

O/071/19

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NOS 1067377, 1313883, 1483522, 1483523  
AND 1500565 FOR THE TRADE MARKS**

**AIWA**

**AND**

**aiwa**

**IN THE NAME OF AIWA CO., LTD  
AND THE CONSOLIDATED APPLICATIONS FOR REVOCATION THERETO  
UNDER NOS 501768, 501769, 501770, 501771 AND 501785  
BY AIWA CORPORATION**

**AND**

**IN THE MATTER OF REGISTRATION NO 3242803 FOR THE TRADE MARK**

**AIWA**

**IN THE NAME OF AIWA CORPORATION  
AND THE CONSOLIDATED OPPOSITION THERETO  
UNDER NO 411102  
BY AIWA CO., LTD**

## BACKGROUND

1) Aiwa Corporation (hereafter “Party B”) applied to register the trade mark AIWA (Application no. 3242803) in respect of the following goods:

**Class 9:** *Televisions; television tuners; earphones; headphones, earbuds; audio speakers; audio-receivers; boxes specially adapted for housing audio equipment; consumer electronic products, namely, audio speakers, speakers, electric audio playback units; electric audio playback units with lights and speakers; audio cables; audio headphone, loudspeakers, stereo headphones; amplifiers; tuners; electronic docking stations; electronic and electrical apparatus for the remote control of audio amplifiers, audio speakers, audio receivers, home theater systems, audio decoders, video decoders, speakers, power and televisions; lithium ion batteries.*

2) This application was filed on 11 July 2017 and published in the Trade Marks Journal, for opposition purposes, on 22 September 2017.

3) Aiwa Co., Ltd (hereafter “Party A”) opposes the application on the basis of section 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against all the goods set out above and is on the basis of earlier marks 1067377, 1313883 and 1483522.

4) Party B filed a counterstatement denying that the respective goods are identical and asserting that the respective marks can be distinguished. It also put Party A to proof of use of its marks.

5) Party B also filed non-use revocation proceedings, on 24 November 2017, against five of Party A’s marks, three of which are the earlier marks relied upon in the opposition. These five revocation proceedings and the opposition were

subsequently consolidated and the decision that follows considers all these proceedings.

5) Party A's five trade mark registrations subject to the revocation proceedings are detailed below with the goods relied upon in its opposition to Party B's mark underlined:

Number:	1067377
Mark:	AIWA
Relevant dates:	Filing date: 19/08/1976 Registration date: 19/08/1976
Specification:	<b>Class 9:</b> <u>Radio and television apparatus and instruments; audio apparatus and instruments; sound amplifying apparatus and instruments; microphones, loudspeakers, tuners, record players, turntables, pickups, tape and video recorders, photographs, photograph records, magnetic tapes, sound and/or image recording and reproducing apparatus and instruments, and parts included in Class 9 for all the aforesaid goods.</u>

Number:	1313883
Mark:	AIWA
Relevant dates:	Filing date: 23/06/1987 Registration date: 14/07/1989
Specification:	<b>Class 9:</b> <u>Electrical and electronic apparatus and instruments, electrical calculating machines, computers, data recorders, modems, modulators, and demodulators, streamers, disc drive units, packet radio controllers being electrical communications apparatus, devices for use with computer terminals, floppy discs, computer software, parts and fittings for all the aforesaid goods, all included in Class 9.</u>

Number:	1483522
Mark:	<b>aiwa</b>
Relevant dates:	Filing date: 21/11/1991 Registration date: 24/06/1994
Specification:	<b>Class 9:</b> <i>Cameras, slide projectors, video cameras, motion picture cameras, projectors, sound recording apparatus and instruments, all for motion pictures, editing apparatus; <u>dry cells, storage batteries</u>; electric irons, electric vacuum cleaners; computer games for use with television apparatus; telephones, <u>radio receivers, televisions, televisions for receiving satellite broadcasting</u>; radios incorporating clocks; video cameras for broadcasting, portable video cameras; stereophonic, audio, tape and disc apparatus, all for use in vehicles; <u>tuners; sound recording apparatus</u>; electric phonographs, record players, tape recorders, tape players, digital audio tape recorders; sound broadcasting apparatus; video tape recorders, video tape players, compact disk players, video disk players; <u>sound recording and playing apparatus</u>; combined radio receivers and tape recorders; portable communications apparatus; microphones; tapes for tape recorders, video tapes; <u>amplifiers; headphones, adapters, antennae, earphones, speakers</u>, digital audio tapes; electronic computers; computerised electronic amusement instruments; electronic typewriters; monitors for electronic computers; tapes, disks and floppy disks, all recorded with computer programmes; computer data storage devices; facsimile machines; all included in Class 9.</i>

Number:	1483523
Mark:	<b>aiwa</b>
Relevant dates:	Filing date: 21/11/1991 Registration date: 17/06/1994
Specification:	<b>Class 11:</b> <i>Electric stoves, electric ranges, electric toasters, electric fans, electric refrigerators, air conditioners, electric cooking pots, electric coffee pots, microwave ovens, incandescent lamps, miniature lamps, fluorescent lamps, electric torches, incandescent lighting apparatus; heating apparatus; water purification installations; hair dryers; all included in Class 11.</i>

Number:	1500565
Mark:	<b>aiwa</b>
Relevant dates:	Filing date: 15/05/1992 Registration date: 02/07/1993
Specification:	<b>Class 37:</b> <i>Installation, repair and maintenance of electric, electronic, telecommunications and medical apparatus and instruments and their accessories and parts; all included in Class 37.</i>

6) Party A filed counterstatements denying the claims and stating that it will provide evidence to demonstrate that the marks have been used in respect of the goods listed in the registrations.

7) Revocations are sought under Section 46(1)(a) in respect of the five-year time periods following the date of completion of the registration procedures. Revocations are also sought under Section 46(1)(b). The five-year periods and the dates of revocation sought are set out in the table below:

Registration No.	Section 46(1)(a) period	Section 46(1)(b) period (the same for all 5 marks)
1067377	20 August 1976 to 19 August 1981  Revocation to take effect 20 August 1981	17 August 2012 – 16 August 2017  Revocation to take effect 17 August 2017
1313883	15 July 1989 to 14 July 1994  Revocation to take effect 15 July 1994	
1483522	25 June 1994 to 24 June 1999	

	Revocation to take effect 25 June 1999	
1483523	18 June 1994 to 17 June 1999  Revocation to take effect 18 June 1999	
1500565	3 July 1993 to 2 July 1998  Revocation to take effect 3 July 1998	

8) Both sides filed evidence and written submissions in these proceedings. These will be referred to to the extent that it is considered appropriate. A hearing took place before me on 10 January 2019 where Party A was represented by Richard Davis of counsel, instructed by Hoffman Eitle Patent and Rechtsanwalts PartmbB and Party B by Charlotte Blythe of counsel, instructed by Tomkins & Co..

### **Evidence**

9) Party A's evidence is in the form of two witness statements by Tomonori Mitsui, president of Party A, a witness statement by Luis Jose Soriano Albert, a Spanish attorney in law and European trade mark and design attorney who acted for Party A in respect of an entitlement case before the Spanish Patent and Trademark Office and a witness statement by Debra Louise Lewis, a UK Registered Trade Mark Attorney and European Trade Mark Attorney. I will summarise this evidence, as necessary, later in my decision, but briefly, this evidence is intended to:

- illustrate the history of the Aiwa mark dating back from 1951 and its more recent chain of title;
- support the claim of widespread second-hand sales and of spares by third party traders;
- support the claim that plans were in train to revive the AIWA brand;
- support the claim that Sony Corporation, a predecessor in title to Party A's AIWA marks, has been providing a website [www.aiwa.com](http://www.aiwa.com) and in 2014 – 2017, it provided service and support for AIWA products;
- demonstrate that Party A obtained its marks via a valid transfer from Sony Corporation;

10) Party B's evidence takes the form of an affidavit by Joseph Born, chairman and CTO of Party B. He provides the following:

- a history of his company and its claimed use of the AIWA mark on a global basis including in the UK since 15 December 2015;
- sets out what he claims is the position around the world in respect of ownership of the AIWA mark;
- the attempt to reach an agreement with Party A's predecessor in title and its involvement in disputes around the world to revoke Party A's registrations of its AIWA marks.

## **Approach**

11) Party A has been put to proof of use of its earlier marks relied upon for the purposes of its opposition. Further, these same three marks together with two more of Party A's AIWA marks are subject to revocation proceedings. The outcome of the proof of use/revocation proceedings will have an impact on the scope of the earlier marks that Party A may rely upon in its opposition. Therefore, it is appropriate for me to consider these issues before considering the opposition proceedings. I will proceed on this basis.

## **Preliminary Point**

12) At the hearing, Mr Davis sought leave to admit late evidence in the form of a short further witness statement by Ms Lewis that introduced an exhibit consisting of a screen grab of an online retailer in the UK offering for sale an AIWA product. The screen grab was printed on 4 January 2018, some 15/16 months after the end of the relevant periods. I declined to admit it because of its very late nature, the fact that it related to an action that took place many months after the relevant periods and that, because of this, its relevance was very limited.

## **PROOF OF USE/GENUINE USE**

### **Legislation**

13) The provisions relevant to the issue of proof of use in the opposition are set out at Section 6A of the Act:

“6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the



trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

14) In respect of the revocation proceedings, Section 46 of the Act states that:

“46(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 completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, 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;

(c).....  
.....

(d).....  
.....

(2) For the purpose of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five

year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

15) Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16) The guiding case law for considering genuine use, whether in the context of section 6A or section 46 is the same. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks and both sides made reference to it. He said:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(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].

(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]; *Reber* at [29], [32]-[34]; *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].”

17) The period defined in section 46(1)(a) is relevant for the purpose of establishing, in the event that no use has been shown, the date in which the revocation of the registration takes effect. Party A’s case is that it has used its mark in the period relied upon by Party B for the basis of its claims under section 46(1)(b). Whilst there is a mention in Mr Mitsui’s witness statement of use dating back to 1951, no further detail is provided. The consequence of this is that if Party B succeeds in its revocation proceedings, the revocation dates will be the section 46(1)(a) dates identified, for each registration, in paragraph 7. However, evidence of such use relates to the later, section 46(1)(b) periods and the section 6A periods.

18) With this in mind, the respective periods for which I need to consider genuine use of Party A’s three earlier marks are 23 September 2012 – 22 September 2017 (for the purposes of proof of use in the opposition proceedings, under section 6A of the Act) and 17 August 2012 – 16 August 2017 (for the purposes of section 46(1)(b)) in respect of all five of Party A’s registrations. These two periods are mostly overlapping and, as a consequence, nothing hangs on the slightly different start and end dates.

### **Party A’s evidence of use**

19) Mr Mitsui states that Party A is a company that was founded by Towada Audio Co., Ltd in April 2017 as a vehicle to re-establish the AIWA brand after it acquired the AIWA marks from the predecessor in title, Sony Corporation.

20) In respect of Party A's reliance on sales of second-hand AIWA goods, Mr Mitsui states/provides the following:

- he is "aware that original [i.e. pre-2008 goods being re-sold] AIWA products are sold in the UK on platforms like *Amazon* and *eBay*"<sup>1</sup>. This claim is supported by a number of Internet prints that are either undated or printed on "3/6/18"<sup>2</sup>. These include the following for sale in the UK on [www.amazon.co.uk](http://www.amazon.co.uk):

- Audio remote controls;
- AC adaptors;
- Headphones;
- Stylus;
- Personal stereos;
- Video recorders;
- Dictation device;
- Personal CD players
- Portable cassette tape player with radio;
- Portable CD, Radio and cassette player;
- Loudspeakers;
- Video cassette recorder;
- Portable mini disc player.

And, additionally, in undated *eBay* searches:

- Receiver and tape decks;
- Cassette decks;
- Digital audio systems/HiFi systems;
- Turntables;

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<sup>1</sup> Mr Matsui's witness statement, para 13

<sup>2</sup> Exhibit 6

- Amplifiers.

And, further, an AIWA cassette deck for sale on the website 2ndhandhifi.co.uk as shown in an undated printout, an AIWA cassette deck, broadcast mic and radio cassette for hire on the website audiogold.co.uk again, as shown by an undated printout. These examples show prices in pounds sterling.

- The website [www.springair.de](http://www.springair.de) indicates that it has “been inspiring friends of classical hi-fi and high-end devices all over Europe”. A search of this website, conducted on “3/6/2018”, records that 653 “aiwa” articles have been found. A selection of these are shown, priced in Euros and described in German<sup>3</sup>.
- Mr Matsui is aware that there are shops in various EU countries which offer spare parts and devices for AIWA products. He provides Internet extracts from UK online shops, namely, [www.buyspares.co.uk](http://www.buyspares.co.uk), [www.partmaster.co.uk](http://www.partmaster.co.uk) and [www.signalsuk.com](http://www.signalsuk.com)<sup>4</sup>. The first two have the headings “AIWA PARTS” and “Aiwa Spares” respectively but it is not possible to discern relevant details from the third because of the small size of the screen capture and the poor quality of its reproduction.

21) Mr Matsui believes that the prior owner of the marks, Sony Corporation, provide support and service for AIWA products and that it provides access to these through its website [www.aiwa.com](http://www.aiwa.com)<sup>5</sup>. Screen captures obtained from the Internet archive, “Wayback Machine”, are provided from 2 November 2014, 20 October 2015, 28 December 2016 and 29 April 2017<sup>6</sup>. These all show the same notice declaring that Sony Corporation has taken over support and service of AIWA products and with a link to find its local contacts. An internal document

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<sup>3</sup> Mr Matsui’s witness statement, para 14 and Exhibit 7

<sup>4</sup> Mr Matsui’s witness statement, para 15 and Exhibit 9

<sup>5</sup> Mr Matsui’s witness statement, para 16

<sup>6</sup> Exhibit 10



obtained from Sony Corporation from January 2017 provides an overview of repair records and customer queries from European customers, including the UK that refer to various AIWA products<sup>7</sup>.

22) Mr Matsui also provides copies of three product manuals<sup>8</sup>. The first two do not show any AIWA mark and the third shows only a highly stylised (arguably a device) mark, not being the same as any of Party A's marks. None of the manuals are dated.

23) Mr Matsui also provides the following evidence supporting the claim that Party A was making preparations to commence trading during the relevant periods:

- As of 22 March 2018 (when Mr Matsui gave his first witness statement), he states that Party A “is scheduled to launch TVs, a portable music player and other electronic products ... under the AIWA brand”<sup>9</sup>;
- It was Party A's plan to revive the AIWA brand as of June 2017 as evidenced by:
  - a Japanese language article that appeared, dated 20 June 2017, on the website [www.phileweb.com](http://www.phileweb.com). An English translation is provided<sup>10</sup>. This reports that Party A is “[c]urrently [...] engaged in negotiations with real stores such as consumer electronics mass merchandisers and comprehensive supermarkets” and that it plans to have a line-up of five types of TV, a “[h]igh resolution DAP”, analogue turntables, Bluetooth speakers, wi-fi network speakers and three types of CD radios;
  - an article dated 2 August 2017 that appeared on the website [www.straitstimes.com](http://www.straitstimes.com). This is in English and references the article

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<sup>7</sup> Exhibit 11

<sup>8</sup> Exhibit 12

<sup>9</sup> Mr Matsui's witness statement, para 5

<sup>10</sup> Ditto, para 5 and Exhibit 3A

as being news from Tokyo. It reports on a revival of Japanese audio brands (such as AIWA) and that AIWA products will “once again be on sale as early as the autumn”. It reports that the brand is being revived by Towada Audio<sup>11</sup>;

- an article published on the website [www.asia.nikkei.com](http://www.asia.nikkei.com), again reporting that Towada Audio is reviving the AIWA brand at “home and abroad”;
- Party A has entered into a number of license agreements in various countries including the UK<sup>12</sup>. A copy of the “Trademark Licence Agreement” with the UK licensee is provided<sup>13</sup> and records that it will commence on “( February 2018)”. It is signed on behalf of both parties. It is in respect of all the earlier marks relied upon by Party A and in respect of various audio and video goods, TVs and recording media, headphones, mobile phones, PCs and tablets;
- Mr Matsui also states<sup>14</sup> that the target countries are mentioned in an internal document<sup>15</sup> and that includes the UK. The document is dated 17 October 2017. He also states that “negotiations with former Aiwa agency (oversea) is scheduled from the end of October 2016 until the end of December 2016”<sup>16</sup> and provides an internal document<sup>17</sup> consisting of a schedule of meetings for 13 – 15 October 2017 and includes a meeting with two gentlemen indicated to be representing a business in the UK.

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<sup>11</sup> Exhibit 3B

<sup>12</sup> Mr Matsui’s witness statement, para 8

<sup>13</sup> Exhibit 3D

<sup>14</sup> Mr Matsui’s 2<sup>nd</sup> witness statement, para 4

<sup>15</sup> Exhibit B to Mr Matsui’s 2<sup>nd</sup> witness statement and an English translation is provided at Exhibit F

<sup>16</sup> Mr Matsui’s 2<sup>nd</sup> witness statement, para 4

<sup>17</sup> Exhibit E

## Relevant evidence from Party B

24) Mr Born states that Mr Matsui confirmed to him that they had not sold any products under the AIWA brand and there had been no sales in Japan or Europe up to December 2017. This has not been challenged by the other side.

## Considerations of genuine of use

### *Second-hand sales*

25) Mr Davis submitted that the evidence shows third parties offering for sale second-hand AIWA items. These items would have been produced by Party A's predecessor in title up to 2008 and include some much older, in one case from the mid-1970s. Mr Davis referred me to the comments of Arnold J in *London Taxi*. Arnold J described the issue he was considering in the following terms:

“220. [...] an issue which arises in the present case is whether sales of used vehicles bearing the trade mark by the trade mark proprietor [my emphasis] are sufficient to constitute genuine use of the trade mark. [...]”

26) After some analysis, Arnold J concluded (at para 223) that this was a difficult question in law and that “it is one which would ultimately have to be resolved by the CJEU”. He did not have to try and answer the question in that case and, therefore, declined to do so.

27) I acknowledge that there may be circumstances where second-hand sales may be sufficient for a finding of genuine use. However, the facts of the current case are sufficiently different to those before Arnold J, in particular, the fact that in *London Taxi* the second-hand sales were made by the proprietor. In the current case, if there are any second-hand sales, they are by third parties unrelated to the proprietor (being Party A). Unlike in *London Taxi*, the sales were

not made with the proprietor's consent. This is a requirement as set out in both section 6A(3)(a) and section 46(1)(a) of the Act. These sections state that the use condition is satisfied where, in the relevant period, use of the mark is made by the proprietor or with his consent. Whilst I recognise that such use may be a moot point yet to be decided by higher authority, on a plain reading of the Act, it is my view that such third party use cannot constitute genuine use because it is not use by the proprietor or with its consent. For this reason, I dismiss Mr Davis' submission that it makes no difference that the re-seller is a third party who does not have the consent of the proprietor.

28) In addition, Ms Blyth pointed out that Arnold J, having considered the findings of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 (that dealt with the issue of after-sales services such as the sale of accessories or parts in respect of the goods in which use was claimed to qualify as genuine use as well as after-sales servicing and repair) concluded (at para. 226) that the CJEU's reasoning was "rather specific to the facts of that case [and that] it cannot be concluded from this that simply re-selling used goods bearing a trade mark either definitely does or definitely does not amount to genuine use of that trade mark". Therefore, the answer is dependent on the facts of the case, and as I have already stated in the previous paragraph, the facts of the current case do not lead me to conclude that the second-hand use relied upon amounts to genuine use.

#### *Sony Corporation's repair services provided since 2008*

29) Mr Davis submitted that *Ansul* makes it very clear that the provision of support for existing products is relevant to the assessment of genuine use and he pointed out that Sony Corporation has taken over the support and service of AIWA products and that internal records, obtained from Sony Corporation, regarding the provision of this support are provided (Exhibit 11) as are product manuals (Exhibit 12).

30) Party A's evidence also illustrates that Sony Corporation operated a website [www.aiwa.com](http://www.aiwa.com), and it is claimed by Party A, that the after-sales services provided through this website is genuine use for the purposes of assessing genuine use.

31) Ms Blythe submitted that the current case is very different from the facts in *Ansul*, where it was the proprietor itself providing support services and parts bearing the mark in issue and the proprietor provided invoices and stickers supporting the claim to use, none of which are in evidence in the current proceedings.

32) The facts of the *Ansul* case were:

- Ansul has been the proprietor of the Minimax word mark, in respect of, essentially fire extinguishers and associated products;
- Ansul stopped selling fire extinguishers under that mark, at the latest May 1989;
- Between May 1989 to 1994 Ansul sold component parts and extinguishing substances for fire extinguishers bearing the mark to undertakings with responsibility for maintaining them. During the same period it also maintained, checked and repaired equipment bearing the Minimax mark itself, used the mark on invoices relating to those services and affixed stickers bearing the mark to the equipment. Ansul also sold such stickers and strips to undertakings that maintain fire extinguishers;

33) The CJEU went on to find (at paragraphs 37 – 42) that:

- "genuine use" entails use of the mark on the market for the goods or services protected by that mark;
- The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if

the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign, as distinct from the goods or services of other undertakings;

- Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available;
- 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 under the conditions described above;
- Since the parts are integral to the goods previously sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods;
- The same may be true where the proprietor makes actual use of the mark, under the same conditions, for goods and services which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

34) It is clear to me that the claimed use by Party A is of the kind that the CJEU envisaged may qualify as genuine use. In particular, the provision of an after-sales service may be use that is sufficient.

35) Ms Blythe made numerous criticisms of the evidence provided by Party A before urging me to find that the identified shortcomings in the evidence resulted in it being insufficient to demonstrate genuine use. In particular, Ms Blythe submitted that:

- it is unclear what services are provided by Sony Corporation;
- the content of the website is minimal and appears to be no more than a holding page which re-directs users to Sony's principal website;
- even if Sony Corporation provided any relevant services, they were provided under and by reference to the SONY brand;
- there is absolutely no evidence that support and maintenance services were provided to any customers by Sony. There are no invoices, revenue or customer figures, worksheets or other documentation nor visitor numbers to [www.aiwa.com](http://www.aiwa.com).

36) Ms Blythe also criticises the individual exhibits provided by Party A. She submits that the spreadsheet provided at Exhibit 11 contains only 19 enquiries from the UK during the relevant periods, four of which do not appear to relate to AIWA products and a significant proportion are categorised as “wrong number” or “pre-sales enquiry”. With regard to the product manuals shown at Exhibit 12, Ms Blythe pointed out that they are dated long before the relevant periods.

37) The spreadsheet consists of a list of service calls received. From my analysis, I note that twelve of these are indicated as originating in the UK, make some reference to AIWA and fall within the relevant five year periods. “Case reasons” provided in the document are reasonably evenly split between “Pre-sales inquiry” [sic], “Malfunctioning”, “User manuals”, “Non-Sony product” and “Other”. There is no information regarding what was done, if anything, in respect of these enquiries or what services were provided. As Ms Blythe pointed out, there are no invoices or other documentation that would shed light on the significance of this spreadsheet. There is no evidence that AIWA branded spare parts or accessories were provided as part of Sony Corporation's offering.

38) Ms Blythe submitted that the three product manuals predate the relevant period, however, it is not obvious to me that they are dated at all. Further, the first two do not show the AIWA mark. The third uses a very stylised AIWA mark (so

stylised that it is arguably a device mark) that is not one of the five marks subject to the revocation proceedings. Consequently, I cannot find that the exhibit supports a claim that Sony Corporation made use of the AIWA mark in respect of manuals or the provision of the same during the relevant periods prior to Party A acquiring the marks.

39) Whilst I dismiss Ms Blythe's point that any services were provided under the Sony brand because the customers were making enquiries to whom they believed had responsibility for AIWA products and accessed the service via the website [www.aiwa.com](http://www.aiwa.com), when taking all of the above together, the evidence of Sony Corporation's use of the AIWA mark does not illustrate anything other than the most basic after-sales service and then only to a maximum of twelve UK individuals during the relevant periods. Such sparse and unparticularised activity is not sufficient to qualify as activity as real commercial exploitation of the mark on the market for the relevant goods.

*Preparations to begin trading*

40) Mr Davis also submitted that *Ansul* provided support for his contention that the preparations to begin trading made by Party A qualifies as genuine use. He identified further support in *BABA HOUSE*, O/049/15 (paras. 3 and 26), a decision of Daniel Alexander QC, sitting as the Appointed Person and *Healey Sports Cars Switzerland Ltd v Jensen Cars Ltd* [2014] EWHC 24 (Pat), (paras. 18-20 and 24-26). I have no reason to question the finding in these two decisions that the absence of actual sales, or even of the existence of the products during the relevant period, does not preclude goods about to be marketed from qualifying as non-token use. I accept that it is one of the factors I must keep in mind when considering the overall factual matrix. I do not accept that these cases are precedents that automatically lead me to a finding of genuine use in the current case.



41) Mr Davis pointed to the third party news articles reporting on the revival of the AIWA brand, that meetings took place in October 2017 (after all of the relevant periods) with contacts in the UK, the existence of a licence agreement for UK sales between Party A and a British company, and the late evidence (that I refused to admit) showing UK sales over fifteen months after the end of the latest relevant period.

42) In respect of the news articles, Ms Blythe points out that the first is from a Japanese website and written in Japanese, the second and third are obtained from Asia-based news websites. It is submitted that these are not targeted at the UK. Whilst I am not convinced that it is fatal for the news articles not to be aimed at the UK, they are still deficient because they carry no indication that Party A intends to re-launch the brand in the UK. The highpoint of these articles is that one makes reference to reviving the AIWA brand at “home and abroad”, but this stops a long way short of illustrating plans to launch in the UK. I find this evidence fails to demonstrate activities that would qualify as “genuine use”.

43) In respect of Party A’s meetings with potential partners in its re-launch of the AIWA brand, Ms Blythe provided reasons as to why the evidence is insufficient to illustrate “genuine use”:

- the evidence is only of internal long-term plans that cannot amount to “genuine use” and do not relate to goods about to be marketed in the UK and for which preparations by the undertaking to secure customers are under way (as required by *Ansul*, para. 37);
- the same criticisms apply to the evidence of communications with potential partners, as these were all internal early-stage preparations and do not relate to goods which are about to be marketed and for which preparations to secure customers are underway. Further the meetings referred to in Exhibits C and D took place after the relevant periods;

- the licence agreement had an effective date of February 2018, which is after the relevant periods;
- All the alleged preparatory activities are at a very preliminary stage and, further, Mr Matsui's first witness statement of 22 March 2018 suggests that Party A had still not launched its revived AIWA-brand in the UK.

44) I agree with Ms Blythe's criticisms. This evidence fails to demonstrate that the goods are "about to be marketed and for which preparations by the undertaking to secure customers" (as required by *Ansu!*). There is a distinction to be drawn between exploring options and planning for a relaunch and making preparations to secure customers. I find that during the relevant periods, this evidence only illustrates, at best, the former.

45) I have found that individually, the second-hand sales by third parties and the claimed service support by Sony Corporation does not amount to "genuine use". Further, I have also found that the activities undertaken by Party A, within the relevant periods, do not amount to "genuine use". Mr Davis submitted that I should not look at each category of claimed use in isolation, but that I should stand back and look at the evidence as a whole, and that when I do so, I should conclude that it illustrates genuine use during the relevant periods. I agree that it is appropriate that I look at the evidence as a whole, but even when doing so the sum of the evidence does not amount to an illustration of genuine use, in the UK, of Party A's AIWA marks during the relevant periods.

46) In summary, the use shown is insufficient for me to conclude that there has been genuine use within the meaning of Section 46 of the Act or that proof of use has been demonstrated for the purposes of section 6A of the Act.

## **Conclusion – Genuine use**

47) No genuine use has been shown in respect of any of the claimed goods and services. Therefore, all five registrations are revoked in their entirety from the earliest dates claimed, namely:

<b>Registration No.</b>	<b>Date of revocation</b>
1067377	20 August 1981
1313883	15 July 1994
1483522	25 June 1999
1483523	18 June 1999
1500565	3 July 1998

## **OPPOSITION**

48) In light of my findings in respect of the revocation proceedings, the opponent's three earlier marks relied upon for the purposes of section 5(1) and section 5(2)(a) were not earlier marks at the relevant date in the opposition, namely the filing date of the contested mark, 11 July 2017. Therefore, the opponent does not have the requisite earlier marks to continue the proceedings. The opposition is therefore dismissed and Party B's mark may proceed to registration.

## **COSTS**

49) Party B has been successful in all five revocation proceedings and in its defence of the opposition and is entitled to a contribution towards its costs. I take account of the fact that both sides filed evidence and written submissions and that a hearing has taken place. I award costs on the following basis:

Applications for revocation (including 5 x official fees); considering statement of case in the opposition and preparing counterstatement:	£1700
Considering other sides evidence and preparing own evidence	£1200
Preparing for and attending hearing	£1000
 TOTAL	 £3900

50) I order Aiwa Co., Ltd to pay Aiwa Corporation the sum of £3900. This sum is to be paid within 14 days of the expiry of the appeal period or within 14 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 4<sup>th</sup> day of February 2019**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**