

IV. Dominant rationales in applying moral exclusions

Introduction

This chapter explores the reasons for efforts to prohibit the registration of immoral marks in the GCC, with jurisdictional contrast from Europe/UK and the U.S. In the absence of precedents and published reasoning in the GCC, there is some conjecture involved. The insights are drawn from opinions of local law firms, as well as independent analysis based on the literature canvassed in previous chapters of this paper. Part A discusses the rationales. Part B introduces a couple of interesting aspects of GCC practice in assessing trademarks.

A. Rationales

A survey conducted of five law firms in the UAE, Saudi Arabia and Qatar suggests that four main reasons (1-4) underlie examiner objections to offensive marks in these countries.²⁹⁴

1. *Concern that the public would be offended by the mark*
2. *Examiner directly applying the law without further thought*
3. *A deeper concern about the power of a mark to erode the morals of society*
4. *The State should not be seen to endorse such marks*
5. *The State should not spend its time or financial resources to support marks that are contrary to the values of society*²⁹⁵

294 With respect to Saudi Arabia, reasons 1 and 2 were highlighted. UAE respondents considered reasons 1, 2, 3 and 4 to be the most common. Qatari counsel highlight reason 3. At least two firms confirmed each of the reasons 1-4. **Disclaimer:** The insights are to be considered in light of three factors [1] they are based on subjective opinions of trademark attorneys and not the examiners or Trade Mark Office officials; [2] they are derived from a small sample size; [3] surveys were completed remotely and it is assumed that respondents understood the rationales and the differences between them. Further research should test these preliminary observations. It should also be noted that respondents were asked to select from five rationales, which constituted a closed list.

295 Reason “5” - that the state’s resources should not be wasted on such marks” - was not expressly confirmed by any respondents.

1. Concern that the public would be offended by the mark

This rationale concerns the *threshold* for public shock and offense. There are two elements to this threshold: (1) the intensity of the sense of affront, and (2) the breadth of its impact (proportion of the public affected). Intensity has been discussed elsewhere in this paper.²⁹⁶ Regarding breadth, the ‘relevant public’ is considered. If moral principles function as a bar to trademark protection, the question is whose principles matter and how many people need to share them in order to activate the prohibition.

The question of how a mark that offends a group of people will be treated is pertinent to the GCC context, particularly the main commercial and cultural cities of Dubai, Abu Dhabi, and Doha. Since Emirati and Qatari nationals are minorities in their countries, if examiners applied the EU/UK approach, they may consider a mark that offends only Emiratis or Qataris insufficient to trigger the prohibition. However, examiners in the GCC do not adopt this nuanced approach.²⁹⁷ If the examiner believes the mark will offend even a limited group, that will likely be sufficient for a rejection.²⁹⁸ Hence, the GCC seems to diverge with respect to both elements; the threshold is lower and an objection will probably be raised if there is a hint that offence could be caused to a small group/small percentage of the population. It may even be enough that the examiner alone is offended or knows people who would be.²⁹⁹ This stands in contrast to European/UK and US guidance for examiners/registrars who must set aside their personal opinions if it goes against an existing generally accepted moral code.³⁰⁰

It is not possible to say unequivocally whether examiners are as equally attuned to the sensibilities of other religions. The UAE, Qatar and Saudi Arabia are home to large populations of workers. The latter two groups come from countries like the Philippines, India, Nepal and Sri Lanka

296 See Chapter I.

297 The situation is potentially more complicated than this given that many of the non-nationals will also be Muslims from other Arab countries, South Asia etc. Thus, the Muslim population is considered to be a majority in these three states (very different from the Western contingents: 2.7% in the UK and 3.75% in the US - <http://islamicweb.com>). Despite this, whether or not offence is taken might still differ between Muslim groups: consider for example, an English-speaking Saudi Muslim, a non-English-speaking Nepalese migrant worker, a conservative Qatari Muslim and a Muslim from a secular country like Lebanon.

298 Survey responses.

299 Survey responses.

300 See, for instance, Richard Arnold QC, (n 191) at [37], citing Sir Nicolas Brown-Wilkinson V-C in case *Stephens v Avery* [1988].

where Hinduism, Buddhism, Christian (Roman Catholicism), are dominant religions. In Saudi Arabia, since there is no official recognition of other religions, it is not clear how strictly trademarks that offend Buddhism, Hinduism would be treated. In the GCC, an application for BUDDHA BEER was rejected on morality grounds due to the reference to Buddha.³⁰¹

If the Trade Mark Office is concerned with public offence, the possibility of changing attitudes among the public is relevant. There are differing views on whether there has been much change over the years in these Islamic countries. Some suggest a degree of change (notably UAE and Qatar),³⁰² however there is no corresponding change in the approach of trademark practitioners dealing with the fundamental morality, cultural and religious questions. In fact, in the UAE at least, examiners are being more cautious in accepting trademarks due to the increasing role of social media in publishing information.³⁰³

2. Direct application of the law

All respondents cited this rationale.³⁰⁴ It relates to the black and white approach taken by trademark officials in the GCC, notwithstanding that examiners have complete discretion to interpret the morality of marks.

While this rationale governs most decisions in the GCC, it does not in the US, Europe or other common law jurisdictions. There are a few reasons for this. The UAE, Qatar and Saudi Arabia's laws and legal institutions are built on the civil law system, specifically French civil law (Napoleonic code) inherited from Egypt.³⁰⁵ ³⁰⁶ ³⁰⁷ There is no system of binding precedent in civil law systems. Sharia, as well, lacks a binding precedent system.³⁰⁸ As such, decisions appear as short citations of the relevant legal

301 See Chapter V. It is not known whether the nature of the goods was at issue.

302 Survey responses.

303 Survey responses.

304 Survey responses.

305 See <http://www.tamimi.com/en/magazine/law-update/section-6/september-2/the-court-structure-in-qatar.html>.

306 Hansen (n 12), xxvii.

307 Saudi Arabia's trademark law of 1939 (promulgated by High Order No. 8762, of September 12, 1939) was based on The Egyptian Trademark Law of July 9 1939. Habachy, S. (n.d.). Protection of Trademarks and Patent Rights in the Middle East History, Geography and Economics.

308 Khoury (n 125) 197.

provision. The fact that the legal profession in these countries is very young may also smother the kind of judicial interest in testing the boundaries of the law that is common in Western (common law) jurisdictions.³⁰⁹

Another reason is that the GCC countries do not have freedom of expression guarantees. Countries that do, are more likely to develop tests and guidelines that allow them to conduct a balancing exercise of the competing interests. EU and UK IP offices, in cases including *MECHANICAL APARTHEID* and *JESUS*, often invoke the applicant's right to commercial speech under Article 10 of the ECHR and explain the limits on state interference with it.³¹⁰ The test applied in European jurisprudence is that the interference has to be justifiable ("prescribed by law and necessary in a democratic society"). Free speech rights dominated *THE SLANTS* case. Thus, having such guarantees lends itself to a more nuanced approach.

Hansen notes that the GCC takes a literal and strict approach to trademarks and goods/services that are contrary to Islamic principles.³¹¹ This means that the more nuanced aspects of Anglo-American case law are not present in trademark jurisprudence in the GCC. Trademark officials do not generally take into account the fact that a word is a parody.³¹² In contrast, the UK/EU and the U.S. give more leeway to parody and puns, in keeping with freedom of expression. Nor do decision-makers in the GCC always consider the positive intentions of an applicant. Some decisions suggest there is allowance for signs with an innocent connotation. Other decisions appear to reject this pleading. See discussion under Part B of this chapter.

The more black and white position of the GCC countries may also be partly due to the lack of any formal examination guidelines for examiners in the UAE, Saudi Arabia or Qatar.³¹³ or any regular formal training carried out for the examiners. Without clear standards for assessing whether a mark is immoral, violates public order, or is of religious nature, it is left entirely to the discretion of the examiners.³¹⁴

309 Hansen (n 12) xxix, with regard to the UAE legal profession observes that "the professions appear not to participate in any kind of disinterested activism for reform of laws and procedures"

310 *Mechanical Apartheid* R 2804/2014-5; *JESUS* (Basic Trademark n 9).

311 Hansen (n 12) 87. Although Hansen speaks of the UAE, the comment is applicable to the GCC as a whole, since the UAE is the most relaxed of the countries.

312 *ibid.*

313 One respondent indicates there may be some "standards" available from the Ministry of Commerce.

314 Survey responses.

In conclusion, the nuanced and publicised judicial reasoning of the common law systems and supranational law system of the EU (including civil law member states) lends itself to the development of sophisticated legal tests. The impact of Shari'a law in the GCC has created a more literal approach to regulation. Decisions normally just cite the legal provision. On the one hand this benefits applicants if decisions can be easily anticipated. However, when there is little balancing of interests traders might lose out to the public interest more than they would elsewhere.

3. A deeper concern about the power of a mark to erode the morals of society

In the Chapter III analysis, it was seen that the constitutions of the GCC states convey a paternal concern towards protecting society from decay. Trademarks rejected on morality grounds cannot be used in the GCC. This signifies a clear-cut approach to preventing immoral trademarks from flowing into society. Penalties for use of rejected marks are a fine and imprisonment.³¹⁵ U.S case law has expressly mentioned the notion of “*in-jury*”³¹⁶

Surprising rejections. Some decisions to refuse to register a trademark can be unexpectedly strict. As discussed in Chapter III, the GCC states apply Shari'a in prohibiting certain Nice Classes and some products and services within allowed Classes. Trademarks for alcoholic related goods and services are proscribed under Shari'a law. Each country regulates its own trademark. Saudi Arabia differs from its neighbours in a few ways. As the most conservative state, it has a higher sensitivity to immoral marks compared to its neighbours. Another difference is that it is common for Shari'a principles to be applied by Saudi courts hearing appeals. If a mark is rejected, the applicant has 60 days to file an appeal with the Trade Mark Office. If the Trade Mark Office dismisses the appeal, the applicant has another 60 days to file an appeal with the Administrative Court in Riyadh. Decisions of the Administrative Court can be appealed to the Administrative Court of Appeals.³¹⁷ However, appeals are not common as applicants consistently

315 UAE Trademark Law: a fine of up to AED10,000 (equivalent to about USD \$2,800) and/or up to one year in prison.

316 Oswald (n 151).

317 Survey responses.

choose to abandon the application and adopt a different mark, rather than go through appeal proceedings.³¹⁸

The Shari'a principles most often cited by the courts are: (1) there should be neither harming nor reciprocating harm, (2) deception and anything that may mislead the people is forbidden, (3) damage and any excuse for corruption should be avoided. Saudi courts have applied the "no harm" principle ((1)), to reject registration of tobacco products, reasoning that because tobacco is harmful to one's health, it is forbidden. This upstream interference with trademark rights for public health reasons can be compared with the downstream brand restrictions by countries like the UK and Australia with Plain Packaging legislation.³¹⁹ If efforts to block registration of tobacco products were successful, it could encourage challenge under Article 7 of the Paris Convention since the sale and distribution of tobacco products are permitted. However, the courts have also cited fatwas (religious legal opinion)³²⁰ declaring tobacco to be forbidden. Notwithstanding the preceding, the Saudi Trade Mark Office routinely registers trademarks for tobacco products as do the Trade Mark Offices of Qatari and the UAE.

4. The government should not provide official sanction to offensive marks

Commentators citing this reason include Wasserman,³²¹ Kelber,³²² and Oswald.³²³ Kelber says federally registered marks carry "implied approval" of the government. Wasserman makes a strong argument that federal registration of pornographic trademarks perpetuates harmful discourse and subordination: "registration of these trademarks both amounts to a government-

318 Survey responses.

319 The UK introduced Plain Packaging legislation in 2017, Australia did so in 2012.

320 Fatwas are issuable in Saudi Arabia by qualified persons, these being approved religious scholars associated with the Council of Senior Ulema (per Royal Decree in August 2010, issued by the late King Abdullah (predecessor to current King Salman)). Ansary, D. A. F. (2008). A Brief Overview of the Saudi Arabian Legal System, 12. Available at: http://www.nyulawglobal.org/globalex/saudi_arabia.htm

321 Wasserman (n 22) 6.

322 Bruce C. Kelber, 'Scalping the Redskins: Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?' (1994) 17 Hamline L.Rev. 533, 560-61.

323 Oswald (n 151).

tal sanction of the goods and/or services the trademark represents, and works to undermine the nation's normative commitment to equality by assisting those who profit from sexual and racial subordination".³²⁴ If courts/public bodies hold power to change societal prejudices, the correct application of morals bars is all the more important. If that power exists, then arguably the decisions of trademark officials should prioritise public policy goals over other interests. There are perhaps two subtle aspects to this rationale (rationale 4); it concerns: [1] the proper role of public bodies, and [2] the power that a particular judicial stance can have on moral and social norms. In defamation law, the courts have to consider the moral views of the time to understand if a particular imputation would lower someone's reputation and esteem. As noted earlier, judges in the common law tradition interpret and apply the law, and increasingly in a human-centric way to be consistent with the ECHR. Lo argues that the law has "limited effectiveness....to change societal prejudices" so individual needs should prevail.³²⁵ This is not persuasive. Even if social prejudices trail behind the law, it is important for the law to take the authoritative stance and send the message. Arguably the law can provide gentle coercion to principles held by the public and thus normalise harmful attitudes. But, UK courts have urged an almost impossible balancing act: in the *Hallelujah* trademark case, Mr. Myall articulated that a Registrar "must not remain isolated from the day-to-day world, frozen in an outmoded set of moral principles, he must equally not presume to set the standard. He must certainly not act as a censor or arbiter of morals, nor yet as a trendsetter."³²⁶

However, several cases have rejected the notion that trademark registration constitutes government approval of a mark (and the point of view it expresses). In *Falcon Sporting Goods AG v. FIIP*, the Swiss Federal Board of Appeal for Intellectual Property Rights (Board of Appeal) overturned a revocation by the Swiss Federal Institute of Intellectual Property (FIIP) of *BIN LADIN* and allowed registration on the basis that it does not amount to endorsement of the September 11th terrorist attacks by Switzerland.³²⁷ In UK design case, *Masterman's Design*, Aldous J stated that Registrars' deci-

324 Wasserman (n 22) 6, citing Gail Dines et al. "Pornography: The Production and Consumption of Inequality 20 (1998).

325 Available at: www.austlii.edu.au/au/journals/PolemicUSyd/2004/1.pdf.

326 *Hallelujah Trade Mark* [1976] RPC 605 (UK)

327 But note dissent from a minority of the Appeal Board. *Falcon Sporting Goods AG v. FIIP*, Case MA-RS 1/2. INTA Bulletin January 15, 2005, Vol 60, No. 2, available at: www.inta.org/INTABulletin/Pages/BINLADINTrademarkUpheld.a.spx

sions are judicial not administrative.³²⁸ In *Matal v. TAM*,³²⁹ Justice Alito quipped “[i]f the federal registration of a trademark makes the mark government speech, the Federal Government is babbling prodigiously and incoherently”. In *In re Old Glory Condom Corp.*,³³⁰ the T.T.A.B. remarked that “the act of registration is not a government imprimatur”. In *FCUK*,³³¹ Richard Arnold QC cited Aldous J’s decision in *Masterman’s Design*,³³² in which he dismissed the notion that the act of registration signals endorsement of the Registrar acting in his public capacity: “the Registrar, when exercising his discretion, is acting in a judicial capacity, not in an administrative capacity. Thus a decision to register is a judicial decision that the design is registrable, not that the Registrar approves of the design.”

The concept of government speech is ostensibly implicated because national trademark offices are government agencies³³³/public bodies.³³⁴ ³³⁵ Under the U.S. government speech doctrine,³³⁶ when government speech is held to be operative, the contested speech - normally that of private (legal or natural) persons - escapes Constitutional (First Amendment) scrutiny. Thus, a ‘government speech’ designation is tantamount to a license to practice political bias (“viewpoint discrimination”, according to the U.S. Court of Appeals for the Federal Circuit in *The SLANTS*, cf. “viewpoint

328 *Masterman’s Design* [1991] RPC 89. This was an appeal to the Registered Designs Appeal Tribunal. Aldous J, “The Registrar, when exercising his discretion, is acting in a judicial capacity, not in an administrative capacity. Thus a decision to register is a judicial decision that the design is registrable, not that the Registrar approves of the design.”

329 *Matal v TAM*, 582 U.S. ____ (2017).

330 *In re Old Glory Condom Corp.*, 26 U.S.P.Q. 2d (BNA) 1216, 1220 (T.T.A.B. 1993).

331 *Case: O-137-06, FCUK*. Trade mark Application Number: 2184549.

332 *Masterman’s Design* [1991] RPC 89.

333 The United States Patent and Trademark Office (USPTO), established by the 1952 Patent Act (35 U.S.C. 1), falls under the U.S. Department of Commerce.

334 Public bodies are “formally established organisation[s] that [are] (at least in part) publicly funded to deliver a public or government service, though not as a ministerial department.” See ‘Classification of Public Bodies: Guidance for Departments’ issued by the Cabinet Office, available at: https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/519571/Classification-of-Public_Bodies-Guidance-for-Departments.pdf

335 The UK Intellectual Property Office (IPO) is an “executive agency” - a type of arm’s-length (public) body sponsored by its home department (the Department of Business, Energy and Industrial Strategy) <https://www.gov.uk/government/organisations/intellectual-property-office>.

336 First articulated in *Rust v. Sullivan*, 500 U.S. 173 (1991).

neutrality”).³³⁷ In that case, the U.S. Court of Appeals for the Federal Circuit reminded the trademark office/government that it is not the keeper of speech.

In the GCC, the absence of precedents means there is no express position on this. However, the fact that third parties and organs of the state (the courts and the responsible Ministry)³³⁸ can reverse the decision of the examiner is cited by practitioners in all three countries as evidence that a trademark examiner is not deemed a representative of the state and decisions are not state endorsement.³³⁹ Furthermore, in the UAE, it is common for other government departments to refuse to recognise rights granted by trademark officials. For example, customs have stopped importation of products (not necessarily for public policy reasons) even when a trademark is known to be registered. Enforcement officials have also refused to enforce 3D marks or other non-traditional marks on the basis that they do not believe that the marks in question, registered in the UAE, are "trademarks".³⁴⁰

5. The government should not expend its time or financial resources to support marks that are contrary to the values of society

This rationale has been articulated by commentators such as Oswald³⁴¹ and in case-law such as *In re McGinley*,³⁴² and EU cases “Screw You”³⁴³ (*Kenneth’s Application*) and “fucking freezing”.³⁴⁴ In *In re McGinley*, the Court³⁴⁵ expressly stated that Congress is not “legislating morality” when it prohibits registration under s2(a) of the Lanham Act, rather it is simply deny-

337 *In Re Tam* (n 74).

338 The responsible ministries are respectively the Ministry of Commerce and Investment in Saudi Arabia, Ministry of Economy and Commerce in Qatar, and UAE Ministry of Economy.

339 Article 21 of the UAE Trademark Law. Survey responses.

340 Survey responses.

341 Oswald (n 151).

342 *In re McGinley*, 660 F.2d 481, 486 (C.C.P.C.1981). According to the case, Section 2(1) is a “judgement by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”

343 Second Board of Appeal, *Case R 1727/2014-2- ‘fucking freezing!’ By TURPITZ (BILDMARKE)*;

344 Grand Board of Appeal, *Case R 495/2005-G – Kenneth’s Application (Screw You)*.

345 United States Court of Customs and Patent Appeals (now Court of Appeals for the Federal Circuit)

B. The problem of deceptively innocuous marks: trademarks accepted in error

ing the mark statutory benefits that it should not be afforded. It is possible that this is actually one and the same thing. This argument is also a government speech argument. The idea of the ‘deserving trademark’ was alluded to in “Screw You” and “fucking freezing!”. Trademark registration was described as a “privilege”.³⁴⁶ Here, the Boards of Appeal seemed to argue that the morality and public order provision (Article 7(1)(f)) of the EUTMR is driven not by a censorial duty per se, but by an ethical one; to prevent the benefits of registration accruing to inappropriate trademarks.³⁴⁷

There is nothing to suggest that this notion of wasting state resources on undeserving trademarks features at all among examiners in the GCC.³⁴⁸ This may be because these legal systems are relatively young and trademark officials are not yet inclined to question the role of trademark registers in society.³⁴⁹ ³⁵⁰ It could also be because the GCC states *are* legislating morality.³⁵¹ This is supported by the prohibition on use of the disallowed sign.

B. The problem of deceptively innocuous marks: trademarks accepted in error

In the GCC, there is a unique problem posed by English marks that are facially innocuous. There are two main ways in which morally objectionable marks that are facially innocuous, may be accepted. First, is **the specification in the application**.³⁵² The precise nature of the goods/service might be unclear to an examiner if the specification in the application form is written too generally. Certain Nice Classes clearly contravene the cultural and moral values of Gulf societies (e.g. Class 33) but many items fall into innocuous classes. Class 44 for ‘medical services’ is an accepted Class but a filing in Class 44 for abortion clinics/services would be rejected. In this case, the nature of the service is obvious from the application if “abortion” or a synonym thereof is mentioned. A less obvious service could in theory

346 *Kenneth’s Application* (n 344) [13].

347 This ethical position ascribed to the EUIPO is by inference of this author.

348 None of the respondents selected this reason.

349 This is an inference made by this author based on postulation by Hansen (n 12) xxix, in relation to the nascent UAE legal system, that “perhaps because of these various facts, the professions appear not to participate in any kind of disinterested activism for reform of laws or procedures.”

350 Normative propositions, in contrast, are prolific in U.S. and UK/EU legislative texts and jurisprudence.

351 Cf. *In Re McGinley*.

352 Survey responses.

be accepted in error. “ASHLEY MADISON” is an online matchmaking service to facilitate extra-marital affairs. It is registered for Classes 38 and 45, both of which are accepted in the GCC. Class 45 broadly covers “Personal and social services rendered by others to meet the needs of individuals.” If the specification is worded too generally, in misleading terms,³⁵³ or if it uses euphemisms, it could slip through. Perhaps the more foreign the concept is to Islam or to a conservative examiner, the less likely it is to cause objection. For example, an alien concept in Islam would be ‘assisted suicide.’ Suicide remains a strong taboo. “DIGNITAS To live with dignity to die with dignity” is a registered EU trademark in Classes 10, 16, 42, 43, 44, 45.³⁵⁴ These are not prohibited Classes in the GCC. Medical services is a broad area. If an applicant filed in the GCC using the truncated form “DIGNITAS” in a bid to reach the large expatriate population through an online presence, and the specification was couched in terms like “dignity”, “autonomy”, “palliative care”, it is conceivable that an examiner may not be alerted to the nature of the service.

The second way for immoral marks to pass without objection is due to **the particular examiner** who assesses the application.³⁵⁵ It is not unusual for objectionable trademarks to be inadvertently accepted by GCC examiners who do not catch the meaning of the word mark. For example, the stylised mark *F**K* was accepted in the UAE and published in the official gazette in early 2017,³⁵⁶ despite evoking a vulgar connotation of the swear word “fuck”. Even in the West, the threshold is high for this particular expletive.³⁵⁷ The UKIPO and EUIPO have refused many phonetic and visual variations of “fuck”³⁵⁸ because it is considered “deeply offensive” and would cause “justifiable outrage amongst a significant section of the pub-

353 In this example, ‘marriage service,’ ‘life is short’ or ‘social networking for married people or people in relationships’

354 International registration.

355 Survey responses.

356 Survey responses.

357 Notwithstanding some difficult-to-explain inconsistencies. For instance, EU-Registered trademarks include, JUST A FUCKING TSHIRT (006397103), FUCK LUCK (007024631). EU trademark protection was denied for the following, FIT FUCKERS (007497795), FICKEN, FUCK CANCER (012172722), FACK IT (014965701), NOYFB (015948359), FML Fuck My Life

358 FCK LDN was refused by the UK IP Office in May 2015 for Class 21 (UK00003109721). Available at: www.trademarks.ip.gov.uk.

lic”³⁵⁹ ³⁶⁰ The trademark FCUK was only accepted by the UKIPO because it was held not capable of being construed as the swear word “FUCK”³⁶¹ In a similar vein, *FCUK* has been accepted in five GCC countries.³⁶² Given the controversy surrounding the registration in the UK, this is noteworthy. One possible explanation is that the examiners in the region were not aware of the offensive connotation at the time of the registration. It could also be ascribed to the fact that the brand is famous (although fame must be judged at the date of application and some of these are not particularly recent). A third explanation for offensive marks such as this, appearing on the GCC registers is that evidence of parallel registrations in the GCC assuaged initial objections. There is precedent³⁶³ from the CRIMINAL case that a rejection decision could be reversed on appeal by bringing to the official’s attention a successful registration in another (more conservative) GCC state.³⁶⁴ However, in another case this strategy failed.³⁶⁵

359 *Scranage's Application*, UKIPO Trade Mark Decision O-182-05, 24 June 2005, [11].

360 But see German Federal Patent Court decision overturning the rejection of “FICKEN”.

361 In 2004, registered UK trademark “FCUK” was the subject of a third party cancellation action made in the public interest, based on Article 3(3)(a) of the Trade Marks Act. The action failed. The subsequent appeal, which was based on the same provision of law and a claim that the Registrar had erred in principle, was also dismissed. The decisions expounded principles that are instructive of the UK/EU approach to immoral trademarks.

362 Not Oman.

363 The term “precedent” is used here in a loose sense. There is no doctrine of precedent in the trademark registration system in question. Trademark offices are not bound by parallel registrations in other GCC states.

364 Successful registration in Saudi Arabia.

365 The trademark “KISSES” was rejected in Saudi Arabia and the rejection was upheld by the Administrative Court 6th circuit, 25 July 2017. The fact that there were many other “KISS” marks already registered at the Saudi Trademark Office did not persuade the officials to drop the objection. This approach is in line with the European approach: “the registrability of a sign as a Community trade mark must be assessed solely on the basis of the CTMR, as interpreted by the Community judicature, and not on the basis of previous Office practice” (judgment of 15/09/2005, C-37/03 P, ‘BioID’, [47] and judgment of 09/10/2002, T-36/01, ‘Surface d’une plaque de verre’ [35]

IV. Dominant rationales in applying moral exclusions

The earliest registration of FCUK is a Saudi Arabian registration date of 1999.³⁶⁶ It was followed by Kuwaiti (2004, 2005),³⁶⁷ U.A.E. (May 2005),³⁶⁸ Bahraini (September 2005),³⁶⁹ and Qatari registrations (2008).³⁷⁰ But this explanation fails to explain how the most conservative jurisdiction allowed the FCUK mark in the first instance. The Qatari registration proceeded without rejection by the examiner and without opposition.³⁷¹

Another surprising acceptance is ZIPPO. This is an example of a mark that is not offensive in English (indeed, would be considered fanciful) but has an offensive meaning in the local language, translating very closely to the male genitals. It is not acceptable to use in ordinary speech, either formal or informal. The trademark was accepted and registered in the UAE, Qatar and Saudi Arabia. This could be due to the fame of this brand for lighters. Interestingly, the trademark was rejected in Jordan.³⁷² Lastly, BULLOX is registered for tools (hammers) in Qatar and Saudi Arabia.³⁷³ This could evoke the Middle English slang word of “bollocks”, meaning testicles. It is used figuratively in colloquial English as an expletive meaning rubbish/bad, or useless/poor quality.³⁷⁴ This problem of unknown words in English is also illustrated by the allowance of the trademark TIRAMISU for desserts.³⁷⁵

Conclusion

This chapter teased out the motivations for prohibiting registration of immoral trademarks. It focused on the GCC with some rich insights from the US and Europe. It considered the role of public bodies and whether trademark registrability decisions are a mere judicial decision or a sanction. Dis-

366 Registration No. 141902217(502/53) - Class 25; Registration No. 141902218 (502/52) - Class 18.

367 Registration No. 57902 - Class 18; Registration No. 58153 - Class 25.

368 Registration No. 53301- Class 3; Registration No. 53300 - Class 18; Registration No. 53299 - Class 25.

369 Registration No. 45496 - Class 3; Registration No.45497 - Class18; Registration No. 45498 - Class 25.

370 Registration No. 33517 - Class 3; Registration No. 33518 - Class 18; Registration No. 33519 - Class 25.

371 Survey responses.

372 The mark was rejected in Jordan (survey responses).

373 Japanese company Imoto Hamano Co. Ltd for tools (hammers).

374 See: <https://en.wikipedia.org/wiki/Bollocks>.

375 Survey responses.

tinguished was the strict application of the law in the GCC and the more nuanced position in the West. It was determined that this was due to a few factors such as the civil law tradition in the Arab states, the young systems, the more stringent interpretation of moral norms, and the lack or subordination of free speech guarantees that tend to cultivate legal tests and guidelines for balancing interests.

It has been shown that in applying moral bars to trademark applications, the GCC and Western jurisdictions share common motivations. However, three main differences have been identified: 1) The concern that an offensive mark is undeserving of the state's resources and should be kept off the register is not thought to be a consideration in the GCC; 2) Shari'a principles are sometimes applied by the courts in conjunction with trademark laws, notably in Saudi Arabia. The principles expound the avoidance of harm and corruption; 3) There can be surprising decisions due to examiners being unaware of the meaning of an English (foreign) word or concept, or due to an unusually strict application of Shari'a by an examiner. The specification in the application may also sway the examiner towards the innocuous meaning.

The research for this paper indicates that all three jurisdictions are driven by a desire to prevent the public from feeling shocked or offended and that this is the primary rationale for refusing to register offensive trademarks. Shari'a principles have been recited in Saudi courts to prohibit registration of tobacco products. This is an example of Shari'a principles overruling both the trademark law and a social norm in the GCC (smoking) as Tobacco products are widely used.