

# World Trademark Review Daily

Relevant public does not consist only of users of the product  
Sweden - von Iode advokat ab

Examination/opposition  
National procedures

October 31 2011

The Swedish Court of Patent Appeals has issued its decision in an appeal by [Kabushiki Kaisha Sony Computer Entertainment](#) over a refusal to register a three-dimensional (3D) trademark representing the hand control for its PlayStation 2 gaming console (Case 09-282, September 19 2011).

Two years ago the Patent and Registration Office rejected the application on the grounds that the mark lacked distinctiveness. Sony appealed to the Court of Patent Appeals, claiming that the hand control was inherently distinctive, since it differed from other hand controls on the market. When launched, the hand control was revolutionary, and the presence of the PLAYSTATION and SONY trademarks rendered it distinctive. In any case, Sony claimed that the hand control had acquired distinctiveness due to extensive use since the launch.

To prove acquired distinctiveness, an applicant may, among other things, show that the mark is well known on the market. Thus, first of all, the relevant public must be defined. In the present case, Sony stated that it would be inappropriate for the relevant public to consist of the general public, since this did not correctly reflect the composition of the consumers who buy PlayStations. Sony claimed that, based on player registrations, the average PlayStation user was between 15 and 35 years old. Moreover, the users' ages ranged from between six and 43 years old. Only 9% of the registered users were women. According to Sony, the registered users were the same as the relevant public, since most users were reported to have bought a PlayStation: the user report showed that 60% of all registered users had bought the PlayStation themselves, while only 33% of users had received the PlayStation as a gift. Based on these facts, Sony argued that the relevant public consisted of men between 15 and 35 years old.

To support the argument that the hand control had become distinctive through use, Sony submitted high market shares (55 to 100% in the period between 2000 and 2003), high sales figures and substantial promotion campaigns. Sony also provided a market study of the relevant public (as defined by Sony) showing that 99% of respondents recognised the origin of the PlayStation 2 hand control.

The Court of Patent Appeal dismissed the claim that the hand control had inherent distinctiveness. It stated that the design did not exhibit characteristics that departed significantly from the norm and could fulfil the essential function of indicating origin.

Regarding acquired distinctiveness, the court stated that Sony's arguments for limiting the relevant public were insufficient. In fact, the Patent and Registration Office had shown that the hand control was also used by people over 35 years and was also bought as a gift. The court referred to the decision of the Court of Justice of the European Union in [Henkel](#) (Case C-218/01), in which it was held that consumers are not used to connecting a 3D mark to a commercial origin and, therefore, it is more difficult to show that such a mark is distinctive. The court stated that the evidence submitted by Sony was insufficient to conclude that the mark had acquired distinctiveness. Furthermore, the results of the market study could not be taken into account due to a lack of information regarding how the study had been carried out.

The Court of Patent Appeal thus rejected Sony's appeal.

The lessons to be drawn from this decision are as follows:

- The threshold to prove acquired distinctiveness for a 3D mark is higher than in respect of word and figurative marks.
- High market shares, substantial marketing campaigns and high sales figures are not always sufficient to show acquired distinctiveness through use.
- It is risky to define the relevant public too narrowly. The relevant public cannot be limited to only two-thirds of the consumers who bought the product.
- The relevant market covers not only the users of the product, but also all the consumers who may be in contact with the product.

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