



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

The Boards of Appeal

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**DECISION  
of the Second Board of Appeal  
of 18 June 2010**

In Case R 175/2010-2

**Federico Cortés del Valle López**

Ctra. Aeropuerto, nave 20  
E-39600 Maliaño (Cantabria)  
Spain

Applicant / Appellant

represented by IPAMARK, Paseo de la Castellana, 72-1º, E-28046 Madrid, Spain

APPEAL relating to the for Community trade mark application No 8 384 653

**THE SECOND BOARD OF APPEAL**

composed of T. de las Heras (Chairperson and Rapporteur), H. Salmi (Member) and G. Humphreys (Member).

Registrar: C. Bartos

gives the following

## Decision

### Summary of the facts

- 1 By an application received at the Office on 24 June 2009, Federico Cortés del Valle López ('the applicant') sought to register the following figurative mark:



for the following goods and services:

Class 33 – Orujo grape marc and spirits.

Class 35 – Assistance for operating a commercial enterprise under a franchise scheme; advertising, marketing and commercial promotion; statements or advertisements in all media; information and advertising dissemination; import-export; wholesale and retail sales by catalogues, e-mail or by electronic means, such as through websites or teleshopping; all the aforementioned for Orujo grape marc and spirits.

Class 39 – Storage, distribution, transport, warehousing, packing and packaging services, all for Orujo grape marc and spirits.

- 2 By letter dated 27 July 2009, the Office notified the applicant that the trade mark applied for could not be registered pursuant to the prohibition in Article 7(1)(f) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark ('CTMR') (OJ EU L 78, p. 1) - codified version of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ EC 1994 L 11, p. 1; OJ OHIM 1/95, p. 52).
- 3 The arguments on which the refusal of the trade mark application was based can be summarised as follows:
  - The trade mark consists mainly of the word 'HIJOPUTA'.
  - The expression 'hijo de puta' is an insult in Spanish, whose definition in the

dictionary of the Royal Spanish Academy is ‘1. masc. & fem. vulg. *Mala persona. U.c.insulto*’ [1. masc. & fem. *Vulgar. Bad person. Common use, insult*].

- Therefore, this expression would amount to an insult that would offend any person to whom it is addressed (unless it were clearly uttered as a joke).
  - It is a vulgar expression that uses a family relationship to hurt the most intimate feelings of people.
  - It is likely that a substantial number of citizens with a normal level of sensitivity and tolerance would be bothered if the expression were on view regularly in business.
  - In the opinion of the Office, a substantial proportion of average Spanish-speaking citizens, whose values and criteria are representative of society in general, would consider the expression ‘HIJOPUTA’ to be offensive and reprehensible.
- 4 On 28 September 2009 the applicant replied to the examiner’s objection with the following arguments:
- The expression ‘hijoputa’ is not offensive and reprehensible in terms of current everyday usage.
  - The level of insult depends on how it is expressed, given that it can even be affectionate.
  - In colloquial language, it has lost all its literal meaning, given that no thought is given to the significance of the expression, and it has become a part of the everyday language of the people.
  - An extract of a news article published in the newspaper *El Mundo* of 16 September 2009 is submitted as a proof. The article is about the judgment of the Tribunal Superior de Cataluña [High Court of Catalonia], which cautioned that calling a boss an ‘*hijo de puta*’ [‘son of a whore’] is not grounds for dismissal. This judgment suggests that the social degradation of the language has caused the expressions used by the appellant to become commonly used expressions in certain situations, especially within the framework of arguments.
  - There is no point in highlighting the literal aspect of the expression in the business world where this word affectionately alludes to the excellent qualities of the product.
  - The expression is not always an insult, as it depends on how it is said.
  - Considering the adult public for which the products (alcoholic beverages) are intended, we are dealing with levels of tolerance and sensitivity that are not excessively puritanical.

- The expression is accompanied by another expression in Asturian dialect, ‘¡QUE BUENU YE!, [meaning ‘IT’S REALLY GOOD’], which combined with the expression ‘HIJOPUTA’ reinforces the strength and excellence of the goods: spirits or Orujo grape marc.
  - Regarding Article 4 CTMR, contrary to what is put forward in the decision, the relevant criterion gives further weight to the full distinctiveness of the trade mark applied for. Neither does the trade mark refer directly to the goods or services applied for.
  - There are several registered trade marks that contain the expression ‘PUTA’ and even ‘HIJO DE PUTA’. Copies of the aforementioned registrations are attached.
  - In view of all the foregoing, the request for registration of the trade mark is reiterated.
- 5 By decision of 24 November 2009, the examiner maintained his objection to all the goods and services, according to and based on the additional arguments listed below:
- The Office emphasised that the objection was based only on Article 7(1) (f) CTMR, and does not refer to either the distinctiveness or the descriptiveness of the trade mark or the applicability of Article 4 CTMR.
  - The Office agrees that the expression ‘hijoputa’ may not be insulting in very specific circumstances. However, on many other occasions it will indeed be an insulting expression.
  - However, it does not agree that the expression has lost all its literal meaning and has become a part of everyday language.
  - Not only does the Royal Spanish Academy define said expression as an insult, but it may also be perceived as such by a substantial number of citizens with a normal level of sensitivity and tolerance.
  - While it is true that the target public for the goods concerned are adult consumers, however, contrary to what the applicant indicates, this public has a level of tolerance and sensitivity that must be positioned somewhere between the puritanical extreme and those who would tolerate a strong obscenity.
  - For this public, of an average consumer, the expression ‘hijoputa’ is not affectionate, but very likely to be insulting.
  - The fact that the trade mark is composed of other verbal and visual elements does not change the earlier conclusions, even more so as the expression ‘HIJOPUTA’ is clearly visible in the sign as it is in larger font.

- A substantial proportion of Spanish-speaking average citizens, whose values and criteria are representative of society in general, would consider the expression ‘HIJOPUTA’ to be offensive and reprehensible.
  - Regarding the judgement of the Tribunal de Justicia de Cataluña [Court of Justice of Catalonia], it must be reiterated that the Community trade mark system is an autonomous and independent system, with specific objectives.
  - Regarding the similar trade marks accepted by the Office, it should be pointed out that Community trade mark No 6 186 274 ‘HIJO DE PUTA’ was rejected pursuant to Article 7(1)(f) for all goods and services applied for. None of the other trade marks mentioned contain an identical expression to the trade mark applied for.
- 6 On 25 January 2010 the applicant filed an appeal against the examiner’s decision (the ‘contested decision’). The statement of grounds of the appeal was submitted on 25 March 2010.
- 7 The examiner rejected a review of the appeal, which was referred to the Boards on 28 April 2010.

### **Grounds for appeal**

- 8 In its notice of appeal, the applicant requests the annulment of the contested decision and registration of the trade mark applied for. Its arguments can be summarised as follows:
- The Office did not take into account the overall meaning of the name of the trade mark applied for, ‘¡Que bueno ye!, HIJOPUTA’, or the commercial context within which said expression is asserted.
  - The relevant issue is the ‘intention’ behind its use and the framework within which it is uttered, that being always the context of communication between people.
  - The trade mark in question is the solution given by the trader to a product for the adult market (Orujo grape marc and spirits) as a commercial designation with a laudatory, but certainly not pejorative, meaning.
  - The Office does not heed the sense of the term which serves to identify an alcoholic product by praising how ‘really good it is’, which is in no way denigratory.
  - The name and the sense thereof must be analysed within a business context, and never within a social context.
  - It cannot be claimed that the expression ‘HIJOPUTA’, accompanied by the expression ‘¡QUE BUENO YE!’ could hurt the sensitivity of many people as it would be perceived as a recommendation of the product.

- A buyer of the product acquires it because they think it is amusing, a significant point of view in this registration.
- People with average levels of sensitivity and tolerance will understand the overall meaning in a matey and affable sense, and may even find it humorous.
- The Office’s prohibition is more applicable to an insult such as the expression ‘Hijo de Puta’ and not to the more reduced and less offensive expression ‘Hijoputa’, which leads us to affirm that the meaning of this word must be assessed within its context and with the nuances created by the accompanying words.
- In the informal atmosphere of friends, the expression ‘HIJOPUTA’ has the opposite meaning. Nevertheless, its use in speech may not be normal because of being considered embarrassing, depending on the ethical and moral level of each individual.
- The products are intended for adults, and it is prohibited for minors to purchase or consume them.
- The Office rejects the argument of the earlier trade marks having similar expressions, thus setting itself up as the censor of the degree of reproach or insult that the words have, which demonstrates that what is important is not the meaning but rather the intended commercial use.
- Other registered trade marks with similar names include Community trade mark No 4 003 554 ‘CABRON 49’, No 8 287 559 ‘BASTARDO BIANCO’ and No 5 834 676 ‘ROSSOBASTARDO’.
- The trade mark is limited to class 33 to ‘Orujo grape marc and spirits’ and to the services of classes 35 and 39 inasmuch as they refer to ‘Orujo grape marc and spirits’.
- It is requested that the contested decision and registration of the trade mark applied for are annulled.

### **Reasons**

- 9 The appeal complies with Articles 58, 59 and 60 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. 258) as amended. It is therefore admissible.
- 10 However, there are no grounds for the appeal, based on the reasons set forth below.
- 11 Article 7(1)(f) 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 According to the prior decision of this Board in Case R 176/2004-2 – ‘BIN LADIN’ (at paragraph 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 seq.*, and the Court of Justice’s judgment in the same case, paragraph 37 *et seq.*). This same provision is contained in Articles 36, 45, 52 and 65 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).
- 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 (in this sense, see Case R 176/2004-2 – ‘BIN LADIN’, at paragraph 14).
- 15 Consequently, it must be understood that Article 7(1)(f) CTMR prohibits the registration of trade marks that are contrary to the ethical and moral principles recognised in a Member State, which can vary over time, given that the dominant morality in a certain society changes with the passage of time, so that what may be acceptable today might have been morally reprehensible yesterday.
- 16 Certainly, Article 7(1)(f) CTMR restricts the fundamental right of freedom of expression, which includes the freedom of commercial expression, recognised by Article 10 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (‘ECHR’) and Article 11 of the Charter of Fundamental Rights of the European Union. Such a restriction is legally justified to the extent that it is necessary for the protection of public order and good habits, considering that these types of restrictions are approved by Article 10(2) ‘ECHR’, as stated by the Grand Board of Appeals in Case R 495/2005-G – ‘SCREW YOU’,

at paragraph 17, and by this Board in Case R 1509/2008-2 – ‘DEVICE OF THE COAT OF ARMS OF THE SOVIET UNION (FIG. MARK)’, at paragraph 33, following the judgement of the European Court of Human Rights in the Case *Casado Coca/España* [1994],<sup>18</sup> EHRR -1, at paragraphs 33-37.

- 17 According to the aforementioned Decision R 495/2005-G – ‘SCREW YOU’ (at paragraph 14 *et seq.*), ‘The wording of Article 7(1)(f) CTMR is very broad and allows a great deal of room for interpretation. A judicious application of this provision necessarily entails balancing the right of traders to freely employ words and images in the signs they wish to register as trade marks against the right of the public not to be confronted with disturbing, abusive, insulting and even threatening trade marks’. The restriction of the freedom of commercial expression is only justified to the extent that it may be strictly necessary for protecting public order and morals or good habits.
- 18 In the present case, for reasons of procedural economy, the Board is going to limit itself to examining whether the refused trade mark is contrary to good habits, in other words against the moral principles generally recognised in a Member State, specifically in Spain because the trade mark consists of Spanish expressions.
- 19 It can be extremely difficult to define the boundary between what is morally acceptable and unacceptable, to ascertain when a sign crosses the boundary from being merely irreverent or in bad taste to being seriously abusive and likely to be deeply offensive. Signs which contain slightly rude words or mild sexual innuendo might not be refused. However, there are cases that are easy to resolve, because they are clearly prohibited, such as signs that contain manifestly profane language or that depict gross obscenity. These, obviously, have no place on the register (see R 495/2005-G – ‘SCREW YOU’, at paragraph 19), since the right to freedom of expression does not include the right to use immoral expressions or serious insults, as is the case of the trade mark at issue, as it is analysed below.
- 20 In accordance with the aforementioned Case R 495/2005-G – ‘SCREW YOU’ and Case R 1509/2008-2 – ‘DEVICE OF THE COAT OF ARMS OF THE SOVIET UNION (FIG. MARK)’, when deciding whether a trade mark should be barred from registration on grounds of public policy or morality, ‘the Office must apply the standards of a reasonable person with normal levels of sensitivity and tolerance. The Office should not refuse to register a trade mark which is only likely to offend a small minority of exceptionally puritanical citizens. Similarly, it should not allow a trade mark on the register simply because it would not offend the equally small minority at the other end of the spectrum who find even gross obscenity acceptable. Some people are easily offended; others are totally unshockable’.
- 21 In accordance with the aforementioned Case R 1509/2008-2 – ‘DEVICE OF THE COAT OF ARMS OF THE SOVIET UNION (FIG. MARK)’, at paragraph 39, the refusal to register a trade mark because of being immoral must be based on the fact that the examined trade mark is judged to be immoral because it is offensive to a substantial part of the public, whose values and moral patterns are decisive and are somewhere between the two extremes mentioned in the preceding paragraph. ‘It is also necessary to consider the context in which



the trade mark is likely to be encountered, assuming normal use in connection with the goods and services covered by the application' (see Case, 'SCREW YOU', *loc.cit.*, at paragraph 21).

- 22 In the present case, the sign applied for consists of a combination of graphic-text elements in which, together with the expression '¡Que buenu ye!', the expression 'HIJOPUTA' appears, in larger font, separate from the remaining elements of the trade mark, all within a rhomboid that crosses the entire trade mark and which is positioned in the lower centre part of the mark.
- 23 The expression 'HIJOPUTA', which significantly stands out in the sign overall, as the examiner correctly pointed out, means, according to the dictionary of the Royal Spanish Academy, '*1. masc. & fem. Vulg. Bad person (Common use. Insult)*'. It is therefore an undoubtedly offensive expression in the Spanish language, and therefore, except for special circumstances, it has the intrinsic capacity to offend any normal person who perceives it and understands its meaning. It is therefore morally unacceptable not only for a substantial part, as previously required, but also for the vast majority of the Spanish society, and not only at present, but also in the past, since the insulting meaning has not varied with the passage of time.
- 24 If we take this meaning into account, in its sense as a very serious insult, probably one of the most serious ones that could be uttered in Spanish, given that one's mother is branded a whore, it is reasonable to think that the average consumer of the intended goods and services, representative of a public morality removed from any extremism, namely with normal sensitivity and tolerance within the general context of society, would in the main perceive the expression as seriously offensive and, therefore morally reprehensible.
- 25 It is true that in very specific circumstances, in contexts in which the inherent capacity of the expression has become banal or has even been transformed, it could be perceived as less reprehensible and even humorous or affectionate when it is pronounced *jocandi gratia*. However, that context to which the applicant refers is not generally representative of the average consumer of the goods and services in question with a knowledge of the Spanish language, but rather, it is part of the jargon used by a reduced circle of people who are probably slightly, or not at all, sensitive to this type of expressions, and even extremely open to or tolerant of them.
- 26 In brief, it is difficult to perceive of the term 'HIJOPUTA', in the trade mark as a whole, as a flattering or laudatory expression of the product, regardless of whether or not that is precisely the case of the other expression, '¡que buenu ye!', included in the trade mark.
- 27 Moreover, the fact that the expression 'HIJOPUTA' is not uttered within the context of a conversation between people, but rather is applied to a product as an element of a commercial trade mark, does not prevent but actually facilitates that it continues to be perceived as an insulting and offensive expression on its own. Furthermore, within the context of specific jargon used by a group of acquaintances or friends, the expression will be communicated orally and in the relevant tone, which will allow the receiver to perceive it as a joke or as an affectionate expression. Whereas, in an ordinary commercial context this expres-

sion will be frequently perceived in writing, without any tone, or gesture or anything to accompany it that would suggest another intention or a perception that is not strictly offensive, in other words, its most evident and extended meaning. Apart from this, the trade mark applied for must be objectively evaluated as it appears in the application for registration, without taking into account the intention of the applicant or the use that the applicant may intend to give it in the future in other contexts. In this regard, the remaining elements that accompany the expression ‘HIJOPUTA’ and that complete the sign do not, from an overall perspective, succeed in eliminating the insulting message. On the other hand, in order for average consumers to consider it insulting, it does not have to be directed at them, rather it is enough that, from a moral point of view, they find it generally reproachable or reprehensible, that is to say, morally unacceptable.

- 28 Regarding the argument that the context is exclusively commercial and not social, in addition to being difficult to clearly distinguish one from the other, the fact is that the freedom of commercial expression is also subject to limitations imposed by good habits, which, within the context of Community trade mark protection, makes it necessary to examine the appropriateness of a trade mark in contrast with the catalogue of ethical and moral principles recognised in one or several Member States of the Community, as explained above.
- 29 The applicant also argues that the expression ‘HIJOPUTA’ is less offensive than ‘HIJO DE PUTA’, for which it would be more suitable to apply the registration prohibition indicated by the Office. In this regard, it should be pointed out that it is not relevant to this case that there are or could be other expressions that are very similar to the former and that could be considered as insults of greater severity. The Office must focus on the specific examination of the trade marks as they were applied for and consider the elements they are composed of, thereby refraining from assessing other expressions that are unrelated to the trade mark. Moreover, it is clear in this case that the insulting meaning of both expressions is the same, given that omitting the preposition ‘*de*’ [of] does not change their sense.
- 30 With respect to the earlier trade marks cited by the applicant, this Board must reiterate that, according to settled case-law, the Office is not bound by its earlier decisions. Rather, it is only subject to applicable regulatory provisions and specifically the CTMR, meaning that the possibility of registering a sign as a Community trade mark must be assessed solely in light of these Regulations, as it has been so interpreted by the Community judge, and not based on a previous practice, even one of the Office itself. In any event, the Board cannot but reject the argument pertaining to such earlier Community registrations (trade mark No 4 003 554 ‘CABRON 49’, No 8 287 559 ‘BASTARDO BIANCO’ and No 5 834 676 ‘ROSSOBASTARDO’), given that they all consist of trade marks that are substantially different from the one applied for, which is why they are inapplicable to the present case.
- 31 On the other hand, regarding the argument that the Office sets itself up as the censor of the degree of reproach or insult that words have, it should be pointed out that the examiner rejected the applicant’s argument about the existence of earlier trade marks because he deemed that they consisted of different circumstances or of a Community trade mark, such as No 6 186 274 ‘HIJO DE PUTA’, cited as a precedent, which had been refused based on Article 7(1)(f) CTMR. In

any event, it is a prime function of the Office to examine particularly the registrability of a trade mark, whereby it falls to it to determine, during the course of the registration proceedings, the offensive nature of the trade marks that could be contrary to morality and good habits, an issue that must always be assessed according to relevant Community legislation, as has been so interpreted by the Community judge.

- 32 Finally, the goods and services that are listed in the application in classes 33, 35 and 39 constitute ordinary goods and services, traded and offered at establishments frequented by the general public, such as large department stores, supermarkets, specialised shops, etc. The Board has taken due note of the limitation to 'Orujo grape marc and spirits' and to services related directly to these goods made by the applicant. However, such a modification does not alter the assessment made by the examiner, with whom this Board agrees, insofar as they are goods and services for general consumption targeted at an average and adult consumer. Likewise, and independently of the fact that the sale of the goods is prohibited to minors, this will not prevent them from also being exposed to perceiving the offensive expression contained in the trade mark. All of which leads the Board to agree with the opinion set out in the contested decision in the sense that the trade mark, due to the expression 'HIJOPUTA', would inevitably offend a significant part of the said public. The Board therefore upholds the objection made by the examiner in so far as it refers to all the goods and services following the limitation made by the applicant.
- 33 Based on the foregoing, the appeal must be dismissed, and the contested decision is upheld in its entirety.

**Order**

On those grounds,

THE BOARD

hereby:

**Dismisses the appeal.**

Signed

T. De Las Heras

Signed

G. Humphreys

Signed

H. Salmi

Registrar:

Signed

C. Bartos

