

**IN THE MATTER OF APPLICATION NUMBER 2028015
IN THE NAME OF KIRPAL SINGH SIHRA
TO REGISTER A TRADE MARK IN CLASS 28**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 47356
BY INTEL CORPORATION**

**IN THE MATTER OF application number 2028015
in the name of Kirpal Singh Sihra
to register a trade mark in Class 28**

And

**In the matter of opposition thereto under number 47356
by Intel Corporation**

Background

1. On 24 July 1995, Kirpal Singh Sihra filed an application to register the trade mark INTEL PLAY in Class 28 in respect of the following goods:

Hand-held constructional toys being puzzles.

2. On 14 August 1997, Intel Corporation filed notice of opposition in which they say they are the proprietors of the trade marks shown as an annex to this decision. The grounds of opposition are in summary:

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|------------------------------|---|
| 1. Under Section 5(2) | because the mark applied for is identical or similar to the opponents' earlier trade mark and is to be registered for goods similar to those of the opponent's mark. |
| 2. Under Section 5(3) | to the extent that the services applied for are not identical or similar to the goods and services for which the opponents' earlier mark is protected and the mark applied for is identical or similar. |
| 3. Under Section 5(4) | because use of the mark is liable to be prevented by virtue of the opponent's earlier right. |

3. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based. Both sides request that an award of costs be made in their favour.

4. Both sides filed evidence in these proceedings. The matter came to be heard on 22 February 2002, when the applicants were represented by Mr Rafique of Counsel, the opponents by Mr James Mellor of Counsel, instructed by Eversheds, their trade mark attorneys.

Opponent's Evidence

5. The opponents' evidence consists of an Affidavit and a Statutory Declaration. The Affidavit is dated 23 November 1998 and comes from Mr Michael Bruck, Director of Toy Development, Consumer PC Software of Intel Corporation (the opponents), a position he has held since 1998, having been employed by Intel Corporation for 15 years. Mr Bruck confirms that he is authorised to make his affidavit and that the facts and information contained therein are taken from the company records, to which he has access, or from his personal knowledge.

6. Mr Bruck gives details of the opponents' involvement in the entertainment/education software industry. He states that the opponents have, over the years, worked to enhance the performance of media rich applications and has generated a significant reputation for producing hardware and software which forms the basis of high powered entertainment machines. He also describes links that the opponent company has with industry associations whose members include hardware and software games developers, specifically mentioning the Open Arcade Architecture Forum which promotes the development of arcade systems which will "provide consumers with top quality games based upon Intel Architecture processors".

7. Mr Bruck refers to exhibit MB1, which consists of a series of six press articles dated between February 1997 and September 1997 in which references are made to Intel processors being aimed at multi-media and games software applications, and details downloaded from an Intel web-site during July 1998 relating to an Open Arcade Architecture forum, the document referring to the event starting in March 1996. The exhibit also includes press releases, most appearing to originate from outside of the United Kingdom, the earliest from within the UK dating from April 1996 although this does not mention computer games.

8. He goes on to refer to Exhibit MB2 which consists of screen prints downloaded in November 1998 from the opponents' web-sites. The prints of the Intel Showcase site feature amongst other items, games/entertainment software for sale or demonstration versions that can be downloaded. It is unclear if the products available for purchase were available to UK consumers given that the prices quoted are in US\$. The Mediadome site makes available entertainment media, including games, for use by internet users. Both sites make frequent use of the Intel name.

9. Mr Bruck discusses the trend in the toy industry to merge PC and digital technology with more traditional games and toys, and to illustrate this he refers to exhibit MB3. The exhibit consists of a series of press articles from what appear to be US publications dating from 1998 that detail the emergence in the toys and games industry of high-tech toys utilizing the latest electronic and computer technology.

10. Mr Bruck refers to Exhibit MB4 which consists of a series of U.S. press articles dating from 1998, referring to the work of the Massachusetts Institute of Technology (MIT) with a consortium referred to as Toys For Tomorrow (of which the opponent is a member) whose aim is to develop and promote these high-tech toys and games. He goes on to Exhibit MB5 which consists of various press releases and web-site downloads dating from 1998, relating to a product called LEGO MINDSTORMS developed through the consortium. The product which Mr Bruck says was on sale in the United Kingdom in September 1998 appears to

feature an “intelligent” building brick.

11. Mr Bruck discusses the shift made by companies associated with computer software and hardware towards the production of toys, referring in particular to the Microsoft Corporation’s development of interactive ActiMates. Exhibit MB6 contains web-site downloads and press articles dating from 1998 relating to this product.

12. Mr Bruck says that the opponent has entered into agreements with two large toy manufactures, Mattel and Hasbro to develop industry wide standards for making PC’s and toys more effectively interactive. He refers to quotes by a Senior Vice President of his company and a spokesman of Matel, both of whom refer to interactive or smart playthings, the Mattel spokesman saying that such toys should reach the market by Christmas 1999.

13. Mr Bruck says that the opponents worked with Matel and Hasbro for several years in the development of CD-Roms, Exhibit MB7 consisting of media articles, the earliest dating from December 1996, which refer, inter alia, to the opponents’ links with these two companies. None of the articles can be seen to have originated in the United Kingdom. Exhibit MB8 consists of an undated advertisement referring to the new LEGO Creator software in conjunction with Intel software, and an advertisement dating from Winter 1997 for a Barbie software title that appears to have been developed with reference to Intel MMX processor technology. Neither advertisement can be seen to have been available in the United Kingdom. The exhibit also includes what appears to be an advertising schedule for UK publications, but cannot be dated and contains no specific details other than a reference possibly relating to Lego.

14. Mr Bruck refers to Exhibit MB9 which consists of a series of press articles dating from November 1995 and January 1996, which give details of a collaboration between the Intel and the TOYS’R’US group, under which the opponents set up an in-store kiosk to provide purchasers with guidance on the selection of software titles and advising on basic computer issues. It is not possible to ascertain whether the articles were available in the United Kingdom.

15. Mr Bruck next refers to the BUNNYPEOPLE characters that since January 1997 have featured in the opponents’ marketing campaigns in the United Kingdom, saying that the opponent has sold over 11,000 BUNNYPEOPLE toys in the UK via the Internet. Exhibit MB10 consists of a picture of a BUNNYPEOPLE toy which has the opponents’ INTEL INSIDE logo on the front, and two North American press articles, dated late 1997 which make mention of these toys being available for purchase.

16. Mr Bruck goes on to say that based on his knowledge of the industry he is aware that toy retailers, such as TOYS ‘R’ US, are increasingly offering for sale computer and hardware and other high-tech products for children, some of which he mentions. He states that use of the mark INTEL-PLAY in respect of toys would lead to confusion and goes on to refer to Exhibit MB11 which consists of material, appearing to have been downloaded from a web-site in November 1998, relating to the IBM and Little Tykes junior computer products, and photographs taken in a US TOYS’R’US store in the United States (date unknown) showing other junior computer and high-tech toy products. Mr Bruck states that a similar range would

be stocked in UK toy stores, and that larger branches of TOYS'R'US in the US & UK would stock personal computers and related accessories, including those bearing the Intel mark.

17. Mr Bruck says that he is aware that toy stores are re-positioning themselves to take advantage of the interest in the development of high tech toys, referring to Exhibit MB12 which consists of a US press article (dated September 1998) commenting on TOYS'R'US stores being re-formatted to take account of the increased demand for video and computer related products. Exhibit MB13 consists of an extract from a UK publication, dated August 1998, which reviews a number of computer related toys and junior computers.

18. Mr Bruck states that the opponents are famous for their computer technology and that the Intel brand is one of the most recognised brands in the world, and by way of illustration highlights that in 1993, Intel's brand equity was ranked 3rd and has been highly ranked in other polls, although these appear to be by US organisations. He continues saying that his company has been involved in the computer entertainment and education industry for a number of years prior to the application and in recent years has become more involved in the toy industry. He says that the INTEL name will become more associated with major toy manufacturers and interactive toys and games who will increasingly use the INTEL mark to promote the technology within their toys, referring in particular to joint ventures with Lego and Mattel.

19. He concludes his declaration saying that PC and digital technology is becoming a central part of the toys and games industry and that the opponent is actively involved in providing the technologies to support this trend. He therefore feels that use by a third party of Intel or Intel-Play for toys or games would mean the third party would benefit from and trade off Intel's reputation.

20. Next is a Statutory Declaration dated 23 November 1998 from Mr Dave Hazell, Regional Manager of Intel Corporation (UK) Ltd. He confirms that he is authorised to make his declaration on behalf of the opponents and that the information given comes from the opponent's records, to which he has access, or from his personal knowledge.

21. Mr Hazell firstly gives some historical background to the opponent company, stating that it was formed in 1968 and that they are one of the worlds largest suppliers of microprocessors, the history and function of which he describes. Further historical information is provided in exhibit DH1 which consists of a brochure commemorating the 25th anniversary of the founding of the company, and which confirms the date of formation given by Mr Hazell.

22. Mr Hazell summarises the principal products sold under the Intel mark, being processor products, Internet and multi-media products, networking products, video communication products and semiconductor products. Exhibit DH2 consists of various material detailing these principal products with reference to the Intel name, amongst which is a brochure dating back to 1993 that refers to an Intel company in the United Kingdom.

23. Mr Hazell says that in addition to these products his company uses the INTEL mark in respect of software, graphics products, the internet, support services, computer games, and merchandise such as clothing, toys, etc, details of which are shown in Exhibit DH3. The exhibit consists of Intel product catalogues, dated 1995-1998, showing a diverse range of

products such as stationery, clothing & key rings. Toys are not prominently featured other than in the form of puzzles, desk toys and dolls. These catalogues give contact addresses and telephone numbers in the United States and prices are in US\$, but they appear to offer international shipping options.

24. Mr Hazell next gives details of the opponents turnover figures with regard to goods and services sold in the UK, which are as follows:

1990	£138,341,000
1991	£166, 292,000
1992	£257, 887,000
1993	£508, 044, 000
1994	£629, 612, 000

25. Mr Hazell refers to exhibit DH4 which consists of extracts from Intel UK's 1995 annual return and the 1993 Intel corporation annual report. UK advertising figures are provided both for Intel themselves and also for joint advertising expenditure by licensees of the Intel brand in the promotion of their products with a secondary reference to the Intel name. The figures are as follows:

	Intel solus	Intel contribution to licensees
1995	\$12,000,000	\$2, 516, 476
1996	\$11,000,000	\$34, 050, 008
1997	\$8,000,000	

26. Mr Hazell refers to Exhibits DH5 and DH6, which consist of advertisements promoting the Intel name and product, both by Intel themselves and in conjunction with the products of their licensees. Few of these advertisements carry a date of publication. In the body of one it can be seen that it dates back to 1992, all other dates shown being after the relevant date in these proceedings. Few advertisements can be seen to have been placed in the United Kingdom (although none prior to the relevant date) most appearing to have been used in the US. All of the advertisements are for computers and computer related products.

27. Mr Hazell goes on to refer to the re-positioning of Intel's market to focus on sales to the ultimate purchasers, and to a marketing campaign run from 1991 using the slogan INTEL INSIDE and the INTEL INSIDE logo, the aim being to focus the consumers attention on the components of their PC's. He says that as a result the majority of consumers would consider the brand of the microprocessor used to be of critical importance in their choice of PC, Intel achieving 53% recognition in a survey.

28. Mr Hazell next refers to the research and development in which Intel participate, both internally and also as joint ventures, referring in particular to the co-operation with toy manufacturers. He says that Exhibit DH7 gives details of research and development projects. The exhibit consists of a series of press articles detailing new research projects in which Intel have been involved and new products that they are placing on the market. All these articles are after the relevant date in the proceedings and I can see nothing of any historical significance to

this case. The exhibit includes a table showing global research and development spend by Intel but does not apportion the amount relating to the United Kingdom.

29. Mr Hazell goes on to say that Intel is a leader in its field with its activities widely reported and scrutinised, and refers to Exhibit DH8 which consists of a series of press articles that feature the Intel name, particularly with reference to microprocessors. Mr Hazell provides a number of quotations taken from press articles exhibited under DH9 which he says demonstrate the fame and reputation of the Intel mark.

30. Mr Hazell states that to protect the integrity of their brand and prevent mis-use of their mark Intel enters into licence agreements with all authorised users. He refers to Exhibit DH10 which consists of an example of a newsletter issued to members of their licensee program which gives general information on the Intel brand and guidelines on correct use of the Intel trade mark. He says that for complying with these guidelines the licensees are entitled to receive a contribution towards their advertising costs, merchandise and marketing materials, such as point of sale materials, signage, screen savers and stickers bearing the INTEL INSIDE mark and logo.

31. Mr Hazell concludes by stating that in view of the reputation enjoyed by the opponents, it is his belief that the use of INTEL-PLAY by the applicant would lead to confusion on the part of the public and that consumers would believe the product was produced by or sold under licence from Intel. He also feels that use of the mark INTEL-PLAY by the applicant would accrue an unjustified benefit or advantage.

Applicant's evidence

32. This consists of a Statutory Declaration dated 12 July 2000 and comes from Mr Kirpal Singh Sihra (now deceased) the applicant for registration in these proceedings.

33. Mr Sihra firstly gives an historical account of his personal background, and the origins for the product intended to be sold under the INTEL-PLAY mark which he says was originally an idea for a constructional block used in buildings which developed into a child's toy.

34. Mr Sihra states that it was originally intended to promote the product under the name LOXOL, which he registered as a trade mark in December 1992. He states that manufacturing facilities were set up in France under a company called IntelPlay Technologies SARL and production started in June 1997. Exhibits KSS1 & KSS2 consist of samples of the puzzles, which are branded under the LOXOL name but also feature the name INTEL-PLAY TECHNOLOGIES as a secondary element.

35. Mr Sihra states that in consultation with his marketing consultant, it was decided to change the brand name to INTEL-PLAY as it was felt that this conveyed the idea of INTELLIGENT PLAY. He confirms that at this time (1995) he had no particular awareness of Intel Corporation other than vaguely as a manufacturer of something to do with computers.

36. Mr Sihra states that his trade mark attorneys carried out a trade mark search, the results of which are shown as exhibit KSS3. He says that the report showed no instances of serious

conflict and the application was filed on his behalf. Mr Sihra comments that his application had encountered objections based on earlier marks, some owned by the opponents, but that this had been resolved by restricting the specification of the application to exclude electronic games and amusement apparatus.

37. Mr Sihra states that in June 1995 his UK company LOXOL Limited changed its name to INTEL-PLAY TECHNOLOGIES (UK) LIMITED, and that in 1997 he ordered a new set of injection moulding tools that would incorporate the name INTEL-PLAY rather than LOXOL.

38. Mr Sihra states that sales of the INTEL-PLAY/LOXOL products commenced in 1997. Sales appear to have been made in France. He then states that due to ill health he was forced to close his factory in France and returned to England for medical treatment. He exhibits at KSS4 details of his medical condition. He states that medical reasons prevented him taking his project forward and that the moulding injection tools have been stored. However, he claims to have exhibited the product at toy fairs such as The Olympia Toy Fair in January/February 1998 and the Interbuild 2000 Exhibition in Birmingham.

39. Mr Sihra then refers to exhibit KSS5 which consists of a press release (via the Internet) dated February 1999, relating to a joint initiative between the opponents and the toy manufactures Mattel Inc, concerning the launch of two new toy products under the name INTEL-PLAY. Mr Sihra states his surprise at this given that the opponents would have been aware of his application for the same words as they had opposed it in 1997.

40. Mr Sihra then refers to other businesses that use trade marks beginning with Intel, exhibits KSS6, KSS7, KSS8 and KSS9 which consist of a print from the internet for a company called INTELSAT, an advertisement for an Italian electronics fair which features the word Intel solus and a list of UK marks that begin with Intel or where Intel would be seen as a separable element of the mark, none of which establishes that INTEL is being used in a relevant field.

41. Mr Sihra goes on to comment upon the opponents' evidence-in-chief, saying that the exhibits attached to Mr Bruck's affidavit relate to software saying that this is not the same as toys and does not show a reputation at the relevant date. He also asserts, although does not say how he knows that the games market was something new even in 1998.

42. Mr Sihra goes to Mr Hazell's declaration and his statement that goods in the Intel catalogues could be ordered from the United Kingdom, accepting that this was possible, but by facsimile. He comments on the "re-positioning" of INTEL to consumers rather than manufactures, and refers to exhibit DH8 noting that this all refers to computers.

Opponent's evidence in reply

43. The first Affidavit is dated 21 November 2000 and comes from Mr Don Whiteside, General Manager of the Connected Products Division of Intel Incorporation, a position he has held since 1997. He confirms that his evidence is taken from the opponents' records to which he has access, or from his personal knowledge.

44. Mr Whiteside says that the toy bricks sold by the applicant bear only the mark LOXOL,

but that there is no evidence of any sales, nor to support the applicant's claims to have exhibited at toy fairs. He comments on the decision to re-brand in 1995 but observes that LOXOL products were apparently still sold in 1997. He also states that the word INTEL is not an abbreviation for INTELLIGENT, the correct abbreviation would be INTELLI although provides no corroborative evidence.

45. Mr Whiteside refers to a customer survey evidenced below by Mr Alan Wicken, that appears to show that 44% of toy purchasers would associate the INTEL-PLAY mark with the opponents, and that 12% would still make this link if the words were surrounded by pictures of constructional building blocks.

46. Mr Whiteside challenges the assertion that the games/toys market was new in 1998, referring to his company's involvement with LEGO and computer software since the 1980's. He also refers to exhibit DW2 which consists of extracts from the Freemans & Argos catalogues 1995 which shows both high-tech toys and computer and video games technology products.

47. Next is a Statutory Declaration dated 6 November 2000 from Mr Alan John Wicken, a freelance private research consultant retained by the opponents. It is Mr Wicken's survey that Mr Whiteside has referred to above.

48. Mr Wicken sets the background to the purpose and methodology of the survey, and goes on to discuss the results. The results are foreshadowed by Mr Whiteside above. He also exhibits the questions used, and sets out the results from which he draws the conclusion that a substantial proportion of the relevant public would associate the words INTEL-PLAY with the opponents when asked to consider the mark with reference to constructional play-things.

49. Following is an Affidavit dated 21 November 2000 from Mr Rand Potter, manager of Industry Engagement and head of Intel Corporation's PC Enhanced Toy Work Group (PET W/G), a position he has held since 1997 having been employed by Intel for a total of 18 years. Mr Potter confirms that he is authorised to make his affidavit and that the information contained therein comes from the company records, to which he has access, or from his personal knowledge.

50. Mr Potter disagrees that the games market was something new and exciting in 1998. He refers to exhibit RP1 which consists of a chronology of LEGO products from which it can be seen that LEGO first produced computer-related products as early as 1986. He also refers to the LEGO MINDSTORM product saying that whilst this was launched in 1998 it was 15 years in the making. Further information on LEGO computer-related products is shown at exhibits RP2 & RP3.

51. Mr Potter next refers to the PET W/G which has since 1998 been meeting with other companies to promote the exchange of ideas aimed at developing new technology opportunities in the toy industry. He refers to exhibit RP4 which consists of a list of companies that have attended such meetings. Mr Potter states that although the PET W/G only started operating in 1998, the group actually resulted from Intel's earlier work with toy companies from at least 1995, giving this as the year that he considers the toy and technology

industries started converging.

52. An Affidavit dated 21 November 2000 comes from Mr Greg Welch, formerly the director of Global Brand Strategy at Intel Corporation in the year 1998/1999, having been employed by Intel for a total of 7 years. Mr Welch confirms that he is authorised to make his affidavit and confirms that the facts and information therein come from the opponents' records to which he has access, or from his personal knowledge.

53. Mr Welch explains that in his position as Director of Global Brand Strategy he was responsible for Intel's branding strategy, including the naming of Intel branded products. He goes on to explain their selection of INTEL-PLAY for the opponents' new toy related products in 1998/1999, saying that the name was to incorporate the INTEL house mark with the word TOY. Mr Welch states that he was not aware of Mr Sihra's application at this time. He refers to exhibits GW1 and GW2 which consist of web-site downloads showing the INTEL-PLAY range, and an Intel internal memo showing a list of names that had been considered for the new range of products. Page 16 lists the word Intel-Play.

54. Mr Welch refers to the marks evidenced by Mr Sihra as showing use of INTEL by companies other than the opponents, giving his reasons why he considers them not to be in conflict or to be irrelevant. He continues saying that it was possible to order products from the INTEL catalogues (exhibited by Mr Hazell) from in the UK via mail order, and makes particular mention of a puzzle product in the catalogue to demonstrate Intel's use on regular toys. Exhibits GW4 and GW5 consist of a copy of packaging for the puzzle and a trade mark registration certificate from the United States Patent & Trademark Office dating from 1992 which covers jigsaws.

55. Mr Welch goes on to discuss the Intel Inside marketing programme, referring to specific exhibits in Mr Hazell's evidence, and to exhibit GW6 which consists of examples of advertisements for Intel/Intel Inside dating from 1991-1995, all of which he feels were aimed at the ultimate purchaser of PC's.

56. The final Affidavit is dated 21 November 2000 and comes from Mr Mitchell Resnick, a professor in the Epistemology and Learning Group at the Media Laboratory at Massachusetts Institute of Technology (MIT). He states that in his research he studies the role of technologies and media in thinking and learning, and that he develops new computational tools and toys. He exhibits his CV at MR1.

57. Mr Resnick refers to his involvement in the LEGO programmable bricks product, which he says dates back to the mid 1980's. He refers to exhibit MR2 which consists of an article that he co-wrote in 1998, discussing the LEGO building blocks product. Mr Resnick states that the first commercialisation of the project was in the late 1980's. He next discusses the convergence of the computer and toy industries, saying that this has been developing since at least the 1980's, and that it is not solely a US phenomenon. He concludes his Declaration by stating that if he saw the words INTEL-PLAY on a building block he would automatically consider it to be linked with Intel Corporation and that this would have been his opinion in 1995.

That concludes my summary of the evidence insofar as it is relevant to these proceedings.

Decision

58. The opposition is based on Section 5(2), 5(2)(b), Section 5(3) and Section 5(4)(a). Turning first to the ground under Section 5(2). The applicants' mark is self evidently not identical to any of the earlier marks relied upon by the opponents, and consequently, the matter must fall under sub-section (b) of Section 5(2). That section reads as follows:

“5.-(2) A trade mark shall not be registered if because:

- (b)** it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”

59. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means

- (a)** a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,”

60. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

- (a)** the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b)** the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v Klijsen Handel B.V.* paragraph 27;
- (c)** the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*, paragraph 23; 15
- (d)** the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in

mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*, paragraph 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

61. The opponents rely on 12 earlier trade marks, none of which are for identical marks nor identical goods, so the question is whether on a “global” appreciation there is sufficient collective similarity for there to be a likelihood of confusion.

62. In my view if any of the marks relied upon by the opponents are similar it will most likely be those where the only word element is INTEL. Given that these marks also cover the widest range of goods I propose to consider the likelihood of confusion by reference to these marks alone, for if the opponents cannot succeed in respect of these they will be in no better position in respect of the INTEL marks with other word matter.

63. From the cases above it is clear that a comparison of the visual, aural and conceptual similarities of the respective marks must be on the basis of the overall impressions that they create, but as they both have more than one element, consideration should be given to the distinctiveness and dominance of the component parts. I also bear in mind the decision in the *Decon Laboratories Ltd v Fred Baker Scientific Ltd* (2001 RPC 293), in which Pumphrey J held that two marks were identical because they consisted of the same word with a descriptive suffix, which because it referred, inter alia, to the nature of the goods could not distinguish the respective goods.

64. The application is for the words INTEL PLAY. That the word PLAY is an ordinary and well known word will almost certainly mean that it will be seen for what it is, a reference to the character of the goods; they are to be played with.

65. In his Declaration Mr Sihra states that the word INTEL was chosen to convey to the public the idea that the goods were a kind of intellectual activity, the mark as a whole meaning “intelligent play”. There is no evidence that INTEL is an abbreviation for intelligent and simply cutting a portion from a well known word does not make it so. I do not consider that this meaning, whether it is the intention or not, will be readily apparent to the consumer. Accordingly, the distinctive and dominant component of the applicants’ mark, (particularly by virtue of it being at the beginning) is the word INTEL.

66. The respective marks are visually, aurally and conceptually identical in their distinctive and dominant component, although are not so when compared as a whole for even words that on the face of it are devoid of distinctive character will have an impact on how marks appear and sound. But it is the word INTEL that is likely to remain fixed in the consumers mind.

67. Much of the opponents’ evidence is either undated or of uncertain origin. What it does show is that the opponents have had a presence in the United Kingdom for some years prior to the relevant date. But it is from their high profile within the market and the success of their marketing activities that they have undoubtedly built a significant reputation, albeit primarily as the manufacturer of microprocessors. Mr Mellor submitted that the “intel inside” campaign had brought about a new awareness and raised the significance of the processors used in computers, which combined with the fact that stickers bearing the “intel inside” logo are affixed to every computer in which the processors have been installed, had extended the reputation to computers and had firmly placed the brand in the minds of the public. Mr Hazell makes reference to independent market research as having shown that “at least 53% of consumers spontaneously named INTEL when asked to name a producer of microprocessors.” No other information about the survey has been provided, and whilst I consider there to be insufficient detail to be able to give the research much weight in itself, it does, in my mind only say what the evidence establishes; that INTEL has achieved a significant level of awareness in the minds of the public in respect of microprocessors. A link may well have been formed between the INTEL brand and computers and computer peripherals, including computer games, but in my view it would be going too far to say that this extends to other goods.

68. The opponents not surprisingly devote a significant part of their evidence in seeking to establish a link between the computer, and in particular the microprocessor market, and that of toys and games. Whilst there is evidence to show that some of the toys available to consumers have become more sophisticated and incorporate processors, this appears to have occurred in the market after the relevant date. Even so, I am not convinced that the name of the processor within will have anything like the significance to the purchaser of the toy as it would for a computer where factors such as the speed and power of the processor will influence the decision to purchase. The purchaser may well be a computer literate parent, but the consideration will be the name and functions of the toy, not the workings. But in any event, the opponents’ earlier marks do not cover such toys.

69. On the question of whether the respective goods are similar I look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* (1996) RPC 281 and in the judgement of the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C- 39/97 case. With these cases in mind I propose to consider the question of similarity by a consideration of the following factors:

- (a) The nature of the goods or services;
- (b) The end-users of the goods or services;
- (c) The way in which the goods or services are used;
- (d) Whether the respective goods or services are competitive or complementary. This may take into account how those in trade classify goods and the trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) In determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account.

70. The application covers “hand-held constructional toys being puzzles” which the evidence shows to be a form of interlocking plastic block. But in my view the specification covers more than this. Constructional toys are capable of being electronic, particularly when in the form of a puzzle; the user solving a constructional puzzle on a screen, be it hand held or in an arcade form. The opponents’ earlier marks are all registered in Class 9, and in respect of, inter alia, computers, computer peripherals and computer software, all of which could include computer games apparatus and games software, and potentially, in the form of a constructional puzzle. I would therefore consider the respective goods to be similar in nature and likely, or at least capable of being used by the same person. Apart from the fact that one may be held in the hand and the other free standing, the goods will be used in the same way. I have no evidence of how the trade classifies such goods and whilst they may be competitive, the choice being a computer based game or a hand-held, they would not, in my view, be complementary. I see no reason why they should not originate from the same manufacturer, or be sold in the same retail outlets. Taking the above into account I come to the view that in respect of electrical or electronic games apparatus the opponents’ earlier marks and the application would notionally cover similar goods, but I would say that beyond this the goods would not be similar.

71. The consideration under Section 5(2)(b) is a notional one based on the mark, goods and a range of surrounding circumstances. Adopting the global approach advocated and taking into account all of the criteria set out above, I come to the view that use of the trade mark INTEL PLAY in respect of electronic hand held constructional puzzles is likely to cause the public to wrongly believe that the respective goods come from the opponents or an economically linked undertaking and that there is a likelihood of confusion within the meaning of the section. Accordingly, the ground under Section 5(2)(b) succeeds. However, if the specification was more precisely limited to the goods of interest to the applicants, namely “interlocking blocks being constructional toy puzzles”, I think that there may be a possibility of the public bringing to mind the opponents’ mark, but not such that they would be confused.

72. Although my decision under Section 5(2)(b) effectively decides the matter, in case I am found to be wrong I will go on to consider the remaining grounds under Section 5(3) and Section 5(4)(a). Section 5(3) reads as follows:

“5(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

73. As with my considerations under Section 5(2)(b) I propose to consider this ground by reference to the opponents’ earlier marks where the only word element is INTEL, for if they cannot succeed in respect of these they will be in no better position in respect of the INTEL with other word matter. These registrations are earlier trade marks within the meaning of Section 6(1) of the Act set out earlier.

74. In my determination of the ground under Section 5(2)(b) I found the marks INTEL and INTEL PLAY to be similar. I also reached the conclusion that to the extent that the opponents earlier marks could include computer games apparatus and the application electronic constructional puzzles, that similar goods were involved, but that in respect of other goods (in particular the interlocking blocks being constructional toy puzzles that the evidence shows the applicants intend the mark for) the respective goods were not similar. The question therefore is whether the opponents’ reputation is such that use on INTEL PLAY will give the applicants some advantage to which they are not entitled, or detract from the distinctive character or repute of the opponents’ earlier marks.

75. In *Pfizer Ltd v Euro Food-Link (UK) Ltd* ((ChD) [1999] 22(4) IPD 22039) Mr Simon Thorley QC sitting as a Deputy High Court Judge said:

"What is necessary is that the trade mark proprietor should prove the required reputation and should then satisfy the Court that the defendants use of the sign is:

- (a) without due cause; and
- (b) takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark."

76. Although the opponents appear to have reputation almost exclusively established through use in respect of microprocessors, for the reasons I have given above I consider it reasonable to consider their reputation to go beyond this, although in relation to goods and services, no

further than the computers, computer peripherals and electronic components. This would include computer games. They refer to use of their mark in respect of promotional items bearing the INTEL mark, exhibit DH3 showing such use on a range of items including a jigsaw puzzle. However, none of the catalogues exhibited can be clearly seen to have been available prior to the relevant date and although they make provision for orders from outside of the United States, including via the Internet, as Jacob J said in the 800-FLOWERS case, (2000 FSR 607):

“The mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world.”

77. There is no evidence that orders were placed from within the United Kingdom, be it via the website or otherwise. Consequently there is insufficient to be able to say that this has furthered their reputation within the United Kingdom, and if it has, to what extent. They also cite the synergy that has developed between the computer and toy industries, but as I have already said, it seems unlikely that the public would have been aware of this at the relevant date, and even if they were, I do not consider that this would lead them to associate a mark centred around information technology, with an unsophisticated, non electronic, block puzzle. Consequently the ground under Section 5(3) fails.

78. Finally there is the ground under Section 5(4)(a). That section reads as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

79. Mr Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

(a) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

(c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

80. To the above I add the comments of Pumphrey J in the *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenmy Gary Stringer (a partnership)* case, in which he said:

“There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirement of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

81. Section 5(4)(a) of the Act offers protection to the goodwill and reputation built up by a trader through the use of a sign, either at the date that the application to register was made, or at an earlier date, if appropriate. There is no claim that the passing-off occurred at a date earlier than the date of application, so it is as at that date that I must view the opponents’ reputation and goodwill. I have already highlighted the limitations of the opponents’ reputation within the United Kingdom and they are in no better a position with respect to goodwill. Whilst they undoubtedly have a high reputation I do not consider that the evidence establishes that at the material date this would have extended much beyond their core microprocessor business other than to closely related products, namely computers and computer peripherals, and accordingly, that they are in no better a position than they were under Section 5(2)(b). In the *Stringfellows v McCain Foods* case (1984 FSR 175) it was said that where the fields of activity are not the same, the burden of showing misrepresentation and damage are greater. I do not consider that the opponents have discharged this burden and consequently, the objection under Section 5(4)(a) fails.

82. As stated earlier I find the opposition succeeds on the ground under Section 5(2)(b). However, if the applicants file a Form TM21 within one month from the end of the appeal period to reduce their specification to:


Interlocking blocks being constructional toy puzzles.

I will, in the event of no appeal, allow this application to proceed to registration. If the applicants fail to file a TM21 within one month from the end of the appeal period the application will be refused.


83. The opposition having been successful the opponents are entitled to a contribution towards their costs. I order the applicants to pay the opponents the sum of £ 835 as a contribution towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17 day of June 2002

**Mike Foley
for the Registrar
The Comptroller General**

Number	Mark	Class	Specification
962981	INTEL	9	Plugs, sockets, connectors, blocks, crimps, holders, mouldings, board and cable fittings, all being electrical or electronic connecting devices; switch devices, capacitors, resistors, knobs, transformers, chokes, stabilisers, transformers, transponders, thermocouples, valves, diodes, transistors and thyristors, all being electrical or electronic devices; parts and fittings included in Class 9 for all the aforesaid goods.
962982		9	Plugs, sockets, connectors, blocks, crimps, holders, mouldings, board and cable fittings, all being electrical or electronic connecting devices; switch devices, capacitors, resistors, knobs, transformers, chokes, stabilisers, transformers, transponders, thermocouples, valves, diodes, transistors and thyristors, all being electrical or electronic devices; parts and fittings included in Class 9 for all the aforesaid goods.
969190	INTEL	9	Integrated electronic circuits; electronic data storage apparatus; and microcomputers.
1036718	INTELLEC	9	Computers and microprocessors; devices for use with computers as aids in the design of electrical and electronic circuits; and semi-conductor integrated circuits for all the aforesaid goods; but not including fuses.
1142466	INTEL	9	Magnetic tapes, discs and records, all adapted for use with computers and with data storage apparatus; integrated Electronic circuits; electronic data storage apparatus and micro computers

Number	Mark	Class	Specification
1411048	INTEL	9	Apparatus and instruments, all for processing, storage retrieval, transmission, display, input, output and printout of data; computers, computer terminals and printers for use therewith; video display units; floppy disc driving apparatus; modems; apparatus and instruments, all for monitoring, detecting, testing and measuring; electronic security apparatus; surveillance apparatus; electronic apparatus and instruments, all for recognising digital and analogue codes; control apparatus for all the aforesaid goods; cards, discs, tapes, wires, records, microchips and electronic circuits, all for the recordal of data; video processor boards; microprocessors; electronic circuit boards; integrated circuit memories; operating systems, computer programs; microcontrollers; computers; data processors; central processing units; computer components; semiconductor chips; computer input and output devices; work stations; data memories; storage devices; registers; apparatus for testing and programming integrated circuits; peripheral memory apparatus; microcomputers; minicomputers; computer installations; memory boards; processing apparatus; racks, cabinets and holders, all adapted for the aforesaid goods; parts and fittings for all the aforesaid goods; computer programmes and computer software; all included in Class 9.
1437993		9	Apparatus and instruments, all for processing, storage, retrieval, transmission, display, input, output and printout of data; computers, computer terminals and printers for use therewith; video display units; floppy disc driving apparatus; modems; apparatus and instruments, all for monitoring, detecting, testing and measuring; electronic security apparatus; surveillance apparatus; electronic apparatus and instruments, all for recognising digital and analogue codes; control apparatus for all the aforesaid goods; cards, discs, tapes, wires, records, microchips and electronic circuits, all for the recordal of data; video processor boards; microprocessors; electronic circuit boards; integrated circuit memories; operating systems, computer programs; microcontrollers; computers; data processors; central processing units; computer components; semiconductor chips; computer input and output devices; work stations; data memories; storage devices; registers; apparatus

Number	Mark	Class	Specification
1437993 (cont)		9	for testing and programming integrated circuits; peripheral memory apparatus; microcomputers; minicomputers; computer installations; memory boards; processing apparatus; racks, cabinets and holders, all adapted for the aforesaid goods; parts and fittings for all the aforesaid goods; computer programs and computer software; all included in Class 9.
1466900		9	Apparatus and instruments, all for processing, storage, retrieval, transmission, display, input, output and printout of data; computers, computer terminals, and printers for use therewith; video display units; floppy disc driving apparatus; modems; apparatus and instruments for monitoring, detecting, testing and measuring; electronic security apparatus; surveillance apparatus; electronic apparatus and instruments for recognising digital and analogue codes; control apparatus for all the aforesaid goods; cards, discs, tapes, wires, records, microchips and electronic circuits, all for the recordal of data; video processor boards; microprocessors; electronic circuit boards; integrated circuit memories; operating systems programs; microcontrollers; computers; processors; central processing units; computer components; semiconductor chips; computer input and output devices; work stations; data memories; storage devices; registers; apparatus for testing and programming integrated circuits; peripheral memory apparatus; microcomputers; minicomputers; computer installations; memory boards; processing apparatus; racks, cabinets and holders, all adapted for the aforesaid goods; parts and fittings for all the aforesaid goods; computer programmes and computer software; all included in Class 9.
1526872	INTEL 1960	9	Computers; computer hardware; computer software; semiconductors; video apparatus; data recorded in electronic, optical or magnetic form; microprocessors; integrated circuits; microcomputers; computer programs; apparatus and instruments all for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging or enhancing of data; algorithms for the compression and decompression of data; testing and calibrating apparatus; parts and fittings for all the aforesaid goods.

Number	Mark	Class	Specification
2023123		9	<p>Computers; computer hardware; computer software; semiconductors; electronic and electromechanical apparatus for use with computers; video apparatus; video circuit boards; video system products; data recorded in electronic, optical or magnetic form; microprocessors; integrated circuits; microcomputers; computer programs; instructional material relating to computers and data, all recorded magnetically, optically or electronically; apparatus and instruments all for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging or enhancing of data; algorithms for the compression and decompression of data; testing and calibrating apparatus; telecommunications apparatus and instruments; apparatus and instruments, all for use in conferencing, document exchange and editing; cameras; headsets; mice; parts and fittings for all the aforesaid goods.</p>
2026599		9	<p>Computers; computer hardware; computer software; semiconductors; electronic and electromechanical apparatus for use with computers; video apparatus; video circuit boards; video system products; data recorded in electronic, optical or magnetic form; microprocessors; integrated circuits; microcomputers; computer programs; instructional material relating to computers and data, all recorded magnetically, optically or electronically; apparatus and instruments all for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging or enhancing of data; algorithms for the compression and decompression of data; testing and calibrating apparatus; telecommunications apparatus and instruments; apparatus and instruments, all for use in conferencing, document exchange and editing; cameras; headsets; mice; parts and fittings for all the aforesaid goods.</p>