

Trade Mark Application
No. 7114 of 2001

IN THE MATTER of the Trade Marks Ordinance
(Cap. 43)

AND

IN THE MATTER of an application No. 7114 of
2001 by French Connection Limited to register
the trade mark "FCUK" in class 8

**DECISION
OF**

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a request for Statement of Grounds of the Registrar's decision made by Messrs. Wilkinson & Grist on behalf of the applicant on 14 February 2004.

1. On 5 May 2001, French Connection Limited (“the applicant”) filed an application to register, in Part A of the Register, in Class 8, the trade mark “FCUK” in plain block capitals (“the suit mark”). The goods for which registration was sought were “hand tools and implements (hand-operated); cutlery; razors; scissors; parts and fittings for all the aforesaid goods; all included in Class 8”.

2. Objection was raised by the Registrar of Trade Marks (“the Registrar”) under the provisions of section 12(1) of the Trade Marks Ordinance, Cap. 43 (the “Ordinance”), that it shall not be lawful to register as a trade mark any matter the use of which would be contrary to morality as the suit mark “FCUK” is closely similar to the obscene expletive “FUCK”.

3. The applicant’s agent filed a considered reply dated 4 January 2003 arguing that the letters “FCUK” are an abbreviation for the applicant which is a UK company, that is, “French Connection United Kingdom”, and when consumers see the letters “FCUK” they will be aware of this. It was submitted that the suit mark has been registered in a number of countries, in particular in Singapore, Canada, Australia and New Zealand. It was contended that even if the letters “FCUK” are too similar to the obscene expletive “FUCK”, the fact that the mark has been allowed registration on a world-wide basis, in particular in the aforesaid commonwealth countries, which are all English speaking, cannot be ignored.

4. The Registrar did not agree and an informal discussion was held between the applicant’s agent and the Registrar on 11 December 2003. At the informal discussion, the applicant’s agent further submitted that an internet search of “FCUK” will bring up the applicant’s website and references to the applicant’s stores and/or products. The Registrar’s attention was also drawn to the fact that the suit mark has been registered in Hong Kong under registration nos. B4783 of 1999 and B4784 of 1999 in classes 25 and 18 respectively. The applicant’s agent further argued that even if the initials of the applicant “FCUK” are close to “FUCK”, the mark appears to be merely a play on the word and consumers would be aware of this and accordingly they would not be offended by the mark. This is particularly so when the suit mark is used with or in close connection to either the house mark “FRENCH CONNECTION” or with other descriptive words such as “jeans” or “fashion”. Despite the informal discussion, the Registrar maintained the objection.

5. Pursuant to the provisions of Section 13(4) of the Ordinance and Rule 20(2) of the Trade Marks Rules, Cap. 43 sub. leg. (“Rules”), the applicant has requested the Registrar to state in writing the grounds for his decision and the materials used by him in arriving at it. These are given as follows :-

6. Even though the new Trade Marks Ordinance Cap. 559 came into operation on 4 April 2003, this application is a “pending” application according to paragraph 10(1), Schedule 5 of the new Ordinance. It therefore remains to be dealt with under the provisions of the Ordinance Cap. 43.

7. Section 12(1) of the Ordinance provides that it shall not be lawful to register

as a trade mark or part of a trade mark any matter the use of which would be contrary to morality.

8. It was established in the *HALLELUJAH Trade Mark* [1976] RPC 605 that to be contrary to morality, the use of a mark would have to offend the generally accepted mores of the time. As regards the standard of the test I must apply I shall take account of the following paragraph of Mr. Myall in the *HALLELUJAH* case at 607 and 608 which is as follows:-

“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 registrability 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.”

9. Mr. Myall, taking into account the nature of the word Hallelujah and the context in which it is almost universally used as well as the adverse public reaction, was of the opinion that there is a likelihood of its registration as a trade mark for clothing giving offence to many people. The application was thus refused because he was not satisfied the registration did not offend against section 11 (equivalent of section 12(1)) of the United Kingdom 1938 Trade Marks Act.

10. The onus is on the applicant to establish that registration of the suit mark is not prohibited by the terms of section 12(1) of the Ordinance. Notwithstanding that a mark may be distinctive in Part A or capable of distinguishing in Part B, registration does not follow as a matter of course. Section 12(1) of the Ordinance contains specific prohibitions upon registration, one of which is “contrary to morality” (see *Kerly’s Law of Trade Marks and Trader Names 12th Edition*, para. 10-01). If the Registrar is not satisfied that the suit mark does not offend against section 12(1), registration is forbidden and no question of discretion arises.

11. The question before me is whether the use of the suit mark would be contrary to morality. Applying the test in *HALLELUJAH*, I shall consider the nature of the suit mark, the context in which it will be used and the possible public reaction to it in order to determine whether the registration of the suit mark is likely to offend the generally accepted mores of the time that many people would find it offensive.

12. I consider that many people in Hong Kong would recognise the explicit meaning of “FCUK” which on first impression is closely similar to the obscene expletive “FUCK”. Both “FCUK” and “FUCK” consist of the same four letters and are of the same length. The only difference between “FCUK” and “FUCK” is that the letters “C” and “U” are transposed. On first impression, one might actually mistake “FCUK” for the expletive “FUCK”. In addition, internet search conducted by the Registry showed that “FCUK” was commonly used in substitution for the explicit word “FUCK” and I find it reasonable to assume that many people in Hong Kong would be aware of this use of the letters “FCUK”. Some examples of such use are set out in the schedule to the written record of the informal discussion as per the Registrar’s letter of 18 December 2003.

13. To illustrate the explicit meaning of ‘FCUK’, I would also like to refer briefly to the case of *French Connection Limited v. Sutton* [2000] EMR 341. In that case, the claimant (the same as the applicant in the present case) ran a chain of fashion stores selling clothing under the name “French Connection”. It used the letters FCUK (said to be standing for “French Connection UK”) in the context of advertising casual clothes and, in particular, T-shirts, which its shops sold. The claimant registered the letters FCUK as a trade mark. The defendant registered a domain name on the internet in this form “FCUK.com”. The claimant took out an application for summary judgment for trade mark infringement and passing off against the defendant due to the use by the defendant of the internet domain name. Rattee J. dismissed the application for summary judgment on the overall failure on the part of the claimant to satisfy the court on the evidence before it that the defendant has no real prospect of successfully defending the passing off claim. The issues of the judgment are not concerned with whether the mark “FCUK” should be registered under section 3(3)(a) of the Trade Marks 1994 Act which provides that a trade mark shall not be registered if it is contrary to public policy or to accepted principles of morality. This case is therefore not directly in point. However, Rattee J. did observe in that case that there was evidence from the defendant that the use of the letters FCUK, even before the launch of the claimant’s advertising campaign using the same letters, was a well-known alternative to the use of the word “FUCK” on the internet which was not challenged by any evidence filed on behalf of the claimant. Similarly, in the present case, the applicant has not filed any evidence to challenge the finding of the Registrar that the letters “FCUK” have been in use by internet users as an alternative to the word “FUCK”.

14. The applicant makes the point that an internet search of “FCUK” will also bring up the applicant’s website and references to the applicant. However, in my judgment, this fact cannot necessarily show that the people in Hong Kong would not find use of “FCUK” closely similar to “FUCK” and therefore offensive. It is noted that the applicant has not filed any evidence of use in the present case, not to mention evidence of the applicant’s use of the suit mark in Hong Kong that might show that “FCUK” was sufficiently known in Hong Kong as a trade mark as to displace the immediate association with the expletive “FUCK”.

15. The applicant suggests that in actual use, the suit mark may be used in conjunction with the house mark “FRENCH CONNECTION” or descriptive words. However, the applicant must justify registration not only for the particular usage that is planned but for any manner of use within the scope of the registration sought. The use of the suit mark alone without the house mark or other words identifying the applicant must be a manner of use within the scope of registration sought by the applicant in the subject application. Looking at the suit mark which consists solely of the word or letters “FCUK”, there is nothing in it which indicates that “FCUK” stands for “FRENCH CONNECTION UK”, and does not represent the expletive. There is nothing whatsoever to deflect consumers from making an immediate assumption that “FCUK” is equivalent to the expletive “FUCK”.

16. The applicant’s agent pointed out that the suit mark has been registered in Hong Kong under registration nos. B4783 of 1999 and B4784 of 1999 in classes 25 and 18 respectively. A similar issue was raised before Mr. Myall in the *HALLELUJAH* case. The applicant’s agent in that case pointed to Mr. Myall a prior registration of the word HALLELUJAH as part of a device mark accepted by the United Kingdom Trade Marks Registry. Mr. Myall dealt with this point at page 608 of the case as follows:-

“He [the applicant’s agent] confirmed that the objection taken to the instant application was not raised or argued in that one [the prior accepted application]. The circumstances do not therefore afford a parallel. I am unaware of the reason why this objection was not taken in the earlier case and unable to say what might have been the outcome if it had Each application has to be judged on its own merits and for the goods on or in relation to which it is intended to use the mark (see, for example, the remarks of G.W. Tooke, Esq., Q.C., reported in the *MADAME* case [1966] R.P.C. 541 at 545, lines 34-36). I cannot be exonerated from so dealing with the present application even if the earlier registration to which Mr. Gyseman referred was erroneously accepted by the Registrar.”

17. I consider that the same reasoning is equally applicable to the present case. The section 12(1) objection taken to the present application was apparently not raised or argued in the two prior accepted applications. The circumstances are therefore not directly comparable. Similarly, I am unaware of the reason why this objection was not taken in the earlier cases and unable to say what might have been the outcome if it had. In any event, each case has to be decided on its own merits. I share the views of Mr. Myall that I should not and cannot be excused from dealing with the issue now by reason of the prior acceptances. If I am not satisfied that the present application would not offend against section 12(1) , I must refuse the application.

18. Apart from considering the nature of the suit mark, I also take into account that the suit mark is used to differentiate products in the course of trade. The products covered by the subject application include hand tools and implements, cutlery, razors, scissors and parts and fittings for all the aforesaid goods. They are ordinary personal and household items that could be sold in department stores, supermarkets, convenience and neighborhood stores on high streets and viewed by all members of the general public from children to adults. The suit mark could also appear on signs in shop windows, on public advertisements in the mass media in particular on the television or signboards on display. The suit mark will therefore be exposed to different sections of the public in daily life. By reason of the nature of the suit mark being an alternative to the expletive “FUCK” and based

on my belief of the generally accepted mores of today, I do think that many people in Hong Kong would find the suit mark offensive. Therefore, registration of the suit mark should be refused under Section 12(1) of the Ordinance.

19. In arriving at my decision, I have considered all documents filed and all arguments submitted by the applicant in relation to the application.

(Ms. Fanny Pang)
p. Registrar of Trade Marks
3 March 2004