

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF applications for the revocation of registered Trade Mark Nos. 124273, 150506 and 150507 and in the matter of the Proprietor's opposition thereto.

AIWA CORPORATION

Applicant for Revocation

(Represented by Tomkins & Co.)

AIWA COMPANY LIMITED


Proprietor

(Represented by FRKelly)

The registered trade marks

1. The three trade marks the subjects of these proceedings are all in respect of the word AIWA, the details of which are set out below.

Trade mark and number	Date of Registration	Class & Goods
AIWA 124273	03/06/1987	Class 9: Electronic calculators, computers, data recorders, modems, modulators, demodulators, streamers, disk drive units, packet radio controllers, acoustic couplers and other terminal and peripheral devices for computers, floppy disks (blank and recorded), computer soft wares.
aiwa 150506	24/06/1991	Class 9: Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines and data processing equipment and computers; fire-extinguishing apparatus.

 150507	08/07/1991	Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
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2. The registration of the 124273 mark was published in Journal No. 1592 of 7 December 1988. The publication of the registrations of trade marks 150506 and 150507 appeared in Journal No. 1732 of 20 April 1994.

The Application for Revocation

3. On 24 August 2017 AIWA Corporation, of West Chicago Avenue, Chicago, Illinois, 60642, USA (the Applicant) made an application for the revocation of the registrations pursuant to the provisions of Section 51 of the Trade Marks Act, 1996 (“the Act”). The application is grounded on claims the trade marks were not put to genuine use in the State, by or with the consent of the Proprietor, in relation to the goods for which they are registered within the period of five years following the date of publication of their registration, and that there are no proper reasons for such non-use.
4. In addition, the Applicant seeks the revocation of the three trade marks on the grounds that use of them has been suspended for an uninterrupted period of five years and there are no proper reasons for such non-use.

Notice of Opposition

5. On 11 June 2018 the Proprietor filed Notices of Opposition together with evidence supporting its claims of use of the marks; such evidence consisting of a Statutory Declaration, dated 23 May 2018, of Tomonori Mitsui, President of AIWA Co. Ltd., and thirty-one accompanying exhibits. While I have examined each exhibit carefully, I shall only refer to them as and when appropriate.

6. In its Notices of Opposition, the Proprietor rejects the claims made in the applications for revocation and claims the evidence submitted sets out genuine use of the marks.
7. The evidence filed by the Proprietor in respect of each of the three registrations was identical. The Applicant also furnished identical materials in respect of its three applications. Also, I am satisfied the three marks can be considered identical for the purposes of these proceedings. So, for the purposes of economy, simplicity and succinctness, I will not differentiate between the individual registrations, unless it is appropriate I do so.
8. In his Statutory Declaration Mr Mitsui provides a history of the AIWA brand from its establishment by AIKO Denki Sangyo Co. Ltd. In 1951. In 1959 that company changed its name to Aiwa Co. Ltd. As of 1982 the Sony Corporation (hereinafter “Sony”) held a 54.6% stake in the company and as of 1 December 2002, Aiwa Co. Ltd. ceased to be a separate company and became a wholly-owned division of Sony. On 1 February 2017 Sony transferred numerous AIWA trade marks, including the three at issue here, to the company TOWADA AUDIO CO. Ltd., which established a new company AIWA Co. Ltd. on 11 April 2017. All three of the AIWA trade marks were transferred to this new company by Sony in line with an “Authorisation letter” issued by the Senior General manager of the Intellectual Property Division of Sony. Mr Mitsui attaches at “Exhibit 1” a copy of this letter and a Deed of Assignment.
9. I detail the complete history as outlined by Mr Mitsui because the chain of ownership of the subject trade marks became a contentious issue during the evidence filing phase of these proceedings. I will return to this again.

10. Mr Mitsui states his company is scheduled to launch a (specified) list of electronic products under the AIWA brand. He attaches at “Exhibit 3A” an article, published in June 2017 on a third party’s website, which mentions that his company planned to revive the AIWA brand. This he says indicates the plan was public knowledge. The article states that AIWA branded products would be released from September 2017 and also mentions the brand owner is in negotiations with retailers in that regard.
11. A close examination of this exhibit uncovers a number of highly relevant factors, the most obvious being that the article was published in Japanese (an English translation was also attached) and clearly was not intended for Irish consumers. The article refers to the “former aiwa” brand and that Sony had announced the end of the brand in 2008. It also mentioned that Sony transferred AIWA’s brand usage rights to the company Towada Audio and that the new product launch was planned in response to this. As can be seen at paragraph 8 above, Mr Mutsui did not mention Towada Audio in the chain of ownership.
12. Mr Mitsui attaches at “Exhibit 3B” an article published in August 2017 on the website of another third party which states “*Aiwa products will once again be on sale as early as this autumn...*” and that “*it will manufacture products... at an affiliated factory in China*”. Here too the article speaks of Sony ending production of AIWA products in 2008 and mentions that Towada Audio is now the owner of the brand.
13. Similarly, a third extract from another third-party website attached at “Exhibit 3C” also refers to the revival of a discontinued brand and the then owners of the trade marks in the story tagline which reads “*Towada Audio purchases dormant audio-visual products maker from Sony*”. This article also states Towada Audio AIWA “*products will be initially sold at retailers in Japan and then introduced to markets in other Asian and Middle Eastern countries...*” There is no mention of Europe, let alone Ireland.

14. Mr Mitsui attaches copies of four Licence Agreements at “Exhibit 3D” and “Exhibit 3E”.

One of these licence agreements is in respect of England and Ireland and another is in respect of Norway, Denmark, Sweden, Finland, Iceland, Eire, Austria, Poland and Germany. These two licence agreements are in respect of two different Licensees and both state “*the Licensor has agreed to grant an exclusive right to the Licensee to manufacture, procure, introduce, and sell the Products under the ‘aiwa’ trademark in the below listed Territories*” - yet both appear to cover Ireland. Clearly something is not right.

15. He attaches at “Exhibit 3F1” and “Exhibit 3F2” two plans (in Japanese with English translations) dated October 2016 in respect of the AIWA brand. One mentions Europe in general and the other mentions certain specific countries in Europe that Towada views as its main targets - though Ireland is not mentioned. It is clear these plans are internal company documents whose contents would not have been known to consumers in Ireland.

16. Exhibits “3F3”, “3F4”, “3F5” and “3F6” either do not mention Ireland or postdate the date of application for revocation, or both, and therefore have zero probative value.

17. Mr Mitsui states the Applicant for revocation, which was established in 2011 as Hale Devices, has no connection nor ever had a connection with the AIWA brand or its owners. He says it was only after his company was established in April 2017 and it started making preparations to relaunch the AIWA brand that AIWA Corporation filed numerous cancellation actions worldwide against his company’s marks. He attaches at “Exhibit 5” sample copies of the cancellation actions.

Evidence of Use

18. Turning to use of the marks at issue, Mr Mitsui states he is advised that the AIWA mark has been used to the present day at least by third-parties and that they are sold on

platforms like Amazon, eBay, Done Deal and Adverts.ie. He says there are several professional distributors of hi-fi products which sell AIWA products. Hence, he claims, until the present day goods bearing the trade mark AIWA have always been on the market and have been offered and sold within Ireland. He attaches at “Exhibit 6” a sample of Amazon UK, Done Deal and Adverts.ie listings for AIWA products. These advertisements are all dated 3 June 2018 and therefore, all postdate the date of application for revocation. However, he attaches at Exhibits “7A”, “7B”, “7C” and “7D” historic advertisement listings from Google and eBay clearly showing AIWA branded goods where available for sale on all the aforementioned internet platforms prior to the date of application for revocation.

19. Mr Mitsui states he is aware of several professional suppliers who still offer hi-fi products under the AIWA brand. He attaches at “Exhibit 8A” an extract, showing AIWA branded products for sale, from the website of a company based in Germany (Springair GmbH) who offer classical hi-fi all over Europe including shipping to Ireland. He also attaches (at “Exhibit 9B”) extracts from various other websites selling AIWA products, namely “Preloved”, “HiFi Forsale”, “HiFi in Touch” and “Audiogold”, which he states sell to Irish consumers.

20. He says he understands there are shops in various EU countries which offer spare parts and devices for AIWA products. He attaches at “Exhibit 9A” and “Exhibit 9B” printouts from 5 such shops which he says sell to Irish consumers.

21. He states that Sony continued to provide a website www.aiwa.com for the support and service of AIWA products. He attaches, at “Exhibit 10” extracts from the “Wayback Machine” captured on 2 November 2014, 20 October 2015, 28 December 2016 and 29

April 2017. These four extracts all refer to the same page which states “... *Please contact the Sony Team in your country or region by selecting your location via the webpage, then following the signs for support.*” However, there is nothing to show that Ireland was a location the viewer could select.

22. He says Irish Sony consumers who need support information for an AIWA product can download manuals from the Irish website www.sony.ie and he attaches at “Exhibit 11” extracts from these support manuals. He also says he is aware that third parties offer repair services for AIWA products in Ireland and he attached at “Exhibit 12A” extracts from three websites to support this.

23. Mr Mitsui states that Sony Corporation company continues to own the website www.aiwa.ie. He says Irish consumers were redirected from this website to another website which then redirected them to an Irish company Intek Ltd., which he was told was an approved/authorised service provider and repairer of AIWA products. He understands that Intek Ltd. was dissolved in January 2016.

24. He attached evidence of reviews of AIWA products (at “Exhibit 13”) and a sample of the results of a Google search for AIWA products limited to the period from 20 May 2012 to 20 May 2017 (at “Exhibit 14”).

25. He concludes his evidence by stating he believes his company is the rightful owner of the reputation and goodwill in the mark AIWA by virtue of the use made by the previous owner SONY CORPORATION and the subsequent assignment of the trade mark rights to his company.

26. Normally in revocation proceedings the matter is decided on the evidence filed by the Proprietor. If it demonstrates genuine use of the mark within the relevant period(s) then the mark will remain on the Register. Therefore, while applicants may argue the evidence does not show genuine use, they rarely seek to file evidence in support of their application. However, in these proceedings the Applicant petitioned the Controller to be allowed to file evidence which addresses certain statements and claims made by the Proprietor in its evidence, which the Applicant claimed impacts on the claims made by the Proprietor regarding the use of the marks at issue. The Applicant identified four specific pieces of evidence it wished to file. Having duly consider the request, the Controller granted the Applicant permission to file the evidence.

Applicant's Evidence

27. Evidence filed by the Applicant consists of a Statutory Declaration dated 25 October 2018, of Joseph Born, Chairman and CTO of Aiwa Corporation, of Chicago, Illinois, USA and four accompanying exhibits labelled "JB1" to "JB4".

28. Mr Born details attempts, that he says were made in good faith, by his company to discuss the status of the trade mark AIWA with Sony Corporation, who had ceased all use of the trade mark. He says one such attempt was a meeting that he and representatives of his company attended in Tokyo, Japan with the proprietors of Towada Group with a view to establishing if there was an opportunity to cooperate. The attempt came to nothing because, according to Mr Born, Sony Corporation did not want a successful reconstituted AIWA nor a global alliance formed that could create a meaningful competitor to Sony themselves.

29. He says that subsequent to the Tokyo meeting, he and representatives from his company visited with Mr Tomonori Mitsui in January 2018 at the CES Exhibition in Las Vegas. By this time numerous applicants for cancellation of AIWA trade marks had been made by the Aiwa Corporation and Mr Mitsui informed Mr Bone that he would only enter into discussions with Mr Bone's company if it abandoned all these cancellation actions. Mr Bone states he did not accept that condition and the discussions ended. Mr Bone states that at the meeting Mr Mitsui confirmed to him that Aiwa Co. Ltd. had not sold any products under the Aiwa brand and Mr Bone claims there have been no sales up to December 2017 in Japan or Europe.
30. Mr Bone then makes statements regarding the chain of ownership of the AIWA trade marks. He states that on 1 February 2017 Sony Corporation assigned all AIWA trade marks to Towada Audio Co. He attached at "Exhibit JB1" an English translation of the documents, filed in proceedings in the United States, confirming the assignment of all AIWA trade marks from Sony Corporation to Towada Audio Co. Ltd.
31. Mr Bone claims that as the AIWA trade marks at issue were no longer the property of Sony Corporation, but were the property of Towada Audio Co., they could not have been assigned to Aiwa Co. Ltd. from Sony Corporation as was recorded on the Irish Trade Mark Register.
32. On foot of this evidence the Controller was reluctant to prosecute these proceedings further until the correct proprietorship of the marks at issue was established and recorded on the Register. This took some time to address but was ultimately resolved to the satisfaction of the Controller.

33. Mr Bone states an independent investigation was undertaken, by the professional investigation company Eccora, prior to the filing of the revocation applications by his Company. He attaches at “Exhibit JB2”, a copy of the full report, which states there was no use of the mark AIWA in Europe undertaken by Aiwa Co. Ltd. within the relevant five-year period.
34. He states the company Cybo Global Limited, announced on LinkedIn on 31 August 2018 their presence at the IFA Consumer Electronic Conference and the relaunch of the AIWA brand. The Conference was held in Berlin from 31 August 2018 to 5 September 2018. He says Cybo Global Limited had entered into a licencing agreement with Aiwa Co. Ltd. after the present revocation applications. He attaches at “Exhibit JB3” a copy of the licence agreement which is a publicly available document, filed as part of cancellation proceedings before the European Union Intellectual Property Office.
35. He states the LinkedIn post reaffirms the Proprietor was not using the trade mark AIWA in Europe, including Ireland, in the relevant five-year period, since the brand was only being relaunched at the trade fair. He attaches at “Exhibit JB4” an advertisement confirming the dates of the 2018 event.

The Hearing

36. The Proprietor chose to file written submissions in lieu of attending at the Hearing. At the Hearing the Applicant for Revocation was represented by Simon Gray, Trade Mark Attorney of Tomkins & Co.

37. In his written submissions David Flynn, Trade Mark Attorney of FRKelly, highlights the relevant legislation, identifies relevant case law, the factors to be considered, the evidence submitted by the Proprietor and what it demonstrates. Mr Flynn emphasises the following:

- i) The ongoing repair and maintenance services that the Proprietor's predecessor Sony Corporation was providing for AIWA products.
- ii) Ongoing sales of AIWA products by third parties.
- iii) The sale of spare parts and devices for AIWA products.
- iv) The resumption of the use of the AIWA trade mark prior to the applications for revocation.
- v) Use of the AIWA trade mark for goods about to be marketed.
- vi) Ongoing references to the renown and reputation of AIWA branded products in trade and consumer publications.

38. He takes issue with certain of the evidence filed by the Applicant for Revocation claiming it to be irrelevant or unsubstantiated. He concludes his submissions by stating the Proprietor of the three marks at issue has shown that the resumption of the use of the marks had begun or at least was being prepared during the interval between the expiry of the five-year period and the filing of the applications for revocation. He argues these preparatory steps date back to October 2016 beginning with the plan for reconstruction of the AIWA brand, followed by the purchase of the AIWA marks in February 2017 and the establishment of the company AIWA Co. Ltd. in April 2017 for the purposes of reviving the AIWA brand globally. This was followed by additional preparations to secure customers. He argues that all this points to genuine use of the AIWA marks during the relevant time period and that such use continues until the present day.

39. At the Hearing Mr Gray took me through all the relevant case law, the factors to be considered, decisions of other competent authorities, the Applicant's evidence and the Proprietor's evidence of claimed use of the mark and all its shortcomings.
40. He argued the evidence submitted by the Proprietor confirms there was no genuine use of the marks during the relevant period. His client filed the revocation applications to reflect the current market position in that the AIWA marks have not been used since 2008 and that the claimed recommencement of use by any of the marks Proprietors has not occurred within the five-year period prior to the date of filing of the applications for revocation.
41. Crucially, he argued, the Proprietor and their representatives have failed to submit any definitive proof of use of the AIWA marks in Ireland with the Proprietor's consent within the five-year period for the full range of goods for which the marks stand registered. Additionally, claims of preparation to recommence use of the AIWA marks in Ireland have not been supported by any proof or any indication of concrete action by the Proprietor.

The law

38. The relevant section of the Act is Section 51, which is written in the following terms:

“(1) The registration of a trade mark may be revoked on any of the following grounds –

- (a) that, within the period of five years following the date of publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the proprietor, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;*
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;*

39. Section 99 also comes into play and reads:

“Where, in any civil proceedings under this Act, an issue arises as to the use by any person of any registered trade mark, the onus of proving such use shall lie with the proprietor.”

Decision

40. At no time throughout these proceedings did the Proprietor or its representative provide any evidence or argument that the disputed AIWA trade marks were used on anything other than audio-visual goods. No claims of use, no claims of preparations being put in place to use, and no claims of support and repairs having been carried out, during the relevant period were advanced in respect of any of the goods in Class 11, which is the only class covered by Registration No. 150507. Accordingly, and without further ado, I must revoke Registration No. 150507 in respect of all these goods, namely, “Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes”.

41. Turning now to the other two registrations No’s. 124273 and 150506 in respect of Class 9. Clearly there are many goods covered by these registrations which are not audio-visual equipment (for example, vending machines and fire-extinguishing apparatus), but for simplicity sake I will not differentiate between the goods unless it is necessary to do so.

42. The Proprietor does not claim that it was manufacturing, distributing, wholesaling, retailing or marketing goods bearing the contested AIWA trade mark in Ireland during the relevant period that are covered by its other two registrations concerning Class 9. The Proprietor does claim that, while the use of the AIWA trade mark had been suspended for

a period of time, preparations for the recommencement of its use had been made prior to the applications for revocation and that Europe and Ireland were included in these preparations.

43. So, the Proprietor was unable to establish the nature of the use of the mark, the place of its use, the time of its use or the extent of its use during the relevant period. The Proprietor could not offer any proof that actual sales had taken place and could not submit any information regarding turnover, the volume of sales, advertising expenditure, details of stockists and market share or provide copies of invoices or delivery dockets.

44. At no time in these proceedings did the Proprietor or its representatives claim that if there was not genuine use of the marks in Ireland within the relevant period, then there were proper reasons for such non-use. Therefore, the outcome rests on whether or not the actions taken and the materials furnished by the Proprietor, which it claims demonstrate use of the AIWA trade mark by the Proprietor and with its consent, constitutes genuine use.

45. In its evidence the Proprietor provides details of the history of the AIWA brand from its inception in 1951, claiming that it is still in genuine use today. I am satisfied that AIWA branded products continued to be available after Sony formally announced its abandonment of the brand in 2008, and they continued to be available up to the relevant date. But the evidence submitted shows they continued to be available only on a second-hand basis, and I shall deal with that anon.

46. Mr Mitsui submitted his Statutory Declaration in June 2018, which is 10 months after the applications for revocation were made. Nowhere in his declaration did Mr Mitsui suggest

his company's plans to relaunch the AIWA brand had advanced to the production stage where AIWA branded goods were now being manufactured and placed on the market. Likewise, in his written submissions in lieu of attending the Hearing and filed on 4 November 2019 (over two years after the applications were made), Mr Flynn did not suggest that the Proprietor's plans had made progress to the point that the Proprietor's AIWA branded products were once again available to Irish consumers. Such claims, had they been made by Mr Mitsui or Mr Flynn, would have been in respect of activities that post-dated the relevant date and would have been irrelevant. Nonetheless, I am sure that if it were the case that such statements reflected the then state of play, they would have been made to prove the Proprietor's plans had actually come to fruition. I mention this not to cast doubt on the veracity of the Proprietor's evidence or arguments, but to acknowledge the reality that the best laid plans often come to zero, and thus, plans to use cannot in and of themselves be taken as proof of use.

47. The CJEU has set out what is required in order to establish genuine use of a trade mark insofar as revocation proceedings are concerned. These include *Ansul*¹, *La Mer*², *Silberquelle*³, *Sunrider*⁴, *Verein*⁵, *Leno*⁶ and *Reber*⁷ in which the following factors were identified as the criteria to be assessed by competent authorities:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

¹ *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439

² *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159

³ *Silberquelle GmbH v Maselli-Strickmode GmbH* (Case C-495/07)

⁴ *Sunrider v Office for Harmonisation in the Internal Market* (Case C-416/04 P)

⁵ *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky* (Case C-442/07)

⁶ *Leno Marken BV v Hagelkruis Beheer BV* (Case C-149/11)

⁷ *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market* (Case C-141/13)

- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services

in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

48. What use was made of the mark must be within the period allowed and must be deemed genuine use in order to justify the continuous monopoly rights granted to the Proprietor by trade mark registration. The onus of proving use lies with the Proprietor and no supposition is entitled to be made in that regard. This is clear from case law where, in *Vitakraft*⁸, the Court had this to say at paragraph 28:

⁸ *Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM, Case T-356/02*

“... 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.”

49. Taking full heed of the factors that I must consider and looking at each individual piece of evidence provided by the Proprietor, I find none of it could be deemed to constitute genuine use. Viewed in its totality, the sum of the parts also fails the test as it provides no greater proof of genuine use. I find there is simply no evidence to suggest the Proprietor sold a single AIWA branded product to a single customer in Ireland during the relevant period. The Proprietor did not in any way target consumers in Ireland by means of advertising or promotion.

50. Irish consumers could not reasonably have known the Proprietor was planning to relaunch the AIWA brand in Ireland as not a single piece of evidence relating to the relaunch was directed towards Irish consumers. The plans initiated by the Proprietor would initially have been confidential internal documents. No evidence was provided by the Proprietor of public announcement or marketing with regard to the impending relaunch of the AIWA brand in Ireland. Information about a planned relaunch published on the foreign website of a third party, that is in theory accessible to Irish consumers, cannot be deemed to demonstrate advertising or marketing information targeting Irish consumers. No evidence was submitted to suggest that such material was accessed by Irish consumers and, in my opinion, if it was encountered it was purely by chance.

51. The licence agreements submitted into evidence are contradictory in that two separate entities were being given exclusive licences for AIWA products in Ireland. Therefore, I cannot accept their validity, contents or that they demonstrate concrete plans by the

Proprietor to resume the use of the trade mark AIWA in Ireland during the relevant period.

52. The Proprietor put much store in its claims that AIWA branded products and spare parts were available online for purchase by Irish consumers. Other than producing screenshots from various independent websites depicting AIWA goods, no evidence of any Irish consumer having actually purchased anything was submitted.

53. I am satisfied the Proprietor did not create or maintain a market for its goods in Ireland during the relevant period in respect of any of the goods for which the disputed marks are registered. The only sales of AIWA products to Irish consumers that could possibly have occurred would have been by way of the purchase of second-hand AIWA branded products or accessories through individuals or independent traders. No evidence was advanced to suggest, let alone prove, that any of these second-hand dealers had a connection with the Proprietor or was operating under a licence or with the consent of the Proprietor.

54. All manner of goods are sold through second-hand markets, particularly online. In my opinion, second-hand or spare part sales and product maintenance can only count as genuine use of the mark when these are provided by the Proprietor or with the consent of the Proprietor. Otherwise the offering for sale of any pre-owned branded item is totally outside the control of the brand owner who has zero control over the provenance, quality, mechanical order or worthiness of the item. Where there is no connection to the brand owner, the Proprietor will never take responsibility for or stand over such sales. Accordingly, this is not use of the mark with the Proprietor's consent and therefore cannot

be deemed genuine use. Sales by individuals on eBay, DoneDeal or the like clearly fall into this category.

55. In his written submissions Mr Flynn argues that *Ansul*⁹ makes it very clear that use of a mark may also be genuine in respect of goods for which the trade mark is registered that were sold at one time but are no longer available. He maintained this applies where the Proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark. He argues the same may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

56. I accept the provision of support for existing products is relevant to the assessment of genuine use. The Proprietor's evidence (Exhibit 10) shows Sony Corporation operated a website www.aiwa.com and claims that the after-sales services provided through this website demonstrates genuine use. The Proprietor entered support manuals into evidence (Exhibit 11) claiming they could be downloaded from the Irish website www.sony.ie by Irish Sony customers who needed support information for an AIWA product.

57. However, it is unclear to me what services were provided by Sony Corporation. The www.aiwa.com website appears to consist of nothing other than a redirect page with no more than a link to www.sony.net/electronics/. There is no indication of where the viewer ends up having clicked on this link or that the destination has a connection with Ireland. The claimed support manuals, which are undated, appear to be user operating manuals and do not seem to provide any technical information that would allow the consumer to carry

⁹ *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439

out any repairs (which, in any case, Sony most likely would have recommended against carrying out).

58. I find the circumstances in *Ansul* are not repeated in the current case. In *Ansul* it was the proprietor itself that was providing support services, maintaining, checking and repairing equipment bearing the mark at issue (Minimax). It used Minimax on the spare parts and provided evidence by way of invoices and other materials to support its claims of use, all of which bore the Minimax mark. Having repaired the equipment, stickers bearing the Minimax mark were affixed to the equipment. *Ansul* also sold such stickers and strips to undertakings that maintained Minimax branded fire extinguishers. No such material was put into evidence in these proceedings.

59. In reality there is absolutely no evidence to demonstrate that support and maintenance services were actually provided to Irish customers by Sony during the relevant period. There are no invoices, details of revenue or customer numbers, no logs of repair work carried out or an indication of the number of visits to the websites by Irish consumers.

60. Under Section 99 of the Act the onus of proving use lies with the proprietor. In this regard Jacob J. had this to say in *La Mer*¹⁰ at paragraph 9:

“In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye - to ensure that use is actually proved - and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

61. I am satisfied that by any standard the Proprietor's evidence falls well short of what would be required to allow me to find genuine use had been made of the marks. The Proprietor

¹⁰ *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159

failed to file solid and objective evidence of effective and sufficient use of the trade marks in Ireland. I find there was no real commercial exploitation of the marks during the relevant period. The Proprietor has failed to prove use of the marks in accordance with their essential function, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin. This applies to the full specification of the goods across all three registrations. Therefore, I must revoke registrations No's. 124273 and 150506 in their entirety.

62. By virtue of Section 51(6) of the Act, the revocation of the registration of a trade mark has the effect that the rights of the Proprietor shall be deemed to have ceased from (a) the date of the application for revocation, or (b) if the Controller is satisfied that the grounds for revocation existed at an earlier date, then at that date.

63. In the present case there was long standing use of the marks at issue beyond the five-year period after the publication of the registration of the marks. It is also the case that the marks ceased to be used long before the date of application for revocation and that grounds for revocation exists at a much earlier date. It is appropriate that I determine an effective date of revocation to reflect these findings.

64. Evidence submitted shows that Sony Corporation formally announced its abandonment of the AIWA brand at some time in 2008. But I cannot conclude that this means the AIWA trade mark was used in Ireland right up until that announcement. Sony Corporation may have stopped trading under the trade mark AIWA in Ireland many years before that. In the absence of definitive evidence either way, I must use my best judgment. In doing so, I am satisfied that an appropriate effective date of revocation of the marks is the start of the

five-year period prior to the date of the applications for revocation, namely 24 August 2012. Accordingly, I revoke the three registrations from that date.

Dermot Doyle

Acting for the Controller

17 April, 2020