

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

UNOFFICIAL DOCUMENT FOR INFORMATION PURPOSES ONLY

DECISION
of the Second Board of Appeal
of 29 September 2004

In Case R 176/2004-2

Falcon Sporting Goods AG

Bahnhofstrasse 27
CH-6300 Zug
Switzerland

Appellant

represented by Lehmann & Fernández, María Isabel Lehmann Novo, Calle Álvarez de Baena, 4, E-28006 Madrid, Spain

APPEAL relating to Community trade mark application No 2 223 907

THE SECOND BOARD OF APPEAL

composed of K. Sundström (Chairperson), T. de las Heras (Rapporteur) and P. Dyrberg (Member)

Registrar: E. Gastinel

gives the following

Decision

Summary of the facts

- 1 By an application filed at the Office on 21 May 2001, Falcon Sporting Goods AG ('the applicant') sought to register the following word mark:

BIN LADIN

as a Community trade mark for the following goods in classes 9, 12, 14, 18, 25, 28, 35 and 41:

Class 9 – Spectacle frames.

Class 12 – Vehicles; apparatus for locomotion by land, air or water.

Class 14 – Jewellery, clocks and watches.

Class 18 – Leather and imitations of leather, and goods made of these materials and not included in other classes.

Class 25 – Clothing, footwear, headgear.

Class 28 – Sporting articles.

Class 35 – Marketing and distribution of sporting articles, clothing and fashion accessories of all kinds.

Class 41 – Manufacture and distribution of audiovisual goods of all kinds; organisation and conducting of sporting and cultural events.

- 2 By a letter of 20 June 2003, the examiner objected to the registration of the trade mark pursuant to Article 7(1)(f) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR') (OJ EC 1994 L 11, p. 1; OJ OHIM 1/95, p. 53), on the following ground:
 - The trade mark is contrary to public policy or to accepted principles of morality since its registration by a public body (such as the OHIM) could be interpreted as a gesture of support for terrorist acts and a lack of respect for the victims of terrorism.
- 3 By letters received on 19 August 2003 and 20 October 2003, the applicant replied to this objection with the following arguments:
 - The applicant is a well-known import-export firm established in Switzerland. The surname of the sole shareholder and owner of this firm is Bin Ladin, which is familiar but has nothing to do with the alleged instigator of the terrorist attack in New York.
 - The right to use one's own name is a right recognised by all European Union Member States, being an inalienable right. If it happens that this surname is, unfortunately, shared by another person who discredits or tarnishes the name, this cannot form an obstacle to the legitimate use by a person having this name. Indeed, many trade marks granted by the various trade mark offices of European Union countries or by the OHIM itself consist of the name and/or surname of a person – for example, Spanish national mark ESCOBAR, (Pablo Escobar, Columbian drug trafficker); Community trade mark POT, (Pol Pot, Cambodia); international trade mark LENIN; Community trade marks CASTRO; Community trade mark MAO; Community trade marks DADA (Idi Amin Dada, Uganda); etc.

- The trade mark was applied for on 21 May 2001, i.e. four months before the terrorist attack on 11 September 2001. Before that date, nobody, apart from Islamic terrorism experts, was familiar with this name.
- The surname ‘BIN LADIN’ is a common Arab name with an excellent reputation. The applicant attaches an extract from the Internet in which ‘SAUDI BINLADIN GROUP’, a company controlled by the members of the same family as Osama Bin Laden, provides services throughout Europe to well-known prestigious companies (Audi, Volkswagen, Porsche, etc.) without there being any suggestion of ‘breaching public policy’, ‘a statement in support of terrorism’ or ‘practices contrary to accepted principles of morality’.
- The registration of the trade marks in Switzerland passed practically without comment in the Swiss or international press. Moreover, the WIPO, the Mexican Industrial Property Institute and the Indonesian and Turkish trade mark authorities have registered the trade mark applied for. The applicant attaches copies of the registration certificates from the abovementioned countries and organisations.
- Article 4(4) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ L 40, pp. 1 to 7) states that:
 - ‘Any Member State may ... provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:
 - ...
 - c) the use of the trade mark may be prohibited by virtue of an earlier right other than the rights referred to in paragraphs 2 and 4(b) and in particular:
 - i) a right to a name;’.

Pursuant to Article 6 of Directive 89/104/EEC:

- ‘1. The trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:
 - a) his own name or address;’.

It is clear from the above that a person’s name constitutes a fundamental right that impedes the registration of identical trade marks and whose use cannot be prevented by a trade mark, and also that said name can be the subject of a trade mark registration as established in the Community regulations and in Directive 89/104/EEC.

- 4 By a decision dated 9 January 2004 (‘the contested decision’), the examiner, in accordance with the opinion expressed by the Legal Issues Group, which is made up of trade mark and legal experts from the Office, refused the application pursuant to Article 7(1)(f) CTMR, for the following reasons:

- The purpose of Article 7(1)(f) CTMR is to prevent an offensive trade mark, whose use could provoke outrage or repulsion on the part of the public, from enjoying the benefits of a protective regime designed to serve the public interest. The Office is not preventing use by a person legitimately called ‘BIN LADEN’, but merely confines itself to deciding whether a trade mark is suitable for constituting an industrial property right. Therefore, since the trade mark applied for could offend the public in general, or at least a substantial part thereof, it is contrary to public policy or to accepted principles of morality.
- In accordance with Office practice, trade marks that allude to terrorist organisations may not be registered. The Office gives the example of ‘IPARRETARRAK REKORDS’, which was refused on the basis of Article 7(1)(f) CTMR because the trade mark contains the word ‘IPARRETARRAK’, a French terrorist independence organisation. The inclusion of this word in a trade mark could cause anger and repulsion amongst the public, or at least part of the public.
- Along the same lines of reasoning, the trade mark applied for would be understood by the public in general as no more than a direct reference to the leader of the terrorist organisation Al Qaeda. This would be the main impact of the trade mark, being a name that appears almost daily in the European press, always in connection with Al Qaeda activities. The fact that that the trade mark has other meanings (being the surname of the applicant and the name of a construction company) does not lessen this main impact. Even if the trade mark had become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it, the situation would be the same, since Article 7(3) CTMR would not be applicable because of Article 7(1)(f) CTMR.
- The trade marks granted by the various trade mark offices of European countries or by the OHIM itself, corresponding to the names of dictators, drug-traffickers, etc. are not considered to have such an inescapable association with terrorism these days as the trade mark applied for, nor do they enable the public to establish an immediate link between the trade mark (e.g. ‘POT’ or ‘DADA’) and the person alluded to (in these examples, POL POT and IDI AMIN DADA).
- The fact that the trade mark applied for has been registered in Switzerland, Turkey, Mexico and Indonesia is not decisive as regards the analysis of the trade mark applied for, bearing in mind the findings of the judgment of the Court of First Instance of 5 December 2000 in Case T-32/00 *Messe München GmbH v OHIM* (‘Electronica’) [2000] ECR II-3829, paragraphs 45 to 47.
- Although the trade mark refused was applied for four months prior to the terrorist attack, when the name ‘BIN LADIN’ did not have the global notoriety it has today, the assessment of the trade mark must take account not only of the facts known at the time of submission of the application but also of events and circumstances arising during the course of the examination. The Office cites the judgment of the Court of Justice of 29 April 2004 in Joined Cases C-456/01 P and C-457/01 P, *Henkel KGaA v OHIM* (‘Tabs’) [2004] pending publication in the ECR, paragraphs 41 to 46).

- 5 On 5 March 2004, the applicant filed a notice of appeal against the contested decision. On 10 May 2004, the applicant submitted the statement of grounds of appeal.
- 6 On 17 May 2004, the appeal was referred to the Examination Division for interlocutory revision pursuant to Article 60 CTMR. On 19 May 2004, it was remitted to the Boards of Appeal.
- 7 On 10 August 2004, the applicant filed a copy and a translation of the judgment of 30 June 2004 by the Swiss Federal Board of Appeal for Intellectual Property, annulling the revocation of Swiss trade mark No 488 044 'BIN LADIN' officially adopted by the Swiss Federal Institute of Industrial Property (IGE).

Grounds of appeal

- 8 The applicant requests that the Board grant the trade mark application for the goods and services for which it was refused, based on its arguments which may be summarised as follows:
 - The applicant argues that the right to use one's own name is a right recognised by all European Union Member States, being an inalienable right, and the exercise of this right cannot be impeded unless its use constitutes a crime, which is clearly not the case here. As a concrete example of the protection of the right to a name in Spain, the applicant cites Article 10 of Title I of the Spanish Constitution, and Article 18 which states that 'The right to honour, to personal and family privacy and to personal reputation is guaranteed'. Moreover, the applicant refers to a number of articles of the *Ley Orgánica de 5 de mayo de 1982 sobre protección civil del derecho al honor, a la intimidad personal y familiar y a la propia imagen* [Spanish implementing act of 5 May 1982 on the civil protection of the right to honour, to personal and family privacy and to personal reputation]. Article 1(1) and (3) of said law states that 'The fundamental right to honour, to personal and family privacy and to personal reputation, guaranteed in Article 18 of the Constitution, shall enjoy civil protection against any kind of unlawful interference, in accordance with the provisions of this Implementing Act'.
 - Furthermore, with respect to the above, the applicant points out that according to reiterated case-law of the *Tribunal Supremo Español* [Spanish Supreme Court], in cases where applicants seek to register their own surnames as trade marks, except in the event of absolute identity, trade marks that are partially made up of a shared name in which the common surname appears together with other expressions allowing its individualisation may coexist on the basis that everyone has the right to use their own surname. Therefore, the fact that trade marks may be registered even in the event of partial coincidence in terms of name and surname is all the more reason to allow the registration of the trade mark applied for, since it has not even been the subject of an opposition but its refusal is based on the ground of public policy, which should not apply in this case. The applicant cites the case-law of the Spanish Supreme Court which, although it refers to clashes involving trade marks that use surnames, is perfectly applicable to the present case, being based on the right to register one's own name.

- The applicant argues that restrictive provisions cannot be applied to rights retroactively. The trade mark was applied for on 21 May 2001, four months before the terrorist attack in New York, a fact that clearly shows that the trade mark was applied for as a reflection of the name of a company shareholder. The applicant therefore argues that, pursuant to Article 79 CTMR, the following principles of procedural law generally recognised in the Member States must be taken into account. First, rules shall not have retroactive effect unless specifically established otherwise, which in practical terms means that a ground pertaining to public policy arising after the date of application for a trade mark cannot be asserted, this application date determining the time to be taken into consideration for the analysis of absolute grounds for refusal. Secondly there is the principle of legal security, since for the same reasons a trade mark could be reviewed and annulled at any time on the pretext that it has become contrary to public policy, which would amount to complete legal insecurity and ineffectiveness of the very concept of trade mark registration. Lastly, regulations that prohibit and limit rights must be understood in the restrictive sense and under their exact terms, never in the broad or extensive sense as regards the time for their application. This is the position taken by the Spanish Supreme Court on the application of absolute prohibitions established in successive trade mark regulations. Contrary to these principles, the contested decision is based on an interpretative criterion that widens the scope of prohibition of Article 7(1)(f) CTMR, by retroactively applying the concept of public policy against the fundamental right to register one's own name.
- The applicant argues that it has acquired rights through its trade name 'Ibrahim Bin Ladin Holding', or 'IBL Holding' for short, by virtue of the application of Article 8 of the Paris Convention for the Protection of Industrial Property, which states that 'A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trade mark'.
- The Office reached the conclusion that the trade mark applied for was contrary to public policy without providing proof of the alleged public outrage or repulsion. The applicant believes that it is not lawful to establish, without proof, any link between the trade mark applied for and the name of the alleged terrorist.
- The applicant reiterates that the name 'BIN LADIN' is a very common Arab name that enjoys considerable prestige.
- In support of the arguments set out above, the applicant provided a copy and translation of the judgment of 30 June 2004 by the Swiss Federal Board of Appeal for Intellectual Property annulling the revocation of Swiss trade mark No 488 044 'BIN LADIN' officially adopted by the Swiss Federal Institute of Industrial Property (IGE). The applicant states that it did not submit this judgment until 10 August 2004 because it was not aware of it when it submitted the statement of grounds of appeal.

Reasons

- 9 The appeal complies with Articles 57, 58 and 59 CTMR and Rule 48 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR

(‘CTMIR’) (OJ EC 1995 L 303, p. 1; OJ OHIM 2-3/95, p. 259). It is therefore admissible.

- 10 However, the appeal is unfounded since, contrary to the applicant’s arguments, there exists no fundamental right to register one’s own name as a trade mark, nor does the right to one’s own name render the absolute grounds for refusal, such as that applied by the contested decision, inapplicable.
- 11 Article 7 CTMR states that:
 - ‘1. The following shall not be registered:
 - (...)
 - f) trade marks which are contrary to public policy or to accepted principles of morality;’.
- 12 Article 7(2) CTMR states that:
 - ‘Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community’.
- 13 Article 7(1)(f) consecrates the provision of public policy and applicable principles of morality as a legal principle determining that trade marks that are unlawful because they are contrary to said provision are not eligible for registration and are invalid. The same provision, expressed in the same or similar terms, is a classic provision of legal texts on the subject of industrial property, from Article 6quinquies(B)(3) of the Paris Convention, to Community legislation, to Article 53(a) of the Munich Convention on the Grant of European Patents (cf. the Conclusions of Advocate-General F. G. Jacobs in Case C-377/98, *Kingdom of the Netherlands v European Parliament and Council of the European Union*, paragraph 95 et seqq., and the Court of Justice’s judgment in the same case, paragraph 37 et seqq.). This same provision is contained in Articles 30, 39, 46 and 58 of the Treaty establishing the European Community – EC Treaty to justify restrictions on fundamental liberties guaranteed by the Treaty (cf. the above Conclusions of Advocate General F. G. Jacobs, p. 97), and furthermore is a classic provision of radical invalidity of contracts and unlawful associations.
- 14 The Community legislator defines this provision in the 39th recital to Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (OJ EC L 213, p. 13), which states that ‘ordre public and morality correspond in particular to ethical or moral principles recognised in a Member State’. This is precisely in line with the Court of Justice’s interpretation and application of these concepts in the context of the EC Treaty, according to the Conclusions of Advocate General F. G. Jacobs, cited above, paragraph 100.
- 15 Article 7(1)(f) CTMR does not require application of the concept of public policy or principles of morality at Community level, since Article 7(2) states that the ground may obtain in just one Member State. In this regard, the Court of Justice has declared that the particular circumstances justifying recourse to the concept of public policy may vary

from one country to another and from one period to another and it is therefore necessary in this matter to allow the competent national authorities an area of discretion within the limits imposed by the Treaty, stating that ‘recourse by a national authority to the concept of public policy presupposes, in any event, the existence, in addition to the perturbation of the social order which any infringement of the law involves, of a genuine and sufficiently serious threat to the requirements of public policy affecting one of the fundamental interests of society’ (cf. judgment of the Court of Justice of 27 October 1977 in Case 30/77, *Régina v Pierre Bouchereau*, paragraphs 34-35).

- 16 In the present case, as the examiner has stated, the trade mark applied for, ‘BIN LADIN’, would be understood by the general public as the name of the leader of the terrorist organisation Al Qaeda, in view of the global notoriety achieved both by the organisation and its leader following the September 11 attack and their frequent exposure in the European press. The fact that the trade mark may have other meanings (being the surname of a shareholder in the applicant company and the name of a construction company) is irrelevant, since these are unknown to the public in general, who will only recognise the meaning described above.
- 17 With the trade mark applied for understood in the manner described, it is abundantly clear that it is contrary to public policy and the accepted principles of morality, since terrorist crimes are absolutely contrary to the ethical and moral principles recognised not only in all European Union Member States but in all civilised nations, being a genuine and one of the most serious threats to the fundamental interests of society and the maintenance of social peace and order.
- 18 The trade mark applied for is also contrary to Community public policy since it contradicts the indivisible, universal values on which the Union is founded, i.e. human dignity, freedom, equality and solidarity, and the principles of democracy and the rule of law, as proclaimed in the *Charter of Fundamental Rights of the European Union* (OJ EC C 364, 18 December 2000, pp. 1 to 22), the right to life and to physical integrity standing out as the main, fundamental values without which the others cannot be enjoyed. These values and principles prevent the legal protection as a Community trade mark and the commercial exploitation of the name of the leader of a global, notorious group known for its mass, indiscriminate terrorist acts, which has killed and wounded thousands of people, with whom all the citizens of the world who share these universal values stand as one, all of whom would be deeply offended and shocked if the trade mark applied for were to be registered in the Community.
- 19 No precedent can prevail over the concept of public policy understood in such a sense, since any precedent would be null and void, there being no place for equality outside of the law, as reiterated so many times in the case-law of the Court of First Instance that citation is unnecessary.
- 20 The judgment of 30 June 2004 by the Swiss Federal Board of Appeal for Intellectual Property annulling the revocation of Swiss trade mark No 488 044 ‘BIN LADIN’ officially adopted by the Swiss Federal Institute of Industrial Property (IGE) is irrelevant to the present case since this judgment did not debate whether said trade mark was contrary to public policy and the principles of morality – precisely the reason for the official revocation adopted by said Institute – but the lack of competence to officially revoke a trade mark that had already been registered.

- 21 Contrary to the applicant's assertions, the right to one's own name does not imply any right to register it as a trade mark, nor does it render the absolute or relative grounds for refusal inapplicable, since Community law makes no exception in this regard and nor does the current *Ley española de Marcas* [Spanish Trade Mark Act]. Article 9(2) of said act leaves no room for doubt as it expressly states that 'names, surnames, pseudonyms or any other sign that identifies the applicant may not be registered if they incur any of the prohibitions on registration (...)'. Besides, in this case the name applied for is not the name of the applicant company.
- 22 The applicant's argument based on its trade name cannot be upheld, since even if it were the applicant's trade name, Article 8 of the Paris Convention cited neither confers the right to register trade names as a trade mark nor excludes the application of the absolute grounds for refusal in general, and in particular of the public policy provision, applied here, this being recognised by the Convention as stated above, to which the Board refers.
- 23 Nor can the argument be upheld that the Office reached the conclusion that the trade mark applied for was contrary to public policy without proof of the alleged outrage or repulsion on the part of the public or of the link between the trade mark applied for and the name of the alleged terrorist. The first part of this argument, relating to the lack of proof of outrage or repulsion on the part of the public, is dismissed since the registrability of a sign as a Community trade mark must be assessed only on the basis of the relevant Community legislation as interpreted by the Community Courts without having to justify this action by the production of evidence (see, in this regard, the judgment of the Court of First Instance of 8 July 2004 in Case T-289/02 *Telepharmacy Solutions Inc. v OHIM* ('Telepharmacy Solutions') [2004] pending publication in the ECR, paragraph 54).
- 24 Likewise, the second part of the argument, relating to the lack of proof of a link between the trade mark applied for and the name of the alleged terrorist, is dismissed on the ground that it is a universal and very well-known fact, by application of the rule that facts which are well-known do not require proof, being facts which are likely to be known by anyone or which may be learnt from generally accessible sources (see, in this regard, the judgment of the Court of First Instance of 22 June 2004 in Case T-185/02 *Claude Ruiz-Picasso and others v OHIM* ('PICARO'), paragraphs 29-32).
- 25 Lastly, the applicant's argument that provisions imposing restrictions on rights cannot be applied retroactively, since the trade mark was applied for on 21 May 2001, four months before the terrorist attack in New York, a fact that in its opinion demonstrates that the trade mark was applied for as a reflection of the name of one of the company's shareholders and not that of the regrettably well-known terrorist, must also be dismissed. First of all, by the time the application was filed, the terrorist leader and his group were already known for earlier terrorist acts such as those of 7 August 1998 in Nairobi (Kenya) and Dar-es-Salaam (Tanzania), universally notorious thanks to worldwide media coverage, for which said terrorist leader was blamed, as can be seen from Resolution 1267 (1999) approved by the UN Security Council at its 4051st session held on 15 October 1999 (see the UN's website, www.un.org, which has a section on UN counter-terrorism measures, including the resolutions passed in this respect).

- 26 Secondly, the absolute ground for refusal applied was not applied retroactively, but is applicable to the examination of the application prior to registration, since the purpose of the examination is precisely to prevent trade marks from being unduly registered, in accordance with reiterated CJEC case-law, which moreover holds that the competent authority cannot register trade marks caught by one of the grounds for refusal (see judgment of the Court of Justice of 12 February 2004 in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* ('Postkantoor') [2004] pending publication in the ECR, paragraphs 122 to 126). Specifically, the ground applied was in force on the date of application and has therefore been applied without retroactive effect of any kind, in accordance with the principle of *tempus regit actum*.
- 27 For all the above reasons, the appeal is dismissed in its entirety.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal filed in its entirety.

K. Sundström

T. de las Heras

P. Dyrberg

Registrar:

E. Gastinel