

# Kluwer Trademark Blog

## Sony's "Vita" mark revoked for non-use

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On 1 September 2021, Sony's 'Vita' trade mark lost out in genuine use revocation proceedings in the EU General Court (see case [T-561/20](#)). The trade mark Vita had been registered by Sony for a variety of class 9 items, including "data carriers containing programs" and "audio and/or image carriers (not of paper)." Vieta Audio applied in 2011 to have the registration revoked for non-use. Sony provided evidence of the trade mark's use, notably in relation to the PlayStation Vita (a handheld gaming console). The proof of use was rejected by both the Cancellation Division and the Board of Appeal (BoA). The General Court has now agreed.

The dispute revolved around whether a portable gaming console could be classified as a "data carrier containing programs" or an "audio and/or image carrier." The General Court held that the purpose or intended use of the items in question, as assessed by consumers, was crucial to the issue (as opposed to any technical definition). The BoA had every right to hold that Sony had marketed the PlayStation Vita's gaming experience to consumers rather than its prospective storage capacity. In other words, while the PlayStation Vita was technically a "data carrier carrying programs" or an "audio and/or images carrier," that was not how it was advertised to the consumer (and those features were supplementary to the Vita console's primary function – gaming).



The GC repeated once again that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (consistent case law). The importance of use is not, in itself, demonstrated by evidence intended to establish reputation, as the provisions on genuine use and reputation must be interpreted independently. The proof of genuine use cannot therefore be relaxed on the grounds that the trade mark owner has established that the trade mark has a reputation in the EU (see CJEU judgment of 8 April 2016, Case T-638/14, *Frisa v Frinsa*, para. 33-35). With regard to an action for revocation, the reputation cannot deprive the principle of speciality of all scope. If a trade mark with a reputation is used exclusively for some of the goods or services of the registration, it has to be revoked for the remainder, without reputation being an obstacle.

The GC also emphasized the relevance of the product's intended usage. While the PSVita console was technically a 'data carrier carrying programs' and an 'audio and/or image carrier (not of paper),' that was secondary to the product's primary purpose (a handheld device for mobile entertainment). Trade mark use is not regarded '*in abstracto*' from the perspective of a hypothetical consumer, but rather from the perspective of real individuals in the real world. A trade mark is always present in a setting where it is used to distinguish the goods or services in question.

### **Comment**

The judgment shows that reputed trade marks will not always be spared from revocation, and that in the assessment of trade mark use, it matters how customers view the products. The case further highlights that a registered trade mark must be used as intended, i.e. to identify the products (or services) of the registration from those of a different origin. This is what Sony was ultimately unable to prove. Where a trade mark is registered for a product but used only for a product viewed by consumers as a different product, the trade mark right is lost for the product for which it is not used, even if it resembles the product actually marketed, or is contained in it, or fulfils a secondary but commercially irrelevant function. In this context it should also be remembered that a single (not composite) product normally can fall only into one product category, not several categories – and which category this is depends on the primary commercial function of the product.

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