

O-210-03

TRADE MARKS ACT 1994 AND THE TRADEMARKS (INTERNATIONAL REGISTRATION) ORDER 1996

IN THE MATTER OF INTERNATIONAL REGISTRATION NO 776058 AND THE REQUEST BY BASIC TRADEMARK S.A. TO PROTECT A TRADE MARK IN CLASSES 3, 9, 14, 16, 18, 24 AND 28

Background

1. On 21 December 2001, Basic Trademark S.A. of 201, Route d'Arlon, L-1150 LUXEMBOURG, on the basis of International Registration No 689374, requested protection in the United Kingdom, under the provisions of the Madrid Protocol, of the following mark:

JESUS

2. The International Registration is numbered 776058 and protection is sought in respect of:

- Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions, dentifrices.
- Class 9: Optical apparatus and instruments, namely spectacles, eyeglasses, sunglasses and frames therefor, lenses; protective glasses, goggles, snow goggles, diving goggles; spectacle cases.
- Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards; printers' type; printing blocks.
- Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- Class 24: Textiles and textile goods, not included in other classes: bed and table covers.
- Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.

3. It was considered that the request failed to satisfy the requirements for registration in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and notice of refusal under Article 9(3) was given because the mark is excluded from registration by Section 3(3)(a) of the Trade Marks Act 1994. This is because the word “Jesus” has religious significance and its use as a trade mark would be seen as morally offensive to the public. Objection was also raised under Section 5(2) of the Act but this was subsequently waived and I need make no further mention of it in this decision.

4. At a hearing, at which the applicants were represented by Mr Buehren of W H Beck Greener & Co, their trade mark attorneys, the objection under Section 3(3)(a) of the act was maintained. Notice of refusal was issued under Article 9(3) and 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.

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

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 prior to the hearing, and at the hearing itself, Mr Beuhren referred to the dividing line between offence which amounts to distaste and offence which would cause outrage and would cause censure as being likely to undermine current religious values. In his submissions Mr Buerhen suggested that the word JESUS, when used as a trade mark in relation to the goods claimed, would not offend against Section 3(3)(a) of the Act. In support of these submissions Mr Buerhen referred me to a number of trade mark applications for trade marks which incorporate the word JESUS, some of which are registered. For convenience copies of these may be found at Annex A.

8. Mr Buehren referred me to the decision by Simon Thorley Q.C. sitting as The Appointed Person in the TINY PENIS case [2002] RPC 33 where he made the following comments in paragraph 30 regarding the dividing line referred to above:

“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.”

Decision

9. In the decision by Simon Thorley Q.C. in the Tiny Penis case guidance was provided at paragraphs 30 to 32 on the test that must be applied in deciding the issues arising from this application:

“In my judgement 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.

Aldous J. in Masterman 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. 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.”

10. No evidence has been placed before me regarding the significance of the word JESUS in the United Kingdom as a surname or as a forename. However, research conducted prior to the issue of the examination report on 19 April 2002 indicates that JESUS is a surname appearing 27 times in the London Telephone Directory. I am also aware that JESUS is a popular forename in a number of countries but I am not aware of it being in common use as a forename in the United Kingdom.

11. Although I accept that a number of residents of the United Kingdom will identify JESUS as an ordinary surname or forename I am of the view that they are in the minority. In fact I consider them to be in a small minority.

12. I have attached at Annex A details of trade mark applications, some of which have proceeded to registration, some of which have not. In my view they are no direct assistance when considering this application for registration. Referring to each application identified by Mr Buehren I have the following observations.

13. The following applications achieved registration:

- 1530220 - Jesus appears to be a forename and is disclaimed.
- 2009230 - Jesus appears to be a forename within a company name.
- 1401890 - Jesus is incorporated within other matter and is disclaimed.
- 2193191 - Jesus is incorporated within other matter.
- 1363305 - Jesus is incorporated within other matter and all words disclaimed.
- 8516657 - Jesus appears to be part of a name.
- 1324853 - Jesus appears to be part of a name.
- 1248449 - Jesus is incorporated within other matter.
- 1359376 - Jesus appears to be a forename or surname and is disclaimed.
- 2293530 - Jesus is incorporated within other matter.

14. In my view there are substantial differences between all of these marks and the word JESUS solus and I repeat that I do not consider them to be of any assistance when considering this application.

15. Collins English Dictionary (5th. Edition first published 2000) has the following extract within its primary definition of the word JESUS:

“n. 1. Also called; Jesus Christ; Jesus of Nazareth; ?4b.c.–?29 a.d., founder of Christianity; born in Bethlehem and brought up in Nazareth as a Jew. He is believed by Christians to be the Son of God and to have been miraculously conceived by the Virgin Mary, wife of Joseph.....He is believed by Christians to have risen from his tomb after three days, appeared to his disciples several times, and ascended to Heaven after 40 days.”

16. Although there are a large number of different religious beliefs held and practised within the United Kingdom I am of the view that a substantial number of United Kingdom residents are Christians in that they believe in the teachings of the Christian faith. It is still a subject which is taught in schools throughout the United Kingdom and is worshipped in churches throughout the country. In my view this substantial number of United Kingdom residents would attribute only one meaning to the word JESUS and that is the one set out above ie JESUS CHRIST.

17. Given my finding that a substantial number of United Kingdom residents would not place surname, forename or any other significance on the word JESUS but would identify it as signifying JESUS CHRIST, the Son of God, I have to consider their reaction to the word 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 JESUS in use in

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

“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.”

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

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

19. Having considered the matter through the eyes of the “right-thinking” member of the public I have concluded that use of the word JESUS as a trade mark, in the manner described above, and in relation to the goods for which registration is sought, would cause greater offence than mere distaste to a significant section of the general public. That offence is caused by the fact that an accepted social and religious value is likely to be undermined to a significant extent. This value is the belief that the word JESUS is the name of JESUS CHRIST who is believed by Christians to be the Son of God and whose name should not be debased by use as a trade mark for the goods in question. 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.

Conclusion

20. In this decision I have considered all the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, it is refused under the terms of Articles 3 and 9(3) of the Trade Marks (International Registration) Order 1996 (as amended) because it fails to qualify under Section 3(3)(a) of the Act.

Dated this 21ST day of July 2003

**A J PIKE
For the Registrar
The Comptroller General**

Annex in paper copy

ANNEX A