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FREQUENTLY ASKED QUESTIONS (FAQs)

CP14. TRADE MARKS CONTRARY TO PUBLIC POLICY OR TO ACCEPTED PRINCIPLES OF MORALITY

APRIL 2024

CP14 FREQUENTLY ASKED QUESTIONS

1 THE COMMON PRACTICE

1.1 General

1.1.1 What is the purpose of this Common Practice?

Although the assessment of signs that are contrary to public policy or to accepted principles of morality must always be carried out on a case-by-case basis, considering the normal level of sensitivity and tolerance of the relevant public in the jurisdiction concerned, all the circumstances specific to the Member State(s) and the particular case, this Common Practice aims to provide guidance and serve as a reference for the relevant authorities, including Member State Intellectual Property Offices (MS IPOs), as well as users, applicants and their representatives. It also aims to ensure that different MS IPOs assess signs under this provision in a similar and predictable way.

1.1.2 Has the Common Practice taken into account national/EU case-law?

Yes. The relevant national and EU case-law was analysed and used as a reference and inspiration for both the principles and examples in the Common Practice. However, the Common Practice should not be seen as a compilation of case-law but rather as a document providing guidance on the basis of case-law, best practices, and market realities.

1.1.3 Regulations are constantly evolving. Likewise, what is considered offensive today could be acceptable in the future. Therefore, what would happen if once the Common Practice is adopted, legislation or morality significantly changes? Or if there is a judgment from the General Court or the Court of Justice that impacts any of the principles of the Common Practice?

Should there be any regulation, EU case-law or significant change that occurs or is issued after the adoption of the Common Practice and may have an impact on its principles, the 'Maintenance of Common Practices' project (or any equivalent subsequent project) would analyse and study it and decide whether it is necessary to adapt the document to it.

1.2 Scope

1.2.1 Why are 'language related-issues regarding the examples of the Common Practice' out of scope?

This is for purely practical reasons. To allow conclusions to be drawn among all participants involved in the development of the Common Practice, irrespective of their native language, all examples of the document are in English, and although some terms may be recognised in several languages, it is assumed that they will be understood by the relevant public as a native English speaker would understand them.

1.2.2 Why is 'cultural heritage' out of scope?

Although the European Free Trade Association (EFTA) Court ([1]) judgment in the Vigeland case ([2]) encourages a broader application of public order and accepted principles of morality as a ground for refusal in cases involving cultural heritage material, the Working Group considered that, due to the lack of guidance from the Court of Justice of the European Union at the time the Common Practice was developed, it was advisable to leave this topic out of the scope of the project.

([1]) The EFTA Court has jurisdiction over EFTA states that are parties to the EEA Agreements (Iceland, Liechtenstein, and Norway). Although they are not part of EU, these countries are subject to EU legislation (i.e. Directive 2008/95).
([2]) Decision of EFTA Court: Case E-5/16, Municipality of Oslo

1.2.3 What is meant by the point out of scope 'how the assessment of freedom of expression should be performed in relation to Article 4(1)(f) TMD'?

Despite the fact that the Court of Justice of the European Union, in the Fack Ju Göhte judgment ([3]), recognised that freedom of expression should be taken into account in the assessment of this provision, EU trade mark law was not settled in this area at the time the Common Practice was developed. For this reason, Section 2.4 of the Common Practice acknowledges that freedom of expression should be considered, but it does not address how the assessment should be performed, as it was considered that further guidance was needed from the Courts. Instead, reference is made to an appendix, created for purely informational purposes, with information on potentially relevant legal sources on the application of Article 10 of the European Convention on Human Rights and Article 11 of the Charter of Fundamental Rights of the European Union in relation to the application of Article 4(1)(f) of the TMD. This document also contains case-law from the Court of Justice and European Court of Human Rights, among other information, that will serve as a reference for examiners.

1.2.4 What is meant by the point out of scope 'what is seen or should be seen as lawful in each EU Member State (MS)'?

Since each EU Member State has its own legal provisions that determine what is considered legal within its territory, the Common Practice does not intend to converge on the lawful type of behaviours and/or actions in each EU Member State.

1.2.5 Considering that public policy and morality are notions that evolve and change over time, could a trade mark application that has been rejected under this ground for refusal be accepted a few years later by the same MS IPO?

Yes. A trade mark application that has been rejected at a certain point in time under this ground for refusal could be accepted some years later, considering the particular circumstances applicable to the case. It should be borne in mind that, according to the General Court, the assessment should be based on the situation at the date of application ([4]).

However, as recognised in the Common Practice, there may be very special circumstances in which the public policy in force and/or the fundamental moral values and standards accepted may be affected by an event that occurs subsequent to the date of application, and in these cases, in principle, those events might also be taken into account.

1.2.6 What is the purpose of the 'General considerations' table?

This table includes several considerations to be borne in mind while reading the whole Common Practice. It aims to ensure a harmonised understanding of the principles, criteria and factors contained in the document and their practical application.

1.3 Principles of the Common Practice

1.3.1 Does the Common Practice aim to give fixed definitions of 'public policy' and 'accepted principles of morality'?

No. The document merely reflects the agreements reached at EU level on the common understanding of the notions of public policy and accepted principles of morality to ensure a harmonised and consistent application of the principles of the Common Practice. These common understandings were created using EU case-law, EU legal texts and feedback from the stakeholders as inspiration.

([3]) 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 56.
([4]) 03/06/2009, T-189/07, Flugbörse; confirmed by 23/04/2010, C-332/09 P, Flugbörse.

1.3.2 Is everything that contravenes Member State legislation considered contrary to public policy?

No. According to the Common Practice, a sign would be considered contrary to public policy if it contravenes a fundamental norm, principle, and/or value, and affects a fundamental interest of the Member State(s) in question. This should be determined, in principle, at the time of filing the trade mark application.

1.3.3 Why does the Common Practice include a common understanding of signs found in bad taste?

Relevant EU case-law refers to bad taste in relation to the assessment of this ground of refusal ([5]). Therefore, a common understanding on this concept is included in order to help differentiate when a sign is found to be in bad taste and when it is contrary to accepted principles of morality. In addition, some principles ([6]) are included to better delimitate signs contrary to accepted principles of morality and signs found in bad taste.

1.3.4 Why does the Common Practice include an exception to the general rule of the filing date as the relevant point in time for the assessment of this ground?

Although, according to the General Court, whether a trade mark should be registered or invalidated must be assessed on the basis of the situation at the date of its application, not of its registration ([7]), the Court of Justice in the Fack Ju Göhte case ([8]) refers to 'the time of the assessment' as the relevant point in time. Taking this into account, the possibility of considering events subsequent to the date of filing is included for very exceptional circumstances.

1.3.5 Subsection 2.2.3.1 focuses on the assessment of the sign itself. Is it possible to refuse a sign under Article 4(1)(f) TMD considering only the sign itself, without assessing other criteria?

As a general rule, the examination of a sign under Article 4(1)(f) TMD should consider all the relevant criteria and factors laid down in the Common Practice and applicable to the particular case. Nonetheless, in some cases, the meaning of the sign and/or the message conveyed by it may be so strong that it could be rejected as contrary to public policy or to accepted principles of morality irrespective of the goods and/or services applied for.

1.3.6 What is meant by 'reliable sources that may, if appropriate, be considered' when assessing public policy?

According to the common understanding of public policy, its content should be ascertainable from reliable and objective sources. While there are different sources that must always be considered by the MS IPOs and the EUIPO when analysing whether a sign is contrary to public policy (e.g. general principles of law, international treaties and conventions, EU treaties, applicable EU and MS legislation and case-law), there are other sources that, depending on the case, may be considered (e.g. relevant governmental guidelines).

The sources to be applied will always be assessed on a case-by-case basis and the final decision remains at the discretion of the MS IPO in question, considering the relevant criteria laid down in the Common Practice.

1.3.7 Why does the Common Practice not provide a set of guidelines on acceptable evidence for the MS IPOs to consider a refusal under this ground?

Providing an exhaustive list of recommended evidence is not possible because this should always be assessed on a case-by-case basis. Nonetheless, the Common Practice includes a non-binding reference to the CP12 Common Practice, which contains recommendations on means and sources of evidence.

([5]) Among others, 20/09/2011, T-232/10 Coat of arms of the Soviet Union, EU:T:2011:498, § 51 and 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 41.
([6]) Section 2.2.5. of the Common Practice, on signs including/related to obscenity, sexuality and innuendo, contains a principle and example related to bad taste.
([7]) 03/06/2009, T-189/07, Flugbörse; confirmed by 23/04/2010, C-332/09 P, Flugbörse.
([8]) See to that effect 27/02/2020, C-240/18 P, Fack Ju Göhte, EU:C:2020:118, § 39.

In addition, section 2.3.2.2 of the Common Practice refers to some elements that may be taken into account in the assessment, since they may prevent or aid the registration of the sign.

1.3.8 Why does the Common Practice not further develop the topic of cannabis and cannabis-related trade marks?

A deep analysis was conducted during the CP14 project on the MS IPOs' practices on signs related or referring to cannabis, as well as on the applicable national legislation, with the aim of identifying areas of potential convergence. The conclusion from the analysis was that despite the complexity of the topic and the divergence of national legislation on cannabis, it was possible to converge to a certain extent. Therefore, considering that cannabis is a matter that is constantly evolving, it was decided to address these kinds of signs under the general principle in section 2.5.1 'Signs including/related to illicit substances' rather than separately, in order to avoid it quickly becoming obsolete. Some examples were also included.

Convergence on other aspects such as the medical use of cannabis was considered impossible, since legal constraints existed for some MS IPOs.

1.3.9 What will happen with signs containing the element 'CBD'?

CBD refers to cannabidiol, which is a non-psychoactive substance derived from cannabis. It is usually contained in cannabis products that are used for medicinal purposes.

As with medical cannabis, convergence on signs related to CBD was not possible at the time of developing the Common Practice due to legal constraints.

1.4 Examples in the Common Practice

1.4.1 Are the examples in the Common Practice taken from real trade mark applications?

No. Since it could be either beneficial or harmful for the corresponding owners or applicants, using real examples in the Common Practices involving either national or EU trade marks is avoided. Instead, real cases are used as inspiration to create clear-cut examples that can serve to illustrate the principles, conclusions and recommendations included in the document.

1.4.2 What is meant by the colours yellow, red and green in the headings of the tables of examples?

The examples with yellow headings illustrate one particular criterion or factor without considering others; for instance, how the sign show be assessed, without considering the goods and/or services, as explained in footnote 22 of the Common Practice ([9]). These examples do not contain a final outcome, in contrast with the examples with red or green headings, which include an outcome (objectionable or non-objectionable under Article 4(1)(f) TMD, respectively) based on the application of the relevant criteria and the general considerations.

1.4.3 Should it be understood that the examples included in the Common Practice as 'Non-objectionable under Article 4(1)(f) TMD' cannot fall under any other grounds for refusal?

No. The fact that the examples do not fall under this concrete ground for refusal does not mean that those examples cannot fall under any other grounds for refusal. For instance, an example could be considered not contrary to public policy or to accepted principles of morality, but non-distinctive and/or descriptive.

([9]) Footnote 22: *'The aim of this point is to determine all the meanings of the sign and whether any of them are particularly relevant for the assessment of Article 4(1)(f) TMD. The goods and/or services in connection with the sign are analysed in the following subsection (2.2.3.2)'.*

1.4.4 Are the outcomes of the examples included in the Common Practice binding for the MS IPOs?

The examples are only for illustrative purposes. They are intended to demonstrate how the principles of the Common Practice should be applied, but should not be understood as imposing conclusions on what is contrary to public policy or to accepted principles of morality at national level.

As indicated in the document, public policy and accepted principles of morality are intricately linked to the norms and values that prevail in each society at a given time. Therefore, the assessment of whether a sign is contrary to public policy and/or to accepted principles of morality should always be carried out on a case-by-case basis, considering the normal level of sensitivity and tolerance of the relevant public in the jurisdiction concerned as well as all the circumstances specific to the Member State(s) and the particular case.

The examples serve to provide guidance for future cases that the MS IPOs and users might have, but it cannot be excluded that, taking into consideration all the circumstances of the case, the final outcome of a similar case in a particular MS IPO could differ from the examples provided in the Common Practice.

2 METHODOLOGY

2.1 Development and effects of the Common Practice

2.1.1 How were IPOs and UAs involved in the development of the Common Practice?

The MS IPOs, the non-EU IPOs, as well as the User Associations (UAs) were consulted through questionnaires, videoconference calls and phone calls, with a view to collecting valuable input. The draft Common Practice was subject to consultations at several stages during development to obtain feedback from all interested parties, with a view to guaranteeing that any concerns expressed could be considered, analysed and discussed by the Working Group members in the corresponding meetings (Working Groups, workshops, etc.). Status updates were also provided during various meetings with stakeholders.

2.1.2 Which MS IPOs and UAs participated in the CP14 Working Group?

The Working Group that developed the CP14 Common Practice was composed of representatives of 11 MS IPOs (BG, EE, ES, EUIPO, FI, FR, IT, LV, PL, RO, SE), as well as of 3 UAs (AIM, ECTA and MARQUES).

2.1.3 What effect will the Common Practice have on the past/ongoing/future proceedings of the implementing MS IPOs?

Each implementing MS IPO provides information about when they are going to implement the Common Practice and as to whether it will apply to proceedings pending on the implementation date and/or initiated after that date. This information is included in the CP14 'Overview of Implementations' table, linked within the Common Communication document.

2.1.4 Is the Common Practice legally binding?

Despite the fact that the Common Practice has no legally binding effect on national or European Courts, the principles contained in the document will be equally applied by all the implementing IPOs, and will constitute internal instructions that will be followed by their examiners when assessing signs that could fall under Article 4(1)(f) TMD.

2.2 Implementation of the Common Practice

2.2.1 What does 'implementation' mean?

Implementation refers to the incorporation of a Common Practice into the MS IPOs' practices. Implementation dates and the proceedings affected are included in the Common Communication document and more

specifically in the CP14 'Overview of Implementations' table. The implementation date and the proceedings affected are especially important as the outcome of certain decisions related to these proceedings may be different once a Common Practice is implemented at a concrete IPO.

2.2.2 Can an MS IPO implement the Common Practice at any time?

Yes. All MS IPOs are strongly encouraged to implement the Common Practice regardless of their participation and contribution to its development. Full network-wide convergence is dependent on the number of implementing Offices. More implementing Offices means a wider reach of the Common Practice and thus greater legal certainty, transparency and efficiency of IP practices across the EU. Therefore, the more implementing MS IPOs there are, the closer we will be to fulfilling that goal. However, implementation of the Common Practice is on a voluntary basis.

2.2.3 Can non-EU IPOs implement the Common Practice?

Yes. Non-EU IPOs are welcome to implement the Common Practice. The more implementing Offices there are, the wider the reach of the Common Practice and, therefore, the more efficient and transparent the respective IP systems for users and Offices.

2.3 Common Practice and Common Communication

2.3.1 What is the difference between the Common Communication and the Common Practice?

The Common Practice is the result of the agreement reached between the EUIPO, MS IPOs and UAs on the general principles regarding the matters that were included in the scope (see Section 1.3 of the Common Practice).

Through the Common Communication, which contains a summary of the Common Practice, the MS IPOs inform users about the implementation of the Common Practice in their Offices. The Common Communication includes a link to the CP14 'Overview of Implementations', which provides the proceedings and dates on which the Common Practice was implemented, following confirmation from the respective MS IPOs.

The full text of the Common Practice is attached as an annex to the Common Communication. This single document is published on the EUIPN website in all available languages, and will be made publicly available by the implementing MS IPOs on their websites.