

**2021 – Study Question**  
**Registrability of trade marks against public order or morality**

**Questions**

**I. Current law and practice**

*Please answer the below questions with regard to your Group's current laws and practice.*

- 1) a) Are trade marks contrary to public order refused or invalidated under your law?

YES

- b) Are trade marks contrary to morality refused or invalidated under your law?

YES

- c) Please state any applicable legal provisions.

According to Section 7, paragraph 1 in Chapter 2 (regarding obstacles to registration on the basis of the public interest) in the Swedish Trademark Act (SFS 2010:1877) (in Swedish "Varumärkeslagen") a trademark may not be registered where the trademark violates any law, other statutory instrument, standard practice or the public order.

Furthermore, according to Section 1, paragraph 2 in Chapter 3 (regarding general grounds for cancellation of a registration) in the Swedish Trademark Act the registration of a trademark can be cancelled if it has come to violate i.e. a standard practice or the public order.

- 2) a) Is there an explicit definition of public order and/or morality under your law?

NO

- b) If your answer is YES, please state the definition. If your answer is NO, please still indicate what you believe to be the definition.

The terms public order and morality in light of the Swedish trademark law are defined

as the concepts that imply that trademarks should not be offensive or immoral.<sup>1</sup> Particularly, a trademark should not be harmful from religious, moral or political points of view.<sup>2</sup>

It might be added that:

Public order – is a broad definition which in general terms may be explained as a basic principle of legal rules applied in a functioning democratic society.

Morality – is fundamental moral values and standards at which societies adheres in relevant time and space.

c) What is the difference between morality and public order?

Swedish law does not indicate the difference between morality and public order. Both concepts imply that a trade mark should not be harmful from religious, moral or political points of view. The term “public order” was first introduced in the 1960 Trademarks Act (1960:644).<sup>3</sup> According to SOU 1958:10 “Suggestion for the Trademark Act”, morality concept will become less important after introducing the public order term and remained in the text of Trademark Act for the sake of completeness.<sup>4</sup> Yet, Swedish case law shows that morality concept is preferable, or that the concepts are used together.

Furthermore, it shall be added that the concept of the public order is an objective criterion when making an assessment whereas the morality concerns subjective values even though these shall be applied objectively when making an assessment in that regard.

3) a) Is this ground applied to the trademark per se, i.e. to the intrinsic qualities of the trade mark in question?<sup>5</sup> Please answer YES or NO.

YES and NO, there is example of case law where goods and services have been considered in the assessment. Swedish case law (a case which has been named

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<sup>1</sup> The Swedish Government Bill, prop. 2017/18:267, p. 242.

<sup>2</sup> SOU 1958:10 on Suggestions for the Trademark Act (“Förslag till varumärkeslag”), p. 283; Translated to English, SOU is short for “Swedish Governmental Official Reports”, (in Swedish “Statens offentliga utredningar”).

<sup>3</sup> 14 § 3 st. in the 1960 Trademark Act (1960:644).

<sup>4</sup> SOU 1958:10: Förslag till varumärkeslag, p. 284.

<sup>5</sup> The answer should be NO if e.g. also the use of the mark in practice is taken into account (e.g. if it is used for hard drugs), or if the goods or services for which the trade mark is applied for or registered are considered illegal. If circumstances are taken into account that help establish how the public will perceive the trade mark itself, the answer should however be YES; in that case, these circumstances are used to help establish if the mark itself is contrary to public order or morality.

“Pensionärsjävlar”<sup>6</sup> ) indicates that the required approach is to look at both the goods/services applied for and the intrinsic qualities of the trade mark in question.

b) Please explain.

The preparatory works for the 1960 Trademark Act (SOU 1958: 10 p. 283 f) provide that trade marks which are contrary to public order and morality are marks that contain inappropriate representations of religious, moral, and/or politically offensive elements. In the case “Pensionärsjävlar”<sup>7</sup>, the former Swedish Court of Patent Appeal (replaced by the Swedish Patent and Market Court) considered that the concept of “morals” is not static, but changes according to the society we live in. In this sense, account must be taken of the context in which the mark is used. A court must consider the goods and services applied for as well as the public at whom the trade mark is directed<sup>8</sup> (page 4 in the “Pensionärsjävlar”-decision).

- 4) a) What is the relevant date for applying the ground of public order or morality ?
- (i) date of application of the trade mark
  - (ii) date of the examination/assessment by the office or the court** point 1 § 7 chapter 2 (registration)
  - (iii) date of filing of the proceedings (e.g. when the invalidation request is filed)** yes, point 1 § 2 chapter 3 (cancellation of the registration)
  - (iv) other, namely

**The grounds for refusal based on discrepancy to public order or morality may be applied during the examination of the application<sup>9</sup>, opposition period,<sup>10</sup> and after registration as a ground for revocation<sup>11</sup>.**

b) Bearing in mind that views regarding morality and public order can be dynamic and change over time, which of the following is possible?

- (i) refile a trade mark that has been refused or declared invalid for being contrary to public order or morality**

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<sup>6</sup> Decision by the former Swedish Court of Patent Appeal (“Patentbesvärsträtten”, in short “PBR”) on 27.06.2012 in case no 11-110 (“Pensionärsjävlar”).

<sup>7</sup> Decision by the PBR on 27.06.2012 in case no 11-110 (“Pensionärsjävlar”).

<sup>8</sup> Decision by the PBR on 27.06.2012 in case no 11-110 (“Pensionärsjävlar”), p. 4.

<sup>9</sup> Section 17 in Chapter 2 in the Swedish Trademark Act (2010:1877).

<sup>10</sup> Section 24 in Chapter 2 in the in the Swedish Trademark Act (2010:1877).

<sup>11</sup> Section 1 in Chapter 3 in the in the Swedish Trademark Act (2010:1877).

- (ii) **file a new action against a trade mark that previously survived a challenge on this ground**
- (iii) other, namely

Both are possible. Registration of the trade mark may be revoked if the trademark has come in conflict with the law or other regulations or morality or public order.<sup>12</sup> It is not prohibited to refile a trade mark that has been refused or declared invalid for being contrary to public order or morality.<sup>13</sup>

C) Must this ground apply in the entire territory<sup>14</sup> covered by the trademark?  
Please answer YES or NO.

**YES**

- 5) From whose perspective is it judged whether or not a trade mark is contrary to public order or morality?
- (i) **the relevant consumer**
  - (ii) **the general public**
  - (iii) a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered
  - (iv) other, namely
- 6) What factor or factors are taken into account when assessing whether a trade mark is contrary to public order or morality?
- (i) **the meaning of the words or other elements contained in the mark<sup>15</sup> YES**
  - (ii) **the background or origin of the words or other elements contained in the mark<sup>16</sup> YES**
  - (iii) the identity or origin of the applicant/registrant<sup>17</sup> **NO**

<sup>12</sup> Section 1 in Chapter 3 in the Swedish Trademark Act (2010:1877).

<sup>13</sup> Decision by the PBR on 28.10.1994 in case no. 94-017 ("OPIUM") and RÅ 1978 2:9 ("OPIUM").

<sup>14</sup> This question aims to establish if e.g. in the EU the trade mark should be contrary to public order or morality in every member state, or if in a country with multiple languages and other differences it should be contrary to public order or morality in the entire country.

<sup>15</sup> Decision by the PBR in cases no 09-306 ("HORUNGEN"); no 11-110 ("Pensionärsjävlar"); reg.nr 528713 ("Jag är tokig i Säter") and no 95-685 ("ECSTASY").

<sup>16</sup> Decision by the Swedish Patent and Registration Office, in short "PTO" (in Swedish "PRV") on 15.11.2004, app.no 2004/07617, ("Blatte de Luxe").

<sup>17</sup> The criterion usually is not taken into account. However, it may have a certain influence in some cases. For example, the trade mark "HJÄLP MIG JESUS" for printed matter in class 16 (reg no:369074, 29.10.2004) was registered. Primarily, the context of usage has a role in the case. Yet, the identity of the applicant as a religious center might affect the assessment.

- (iv) **the designated goods and/or services<sup>18</sup> YES**
- (v) the goods and/or services for which the mark is used in practice by the applicant/registrant **NO**
- (vi) fundamental rights (e.g. freedom of speech/expression) - **NO**
- (vii) other, namely  
**relevant public<sup>19</sup>**  
**trade mark distinctiveness<sup>20</sup>**  
**the context of use<sup>21</sup>**

7) In what types of proceedings can the morality and/or public order ground be invoked?

- (i) **examination (i.e. ex parte examination by the trade mark office)**
- (ii) **opposition proceedings (i.e. inter partes proceedings before the trade mark is approved for registration, or after registration in jurisdictions with post-registration oppositions)**
- (iii) invalidation/cancellation proceedings before the trade mark office (i.e. inter partes proceedings after the trade mark is approved for registration)
- (iv) **invalidation/cancellation proceedings before a court (i.e. inter partes proceedings after the trade mark is approved for registration)**
- (v) other, namely \_\_\_\_\_

The grounds for refusal based on discrepancy to public order or morality may be applied during the examination of the application<sup>22</sup>, opposition period during three months after the trade mark registration<sup>23</sup> and after registration as a ground for revocation<sup>24</sup>. A party wishing to initiate a proceeding to revoke a registration may bring an action before a Court.<sup>25</sup>

## **II. Policy considerations and proposals for improvements of your Group's current law**

<sup>18</sup> Decision by the PBR in case no 11-110 ("Pensionärsjävlar") and decision RÅ 1976 ref. 174 ("JESUS").

<sup>19</sup> RÅ 1976 ref. 174 ("JESUS"), RÅ 1978 ref. 2:9 ("OPIUM")

<sup>20</sup> Decision by the PBR in case no 94-017 ("OPIUM"), ("Blatteförmedlingen") (reg no 387808, 23.03.2007), "JESUS CHRIST SUPERSTAR" (reg.no 148803, 04.10.1974)

<sup>21</sup> RÅ 1976 ref. 174 ("JESUS")

<sup>22</sup> Section 17 in Chapter 2 in the Swedish Trademark Act (2010:1877).

<sup>23</sup> Section 24 and Section 29 in Chapter 2 in the Swedish Trademark Act (2010:1877).

<sup>24</sup> Section 1 in Chapter 3 in the Swedish Trademark Act (2010:1877).

<sup>25</sup> Section 5 in Chapter 3 in the Swedish Trademark Act (2010:1877).

- 8) Can your Group's current laws or practice relating to the registrability of trade marks contrary to public order or morality be improved? Please explain.

The current laws and practice can should be improved. It is important to introduce the definition of public order and morality and elucidate the difference between them. It should be explained to the Trade mark office and courts in what cases which concept is implied or they should be implied together. Clear criteria and algorithms of assessment have to be established. The Swedish version speaks about "goda seder eller allmän ordning" direct translation "good practice and public order". In the directive, the words chosen is "mot allmän ordning eller mot allmän moral" i.e. "against public order or against public moral". A coherent choice of words would make it more easily understandable.

- 9) Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

The fact that this area is highly harmonized on an EU level may be cause for some issues, as the answer to whether something conflicts with public order and morality is something that will vary depending on cultural context. The Swedish Courts may need to interpret the definition in accordance with European Union law but has must still consider what is morality or not from a Swedish perspective.

### **III. Proposals for harmonisation**

*Please consult with relevant in-house / industry members of your Group in responding to Part III.*

- 10) Do you believe that there should be harmonisation in relation to the registrability of trade marks contrary to public order or morality?

No, we do not believe there shall be a harmonisation as the concept of "morality" is different depending on the history and society structure in each country, i.e. what is acceptable by society in one country is not acceptable in another. The same applies for the concept of "public order".

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

YES

*Even if NO, please address the following questions to the extent your Group considers*

*your Group's current law or practice could be improved.*

11) a) Should trade marks contrary to public order be refused or invalidated? Please answer YES - Refused during the examination.

b) Should trade marks contrary to morality be refused or invalidated? Please answer YES – Refused during the examination or NO.

12) a) Should there be an explicit definition of public order or morality? Please answer YES or NO. As it is difficult to establish the exact term, we deem the criteria is needed instead.

b) If your answer is YES, please state the definition.

c) What should be the difference between morality and public order?

Public order – is a broad definition which in general terms may be explained as a basic principle of legal rules applied in a functioning democratic society.

Morality – is fundamental moral values and standards at which societies adheres in relevant time and space.

13) a) Should this ground be applied to the trade mark per se, i.e. to the intrinsic qualities of the trade mark in question?<sup>26</sup> Please answer YES or **NO**.

b) Please explain.

We refer to the existing order which takes into consideration both aspects and creates flexibility. Please refer to the above point 3.

14) a) What should be the relevant date for applying the ground of public order or morality?

**(i) date of application of the trade mark**

**(ii) date of the examination/assessment by the office or the court**

(iii) date of filing of the proceedings (e.g. when the invalidation request is filed)

(iv) other, namely \_\_\_\_\_

The same as in point 4 above.

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<sup>26</sup> See also footnote 13 above.

b) Bearing in mind that views regarding morality and public order can be dynamic and change over time, which of the following should be possible?

- (i) **refile a trade mark that has been refused or declared invalid for being contrary to public order or morality**
- (ii) **file a new action against a trade mark that previously survived a challenge on this ground**
- (iii) other, namely \_\_\_\_\_

The same as point 4 above.

c) Should this ground apply in the entire territory<sup>27</sup> covered by the trade mark?  
Please answer **YES** or **NO**.

Yes, same as point 4 above.

15) From whose perspective should it be judged whether or not a trade mark is contrary to public order or morality?

- (i) **the relevant consumer**
- (ii) **the general public**
- (iii) a reasonable person with average thresholds of sensitivity and tolerance, taking into account the context in which the mark may be encountered
- (iv) other, namely \_\_\_\_\_

Same as point 5 above.

16) What factor or factors should be taken into account when assessing whether a trade mark is contrary to public order or morality?

- (i) **the meaning of the words or other elements contained in the mark**
- (ii) **the background or origin of the words or other elements contained in the mark**
- (iii) the identity or origin of the applicant/registrant
- (iv) **the designated goods and/or services**
- (v) the goods and/or services for which the mark is used in practice by the applicant/registrant
- (vi) fundamental rights (e.g. freedom of speech/expression)

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<sup>27</sup> See also footnote 14 above.



(vii) other, namely \_\_\_\_\_

Same as point 6 above.

17) In what types of proceedings should it be possible to invoke the morality and/or public order ground?

- (i) **examination (i.e. ex parte examination by the trade mark office)**
- (ii) opposition proceedings (i.e. inter partes proceedings before the trade mark is approved for registration, or after registration in jurisdictions with post-registration oppositions)
- (iii) invalidation/cancellation proceedings before the trade mark office (i.e. inter partes proceedings after the trade mark is approved for registration)
- (iv) **invalidation/cancellation proceedings before a court (i.e. inter partes proceedings after the trade mark is approved for registration)**
- (v) other, namely \_\_\_\_\_

Same as point 7 above.

18) Please comment on any additional issues concerning any aspect of the registrability of trade marks contrary to public order or morality you consider relevant to this Study Question.

We believe that harmonisation when it comes to the assessment whether the trademark is against public order and morality is not possible considering that it is closely related to the standards and structure in society, which differs very much from one country to another.

19) Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

The representative from the Swedish PTO answered the questions 6-7.