

I. FREE SPEECH VS. GOOD TASTE IN TRADEMARK REGULATION IN MEXICO.

Since the foundation of Mexico as an Independent Sovereign State, back in the summer of 1821, the principle of Constitutional Supremacy has been a constant in the legal theory. This principle equally applied to the original conception of the Nation as a Constitutional Monarchy, under the Iguala Plan and the Cordoba Treaty -the declaration of Independence documents-, as it has to the Constitutional Republic established shortly thereafter and reestablished a few times throughout history. It is certainly true under the current Constitution, which dates to 1917. However, an exception to this paradigm was introduced through a Constitutional reform on June of 2011, under the principle of *pro homine* or *pro personae* interpretation regarding Human Rights. The *pro homine* or *pro personae* principle for interpretation of human rights normativity requires securing the most ample and beneficial protection to the person/individual. This allows for an International Treaty to supersede the Constitutional rule, if in connection with human rights, the Treaty provides for more ample or beneficial protection of such right. The second paragraph of article 1 of the Constitution of Mexico, introduced on June 6, 2011, states that “... *regulations in connection with human rights shall be interpreted in accordance with this Constitution and with international treaties on such subject matter, favoring the amplest protection to the person at all times*”. Thus, such hierarchy of law in Mexico demands a multilevel study of supranational and national legal dispositions, as well as the Judicial interpretation of such normativity, in order to harmonize a coherent posture that would allow us to reach a plausible legal conclusion. We shall, hence, separate the study into a) supranational legal framework on free speech; b) Constitutional legal framework on free speech; c) International and national legal framework on distasteful trademarks; d) supranational and national legal framework in connection with distasteful trademarks; e) conclusions.

a) Supranational legal framework on free speech

Mexico, as many other Latin American countries, is a signatory party to several International Treaties in connection with human rights. To name a few, the Universal Declaration of Human Rights; the American Convention on Human Rights “Pact of San Jose Costa Rica”; and the International Covenant on Civil and Political Rights. We will devote our study solely to Article 13 of the American Convention on Human Rights “Pact of San José Costa Rica”, as out of the three aforementioned treaties, this one provides de most ample or unrestricted protection to freedom of speech. Said article reads as follows:

American Convention on Human Rights “Pact of San Jose Costa Rica”

Article 13. Freedom of Thought and Expression

1. Everyone has the right to freedom of thought and expression. This right includes freedom to seek, receive, and impart information and ideas of all kinds, regardless of frontiers, either orally, in writing, in print, in the form of art, or through any other medium of one's choice.

2. The exercise of the right provided for in the foregoing paragraph shall not be subject to prior censorship but shall be subject to subsequent imposition of liability, which shall be expressly established by law to the extent necessary to ensure:

- a. respect for the rights or reputations of others; or
- b. the protection of national security, public order, or public health or morals.

The American Convention on Human Rights establishes a duality within the freedom of expression. Every person has the right to express him/her self, but also the society, as a whole, has the right to receive the information expressed by any person. The correlation of free speech and the right to information conform not only an individual right, but also a social or collective one. The individual side of the coins assures the right to express one's own thoughts, ideas and opinions; while the

collective side of the coin obliges the State to ensure that all members of the society are allowed to receive information on other's thoughts, ideas and opinions. This liberty, in the dual form thereof, may not be restricted *a priori* by the State. Prior censorship is prohibited. However, people must own the message, thought, idea or opinion and, therefore, be subject to liability, *a posteriori*. The liability or torts that may arise from the expression of thoughts, ideas or opinions are to be restricted, however, to actual damage in connection with rights or reputations of third parties or the protection of national security, public order, public health or public morals.

The Inter-American Commission for Human Rights, in Support of the Special Rapporteur for Freedom of Expression, has adopted a "Declaration of Principles on Freedom of Expression", setting forth a series of thirteen principles relating to Article 13 of the American Convention of Human Rights. The international organization has also issued the "Background and Interpretation of the Declaration of Principles", based on doctrine and jurisprudence on the subject matter, which result particularly enlightening in understanding the stretch and the limits to free speech. We will come back to said principles and interpretation guidelines further on, as same will be key in understanding the current legal framework applicable to "distasteful" trademarks.

b) Constitutional legal framework on free speech

Mexico was founded as a Religious State. The Catholic Monarchy Constitution adopted in 1821 and the Republic established shortly thereafter, in 1824, both stated that the Roman Catholic religion was to be the only tolerated religion in the land. Thus, the values and principles of the Catholicism have had a great influence in Mexico, since its transition through history -not without bloodshed- to becoming, a Lay State, an up to date. In the recognition of "freedom of belief" and "freedom of cult", the Roman Catholic values and moral standards have been present not only as a social convention of behavior but inserted within our laws. An example of said influence are articles 6 and 7 of the Constitution, relative to free speech, and article 4 of the Industrial Property Law, relative to our subject matter of related to "bad taste" trademark registrations.

Article 6 of the Mexican Constitution clearly states that "free speech" is not an unrestricted right, as it indicates that the manifestation of ideas will not be subject to judicial or administrative inquisition/examination, UNLESS it is deemed an attack on morality, and invasion of private life or rights of third parties, instigates a crime or disrupts public order. Article 7 thereafter reaffirms the inviolability of the right to transmit and disseminate opinions, information and ideas by any means or media, with no other restrictions than those indicated in article 6 herein above.

The use of the phrasing "*...will not be subject to judicial or administrative inquisition, unless ...*" within the Constitutional text had been consistently interpreted as permissive of prior censorship. However, after the above-mentioned reform to article 1 of the Constitution, introducing the *pro homine* principle, the interpretation has changed -or should change- to conform to the standards of article 13 of the American Convention of Human Rights, which should supersede the more restrictive Constitutional text. The aforementioned change is clear in connection with journalism, periodic publications, radio/TV broadcasting, etc., not only on the legal precedents and changes in the legal framework, but also noticeable in everyday life. Very few years ago it would be unthinkable to hear the use of foul language in television, news casts or read them in the newspaper. Currently, it is an increasing trend. I believe that we are starting to live the euphoria of a new-found freedom and abuse thereof will be unavoidable, but in time it should autoregulate and return to acceptable social conventionality.

c) International and national legal framework on distasteful trademarks

In line with the more restrictive text of articles 6 and 7 of the Constitution -and complying with current NAFTA obligations as stated under article 1708, section 14-, the Industrial Property Law states (article 4) that no patent, registration or authorization will be granted, nor will any figure or legal institution regulated in said law be published in the Gazette, when the content thereof or the form in which it is presented contravene public order, morality and good custom, or are contrary to any law. The phrasing used by the national legislator in article 4 of the Industrial Property Law, as to the refusal of trademarks or other IP rights if the content thereof contravenes morality, is far too broad and vague, giving leeway to all sorts of subjective “opinions” and “value judgments”. In practice, this value judgments are closely linked or identified with “traditional Catholic morality.”

In the only published precedent, regarding trademark refusal, that we are aware of, the Ninth Collegiate Tribunal for Administrative Matters for the First Circuit, in Mexico City, issued a Judicial Thesis in 2015, identified under the alphanumeric clue I.9°.A.74 A (10^a), substantially stating that any trademark comprised of or containing “... *an allusive synonym to products that are prohibited as to their preparation, agriculture, acquisition, commercialization, use or consumption within the national territory ...*” must be denied in terms of article 4 of the Industrial Property Law, since otherwise considered “... *such a circumstance would constitute a glorification to the consumption of such products, which would contravene the public order, morality and good custom, because the publicity of a trademark with terms that are synonyms to prohibited substances that cause physical and mental alterations, constitutes an incitement to its consumption ...*”. It should be noted that even when the precedent was published in 2015, after the 2011 Constitutional reform, because of the time frame in the Mexican applications, it is likely that the judgement refers to an application filed prior to 2011.

Under NAFTA, while the text does contain more specificity, it also references to “immorality”, which again provides for a personal subjective opinion on what is good and what is bad behavior. It is not a Government function to determine what is morally plausible behavior and what it is not; at least not in a Liberal State. The obligation under article 1708, section 14 of NAFTA provides for the refusal of registration of trademarks “... *that consist of or comprise immoral, deceptive or scandalous matter, or matter that may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or any Party’s national symbols, or bring them into contempt or disrepute*”.

NAFTA is soon to be replaced by the new USMCA Treaty. We do not have knowledge of what the IP Section of the Treaty stipulates or if it is different to the text today. In any case, I do have doubts on the enforceability of the obligation in Mexico and Canada, if the US has decided -in view of the *Matal v. Tam* resolution- not to comply with such obligation and not to enforce such a cause for refusal. This is a question I do not intend to answer at present but do desire to raise and leave on the table, just for argument sake.

d) Applicable rule and procedure for the legal solution

The applicable legal framework in Mexico, article 1708, section 14, of NAFTA and article 4 of the Industrial Property Law, while concurrent with articles 6 and 7 of the Mexican Constitution, is more restrictive of the right of free speech and dissonant with article 13 of the American Convention of Human Rights, principles and interpretation thereof. Therefore, should be unapplied. However, the waiver of the local law is not automatic, as long as a general declaration of unconstitutionality has not been issued. It is an individual privilege that needs to be granted by the Judiciary, through litigation -Constitutional proceedings-. We will therefore explore the theory and the practical aspects of pursuing an application to register a distasteful trademark.

(i) Legal Argument

In the Constitutional and Human Rights theory, if articles 4 of the Industrial Property Law and/or article 1708, section 14, of NAFTA contravene or limit the scope of the right of freedom of speech, same shall be deemed inapplicable, favoring the most beneficial rule. While these articles are in line with articles 6 and 7 of the Mexican Constitution, article 13 of the Pact of San Jose Costa Rica does provide a more ample and beneficial protection to the individual. Thus, the international treaty on human rights should take preference over all the aforementioned normativity. The First Chamber of the Supreme Court in Mexico, on the Jurisprudence Thesis identified as 1ª L/2014 (10ª), issued on February 2014, has aligned the interpretation of the Constitutional text to that of the “Declaration of Principles on Freedom of Expression” and “Background and Interpretation of the Declaration of Principles” issued by the Inter-American Commission for Human Rights. On this thesis, the Supreme Court indicates that restrictions to the freedom of speech are an exception, not a general rule and as such, they must be interpreted restrictively. Also, the Supreme Court indicate that the terms “morals” and “good custom”, contained in the constitutional text “... *may not be identified with the cultural conventions prevailing in society at a certain time, but should be limited to “public morality”, as the nucleus of basic and fundamental conventions about what is good and bad in society ...*”. That “... *restrictions should not be applied in a form that would promote prejudice and intolerance, but by protecting minority opinions, including those that make us uncomfortable. Therefore, it is important to make the distinction between incentivizing an immoral conduct, which could constitute legitimate basis for limitations, and the expression of dissident opinions or the rupture of taboos.*” The Supreme Court has further determined that any and all limitations to the freedom of speech (a) must pursue constitutionally valid ends/goals; (b) be necessary to achieve such an end/goal; and (c) must be proportional -measured response to achieve the end-.

Attaining to the “Declaration of Principles on Freedom of Expression” and “Background and Interpretation of the Declaration of Principles” issued by the Inter-American Commission for Human Rights, as well as the Supreme Court interpretation of the valid limitations, by reason of “morality” or “good costume”, we consider that on the specific subject matter of distasteful trademarks, it appears clear that article 13 of the American Convention of Human Rights should prohibit the refusal of registration on the grounds of such a personal value judgment on acceptable or unacceptable behavior. Principles 1, 2 and 5, and the interpretation guidelines thereof are of particular value to our analysis.

Principle 1

Freedom of expression in all its forms and manifestations is a fundamental and inalienable right of all individuals. Additionally, it is an indispensable requirement for the very existence of a democratic society.

Paragraph 8 of the “Background and Interpretation of the Declaration of Principles” issued by the Inter-American Commission of Human Rights, points out that it should be emphasized or noted that the principle refers to freedom of expression “*in all its forms and manifestations*”. It is not limited to the media or people exercising their right through the media. Free speech or “... *the right to freedom of expression includes artistic, cultural, social, religious and political expressions, as well as any other type of expression*”. The wording used in the interpretation guidelines (paragraph 8) clearly includes economic talk, commercial speech, commercial imaging and distinctive signs. A trademark, as a distinctive sign, serves the functions of indication of origin and quality guaranty, both strong messages destined to the consumer, for an informed choice.

Principle 2

Every person has the right to seek, receive and impart information and opinions freely under terms set forth in Article 13 of the American

Convention on Human Rights. All people should be afforded equal opportunities to receive, seek and impart information by any means of communication without any discrimination for reasons of race, color, sex, language, religion, political or other opinions, national or social origin, economic status, birth or any other social condition.

The second principle relays to the duality of the right of freedom of expression, that would be applicable to trademark owners as the people originating the message, and the public consumer as the collectivity who is entitled to receive the information, to make an informed choice on what to spend their money. Said right, in its duality, may not be restricted on a matter of opinion of any kind. Moral standards or viewpoints regarding morality may not be used as grounds for denying the right to emit the message, nor to restrict the right of the recipients of said message to be duly informed. Paragraph 9 of the “Background and Interpretation of the Declaration of Principles”, points out the imperativeness to eliminate any and all measures that prevent the full participation of the individual, among others, in the economic life of their country. That would include unreasonable prior censorship of what is acceptable commercial speech, that is implicit on trademarks.

Principle 5 is particularly relevant as to the granting or the refusal of registration of a trademark, particularly in countries where the right to the exclusive use is only acquired by registration and not by use, like is the case with almost all of Latin American countries.

Principle 5

Prior censorship, direct or indirect interference in or pressure exerted upon any expression, opinion or information transmitted through any means of oral, written, artistic, visual or electronic communication must be prohibited by law. Restrictions to the free circulation of ideas and opinions, as well as the arbitrary imposition of information and the imposition of obstacles to the free flow of information violate the right to freedom of expression.

Paragraph 21 of the interpretation guidelines indicates that “prior censorship implies control and veto power over information before it has been disseminated ...” and that the duty to refrain from interfering “... extends to the free circulation of information and ideas and the exhibition of artistic works that may not have the approval of the government”. The Inter-American Commission for Human Rights expressly includes Intellectual Property, while there is no denying that logos or graphic work may constitute a trademark.

Further, paragraph 22 is reiterative to indicate that “*restrictions on freedom of expression are only permissible through subsequent imposition of liability ...*”. That is, governments of the signatory parties may not impose an a priori restriction on expression or speech, as would be to include morality as grounds for refusal of a trademark registration. Finally, on paragraph 26 it is stated that, the Inter-American Court on Human Rights, citing the European Court in the case of *Castells v. Spain*, judgment of April 23, 1992, has declared that the protection of freedom of expression “... *must encompass not only favorable information or ideas, but also those that “offend, shock or disturb” because “such are the demands of pluralism, tolerance and broadmindedness ...*”

Paragraph 26 of the interpretation guidelines and the *Castells v. Spain* precedent, cited and adopted as own by Inter-American Court, constitute the cornerstone or jewel of the crown in connection with the refusal or registration of untasteful trademarks, as it is clear that it is not admissible to impose restrictions on any type of expression, even if offensive, shocking or disturbing. Thus, an attack on public morals may not validly constitute grounds for refusal.

Therefore, it should be concluded that article 4 of the Intellectual Property Law in Mexico, stating that that no registration will be granted when the content thereof or the form in which it is presented contravene morality and good custom, is violative of the obligation to respect freedom of expression, as protected by article 13 of the American Convention on Human Rights. Therefore, said law results inapplicable.

(ii) Legal Procedure (Amparo)

The waiver of the law, under the argument that it is violative of human rights is not automatic and it is not for everybody, in most cases. Exceptionally the legal theory allows it if there is a Declaration of Unconstitutionality by the Supreme Court of Justice. To the date, we are not aware of a single declaration of the sort. Therefore, each individual who considers the law to be violative of human rights and has the pretention that it not be applied to his/her case, must undertake Amparo Proceedings, which is a Constitutional procedure, in order for the Judiciary to order that in the specific case the contested law nor be applicated.

In any case that the examiner at the Mexican Institute of Industrial Property is faced with a scandalous, inappropriate, disturbing or offensive trademark being applied for, said examiner is obligated to refuse registration under article 4 of the Industrial property Law. Thereafter, the applicant may opt to challenge said resolution, raising the human rights argument, claiming its way to the Judiciary, in Amparo proceedings, until the Constitutional argument may be heard and resolved. If found to be correct of the merits, the judiciary will order the annulment of the refusal and un-application of article 4 of the Industrial Property Law, on the grounds of it being violative of the right of freedom of speech, therefore resulting in the granting of the sought registration.

e) Conclusions

1) We find that the protection of freedom of expression under article 13 of the American Convention of Human Rights extends to trademark rights, as expressions from source to consumer.

2) The guidelines to the interpretation of article 13 of the American Convention of Human Rights, as well as the precedents dictated by the Inter-American Court for Human Rights, prohibit any and all *a priori* censorship, as would be the refusal of registration of a trademark, on the grounds that it be immoral, scandalous, offensive, shocking or disturbing.

3) Articles 6 and 7 of the Mexican Constitution are more restrictive on freedom of expression than article 13 of the American Convention of Human Rights, therefore the last takes precedence over the former.

4) Article 1708, section 14, of NAFTA contravenes or is violative of article 13 of the American Convention of Human Rights, thus should be rendered inapplicable by the Judiciary in Amparo proceedings, should a trademark applicant opt for adopting and registering an immoral, scandalous, offensive, shocking or disturbing trademark.

5) Article 4 of the Industrial Property Law is also violative of article 13 of the American Convention of Human Rights, thus is also possible to request the Judiciary to order the waiver thereof in connection with an immoral, scandalous, offensive, shocking or disturbing trademark application.

6) At a personal level, I believe that it is not a governmental duty or function to regulate morality. In the case of trademarks, the market and the consumers will determine just how offensive a distinctive sign may be, if at all.