

O-330-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION UNDER  
NO. 81862 BY DENNIS WOODMAN  
FOR A DECLARATION OF INVALIDITY IN RESPECT OF TRADE MARK NO.  
2184549 IN THE NAME OF FRENCH CONNECTION LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF an application under No. 81862  
by Dennis Woodman for a Declaration of Invalidity  
in respect of trade mark No. 2184549  
in the name of French Connection Limited**

### **BACKGROUND**

1. Trade Mark No. 2184549 is for the mark FCUK and is registered in Class 14 in respect of the following goods:

Watches, clocks, horological and chromometric apparatus and instruments; watch straps, watch bands; jewellery; costume jewellery; key rings, key holders, key-chains, necklaces, bracelets, earrings, brooches and rings; containers adapted to carry the aforesaid goods; parts and fittings for all the aforesaid goods.

2. The registration currently stands in the name of French Connection Limited.

3. By an application dated 20 September 2004, Dennis Woodman applied for the registration to be declared invalid. The application is made on the following ground:

**A3** (3) A trade mark shall not be registered if it is -

(a) contrary to public policy or to accepted principles of morality,@

4. On 4 November 2004, the registered proprietors filed a counterstatement in which they deny the ground on which the application is based.

5. The registered proprietors and the applicant for invalidity both ask for an award of costs in their favour.

6. Both sides filed evidence in these proceedings, which, insofar as it may be relevant to these proceedings I have summarised below. The matter came to be heard on 5 October 2005, when the applicant was represented by Mr Malcom Chapple of Counsel, instructed by Gillhams, solicitors. The registered proprietors were represented by Mr Daniel Alexander QC, instructed by Bristows, their trade mark attorneys.

### **EVIDENCE**

#### **Applicant's evidence**

7. This consists of a Witness Statement dated 25 February 2005, and comes from Mr Dennis Woodman, the applicant for invalidation. Mr Woodman states that unless otherwise stated the facts contained in his statement come either from his own personal knowledge, from public records or are facts that he has been told.

8. Mr Woodman refers to the ex-parte examination of the registration that is the subject of these proceedings, exhibiting extracts from the official files at DW 1. He gives details of various codes of conduct and reports relating to advertising and sales promotion, copies of which are also shown as part of exhibit DW 1. In addition, Mr Woodman exhibits Chapter 6 of the Registry Work Manual, referring to the Registrar's practice in relation to applications to register offensive trade marks.

9. Mr Woodman refers to the records of the adjudications made by the Advertising Standards Authority (ASA) that he exhibits as part of DW 1, relating to the use, and phonetic variants of the word FUCK. Not surprisingly the ASA upheld complaints where the actual expletive is used, or where letters were replaced with typographical characters as in F\*CK. Most, but not all complaints relating to the use of FCUK were upheld by the ASA, but these related to instances where FCUK was used as part of a phrase such as 'World's biggest fcuk@', or with imagery that would be likely to cause the use to be interpreted as the expletive.

10. Mr Woodman refers to a letter from the ASA that states that complaints are dealt with on a confidential basis and are not in the public domain, and therefore he is not able to obtain copies of any other complaints. As an alternative he relies upon figures published on the registered proprietors' website, which shows there to have been complaints, but also that not all were upheld. The information is not specific on the number and nature of the complaints made, or that were subsequently upheld. Mr Woodman asserts that the evidence taken from the registered proprietors' website shows that they do not seek to use the trade mark as a play on words, but to rely on the primary meaning of the offensive word to promote its sales by shock value.

11. Mr Woodman exhibits a number of further letters from the ASA, which state that because FCUK is a registered trade mark the ASA were unable to ask the registered proprietors to withdraw their current advertising campaign. The letters also state that the ASA have not upheld complaints where FCUK is not used in a context where it can be interpreted as the expletive...@

### **Registered proprietors' evidence**

12. This consists of two Witness Statements, both dated 29 April 2005. The first comes from Neil Williams, Operations Director of French Connection Group Plc, a position he has held since 1994, having joined the company as General Manager of the Wholesale Division in 1992.

13. Mr Williams recounts the history of his company and the brand FCUK, which, he says was originally used as an internal reference for the company, FC denoting French Connection with a letter suffix denoting the country in which the division operates, eg, FCUS for the United States, FCHK for Hong Kong and FCUK indicating the UK arm of the company. Mr Williams says that in 1997 the decision was made to use the letters F.C.U.K in conjunction with the French Connection name. Exhibit NW1 consists of a copy of the 2005 French Connection Annual Report. Exhibit NW2 consists of an extract from the 3 April 2004 edition of The Drapers' Record, a clothes industry publication, Mr Williams referring to French Connection

(although not FCUK) being in the top 5 brands in the UK for young fashion customers. Exhibit NW3 consists of an extract from the ROAR report of 2001 showing FCUK to be the 3<sup>rd</sup> most highly rated fashion brand in the 15-24 year old age group.

14. Mr Williams states that the registered proprietors currently have 56 retail stores and 25 franchised retail outlets in the UK trading under French Connection and FCUK signage, exhibits NW4 and NW5 being a list of store addresses and pictures of the frontage of 3 stores in London, all but one showing FCUK on internal or external signage. Exhibit NW6 consists of the Spring 2005 catalogue showing men's and women's wear for sale under the FCUK brand. Mr Williams gives details of concessions selling FCUK branded clothing and accessories, inter alia, in Harrods and Selfridges in London, and Fenwicks in Newcastle. Exhibit NW7 provides photographs of sales areas in high street department stores that sell FCUK branded clothing. The photographs show FCUK prominently displayed on signage and articles of clothing. The turnover figures given for the concessions show a substantial level of sales. Mr Williams says that his company also sells FCUK branded clothing by mail order and via the Internet, stating that the websites fcuk.com and fcukbuymail.com receive some 70,000 unique visitors each month. Mr Williams states that between 1998 and 2005, in excess of 16 million items of clothing branded FCUK have been sold in the UK.

15. Mr Williams goes on to refer to his company's licensing activities, exhibits NW8 and NW9 being catalogues for FCUK branded sunglasses, timepieces, homewear, and shoes, although exhibit NW9 only shows FCUK being used on timepieces and a bracelet, the remainder being sold under the French Connection name. Mr Williams refers to the licence agreement with Boots, which resulted in over , 33 million of sales of FCUK branded personal care products in the 2005 financial year. Exhibit NW10 consists of images of these products, all having FCUK running along the length of the container. Mr Williams says that these products are sold in 1,419 Boots branches. Exhibit NW11 consists of photographs of FCUK branded products in displays and at point-of-sales in various Boots branches. Exhibit NW12 consists of advertising for FCUK products that Mr Williams says was placed by Boots in Glamour magazine. Exhibits NW13 to NW18 consists of letters from retailers involved with the FCUK brand, giving details of their trade. Of those who comment on whether there have been any complaints resulting from their association with FCUK, one recounts the ASA having received one or two objections@resulting from an advertisement that appeared in their Health & Beauty magazine, putting this into the context of the 1.8 million that were distributed. The remainder either say that they have not received any complaints or do not comment. Some state that they find the assertion that FCUK is offensive to be surprising. Exhibit NW19 consists of a decision by WIPO relating to a domain name dispute.

16. The remainder of Mr Williams's Statement consists of a summary of the trade transacted under the FCUK mark in the UK, and submissions on the evidence of Matthew Griffiths on behalf of the registered proprietors, the evidence of Mr Woodman, and the relative merits of these proceedings. Whilst I do not consider it appropriate or necessary to summarise these submissions, I have read them and will take them fully into account in my determination of the case.

17. The second Witness Statement comes from Matthew Griffiths, Head of Marketing for

French Connection Limited, a position he has held since April 2001, having previously been employed in the capacity of Group Product Manager for L-Oreal UK.

18. Mr Griffiths gives an account of the commercial history of French Connection, confirming the company's target group to be consumers of fashionable clothes in the 18-35 age range. Mr Griffiths restates that the FCUK mark is composed of the first letters of the company name, with a suffix denoting that it is the UK arm of the business, going to say that the *raison d'être* for the mark is to keep the French Connection brand *à*front of mind as a *hook* to promote and increase awareness. He cites the shortening of Coca Cola to Coke as a similar concept.

19. Mr Griffiths gives details of the advertising and promotion spend for the FCUK brand in the years 1997/1998 through to 2004/2005, which ranges from , 2,864,000 in 1997/1998, rising year on year to a peak of , 8,620,000 in 2003/2004. Whilst he gives details of the media used, and figures relating to the potential reach of each, he does not provide any examples of how the mark was used. He makes particular reference to the launch of a radio station, FCUK FM as part of the French Connection 2004 Spring-Summer campaign. At exhibit MG1 he provides a copy of a letter dated 16 March 2004 from Ofcom relating to the change of name of the station to FCUK FM, stating that at no stage did Ofcom express any reservations about the channel name. He notes that as shown by Mr Woodman's evidence, Ofcom is a broadcasting regulator responsible for the enforcement of the 2002 CAP Code. Mr Griffiths goes on to give details of two nominations received by FCUK FM, and awards won by FCUK advertising campaigns.

20. Mr Griffiths confirms the information given by Mr Williams in relation to the registered proprietors' Internet sites, going on to give details of catalogues sent to existing and potential customers. He refers to his company's sponsorship of Amnesty International's 40<sup>th</sup> Anniversary, French Connection being the sole distributor of Amnesty's T-shirts, which, as can be seen by exhibit MG2, were co-branded with FCUK. He states that his company also sponsors sports personalities, mentioning Elena Baltacha, the number one British tennis player and the British golfer Van Phillips. He says that both wear clothing bearing the FCUK brand in public, a photograph of Ms Baltacha having appeared on the front page of the Daily Telegraph wearing a shirt bearing the FCUK brand (exhibit MG3). He mentions the sponsorship of the Arsenal and French footballer Robert Pires, an article relating to his involvement with FCUK also being part of exhibit MG3. Mr Griffiths refers to the sponsorship of cultural events such as the Serpentine Gallery Summer Party, an event which, being part of the *Society Season* is widely reported in the media, the FCUK name appearing on invitations, banners and the like. He mentions the involvement of FCUK with organisations such as The Royal Opera House, Saddlers Wells, The Royal Court Theatre, The Victoria and Albert Museum, which he says illustrates the acceptance of the FCUK mark. Exhibit MG4 consists of a programme for a ballet supported by French Connection UK.

21. Mr Griffiths goes on to say that French Connection has its own store card, FCUK cash, operated in conjunction with a division of The Royal Bank of Scotland. He says the facility is used as a vehicle for sponsorship, co-branding and promotion of films, exhibit MG5 being images of posters for various films where FCUK has been involved. These show two instances of FCUK being used to promote *fcuk cash - the french connection*, and one where the

reference is simply **A**from fcuk@

22. Mr Griffiths goes on to refer to Mr Woodman's comments in relation to the complaints made to the ASA, stating that it is clear that all ASA adjudications relate to the content and form of specific advertisements. He also says that from 2001 to 2003, all of his company's poster advertising was pre-vetted in accordance with the CAP code exhibited by Mr Woodman, copies of the posters approved being shown as exhibit MG6. These show FCUK used on its own, and also in various strap lines such as **A**eau de fcuk@, **A**he says french connection. she says fcuk@, **A**he sees french connection. she sees fcuk@, **A**WELCOME TO fcukiki beach@ and **A**vive le fcuk@. There is one poster with fcuk being used in connection with a condom. Mr Griffiths goes on to say that all advertising featuring FCUK that have been broadcast on television, radio or at a cinema will have been cleared by the Broadcast Advertising Standards Clearance Committee and Radio Advertising Clearance Committee, as appropriate, to ensure they are in accordance with the CAP code.

23. Mr Griffiths says that the approval of the posters by CAP and the adjudications by the ASA show that FCUK is not itself offensive. He says that the ASA noted that where **A**fcuk was not used in a phrase where it could be interpreted as an expletive and considered that consumers would understand it as a reference to the French Connection UK brand@. He states that where the ASA has upheld complaints it has made it clear that it is the context of the advertisement rather than as a result of the use of FCUK. Mr Griffiths states that he considers the complaints to be isolated, stating that 227 complaints over a presumed eight year period is minimal and isolated in the context of mass advertising, but lacking any detail of the substance of the complaint do not assist in showing any public perception of the FCUK brand itself. That exhibit MG7 consists of letters sent to French Connection by the ASA advising them of the results of various objections.

#### **Applicant's evidence in reply**

24. This consists of a Witness Statement dated 1 July 2005, from Dennis Woodman. Perhaps not surprisingly, much of Mr Woodman's Statement consists of submissions on the evidence provided by the registered proprietors. Whilst I do not consider it to be necessary to summarise it here, I will take the comments fully into account in my decision. Mr Woodman does refer to one exhibit, DW 4, which consists of a letter dated 1 March 2005, from the Director General of the ASA, enclosing copies of some ASA adjudications that were upheld. In each case the complaint had been to the use of FCUK with other matter, the context of which led the complainant to see the FCUK as a play on the expletive.

25. At the hearing the applicant made a request for further evidence to be admitted in to these proceedings. The evidence consists of a Witness Statement dated 3 October 2005, from Leigh Ellis, a solicitor with Gillhams. The registered proprietors did not object to the evidence being admitted and accordingly, this Witness Statement forms part of the evidence in these proceedings.

26. In his Witness Statement, Mr Ellis refers to articles that appeared in the media reporting that French Connection intends to reduce the use of the FCUK brand, copies of these articles

being annexed to the Statement.

27. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## DECISION

28. The application for a Declaration of Invalidity is made under the provisions of Section 47, which reads as follows:

**A47.** - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).@

29. The application is based on an allegation that the mark has been registered in contravention of Section 3(3)(a), which reads as follows:

**A3(3)** A trade mark shall not be registered if it is -

(a) contrary to public policy or to accepted principles of morality,@

30. As I see it, Section 3(3)(a) is an absolute ground that goes to the inherent characteristics of a trade mark. Accordingly, if a mark is open to objection, whatever makes the mark objectionable should be present at the date that the application for registration is made. The basis of an objection under Section 3(3)(a), and the current case law to which I was referred in these proceedings, was considered and conveniently summarised by Mr David Kitchen QC, sitting as the Appointed Person in the *FOOK* trade mark (O-182-05):

**A4.** These words were considered by Mr Simon Thorley QC, sitting as the Appointed Person, in *Ghazilian's Application* [2002] ETMR 631. In upholding the decision of the Registrar to refuse registration of the words TINY PENIS as a trade mark in relation to various articles of clothing he said, at paragraph 21:

**A5** it is only in cases where it is plain that an accepted principle of morality is being offended against that registration should be denied. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough.@

And at paragraph 31:

**A6** In my judgment the matter should be approached thus. Each case must be decided 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.®

5. The corresponding words of the Community Trade Mark Regulation were considered by the Fourth Board of Appeal of OHIM in Case R 111/2002-4 *Dick Lexic Limited*, a decision of the 25th March 2003. The Board allowed the registration of the mark DICK & FANNY on the basis that it transmitted no offensive message that could justify the denial of registration on grounds of either public policy or accepted principles of morality, despite the fact that the words might have, in coarse slang, a sexual connotation. It reasoned:

¶7 The contested decision was based on the particular meaning of the words in English slang. Yet, as the appellant argues, the same words have another meaning when employed in less informal speech. Dick and Fanny are the diminutive forms of the English first names Richard and Frances (the latter being the feminine version of Francis), respectively. Thus, the words express different meanings depending on whether standard or informal language is used and the sexual connotation is only present in the latter.

8 The Board concedes that the liability of a word mark to the absolute grounds of Article 7(1)(f) CTMR must be assessed on the basis of any usage, not necessarily formal, that the public makes of a given language. Therefore, the meaning of a word in slang may, in principle, lead to an objection, even if in normal usage it does not have an unfavourable connotation.

9 However, the Board doubts that the mere fact that the two words have, alone or in combination with each other, a sexual connotation should be regarded as ~~offensive~~ and that it justifies the rejection of the mark on account of public policy or accepted principles of morality. There are two reasons for this : firstly, these words merely designate things but they do not transmit any message; secondly the association of the two words does not necessarily reinforce the connotation of the mark.

10 As regards the first reason, the words admittedly designate, in a particularly inelegant (or tasteless) manner, anatomical parts that are rarely mentioned in ordinary speech **B** whether formal or informal. In principle, the mark does not proclaim an opinion, it contains no incitement, and conveys no insult. In the Board's opinion, in these circumstances, the mark should not be regarded as contrary to either public policy or accepted principles of morality. For this reason, the Board would agree with the appellant that the mark may, at most, raise a question of taste, but not one of public policy or morality.

11 As regards the second reason, the Board denies that the association of the two words reinforces the sexual connotation of the mark. There would be good arguments in support of the opposite view as well. As a combination of the diminutive form of forenames, the association of ~~Dick~~ with ~~Fanny~~ could, in

fact, reduce that connotation and allude instead to a couple. This sort of combination of names, particularly in their diminutive form, is rather widespread even in an English-language context (Tom & Jerry, Bonnie & Clyde, to name just a few).

12 All in all, the Board considers that the mark has, in non-formal English usage, a rather smutty flavour but, since it does not convey any additional message and has a neutral meaning in formal English usage, it falls short of being contrary to public policy or accepted principles of morality.®

6. The Board considered that a mark is not contrary to public policy or accepted principles of morality merely because it carries a sexual connotation or innuendo. Nor is it enough to refuse registration that the mark may be perceived to be smutty or in bad taste. Further, in making the assessment it is relevant to consider whether the mark proclaims an opinion, contains an incitement or conveys an insult.

7. In *Jesus Trade Mark* decision BL 0-021-05 dated 18 January 2005, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, emphasised that these prohibitions must be interpreted consistently with the provisions of the European Convention on Human Rights and the right to freedom of expression. Under Article 10 the right to freedom of expression is exercisable subject only to:

Asuch formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society Yfor the prevention of disorder or crime, the protection of health or morals Y®

8. I do not detect any aspect of the reasoning in *Ghazilian* or in *Dick Lexic* which is inconsistent with Article 10 of the European Convention on Human Rights. Registration is not to be refused on the grounds of taste. For the prohibition to operate a mark must be one which will justifiably cause outrage or be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values.®

31. Whilst these cases provide guidance on the way in which I must approach the issue, they also make it clear that the outcome of a case will depend upon its own particular facts.

32. The applicant objects to the FCUK mark remaining on the register because he considers it to be capable of being misconstrued as the word fuck. Therefore, the first question that I have to answer is not whether FCUK is open to objection, but whether the word FUCK would be declared invalid under the provisions of Section 3(3)(a)? If the answer to this question is no, there can be no case for the owners of the FCUK mark to answer.

33. I doubt whether there are many that would need to refer to a dictionary to understand the meaning of Afuck®. It is extremely well known and frequently heard in day to day life, particularly on the television in films, drama series and the like. But the fact that it may be in everyday use does not make it any more acceptable. In the *FOOK* trade mark case Mr David

Kitchen QC stated:

A11. ....Although it may be used commonly it is, nevertheless, a swear word and deeply offensive and insulting to many people. It is more than distasteful or smutty. The general use of the word is likely to cause justifiable outrage amongst a significant section of the public.®

34. Not unexpectedly, Mr Kitchen determined that the word Afuck® would not qualify for registration as a trade mark, so the answer to the first question is in the affirmative.

35. This brings me to the nub of the issue; is FCUK likely to cause offence because it will be seen as the swear word FUCK? The *FOOK* case turned on the fact that when spoken in the local accent of various regions of the United Kingdom, the word would be phonetically indistinguishable from FUCK. In the *Tiny Penis* and *Jesus* trade mark cases referred to above, the potential for offence is plain to see; no interpretation, intentional or otherwise is required. The position with FCUK is somewhat different. It is not a word with a meaning. When referred to in speech it will, in my view, be enunciated as the letters F-C-U-K, as it consistently was throughout the hearing. But it is not in oral use that there is a potential for offence, but in a visual misconstruing of the letters.

36. The registered proprietors say that FCUK was first used as an internal reference to denote the UK division of their company following the international expansion of French Connection. On its face this appears to be a plausible explanation and I see no reason to doubt it. In his Witness Statement, Neil Williams, the Operations Director of French Connection Group Limited recounts that in March 1997, in conjunction with his company's advertising agency, a decision was taken to launch FCUK as a brand in its own right, initially in the UK. He says that the mode of use separated by dots or by co-branding it with French Connection made it abundantly clear to the public that FCUK was an abbreviation for FRENCH CONNECTION UK. However, in paragraph 48 of his Statement, he states:

AFrench Connection knew at the outset the potential for the FCUK brand as a word play. But the lighthearted joke depends upon the fact that the brand is not the word Afuck®. Some of our advertisements and products make use of that word play.®

37. From the evidence it is clear that the registered proprietors made considerable use of this potential for Aword play® in their promotion of FCUK. Mr Woodman obviously places a good deal of weight on the fact that this advertising resulted in complaints being made to the ASA. French Connection contrast the number of objections with the scale of the use and promotion of the mark, and on its face the number of those who have complained seems to be quite small. That may well be the case, but it is generally accepted that those who actually make a complaint are but the tip of the iceberg, and that there will be many more who although offended, will not take the time or trouble to register their views.

38. French Connection have been using the mark FCUK in their advertising campaigns for quite some time, yet there is not one adjudication upholding a complaint against the mark used on its own, which could be taken as an indication that the ASA consider FCUK to be free from

objection. However, in a letter dated 30 June 2004, sent to Mr Woodman by the ASA, they say that as FCUK is a registered trade mark of French Connection the ASA cannot ask for the current advertising to be withdrawn. It would be easy to infer from this that if FCUK was not a registered trade mark the ASA would ask French Connection to withdraw their advertising. In a second letter dated 29 July 2004, the ASA are a little clearer, stating that "Although the trade mark status of FCUK means that the company is entitled to use it, we have not upheld complaints about this issue where FCUK is not used in a context where it can be interpreted as the expletive, 'Fuck'". This is consistent with a comment in their first letter where the ASA say that they have upheld many complaints where the use has been "in a context where the FCUK can be interpreted as 'fuck'". I believe that the letters make it fairly clear that whether or not FCUK is a registered trade mark, the ASA do not consider the use of FCUK on its own to be a problem.

39. I believe the same position exists with the Committee of Advertising Practice (CAP). Appendix 6 to the Statement of Case is a news release dated 13 July 2004, which states that following a ruling by the ASA relating to posters for the FCUK FM radio station, which stated "FCUK FM FROM PNUK TO RCOK AND BACK. NON-STOP FNUK. FCUK FM", the CAP had ordered French Connection to pre-vet all of its advertising posters for the next two years. The ASA had concluded that these FCUK FM posters would cause offence because readers would interpret the FCUK trade mark as the expletive 'fuck'. Citing a comment from the Secretary of the CAP, the press release states that the company had been warned against using its trade mark in a way that many find offensive, clearly inferring that the offence rests in the context of use rather than the trade mark itself. Whilst the adjudications of these bodies may provide a useful insight into how the public possibly perceive FCUK, I am not in any way bound by their views..

40. Mr Woodman relies on the fact that the Driver Vehicle Licensing Agency do not issue combinations of letters on personalised number plates that could be interpreted, amongst other things, as the expletive 'fuck'. The letter from the DVLA particularly mentions the combinations FUK and FCK. It may well be that the reasons for this practice are similar to those in these proceedings, but the considerations applied by the DVLA through their code of practice are different, particularly given that, as Mr Woodman points out, the public is educated to see a personalised number plate and replace the missing letters to recreate the original word. The question is, would the same be the case where the letters are used in a situation where word play by misplacing or exclusion of letters is not commonplace, in this case, in trade marks?

41. I propose to approach the matter by reference to the manner in which trade marks are used and impact upon the consumer, that is visually, aurally and conceptually, and determine whether these factors create the likelihood of FCUK, being regarded as the objectionable word FUCK.

42. The registered proprietors say that FCUK would be pronounced as letters rather than as a word. I do not see there is any dispute, so aurally the mark and the expletive are likely to be very different, save that, in the unlikely event that the trade mark were to be enunciated, it would, in my view, be similar.

43. Whether there can be any conceptual similarity depends upon whether those encountering the mark see it as letters or as the word, be it actual or mis-spelt. Mr Woodman says that the eye has a natural ability to correct mistakes, and to sort out and reorder letters, the correction to the word in this case being trivial. Whilst there is no scientific evidence to back-up Mr Woodman's claims in this respect, I believe that he finds support in two areas. It is not uncommon when entering text via a keyboard, that keys will be depressed out of synch. I know from personal experience that when proof reading such material, in particular, written by oneself, typographical errors such as misplacing of letters are overlooked because the eye sees what was intended or expected rather than what is actually written. However, the difference between FCUK and FUCK is unlikely to be overlooked in such a short word unless there are positive efforts to approximate the two words.

44. Part of the registered proprietor's defence of the mark revolves around the widespread use and promotion of the FCUK brand, in particular, by retailers and at cultural events that would be considered to be bastions of respectability, and who have provided letters attesting to the commercial success of the brand. The registered proprietors assert that if use of the FCUK mark was going to cause offence these organisations would have steered well clear. The applicant in turn submits that the use should not be viewed as tacit approval of FCUK, or that the trade mark does not cause offence, suggesting that these organisations may have compromised their principles in the search for profit for shareholders, voluntary donations or sponsorship.

45. The evidence that shows how these traders have used the FCUK mark suggests to me that there may have been careful management of its presentation, the use either being with the French Connection name, or on its own, often with the symbol denoting that it is a registered trade mark. I see little evidence that it has been used by the traders in a context likely to lead the person viewing it as the expletive. The traders express surprise that FCUK could be considered offensive stating that if they believed being associated with FCUK would harm the goodwill of their business, or cause offence to their customers, they would not have entered into that association.

46. Clearly there is money to be made from being associated with FCUK branded goods, or from carrying FCUK advertising, but would a trader risk damaging their own image in search of a profit? They could have balanced the potential risk of causing offence to a small section of the community against the profits to be earned, but would they do this if they considered the association likely to cause a justifiable outrage amongst a significant section of the public. Whilst one trader admits that FCUK advertising did receive one or two complaints, the exposure and sales have been to millions of consumers, but even if I accept that the actual number of those offended is potentially much higher, putting this into context I do not see how I can conclude that there is evidence that a trade in goods branded FCUK has caused outrage amongst a widespread or even limited section of the public, identifiable or otherwise.

47. From the evidence it is clear that FCUK is a brand directed at the younger market, who I think it is fair to say are more likely to see the word play as the joke referred to by Mr Williams, and less likely to be offended by it. That may well be the case, but the mark in use will be seen by all ages, and from all backgrounds, and for this reason I do not consider that the

age or demographic make up of the target consumer group for FCUK branded goods is a relevant consideration. The word-play may be more obvious to some and the offence greater to others, but given that the word **Afuck@** is a swear word considered to be deeply offensive and insulting, far from seeing the lighthearted joke claimed by French Connection, if people see FCUK in general use as the expletive F**UCK**, it will, most likely cause justifiable outrage to many people.

48. There can be no doubt that use of the word **Afuck@** would cause a high degree of offence to a significant number of people, but the trade mark in question is not the swear word. The offence is not caused by FCUK itself, but rather that through word play, mistake, or misconstruing of the letters, the mark is capable of being seen as the word. Should I consider a mark open to objection because it is capable of being seen as something it is not? I do not think that that would be right. There is no evidence that establishes that the trade mark FCUK solus is seen as the expletive amongst an identifiable section of the public.

49. There is nothing that I can see in Section 47 that allows for a mark to become objectionable on absolute grounds post application through the use that may have been made of it. The position should, as I stated earlier, be assessed on the facts as at the time that the application to register the mark was made. This being the case, the fact that French Connection may, through contextual use, have educated the public to regard the trade mark as an objectionable word should not have a bearing on my decision. However, the manner in which a mark is used may change the public perception, and it is quite possible that the contextual use of FCUK may have caused contamination such that, even if the public did not see the connection with the expletive at the relevant date, they may well do now, and if I was considering the question of offence at some later date I would have to take this into consideration.

50. I do not see that there can be any better barometer of the impact of a mark on the public perception than evidence resulting from the actual use in the market. Respectable traders have been involved in a significant trade in FCUK branded goods with an almost complete absence of adverse reaction from their customers, although again I acknowledge that the actual number of complaints is unlikely to be representative of the number actually offended. However, any offence that has been caused has not been as a result of the use of FCUK per se, but rather by the context in which the trader has chosen to use the letters in their promotional activities, and for which they have been the subject of censure. On the facts before me I consider that whilst I can understand and appreciate the basis for the objection, I do not consider that this is a sufficient basis on which to declare the trade mark registration invalid, and the application fails.

## **COSTS**

51. The application having failed, the registered proprietors would, in the normal course of events be entitled to a contribution towards their costs. However, acknowledging that the application was made in the public interest and with no potential for commercial gain by the applicant, Mr Alexander confirmed that in the event of the application failing his clients would not seek an award of costs. Accordingly, no award of costs is made.

**Dated this 20<sup>th</sup> day of December 2005**

**Mike Foley  
for the Registrar  
The Comptroller General**