case, as was allowed to the CJEU by Article 61 of the Statute of the Court of Justice of the EU (2016 OJ C 72, 89).

The CJEU first explained that “accepted principles of morality” refer to the “fundamental value and standards” of a society. In assessing objectively what those are at any given time it was necessary to take account of the “social context” and all the elements “specific to the case” and where appropriate differing “cultural, religious or philosophical diversities” (at [39]). To judge a sign against these standards, it was necessary to base an examination on the “average thresholds of sensitivity and tolerance” in the relevant part of the EU, taking into account the context in which the mark may be seen, and other elements such as legislation and administrative practices, public opinion and how the public might have reacted to other similar signs (at [42]). On that basis the GC had been wrong to confine itself to an abstract assessment of the mark. When looked at

concretely, relevant factors in favour of registration were the comedy's success among German speakers, that there had been no public controversy surrounding its title, that the film was approved for young people and that the Goethe Institute used the film as an educational tool. It followed that the German speaking public do not see the mark as morally unacceptable. As a result, the CJEU held that both the decisions of the BA and the GC should be overturned.

The CJEU considered another important issue raised by the application of Article 7(1)(f): that is the potentially fraught relationship between trade mark protection and freedom of expression. In its submission to the CJEU, the EUIPO argued that that the exclusive right granted by trade mark registration is to ensure undistorted competition and not freedom of expression (at [33]). And while the title of the film might be protected by freedom of expression this was not true of its use as a brand. The CJEU disagreed (at [56]). Freedom of expression must be taken into account when applying Article 7(1)(f) and this is corroborated by Recital 21 of the TMR 2017 which states that the TMR should be interpreted in such a way that ensures full respect for fundamental rights and freedoms, in particular freedom of expression. Interestingly, the balance between trade mark protection and freedom of expression was recently the subject of two Supreme Court decisions in the US. Clause §1052 of the Lanham Act prohibited the registration of a sign which "consists of or comprises immoral, deceptive, or scandalous matter" or that disparages, inter alia, any persons or belief. In *Andrei Iancu v Erik Brunetti* (2019) 139 S. Ct. 2294, the Supreme Court struck down the immorality exception on the basis that trademarks are private speech and as such the First Amendment freedom of speech clause applies. In the earlier case, *Matal v Tam* (2017) 137 S. Ct. 1744, the Court had taken a similar approach to the disparagement provisions.

There are other ways, too, that *Constantin*, while setting a standard for interpreting Article 7(1)(f), might differ from national approaches to the issue, and may need further clarification. For example, the Trade Mark Manual of the United Kingdom Intellectual Property Office notes in relation to section 3(3)(a) of the Trade Marks Act 1994 (equivalent to Art. 7(1)(f)) that where a sign causes outrage, this must be attributed to an identifiable section of the public, while allowing that "a higher degree of outrage amongst a small section of the public will be sufficient to raise an objection, just as a lesser degree of outrage amongst a larger section of the public will also suffice". This approach differs from EU decisions before *Constantin*. In its 2006 decision, *Application of Kenneth (trading as Screw You)*, Case R 495/2005-G, [2007] E.T.M.R. 7), the Enlarged Board of Appeal of the EUIPO held that in deciding whether a mark was offensive it was necessary to apply the standards of "the reasonable person with normal levels of sensitivity and tolerance" (at [21]), who falls in between a minority who might

be exceptionally outraged and a minority whom it is difficult to offend. In *Constantin*, the CJEU apparently rejected the approach taken in the “Screw You” decision, when it says the context of a sign’s use includes where appropriate the cultural, religious and or philosophical diversities which characterise that context. However, by identifying the importance of ascertaining the perception of average consumers for the relevant goods or services, it remains to be seen whether the CJEU test will enable the views of minority groups, be they defined by religion or culture, who would not on principle be consumers of goods or services carrying the mark, to determine whether it is offensive. This is especially the case because in the *Constantin* application, where the goods and services were wide enough to cover a multitude of goods from soaps to toys, the relevant consumer would undoubtedly be the majority of consumers. And offence taken to the word “fuck” would presumably not be linked to any particular, identifiable minority group. However, this will not always be the case. For example, in the UK case, *Pooja Sweets & Savouries Ltd. v Pooja Sweets Ltd.* [2015] 2 WLUK 243, the applicants sought to register the mark “Pooja Sweets and Savouries”. Opponents claimed the sign was offensive as “pooja” is a “sacred term” describing a form of Hindu worship. The challenge failed. The Appointed Person held that observant Hindus as well as the wider population of consumers for the goods in question would not find use of the word “pooja” offensive. Nonetheless the judgment leaves open the possibility that, if the mark had been offensive only to observant Hindus, a small minority of the population, it would not have been registrable. Arguably, post-*Constantin*, the EU response in a similar situation remains unclear.

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#### UNREGISTERED RELIGIOUS MARRIAGES ARE NEITHER VALID NOR VOID

IN *Her Majesty’s Attorney General v Akhter & Anor* [2020] EWCA Civ 122, the Court of Appeal confirmed that unregistered religious marriages are to be regarded as “non-qualifying ceremonies” which are outside the scope of marriage legislation. This means that the parties will be unable to seek the financial remedy provision available to married couples on relationship breakdown pursuant to the Matrimonial Causes Act 1973. The judgment reversed the decision of Williams J. at first instance, in *Akhter v Khan* [2018] EWFC 54, which applied what His Lordship called a “holistic” and “flexible” approach to hold that an unregistered religious marriage could be treated as a void marriage and be entitled to financial