

TRADE MARKS ACT 1994

**IN THE MATTER OF
APPLICATION No 2309350
BY KEVIN SCRANAGE
TO REGISTER A TRADE MARK
IN CLASS 25**

DECISION AND GROUNDS OF DECISION

Background

1. On 30 August 2002 Kevin Scranage of 2 Market Street, Edenfield, Bury, BL0 0JN applied to register the trade mark **FOOK** in Class 25.

2. The goods for which registration is sought are:

Class 25 Clothing, footwear, headgear.

3. Objection was taken against the application under Section 3(3)(a) of the Act because the mark consists exclusively of the word FOOK which is seen as being phonetically very similar (or identical, depending on regional dialect), to the offensive slang word FUCK. The word is seen as being contrary to accepted principles of morality as it sends the message of an offensive word.

4. At a hearing, at which the applicant was represented by The Trade Marks Bureau, his trade mark attorneys, the objection under Section 3(3)(a) of the Act was maintained.

5. 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.

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

The Law

7. 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 the accepted principles of morality”.

The Case for Registration

8. In correspondence dated 8th October 2002 Mr Scranage made three points in support of his application:

“ 1. The OO sound within the word FOOK is pronounced as in “you only get an ooh with TYPHOO.”

2. It is an acronym for Friends only OK

3. There is a registered trade mark FCUK that is quite clearly intended to be associated with, and indeed sends the message, FUCK and has been allowed.”

9. In further correspondence dated 2nd May 2003 from The Trade Marks Bureau, who by now were acting as Mr Scranage’s trade mark attorneys, additional points were made in support of this application:

“We disagree, the word FOOK is pronounced FOOWK and the word FUCK is very precisely pronounced FUK. We also feel that the word FUCK is that precisely pronounced that it cannot be slurred.

Furthermore, there are three existing trade mark registrations that all include the word FOOK which, in Chinese, means “blessing”, a copy of these marks are enclosed for your reference. The reason why there are other marks incorporating the word FOOK is because it is a Chinese surname, we enclose printouts for your reference. It appears from our investigations on BT Phonedisc that there are 5 references to the surname within London. This would indicate that the surname is uncommon and, in accordance with Chapter 6 of the Trade Marks Registry Work Manual, should be taken into consideration when determining the registrability of the mark.”

Copies of the earlier trade mark registrations referred to above are at Annex A.

10. During the hearing, the applicant’s representative advised me that the word FOOK has been accepted as part of a limited company name in spite of the fact that the Companies Act 1985 states that offensive words will not be registered. Subsequently, they provided me with copies of an extract from the Companies Act 1985, notes of guidance on the acceptability of company names together with details of limited companies incorporating the words FOOK or FOOKS into their limited company names. Copies of these documents are at Annex B.

11. In further correspondence dated 12th March 2004 and 16th March 2004 the applicant’s representative made further submissions and provided further documentation in support of this application. Copies of these documents are at Annex C and D respectively.

Decision

12. 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.”

13. The letters which combine to form the word FOOK are such that may lend themselves to two different pronunciations. On the one hand the letters “OO” may lead to the word being pronounced in the same way as the words BOOK, LOOK and COOK or they may lead to it being pronounced in the same way as the words COOT, LOOT and BOOT. At the hearing I advised Mr Scranage and his representative who attended the hearing, that the pronunciation of the word FOOK will vary throughout the United Kingdom depending on the dialect prevalent in any particular region. This application is for “Clothing, footwear, headgear” in Class 25 but at the hearing Mr Scranage advised me that he has an intention to use the trade mark FOOK on T-shirts. These are goods which are often used for the purposes of carrying messages and other non-trade mark matter. It may be different if used only on a swing ticket or label but if used on the front or back of the T-shirt then it may well be seen as a simple message or statement.

14. In parts of the United Kingdom, for example the Midlands and North West of England, aural use of the word FOOK will be interpreted by many as aural use of the word FUCK. When encountered visually the word FOOK will be identified as no more than a visual rendition of the aural pronunciation of the word FUCK. Collins English Dictionary Millennium Edition confirms that FUCK is a taboo word. If the word FOOK is interpreted in parts of the United Kingdom as the aural or visual equivalent of the word FUCK then the word FOOK itself will be recognised as a taboo word.

15. Mr Scranage and his representative have referred me to a number of trade marks accepted in the United Kingdom and by the Community Trade Marks office (OHIM) including the decisions by both offices to register the trade mark FCUK. However, I do not accept that they establish any reason why they should influence the outcome of this application.

16. The comments made in the MADAME case (1996) RPC page 545 were re-stated by Mr Justice Jacobs in the TREAT trade mark case (1996) RPC page 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 TM and the same must be true under the 1994 Act.”

17. Likewise, I do not find the references to limited company names which have been accepted for registration under the Companies Act 1985 to be of any relevance when deciding the merits of this application.

18. It has been stated that the word FOOK is a Chinese surname and is also a Chinese word meaning “Blessing”. While these facts may be correct I do not consider that the word would be so interpreted by the relevant consumer of the goods in question.

19. Finally, Mr Scranage has suggested that the word FOOK is an acronym for “Friends only OK” but again I do not accept that the relevant consumer of these goods would be aware of such an interpretation of the word.

20. On 13th February 2004 Mr Scranage provided me with copies of documents which he claimed supports his view that the word FUCK is in the public domain as an accepted word which no longer causes offence to the average member of the public. I cannot agree with this submission. In my view the word FUCK remains a taboo word, a swear word which causes grave offence, even today, to a significant proportion of the general public. The documents referred to are no longer available. I returned them to Mr Scranage with my letter of 5 March 2004 in which I explained that their content was such that I did not consider it appropriate for them to be placed on a public file which may be available for public inspection. These documents were returned because they contained images which were pornographic in nature and are unlikely to be legally available in the United Kingdom, at least outside a licensed sex shop.

21. I have to consider the reaction of residents in the United Kingdom to the word FOOK 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 FOOK 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.”

22. Clearly there will be some members of the general public who will not be offended when encountering the word FOOK 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?”

23. Having considered the matter through the eyes of the “right-thinking” member of the public I have concluded that use of the word FOOK 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.

24. 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 13th day of May 2004

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

ANNEXES A, B, C & D ARE NOT ATTACHED