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LA MAFIA SE SIENTA A LA MESA - are you offended?

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The General Court (in Case T-1/17) was, as it found the sign (IR 5510921)



(hereafter LA MAFIA SE SIENTA A LA MESA) (in English: 'The mafia is seated at the table') contrary to public policy within the meaning of Article 7(1)(f) EUTMR.

The sign was applied for and registered for goods/services in Classes 25, 35, 43 in 2006.

The test of Article 7(1)(f) EUTMR stands out from most of the other rejection grounds in Article 7 EUTMR, as the relevant public cannot be limited to the public to which the goods and services in respect of which registration is sought is directly addressed. Consideration must be given to the fact that the signs caught by that ground for rejection will shock not only the public to which the goods and services designated by the sign is addressed, but also other persons who, without being concerned by those goods and services, will encounter that sign incidentally in their everyday lives.

Later on in 2006, the Italian Republic requested that the registration LA MAFIA SE SIENTA A LA MESA be cancelled, arguing that the sign was contrary to public policy and to accepted principles of morality since the word element 'Mafia' referred to a criminal organization, and that its use in the contested mark designating the applicant's restaurant chain had, in addition to arousing deeply negative emotions, the

effect of ‘manipulating’ the positive image of Italian cuisine and trivialising the negative meaning of that element. Next, the Italian Republic stated that the word element ‘la Mafia’ is understood world-wide as referring to a criminal organization originating in Italy, whose activities extend to States other than the Italian Republic, ia within the European Union.

Both the Cancellation Division and the First Board of Appeal (BoA) found that the contested mark was **contrary to public policy** and cancelled the registration.

The applicant appeals the BoA-decision to the General Court (GC). The GC starts by agreeing with the BoA that the most dominating element in the contested mark is LA MAFIA, and the Mafia is a criminal

organization that resorts to intimidation, physical violence and murder when carrying out its activities, which include, ia, drug trafficking, arms trafficking, money laundering and corruption.

Then the GC takes the argumentation a notch up by stating that the criminal activities of the Mafia **‘breach the very values on which the European Union is founded**, in particular the values of respect for human dignity and freedom as laid down in Article 2 of the Treaty of the European Union and Articles 2, 3 and 6 of the Charter of Fundamental Rights of the European Union. **Those values are indivisible and make up the spiritual and moral heritage of the European Union.** Moreover, organised crime and the activities (drug trafficking, arms trafficking, money laundering and corruption (added by the author)) are some of the areas of particularly serious crime with a cross-border dimension that the EU legislature may intervene into, as provided for in Article 83 Treaty on the Functioning of the European Union.’

It is food for thought (and impressive) that the GC reads fundamental human rights and values of the EU into **‘contrary to public policy’** in Article 7(1)(f) EUTMR.

That neither the organization known as the Mafia nor its members are included in the list of terrorist persons and groups in the Annex to Council Common Position 2001/931/CFSP of 27 December 2001 on the application of specific measures to combat terrorism does not alter the fact that the Mafia is a criminal organization. Nor does the reputation of ia the Godfather films change the association of the contested mark. Thus, the GC rejects the main arguments put forward by the applicant.

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