

Challenging the Ban on Offensive Marks: Is s 9(1)(j) F***ed?

Introduction

In 2017, Simon Tam and his band, The Slants, successfully felled section 2(a) of the *Lanham Act*, the provision of US trademark law that barred registration of offensive or disparaging marks. According to Tam, the band's name was chosen to reclaim a word that many consider a slur against Asian people. Indeed, it was on that ground that Tam's attempts to register "The Slants" was initially refused.¹ The Supreme Court of the United States held that the provision violated the men's First Amendment rights to free speech and struck the provision down.

The case garnered considerable media attention in the US, but Canada has had significantly less discourse surrounding this issue and even less jurisprudence. What, then, is the current state of Canadian law on the topic of potentially offensive trademarks? And how well-equipped is that law to face a Charter challenge based on section 2(b) and the right to freedom of expression?

The State of the Law

The *Trademarks Act* states:

9 (1) No person shall adopt in connection with a business, as a trademark 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;²

¹ Bill Chappell, "The Slants Win Supreme Court Battle Over Band's Name in Trademark Dispute" (19 June 2017) online: NPR <<https://www.npr.org/sections/thetwo-way/2017/06/19/533514196/the-slants-win-supreme-court-battle-over-bands-name-in-trademark-dispute>>; *Matal v Tam*, 582 US __ (2017).

² *Trademarks Act*, RSC 1985, c T-13, s 9(1)(j) (emphasis added).

The Canadian Intellectual Property Office's ("CIPO") published guidelines says that a mark is offensive if it "would offend the feelings or sensibilities of a not insignificant segment of the public."³

However, these guidelines are not binding nor have they received much testing in the Courts. The Federal Court has only considered s 9(1)(j) twice.⁴ In *Miss Universe Inc v Bohna*, they held that the word "nude" in MISS NUDE UNIVERSE was a "perfectly acceptable adjective"⁵ and not offensive. More recently, in *Drolet v Stiftung Gralsbotchaft*, the plaintiff tried to challenge the registration of an obscure religious mark by a rival sect of the spiritual "Grail Movement". The Court dispensed of his s 9(1)(j) argument in a single sentence: "Nor am I satisfied that the use of this logo would be obscene, scandalous or immoral within the meaning of paragraph 9(1)(j) of the Trade-marks Act, even if it may outrage those who, like Mr. Drolet, believe that the defendants are not spreading the original message of Oskar Ernst Bernhardt."⁶

The upshot of this lack of judicial guidance combined with the necessarily discretionary nature of administrative decision-making has resulted in highly different interpretations of what is immoral. At times, this discretion seems to result in arbitrariness. For example, CIPO denied a mark to LUCKY BASTARD VODKA based on s 9(1)(j), despite FAT BASTARD (wine) and FAT BASTARD BURRITO already being registered.⁷ There are other extant registered marks that that are, perhaps, questionable under CIPO's guidelines. Allusions to common four-letter vulgarities have been registered (FIT AS FUK sportswear, REFRESHSHT bathroom spray), as

³ Canada, Canadian Intellectual Property Office, *Trademarks Evaluation Manual*, (Ottawa: Canadian Intellectual Property Office, 2019) at para 4.7.6.

⁴ Section 9(1)(j) has been argued in more cases than this, but the Court came to its decision on other grounds and did not address those arguments. See, e.g., *Susan Fielder Inc v Cohen*, 2013 FC 967, *Canadian Jewish Congress v Chosen People Ministries Inc*, 2002 FCT 613.

⁵ *Miss Universe v Bohna*, [1992] 3 FC 682, FCJ No 608 (rev'd on other grounds), at para 14.

⁶ *Drolet v Stiftung Gralsbotchaft*, 2009 FC 16, at para 166.

⁷ Lauren Blaiwais & Scott Miller, "Offensive Trademarks: The Canadian and American Perspectives" (2018) 30:2 IPJ 205 at 211.

have marks of an overtly sexual nature (CUMBRELLA, a condom company). Words with a common, non-offensive meaning that can also be used as slur have also been accepted (think transmission fluids).

Trademark Prohibition and Freedom of Expression

Approval by CIPO can only tell us so much. Whether these marks would withstand a court challenge is very much an open question. And while the public interest in Cumbrella's trademark protection may be low, the right of vulnerable groups to express themselves is a significant consideration in the Supreme Court of Canada's ("SCC") s 2(b) jurisprudence.⁸ How would the SCC resolve an issue like The Slants'?

Though too early to say with certainty, the right fact pattern for a constitutional challenge may be brewing. In February 2021, LGBTQ+ non-profit Dykes on Bikes ("DOB") received a notice of potential opposition of their pending trademark. Presuming the opposition is to "dyke" being a pejorative term for a lesbian, we have a useful hypothetical for applying a Charter analysis.⁹

What constitutes "expression" in Canada is incredibly broad, and finding an infringement of s 2(b) is a low threshold. Advertising and the use of one's own trademarks have been recognized as a form of expression since at least the *RJR-MacDonald* decision in 1995.¹⁰ A finding of infringement is therefore all but certain; the question is whether the infringement is justifiable under section 1 of the Charter.

Justification is determined by the *Oakes* test, which has two requirements: the law must have a "pressing and substantial objective", and it must pass a proportionality test finding it to be

⁸ *Irwin Toy Canada Ltd v Quebec (Attorney General)*, [1989] 1 SCR 927, 58 DLR (4th) 577, at para 80. ["*Irwin Toy*"]

⁹ I tried reaching out to Dykes on Bikes to confirm the substance of the objection but received no response.

¹⁰ *RJR-Macdonald Inc v Canada (Attorney General)*, [1995] 3 SCR 199, 127 DLR (4th) 1.

rationally connected to that objective, minimally impairing in achieving it, and not grossly disproportionate in its positive and negative effects.¹¹

For the sake of brevity, we will assume s 9(1)(j) passes the relatively low thresholds of pressing and substantial objective and rational connection. Minimal impairment is where most laws facing a Charter challenge are found unjustifiable, and it would be easy to argue that Parliament scrapping the blanket ban and simply including clearer rules may strike a sufficient balance. However, the strongest argument against s 9(1)(j) lies in the final prong of the analysis: gross disproportionality.

Like *The Slants*, DOB chose its name to reclaim a slur. The act of naming therefore functions to lessen the offensive nature of the word “dyke”. A blanket ban on use of such a mark might prevent offence to some, but also denies marginalized groups a tool to define their own identities. Community participation and individual self-fulfilment, both “core values” of freedom of expression requiring greater state protection, are strongly implicated here.¹²

A further consideration is the probation on *adoption*, rather than just use. DOB registered their mark in the US only after discovering another party was using their name to sell merchandise for a profit.¹³ Were such a situation to arise in Canada, DOB would be denied both the protection of a registered mark *and*, theoretically, access to the tort of passing off, since even unregistered use of their mark would be disallowed. Given the LGBTQ+ community’s status as a marginalized or vulnerable group, so greatly restricting their rights simply for the benefit of preventing offence to the general public appears to be grossly disproportionate on its face.

¹¹ *R v Oakes*, [1986] 1 SCR 103, 26 DLR (4th) 200.

¹² *Irwin Toy*, *supra* note 7, at para 54.

¹³ “Federal Court of Appeal Rules in Favor of Dykes on Bikes in Landmark Trademark Case” (12 July 2007) online: National Center for Lesbian Rights (blog) <www.nclrights.org/about-us/press-release/federal-court-of-appeal-rules-in-favor-of-dykes-on-bikes-in-landmark-trademark-case/>.

Both the non-minimally impairing and disproportionate affects of s 9(1)(j) could be addressed with small amendment the *Trademarks Act*. Something to the effect of:

- 9 (1) (j.1)** Notwithstanding paragraph 9(1)(j), a mark otherwise ineligible for registration under that paragraph may be adopted where it can be reasonably shown that
- (i) the mark is considered scandalous, obscene or immoral because it disparages a group protected under paragraph 15(1) of the *Constitution Act, 1982*,
 - (ii) the trademark holder is a member of that protected group, and
 - (iii) a significant number of members of that protected group would not find the use of the mark offensive within the given context.

This example is not meant to be a perfect formulation, nor would it appease free expression absolutists who see s 9(1)(j) abolished entirely. However, it represents a more attainable adjustment to a blanket prohibition that has the potential to disproportionately affect marginalized groups by narrowing the scope of who must find the mark offensive in order to prevent its adoption. The purpose of s 9(1)(j) would remain intact, but more power would be granted to marginalized individuals to define their identities by removing what is, ultimately, a paternalistic constraint on their expression.