



# When is Offensive, Too Offensive?

**Scott Miller**

Co-Managing Partner

# Apologies in Advance

- Dr. Teresa Scassa;
- Dr. Florian Martin-Bariteau; and
- Anyone else I'm about to offend.

## *Trade-marks Act, s. 9(1)(j)*

9(1) No person shall **adopt** in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

(j) Any scandalous, obscene or immoral word or device.

# What's Offensive?

What the

# FUCK

Cancer

- Is anyone offended?

# What's Offensive?

- OTTAWA SENATORS
- EDMONTON ESKIMOS
- OTTAWA JEWS



- CLEVELAND INDIANS



# Who needs to be offended?

- Public at Large vs. Individual?
- A scandalous word/design is one which is offensive to the **public or individual sense of propriety or morality**, or is a slur on nationality and **generally regarded as offensive**, causing outrage or indignation (Trademarks Examination Manual).

# “LOOTERY”

- In the absence of direct evidence that the **public** would be offended by the term, the argument is tenuous:

“I seriously doubt that the public would be scandalized by seeing the trade-mark LOOTERY. On the contrary, I suspect that they would view the mark as an amusing coinage suggesting that someone participating in the applicant's contests can win "loot" in the everyday sense of that word, namely, money or goods rather than plunder or spoils. Thus, I find that the opponent has failed to satisfy its evidential burden and the first ground is therefore unsuccessful.”

# *Drolet v Stiftung Gralsbotschaft*

- Must be offensive to the general public, and not just a smaller group.
- The FC held that the subjective feelings of a group of people who felt a mark was being used to spread a false message, and were therefore offended, was insufficient to find that a mark violated section 9(1)(j).





# Uneven Application of s. 9(1)(j)

- FAT BASTARD – reg. 4/7/03 (wine).
- FAT BASTARD – reg. 3/15/06 (plush toys).
- FAT BASTARD BURRITO – reg. 3/2/12 (clothing/restaurant).
- DOUBLE BASTARD – reg. 5/26/15 (beer).
- LUCKY BASTARD VODKA – filed 3/25/11 – **refused!**
- LUCKY BASTARD – filed 1/15/15 – **TBD.**

# Human Rights: Nepean Redskins

- In 2013, Juno-winning musician, Ian Campeau, filed a human rights complaint alleging discrimination because of race and colour.
- Following public outrage, the Nepean Redskins changed their name to Nepean Eagles.
- Football club's president stated the name was offensive and divisive to the community.



# How to Attack?

## Trade-marks Act

- 9(1) - No person shall **adopt** ... offensive.
- What if the mark has been previously used?
- 11 - No person shall use in connection with a business, as a trademark or otherwise, any mark contrary to s. 9 or 10

## Human Rights Code

- Part I: ancestry, colour, race; ethnic origin; gender; disability; sexual orientation, etc.
- No inherent jurisdiction...what about an injunction?

## Torts

- Possible?

# American Comparison

## s.2(a) *Lanham Act*

- Marks must be considered disparaging by a **substantial composite of the target group** *at the time the trademarks are issued to registration.*
- Only registration is prohibited: cancellation of the registration does not preclude use of the mark.

## s.2(a) *Lanham Act*

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute...

# Washington Redskins

## *Blackhorse v Pro-Football Inc*

- June 2014 – Trademark Trial and Appeal Board (TTAB) – cancelled 6 Redskin trademarks.
- July 2015 – US District Court VA – affirmed TTAB decision – denied arguments re: First Amendment Right to free expression.
- Oct. 2016 – Supreme Court – refused leave to appeal by Redskins re: constitutionality of *Lanham Act* in refusing the reg. of trademark that disparages “persons, living, or dead, institutions, beliefs, or national symbols.”

# *In re Simon Shiao Tam*

## “THE SLANTS”

- April 2013 – TTAB – denied registration.
- April 2015 – US Court of Appeals Fed. Circuit – affirmed TTAB decision.
- Dec. 2015 - US Court of Appeals Fed. Circuit (en banc) - found that the bar on registration of “disparaging” marks under s. 2(a) of the *Lanham Act* is unconstitutional and violates the First Amendment (freedom of expression).
- Jan. 2017 – Supreme Court – TBD.

# Canadian Charter of Rights and Freedoms

2. Everyone has the following fundamental freedoms:

(b) freedom of thought, belief, opinion and **expression**, including freedom of the press and other media of communication



**15. (1)** Every individual is equal before and under the law and has the right to the equal protection and equal benefit of the law without discrimination and, in particular, without discrimination based on race, national or ethnic origin, colour, religion, sex, age or mental or physical disability.

**(2)** Subsection (1) does not preclude any law, program or activity that has as its object the amelioration of conditions of disadvantaged individuals or groups including those that are disadvantaged because of race, national or ethnic origin, colour, religion, sex, age or mental or physical disability

# Offensive or Not?

- Atlanta Braves
- Chicago Blackhawks
- Cleveland Indians
- Edmonton Eskimos
- Kansas City Chiefs
- Langley Warriors
- Minnesota Vikings
- Mississauga Tomahawks
- Washington Redskins

# Licence Plates

- Manitoba Public Insurance (MPI) revoked a Star Trek fan's personalized licence plate: **ASMIL8**, as it was deemed offensive to indigenous people.
- Lorne Grabher of Nova Scotia, had his licence plate (**GRABHER**) revoked after it was deemed too offensive to women.

# THANK YOU

## COMMENTS AND QUESTIONS

**Scott Miller**

Direct: 613.801.1099

Cell: 613.292.2225

Email: [smiller@mbm.com](mailto:smiller@mbm.com)