

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

In the matter of an application for the registration of Trade Mark No. 254833 and in the matter of an Opposition thereto.

Irelands Got Talent and Blanchardstown Got Talent

Applicant

Simco Limited and FreemantleMedia Limited

Opponents

The Application

1. On 31 March 2016 Irelands Got Talent and Blanchardstown's Got Talent of 112 Avondale Park, Mulhuddart, Dublin 15, Ireland (hereinafter "the Applicant"), made application (No. 2016/00677) under Section 37 of the Trade Marks Act, 1996 ("the Act") to register IRELAND'S GOT TALENT BLANCHARDSTOWN'S GOT TALENT IRELLYWOOD as a trade mark in respect of "Entertainment" in Class 41.
2. The application was accepted and published in Journal No. 2309 on 15 June 2016. Notice of Opposition to the registration of the mark, pursuant to Section 43 of the Act, was filed on 14 September 2016 by Simco Limited, of 9 Derry Street, London, United Kingdom and FreemantleMedia Limited of 1 Stephen Street, London, United Kingdom (hereinafter "the Opponents").
3. The Applicant filed a counter-statement on 22 November 2016 and evidence was then filed under Rules 20 and 21 of the Trade Mark Rules, 1996 ("the Rules"). Both parties attended a hearing on the matter on 14 June 2018.
4. Acting for the Controller, I decided to uphold the opposition and to refuse to allow the application to proceed to registration. The parties were informed of my decision by way of letter dated 25 June 2018. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent, dated 6 July 2018, pursuant to Rule 27(2) of the Rules.

Grounds of the Opposition

5. In their Notice of Opposition, the Opponents identify themselves as providers of, *inter alia*, entertainment services, the production and presentation of television and radio programmes, films, sound and video recordings, services relating to the organisation, presentation and production of competitions, shows, live performances and audience

participation events, and related goods and services. They say they are the registered proprietors of the following European Union Trade Marks:

Number	Mark	Nice Classes	Application Date
008385874	GOT TALENT	9, 38 and 41	24/6/2009
012124459	THE WORLD'S GOT TALENT	9, 38 and 41	9/9/2013
014510325	ESPAÑA GOT TALENT	9, 38 and 41	26/8/2015
008889644	ČESKOSLOVENSKO MÁ TALENT	9, 16, 25, 28, 38 and 41	17/2/2010

6. The Opponents also say they are the Proprietors of many international GOT TALENT marks (e.g. Britain's Got Talent, America's Got Talent) and attach a list of them to their Notice of Opposition. They then raise objections to the present application under Sections 8 and 10 of the Act, which I summarise as follows:

Section 8(4)(b) – the application was made in bad faith by the Applicant;

Section 10(2)(b) – a likelihood of confusion on the part of the public, and the likelihood of association with the Opponent's earlier GOT TALENT marks;

Section 10(3) – use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponents' marks;

Section 10(4)(a) – use of the applied for mark is prohibited by virtue of the law of passing off.

7. They also object to any application of Section 12 of the Act which would allow the application to proceed to registration on the grounds of honest concurrent use of the disputed mark and the Opponents' earlier marks. The Opponents' final ground of objection is the Applicant is not a legal entity and, accordingly, it is disentitled to hold property, such as a trade mark application or trade mark registration.

Counter Statement

8. Ms. Rebecca Omakaro replied to the Notice of Opposition. I would summarise the relevant contents of her statement as rejecting the Opponents' claims to own the rights to Ireland's Got Talent, and contending that owning other marks (e.g. Britain's Got Talent and

Australia's Got Talent) does not provide any basis for a claim to owning Ireland's Got Talent. She says that if the Opponents owned the disputed rights that they should have sought registration thereof, which the Opponents failed to do.

Rule 20 Evidence

9. Evidence filed by the Opponent under Rule 20 consists of a Statutory Declaration, dated 8 June 2017, of Isabelle Brender, Trade Marks Manager of FreemantleMedia Limited, and sixteen exhibits labelled "1" to "16". Ms. Brender provides details of her company's background and current media operations and lists an extensive number of popular productions, apart from the "Got Talent" range, which includes X Factor, Idols, Family Feud, Storage Wars and The Price is Right.
10. Ms. Brender states that Simco is one of the world's leading music, film and television production companies, which manages a string of high-profile brands through partnerships with FreemantleMedia and others. Simco's assets include the franchises The X Factor and GOT TALENT.
11. Ms. Brender provides a history of the GOT TALENT brand which was created by Simon Cowell and is co-owned and co-produced by FreemantleMedia and Simco. She says the GOT TALENT series has discovered many stars since it began in 2006 and at Exhibit 1 she attaches stories about the winners and their career successes following their victories in the GOT TALENT shows.
12. Ms. Brender states the Opponents have used variants of GOT TALENT marks corresponding with each country around the world. Since the first registration of GOT TALENT in the United States in March 2004, the Opponents have obtained more than 100 trademark registrations for the word marks GOT TALENT or TALENT, including those in local languages, and have also registered a GOT TALENT logo version in 96 countries. A printout of these registrations is attached at Exhibit 2.
13. Ms. Brender says the GOT TALENT format airs in 69 territories across the world and provides at Exhibit 3 a GOT TALENT Global Production Newsletter which quotes this figure. She attaches at Exhibit 4 a printout from Wikipedia, under the heading Got Talent, that lists the territories in which the GOT TALENT show format is produced and aired. She

provides a breakdown of the global revenue for the GOT TALENT shows from 2006 to mid-2015, which show earnings of over €1 billion in that period.

14. At Exhibits 5, 6 and 7 Ms. Brender attaches media coverage of Susan Boyle's record breaking YouTube viewings, printouts of GOT TALENT social media coverage and copies of the extensive Irish media coverage of the GOT TALENT format, respectively.
15. Ms. Brender attaches at Exhibit 8 Irish viewing figures for Britain's Got Talent in respect of a number of seasons. At Exhibit 9 she attaches lifetime (April 2008 to Dec 2016) Irish viewing figures for Britain's Got Talent and America's Got Talent YouTube videos, which indicate that more than 46 million viewings occurred. Exhibit 10 contains a list of 33 YouTube channels for the GOT TALENT format.
16. Exhibit 11 contains the output from a Google® search for the term Got Talent, the first 2 pages of the results of which show that all but one reference returned relates to the GOT TALENT show format.
17. Ms. Brender states the GOT TALENT format is recognised by GUINNESS WORLD RECORDS as the world's most successful reality TV format and she attached at Exhibit 12 a printout of an article dated 7 April 2014 published on the official page of the GUINNESS WORLD RECORDS website evidencing this. Exhibit 13 contains a printout from Wikipedia detailing the many nominations and awards won by the GOT TALENT show in the United Kingdom and the United States.
18. Exhibit 14 contains a FreemantleMedia publication that identified the GOT TALENT format as being the No. 1 show in 49 out of the 61 national versions.
19. Ms. Brender states the Applicant is not a legal entity and is therefore not entitled to own property under Irish law. She attached at Exhibit 15 confirmation for the Companies Registration Office's database that shown Irelands Got Talent/Blanchardstown Got Talent is a business name and not a company.
20. Ms. Brender says the FreemantleMedia Group used its various GOT TALENT rights to successfully invalidate two Spanish trade marks registered for BENIDORM HAS TALENT. She attaches at Exhibit 16 the judgment of the Granada Commercial Court which handed down the decision, together with an English translation thereof.

21. Ms. Brender completes her declaration by stating the Opponents have used their GOT TALENT trade marks in relation to a wide range of entertainment services over a wide geographical area in the European Union, including Ireland.

Rule 21 Evidence

22. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 31 October 2017, of Rebecca Omokaro, of Mulhuddart, Dublin 15 and eleven accompanying exhibits marked “RO1” to “RO11”. Some of the exhibits are copies of the materials submitted by the Opponents and do not require specific mention here.

23. Ms. Omokaro states she trades under the name IRELAND’S GOT TALENT / BLANCHARDSTOWN’S GOT TALENT which she registered as a business name with the Companies Registration Office and she attaches at Exhibit RO1 a copy of the registration certificate. She says the Opponents carry out their business in the United Kingdom and while they have organised talent shows in many parts of the world, they have never done so in Ireland. She refers to the list of countries mentioned by the Opponents in their Notice of Opposition wherein the Opponents have registered their Got Talent trade mark, and notes that Ireland is not included.

24. Ms. Omokaro attaches at Exhibits RO5, RO6, RO7 and RO8 correspondence between the parties wherein the Opponents sought the withdrawal of the Applicant’s application, and put the Applicant on notice that failure to do so would result in the Opponents formally opposing the application; and Ms. Omokaro’s replies indicating the Applicant was not prepared to withdraw the application and intended to robustly defend it.

25. Ms. Omokaro states the Applicant commenced its talent show business in 2015. She says that since 2015 the Applicant has built up goodwill and a reputation in the name IRELAND’S GOT TALENT AND BLANCHARDSTOWN’S GOT TALENT. She attaches at Exhibit RO9 advertisements for these Blanchardstown’s Got Talent events and a single invoice from The Northside People (a local newspaper) for advertising in respect of a “Blanchardstown Feature”, though the invoice is made out to Globe Attainment, at the Applicant’s address.

26. Ms. Omokaro attaches at Exhibits RO10 and RO11 extracts from a September 2017 edition of Metro Éireann whereon the front page contains a photograph of Ms. Omokaro and a

headline proclaiming “I WON’T BOW TO SIMON’S THREATS”, though the publication was printed after the relevant date.

27. Ms. Omokaro also advances argument in support of the application, which I summarise thus: The Opponents’ marks are not registered in Ireland and, in any event, they are not the same as the Applicant’s mark.

The Hearing

28. The Opponents choose not to file any evidence under Rule 22 and the proceedings were moved on to Rule 25 stage, with both parties electing to attend a Hearing. At the Hearing, the Opponents were represented by Mr. David Flynn, Trade Mark Attorney of FRKelly, and the Applicant by Ms. Rebecca Omokaro.

29. Mr. Flynn opened his submissions by confirming the Opponents were maintaining all the grounds of opposition mentioned in the Notice of Opposition. He argued the Applicant must have been aware of the Opponents’ GOT TALENT mark and the Opponents’ reputation in the mark from the television programmes Britain’s Got Talent and America’s Got Talent, both of which have a huge following in Ireland. He argued the Applicant is simply piggybacking on the Opponents’ GOT TALENT marks to the detriment of the Opponents.

30. Mr. Flynn set out his legal arguments based on the relevant facts of the case as he saw them and the evidence filed. He referred to a number of decisions of the European Court of Justice and other precedents in support of each of the grounds of opposition.

31. For her part, Ms. Omokaro argued that the application was examined, accepted and deemed to be in order by the Controller. At no time during the application process did the Controller draw attention to, or raise an objection based on, the Opponents’ claimed marks. She questioned whether the raising of the earlier marks by the Opponents was tantamount to the Controller failing in his duty of care towards the Applicant.

32. Ms. Omokaro argued the term “Ireland’s Got Talent / Blanchardstown’s Got Talent” was registered as a legitimate business name by the Companies Registration Office before the relevant date for these proceedings. She argued the Applicant’s business was trading and had built up a reputation in the contested mark prior to the date of application.

33. I shall deal with each ground of opposition in turn starting with bad faith.

Bad Faith

34. In their Notice of Opposition, the Opponents level a charge of bad faith against the Applicant based on the renown, goodwill, reputation and the long and widespread use of their earlier marks. The Opponents claim the Applicant's mark would take advantage by free-riding on the preparatory work, marketing and promotion which the Opponents have invested in their marks, and that registration of the disputed mark would lead to a misrepresentation or deception that there is some connection or association between the parties. This, the Opponents argue, constitutes behaviour that falls short of acceptable commercial behaviour observed by reasonable and experience people in the particular business area, and thus, it is bad faith. A second claim to bad faith was advanced on the basis that the Applicant was not a legal entity and therefore was disentitled to own property under Irish property law.

35. There is no legal definition of 'bad faith'. However, over many years the Courts have contemplated its meaning and have provided lists of factors which should be considered to determine whether an application was made in bad faith. In this regard the most recent relevant Irish decision is *Marie Claire Netherlands BV v The Controller of Patents, Designs and Trade Marks, Marie Claire SA and Brandwell (Irl) Limited*, wherein Barrett J., having reviewed relevant prior case law, suggests the following principles can usefully be borne in mind when determining whether an application for registration has been made in bad faith:

- (1) bad faith includes dishonesty;
- (2) bad faith includes dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced people in a particular area;
- (3) a relevant factor when determining whether there was bad faith is whether there has been a failure by the person against whom a charge was levelled to address that charge;
- (4) awareness that a party has been using an identical/similar mark for an identical/similar product in at least one EU Member State is not per se conclusive as to bad faith;

- (5) consideration must be given to an applicant's intention at the time of filing an application for registration; intention to prevent a party from marketing a product may be an element of bad faith;
- (6) a key issue arising is whether a mark is being used for its essential purpose, being to aid consumers in distinguishing products;
- (7) the fact that a third party has long used a sign for an identical or similar product capable of being confused with the mark applied for and that such sign enjoys some level of legal protection is a relevant factor when determining whether an applicant acted in bad faith;
- (8) a person is presumed to have acted in good faith unless the contrary is proven;
- (9) an allegation of bad faith is a serious charge that must be proven with cogent evidence on the balance of probabilities;
- (10) it is not enough when seeking to establish bad faith to prove facts which are also consistent with good faith;
- (11) where a party cannot maintain a relative ground of objection to registration, bad faith involves some breach of legal or moral obligation by the applicant towards the third party;
- (12) bad faith may exist where an applicant has sought or obtained registration of a trade mark for use as an instrument of extortion;
- (13) bad faith is not pertinent in a situation where there is a bona fide conflict between the trade mark rights, or perceived rights, of different traders;
- (14) it is not bad faith for a third party to seek, inter alia, a trade mark where third parties are using similar marks and/or are using them in relation to similar goods or services;
- (15) the fact that one party is aware of and has previously clashed with another is not the same as saying a trade mark application by one of those parties is made in bad faith;
- (16) seeking to protect one's commercial interests where one considers that one's activities do not impinge on the core activities of another is not bad faith;
- (17) bad faith is the opposite of good faith; it generally involves but is not limited to actual or constructive fraud; it may merely involve a design to mislead or deceive or some other sinister motive;
- (18) in determining whether there is bad faith, a knowledge of third party use, an intention to prevent a third party marketing a product and the lack of an intention to use

a trade mark, as well as the extent of the reputation enjoyed by the third party's sign at the time of the application are all relevant.

36. Regarding the bad faith claim based on matters not relating to the right to own property, it is clear from the wording used in the Notice of Opposition that the claim is pertinent to Section 10 which deals with relative grounds of opposition that are based on earlier rights, the impact on those earlier rights and the possibility of the respective parties' marks being associated or confused with each other in the marketplace. It is also clear that few if any of the factors listed by Barrett J. favour a finding of bad faith in respect of this claim. Furthermore, this claim has not been sufficiently particularised, and is merely a rehearsal of the arguments advanced in respect of the relative grounds of opposition. Dressing up relative grounds of opposition as bad faith cannot be entertained as a basis on which to level such a serious charge that includes dishonesty, fraud, extortion or other wrongdoing. Having considered all the facts of the case, the evidence adduced (or lack thereof) and the factors identified for consideration by Barrett J., I find there is no cogent argument or basis to lead me to find the Applicant was lacking in bona fides when making the application.

37. Looking now at the claim of bad faith on the basis of a disentitlement to own property. Barrett J. provided a comprehensive list of factors to be considered in determining whether an application was made in bad faith. While it is not offered as an exhaustive list, nonetheless, it touches on all relevant aspects of bad faith. I note the right to own property is not mentioned. In my opinion, in entering of the applicant's name as it appears on the application form, the Applicant was not attempting in any way to be dishonest, underhanded or deceitful. The Applicant entered the name of a business that, prior to the date of application, had already been registered as a business name with the Companies Registrar. I am satisfied the Applicant was unaware that making such an entry on the form could have implications down-the-road in terms of vindicating the rights that registration of a trade mark confers. But this lack of awareness is clearly not a manifestation of bad faith. Accordingly, I reject this argument also. Therefore, I am completely satisfied the application was not made in bad faith.

Section 10(2)(b) – likelihood of confusion

38. Turning now to the relevant part of Section 10(2) of the Act, insofar as the present application is concerned, which is written in the following terms:

(2) A trade mark shall not be registered if because –

(a)

(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.

39. The principles of interpretation to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the Court of Justice of the European Union (CJEU)¹ and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischalteprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*². In summary, the principles are:

- (i) the likelihood of confusion must be appreciated globally, having regard to all the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;
- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely instead on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer normally perceives a mark as a whole and does not analyse its various details;

¹ including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

² Unreported decision dated 14 June, 2007

- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

40. There are four basic requirements which must be met for an objection under Section 10(2)(b) to succeed. The first of these conditions is there must be an earlier mark. All the marks relied upon by the Opponents were filed with the European Union Intellectual Property Office prior to the date of application of the disputed mark. By virtue of Section 11(1)(b) of the Act they are earlier trade marks.

41. The second requirement is there must be identity or similarity between the services. The Applicant seeks registration for its mark in respect of entertainment in Class 41. As each of the Opponents' marks are already registered for entertainment in Class 41, there is identity insofar as the services are concerned.

Similarity of the marks

42. Turning now to the third requirement: the mark applied for must be similar to the earlier marks, though it need only be similar to one of the Opponents' marks for it to fall foul of Section 10(2)(b). For the purposes of conducting this examination, I will concentrate on the Opponents' house or basic mark "GOT TALENT". I have compared this mark to the disputed mark 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. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the services for which the Applicant seeks registration. I must also be mindful that the CJEU has noted in *Sabel*³ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

43. In his submissions at the Hearing, Mr. Flynn argued the marks share a high degree of similarity because of the presence of Opponents' mark GOT TALENT, not just once but twice, in the Applicant's mark. The presence of the two geographical references merely replicate the structure and conceptual message portrayed by the Opponents' many other GOT TALENT marks. He argued the IRELLYWOOD element was negligible and serves

³ *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*

no purpose in the mark. While Ms. Omokaro did not explain the rationale behind the inclusion of this word, I am satisfied it is a fusion of the words Ireland and Hollywood.

44. Clearly the marks share some visual similarity as both contain the words GOT TALENT. The elements that distinguishes the marks is the presence of the words IRELAND'S, BLANCHARDSTOWN'S and IRELLYWOOD. The respective marks are depicted in uppercase characters using an unremarkable typeface. In my opinion, from a visual perspective, the marks are far more similar than dissimilar and I would rate the level of similarity as high.
45. The aural difference between the marks is also centred on the inclusion, in the Applicant's mark, of the words Ireland's, Blanchardstown's and IRELLYWOOD. Again, I find from an aural point of view, the marks are also similar, but less so as compared with the visual similarity. I would assess the degree of aural similarity as medium.
46. Conceptually, the Opponents' mark will be understood by consumers as conveying the message that someone has talent. The references to Ireland and Blanchardstown in the Applicant's mark merely explains that it is the people of Ireland and Blanchardstown that have talent.
47. The inclusion of the word IRELLYWOOD at the end of the mark does not diminish this message or convey an independent or separate message that would be understood or remembered by consumers. In my opinion, in the context of the overall conceptual understanding of the Applicant's mark, it is merely an irrelevant add-on.
48. Clearly there is some level of conceptual similarity. I am satisfied the marks share a high degree of conceptual similarity. This, when considered in conjunction with what I have found as regards the verbal and visual similarities, leads me to find the marks share a high degree of overall similarity.

Likelihood of confusion

49. The basic ingredients of an objection under Section 10(2)(b) of the Act – *earlier similar trade mark and identical services* – are present in this case and the issue now rests on whether, as a consequence, there is a likelihood of confusion on the part of the purchasing public.

50. The kind of confusion that Section 10(2)(b) seeks to avoid is concerned solely with the commercial origin of goods or services (though in this case only services), whereby the average consumer, being familiar with services sold under the earlier mark and, because of the similarity in the respective marks, attributes to the services offered under the disputed mark the qualities and characteristics that he associates through experience with the services offered under the earlier mark. The question is whether the average person, who knows of services sold under the Opponents' trade mark GOT TALENT and who then encounters the Applicant's identical services offered under the disputed trade mark, would assume that the latter services were connected to the former in the sense that they were both put on the market by the same undertaking or by commercially related undertakings.
51. The criteria against which the question should be answered has been enunciated in a number of decisions of the CJEU⁴ in this area and include the following:
- i. A lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
 - ii. The more distinctive the earlier mark, the greater will be the likelihood of confusion;
 - iii. In determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;
 - iv. In making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
 - v. A global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed;

⁴ Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- vi. The assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- vii. The likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case.

52. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- (a) The Opponents' GOT TALENT mark has a low level of inherent distinctiveness in respect of entertainment services, but nonetheless it has the capacity to identify these services as being those of a particular undertaking and thus to distinguish them from the entertainment services offered by other undertakings.
- (b) The average consumer, in this case the general public, is very familiar with the Opponents' GOT TALENT mark by virtue of the popularity of the television shows Britain's Got Talent and America's Got Talent.
- (c) The Opponents' GOT TALENT mark is long established, recognised easily and well known in the State, and has acquired substantial additional distinctiveness through use.
- (d) The Opponents have invested significantly in the promotion of their GOT TALENT brand.
- (e) The overall impression created by the marks in question is that they are very similar.

53. In her evidence and at the Hearing Ms. Omokaro argued the Opponents do not own "the world" in terms of the Got Talent mark and that she was the first to use the term Ireland's Got Talent in trade. The Opponents have not registered Ireland's Got Talent or Blanchardstown's Got Talent and she has a constitutional right to own property and she is the rightful owner of the mark at issue. In any event, she argued, no-one would confuse her talent shows with those of the producers of Britain's Got Talent.

54. Ms. Omokaro portrayed these proceedings as a David versus Goliath scenario, with the large, deep-pocketed Opponents seeking to achieve world dominance in the talent show business and to crush the Applicant who is merely a small local operator. Mr. Flynn argued

the Opponents are simply trying to protect their intellectual property assets and investments and have every right to block third parties from registering confusingly similar marks.

55. I am sure there are many one-off local fund-raising or charity talent shows organised by schools, clubs or firms in Ireland that use the Got Talent moniker. I am also sure the Opponents have no interest in spoiling such fund-raising fun by attempting to block all such events. But this is not what is happening in these proceedings. The Applicant has sought trade mark registration and is seeking to acquire all the benefits of getting its mark on the Register, most important of which is attaining a State-wide monopoly in the mark.
56. Ms. Omokaro admitted that she is not an expert on trade mark matters and did not fully understand the rights confers by the registration of a European Union Trade Mark (EUTM). Be that as it may, the Opponents own an EU-wide monopoly in the GOT TALENT mark by virtue of its registration as an EUTM. The earlier similar mark is registered for identical services for which the Applicant seeks registration. These are the pertinent facts of this case. Any differences in the scale, format, participation levels, venues or geographical location through which the Applicant and Opponents currently operate are irrelevant. That the Applicant is not producing televised talent shows in a like manner to the Opponents is also irrelevant. While, at the moment, the Opponent may be operating on a completely different scale to the Opponents, nonetheless, the “entertainment” services for which registration is sought are identical to those for which the Opponents’ Got Talent mark is registered.
57. Irish consumers are well used to the overspill of television entertainment show formats from the United Kingdom and elsewhere. Many television shows are replicated for an Irish audience and some, like Who Wants To Be A Millionaire, retain the name used in the UK. When this happens, the Irish public are aware that the owners of the brand have either a direct connection with the Irish version or have licenced the use of the name and format. Accordingly, Irish consumers would instinctively expect that anyone operating on a nation-wide level under the brands Ireland’s Got Talent or Blanchardstown’s Got Talent, separately or in tandem, would have some connection with the Got Talent brand owners.
58. Therefore, it is clear to me that, if a consumer was familiar with the Opponents’ trade mark Got Talent in respect of entertainment services and encountered the Applicant’s mark in respect of identical services, they would be likely to believe the Applicant’s mark emanates

from the same source or that the proprietors of the marks were economically linked. This is precisely the scenario that would inevitably lead to the type of confusion that Section 10(2)(b) seeks to avoid.

59. Accordingly, the application offends against Section 10(2)(b) of the Act and must be refused.

Unfair Advantage

60. Lest on appeal the Court finds that I have erred in my ruling under Section 10(2)(b), I will consider the matter under Section 10(3), the provisions of which read as follows:

“(3) A trade mark which is identical with or similar to an earlier trade mark 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.”

61. There are a number of conditions which must be fulfilled for an opposition to succeed under Section 10 (3) of the Act. Firstly, there must be identity or similarity of the marks at issue; secondly, the earlier mark must have a reputation in the State; thirdly, the use of the later trade mark must be without due cause; and fourthly, such use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

62. I have already found that the first condition has been met – there is a high level of similarity between the Applicant’s and the Opponents’ marks. The evidence provided by the Opponents shows their mark is well-known throughout the State and that significant investment in it has been undertaken. Considering the foregoing, it is fair to say the Opponents marks enjoy a reputation in the State.

63. However, is that reputation entitled to protection under the Paris Convention as a well-known trade mark and does it enjoy the type of reputation that Section 10(3) seeks to protect? Such a reputation would be expected to extend beyond the limited class of consumers of the Opponent’s services and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponents’ services. In my opinion, basically everyone in Ireland

knows of the Opponents' GOT TALENT mark and it had, on the relevant date, reached the level of recognition required in order to invoke the provisions in Section 10(3) of the Act.

64. The Applicant does not accept that use of the brands Britain's Got Talent and America's Got Talent, albeit that they contain the words "Got Talent", equates to a reputation in the Applicant's IRELAND'S GOT TALENT BLANCHARDSTOWN'S GOT TALENT IRELLYWOOD mark. However, it is common case that the Opponents are well known in Ireland for their television shows Britain's Got Talent and America's Got Talent.
65. Therefore, it must be the case that it is the common Got Talent element of these brands that have generated the reputation and not the geographical location referred to, which merely explains that the entertainment services produced under the mark are of a particular geographical origin. Viewers know what to expect of the Opponents' entertainment services, whenever they are under India's or Australia's Got Talent, because of the reputation and quality associated with the Got Talent brand.
66. No evidence was adduced by the Applicant to suggest that it had due cause to adopt the mark, save that it was registered as a business name. The Applicant has not advanced any explanation as to how it came to adopt its mark. While there are any number of trade marks that can be devised for entertainment services, it is clear to me the Applicant must have been aware of and had the Opponents' already established and registered GOT TALENT brand in mind when it settled on its mark. The Applicant had no association with the words GOT TALENT prior to selecting it and in the absence of any explanation for doing so, I find that the Applicant does not have due cause to seek registration of the disputed mark.
67. I must now consider whether the disputed mark would take unfair advantage of, or be detrimental to, the Opponent's earlier marks. The issue of unfair advantage and detriment are not concerned with likelihood of confusion or with passing off, and must be looked at in isolation from these aspects of this case. To find in favour of the Opponent on this ground I do not have to find that the Applicant's actions were both unfair and detrimental - it is sufficient that only one of the conditions be met. Looking firstly at detriment, it is in my opinion possible that "blurring" may occur, whereby the Opponents' mark's capacity to identify the services as being those of the Opponent could be insidiously eroded over time by the use of the same or a similar mark in relation to services that have another commercial origin.

68. As regards unfair advantage, in my opinion, the Applicant must have been aware of the Opponents mark, though I accept that it may not have been aware of the protection afforded it by virtue of the Opponents' EUTM. In my opinion, by using a mark highly similar to the Opponents' GOT TALENT mark, the use of which no due cause has been demonstrated, the Applicant is attempting to ride on the coat-tails of the earlier mark in order to benefit from its power of attraction, its reputation and prestige. This would exploit, without paying any financial compensation, the marketing effort expended by the Opponents in creating and maintaining their image, and in promoting their own products. Therefore, I must conclude the advantage resulting from such use is an advantage that would be unfairly taken by the Applicant of the distinctive character and repute of the Opponents' GOT TALENT mark. Therefore, I must uphold the opposition on the grounds that the Applicant's mark offends against Section 10(3) of the Act.
69. Having refused the application on grounds that it offends against Sections 10(2)(b) and 10(3) of the Act, I need not consider the opposition on the grounds raised in respect of Section 10(4)(a). Based on the foregoing, I refuse to allow the application to proceed to registration.

Dermot Doyle

Acting for the Controller

24 October 2018