

Oops, the name is already taken

Not obtaining trademark registrations early may prove costly.

The industry-leading Sony PlayStation is a household name even for non-gamers¹. The 'PlayStation 4' (or more colloquially referred to as 'PS4') released in 2013 became the fastest selling gaming console in history. The very eagerly awaited 'PS5' or **PS5** expected launch in November 2020.

While expected to dominate next-gen gaming, the 'PS5' faces an awkward scenario in India: the 'PS5' brand had been trademarked in India, but it wasn't by Sony.

It is reported that a Delhi resident named Hitesh Awani filed to register 'PS5' in October 2019². It is unclear as to why Sony did not file it any earlier although the first news of Sony's next PlayStation came in April 2019³ and the hardware specifications confirmed in October 2019⁴.

Sony has a few options including challenging / acquiring Awani's registration or changing the 'PS5' name to something else. Whichever way, it will come at a cost. Currently the 'PS5' may not be available for pre-order in India⁵ and the launch date for the 2nd most populous country on Earth is uncertain.

Pay to use or forced to change

This is not the first case emphasising the significance of registering your trademark in advance. Brands have had to change their appearance in other countries.

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¹ MBLM (2020), U.S. brand ranking trends for 2020 <<https://mblm.com/lab/ranking-tool/?region=1&yr=2020&study=bis&minage=1&maxage=2>>

² Public record of India Intellectual Property India <<https://ipindiaonline.gov.in/tmrpublicsearch/tmsearch.aspx?tn=176036480&st=Wordmark>>

³ What to Expect From Sony's Next-Gen PlayStation (16 April 2019) <<https://www.wired.com/story/exclusive-sony-next-gen-console/>>

⁴ Name decided for next-generation console game machine "PlayStation 5" released in the end of 2020 sales season (8 October 2019) <<https://www.sie.com/jp/corporate/release/2019/191008.html>>

⁵ India Today (7 October 2020), Sony PlayStation 5 India launch could be delayed because a Delhi guy owns PS5 trademark <<https://www.indiatoday.in/technology/news/story/sony-playstation-5-india-launch-could-be-delayed-because-a-delhi-guy-owns-ps5-trademark-1729181-2020-10-07>>

Here are a few examples:

Trademark	What Happened?
	<p>When Burger King attempted to expand its operations into Australia, 'Burger King' was already trademarked by a takeaway food shop in Adelaide.⁶</p> <p>As a result, the Australian franchisee adopts the mark:</p> 
	<p>Asus was restrained by the Delhi High Court from using Zen for branding its products due to similar trademark registered by another.⁷</p> <p>As a result, ASUS renamed the ZenFone 6 to 'ASUS 6Z',</p> 
	<p>When TJX Companies expanded to UK and Ireland, the US store</p>  <p>decided to change its name to 'TK Maxx', to avoid confusion with another established department store called TJ Hughes.⁸</p>
	<p>The company from Ireland changed its name to 'Primark',</p>  <p>to avoid legal action by US retailer J. C. Penney.⁹</p>

For any enquires on trademark protection, please contact **Bahari Yeow** (bahari@ganlaw.my) or **Lim Zhi Jian** (zhijian@ganlaw.my).

⁶ Andrew Terry and Heather Forrest, 'Where's the Beef? Why Burger King is Hungry Jack's in Australia and Other Complications in Building a Global Franchise Brand' (2008) 8 NJILB
⁷ Firstpost (8 June 2019), ASUS is rebranding the Zenfone 6 to ASUS 6Z which will now launch on 19 June <<https://www.firstpost.com/tech/news-analysis/asus-is-rebranding-the-zenfone-6-to-asus-6z-which-will-now-launch-on-19-june-6778561.html>>
⁸ Business Insider (27 August 2018), TJ Maxx has a different name in Europe and Australia, and there's a simple reason why <<https://www.businessinsider.com/tj-maxx-and-tk-maxx-are-same-company-2018-8#:~:text=To%20avoid%20confusion%2C%20the%20US,its%20name%20to%20avoid%20confusion.>>>
⁹ Metro (30 May 2017), Just so you know, Primark is called something totally different in Ireland <<https://metro.co.uk/2017/05/30/just-so-you-know-primark-is-called-something-totally-different-in-ireland-6672292/#:~:text=Primark%20is%20the%20place%20of%20every%20bargain%20lover's%20dreams.&text=No%2C%20literally%2C%20it's%20Primark.,1969%2C%20it%20opened%20as%20Penneys.>>>