

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2232411  
BY CHRISTOPHER PHILLIP GHAZILIAN  
TO REGISTER A TRADE MARK IN CLASS 25**

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10 **DECISION AND GROUNDS OF DECISION**

On 13 May 2000, Christopher Phillip Ghazilian of 4b St Columb Industrial Estate, St Columb Major, Cornwall, applied under the Trade Marks Act 1994 for registration of the mark TINY PENIS in respect of:

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Class 25            Clothing, footwear, headgear, t-shirts, sweatshirts, shorts, swimwear, belts, shoes and wetsuits.

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Objection was taken to the application under Section 3(3)(a) of the Act because the mark consists of the words TINY PENIS being a sign which is contrary to the accepted principles of morality.

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At a hearing at which the applicant was represented by Mr D Moore of Jensen & Son, the objection was maintained. Following refusal of the application under Section 37(4) of the Act 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.

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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."

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The mark consists of ordinary words in the English Dictionaries which are well known. It is not therefore necessary for me to set out any references for the individual words that constitute the mark as a whole.

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At the hearing, Mr Moore argued that the trade mark does not breach morality codes, because it consists of ordinary dictionary words which are acceptable by the general public. Indeed, he argued, the term PENIS is present in school biology books and is a term that a teacher would use as an acceptable descriptive term, rather than the more explicit and offensive terms that are used in the school playground. Similarly, these descriptive words could be used by a medical practitioner who would not cause any offence to the patient.

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It seems to me that the meaning of Section 3(3)(a) of the Trade Marks Act 1994 is much the same as Section 11 of the Trade Marks Act 1938 (as amended) which read as follows:

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design."

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It is difficult to exactly determine the appropriate standards to be applied when deciding what is "contrary to accepted principles of morality". The *Hallelujah* trade mark case [1976] RPC 605 established that morality is to be judged against current thinking and susceptibilities and explored the tests to be applied in deciding, whether or not, a trade mark is "contrary to morality". Here, Mr Myall, acting as the Registrar's Hearing Officer, indicated that there are two tests to be considered. In the first test for the use to be contrary to morality, the generally accepted mores of the time would have to be offended, while for the second test the adverse use of the Registrar's discretion to refuse registration would be warranted if registration would be likely to offend persons who might be in a minority in the community yet be substantial in number. With regard to the standard of the test to be applied, I shall take account of the paragraph of Mr Myall in the *Hallelujah* trade mark case from page 607 line 29 which is as follows:

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"Section 11 of the Trade Marks Act 1938 prohibits, so far as is relevant to this case, the registration of a trade mark any matter the use of which would be "contrary to morality". I find very little guidance in reported cases for determining what meaning is to be attributed to this phrase. The dictionaries give the meaning of "morality" as "moral principles or rules; moral conduct" and of "moral" as "concerned with the distinction between right and wrong, virtuous, righteous ". At present we live in what is commonly called the "permissive age", where previously accepted moral standards are undergoing change. There have been similar periods in the past and no doubt there will follow in due course a return to stricter standards as the historical wheel turns full circle. However, it is well established that the registerability of a trade mark must be judged as at the date of its application. I conclude that the phrase "contrary to morality" falls to be considered by the generally accepted standards of today and not by those of 1938. The difficulty is to be sure what those are, and more particularly, where the line is to be drawn between marks whose registration is prohibited by the section and those where it is not. When religious and moral standards are changing, sometimes quite rapidly, it seems to me that the Registrar should only follow where others have given a clear lead. While he 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. He must not lag so far behind the climate of the time that he appears to be out of touch with reality, but he must at the same time not be so insensitive to public opinion that he accepts for registration a mark which many people would consider offensive".

The *Hallelujah* trade mark case also draws attention to the following quotation from Evershed, J.'s judgement at page 30 of *La Marquise Footwear Inc.*'s application (1946) 64 RPC 27;

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"I must wholeheartedly accept the proposition that it is the duty of the Registrar (and it is my hope that he will always fearlessly exercise it) to consider not merely the general taste of time, but also the susceptibilities of persons, by no means few in number, who still may be regarded as old-fashioned and, if he is of opinion that the feelings or  
5                   susceptibilities of such people will be offended, he will properly consider refusal of the registration. I should certainly hope, in taking, as I do take in this case, a different view from him, I am in no way debasing the standard which, as a servant of the State, he should exercise and maintain in his jurisdiction."

10           and again (page 32):

"I repeat that on the question of discretion, I have expressed my own view on the evidence, taking, as I do, a different view from that taken by Mr Faulkner. I have tried to explain the reasons why I think that I must make up my own mind in the matter. I  
15                   only repeat that I do indeed hope that nothing that I have said will encourage anybody to suppose that the Registrar hereafter will be less astute to watch the proper susceptibilities of persons who may be offended by the use of words which would be thought by them to have a morbid, erotic or salacious significance".

20           In the aforementioned case, the Court ruled that the Registrar had exercised his discretion wrongly in refusing to register the non invented word OOMPHIES for shoes on the (admitted) ground that it was equivalent to "sex appeal". Although Section 11 of the 1938 Trade Marks Act was not considered at all, the judgement does afford useful guidance on the proper way to approach the issues raised in this case for the registration of TINY PENIS.

25           Although helpful for the purpose of trying to assess this application within the meaning of Section 3(3)(a) of the Act, the cases cited so far in this decision were considered under the Trade Marks Act 1938 (as amended). There is no case law, to date, regarding Section 3(3)(a) of the Trade Marks Act 1994. However, I feel it relevant to make reference to a judgement  
30                   issued by Mr Justice Rattee in the [2000] ETMR 341 case of *French Connection Ltd v Sutton*. Here, Mr Justice Rattee decided against an application for summary judgement for trade mark infringement and passing off, due to the use by the defendant of the Internet domain name "FCUK.com". The claimant holds a trade mark registration of the word "FCUK" in respect of fashion clothes. Although the issues of the judgement are not concerned with the  
35                   interpretation of Section 3(3)(a) of the Trade Marks Act 1994, I note that Mr Justice Rattee makes the following comment at page 346, lines 6 to 10:

"I cannot help commenting that I find the case of both parties in this litigation unpalatable in the extreme, having regard to its subject matter, but that is not  
40                   something, of course, on which, sitting in this court, I can make any ruling, or on which I can properly base any decision on the issues which I have to decide."

He goes on in that judgement at page 361, lines 6 to 9, to make the following statement:

45                   "As I have said, I do not find the public policy argument an attractive argument in the mouth of the defendant in this case, having regard to the fact that he has clearly sought to take advantage, if that is the right word, also of the tasteless implications in the use of the letters FCUK ....."

Turning now to the application at issue, I consider that use of the ordinary dictionary words TINY PENIS, when used in a proper descriptive context, are not words that would, or should, cause offence to the vast majority of persons in the UK. But the applicant seeks to use these words not in an ordinary descriptive context, but as a means of differentiating products in the course of trade. Consequently, these words could appear on signs in shop windows, on advertisement boards in public places and on labels on clothing and accessories. I can only think that such a phrase has been chosen purely as a means to appeal to only a proportion of the purchasing public, namely the market segment identified for the goods on offer. However, bearing in mind that the goods applied for are items which could be on display in public places for all members of the general public to view, I consider that the trade mark will cause offence to a substantial proportion of the purchasing public who will, without any choice, be exposed to the words TINY PENIS out of context. I am exercising my own judgement on this issue based on my belief of the generally accepted mores of today. In the same way that case law under the 1938 Act (as amended) guides us towards a cautious yet realistic approach in considering marks that could offend a substantial proportion of the public of today, I believe that the meaning of Section 3(3)(a) of the Trade Marks Act 1994 is such that the Registrar should not test the boundaries of acceptability by denying registration only to what can clearly be regarded as the most shocking and outrageous of expletives.

In this decision I have considered all documents filed and all arguments submitted to me in relation to the application, and for the reasons given, it is refused under the terms of Section 37(4) of the Act because it fails to qualify under Section 3(3)(a) of the Act.

Dated this 9 day of January 2001

Janet Folwell (Ms)  
For the Registrar  
The Comptroller General