

### **Criminal organizations at the table**

As many may recall, in 2018 the EU General Court was called upon to rule on the validity of the trademark "*La Mafia se sienta a la mesa*" (case T-1/17). Fast forward to the present, just last week it was reported that a pizzeria located in the Spanish city of León received a letter from the Italian ambassador to Spain who, unfortunately, was not writing to praise the quality of the famous Italian product, but rather to express a firm reprimand to the owner for having chosen to use the sign "*La Camorra - pasta and pizza*".

More specifically, the ambassador complained that the owner's choice to use this expression as the signboard of the restaurant, as well as the name of a pizza included in the menu, was extremely careless and showed a lack of respect for the art of pizza makers, which are recognized by UNESCO as cultural know-how. The ambassador clearly stated that this initiative, which indirectly recalls Neapolitan pizza (i.e. a pizza made in a part of the Italian territory that has sadly been afflicted by the criminal organization referred to as the "Camorra"), shows:

- a total disregard for a profession that, for some people, represents an opportunity for social redemption and, when supported by innovative and entrepreneurial skills, important lucrative rewards;
- a lack of sensitivity towards the trivialization of the criminal phenomenon and the suffering of the victims of the Camorra;
- a lack of respect for the principles of public order recognized by the EUIPO and the EU General Court in the case "*La Mafia se sienta a la mesa*".

### **The legal framework and a few considerations**

One would hope that the pizzeria owner will quickly adopt the necessary measures to prevent the citizens of León from unfortunately (and unfairly) associating the image of the most famous Italian product in the world with the criminal phenomenon of the Camorra. However, in the meantime, this matter provides a useful opportunity to focus on some principles governing the validity of a distinctive sign and, in particular, on the requirement that a sign must not be contrary to public policy.

In this respect, the Italian ambassador to Spain was not wrong in recalling that in order for a sign to be registered as a European trademark, it must satisfy, among other requirements, those provided in Article 7(1)(f) of the Regulation no. 2017/1001, i.e. the sign must not be contrary to public policy or accepted principles of morality. A similar provision is also found in Italian law and, more specifically, at article 14(a) of the Italian Intellectual Property Code, providing that an Italian trademark must not be contrary "(...) to the law, public policy or morality".

So far, focus has been on signs that are filed or registered as trademarks, but we should not forget the relevance of the *de facto* signs (e.g. storefront signs, de facto trademarks, domain names which are expressly mentioned in article 12 of the Italian Intellectual Property Code and, with a more generic reference, in article 8(4) of EU Regulation no. 2017/1001). To be protected, *de facto* signs must satisfy the same requirements of a registered trademark, including compliance with the law, public policy and principles of morality. In this sense, given that the sign "*La Camorra - pasta and pizza*" seems to be used only *de facto* and not as a registered trademark, the ambassador's letter acts as a reminder to the pizzeria owners to respect those general principles.

On the other hand, returning to the issue of registered trademarks, we recall the dispute cited above, which attracted a significant amount of attention. That case related to a logo adopted by a well-known Spanish restaurant chain characterized by the sentence "*La Mafia se sienta a la mesa*", which was accompanied by an image of a red rose in the background, as a reference to the poster of the famous movie "*The Godfather*". The dispute dates back to the 2005 attempt by a franchising company to register this expression as a European trademark. However, the trademark application was opposed by the Italian government, on the grounds that the expression was contrary "(...)to public policy and to accepted principles of morality (...)". The opposition was granted and the EUIPO Board of Appeal rejected the subsequent appeal, after which the trademark applicant turned to the EU General Court. The General Court then put an end to the dispute, clarifying that the word "mafia" in the logo clearly stood out as a dominant element of the sign, and that it is globally understood as identifying a criminal organization that uses intimidation, physical violence and murder in carrying out its activities. Furthermore, the Court made it very clear that the values supporting the condemnation of the criminal activities carried out by this organization do not have national boundaries, but are instead the same values that "(...) constitute the spiritual and moral heritage of the European Union".

It is also worth mentioning that like the "*la Mafia se sienta a la mesa*" case, in the recent matter for which the Italian ambassador felt the need to send a letter, the idea that the words "*Camorra- pasta e pizza*" can, at most, be taken as a joke is not only wrong, but certainly cannot be accepted since, as recalled by the EU judges, the assessment of the validity of the sign "(...) cannot be based on the perception of the part of the relevant public that does not find anything shocking, nor can it be based on the perception of the part of the public that may be very easily offended, but must be based on the standard of a reasonable person with average sensitivity and tolerance thresholds". On top of that, since the level of public sensitivity involved is not necessarily only that of the consumers targeted by the products or services bearing the sign, the disregard for the principles of morality and public policy must not be ascertained only with reference to the products or services bearing the sign, but also the sensitivity of those consumers who may accidentally find themselves faced with the sign in the course of their daily lives.

Moreover, it is not acceptable to defend these signs by arguing that the mafia and/or the Camorra are the subject matter of many literary or cinematographic works (e.g. "*The Godfather*" or "*Gomorrhah*"), or that the association of these signs with leisure or convivial moments (such as sharing a meal with friends) is sufficient to soften the degree to which they would be contrary to public policy since, on the one hand, books and films do not alter the consumer's perception of criminal acts and, on the other hand, the sign remains "(...) of such a nature as to shock or offend, not only the victims of the said criminal organization and their families, but also anyone, in the

*territory of the Union, who comes across the said mark and has a normal degree of sensitivity and tolerance".*

It is also interesting to note that in the European context, the case "*La Mafia se sienta a la Mesa*" is part of a group of decisions covered by an EUIPO study that was promoted with the aim of identifying the trends in the relevant case law and for providing a better understanding of the concepts of "public policy" and "moral principles". Following this study, the EUIPO published the "*Case-law Research Report - Trade marks contrary to public policy or accepted principles of morality*" in 2021 (see [file:///C:/Users/massi/OneDrive/Desktop/JACOBACCI%20TO/Public%20policy%20and%20morality\\_final\\_en.pdf](file:///C:/Users/massi/OneDrive/Desktop/JACOBACCI%20TO/Public%20policy%20and%20morality_final_en.pdf)) which clarifies (paragraph 24) that a trade mark is contrary to public policy even when the message conveyed by the sign does not address a specific public or a given group of consumers. In fact, "*what is relevant is that it encourages, promotes or at least trivializes an infringement of a fundamental interest of the concerned Member State, according to its own system of values*".

According to the report, the signs that can fall under the scope of art 7(1)(f) EUTMR are therefore those that:

- a) incite hate towards a particular group, institution, belief or national symbol;
- b) transmit an insult even if it is not targeting a particular group;
- c) employ vulgar or offensive language, often with sexual connotations;
- d) transmit, incite or trivialize messages related to criminal activities or against public safety, including the promotion or use of illegal substances;
- e) trivialize a tragedy or convey immoral messages about it;
- f) praise or trivialize the message or impact of a well-known movement of a certain significance (such as the ideology of a totalitarian regime).

In this framework, and on the basis of the EU General Court decision in the "*La Mafia se sienta a la mesa*" case, we trust that the ambassador's letter will be perceived by the recipient, as well as by other business entities, as a strong warning to avoid any form of trivialization of the evil that is accompanied by an attempt to manipulate the positive image of Italian gastronomy or, in any case, of any other Italian product that is recognized and appreciated abroad as a byword for high quality.