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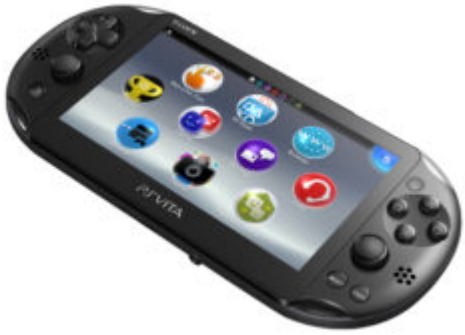
Sony scores twice in Luxembourg – in the same case!

Verena von Bomhard (BomhardIP) · Tuesday, February 4th, 2020



By judgment of 19 December 2019, T-690/18, the General Court delivered the second victory to Sony over EUIPO in the same case concerning its EUTM "VITA" and registration thereof for a number of goods in class 9 such as software and data carriers. The contested decision of the Fourth Board of Appeal of EUIPO was annulled because the Board had failed to "hand down a fresh decision".

Sony's mark was challenged on the ground of non-use. Sony submitted copious evidence; however, the EUIPO Cancellation Division didn't think it was good enough, and revoked the mark. The Fifth Board of Appeal upheld that finding. However, the General Court annulled that Board decision (by judgment of 12 December 2017, T-35/16) for failure to state reasons. Sony had not even raised this point – but failure to state reasons is a public policy issue that the Court can raise of its own motion.

The case went back to the EUIPO, whose Fourth Board of Appeal had to draw the consequences from the Court's judgment. This Board again confirmed the revocation of the VITA mark, arguing, on a number of points, that the earlier Board decision had been confirmed by the Court and was as such *res judicata*. The problem was that the Court's 2017 judgment only dealt with the requirement to state reasons. To the extent that the Court had confirmed certain statements of the Board, this was not a confirmation of the substance of what had been stated, but merely that the requirement to state reasons had been complied with. The Court made clear that the requirement to state reasons has little to do with the correctness of those reasons but only means that the reasoning must be sufficiently clear and unequivocal to allow the persons concerned to ascertain the reasons for the decision and the Court to effectively exercise its judicial review (para. 48). In other words – in the 2017 decision, which dealt only with the requirement to state reasons, the Court did not address the

correctness or legality of the substance of the Fifth Board's findings.

As such, the Fourth Board, when the case came back to it, had to undertake a new assessment of all the various points raised. While it could have effectively endorsed the Fifth Board's findings on the substance, for the Court it was clear that it had not done so, but had rather considered itself bound by the presumably final rulings in the earlier Board decision. As such, the Fourth Board had violated its obligation to reassess the case at issue.

One may of course wonder whether Sony's perseverance will ultimately prove to be a Pyrrhic victory. Apparently, the evidence mostly showed use for a game console. Game consoles, however, are in class 28, and not in class 9. The evidence relating to a video game was not considered sufficient to begin with. As such – the last word has not been spoken, but surely Sony and the fabulous Simon Malynicz QC who represented Sony were surely pleased to bring this one home!

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“>General Court
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