

# Italian Supreme Court: there is only one 'Oscar' - for films

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And the winner is... the Oscar. It is hard not to connect the word 'Oscar' to the statuette awarded every year in Los Angeles for the best movies, directors, actors and producers. At the same time, when used in different sectors, the term 'Oscar' should now be considered as generic.

This is - at least - what the Italian Supreme Court recently held in a decision [fn]Cassazione civile, sezione I, 21/07/2016, n 15027.[/fn] on the partial revocation for non-use of the Italian and EU trademark, Oscar.

The decision originated from a dispute instigated by the Academy of Motion Pictures Arts and Science (AMPAS) against a football association and two other companies that organised an event entitled 'Oscar del Calcio' (i.e. Football Oscars), which gave awards to the best players, coaches and referees of the football season.

It is worth pointing out that, compared to the use made in the English language,

the word 'Oscar' in Italian is used in a broader manner. Indeed, Italians usually refer to the Academy Awards simply as 'Oscar' while the expression 'Academy Awards' - which is quite common in English - is almost unknown in Italy.

The defendants stated that the trademark 'Oscar' should be revoked due to its 'common use' or what is in Italian language known as 'vulgarisation'. In their opinion, the expression had, over time, acquired the generic meaning of 'first prize' in all contexts particularly given its extended, wide and long use in a number of fields other than the film industry.

The Venice Court of Appeal agreed with that and overturned the first instance decision - which had declared the Oscar trademarks valid. Before the Supreme Court, AMPAS could not turn this around again.

According to the Supreme Court, vulgarisation occurs when the word that constitutes the trademark is acquired by the common language, so that it loses any link with the original rightholder and becomes a generic name. In other words, vulgarisation occurs when the trademark has lost its individualising power and has become a 'common name of an object' for producers and, most of all, for consumers, as a consequence of the spontaneous evolution of the language.

The Court recognised that revocation does not necessarily affect the trademark with respect to all goods and services. The sign may be vulgarised only with reference to some products or services, while maintaining its distinctiveness in some other fields. The Supreme Court agreed with the Court of Appeal that the word 'Oscar' had maintained its distinctive character with reference to the famous cinematographic international competition organised by the Academy. However, the sign had acquired another additional meaning over time, the meaning of 'first prize', in other sectors, different from the film industry. This additional meaning has not been able to neutralise the distinctive character and the 'individualising power' of the word 'Oscar' in its original area.

The trademark 'Oscar' was therefore only partially revoked, namely in fields other than the film industry. Although under the principles of Italian law this can not be considered as a 'precedent' in the common law sense it will be interesting to see how the guidelines set out in this case are followed in future cases by lower courts.