

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE  
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

**Kevin Rowe (Holder/Proprietor)**

**and**

**The Academy of Motion Pictures, Arts and Sciences (Applicant for Declaration of  
Invalidity)**

CONCERNING

**Trade Mark No. 256705**

**The registered trade mark.**

1. Kevin Rowe, of 20 Millrace Walk, Saggart, Co. Dublin is the registered holder of the Trade Mark, OsKaRs, which is registered under TM No. 256705 in the following classes:  
Class 36: Fundraising; Charitable fundraising; Charitable fundraising services; Charitable fundraising by means of entertainment events.  
Class 41: Entertainment; Live entertainment; Cinema entertainment; Theatre entertainment; Cinematographic entertainment services.  
The mark in question is an Irish Trade Mark that was registered on 23/07/2017 with a registration date of 12/01/2017.

**Application for declaration of invalidity**

2. On 17th June 2020, The Academy of Motion Picture Arts and Sciences, an American company of 8949 Wilshire Boulevard, Beverley Hills, California, 90211-1972 applied under Section 52 of the Trade Marks Act, 1996 for a Declaration of Invalidity in respect of the registration and included with the application a statement of the grounds on which it was made. Having outlined the background and nature of their business, the Applicant contended that the Proprietor's TM No. 256705, "OsKaRs", offends against their earlier EUTM 002931038, "OSCAR", for services in Class 41, TM 200015, "OSCAR", for services in Class 41, TM149097 "OSCAR", for goods in Class 9 and TM140893 "OSCAR", for good in Class16. The action was based on the provisions of Sections 10(2)(b), 10(3) and 10(4) of the Act.

On 28<sup>th</sup> September 2020, the Holder filed a Notice of Opposition against the application under Rule 41(3) of the Trade Mark Rules, 1996 (“the Rules”). On 29<sup>th</sup> March 2021, the Applicant filed supporting documentation, under the provisions of Rule 20, that included a Statutory Declaration from Scott Miller, Chief Administrative Officer, and General Counsel of the Applicant, together with accompanying exhibits referenced KR1 to KR6, in support of their application.

### **Counter Statement of the Proprietor**

3. On 28 September 2020, the Proprietor filed a counter statement in defence of his mark which can be summarised as follows:
  - i. The registered mark differed in important ways from that of the Applicant. This included differences in spelling, colour, and visual presentation. The marks were not, therefore, identical.
  - ii. The average consumer of the services in question would be unlikely to be confused by the respective marks.
  - iii. The similarity between the marks was limited to phonetic factors only.
  - iv. The respective services covered by the marks were different.
  - v. The invalidity action was launched nearly three years after the Proprietor’s mark was registered thus indicating that the Applicant had not been impacted by its registration.

### **Grounds of the Application**

4. In its Statement of Grounds, accompanied by a Statutory Declaration, filed as evidence under Rule 20 in support of the application for a declaration of invalidity on 29 March 2021, the Applicant makes a number of statements and claims, which I summarise as follows:
  - (i) The Applicant is the registered Proprietor of the following marks: European Union Trade Mark Number 002931038- “OSCAR”- covering services in Class 41, Irish TM Number 200015 “OSCAR”- covering services in Class 41, Irish TM Number 149097 “OSCAR”- covering goods in Class 9 and Irish TM Number 140893 “OSCAR”- covering goods in Class 16. Details of the Applicant’s mark were included in Exhibit Reference KR1.

- (ii) The Applicant further asserted that their listed marks are very similar to that of the Proprietor. They were stated to look alike, sound alike and are conceptually similar. Furthermore, the respective Class 41 services were held to be absolutely identical. In addition, it was argued that the Class 36 services contained in the Proprietor's mark were intrinsically linked to and overlap with the Class 41 services, as entertainment services are often used as a means to raise charitable funds.
  
- (iii) The Applicant outlined in some detail the history of the motion picture Academy Awards, first held in 1929, and known internationally as The Oscars. These have been awarded annually since then and include awards in over twenty categories including Best Picture, Best Director, Best Actor and Best Actress. The annual awards ceremony is broadcast internationally and is viewed by an estimated audience of fifty-six million people, either via a live or delayed broadcast. The event is preceded every year by a big build up which is extensively followed by the international media. After the ceremony, the word OSCAR is used on many products and merchandise with the permission of the Applicant.
  
- (iv) Exhibit Reference KR2 consisted of a document titled "International Distribution Review" which included information on the broadcast and promotion of the Oscars in a number of countries around the world. The Applicant asserted that their mark "OSCAR" has acquired a very substantial reputation throughout the world in relation to entertainment services, namely the promotion of movies in the film industry, by the awarding of prizes, awards and tributes for movies, cinema shows, and entertainment services rendered through the medium of an annual live television broadcast dealing with motion pictures. The term "OSCAR" has a substantial reputation in all related and affiliated goods and services including motion picture exhibitions, movie festivals, the rental of film and books and publications concerning anything to do with the film industry and movies in general. The substantial reputation of the Applicant's mark subsists in the service of promoting the art form of film due to the intensive use that has been made of the term for more than 90 years and the widespread popularity of the event it designates, namely the Oscars. The mark OSCAR has become a

vehicle for communicating a message of exclusivity and top achievements to the public and that clearly represents a financial value. The international reputation of the mark was mirrored in Ireland. The annual event is written and spoken about for months before the actual ceremony, with predictions being made in advance and with lengthy discussions taking place in relation to the nominations for any particular year.

- (v) Exhibit Reference KR3 consisted of the results page from various online searches limited to Ireland. The searches run included “the Oscars”, “Oscar”, “Oscar winners Ireland” and other similar ones. This was held by the Applicant to show how ubiquitous the term “OSCAR” had become in Ireland.
- (vi) Exhibit Reference KR4 consisted of various articles extracted from websites of entertainment and news sites discussing the success of the Irish at the Oscars over the years. These show in the mind of the Applicant that the term “OSCAR” has a substantial reputation in the minds of the Irish public.
- (vii) Exhibit Reference KR5 consisted of an extract from an article from the website “joe.ie”. This discussed how Ireland is number one per capita in Europe for cinema attendance. The Applicant contended that their trade mark “OSCAR” has been used by them throughout the world and, as a result, it enjoys a substantial reputation including in Ireland. Furthermore, owing to this widespread and long-standing use of the term “OSCAR”, the mark should be held to have an enhanced, elevated level of distinctiveness in the arena of films, and the film industry in general and related goods and services.
- (viii) Exhibit Reference KR6 consisted of a printout from the website of the Proprietor of the contested registered mark, TM 256705. It was argued that this showed that the Proprietor is engaged in event services and corporate event management. This exhibit also included an extract from a related website of the Proprietor. The Applicant stated that this latter showed that the Proprietor uses the Applicant’s well known gold statuette design in order to advertise events. This indicates an attempt, in their opinion, by the Proprietor to create the impression that their services are either offered by the Applicant or are at least endorsed by them,

which is clearly not the case. This was held to be an attempt by the Proprietor to create a link between the events offered by them and those offered by the Applicant in the minds of the relevant public. This would lead to a likelihood of confusion in the minds of the relevant public between the respective marks. Furthermore, details were provided from the Proprietor's website showing use of the word OSCARS along with the gold statuette design to market his events. It was argued that this showed the Proprietor was actually using the Applicant's mark for this purpose.

- (ix) The Applicant concluded by reiterating his belief that their marks and that of the Proprietor are very similar, visually, aurally, and conceptually. The respective Class 41 services are identical, and the Class 36 services covered by the Proprietor's mark are intrinsically linked to Class 41 services, particularly as entertainment services are often used as a means to raise charitable funds. For the reasons outlined above, the Applicant submitted that the Proprietor's registered mark, TM256705, should be invalidated.

### **Counter Statement of the Proprietor**

- 5. The Proprietor filed his counter statement against the application for a declaration of invalidity on 28th July 2021. The key points made in this are as follows:
  - (i) The Proprietor denied all the grounds and made several statements and claims supporting that denial. These include his contention that his mark, "OsKaRs," is very different to the Applicant's mark, "OSCAR".
  - (ii) The Proprietor went on to state that the differences between the respective marks and the goods/services with which they were used precluded a likelihood of confusion occurring.
  - (iii) The time taken by the Applicant to lodge their action for invalidity, almost three years since the Proprietor's mark was registered, indicated that the Applicant had not suffered any serious impact on either their reputation or finances.

Note: The Proprietor was advised by the Office that evidence filed under Rule 21 must be done by way of a Statutory Declaration. This was not subsequently done. However, I wish to emphasise that this did not impact the decision in this case.

### **Written submissions on behalf of the Proprietor**

6. Mr Dermot Flanagan of Flanagan Solicitors was recorded as representing the Proprietor on 8<sup>th</sup> April 2022. Written submissions were filed on behalf of the Proprietor by Mr James Lawless BL, instructed by Mr Dermot Flanagan, Flanagan Solicitors, under Rule 25(3) on 27<sup>th</sup> May 2022.

The key points made in this were as follows:

- (i) The Proprietor's business specialises in event management. It offers, amongst other things, a fundraising event whereby participants film short home movies featuring local participants. This culminates in an "awards night" the aim of which is to drive revenue to the host organisation whilst providing a night of entertainment.
- (ii) The Applicant for Invalidation, based in California, operates an enterprise that bestows awards on Hollywood stars and assesses what are considered to be the world's leading film productions annually.
- (iii) The Applicant has suggested that a risk of confusion could arise between the respective enterprises and seeks to invalidate the mark of the Proprietor on that basis.
- (iv) The key points and background to the Applicant's case, as outlined in their Application for a Declaration of Invalidation and a Statement of Grounds on 17 June 2020 were then repeated.
- (v) A summary of the main points of the Proprietor's counter-statement of 28<sup>th</sup> July 2021 was then included.
- (vi) The fact that the Applicant raised no objection at the time of the Proprietor's registration and made no move for three years of its operation made it apparent that no actual loss was being incurred.
- (vii) It is a central part of the Applicant's case that the events which they operate in California enjoy worldwide recognition and that any use of a similar mark

or activity is likely to reduce the value of their brand. Furthermore, the Applicant has some marks registered in Ireland which they say are similar to the Proprietor's mark. They were, therefore, seeking to invalidate the Proprietor's mark on this basis.

- (viii) The Applicant does not trade in Ireland but claims that they enjoy goodwill and recognition here. They did not oppose the Proprietor's mark being registered here.
- (ix) A comparison of the marks of the Proprietor and those of the Applicant reveals that they overlap in one category only, Class 41, Entertainment. The Applicant does not provide services in Ireland in that category. As the Applicant has no commercial activity in Ireland, no conflict between the parties could occur.
- (x) A series of articles and testimonials were included, marked Exhibit 1, to indicate the goodwill that the Proprietor had established in his own right and that of his trademark.
- (xi) A series of articles and advertisements were included, marked Exhibit 2, to show examples of other organisations that trade in Ireland using marks similar to those of the Proprietor.
- (xii) It was further contended by the Proprietor that the Applicant's mark could now be considered to have become genericised as illustrated by a copy of an advertisement published in the national press and included in Exhibit 3.

Mr Lawless went on to state the relevant legal context of the Trade Marks Act 1996 on which the case is based. He then compared the Proprietor's mark with that of the Applicant and argued that sufficient differences existed between them to preclude the existence of a likelihood of confusion based on their similarity to each other. Various well-known case law examples were quoted in support of this argument. It was further stated that, as this case concerned services rather than goods, different and more sophisticated criteria apply.

- (xiii) The other grounds on which the Applicant based their case for Invalidity, Sections 10(3) and 10(4) were similarly challenged with reference to well-established case law.
- (xiv) The alleged inactivity of the Applicant in respect of their own mark in Ireland and the delay of three years by the Applicant in bringing the current

proceedings meant that the Proprietor is entitled to defeat the claim of the Applicant and maintain his registration of the relevant mark.

## **The Hearing**

7. At the Hearing, held on 15<sup>th</sup> March 2023, the Proprietor was represented by Mr. James Lawless BL, instructed by Mr Dermot Flanagan, Flanagan Solicitors who also attended. The Applicant was represented by Mr Simon Gray, Trade Mark Attorney of Tomkins & Co.

At the outset, Mr Lawless queried the admissibility of a submission made by Mr Gray in advance of the Hearing on 7<sup>th</sup> March 2023. Mr Gray stated that the material dated 7<sup>th</sup> March 2023 was not a submission of new material, but it contained a copy of his notes for the Hearing. Following a discussion on the matter, I confirmed to the parties that I would make my decision on this case based on the submissions filed by both sides in conformity with the Rules laid down for this. This was consistent with the email sent to Mr Gray and copied to the Proprietor's representatives on 9<sup>th</sup> March 2023. Having clarified this matter, the subsequent arguments advanced by the Proprietors and Applicant's representatives at the Hearing were based on the submissions correctly filed in advance.

Mr Gray proceeded to outline the case of the Applicant for the Declaration of Invalidity, the Academy of Motion Picture Arts and Sciences. Mr Gray summarised in his submission the main points contained in the Application filed on 17<sup>th</sup> June 2020 and the subsequent Statement of Grounds, accompanied by a Statutory Declaration, which was filed as evidence under Rule 20 in support of the application for a declaration of invalidity on 29 March 2021. It was contended by the Applicant that the Proprietor's TM No. 256705, "OsKaRs", offends against their earlier EUTM 002931038, "OSCAR", for services in Class 41, TM 200015, "OSCAR", for services in Class 41, TM149097 "OSCAR", for goods in Class 9 and TM140893 "OSCAR", for goods in Class 16. Mr Gray asserted that their marks are very similar to that of the Proprietor. They were stated to look alike, sound alike and to be conceptually similar. Furthermore, the respective Class 41 services were held to be absolutely identical. In addition, it was argued that the Class 36 services contained in the Proprietor's mark were intrinsically linked to and overlap with the Class 41 services, as entertainment services are often used as a means to raise charitable funds.



The motion picture Academy Awards, first held in 1929, and known internationally as The Oscars, are awarded annually and include awards in over twenty categories including Best Picture, Best Director, Best Actor and Best Actress. The annual awards ceremony is broadcast internationally and is viewed by an estimated audience of fifty-six million people, either via a live or delayed broadcast. The event is preceded every year by a big build up which is extensively followed by the international media. After the ceremony, the word OSCAR is used on many products and merchandise with the permission of the Applicant. Mr Gray stated that the mark "OSCAR" has acquired a very substantial reputation throughout the world in relation to entertainment services. The mark OSCAR has become a vehicle for communicating a message of exclusivity and top achievements to the public and that clearly represents a financial value. The international reputation of the mark was mirrored in Ireland, where the term "OSCAR" has a substantial reputation in the minds of the Irish public.

Mr Gray referenced a review of the Proprietor's website which revealed that the Proprietor uses the Applicant's well known gold statuette design in order to advertise events. This indicated an attempt, in their opinion, by the Proprietor to create the impression that their services are either offered by the Applicant or are at least endorsed by them, which is clearly not the case. This was held to be an attempt by the Proprietor to create a link between the events offered by them and those offered by the Applicant in the minds of the relevant public. This would lead to a likelihood of confusion of the relevant public between the respective marks.

The mark of the Petitioner is distinctive and, despite the claim of the Proprietor, it has not become common or generic. The Petitioner at all times enforces their rights in their trade mark and has not allowed their mark to be generic of an entertainment service or award ceremony, particularly in the cinema and entertainment sectors.

Mr Gray concluded his submission by reiterating his belief that the Applicant's marks and that of the Proprietor are very similar, visually, aurally, and conceptually. The respective Class 41 services are identical, and the Class 36 services covered by the Proprietor's mark are intrinsically linked to Class 41 services, particularly as entertainment services are often used as a mean to raise charitable funds.

Mr Lawless, acting for the Proprietor, then argued against a Declaration of Invalidity being granted in respect of their mark, TM 256705, “OsKaRs”. His arguments were based on the written submissions filed on behalf of the Proprietor under Rule 25(3) on 27<sup>th</sup> May 2022. The nature of the Proprietor’s business was outlined and contrasted with that of the Applicant. The Proprietor is based in Ireland and his business specialises in event management and includes, amongst other packages, short home movies featuring local participants. This culminates in an “awards night” the aim of which is to drive revenue to the host organisation whilst providing a night of entertainment. This contrasts with the business of the Applicant which operates an enterprise that bestows awards on Hollywood stars and assesses what are considered to be the world’s leading film productions annually. The fact that the Applicant raised no objection at the time of the Proprietor’s registration and made no move for three years of its operation made it apparent that no actual loss was being incurred.

Mr Lawless went on to state that a comparison of the marks of the Proprietor and those of the Applicant reveals that they overlap in one category only, Class 41, Entertainment. The Applicant does not provide services in Ireland in that category. As the Applicant has no commercial activity in Ireland, no conflict between the parties could occur. Mr Lawless further submitted that sufficient differences existed between them to preclude the existence of a likelihood of confusion based on their similarity to each other. Various well-known case law examples were quoted in support of this argument.

It was further contended by the Proprietor that the Applicant’s mark could now be considered to have become genericised thus losing its unique identity through its use by people.

### **Issues for Decision**

8. In the application for a declaration of invalidity, the Applicant claims that the Mark offends against the provisions of the Trade Marks Act, 1996 and in particular offends against the provisions of Sections 10(2)(b), 10(3) and 10(4) of the Act. These are the relevant provisions on which I have decided this case.

## **Section 10 – Is there a likelihood of confusion with the earlier trademarks?**

9. The relevant parts of Sections 10(2)(b), 10(3) and 10(4) of the Act insofar as the present case is concerned read as follows:

*10(2) A trade mark shall not be registered if because—*

- (a) it is identical with an earlier trade mark and would be registered for goods or services similar to those for which the earlier trade mark is protected, or*
- (b) it is similar to an earlier trade mark and would be registered for goods or services identical with or similar to those for which the earlier trade mark is protected.*

*there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark.*

*10(3) A trade mark which—*

- (a) is identical with or similar to an earlier trade mark, and,*
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,*  
*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark*

*10(4) A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented.*

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or*
- (b) by virtue of an earlier right, other than those referred to in subsections (1) to (3) and paragraph (a), in particular by virtue of the law of copyright, registered designs or any other law relating to a right to a name, a right of personal portrayal or an industrial property right*

10. Regarding Section 10(2)(b), it is evident that four basic requirements must be met in order for an objection under it to succeed. They are (i) there must be an earlier trademark, (ii) the mark applied for must be similar to that earlier trade mark, (iii) the goods and services of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, and (iv) there must be a resultant likelihood of confusion on the part of the public.

The first of these conditions is clearly fulfilled in this case. The Applicant's marks were filed, at the European Union Intellectual Property Office (EUIPO) or the Industrial Property Office of Ireland, prior to 12<sup>th</sup> January 2017 (the relevant date) and by virtue of Section 11(1)(b) of the Act, is an earlier trademark as against the present application for the purposes of Section 10. The case is similarly met regarding the provisions of Section 10(3).

When considering this case, I am satisfied that sufficient scope exists within the provisions of Section 10 (2) and (3), together with the submissions made by both sides, to allow me to decide on the application for invalidity before me without recourse to the provisions of Section 10(4) of the Act.

### **Comparison of the marks**

11. I have compared the respective marks of the parties on the criteria of visual, aural, and conceptual similarity and have made an overall assessment of the extent to which they should be regarded as similar or different. This is an assessment of the overall impression the marks would, in my opinion, make on the average consumer of the services for which the Applicant is seeking protection. The European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)<sup>1</sup> that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural, and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

12. There is visual, aural, and conceptual similarity between the marks. Visually, the Applicant's mark consists of a word mark "OSCAR" The Proprietor's word mark "OsKaRs" shares a high level of visual similarity with the Applicant's mark. I would, therefore, assess the level of visual similarity as being high.
13. The first syllable of the Applicant's mark, "OSC" shares a high aural similarity with the first syllable of the Proprietor's mark, "OsK." Similarly, the second syllables of both marks, "AR" and "aRs" respectively share a high aural similarity. When compared as a whole, "OSCAR" and "OsKaRs" share a high level of similarity.
14. The assessment of a mark from a conceptual perspective cannot be conducted in complete isolation from the goods or services covered by the mark, which reinforces the shared conceptual meaning between of the marks. Therefore, I find there is a high conceptual similarity between the marks at issue.
15. Having compared the marks from a visual, aural, and conceptual view I am satisfied that, overall, they share a high level of similarity.

### **Comparison of the services**

16. The Proprietor's mark is registered for "*Fundraising; Charitable fundraising; Charitable fundraising services; Charitable fundraising by means of entertainment events*" in Class 36 and "*Entertainment; Live entertainment; Cinema entertainment; Theatre entertainment; Cinematographic entertainment services*" in Class 41.

Therefore, the services for which the Proprietor has protection in Class 41 are similar or identical to those contained in Class 41 of the Applicant's earlier marks. In particular, these include in EUTM 002931038 "*Entertainment services, namely, conducting an annual award ceremony recognizing exceptional achievement in the film industry, and giving people the incentive to excel in the film industry through the awarding of prizes*" and in TM 200015 "*Entertainment services rendered through the medium of an annual live television programme dealing with motion pictures; the presentation of awards for meritorious achievement being services in Class 41.*"

There is not an obvious overlap between the Proprietor's Class 36 services: "*Fundraising; Charitable fundraising; Charitable fundraising services; Charitable fundraising by means of entertainment events.*" with those of the Applicant. However, the earlier trademarks have a reputation in the State and in the EU, and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark, and this must be taken into consideration when deciding this case.

### **Likelihood of confusion**

17. The CJEU guidance to decision-makers, can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product or service sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product or service bearing the mark put forward for registration in the mistaken belief that it is the product or service he knows by the earlier mark (direct confusion) or that it is related to that product or service (indirect confusion by association).* The confusion in question may be direct confusion, whereby the Proprietor's service is mistaken for that of the Applicant, or indirect confusion, whereby the Proprietor's service is associated in the mind of the consumer with that of the Applicant and a common commercial origin is inferred. It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trademark under the section. The question is whether it is likely or unlikely that the average person would be confused during the typical purchasing scenario.

18. The Proprietor's principal area of business concerns *Fundraising; Charitable fundraising; Charitable fundraising services; Charitable fundraising by means of entertainment events* in Class 36 and *Entertainment; Live entertainment; Cinema entertainment; Theatre entertainment; Cinematographic entertainment services* in Class 41. In arriving at my decision, in addition to the points outlined above, I posed the following question to myself: if the organisation, business and reputation of the Applicant for Invalidity did not exist would the Proprietor have called his enterprise OsKaRs? I think that would be, on the balance of probability, unlikely.

19. Having considered the submissions made by both parties and the arguments advanced at the Hearing, I have decided that the registered mark offends against the provisions of Sections 10(2) & 10(3) of the TM Act 1996. The application brought under Section 52 of the Trade Marks Act, 1996 for a Declaration of Invalidity in respect of the registration of TM No. 256705 is, therefore, allowed.

John Nolan

Acting for the Controller

5<sup>th</sup> September 2024