

**TRADE MARKS ACT 1994  
IN THE MATTER OF  
APPLICATION No 2378664  
TO REGISTER A TRADE MARK  
IN CLASSES 20 & 25  
DECISION AND GROUNDS OF DECISION**

**Background**

1. On 19 November 2004 Toke UK Limited of 7 Wilsons Row, Methley Leeds, LS26 9AS applied to register the trade mark TOKE in Classes 20 & 25. The goods for which registration is sought are:

Class 20 Trays.

Class 25 Clothing, footwear, headgear.

2. Objection was taken against the application under Section 3(3)(a) of the Act because the mark consists exclusively of the word TOKE, defined in the Collins English Dictionary as “To take a draw on a cannabis cigarette”. The word is seen as being contrary to public policy and accepted principles of morality. It is against public policy for the Registry to accept terms which are descriptive of or associated with an illegal activity.

3. Following a hearing, at which the applicant was represented by Mr Kinsey of Wildbore and Gibbons, its trade mark attorneys, the objection under Section 3(3)(a) of the Act was maintained.

4. Following refusal of the application I am now asked under Section 76 of the Act and Rule 62(2) of the trade Mark Rules 2000 to state in writing the grounds of my decision and the materials used in arriving at it. Having given further consideration to the application and subsequent decision, I am prepared to waive the objection against the goods in class 20 (trays). Accordingly, to enable the acceptable goods in class 20 to proceed, the Applicant has been offered the option to either delete class 25 from the application or alternatively, request division of the application.

5. No evidence of use has been put before me, I have therefore only the prima facie case to consider in respect of the goods in class 25.

**The Law**

6. Section 3(3)(a) of the Act reads as follows:

“A trade mark shall not be registered if it is –

(a) contrary to public policy or to accepted principles of morality”.

## **The Case for Registration**

7. In correspondence dated 3<sup>rd</sup> February 2005 Mr Kinsey made two points in support of his application:

1. The word TOKE would be perceived as inoffensive in relation to the goods claimed as the average consumer would not be familiar with the slang terminology of smokers of cannabis.
2. The word “TOKE” was registered prima facie in Class 3 for “Starch, ironing aids; scale preventing and removing preparations (Application No. 2052418).

A copy of the earlier trade mark registration referred to above is at Annex A.

8. In reply, the Official Letter dated 11 March 2005 set out the reasons for maintaining the Section 3 objection. The Examiner considered that the word “Toke” has a clear meaning which is defined in Collins English dictionary as “To take a draw on a cannabis cigarette” which is descriptive of and associated with an illegal activity. Acceptance of the mark would be contrary to public policy as it is seen as promoting the use of drugs. In respect of the earlier registration, Trademark No. 2052418, the Official Letter stated this is not on a par given the differences between the goods upon which the respective marks are to be used.

9. A hearing was requested by the Applicant. At the hearing Mr Kinsey argued that “Toke” had a number of meanings besides the objectionable meaning. He also provided me with a list of marks referring to drugs and the use of drugs (copies attached at Annex B) and reminded me that “Toke” had been accepted for registration on unrelated goods. I was also reminded of the “Jesus” decision which highlighted the right to “Freedom of expression”. I advised Mr Kinsey that in view of the new information provided at the hearing I would defer my decision until I had time to consider all of it in its entirety.

10. Having considered all of the new information provided, I subsequently advised Mr Kinsey in the Hearing Report that whilst I acknowledged the precedents I was bound to judge this case on its own merits. I refused the mark under Section 3(3)(a) of the Act on the grounds that it is contrary to public policy as the Registry would be likely to be perceived as promoting the use of drugs.

## Grounds for Decision

11. In the decision of Simon Thorley Q.C. in the Tiny Penis case [2002] E.T.M.R. 57 guidance was provided at paragraphs 30 to 32 on the test that must be applied in deciding the issues arising from this application:

“31 In my judgment the matter should be approached thus. Each case must be decided with on its own facts. The dividing line is to be drawn between offence which amounts only to distaste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values. The outrage or censure must be amongst an identifiable section of the public and a higher degree of outrage or censure amongst a small section of the community will no doubt suffice just as lesser outrage or censure amongst a more widespread section of the public will also suffice.”

12. In Masterman’s Design Application [1991] RPC 89, Aldous J. invoked the concept of right-thinking members of the public. I believe this a helpful approach. A right thinking member may himself or herself not be outraged but will be able, objectively, to assess whether or not the mark in question is calculated to cause the “outrage” or “censure” that I have referred to amongst a relevant section of the public. This is the function of the Hearing Officer. The matter must be approached objectively. It does not matter whether the Hearing Officer finds the mark personally unacceptable. It seems to me that this degree of offence is what OHIM had in mind when writing their guidelines:

13. Section 3(3) is not concerned with political correctness, it is concerned with principles of morality, a different and less readily invoked standard. The Registrar’s Hearing Officers cannot be expected in all cases to form a view without the assistance of evidence. They are entitled to draw upon their own knowledge of words and upon their own perception of the way in which those words can be used without offending against public morality. They must however be careful not to allow their personal views to deflect them from approaching the matter on the basis of the “right-thinking” person.

14. I have to consider the reaction of residents in the United Kingdom to the word “TOKE” when used as a trade mark in respect of the goods for which registration is sought. In doing this I must put aside any personal views that I may hold in relation to the mark applied for and consider the matter by assessing the position through the eyes of right-thinking members of the public. What would be their reaction when encountering the word “TOKE” in use in advertising.

15. In the Tiny Penis decision Simon Thorley Q.C. commented:

“49...I must contemplate the use of the words Tiny Penis in television advertisements going out before the general public, in advertising bill boards in public places, perhaps even on the side of the well known Clapham omnibus.”

16. Clearly there will be some members of the general public who will not be offended when encountering the word “TOKE” in use as a trade mark. However, I find it equally clear that it would cause offence to many. The test to which I referred to earlier in this decision makes it clear that mere distaste or offence is insufficient. As Simon Thorley Q.C. put the question:

“49...Would they be outraged? Would they feel that the use should properly be the subject of censure?”

17. Having considered the matter through the eyes of the “right-thinking” member of the public I have concluded that use of the word “TOKE” as a trade mark, in the manner described above, and in relation to the goods for which registration is sought in class 25, would cause greater offence than mere distaste to a significant section of the general public. The mark would be considered to be promoting the use of drugs and thereby an illegal activity.

18. Mr Kinsey referred me to a number of trade marks accepted in the United Kingdom and by the Community Trade Marks office (OHIM). However, I do not accept that they establish any reason why they should influence the outcome of this application. The comments made in the MADAME case [1966] RPC 541 were restated by Mr Justice Jacobs in the TREAT trade mark case [1996] RPC 281: “In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. MADAME Trade Mark and the same must be true under the 1994 Act.”

19. I therefore conclude that the trade mark applied for is contrary to public policy or to accepted principles of morality and is therefore excluded from acceptance by Section 3(3)(a) of the Act.

**Dated this 28<sup>th</sup> day of April 2006**

**R EVANS**  
**For the Registrar**  
**The Comptroller General**

**ANNEXES A, B ARE NOT ATTACHED**