

## V. Moral thresholds – case law

### *Introduction*

This chapter has two main components. Part A builds on the discussion of taxonomies in Chapter II and the idiosyncrasies of the GCC trademark system in Chapters III and IV, to present a harm-based taxonomy for immoral trademarks. Part B tabulates a small selection of GCC trademark decisions to expose thresholds<sup>376</sup> and provides brief insights where possible.<sup>377</sup> The chapter does not present a comprehensive review of GCC case decisions due to a lack of accessible data.

### *A. Harm taxonomy*

This paper discussed current classifications of immoral trademarks in the literature.<sup>378</sup> Their limitations can be overcome by a two-layered taxonomy (Figure 4); it distinguishes the methodological task from the interpretative task to avoid logic overlaps and construes the censurability of the trademark as the type of harm to which it contributes or causes.<sup>379</sup> This concept of ‘harm’ is employed as both a lens and a tool, to understand the social concerns that can be triggered by certain improper words/signs. It may also serve legal discussion of the sufficiency of a sign’s impropriety to warrant state intervention. In this way, the taxonomy offers a ‘language’ grounded in harm, to improve alignment across jurisdictions in the treatment of this legislative area.

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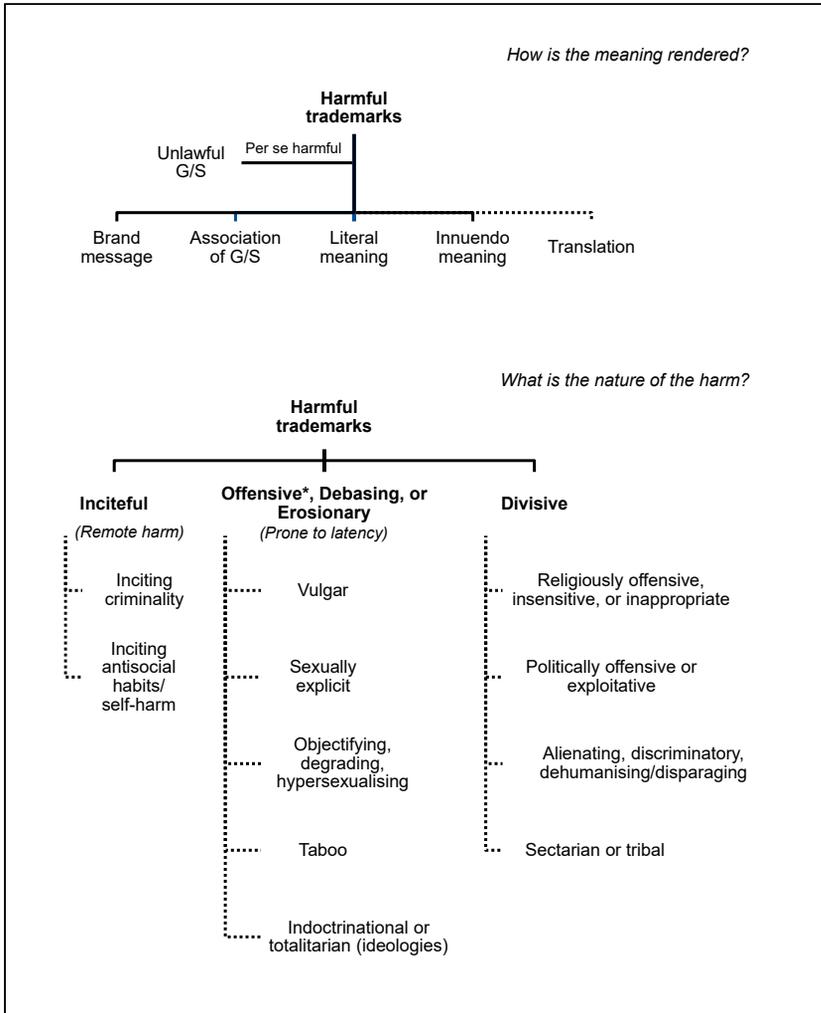
376 Thresholds operate at the second level (interpretative level) of the schematic.

377 Literature on trademark registration decisions is lacking in the GCC region, making it a very difficult-to-research jurisdiction. Nevertheless, this paper has attempted to draw out some idiosyncrasies in decision records.

378 See Chapter II(C)(III).

379 Contributory is used in relation to indirectly causing an act or series of acts (behaviour) by incitement (the direct harm is the resultant crime); causal is used in relation to directly evoking passive emotions (the harm is not physical).

Figure 4: New classification and taxonomy based on the concept of harm.



**INCITEFUL**

- **Inciting criminality:** e.g. violence, theft, rape, sedition. Contrary to law and order.
- **Inciting antisocial habits/self-harm:** e.g. suicide, anorexia. Harmful to public health or social integration.

**OFFENSIVE, DEBASING, OR EROSIONARY**

- \*Offensive means seriously morally offensive, suppresses human dignity, debasing, demoralising.
- **Vulgar:** harmful to societal values and personal dignity
  - **Sexually explicit:** harmful to societal values and personal dignity
  - **Objectifying, degrading, hypersexualising:** harmful to girls/women/those subject to hypersexualisation
  - **Taboo:** harmful to inviolable/protected values.
  - **Indoctrinational or totalitarian:** fanatical ideologies harmful to society and human dignity.

**DIVISIVE**

- **Religiously offensive, insensitive, or inappropriate:** harmful to religious sensitivities, tolerance and security
- **Politically offensive or exploitative:** harmful to political harmony and co-existence
- **Alienating, discriminatory, dehumanising/disparaging:** harmful to minority, marginalized, disempowered groups
- **Sectarian or tribal:** harmful to tribal identity and sovereignty, protection of religious sects.

*Nature of the harm.* Three categories of harm are proposed: [1] The first category is ‘remote’ or ‘direct’ harm and comprises “inciting trademarks“ (trademarks **remotely connected [contributing] to the commission of a direct harm**, by incitement). Trademarks in this category threaten public safety, national security, and individual integrity and wellbeing. They are linked to behaviour. Thus, it is a public order category. With regard to tangible harm, there is a close connection. [2] The second category comprises “offensive, debasing or erosionary trademarks” that threaten to indirectly undermine moral values in society. Under this category, the desire to protect public morality is sufficient and no subsequent act/direct harm is necessary. However, this does not preclude the ability of such marks to perpetuate dangerous narratives and once ubiquitous, lead to direct harm. Latency, therefore, is a critical element in considering the harmfulness of such marks. Indeed, this harm may be more insidious. With regard to tangibility of harm, there is a loose, fragile connection. [3] The third category is a public order and social norm category. This category of trademarks is harmful to social cohesion and tolerance. These are “divisive trademarks”. The harm relates to the ability to undermine societal values of tolerance and unity, with respect to religious, tribal, political, personal and

other group affiliations and identity. Additionally, it is a morality category because the marks can be linked to offense against specific moral principles. UK courts have stated that the discrete moral principle that is offended against should be identified.<sup>380</sup>

## 1. Inciting trademarks

*Direct harm* is a public order category.<sup>381</sup> It links the trademark to a person's decision to commit a direct harm; that harm being a crime or engagement in antisocial/deleterious behaviour. Intervention is justified for the prevention of disorder and crime, and the safeguarding of public health and national security. There are two subcategories: (i) 'incitement to criminal activity' and (ii) 'incitement to antisocial habits.' When the imputation of the sign constitutes a criminal offence, it falls within the former subcategory. The latter subcategory covers suggesting or promoting harmful, deleterious activity that is not strictly unlawful. In some societies, a word may fall under a taboo, in other societies it may fall here. A trademark for a pro-anorexia website would fall under the scope of antisocial habits. A downstream extension of this logic is tobacco plain packaging legislation (censure based on the deleterious impact on health), smoking being neither illegal nor taboo. It is a truism that conduct may be both taboo and legally circumscribed.

## 2. Offensive, Debasing or Erosionary trademarks<sup>382</sup>

This category pertains to indirect harm and latency. Trademarks are harmful when, rather than inciting commission of a direct harm, they a) challenge human dignity, propriety or social identity and/or, b) perpetuate, cumulatively and over time, the erosion of society's moral values. According to this category, trademarks are censurable because they are seriously morally offensive such that they deliver an assault on personal dignity. But it goes further and proposes a 'risk' of more significant societal harm (and

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380 *Basic Trademark* (n 9).

381 See discussion of public order in Chapter II, Part C.

382 Turner discusses levels of identity: core, social, group, role. Jonathan H. Turner, 'Revolt from the Middle. Emotional Stratification and Change in Post-Industrial Societies' (2017 Routledge).

potentially direct harm) when latently harmful trademarks accumulate and gradually exert an undermining effect on values. This follows “slippery slope” consequentialist logic.

*Indirect harm* is defined for the purposes of this taxonomy as: an instant affront to moral feelings, sense of propriety, or sense of security and dignity. It is evoked by gratuitously vulgar or sexually explicit signs.<sup>383</sup> This category is closest to and takes inspiration from U.S. trademark law’s ‘scandalous’ matter. It differs by arguing for personal dignity as a right; more concretely, as a moral right to be free from insult.<sup>384</sup>

*Latent harm* is defined for the purposes of this taxonomy as proliferation and accumulation of signs over time, with the potential to lead to collective harm in the form of erosion of values, esteem, and connected behaviours or subcultures. This type of harm is potential, non-obvious and non-explicit;<sup>385</sup> it follows that applying a concept of latency incurs risks, notably that a) the harm (impact of the meaning) is not predictable at the time, b) once discovered, causation is difficult to establish and c) because it is by definition delayed, it becomes too late to correct.

There are five sub-categories:

- (i) Vulgar
- (ii) Sexually explicit<sup>386</sup>
- (iii) Objectifying or degrading
- (iv) Marks relating to a taboo: normalizing a taboo
- (v) Indoctrinational or totalitarian (ideologies)

An example of a registered trademark that objectifies women is SLUT.<sup>387</sup> A trademark that is degrading would be, for example SLUTS STAY IN THE KITCHEN (fictional). Both are misogynistic and harmful to the social identity of women. US-registered trademarks SHANK THE B!T@H<sup>388</sup> and DIRTY WHOOOORE CLOTHING COMPANY<sup>389</sup> have no place on the

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383 The adjective ‘gratuitous’ denotes that the context of the particular goods/services cannot justify the word/does not negate its impact on the consumer as vulgar or explicit. This suggested addition would allow the sign “SCREW YOU” to be registered for sex toys, for example. In the GCC, this qualifying term would probably be redundant. See Hansen on parody (n 12).

384 Gan Shaoping and Zhang Lin, ‘Human Dignity as a Right’ (2009) *Frontiers of Philosophy in China*, Vol 4(3), 370-384.

385 Collins English dictionary (latent).

386 See (n 401).

387 SLUT (EU trademark registered 18/07/2005) – 003705084.

388 <https://trademarks.justia.com/853/01/shank-the-b-t-85301216.html>

389 <https://trademarks.justia.com/857/23/dirty-whooore-clothing-85723806.html>

register according to the standards of objectification of women and of social identity.

The violation of a taboo evokes a particular sense of alarm amongst society. It is difficult to determine whether a trademark represents a taboo as it is subjective and standards change. Extra-marital affairs, for example, may no longer be a taboo in the West. The trademark “ASHLEY MADISON” and “ASHLEY MADISON LIFE IS SHORT HAVE AN AFFAIR” is a registered UK trademark and the former is a registered EU trademark. Therefore, the UK Registrar, following the UK Trade Marks Manual guidance, perhaps does not consider it to be more than unsavoury conduct in modern day Britain.

A taboo mark could be one that risked normalising anorexia, such as the name of a “pro-anorexia” website. A mark that promoted suicide could also fall under taboo since suicide is not a criminal offence. Generally, when a mark crosses the line from taboo to criminal offence will not always be clear-cut. In the GCC, suicide is a sin (*haram*), not a crime as such and no criminal sanctions are set out in Shari’a law unlike other conduct. However, because it is a sin in Islam, attempted suicide has been punished criminally.

By proposing a harm-based approach, it is not argued that the survival of society is at stake. Rather, it is proposed that it is difficult to separate commercial speech from behaviour, and that trademarks at least have the power to influence perspectives. Accordingly, the thesis is that a proliferation of certain trademarks has the capacity to impact the collective marketplace in positive and negative ways and some can be significantly negative (perpetuation of inequities, objectification of women, for example).

### 3. Divisive trademarks

This is a public order category by virtue of the power of certain trademarks to alienate or vilify group identities and to exploit or perpetuate political, religious, tribal, and ethnic enmity. It includes signs that may symbolise organized oppression,<sup>390</sup> perpetuate victimization,<sup>391</sup> or threaten the sense of

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390 For example, Case T-232/10 *Couture Tech Ltd v OHIM*; Case T 232/10 *Coat of arms of the Soviet Union*, EU:T:2011:498

391 For instance, “Je Suis Charlie” (application 1668521, and “BIN LADEN” application (R-176/2004-2) have both been refused by the EUIPO.

safety or group identity.<sup>392</sup> This is in keeping with U.S. case-law, which has held that the application of the U.S. Lanham Act disparagement clause was most suited to religious groups.<sup>393</sup>

This category may be most similar to the disparagement clause in U.S. trademark law, but, driven by the harm concept, it emphasises the objective of the censure: to prevent symbols, imagery or messages that sow division, discord and alienation.

There are four sub-categories:

- (i) Religiously offensive, insensitive or inflammatory
- (ii) Politically offensive, exploitative, or victimizing
- (iii) Alienating, discriminatory, dehumanising/disparaging
- (iv) Sectarian or tribal

#### B. Case examples – marks refused on morality or public order grounds in the GCC

The following GCC trademark decisions explore consistency of harm thresholds in the GCC region. EU cases are compared.

#### INCITING

Incitement to criminality or antisocial habits

Trademark	UAE	QATAR	SAUDI
“CRIMINAL”	Initially rejected (registered following appeal)	Registered	Registered

The undertaking Criminal Clothing Ltd. filed applications for “CRIMINAL” in the GCC countries. The application was rejected in the UAE for “violating the public morals or desecrating the public order.” The UAE officials subsequently accepted the mark having been persuaded by registration certificates of other GCC countries including Saudi Arabia.

Similar marks rejected in the EU for suggesting or encouraging illegal activity are “HAIKIA”, “STREAMSERVE”, “ILC I LOVE COCAINE”

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392 Turner (n 382).

393 As per the TTAB in *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1216 (T.T.A.B. 2010)).

“WORLDWIDE-STOLEN GOODS”, “WEED”, and “COPYCAT”<sup>394</sup> The fact that “CRIMINAL” was rejected in the UAE reveals a cultural difference. In the West, criminals may take on a mysterious, glamorous, misunderstood image (Bonnie & Clyde, the Kray twins, Hollywood films like *Goodfellas*). There have been registered trademarks for the music group “FUN LOVIN’ CRIMINALS”,<sup>395</sup> and for “BILLIE JEAN CRIMINAL”.<sup>396</sup> This romanticism does not generally exist in the GCC. Interestingly, Europe bans from the register trademarks that glorify terrorism or offend its victims.<sup>397</sup> Here, it is possible that even a single victim would suffice to trigger the prohibition.

In “MECHANICAL APARTHEID”, trademarks were said to have the ability to be “threatening”.<sup>398</sup>

This category of marks, like marks with religious connotation, engage the idea of ‘public order.’ The jump from morality to public order appears to be “gross obscenity” which begins to impinge upon founding values of a society.

Islamic criminal jurisprudence recognises antisocial behaviour and the notion of that behaviour spreading throughout society: “Fasad fi al-ard” means “to corrupt the earth and destroy beauty of its creation” (Qur’ān, 2:27, 5:32). Terrorisms falls here and there have been many Islamic fatwas

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394 HAIKA - 011610458; Judgement of 27 February 2002, STREAMSERVE, T-106/00; ILC I LOVE COCAINE – 013590948; WORLDWIFE-STOLEN GOODS – 013239827; WEED – 011953387; COPYCAT – 011870763.

395 001176361 (expired).

396 The mark is a reference to a Michael Jackson song. It is a cancelled EU trademark – 009297607.

397 The name of a terror group was banned in HAIKIA as contrary to public policy of the European Community. It was held that the fundamental values laid down in the CFR of the EU were precluded by absence of a right to life and to physical integrity. In this sense, terrorism strikes at these ‘precursor rights.’ The decision also suggests a presumption of public offence if such a trademark were registered; Offence to the victims was an express concern in MECHANICAL APARTHEID, see (n 310) [13], citing Case T 232/10, Coat of arms of the Soviet Union, EU:T:2011:498. “Signs that have no place on the register are certainly those which appear to glorify terrorism or offend the victims of terrorism (see 20.09.2011, T 232/10, Coat of arms of the Soviet Union, EU:T:2011:498).” In this cited case, the General Court upheld OHIM’s refusal to register the trademark on public policy and accepted principles of morality grounds. The General Court deferred to the relevant public in Hungary, for whom the sickle, hammer and five-point red star symbolizes despotism.

398 MECHANICAL APARTHEID (n 310) [11].

against terrorist acts.<sup>399</sup> This is perhaps a ‘collective marketplace’ nuance but in respect of criminal conduct.<sup>400</sup>

OFFENSIVE, DEBASING, EROSIONARY

Sexually explicit<sup>401</sup>

Trademark	UAE	QATAR	SAUDI
“RED HOT SEXY”	Rejected	Rejected	Rejected
“LA SENZA 24 SEXY”	Rejected	Rejected	Rejected
<b>KISSES</b>	Registered	Registered	<b>Rejected</b>
	Rejected	Registered	Registered
	Initially rejected. Registered following appeal.	Registered	Registered
“ZIP”	<b>Registered</b>	Rejected	Rejected
“ZIPPO”	Registered	Registered	Registered
Various marks containing “KISS” “KISSES”	Registered	Registered	Registered

In the case of “kisses”, “ZIP” and “ZIPPO”, it is the translated word that is offensive. This is in line with EU cases such as “FICKEN”, FICKEN Liquors and “AIRCURVE”.<sup>402</sup> However, in some cases the sensitivity of GCC officials is higher, as shown by the last two marks in particular. An immoral connotation was found in the back-to-back figures and the shape of the figurative mark presumably was suggestive of female reproductive organs.

399 See list of fatwas, rulings and authoritative statements against terrorism and related acts, according to the University of Melbourne’s National Centre of Excellence for Islamic Studies, available at: <http://arts.unimelb.edu.au/nceis/welcome/community-engagement/national-imams-consultative-forum/rulings-and-statements>

400 Note that Islamic criminal law recognises offences against persons (*Qisas*, e.g. murder, theft, rape) or God (*hudud*).

401 Note, as per the tabulated examples, that ‘sexually suggestive’ is sufficient to meet GCC thresholds.

402 FICKEN – 009924275, 009274366; FICKEN Liquors – 010142123; AIRCURVE – Case R 203/2014-2.

While the above marks are at the subtler end of the spectrum, there is a question to be asked for brands that fall into this category. In relation to the type of harm that may flow from such marks, the question is whether the risk posed by sexually suggestive or profane marks is mere offence or a greater sense of personal invasion or assault - both of which are rather fuzzy and intangible-, or whether the accumulation of certain marks (that “transmit a message”<sup>403</sup>) begin to imprint on societal values and actually undermine them in tangible, measurable ways. This is beyond the scope of this paper but worthy of further analysis.

## DIVISIVE

### Religious issues<sup>404</sup>

	Trademark	UAE	QATAR	SAUDI
1	“BUDDHA BEER”	Rejected	Rejected	Rejected
2	“CHURCH”	<b>Rejected</b>	Registered	Registered
3		Rejected	Rejected	Rejected
4		Rejected	Rejected	Rejected
5		<b>Registered</b>	Rejected (because of the Cross)	Rejected (because of the Cross)

Marks 3-5 were rejected for being similar to the symbol of the Red Cross and the Red Crescent. This is consistent with international convention. However, the UK would have allowed these marks because they are not in red and white. White crosses on green background symbolise first aid goods and services; black and white depictions are also acceptable.<sup>405</sup> The

403 *Dick Lexic’s Application* (n 9).

404 In the case of religious ‘symbols’, they fall under a separate provision not related to morality or public order. They are included here to demonstrate different thresholds.

405 Section 10.2 of the UK Trademarks Manual.

GCC rejections may indicate a reluctance to allow marks that resemble religious symbols in general. “CHURCH” for footwear was rejected in the UAE.

### *Conclusion*

This chapter introduced an alternative classification and taxonomy for trademarks falling under the morality and public order prohibition. It offered more granularity<sup>406</sup> and implicit recognition of subtle, progressive and cumulative infliction of harm. The classification framed and structured the public order and morality objection as a specific type or manifestation, of harm (divisive, erosional, inciting). It acknowledges a problem of imputation (whether the conduct of autonomous individuals can be imputed to messages conveyed by symbols and signs). Further, because approaching the regulation of offensive trademarks from the perspective of remote or intangible harm has problems, a conceptual tool built in reliance is necessarily imperfect. ‘Contingency’ and ‘causation’ are not the only hurdles: a concept of harm that is not linked to tortious or criminal (physical) injury is prone to extension and arbitrary application; the idea of future harm is also insufficiently concrete.

With respect to jurisdictional differences, GCC decisions understood in light of Constitutional language, confirm a stronger inclination towards preventing harm. Despite GCC trademark law harmonisation efforts, there being different decisions particularly in the case of signs with sexual connotation means uncertainty for global brand owners.

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406 For example, trademarks that objectify women are an additional sub-category, as well as trademarks that exploit tribalism or inflame sectarianism.