

# TRADE MARKS ACT, 1996

## Decision in Hearing

In the matter of an application for the revocation of the registration of Trade Mark No. 205701 and in the matter of the registered Proprietor's opposition thereto.

VERWEIJ FASHIONB.V.

Applicant for Revocation

WALTON INTERNATIONAL LIMITED

Proprietor

### **The registered trade mark**

1. Walton International Limited (hereinafter "the Proprietor") of Offices of Royal Bank of Canada Trust Company (Cayman) Limited, George Town, Grand Cayman, Cayman Islands, is the registered Proprietor of the trade mark GIORDANO. The mark is registered under No. 205701 in respect of "*bags, handbags, leather cases, travelling bags, shoulder belts; briefcases, file cases, attaché cases; purses, key bags, passport cases, cheque cases, leather bags, suitcases, pocket wallets, bill cases, bags for money, clips for keys; umbrellas, parasols, canes, folders (leather), leather cases for credit cards, knapsacks, rucksacks, valises, satchels, school bags, pouches, haversacks.*" in Class 18 and "*clothing, footwear, headgear.*" in Class 25.
2. The application for registration of the mark was filed under the Trade Marks Act, 1996 (the "Act") with an application date of 1 September 1997, which is deemed to be the date of registration. Publication of the registration of the mark appeared in Journal No. 1872 on 8 September 1999.

### **The application for revocation**

3. On 13 October, 2015 Verweij Fashion B.V. of Keienbergweg 103, NL – 1101 GG Amsterdam, The Netherland, (hereinafter "the Applicant") made an application for the revocation of the registration pursuant to the provisions of Section 51 of the Act. The Applicant seeks revocation on the grounds that the GIORDANO trade mark has not been put to genuine use in the State, by or with the consent of the Proprietor, in relation to any of the goods for which it is registered within the period of five years following the date of publication of the registration (i.e. 8 September 1999) and there are no proper reasons for this non-use. Further, and in the alternative, the Applicant seeks revocation of the trade mark on the basis the mark has not been put to genuine use in the State, by or with the consent of the Proprietor, in relation to any of the goods for which it is registered, for an uninterrupted period of five years and there are no proper reasons for this non-use.

## **Notice of Opposition**

4. On 22 April 2016 the Proprietor filed a Notice of Opposition to the application together with evidence supporting its claimed use of the mark; such evidence consisting of a Statutory Declaration, dated 20 April 2016, of Mark Alan Loynd, a Director and the General Counsel and Head of International Brand Collaborations of the Proprietor, and sixteen accompanying exhibits marked MAL1 to MAL16, and a Statutory Declaration of Notan Hassanand Tolani, Managing Director of Solar Time Limited and two accompanying exhibits marked NHT1 and NHT2.
5. In the opening paragraphs of his Statutory Declaration Mr. Loynd provides the background to the Proprietor's business. He attaches printouts of the Giordano Groups' Hong Kong website evidencing the establishment of the Giordano Group in 1981 in Hong Kong and a list of its subsidiaries (Exhibit MAL1), an extract from the Giordano Group's Annual Report for 2014 (Exhibit MAL2) and other extracts from the aforementioned Hong Kong website showing the Giordano family of brands (Exhibit MAL3), though none of these three exhibits contain any reference to Ireland.
6. Mr. Loynd states that on 1 May 1997 Giordano Limited, as the franchisor, entered into a franchise and distribution agreement with Giordano (UK) Limited, as the franchisee, and Whittard of Chelsea Plc which held a controlling interest in Giordano (UK) Limited. The Agreement granted the franchisee an exclusive licence to use the GIORDANO marks and an exclusive right to distribute the Giordano Group's goods and services under and by reference to the GIORDANO marks in the United Kingdom and Ireland. He attaches at Exhibit MAL4 details of the agreement and related materials.
7. He states that based on the Agreement a retail shop under the GIORDANO marks, located at 9 Peascod Street, Windsor, the United Kingdom, was opened in 1997 for the distribution and offer of goods and services under the GIORDANO marks in the UK. He attaches at Exhibit MAL5 a copy of the application for planning permission for the retail shop and related materials, including a photograph of the shop front.
8. Mr. Loynd states that Giordano Limited supplied goods under the Agreement and attaches at Exhibit MAL6 copies of a range of invoices, dated from 7 May 1997 to 27 June 1997, for clothing, belts, rucksacks, wallets and umbrellas, which he states all bore the GIORDANO mark, and which show the goods were sent by Giordano Limited to Whittard of Chelsea Plc in London. He states that, due to commercial reasons, the franchise under the Agreement ended in around 1998 or 1999.
9. He states that despite the termination of the franchise, the Giordano Group continuously made efforts to create and maintain brand awareness and market share of GIORDANO branded goods. The Group explored opportunities to co-

operate with potential partners in Europe, including Ireland. He attaches at Exhibit MAL7 copies of e-mail correspondence dated 2013 pursuing and discussing these possibilities.

10. Mr. Loynd states that in 2015 he put together a team to create new markets for GIORDANO goods and services, with special focus on the European market, including Ireland. He attaches at Exhibit MAL8 e-mail correspondence dated 2015 with potential partners, including businesses that have a presence in Ireland, namely T.K. Maxx and Tesco.
11. He states that goods bearing the GIORDANO trade mark were also available in Ireland via the Giordano Group's online global e-shop at [www.giordano.com/GB/](http://www.giordano.com/GB/), which is in the English language. He attaches at Exhibit MAL9 screenshots from the website showing Ireland as a shipping destination and dozens of pages showing the products available for purchase through the website. Mr. Loynd states that GIORDANO branded goods are also available on its e-shop on Aliexpress, which is also available in English and allows Irish customers to make purchases. He attaches at Exhibit MAL10 screenshots from the Aliexpress website showing the many GIORDANO products available for purchase through that website.
12. He provides a table of sales to consumers in Ireland from December 2010 to December 2015 as follows:

<b>Year</b>	<b>Sales Amount (US\$)</b>
2010	Nil
2011	416.34 (approximately €364.58)
2012	Nil
2013	Nil
2014	75.80 (approximately €66.38)
2015	214.43 (approximately €187.77)

He provides copies of invoices (Exhibit MAL11) attesting to these sales, but all the 2015 sales invoices post-date the relevant date for these proceedings (15 October, 2015). He also provides copies of many invoices for sales to countries other than Ireland, which are irrelevant, as are the two tables containing a breakdown of sales to the UK and to the rest of Europe (excluding Ireland and the UK).

13. Mr. Loynd states the Giordano Group continued to make efforts to expand into the European market and established two private limited companies, one on 27 October 2015 in the UK and the other on 9 March 2016 in Spain. Evidence confirming this was attached at Exhibit MAL12, but the incorporation of these companies occurred after the relevant date and, therefore, cannot be taken into account.

14. In Exhibit MAL13 Mr. Loynd provides details regarding the opening of two high-street stores in the UK in February 2016 and April 2016, though again these actions occurred after the relevant date and cannot be considered.
15. He provides photographs (at Exhibit MAL14) of a number of Spanish shop-fronts bearing the GIORDANO name and claims it is contemplated that the store operators will also operate GIORDANO stores in other European countries, including Ireland.
16. Mr. Loynd states the GIORDANO mark is also used on foot of licencing agreements and provides (at Exhibit MAL15) a copy of one such agreement with Carlsson Developments (Asia) Limited in relation to footwear. He states the licence, which was to run from January 2005 to June 2010, was terminated prematurely in around March 2007 due to commercial and market conditions. Another licence was agreed with Solar Time Limited, under which they were granted worldwide rights, including Ireland, for Class 18 goods. This licence, a copy of which he attaches at Exhibit MAL16, first came into effect in October 2003 and is still ongoing.
17. For his part Notan Hassanand Tolani confirms the existence of a worldwide, including Ireland, licencing agreement between his company, Solar Time Limited, and Walton International Limited for various goods in Class 18. He also provides, at Exhibit NHT1, a copy of the licence agreement (i.e. a duplicate of the one attached at MAL16).
18. Mr. Tolani refers to the efforts undertaken by his company to sell and promote Class 18 goods under the GIORDANO mark and provides, at Exhibit NHT2, copies of his company's 2004 and 2006 GIORDANO product catalogues, which were distributed in Europe. He also states that since November 2013 his company has been in discussions with Argos, TK Maxx, Rolling Luggage, Sainsbury's, Asda Wall-Mart and Tesco, and although these discussions have not resulted in a successful outcome, he envisages that 2 or more large retailers will come on board in the next 18 months.
19. Both parties lodged written submissions in lieu of attending at a hearing and the Proprietor submitted written submissions in reply.

#### **Written Submissions of the Proprietor**

20. In its written submissions FRKelly (the Proprietor's trade mark attorneys) outlined the background to the Proprietor's business, the worldwide use of its GIORDANO trade mark and efforts undertaken to create a market presence in Ireland through franchise and licencing agreements. FRKelly also highlight there were actual sales. While admitting the sales figures may not be particularly high, nonetheless, they fall within the realm of what constitutes genuine use.

21. FRKelly directed me to the Court of Justice of the European Union (CJEU) *MINIMAX*<sup>1</sup> case which establishes the conditions for determining genuine use of trade marks, which FRKelly summarised as follows:

- a) Genuine use means actual use of the mark and must not be merely token, serving solely to preserve registration;
- b) Genuine use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer;
- c) Genuine use requires use of the mark on the market for the goods and services concerned and the use must relate to goods or services already marketed or about to be marketed by the registered proprietor;
- d) The assessment of whether genuine use has been made of the mark is a global one, therefore all factors relevant to the case should be considered to establish whether the commercial exploitation of the mark is real and warranted within the relevant economic section to maintain or create a share in the market for the goods and services concerned;
- e) The nature of the goods and services must be considered, along with the characteristics of the market concerned and the scale and frequency of use of the mark.

22. FRKelly then summarises the evidence submitted by the Proprietor and identifies the key elements that support its claims to have genuinely used the mark during the period under examination. FRKelly divides its evidence into three categories, namely:

- a) Online e-shops and actual sales of products in Ireland;
- b) Licence agreements with third parties;
- c) Approaches to third parties.

23. Firstly, addressing e-shops FRKelly submits the CJEU's findings regarding traders' contractual obligations when conducting trade via websites across EU Members States' borders in CJEU joined cases *Peter Pammer v Reederei Karl Schlüter GmbH & Co KG (C-585/08)* and *Hotel Alpenhof GesmbH v Oliver Heller (C-144/09)* are pertinent to these proceedings. The Court had to decide whether the trader, against whom a dissatisfied consumer took action, was engaging in trading activity that was directed to the Member State of the consumer's domicile. In its decision the Court held (at paragraph 94) that "*the mere accessibility of the trader's or the intermediary's website in the Member State in which the consumer is domiciled is insufficient*". What is required is that the trader "*must have manifested its intention to establish commercial relations with consumers from one or more other Member*

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<sup>1</sup> *Ansul BV v Ajax Brandbeveiliging BV (Case C-40/01)*

*States, including that of the consumer's domicile" (at paragraph 75). The Court gave guidance (at paragraph 80) that in making an assessment of "whether an activity is 'directed to' the Member State of the consumer's domicile are all clear expressions of the intention to solicit the custom of that State's consumers". The Court held (at paragraph 81) that "clear expressions of such an intention on the part of the trader include mention that it is offering its services or its goods in one or more Member States designated by name" and that the same is true of "the disbursement of expenditure on an internet referencing service to the operator of a search engine in order to facilitate access to the trader's site by consumers domiciled in various Member States, which likewise demonstrates the existence of such an intention".*

24. Finally the Court concluded (at paragraph 93) that *"the following matters, the list of which is not exhaustive, are capable of constituting evidence from which it may be concluded that the trader's activity is directed to the Member State of the consumer's domicile, namely the international nature of the activity, mention of itineraries from other Member States for going to the place where the trader is established, use of a language or a currency other than the language or currency generally used in the Member State in which the trader is established with the possibility of making and confirming the reservation in that other language, mention of telephone numbers with an international code, outlay of expenditure on an internet referencing service in order to facilitate access to the trader's site or that of its intermediary by consumers domiciled in other Member States, use of a top-level domain name other than that of the Member State in which the trader is established, and mention of an international clientele composed of customers domiciled in various Member States. It is for the national courts to ascertain whether such evidence exists".*

25. FRKelly submits that when these findings are applied to the evidence relating to its online presence it is such that it constitutes use. The proprietor's global e-shop [www.giordano.com/GB/](http://www.giordano.com/GB/) (previous site [gb.giordano.com](http://gb.giordano.com)) contains a list of shipping destinations that includes Ireland. The same comments apply to the Proprietor's e-shop at [www.aliexpress.com/store/1113130](http://www.aliexpress.com/store/1113130), which also mentions Ireland as a destination and Euro as an acceptable currency. A wide range of articles covering goods in Classes 18 and 25 appear on these websites which target consumers in Ireland. The fact that actual online purchases have been made by Irish consumers demonstrates that Irish consumers have been successfully targeted by the Proprietor and that there is exploitation of the GIORDANO mark to such an extent that a market has been created in Ireland for goods bearing the mark.

26. Turning to licence agreements with third parties; FRKelly submits that by entering into franchise and distribution agreements, and licence agreements with Giordano (UK) Limited (covering the UK and Ireland), Solar Time Limited (in respect of all

territories across the globe) and Carlsson Developments (Asia) Limited (also with worldwide effect), the Giordano Group has demonstrated a clear and consistent attempt to create a market for goods under and by reference to the GIORDANO mark in Ireland.

27. Addressing the third pillar of its submission – approaches to third parties - FRKelly highlights the exploration of opportunities by the Proprietor to cooperate with potential business partners to promote and offer goods under the GIORDANO mark in Europe, including Ireland. Tasks pursued to achieve this include the establishment of a dedicated team to work on international collaborations and the evaluation of pre-existing and new global expansion plans. While there was use of the mark without actual customers or sales, nonetheless, there was external use of the mark in the nature of “preparations by the undertaking to secure customers”, which can be sufficient, provided the aim of such is to create a market in the goods under the mark.

28. In conclusion FRKelly argues that there has been use of the GIORDANO mark, which cannot be considered sham or token and must be considered genuine. There is no law as to how a trade mark must be exploited. It can be by traditional methods, including retail outlets, by advertising or marketing alone, by licencing or third party agreements or by modern methods including online sales. The latter has become customary and the medium of choice for many businesses. Also, the manner of exploitation depends on circumstances such as economic climate, the patterns and purchasing habits of the consumer and the competition. Finally the Proprietor has opened retail outlets in the UK in 2016, which was done to maintain and grow the business as a result of the market created by online sales in the UK. It would not be commercially sensible to open physical outlets until the market had been created and/or other avenues had not been explored. The Proprietor has not sat on its hands and done nothing, quite the contrary, it has actively attempted to create a market for the goods under the GIORDANO mark in Ireland.

#### **Written submissions of behalf of the Applicant**

29. Paul Coughlan B.L filed written submissions on behalf of the representatives of the Applicant for Revocation. He laid out the relevant statutory provisions governing the grounds upon which the registration of a trade mark may be revoked for non-use (Section 51 of the Act). He pointed to Section 99 of the Act which provides that, where in any civil proceedings under the Act, an issue as to the use made by any person of any registered trade mark, the onus of proving such use shall lie with the Proprietor.

30. Mr. Coughlan also directed me to *ANSUL*<sup>2</sup> which sets out the meaning of “genuine use”. He put particular emphasis on paragraph 39 of the judgment wherein the Court found that:

*“Assessing the circumstances of the case may thus include giving consideration, inter alia, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”*

31. He submits that the observations of the Court quoted above require that regard must be had to the nature of the goods and the characteristics of the market for those goods. He directs me to an earlier decision of the Controller in *BiBA*<sup>3</sup> wherein I, acting as Hearing Officer, observed as follows:

*“I accept that, depending on the nature of the goods, a single transaction over a five-year period may be considered genuine use. For example, manufacturers of nuclear submarines or the producers of block-buster movies may output only one product during such a period. It is therefore clear that each case must be considered on its merits and that the nature of the goods, the average consumer, the characteristics of the market and the frequency and scale of the use of the mark are significant factors. The nature of the goods at issue is such that the average consumer must be deemed to be the general public. While no market data regarding sales of the goods in question is available to me, I am satisfied the general public purchase tens of thousands of the goods, covered by the registration, in Ireland on an annual basis. In my opinion, the sale by the Holder of 22 jewellery items, in a single transaction, over a period of five years cannot be deemed sufficient to meet the qualification identified by the CJEU in *ANSUL* that genuine use of a mark is established when the mark is “used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services”.*

32. Mr. Coughlan submits these observations are particularly apposite in the present case. The market in Ireland for all of the various goods comprised in the Class 18 and Class 25 specifications is enormous and the average consumer of these goods must be deemed to be the general public. The evidence adduced on behalf of the

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<sup>2</sup> *Ansul BV v Ajax Brandbeveiliging BV* (Case C-40/01) ECR I-2439

<sup>3</sup> *House of Fraser (Store) Ltd. v BiBA GmbH* Decision dated 13 June 2014, paragraph 21



Proprietor falls very far short of establishing genuine use within the market during the relevant period. He then critiques each and every item of evidence submitted by the Proprietor. He maintains that there is no mention of Ireland in Exhibits MAL1, MAL2 or MAL3. The franchise/licence agreement exhibited at MAL4 is irrelevant as it pre-dates the publication date of the registration and that in his Statutory Declaration Mark Alan Loynd admits this attempt at a UK enterprise ended in 1998 or 1999. In any event it is well established the existence of licensing arrangements does not constitute evidence of use of a mark in the State<sup>4</sup>. Also, he submits the second party to this agreement, Giordano (UK) Limited, was struck off the English Companies Register and dissolved during September 1999.

33. He maintains that Exhibits MAL5 and MAL6 are irrelevant as they do not relate in any way to Ireland. The first of the two e-mails which comprise Exhibit MAL7 relates to the potential creation of an e-shop by a UK businessman and do not point in any way to use of the mark in Ireland. The second e-mail relates to a different brand (BSX) and is completely irrelevant. Exhibit MAL8 consists of a number of e-mails from Giordano personnel to UK operators about whether they might be interested in selling Giordano products. These e-mails reveal that Giordano Limited has no European warehouse. All relate to the UK and date from August 2015, which is outside the relevant period by virtue of Section 51(3) of the 1996 Act, and are therefore irrelevant and inadmissible.

34. Turning to printouts and screenshots that comprise Exhibit MAL9, the contents of which are referenced at paragraph 18 of the Statutory Declaration of Mark Alan Loynd, Mr. Coughlan notes the deponent states these printouts and screenshots are from the “*global e-shop*”, that “*Ireland is one of the available shipping destinations*” and that “*consumers in Ireland are... targeted by this e-shop.*” He argues there is no evidence of any focussed targeting of the Irish market (such as an Irish contact telephone number, etc.) and that prices are in dollars. He directs me to Kerly’s Law of Trade Marks and Trade Names<sup>5</sup> wherein the following is stated:

*“In essence, use of a mark on a website will only constitute use in a particular territory if the website is specifically aimed at and used by consumers in that territory.”*

35. He notes Exhibit MAL10 begins with web pages from 2016 (outside the relevant period) from the Alibaba website (an online marketplace similar to Amazon) and that the archived view of some webpages from 2014 shows Giordano garments priced in US dollars.

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<sup>4</sup> Decision of the Controller in *The Professional Golfers’ Association Limited v. Ladies Professional Golf Association*, 11 August 2006 (Mr. Tim Cleary, Hearing Officer) at paragraph 18.

<sup>5</sup> 15<sup>th</sup> Edition, 2011, at paragraph 10-067.

36. Exhibit MAL11 deals with actual sales to consumers in Ireland and Mr. Coughlan makes a number of statements as to the relevance and probative value of this material. In his supporting Statutory Declaration Mark Alan Loynd (at paragraph 21) asserts that the Giordano Group's e-shop supplied goods to Irish consumers from December 2010 to December 2015, yet the table set out in that paragraph has no sales whatsoever for the years 2010, 2012 or 2013. Of the ten invoices pertaining to goods apparently supplied to persons in the State, six are dated November 2015 and plainly post-date the application for revocation. For the year 2011, the three invoices show that there were sales of \$416 (or approximately €364 according to the declaration of Mr. Loynd), such sum being made up of three orders from two individuals. Each invoice is subject to a \$15 delivery charge so the cost of the goods is, in reality, lower than the figure quoted.
37. The 2014 sale comprises a single order of items, delivered to a Dublin address, totalling \$75 (approximately €66), which includes the \$15 delivery charge. The balance of the exhibit contains 80 invoices concerning goods delivered to the UK (76), Israel (1), Russia (1), the Ukraine (1) and Norway (1).
38. In summary, Mr. Coughlan argues that the admissible material in Exhibit MAL11 reveals online purchases worth approximately €350 to three individuals with Irish addresses. The rest of the exhibit is irrelevant as it is comprised of invoices addressed to customers outside the State and sales to customers in the State after the date of application for revocation.
39. Mr. Coughlan contends the material in Exhibit MAL12 is also inadmissible and irrelevant as it relates to the incorporation of two companies (one English, the other Spanish) after the date of application for revocation. Similarly, Exhibit MAL13 contains material relating to two stores opened in the UK in 2016 and operated by Giordano (Hong Kong) UK Limited, which is also irrelevant as it relates to activity in the UK and post-dates the application for revocation. Exhibit MAL13 relates to a Spanish store operated by the same (Hong Kong) associate and is irrelevant to the issue as to whether there has been genuine use of the GIORDANO trade mark in Ireland.
40. He notes that while Exhibits MAL15 contains a licence agreement with Carlsson Developments (Asia) Ltd and MAL16 comprises two licencing agreements with Solar Time Limited, there is no evidence that either licensee ever engaged in any use of the GIORDANO mark in Ireland. In fact Mr. Tolani, who is party to each of the Solar Time Limited agreements, as set forth in his Statutory Declaration, underlines the absence of any actual use.

41. Turning to Mr. Tolani's declaration, Mr. Coughlan points out that Exhibit NHT1 contains the same two agreements as in Exhibit MAL16 and that Exhibit NHT2 contains product catalogues for the years 2004 and 2006 pertaining to GIORDANO branded luggage. These documents contain nothing to suggest use of the mark in the State, and in any event, the catalogue dates are well before the relevant period for the purposes of Section 51(1)(b) of the Act.
42. Mr. Coughlan describes Mr. Tolani's Statutory Declaration as utterly irrelevant. While it asserts that Solar Time Limited (STL) has a worldwide exclusive licence that includes Ireland for various Class 18 goods, it does not refer to any use of the GIORDANO trade mark in Ireland. Instead paragraph 8 is merely aspirational insofar as it expresses the hope that a relationship with Argos and TK Maxx "... *may also help STL canvassing the Irish market for Class 18 Licenced Products under and by reference to the GIORDANO Marks in the future.*" Far from proving use, Mr. Tolani's Statutory Declaration is for all intents and purposes tantamount to a tacit admission of non-use in the State.
43. In conclusion Mr. Coughlan argues the Proprietor has failed to adduce any evidence of trading activity conducted within the State under the Trade Mark or any marketing or promotional activity specifically directed at the State. There is no suggestion that a single item bearing the Trade Mark has ever been sold in any shop in Ireland. The meagre handful of online sales is utterly inconsequential. The 3 invoices from 2011 and the single invoice from 2014 are the only invoices pertaining to goods supplied to persons in the State during the relevant period. The only goods referred to in those invoices are t-shirts and men's undergarments and there is no evidence of actual sales pertaining to any of the goods within the Class 18 specification, or footwear or headgear from the Class 25 specification. The material adduced by the Proprietor does not prove genuine use of the Trade Mark within the period of five years following the date of publication of the registration (Section 51(1)(a)) or at any time in the period leading up to 14 July 2015 (Section 51(1)(b)). There is no claim on behalf of the Proprietor that there are proper reasons for non-use and so this saver cannot apply (and no evidence based on it has been presented in any event).
44. FRKelly filed written submissions in reply on behalf of the Proprietor, while the Applicant chose not to rely to the Proprietor's submissions. FRKelly submits that, while the Applicant claims the Proprietor has failed to adduce any evidence of trading activity conducted within the State under the Trade Mark or any marketing or promotional activities specifically directed at the State and that there is no suggestion that a single item bearing the Trade Mark has ever been on sale in any shop in Ireland; it is not necessary for the Proprietor to prove such matters. When assessing the question of whether a trade mark has been put to genuine use, each

case must be determined on its merits and it is necessary to consider all relevant factors.

45. FRKelly then go on to address all the evidence filed by the Proprietor and provides further clarification and argument in respect of each exhibit. Exhibits MAL1, MAL2 and MAL3 were all produced to provide historical and background information in relation to the Proprietor and information relating to when the trade mark GIORDANO was adopted and launched. While admitting Exhibit MAL4 contains evidence dating from outside the relevant period, FRKelly argue it should not be considered irrelevant as it shows that steps were taken to establish franchising agreements from an early date in order to create a market for goods under the GIORDANO mark. Exhibits MAL5 and MAL6 contain evidence that such franchising agreements covered Ireland.
46. FRKelly submit the e-mails attached at Exhibit MAL7 show efforts to create a market share and such acts constitute “genuine use” as defined in *ANSUL*<sup>6</sup> where the Court found that “*there is ‘genuine use’ of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods...*”. The market does not have to be shown to exist but it is sufficient to show the Proprietor has taken steps and made genuine efforts to create a market in goods under the trade mark. The relevance of Exhibit MAL8 is to highlight and identify the actions taken by the Proprietor to originally create a market in the United Kingdom with a view to extending this to Ireland.
47. Exhibit MAL9 clearly shows Ireland as a shipping destination and Euro as an accepted currency on the Proprietor’s e-shop and Exhibit MAL10 shows Ireland as a shipping destination on the Proprietor’s Aliexpress.com e-shop. Although both of these Exhibits contain printouts dated 2016, consumers in Ireland actually made purchases on the e-shop, which were delivered to Ireland before 2016. This is supported by the copies of invoices attached at Exhibit MAL11. FRKelly argues it is clear that this constitutes use of the Trade Mark in Ireland according to the passage in Kerly’s Law of Trade Marks and Trade Names cited by the Applicant.
48. Though the Applicant alleges these invoices do not show sufficient use given the approximate worth of the products sold, the fact remains that products under the Trade Mark were sold to consumers in Ireland during the relevant period and that consumers were targeted by the Proprietor. If Irish consumers were not targeted and did not know that products were available to them in Ireland, they would not have been able to purchase them.

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<sup>6</sup> *Ansul BV v Ajax Brandbeveiliging BV* (Case C-40/01)

49. FRKelly submits the Proprietor cannot be prejudiced by the fact that greater quantities of the goods were not sold. There is no quantitative yardstick for “genuine use” by virtue of sales and the issue must be determined on the circumstances of each case. The online facilities of the Proprietor allow for any number of products to be sold to consumers in Ireland. This is the equivalent to products being available in a shop but not being sold in totality. In the latter case, this would constitute “genuine use” and by analogy the availability of products in an e-shop (whether sold or not) must be afforded the same label as being “genuine”.

50. Furthermore, FRKelly submits the invoices dated after the date of application for revocation should not be considered irrelevant as it is well established that in assessing the genuineness of use during the relevant period, account should be taken of any circumstances subsequent to filing (*LA MER*<sup>7</sup>, paragraph 31). The invoices after the date of application for revocation demonstrate consistent and continuous efforts of the Proprietor to use the GIORDANO mark in Ireland. The invoices for other jurisdictions demonstrate the fact that various goods in Classes 18 and 25, such as umbrellas and shoes, were also offered for sale on the online shops (and therefore offered to consumers in Ireland), although consumers in Ireland did not choose to purchase them.

51. FRKelly submits that the incorporation of a company in the UK (evidenced at Exhibit MAL12) and the establishment of retail stores in the UK (Exhibit MAL13) and Spain (Exhibit MAL14) all demonstrate that continuous steps were taken by the Proprietor to create a relevant market. This evidence should not be considered irrelevant simply because it post-dates the filing of the application for revocation. Exhibits MAL15 and MAL16 are evidence of the actions taken to create a market in the goods in Ireland by virtue of licencing arrangements. FRKelly submits that each item of evidence should not be assessed individually, but that it must be assessed in its totality.

52. Addressing the Applicant’s arguments that the meagre handful of online sales is utterly inconsequential, FRKelly directs me to the *BUFFALO MILKE*<sup>8</sup> decision, wherein the General Court (Second Chamber) found at paragraphs 66-67 and 69-70 as follows:

*“66. As regards the invoices filed for the first time before the Board of Appeal, the applicant contests their probative value on the ground, first, that they only show sporadic use, considering the nature of the goods (low-priced products), the extent of the geographical market concerned (Germany) and the relevant*

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<sup>7</sup> *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159

<sup>8</sup> *Buffalo Milke Automotive Polishing Products, Inc., v OHIM* (Case T-308/06)

consumers (the general public), and that they only correspond to a minute fraction of the turnover mentioned in the affidavit, second, that they are issued by a different entity, for which there is no proof that it is the owner's authorised licensee, third, that they do not relate to the entire five-year period, but only to 13 months and, fourth, that they can at best show use in relation to shoes only and not for polishing creams and leather conditioners in general.

67. In the present case, as regards the supplementary invoices and their impact on the assessment of the extent of use, the Board of Appeal correctly held that, in conjunction with the rest of the evidence, those invoices '... provide evidence of use which objectively is such that it creates or preserves an outlet for polishing cream and leather conditioner. Furthermore, the volume of sales, in relation to the period and frequency of use, is not so low that it might be concluded that the use is merely token, minimal or notional for the sole purpose of preserving the rights conferred by the mark'.

...

69. These findings are consistent with the case-law of Court of Justice, according to which, when it serves a real commercial purpose, even minimal use of the mark or use by only a single importer in the Member State concerned can be sufficient to establish genuine use (*Ansul*, paragraph 39, and order in *La Mer Technology*, paragraph 27).

70. It follows that the applicant's contention that the sales reflected in the invoices merely show sporadic use, in view of the nature of the goods and the extent of the geographical market, must be rejected."

53. FRKelly submits that when the above findings of the Court are applied to the evidence filed by the Proprietor in these proceedings, the same conclusion should be reached and it should be considered that as a result of the continuous acts (not sporadic) of the Proprietor, they made genuine commercial efforts to create a market and have, therefore, satisfied *ANSUL*<sup>9</sup>.

54. Regarding the question of whether or not a quantitative threshold should be applied FRKelly directed me to *SUNRIDER*<sup>10</sup>, wherein the CJEU had this to say at paragraph 72:

*"It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal,*

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<sup>9</sup> *Ansul BV v Ajax Brandbeveiliging BV* (Case C-40/01)

<sup>10</sup> *The Sunrider Corp. v OHIM* (Case C-416/04)

*the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in La Mer Technology, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in La Mer Technology, paragraph 27)."*

55. In light of the Court's findings FRKelly maintain that, even if the use shown is minimal, it serves a real commercial purpose and when considered in light of the steps taken to create a market, there has been genuine use of the Trade Mark.

56. FRKelly ends its submission by claiming that the circumstances of the current proceedings differ from those in *BiBA*<sup>11</sup>, upon which the Applicant relies, in that the date of the single relevant invoice submitted in that case was just two months prior to the expiration of the period wherein use of the mark must be made in order to stave off an action for revocation. The single transaction was between a producer and distributor for goods which may not have been placed on the market for the benefit of the end consumer and did not demonstrate the creation of an outlet for the goods concerned. However, in these proceedings, the online sales are continuous over a number of years (although actual sales were not successfully made every year) and the transactions are between the retailer and the ultimate consumer.

## **The Law**

57. The relevant parts of Section 51 of the Act, insofar as the present application is concerned, read as follows:

*"(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;*

*...*

*(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) 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; but, for this purpose,*

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<sup>11</sup> House of Fraser (Store) Ltd. V BiBA GmbH Decision dated 13 June 2014

*any such commencement or resumption of use occurring after the expiry of the five year period and 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.”*

### **The issue to be decided**

58. The publication of the registration of this trade mark occurred on 8 September, 1999. The application for revocation was made on 13 October, 2015. Those dates define the start and finish, respectively, of the “the relevant period” for the purposes of the present application. The question to be decided is whether there was genuine use of the mark within that period and, if so, whether that use was suspended for an uninterrupted period of five years and not recommenced within the relevant period. I am satisfied the evidence shows that clothing bearing the goods trade mark GIORDANO were sold to consumers in Ireland within the relevant period. The issue rests on whether such use is deemed “genuine use”, which is required in order to allow the mark to remain on the Register.

59. The Act does not define the words “genuine use” of a trade mark for the purposes of Section 51 but the words have been considered by the CJEU in *ANSUL*<sup>12</sup>, to which both Agents representing the Applicant for Revocation and the Registered Proprietor each referred in the course of their comprehensive written submissions. In that case the ECJ stated that,

*“... there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.”*

60. It is clear from the foregoing that “genuine use” may be equated with actual use, provided that such use has been more than mere token use and that the use in question has brought the mark to the notice of the relevant class of consumers of

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<sup>12</sup> *Ansul BV v. Ajax Brandbeveiliging BV* (Case No. C-40/01)



the goods for which it is registered. It is not necessary for the purpose of proving genuine use of a mark to establish that the use in question has been continuous or extensive or that it has resulted in the mark becoming well-known to the relevant consumers. It is sufficient to show that the mark has been used as a trade mark for the goods within the relevant period and that it has, as a result, come to the notice of consumers of those goods.

61. Having said that, the reference in the passage quoted in paragraph 59 to the matter of whether use made of a mark is viewed as warranted in the economic sector concerned, in order to maintain or create a share in the market for the goods protected by the mark, may be taken as implying usage that is above the level of *de minimis*. However, the ECJ pointedly declined to impose a *de minimis* rule in its subsequent decision in *LA MER*<sup>13</sup>, in which it addressed the specific question of whether any amount of use, however small, is sufficient to establish “genuine use” of a trade mark. In that case, the ECJ stated:

*“... it is not possible to establish a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down.”*

62. In my opinion, the Court was not only being particularly keen to ensure it did not tie the hands of national courts by adopting a *de minimus* rule, but was also ensuring national courts would not be so restricted that they must view any proven commercial exploitation as automatic characterisation of genuine use of the mark in question.

## **Decision**

64. I have carefully considered all the evidence submitted by the Proprietor in support of maintaining the registration on the Register, which, while voluminous, contains very little by way of relevant material. I shall deal with the website and online sales-related material later. Firstly I will address the other elements.

65. The Proprietor made much of the efforts undertaken to establish franchise and licencing arrangements with various interested parties, though none of these parties were based in the State. The agreements, some of which were initiated outside of the relevant period (both before and after), and some of which were dissolved prior to the expiry of the original agreed duration, do nothing to demonstrate use of the mark in Ireland. Forming business alliances with the intention of, all being well, perhaps, maybe, someday, entering the Irish market counts for little. The fact of the

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<sup>13</sup> *La Mer Technology Inc. v. Laboratoires Goemar SA* (Case No. C-259/02)

Proprietor having licensed the use of the mark to a number of licensees for use of the mark in the United Kingdom and Ireland, or worldwide, do not of themselves, constitute evidence of use of the mark within the State. Licensing and distribution arrangements are a normal part of the exploitation of brand names but their existence alone does not mean that goods bearing a particular mark have actually been put on the market. In reality none of the initiatives pursued by the Proprietor bore fruit in Ireland. Not one of them resulted in the sale into Ireland of a single product bearing the trade mark GIORDANO. It is clear to me these business relationships provided nothing more than a hook upon which to hang business expansion plans that were merely aspirational.

66. Also, the establishment of retail stores in the UK and Spain, after the relevant period, says nothing about use of the contested mark in Ireland during the period in question.

67. The Proprietor urged me to take account of evidence that post-dates the relevant period, as it claimed the material speaks to the Irish market during the relevant period. While it is permissible and advisable for decision makers to take account of material which, while post-dating the relevant period, nonetheless shines light on the state of play during the relevant period, I am satisfied that in these proceedings no such evidence has been adduced. None of the post-dated material sheds any light on the state of the market in Ireland during the relevant period in respect of GIORDANO branded goods and, therefore, the post-dated material lacks any probative value. Accordingly, its inclusion or exclusion cannot strengthen or weaken, nor assist or hamper, the Proprietor's case. In rejecting the Proprietor's urgings I am also of a mind that, for the nature of the goods at issue, five years is ample time in which to make genuine use of the mark.

68. The only evidence relating to use in Ireland during the relevant period concerns 4 invoices for items of men's clothing. While other invoices relate to sales in Ireland after the relevant period and to sales to other jurisdictions, these are irrelevant to the matter at hand.

69. The Proprietor's GIORDANO trade mark is registered in respect of "*bags, handbags, leather cases, travelling bags, shoulder belts; briefcases, file cases, attaché cases; purses, key bags, passport cases, cheque cases, leather bags, suitcases, pocket wallets, bill cases, bags for money, clips for key; umbrellas, parasols, canes, folders (leather), leather cases for credit cards, knapsacks, rucksacks, valises, satchels, school bags, pouches, haversacks*" in Class 18 and "*clothing, footwear, headgear.*" in Class 25.

70. I shall deal with the Class 18 goods first. There is no evidence whatsoever that any such goods were sold in the State within the relevant period. Not a single invoice or advertisement was produced to support a claim of use of the mark in the State in respect of Class 18 goods. Nor is there any evidence of any marketing or promotion of the brand in Ireland for these goods. While the Proprietor's evidence shows that goods in this class and bearing the GIORDANO trade mark were available for purchase online, this cannot be considered use of the mark on these goods in Ireland. I have no hesitation whatsoever in finding the Proprietor's trade mark GIORDANO was not used in a fashion that could in any way be considered use of the mark in Ireland, let alone genuine use, within the relevant period. Therefore, without further ado, I revoke the registration in respect of all goods in Class 18.

71. Turning now to the Class 25 goods. Total trade in goods during the relevant period consisted of four transactions, all in respect of clothing; three of which were transacted in 2011 (to two distinct individuals) and one in 2014. The total value of these sales was in the order of €430, of which approximately €50 relates to delivery charges. Each of the four transactions was conducted online. There were zero sales of GIORDANO branded goods into Ireland in other years during the relevant period, namely 2010 (post 13<sup>th</sup> October), 2012, 2013 and 2015 (pre 14<sup>th</sup> July).

72. There are two significant factors to be considered with regard to these online sales; (i) whether having an online presence is deemed trading in Ireland and (ii) whether the use of the mark as evidenced by the level of trade during the relevant period (four transactions) can be considered "genuine use". Looking firstly at the former, the Proprietor claims that its own website and its e-shop on Aliexpress were assessable to Irish consumers and that this is analogous to having a retail store in Ireland. The fact that goods could be viewed and purchased and shipped to Ireland and that payment in the Euro currency was acceptable further enforces this argument.

73. There is no doubt that online trading is a legitimate basis upon which to create or maintain a market presence and thereby exploit a trade mark. However, for the purposes of these proceedings, more is required than simply pointing to a website and saying this is where Irish consumers can and have come to purchase goods. The fact the owners of a website are prepared to ship its goods to Ireland cannot of itself be deemed to demonstrate use of the mark in Ireland. If free shipping to Ireland was part of the deal it may be considered the targeting of Irish consumers. However when, as in this case, the purchaser is paying the shipping fees (which are often in excess of the actual shipping costs involved) it matters not where the Proprietor is willing to dispatch goods to. So, taken in isolation from any other marketing or promoting of the goods in Ireland, facilitating shipping to Ireland at the customer's expense, cannot be taken as targeting Irish consumers.

74. Similarly, facilitating online purchases in the Euro currency, does not demonstrate targeting of Irish consumers. It would be most unusual for online traders not to accept payment in one of the strongest and most widely used currencies in the world. In this day and age, it makes little difference what currency is used when shopping online, as payment can be made by credit card in the local currency and the transaction will be converted to Euro for inclusion on the customer's credit card bill. In any event, each of the four relevant invoices shows billing in dollars (though the goods appear to come from Hong Kong, I take it to be US dollars, not Hong Kong dollars) not Euro. Therefore, I attach little weight to the Proprietor's arguments regarding shipping to Ireland and the acceptance of payment in Euro.
75. Of fundamental importance is how Irish consumers became aware of the Proprietor's website in the first place. Having a website does not negate the need to inform the marketplace of your existence. There is no evidence of any advertising ever having been placed in any medium that would have brought the Proprietor's website to the attention of Irish consumers. There is nothing to suggest the Proprietor ever sought to influence Irish consumers who purchase Class 18 or Class 25 goods online. Methods such as paying to have your website featured high up in the list of results when an online search is conducted in Ireland (on the likes of Google) or placing advertising links on popular Irish third party websites to attract potential customers to the Proprietor's e-shop, were never deployed.
76. Furthermore, there was no Irish top-level domain (.ie) version of Proprietor's website, no indication of a customer care service (i.e. English language based) or appropriate phone number directed towards serving Irish consumers. It is not sufficient in business to adopt a "Field of Dreams" approach that "if we build it they will come". Businesses need to do more than that to attract custom. In this case I think it is reasonable to infer the Irish consumers, who bought GIORDANO goods online, came upon the Proprietor's website by sheer happenstance. The fact that more than one Irish consumer happened upon the Proprietor's website and made purchases within the relevant five-year period is, in my opinion, mere coincidence.
77. The CJEU considered the question of whether accessibility of a trader's website constituted offering services to consumers domiciled in a Member State which differs to the Member State in which the trader is based in joined cases C-585/08 and C-144/09<sup>14</sup>. The Court answered by stating that "... *the mere accessibility of the trader's or the intermediary's website in the Member State in which the consumer is domiciled is insufficient*". In these proceedings there is nothing other than the mere accessibility of the Proprietor's or the intermediary's (Aliexpress) websites. Therefore, I am completely satisfied that access to the Proprietor's website, which

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<sup>14</sup> Peter Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Oliver Heller

exists in the cloud, does not constitute trading in Ireland. Trade marks are territorial, clouds are not.

78. Finally, turning to the level of sales and the question of whether it constitutes genuine use of the contested mark. There is ample material emanating from the CJEU to assist me in answering this question. 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*<sup>15</sup>, *La Mer*<sup>16</sup>, *Silberquelle*<sup>17</sup> and *Sunrider*<sup>18</sup> in which the following factors were identified as the criteria to be assessed by competent authorities:

- i. Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark. *Ansul* §35
- ii. The use must be more than merely token; which means in this context that it must not serve solely to preserve the rights conferred by the registration. *Ansul* §36
- iii. 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, without any possibility of confusion, to distinguish the goods or services from others which have another origin. *Ansul* §36; *Sunrider* §70; *Silberquelle* §17
- iv. The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market. *Ansul* §37-38; *Silberquelle* §18
- v. Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating 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. *Ansul* §39; *La Mer* §18, §24-25; *Sunrider* §72
- vi. All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and

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<sup>15</sup> *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439

<sup>16</sup> *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159

<sup>17</sup> *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759

<sup>18</sup> *Sunrider v Office for Harmonisation in the Internal Market* (C-416/04 P) [2006] E.C.R. I-4237

services covered by the mark or just some of them, and the evidence that the proprietor is able to provide. Ansul §38-39; La Mer §22-23; Sunrider §70-71

79. In doing so I must consider as significant factors the nature of the goods, the average consumer, the characteristics of the market and the frequency and scale of the use of the mark. The nature of the goods at issue is such that the average consumer must be deemed to be the general public. The Class 25 goods in respect of which the mark is registered are *clothing, footwear, headgear*. Each of the four relevant transactions relate to items of clothing, specifically men's tee-shirts and men's underwear. Therefore, there was zero trade under the GIORDANO trade mark in respect of footwear and headgear. Accordingly and without further ado, I must revoke the registration in respect of both these categories of goods. That leaves clothing.

80. While no market data regarding sales of clothing is available to me, I am satisfied in Ireland the general public purchase millions of items of clothing on an annual basis. In that regard, four sales over a period of five years simply cannot be deemed sufficient to meet the qualification identified by the CJEU in ANSUL that genuine use of a mark is established when the mark is "*used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services*". Even when taking the most sympathetic approach and considering the Proprietor's trade in tee-shirts and underwear (without passing comment on how frequently Irishmen change these types of garments) and looking at them in relation to the overall Irish market for these specific types of clothing, I still find the Proprietor has failed to prove genuine use.

81. 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<sup>19</sup>, the Court had this to say at paragraph 28:

*"... 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."*

82. I find the Proprietor did not in any way target consumers in Ireland by means of advertising or promotion. It did not create a market for its goods in Ireland. The only sales of GIORDANO products occurred online by consumers who happened to

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<sup>19</sup> Vitakraft-Werke Wührmann & Sohn GmbH & Co. KG v OHIM, Case T-356/02

chance upon the Proprietor's website. Having sold a negligible amount of goods to three Irish consumers, there is no evidence the Proprietor ever sought to secure repeat business, by a follow-up e-mail or any other method, from these customers so as to maintain even this miniscule level of Irish custom.

83. Under Section 99 of the Trade Marks Act, 1996 the onus of proving use lies with the proprietor. In this regard Jacob J. had this to say in *La Mer*<sup>20</sup> 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.”*

84. In these proceedings it is clear the Proprietor has failed to prove genuine use of its mark. The Proprietor has failed to use the mark in accordance with its essential function as it did not seek to create or maintain a market for its goods in Ireland. Therefore, I revoke the registration in respect of all goods.

85. 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, that date. In this case I find that no genuine use was ever made of the mark. Therefore, I am satisfied the registration should be revoked from the day after the expiry of the period of five years following the date of publication of the registration. Accordingly, I revoke the registration as of 13 October, 2015.

Dermot Doyle  
Acting for the Controller  
24 March, 2017

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<sup>20</sup> *La Mer Technology Inc v Laboratoires Goemar SA (C-259/02) [2004] E.C.R. I-1159*