

## Memorandum

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Aan AIPPI Nederland  
Van Werkgroep Study Question Q277  
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Betreft Rapportage: Registrability of trade marks against public order or morality

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### 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?**

**Please answer YES or NO.**

YES

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

**Please answer YES or NO.**

YES

**c) Please state any applicable legal provisions.**

- Art. 2.2bis(1)(f) jo. art. 2.11 BCIP (*Benelux-Verdrag inzake de Intellectuele Eigendom*) (examination)
- Art. 2.2bis(1)(f) jo. art. 2.28(1) BCIP (invalidation proceedings before a court)
- Art. 2.2bis(1)(f) jo. art. 2.30bis(1) BCIP (invalidation proceedings before the trade mark office, the Benelux Office for Intellectual Property, BOIP).

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

**Please answer YES or NO.**

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.**

Public order and morality are not further defined in the BCIP (or in Dutch law overall). Decisive for the meaning of morality is what ought to be (by the social judgement), and should be based on an assessment of 'subjective' values (see BOIP Cancellation Division, decision of 24 January 2020, No 3000086 (*#WeareBelgium*), and EFTA Court, 6 April 2017, Case E-

5/16, Municipality of Oslo (*Vigeland*), para 84-86). Public order may be defined as the whole of the rules of law, which determine the constitutional, political, ethical, social and economic foundations on which a democratic society is based, which are mostly laid down in law (Asser/Hartkamp & Sieburgh 6-III 2014/330, 345) and should be based on an assessment of 'objective' criteria (see aforesaid BOIP decision in *#WeareBelgium* and aforesaid EFTA Court judgment, para 84-86).

Relevant to trademark law, at the time of application, to be contrary to public order or morality the sign must be perceived as contrary to the fundamental moral values and norms prevailing in that society at that time (Gielen & Verschuur, *Kort begrip van het intellectuele eigendomsrecht* 2020/312). In specific cases a balance between fundamental rights played a role in the assessment whether a trade mark was contrary to public order or morality (e.g. freedom of speech vs. freedom of religion; see Court of Appeal Amsterdam 30 November 2006, case 04/213 (*Shiva*)).

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

Thus far, Dutch case law does not clearly distinguish between morality and public order.

The two terms are used together and interchangeably (*Industriële eigendom deel 2* 2011/6.1.1). However, in their guidelines, the BOIP refers to the CJEU *Fack Ju Göhte* case (CJEU 27 February 2020, ECLI:EU:C:2020:118).

The BOIP states in this regard that the concept of public order refers to an assessment on objective grounds (see BOIP Cancellation Division, decision of 24 January 2020, No 3000086 (*#WeareBelgium*); see also see aforesaid EFTA Court judgment, para 84-86).

Something is contrary to public order if it is contrary to legislation and regulations as defined by the government authorities in the Benelux-countries. The term morality refers to the basic moral values and norms to which a particular society attaches importance at any given time. This assessment is based on subjective grounds (see aforesaid BOIP decision in *#WeareBelgium*; see also aforesaid EFTA Court judgment, para 84-86)). This concerns the question whether a sign is perceived by the relevant public as contrary to the fundamental moral values and norms prevailing in that society at that time (BOIP Guidelines, p. 37).

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

YES, provided that the goods and services for which a trademark is registered are considered intrinsic qualities of the trade mark.

**b) Please explain.**

A conflict with public order or morality can only arise if the content of the mark itself is contrary to public order or morality (or if the public may perceive it as such, CJEU 27 February

2020, ECLI:EU:C:2020:118) and not if it is used for prohibited purposes (HR 30 November 1945, ECLI:NL:HR:1945:9).

- 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**  
**(iii) date of filing of the proceedings (e.g. when the invalidation request is filed)**  
**(iv) other, namely \_\_\_\_\_**

Answer options (i) and (iii) are correct.

Ad (i), see BenGH 26 July 2000, ECLI:NL:XX:2000:AD3175.

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

Answer options (i) and (ii) are correct.

- c) Must this ground apply in the entire territory covered by the trade mark? Please answer YES or NO.**

NO. The trade mark must only be contrary to public order or morality in a significant part of one of the countries of the Benelux (Industriële eigendom deel 2 2011/6.1.1).

- 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 \_\_\_\_\_**

Answer option (iii) is correct (see: BOIP Guidelines, p. 37).

- 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 contrary to public order or morality.**  
**(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)**
- (vii) other, namely the perception of the public, the context in which the words are usually used**

Answer options (i), (ii), (iv), (vi) and (vii) are correct.

Ad (i) and (ii), see BOIP Guidelines, p. 38; CJEU 27 February 2020, ECLI:EU:C:2020:118).

Ad (iv), an example of a BOIP trade mark rejection in which the designated goods and/or services were taken into account is a trade mark "JODEN", meaning "Jews", for shower heads.

Ad (vi): in the Benelux, fewer trademark applications are refused because the trademark name is contrary to public order or morality. This has mainly to do with the reasoning of the BOIP that the trademark registration should be allowed because of the freedom of expression. See also CJEU 27 February 2020, ECLI:EU:C:2020:118.

Ad (vii): see BOIP Guidelines, p. 38.

- 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 \_\_\_\_\_**

Answer options (i), (iii) and (iv) are correct.

Ad (i), see art. 2.2bis(1)(f) jo. art. 2.11 BCIP.

Ad (iii), see art. 2.2bis(1)(f) jo. art. 2.30bis(1) BCIP.

Ad (iv), see art. 2.2bis(1)(f) jo. art. 2.28(1) BCIP.

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

- 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.**

NO. The Dutch Group is of the opinion that the Benelux laws and practices relating to this topic provide sufficient legal certainty and predictability for trade mark proprietors and the general public, whilst also being sufficiently flexible for adequate decisions in individual cases.

**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?**

NO.

**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?**

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

*Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.*

The Dutch Group considers harmonisation of the concepts of morality and public order to be undesirable and to a certain extent even impossible. This is due to the fact that the notions of morality and public order are interpreted differently in each jurisdiction worldwide and depend heavily on the local culture, political system and religious beliefs. In addition, the notions of public order and morality are rather fluid and subject to change. Therefore, harmonisation of these concepts may lead to an undesired consequence of the laws not being able to keep up with local developments (such as a specific movement or suddenly popping up cultural phenomenon).

Further, the Dutch Group is of the opinion that there should be a high threshold for refusing or invalidating a trade on these grounds. The Group namely believes that applicants of trade marks should be able to protect their trade marks as much as possible. Therefore, far-stretching restrictions based on public order/morality, which are dynamic as of their nature, are not desirable in general.

**11) a) Should trade marks contrary to public order be refused or invalidated? Please answer YES or NO.**

YES

**b) Should trade marks contrary to morality be refused or invalidated? Please answer YES or NO.**

YES

**12) a) Should there be an explicit definition of public order or morality? Please answer YES or NO.**

NO.

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

n/a

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

The concept of public order refers to an assessment on objective grounds. Something is contrary to public order if it is contrary to legislation and regulations. The term morality refers to the basic moral values and norms to which a particular society attaches importance at any given time. This assessment is based on subjective grounds.

**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? Please answer YES or NO.**

YES.

**b) Please explain.**

The Dutch Group recognises that certain signs that by themselves may not be offensive, may still be contrary to morality (or public order) in connection to certain goods or services. For example, for a Dutch public a trade mark "FORTUYN" for bullets would immediately refer to the assassination of a controversial and famous politician in the Netherlands, whereas "FORTUYN" for cookies or bicycles would likely not be problematic, and even though ammunition is by itself not an illegal good to trade in. As another example, the Benelux Office for Intellectual Property has refused the application for a trade mark "JODEN" (meaning JEWS) for shower heads, because of its reference to World War II. This illustrates that it is necessary to examine the trade mark as a whole, i.e. including the goods and/or services for which protection is sought. The Dutch Group considers the goods and services for which protection is sought as intrinsic qualities of the trade mark in question. However, according to the Dutch Group the use of the mark *in practice* should not be taken into account, as this may vary and is not part of the trade mark registration.

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 \_\_\_\_\_

Answers (i) and (iii) should be the relevant dates.

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 \_\_\_\_\_

Answers (i) and (ii) should both be possible.

c) Should this ground apply in the entire territory covered by the trade mark? Please answer YES or NO.

NO. The ground should apply in a significant part of the territory.

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

The Dutch Group is of the opinion that answer (iii) is correct.

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)**

**(vii) other, namely the perception of the public, the context in which the words are usually used**

The Dutch Group is of the opinion that answers (i), (ii), (iv), (vi) and (vii) are correct.

**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 \_\_\_\_\_**

The Dutch Group is of the opinion that answer (i), (iii) and (iv) are correct.

**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.**

The Dutch Group refers to its answer to Question 10.

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

The Dutch Group comprises attorneys-at-law and trademark attorneys, tasked with managing trade mark portfolios. Specific input from in-house counsel has not been obtained. The Dutch Group is however confident that it represents the views of the industry (especially the industry which operates internationally) in the Netherlands in saying that it is in the interest of the trademark owners that there should be a high threshold before a trademark is refused on the ground that it is contrary to morality or public order. The ex officio examination should be as restrictive as possible. There is also a task for trademark attorneys in different jurisdictions, to inform potential applicants about the particularities of their respective jurisdictions in this respect.