

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3604046

BY JIJi PRIME

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASSES 9, 35, 38 AND 41

FANTASYFUCKERY&FOOLERY and FANTASYFVCKERY&FOOLERY

Background

1. On 3 March 2021 JiJi Prime, (the applicant) applied to register the words 'FANTASYFUCKERY&FOOLERY' and 'FANTASYFVCKERY&FOOLERY' as a series of two marks for the following goods and services:

Class 9

Computer software; computer hardware; computer programs; mobile apps; computer software for use in collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects; podcasts; downloadable podcasts; video podcasts; e-books; encoded gift cards; encoded loyalty cards; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media; downloadable and electronic publications; printed publications in electronically readable form; downloadable pre-recorded audio and audiovisual content, information, and commentary; downloadable electronic books, magazines, newsletters, newspapers, journals, and other publications; downloadable digital media and recordings containing sound, images, text, information, signals or software; downloadable electronic publications of books, audio books, magazines, and journals; electronic bulletin boards; website development software; computer software for use in creating and designing websites; software for designing online advertising on websites; communication, networking and social networking software; computer software platforms for social networking; application software for social networking services via internet; computer game software for use on mobile devices; downloadable interactive entertainment software for playing computer games and video games; games, computer games, video games, electronic games, interactive games and virtual reality game software; game development software;

computer games; game programs; computer game and video game discs; computer game and video game cassettes; computer game and video games cartridges; monitors, microphones, earphones and headsets for consumer video game apparatus; blog software.

Class 35

Advertising, marketing and promotional services; business management; business administration; office functions; loyalty, incentive and bonus program services; publicity services; online and offline wholesale, retail, import and export services for the sale of non-medicated cosmetics and toiletry preparations, cosmetics, skincare cosmetics, body care cosmetics, cleansers, exfoliators, beauty masks, cosmetic tonics, lotions and creams, moisturising creams, sunscreen creams, hand creams, body creams, night creams, day creams, eye creams, eye washes - not for medical purposes, soaps and gels, bath and shower gels, bath preparations, bath soaps, baths salts, bath bombs, bubble baths, beauty serums, anti-ageing serums, perfumery, fragrances, incense, essential oils, hair oils, bath oils, body oils, face oils, massage oils, facial massage oils, body massage oils, essences, cleansing milk, body milk, moisturising milk, bath milk, beauty milk, makeup, makeup setting sprays, makeup foundations, concealer, lipsticks, lip gloss, lip liners, blushers, mascara, lash extensions, eye shadows, eye liner, bronzers, skin toners, highlighters (make-up), makeup primers, make-up powder, eye make-up, make-up removing preparations, make-up removers, nail cosmetics, nail care products cosmetics, cosmetic nail preparations, nail polish, nail varnish, nail enamels, nail gels, nail glitters, nail decolorants, nail cream, lotions for strengthening the nails, nail strengtheners, nail hardeners, nail tips, nail whiteners, nail conditioners, false nails, artificial nails, nail care preparations, nail buffing preparations, nail polish pens, nail repair preparations, gel nail removers, nail polish remover pens, nail enamel removers, nail-polish removers, nail varnish removing preparations cosmetics, nail primer, nail art stickers, nail polishing powder, nail polish top coat, nail polish base coat, adhesives for artificial nails, glue for strengthening nails, adhesives for fixing false nails, preparations for removing gel nails, glaze activator for strengthening nails, nail manicure products preparations, nail revitalising lotions cosmetics, nail treatment gels cosmetics, hair products, haircare preparations, hair cleaning preparations, hair shampoos, hair conditioners, hair colourings, hair dyes, non-medicated dentifrices, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, baby wipes, wipes incorporating cleaning preparations, moist wipes for sanitary and cosmetic purposes, facial wipes impregnated with cosmetics, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and

abrasive preparations, smart watches, sunglasses, precious metals and their alloys, jewellery, jewellery made of precious and semi-precious stones, jewellery made of precious and semiprecious materials, jewellery products, articles and items, horological and chronometric instruments, jewellery boxes and watch boxes, gemstones, beads for making jewellery, lockets, medals, necklaces, rings, bracelets, earrings, pins, brooches, amulets, body chains, anklets, chains, charms, trinkets, badges of precious metal, clasps for jewellery, cuff links, clocks, boxes of precious metal, key rings and key chains, and charms therefor, statues and figurines made of or coated with precious or semi-precious metals or stones or imitations thereof, ornaments made of or coated with precious or semi-precious metals or stones or imitations thereof, jewellery cases, jewellery rolls, watches, mechanical watches, wrist watches, alarm watches, pendant watches, automatic watches, electric watches, stop watches, sports watches, pocket watches, watches made of precious metals or coated therewith, quartz watches, platinum watches, silver watches, straps for watches, watches made of gold, bands for watches, chains for watches, straps for watches, parts and fittings for watches, watches with wireless communication function' watches containing an electronic game function, chronographs, chronometers, chronometric instruments, chronoscopes, cases for watches, presentation boxes for watches, bracelets and watches combined, leather and imitations of leather, leather pouches, leather straps, leather boxes, leather bags, bags, luggage and carrying bags, shopping bags, weekend bags, cosmetic bags, wash bags for carrying toiletries, handbags, shoulder bags, carrying bags, cross-body bags, duffle bags, leather bags, travel bags, suitcases, work bags, bum bags, belt bags and hip bags, clutch bags, tote bags, sports bags, sports packs, all-purpose sport bags, gym bags, yoga mat bags, barrel bags, backpacks, rucksacks, camping bags, hiking bags, credit card cases, wallets, purses, pouches, umbrellas, clothing, footwear, headwear, uniforms, workwear, sportswear, gym clothing, thermal clothing, waterproof clothing, maternity wear, sweatbands, wristbands, headbands, leisure wear, beach wear, casualwear, tops, printed tops, shortsleeved, long-sleeved and sleeveless tops, t-shirts, sleeveless tshirts, printed t-shirts, short-sleeved and long-sleeved t-shirts, shirts, polo shirts, vests, tank tops, stringer vests, hoodies, sweatshirts, jerseys, dungarees, overalls, bodysuits, playsuits, jumpsuits, jeans, trousers, skirts, sweat pants, pants, joggers, track pants, shorts, tracksuits, leggings, tights, lingerie, hosiery, stockings, lounge wear, nightwear, pyjamas, robes, underwear and undergarments, slippers, bras, knickers, camisoles, outerwear, jackets, gilets, coats, parkas, ponchos, shawls, waistcoats, bodywarmers, suits, blazers, knitwear, cardigans, sweaters, pullovers, jumpers, dresses, socks, shoes, slippers, sandals, heels, boots, trainers, sneakers, clogs, running shoes, cleats for attachment to sports shoes,

hats, caps, snapbacks, visors, sports headgear other than helmets, scarves, gloves, belts, games, toys and playthings, candles, drinking cups and glasses, drinking bottles, computer software, computer hardware, computer programs, mobile apps, computer software for use in collecting, compiling, storing, registering, creating, managing, summarising, sharing, supplying, transmitting, exchanging, reading, identifying, transcribing, organising, viewing, interpreting, cleansing, consolidating, engineering, calculating, projecting, forecasting, tracking, analysing, assessing, visualising, recording, describing, modelling, researching, transforming, supporting, generating, mapping, operating, controlling, scheduling, dispatching, planning, reporting, monitoring, systemising, settling, updating, maintaining, displaying, and processing data, information, analytics, graphics, projects, podcasts, downloadable podcasts, video podcasts, e-books, encoded gift cards, encoded loyalty cards, apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data, recorded and downloadable media, downloadable and electronic publications, printed publications in electronically readable form, downloadable pre-recorded audio and audiovisual content, information, and commentary, downloadable electronic books, magazines, newsletters, newspapers, journals, and other publications, downloadable digital media and recordings containing sound, images, text, information, signals or software, downloadable electronic publications of books, audio books, magazines, and journals, electronic bulletin boards, website development software, computer software for use in creating and designing websites, software for designing online advertising on websites, communication, networking and social networking software, computer software platforms for social networking, application software for social networking services via internet, computer game software for use on mobile devices, downloadable interactive entertainment software for playing computer games and video games, games, computer games, video games, electronic games, interactive games and virtual reality game software, game development software, computer games, game programs, computer game and video game discs, computer game and video game cassettes, computer game and video games cartridges, monitors, microphones, earphones and headsets for consumer video game apparatus, blog software.

Class 38

Telecommunications services; streaming services; video, audio and television streaming services; streaming of audio, visual and audiovisual material via a global computer network; podcasting; podcasting services; transmission of podcasts; communication by online blogs; providing online forums; online messaging services; providing online chat rooms and electronic bulletin boards; providing

online chatrooms for the transmission of messages, comments and multimedia content among users; chat room services for social networking; providing an online interactive bulletin board; providing access to multimedia content online; broadcasting services; internet broadcasting services; audio, visual and television broadcasting; transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the internet.

Class 41

Education, training, coaching and entertainment services; sporting and cultural activities; organising, arranging and conducting educational and training courses, classes, seminars, events, exhibitions, workshops, tutorials, online courses, conferences, tournaments, games and competitions; providing online entertainment; ticket reservation and booking services for education, entertainment, sports activities and events; ticket information services for shows and entertainment events; provision of entertainment via podcast, webcast and videocast; creation [writing] of podcasts; writing services for blogs; publishing, reporting, and writing of texts; providing online publications; theatrical and drama performances; music, singing, dancing and acting for entertainment purposes; acting and voice over services; game shows; computer and video game services; entertainment services in the nature of computer and video games; online computer game services; online game services; online game services through mobile devices; providing information online relating to computer and video games; providing online entertainment in the nature of game tournaments; provision of games by means of a computer based system; electronic games services, including provision of computer games on-line or by means of a global computer network.

2. On 27 April 2021, the examiner at the Intellectual Property Office issued an examination report in response to the application. The examination report contained an objection under Section 3(3)(a) of the Trade Marks Act 1994 (*"The Act"*) as follows:

The application is not acceptable in Classes 9, 35, 38 and 41 as there is an objection under Section 3(3)(a) of the Act. This is because the mark contains the word 'FUCKERY', a term which would be considered taboo and contrary to accepted moral values within the UK.

The Act states the following:

3(3)a – A mark shall not be registered if it is-

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

Accordingly, as your mark consists of an expression which contains an expletive it is considered that the mark falls foul of the above provision of the Trade Marks Act.

I note that the second mark contains the misspelling “fvckery” however this is unlikely to be observed by the average consumer when first confronted with the mark and as such this misspelling does not change the offensive nature of the expression.

3. On 7 June 2021, a hearing was requested by the applicant. A hearing date was scheduled for 29 June 2021; however, the applicant was unable to attend. The hearing was rescheduled for 20 July 2021, due to connection issues during the hearing of 20 July 2021 it was agreed that we would conclude the hearing on 22 July 2021.
4. During the hearing Ms Prime stated that she was surprised that an objection had been raised because the marks are contrary to public values and disagreed that profanity is immoral. Ms Prime explained that the marks consist of one word consisting of 22 characters. Ms Prime stated that even though *Fuckery* is an element within the marks it is not the swear word *fuck* and instead it is a slang word which refers to a specific type of nonsense that is insidious or malicious in nature. Ms Prime submitted that the word *Fuckery* is not a dictionary defined term and explained that the term originates from the Caribbean and South America. Ms Prime stated that the word *Fuckery* is used in the United Kingdom and it does not cause offence or outrage. Ms Prime also referred to the fact that FCUK is a registered trade mark and this mark could easily be perceived as *Fuck*. Ms Prime pointed out that marks containing profane words are accepted by the USPTO and that the mark ‘FUCT’ has been accepted by the USPTO. Ms Prime referred to earlier marks which have been accepted for registration, including the marks ‘FUCK WINTER’, ‘FUK’, ‘FUQ’ and ‘HO LEE FOOK’; she contended that these registrations indicate that the marks should be accepted. Ms Prime stated that the goods and services are aimed at adults and that to access the podcast she provides, there are safeguards in place and if the customer is not old enough, they cannot access the podcast. Ms Prime stated that Love Island is a popular television show, which promotes sexual activity outside of marriage. She considered that previously this would have been taboo but is now acceptable. Ms Prime contended that the tolerance of television programmes such as Love Island is an indication that the public would not be offended or outraged by swear words. Ms Prime stated that the marks consist of one word made up of twenty-two letters, four of them happen to make out the word *fuck* but this does not stand alone and is therefore not contrary to public values.
5. I issued the hearing report on 23 July 2021, in which I maintained the objection. Ms Prime responded on 25 July 2021 stating that the hearing report did not accurately reflect the conversation at the hearing and that all

her submissions had not been addressed. Ms Prime provided details of this in correspondence dated 22 August 2021. The matter was reviewed by a senior hearing officer and on 27 August 2021 the Registry issued correspondence stating that it was felt that the hearing officer had addressed all the relevant submissions made at the hearing in the hearing report and Ms Prime was advised that if she wished to appeal the decision, she should request a statement of reasons for registrar's decision within a month of the date of that letter.

6. On 3 September 2021, Ms Prime submitted a form TM5 requesting a full statement of reasons for the refusal of the application. In summary, Ms Prime's case for registration is:

- The word *Fuckery* is not the swear word *Fuck*.
- *Fuckery* is not a dictionary defined term and is a slang word which refers to a specific type of nonsense that is insidious or malicious in nature.
- *Fuckery* is a word which originates from the Caribbean and South America, it is a word used in the United Kingdom and it does not cause offence or outrage.
- Trade marks containing profanities are accepted by the USPTO.
- Ms Prime refers to previous registrations by the Registry and the EUIPO as a basis for the acceptance of this mark.
- The brand is aimed at adults.
- The popularity of Love Island which promotes sexual activity outside of marriage, which was once taboo is an indication of the change of societal values.
- The marks consist of twenty-two letters, four of which happen to make out the word *fuck*, which does not stand alone and is therefore not contrary to public values.

The Law

7. Section 3(3)(a) of the Act reads as follows:

Absolute grounds for refusal of registration

A trade mark shall not be registered if it is—

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

The relevant legal principles - Section 3(3)(a)

8. There are a number of judgments of the Court of Justice of the European Union (“CJEU”) which deal with the scope of Article 3(1)(f) of the Directive and Article 7(1)(f) of the Regulation, whose provisions correspond to Section 3(3)(a) of the UK Act. The Trade Marks Act 1994 is largely derived from EU law (Directive 2015/2436). In relation to the interpretation of such retained law, the case law of the Court of Justice of the European Union (CJEU) (including the General Court) issued before the end of the transition period continues to apply, and is binding, as retained EU case law under section 6 of the Withdrawal Act. I derive the following main guiding principles from the cases noted below:

I refer to the principles set out in the Appointed Person decision BL O/137/06 ‘FCUK’ in relation to marks which are said to be ‘contrary to accepted principles of morality’. Paragraph 60 of this decision reads as follows:

“(1) The applicability of section 3(3)(a) depends on the intrinsic qualities of the mark itself and not on circumstances relating to the conduct of the applicant (*Case T-224/01 Durferri GmbH v OHIM* at [76], *Case T-140/02 Sportwetten GmbH Gera v OHIM* at [27]-[29]).

(2) As with any other absolute ground of objection, the applicability of section 3(3)(a) is to be assessed as at the date of application (*Ghazilian* [2002] R.P.C 33 at [44]).

(3) Section 3(3)(a) should be interpreted and applied consistently with Article 10 ECHR. It follows that registration should be refused only where this is justified by a pressing social need and is proportionate to the legitimate aim pursued. Furthermore, any real doubt as to the applicability of the objection should be resolved by upholding the right to freedom of expression and thus by permitting the registration (*Basic Trademark* [2002] R.P.C 25 at [3]-[6]).

(4) Section 3(3)(a) must be objectively applied. The personal views of the tribunal are irrelevant (*Ghazilian* [2002] R.P.C 33 at [31], *Basic Trademark* [2002] R.P.C 25 at [8,] [23], *Stephens v Avery* [1988] Ch 449 at 454B).

(5) While section 3(3)(a) may apply to a mark whose use would not be illegal, the legality or otherwise of use of the mark is a relevant consideration (*Masterman* [1991] RPC 89 at 104 II. 16-17, 38-40).

(6) For section 3(3)(a) to apply, there must be a generally accepted moral principle which use of the mark would plainly contravene (*Ghazilian* [2002] R.P.C 33 at [20]).

(7) 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

for section 3(3)(a) to apply (*Masterman* [1991] RPC 89 at 103 ll. 28-43, *Ghazilian* [2002] R.P.C 33 at [20]).

(8) Section 3(3)(a) does apply if the use of the mark would justifiably cause outrage, or would be the subject of justifiable censure, amongst an identifiable section of the public as being likely significantly to undermine current religious, family or social values (*Ghazilian* [2002] R.P.C 33 at [30], *Scranage's trade mark application* (BL O/182/05) at [8]).

(9) In the case of a word mark, it is necessary to consider the applicability of section 3(3)(a) on the basis of any usage that the public makes of the word or words of which the mark is comprised. Thus the slang meaning of a word may lead to an objection even if its normal meaning does not (Case R 111/2002-4 *Dick Lexic Ltd's Application* [2005] at [8]).

(10) A mark which does not proclaim an opinion, or contain an incitement or convey an insult is less likely to be objectionable than one that does (Case R 111/2002-4 *Dick Lexic Ltd's Application* [2005] at [10], *Basic Trademark* [2002] R.P.C 25 at [11]).

(11) Different considerations apply to different categories of marks (*Basic Trademark* [2002] R.P.C 25 at [12])."

I am also mindful of the Appointed Person's comments in *Scranage's trade mark application* for the mark *FOOK* decision BL O/182/05:

"9. In his written submissions and in the course of argument the appellant accepted, as was inevitable, that in various different regions of the United Kingdom the word FOOK is phonetically indistinguishable from the word FUCK. Indeed, the fact that the mark is, to many, phonetically indistinguishable from the word FUCK is, I have no doubt, one of the reasons it was chosen by the appellant. Nevertheless, he submitted, the word FUCK and other swear words are now often used and accepted in everyday conversation and expression and therefore ought to be allowed to proceed to registration. As illustrations of such usage and acceptance, I was referred to the recent film title "Meet the Fockers" and the well known High Street brand "FCUK".

10. To my mind, however, the acceptance by the appellant that the word FOOK would be pronounced FUCK in various different regions of the United Kingdom places an insuperable difficulty in the path of the application for the following reasons.

11. First, I have no doubt that it would not be appropriate to allow registration of the word FUCK. 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. I can see no justification based on the right to freedom of expression or otherwise to allow such a word to proceed to registration.

12. Secondly, trade marks on t-shirts and other garments are frequently referred to orally and may be advertised by radio, recommended by word of mouth or asked for in a shop. There is therefore ample scope for the mark FOOK to be used in circumstances where it would be indistinguishable from the word FUCK. Accordingly I believe that the mark FOOK has, at least in oral use, the same capacity to cause offence and outrage as the word FUCK. In the context of this application such oral use cannot be disregarded.

13. The Hearing Officer concluded that the use of the word FOOK as a trade mark 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. I agree with him. The mark is excluded from acceptance by section 3(3)(a) of the Act.”

I have also considered the Appointed Person’s comments in Ghazilian’s trade mark application for *Tiny Penis* decision BL O/538/01:

30. In my judgment 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.

31. Aldous J. in Masterman invoked the concept of right-thinking members of the public. I believe this is 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.

32. 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. This does not mean that they must have 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.”

Application of the legal principles

9. The moral principle identified in the ‘FCUK’ decision BL O/137/06 at paragraph 61 was ‘the prohibition on the use of swear words, and in particular their use in contexts where children may be exposed to them’. The same principle must apply here and to this day.
10. The marks are FANTASYFUCKERY&FOOLERY and FANTASYFVCKERY&FOOLERY. I note that all the words in the marks are conjoined, however the marks do not have the appearance of being a neologism. In my opinion upon encountering the sign the average consumer would perceive the marks as the separate words because there is a natural break between the letters ‘Y’ and ‘F’. There is also the ampersand within the mark which in my view would lead consumers to seeing the marks as consisting of a string of words. When considered as a whole I do not consider the word *fuckery* to be lost within the marks. The marks could only be pronounced as the separate words Fantasy, Fuckery and Foolery. A key point in the ‘FCUK’ decision and what distinguishes this case was that FCUK may be orally pronounced as F C U K. In this case there is no avoiding the oral pronunciation of *fuckery*.
11. I must consider the public’s perception of the word *Fuckery*. *Fuckery* is not a dictionary defined word in the Oxford, Collins, Cambridge or Merriam Webster dictionaries. The word *Fuckery* only appears in slang dictionaries such as the Urban Dictionary which states it is a Jamaican Patois term meaning nonsense or bullshit. I believe that consumers would expect that it is a word derived from *fuck* and those who are unfamiliar with the term are likely to perceive *fuckery* as a variant form of the word *fuck*. I agree with Ms Prime, that the public are likely to be more tolerant of swear words, especially as far as the younger generation are concerned and less likely to be offended by them than in 2005, when the FOOK decision was issued. However, the word *fuck* is still considered to be highly offensive for some. In OFCOMs publication [Attitudes to potentially offensive language and gestures on TV and radio: Quick reference guide \(ofcom.org.uk\)](#) published in September 2016, it states on page 6 that the word *fuck* is ‘*Strongest language, unacceptable pre-watershed. Seen as strong, aggressive and vulgar. Older participants more likely to consider the word unacceptable.*’ As such, it is clear that the word *fuck* is still likely to cause offence to a significant section of the general public.
12. I note that the word is not being used in an aggressive or insulting way, in that it is used in a string of independent words and the applicant is not

intending for the mark to offend anyone. However, I must consider the impact of the mark in trade. I note that Ms Prime has stated that in order to access her podcasts, customers have to be over a certain age. However, the mark would still be in the public domain and could be viewed by the public at large. The sign has been applied for in relation to a wide range of goods and services, namely software, computer hardware, education, entertainment, telecommunication services, advertising and the retail of products that would be used by people of all ages. People of all ages could use the applicant's goods and services and could encounter the sign going about their daily lives. Young adults and teenagers in general will be less likely to be offended by the term, however as OFCOM points out the word *fuck* is likely to be unacceptable to older people. I consider the OFCOM guidance to be relevant to this decision, because in terms of broadcasters, the guidance will reflect public tastes and societal norms. I also consider the comments and rulings of the Advertising Standards Authority to be relevant. In an article on the Advertising Standards Authority website [Don't Flub It Up! A parental advisory for profanity in ads \[contains strong language\] - ASA | CAP](#) dated 12 November 2020 it states that '*There are some words that you'll struggle to justify outside of very specifically targeted media – most notably 'the 'F' word' and 'the 'C' word'*'. The article also refers to rulings against advertisements containing "THE END OF THE F*****G WORLD" and "SOBER AS A MOTHERFU", where it was held that both of these advertisements were likely to result in serious and widespread offence, even though the swear word is partially obscured and alluded to. Trade marks are exposed to the public in a similar way as broadcasting services and advertisements and in relation to the goods and services claimed in this application, the mark would be viewed by the general public at large. I also have to consider the impact of the mark on people with young children, who would not want to encounter the mark with their child, I would expect that they would consider the mark to be more than bad taste and would find it offensive. In my opinion those who are offended by the word *fuck* are likely to also be offended by the word *fuckery* and I consider especially in relation to elderly people and parents with children, that a significant proportion of these groups of people will find the mark offensive.

13. In terms of the OFCOM guidance and the Advertising Standards Authority articles and rulings, neither of these determine the registrar's application of Section 3(3)(a), but nonetheless they can be used as factors and external guidance to the application of that Section, as they were in the 'FCUK' decision¹. Both OFCOM and the Advertising Standards Authority guidance may be presumed to be expressions of what society in general (not just the young or a portion of society) may tolerate or be receptive to at a given point.

14. The second mark in the series is FANTASYFVCKERY&FOOLERY and so doesn't contain the exact word *FUCKERY*. I have considered the Appointed

¹ BL O/137/06, see paragraph 89 only by way of example.

Person FCUK decision BL O/137/06. In my opinion the present case differs from the FCUK case. This is because I believe that the *FVCKERY* element in the second mark is clearly intended to be the word *FUCKERY*. The misspelling is subtle due to the letter 'V' being visually similar to the letter 'U'. In my view the mark would only be pronounced as *FUCKERY*. Although the second mark in the series does not contain the actual word, *Fuckery*, it would be interpreted as that word. In the FCUK decision the mark was held to be acceptable as the applicant had a reason for choosing the letters in that sequence, it is an acronym of the term 'French Connection UK'. The acronym FCUK would consequently be pronounced as F-C-U-K and would not be pronounced as *fuck*. Furthermore, the mark FCUK had been used in trade for a number of years and the mark itself had not caused any offence to the general public.

15. I note that marks containing profanities are accepted by the USPTO², however the Registrar is not bound by the decisions of other national offices.
16. Ms Prime has referred to previous acceptances by the Registry and the EUIPO as a basis for accepting this application, however I must state that each mark is examined on its own merits and earlier acceptances do not set any precedent. I refer to the judgement of Jacob J in *British Sugar* [1996] RPC 281 where he stated:

"Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. 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 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 Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence."

17. I have considered all of Ms Prime's submissions in favour of acceptance of the marks, as well as the legal principles set out in the 'FCUK' decision and other cases, however I have concluded that the marks would cause serious offence and outrage to a significant proportion of the public.

² The Supreme Court 'FUCT' decision in *Iancu v Brunetti* 139 S Ct 2294 (2019) has prompted a possible liberalisation in the USPTO, but that of course has no bearing on the Registry.

Conclusion

18. In this decision, for the reasons given above, the application is refused under Section 37(4) of the Act because it fails to qualify under Section 3(3)(a) of the Act.

Dated this 13th day of October 2021

Martyn Jefferiss

For the Registrar

Comptroller-General