

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 94454**

**IN THE NAME OF INTEL CORPORATION**

**TO TRADE MARK APPLICATION No. 2404164**

**IN THE NAME OF GARY MILTON MUNROE**

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**DECISION**

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1. Under Section 41 of the Trade Marks Act 1994 it is possible to file a single application for registration of a series of trade marks i.e. *'a number of trade marks which resemble one another as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark'*: Section 41(2). The wording of Section 41(2) calls for iteration of the material particulars of a trade mark with nothing more than variations of a non-distinctive character not substantially affecting the identity of the trade mark reiterated in the series.<sup>1</sup> That effectively requires the marks in a series to be collectively registrable for the goods or services specified in the application for registration. The inclusion of one or more unregistrable marks is therefore liable to prevent registration of the series as a whole. That is a problem which can, in appropriate situations, be solved by dividing the original

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<sup>1</sup> Digeo Broadband Inc's Trade Mark Application [2004] RPC 32; O2 Holdings Ltd v. Hutchison 3G Ltd [2006] EWHC 534 (Ch); [2006] RPC 29 at para. 78.

application in a way which isolates one or more registrable marks individually or in sub-series from the unregistrable remainder.<sup>2</sup>

2. On 12 October 2005 Mr. Gary Munroe applied under number 2404164 to register a series of 5 trade marks for use in relation to *'computers; computing hardware; computer software (including software downloadable from the Internet); computer gaming equipment'* in Class 9 and *'design and development of computer hardware; installation, repair and maintenance of computer hardware and software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the websites of others; compilation, creation and maintenance of a register of domain names; leasing of access time to a computer database'* in Class 42.

3. The marks in the series were graphically represented with colouring in Pantone PMS 298 and Pantone PMS 296 as follows:



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<sup>2</sup> Rule 28 of the Trade Marks Rules 2008; Gateway Inc's Trade Mark Application BL O-322-03, paras. 5 to 9 and 21 to 27; DIANA PRINCESS OF WALES MEMORIAL FUND Trade Mark BL O-125-03, paras. 3 and 8 to 10.

In the absence of any request to sub-divide the application for registration, it is appropriate to proceed upon the basis that the variations between the marks are not alleged to be either significant in terms of distinctiveness or substantial in terms of identity, as required by Section 41(2) of the Act.

4. From that perspective it is instructive to note that in the fifth mark in the series the verbal element **ACTIV** and the verbal element **INTEL** are contrastingly represented in white and dark blue (Pantone PMS 296) on a light blue (Pantone PMS 298) background. This visually emphasises the capacity of the word **ACTIVINTEL** to be perceived and remembered as **ACTIV-INTEL** in the market for computer goods and services of the kind specified in the application for registration.

5. Mr. Munroe clearly appears to have thought that the word **ACTIVINTEL** was apt to be understood as **ACTIV-INTEL**. On 4 October 2005 he sent an email to the Intel Corporation in the following terms:

... I am setting up a company that will be selling all in one computers and I write to enquire if Intel has any objection to either of the names (Activintel or ActiveIntel or ActivIntell) being used. As a side note, the computers will use only Intel processors and I am more than happy to provide a demonstration of the product if required. In the interim, please visit [www.activintel.com](http://www.activintel.com) and advise if there are any objections to the name being used.

On 5 October 2005 he received a negative response:

You indicate that you will use the company name Active Intel for reselling PCs. Intel is concerned that this use of any of the above mentioned terms as your company name as well as part of your company's domain name will likely cause

confusion as to the source of affiliation of your company with INTEL and is therefore actionable in passing off under UK law.

Therefore, to avoid such confusion, we have to request that you do not use the above terms and take the necessary steps to change the company name ActivIntel to something else not including the INTEL mark as well as cancel the domain name [www.activeintel.com](http://www.activeintel.com). Please confirm to me in writing within the next week after receipt of this email mail that you will instruct the necessary changes to the company name and domain name.

He sent a further query by email on the same day:

Please confirm that you also express concern with the name “ActiveIntell”.

On 6 October 2005 he was told:

I have the same concerns of confusion of the consumer with the term “ActivIntell”. The term highlights the Intel part even more.

On 12 October 2005 (the date on which he filed his application for registration) he responded in the following terms:

Thank you for your response of which the content is noted. However, I wrote to the Corporation on 20 July 2005 requesting confirmation of any objections within 3 weeks. As no response was received, I went ahead and have outlaid significantly on developing my brand; including production of the marketing material, logo development, and advertising and at present I have 2400 units with my “activintel” branding awaiting shipment.

In view of the significant outlay I have made as a small business that is looking to grow through development of my products and given that Companies House raised no

objections, I request that I be given lee-way to continue to use the name "activintel". I trust that all my machines use an Intel chipset, Intel processor, Intel motherboard and Intel graphics, that you see the benefit to Intel Corporation. If possible I would like the opportunity to demonstrate our products to you in a bid that you can see the added value to your corporation.

The utilisation of Intel chipsets, Intel processors, Intel motherboards and Intel graphics was thus presented as a benefit which use of the name **ACTIVINTEL** with 'lee-way' (which I take to mean clearance) from the Intel Corporation would serve to promote. The request for clearance implicitly recognised that the name **ACTIVINTEL** was liable to signify a connection with **INTEL**.

6. Mr. Munroe is the holder of a Bachelor of Engineering degree in Electrical and Electronics Engineering with a specialisation in Satellite and Data Communications. He served as an engineering officer and IT manager in the Royal Air Force. During the period of his service he rose to the rank of Flight Lieutenant. It appears to me that his thinking as to the way in which the word **ACTIVINTEL** was liable to be perceived and remembered is pertinent in view of his familiarity with the commercial sector in which he was operating.

7. His application for registration was opposed by Intel Corporation. The notice and grounds of opposition were filed on 30 June 2006. For present purposes it is sufficient to note that objections to registration were raised under Section 5(2)(b) of the 1994 Act on the strength of the rights conferred by 6 earlier trade mark registrations protecting the mark **INTEL** across a wide range of computer goods and services. All of the goods and services listed in the opposed application for registration were either identical or closely

related to those covered in the aggregate by the earlier trade mark registrations. The central premise of the objections under Section 5(2)(b) was that the mark **INTEL** and the denomination **ACTIVINTEL** could not be used concurrently in relation to goods and services as similar as those for which they were respectively registered and proposed to be registered without giving rise to the existence of a likelihood of confusion, even if the denomination **ACTIVINTEL** was used as part of a composite mark graphically represented in one or other of the ways shown in the opposed application for registration.

8. In relation to those of the earlier trade marks that were subject to proof of use in accordance with the provisions of Section 6A of the 1994 Act, the notice of opposition contained statements to the effect that they had been used within the period of 5 years ending with the date on which the opposed application for registration was published (31 March 2006) for all goods and services in respect of which they were registered. The opponent also filed evidence in support of its contentions with regard to the likelihood of concurrent use of the trade mark **INTEL** and the denomination **ACTIVINTEL** giving rise to confusion.

9. Mr. Munroe defended the opposition on the basis of a Form TM8 and counterstatement filed on 5 October 2006. In box 5 of the Form TM8 he specifically confirmed that he accepted the opponent's statements of use with regard to the cited earlier trade marks. In box 7 he confirmed that there was no dispute as to the reputation of **INTEL**. He subsequently put forward written observations for consideration at the substantive hearing of the opposition. It is clear from these observations<sup>3</sup> that he accepted

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<sup>3</sup> see, in particular, paragraphs 3, 4, 6 and 7.

the opponent's contentions to the effect that **INTEL** was a distinctive and well-known trade mark.

10. His defence to the objection under Section 5(2)(b) as summarised in his counterstatement was:

The goods are similar to the extent that they fall in the same class and it is at this point the similarity ends as the Opposer produces micro-processors, chipsets, motherboards and other computer accessories, all of which are an integral part of any computer and can be classed as computer hardware. The Opposer does not produce the end product but produces the elements that constitute the end product and it is for this reason the Opposer is well known in the marketplace. Additionally, the Marks of the Opposer are distinctively different.

Although he sought and obtained an extension of time for filing evidence in answer to the opposition, he ultimately chose to defend his application for registration without formally tendering any evidence in support of his arguments as to the absence of a likelihood of confusion.

11. The opposition proceeded to a hearing on 14 May 2008 before Mr. David Landau acting on behalf of the Registrar of Trade Marks. The opponent was represented by Ms. Anna Carboni of Counsel. The applicant represented himself. The Hearing Officer decided that the opponent's objections to registration under Section 5(2)(b) were well-founded for the reasons he gave in a written decision issued under reference BL O-150-08 on 29 May 2008. He refused the application for registration in its entirety and ordered the applicant to pay the sum of £1,700 to the opponent as a contribution towards its costs of the proceedings in the Registry.

12. The Hearing Officer correctly directed himself as to the law relating to the assessment of objections to registration under Section 5(2)(b). He fully appreciated that he was required to give due weight to the differences and similarities between the relevant marks, in each case taken as a whole and appraised without dismemberment or excision. On the evidence before him he was satisfied that the **INTEL** trade mark had an enormous reputation and that people who saw it used in relation to computers or computer-linked products or services would take it to be denoting a connection in the course of trade with the Intel Corporation. He considered that the denomination **ACTIVINTEL** would be perceived and remembered in the context of the applicant's marks as **ACTIV-INTEL** rather than as a wholly invented word with no separately identifiable parts.

13. On assessing the marks in issue from that point of view, he decided as follows:

32 ... The marks converge in visual and aural similarity upon the INTEL element although, clearly, the applicant's marks consist of more than INTEL. I consider that conceptually, ACTIV is a qualifier for INTEL, describing an 'active' aspect of the goods or services. INTEL has become so well-known as [the opponent's] trade mark that for these goods and services any other meaning has been supplanted. The whole of [the opponent's] mark appears in the application as the element described by the adjectival ACTIV. Visually, aurally and conceptually, the marks are similar to a substantial extent. However, the device and the ACTIV elements are not negligible and taking into account the whole of Mr. Munroe's trade marks, I do not consider that it can be argued that INTEL is the dominant component.

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34. ... I must assess the weight which each part plays in the overall impression of the marks and consider any conceptual similarities ... I do not consider that INTEL is the dominant component of the applicant's marks, but neither is it negligible. On the contrary, the adjectival use of ACTIV



(because of its position in front of INTEL) makes ACTIV subordinate to INTEL in the overall impression of the mark. The corollary of this is that INTEL is more important in the overall impression given by the mark. ...

35. Mr. Munroe submitted that ACTIVINTEL is a contracted form of “Active Intelligence” and that the device is comprised of an “a” and an “i”, taken from the initials of those words. Whether or not ‘intel’ means intelligence, the meaning of INTEL in the computing field is overwhelmingly that it distinguishes computing goods and services as emanating from [the opponent]. INTEL is therefore highly distinctive for the goods and services in issue and has an independent distinctive role in the composite sign even though it is not dominant. This independence is achieved by virtue of INTEL’s status as a famous trade mark and by the natural visual and aural split between ACTIV and INTEL, stated above.

36. I have found that the marks are similar to a substantial extent and that the goods and services are either identical or closely similar. I think it unlikely that the marks would be directly confused with one another. However, according to the jurisprudence cited above, I must also have regard to a scenario where, although the marks are not mistaken directly, there is a belief or an expectation upon the part of the average consumer that the goods bearing the individual marks emanate from a single undertaking because there are points of similarity which lead to association. If the association between the marks causes the relevant consumer, who is reasonably well informed and reasonably circumspect and observant, wrongly to believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion (*Canon, supra*). This would include use by licensees, a key feature of [the opponent’s] business strategy. Having regard to the identity or close proximity of the goods and services and the distinctive character of the word INTEL, described by ACTIV, I find that there is such a likelihood of confusion within the meaning of Section 5(2)(b) of the Act.

14. Mr. Munroe gave notice of appeal to an Appointed Person under Section 76 of the Act. With the assistance of Mr. Mark Engelman of Counsel instructed on the basis of direct access to members of the Bar of England and Wales he mounted a four-pronged

attack upon the Hearing Officer's decision. First, he contended that the marks in issue were distinctively different and that the Hearing Officer's decision to the effect that they were distinctively similar should be set aside on the ground of manifest error. Second, he sought permission to support that contention with evidence contesting the distinctiveness of the **INTEL** trade mark for the first time on appeal. Third, he contended that the Hearing Officer's decision should be set aside for having been made in breach of his right to a fair hearing before an independent and impartial tribunal under Article 6(1) ECHR. Fourth, he contended that Section 6A of the 1994 Act provided no valid basis for implementation of the procedure pursuant to which he had accepted the opponent's statements of use and that his acceptance of those statements should therefore be treated as null and void so as to retroactively deprive the opponent of the right to rely on them.

15. In my view, there is no substance or merit in the first line of attack. It appears to me that the Hearing Officer was fully entitled to reach the conclusion that he did on the basis of the pleadings and evidence before him. No amount of poring over his finding that **INTEL** performed an independent distinctive role without also being a dominant element in the perception of the applicant's marks can detract from the correctness of the basic tenet of his decision. The differences between the marks were simply not sufficient to drown out the powerful message of trade origin conveyed by the readily recognisable reference to **INTEL** in the applicant's marks. Hence the need for clearance as requested in the correspondence noted in paragraph 5 above.

16. The second line of attack involved a change of position in the aftermath of the Hearing Officer's decision. It appeared to me that Mr. Munro was attempting to outflank

the decision by adducing evidence in support of a case that backtracked to a not insignificant degree on the position he had adopted at first instance. I refused the application for permission to adduce the evidence put forward on appeal. I did so for the reasons given in the transcript of my decision posted on the Trade Marks Registry website under reference BL O-331-08.

17. The third line of attack arose out of a concern I raised on seeing that Intel Corporation intended to be represented by Ms. Anna Carboni of Counsel at the hearing of Mr. Munroe's appeal. Ms. Carboni was and is one of a small number of persons appointed to hear and determine appeals from decisions of the Registrar of Trade Marks under Section 76 of the Act. I therefore considered it appropriate to invite observations from the parties and the Registrar as to the acceptability under Article 6(1) ECHR of a party being represented by one Appointed Person on appeal to another.

18. The Intel Corporation subsequently elected to be represented at the hearing of the appeal by Mr. James Mellor Q.C. However, Mr. Munroe was not content with that outcome. He sought to amend his Grounds of Appeal so as to raise a complaint to the effect that the Hearing Officer should not have allowed an Appointed Person (Ms. Carboni) to appear on behalf of the Intel Corporation at the hearing in the Registry without his (Mr. Munroe's) knowledge and consent. Her appearance as Counsel for Intel Corporation without his knowledge and consent was alleged to have breached his right to a fair hearing before an independent and impartial tribunal under Article 6(1) ECHR. After hearing argument as to the maintainability of the complaint, I refused the

application to amend the Grounds of Appeal for the reasons given in the transcript of my decision posted on the Trade Marks Registry website under reference BL O-330-08.

19. I have found it difficult to follow the logic of the fourth line of attack on the Hearing Officer's decision. To the best of my understanding it begins with the proposition that the provisions of Section 6A of the 1994 Act are incompatible with the provisions of the Directive which they were intended to implement. That is said to have rendered the incompatible provisions of Section 6A invalid. The invalidity of those provisions is then said to have rendered the Forms TM7 and TM8 prescribed for use in Registry proceedings invalid to the extent that they make it necessary for the parties to such proceedings to conduct their cases with regard to proof of use in accordance with the invalid provisions of Section 6A. The invalidity of the prescribed forms is then said to have invalidated Mr. Munroe's compliance with the invalid provisions of Section 6A and thereby rendered his acceptance of the opponent's statements of use null and void. That is said to have retroactively deprived the opponent of the right to rely on his acceptance of its statements of use.

20. The end result of the argument is said to be an opposition in which use must, to the extent that it was not proven by evidence tendered on behalf of the opponent, be regarded as non-existent in relation to those of the cited earlier trade marks that were subject to proof of use in accordance with the provisions of Section 6A. According to paragraph 44 of Mr. Engelman's skeleton argument, an assessment carried out on that basis would have shown *'the goods/services the subject of the competing marks to be merely similar not identical'*. However, the earlier trade mark rights for which no statements of use were

required under Section 6A would not (as I understand the argument) be affected by that approach to assessment. These were United Kingdom registered trade mark number 2227092 and Community trade mark number 1574516. They provide quite extensive coverage in Classes 9, 38 and 42. I am therefore left with the impression that the Hearing Officer's decision could be supported by reference to the cited earlier trade marks even if the argument I am struggling to understand is correct. In which case the argument serves no useful purpose.

21. It further appears to me that the argument is unmaintainable on any realistic view of the matter. Section 6A operates in the same way as to the parallel provisions of the Community Trade Mark Regulation.<sup>4</sup> When an opposition is based on an earlier trade mark registered more than 5 years prior to the date on which the opposed application for registration was published, the applicant for registration can require the Registrar to proceed as if the coverage of the earlier trade mark registration had been reduced to the same extent as it would have been reduced upon an application for revocation on the ground of non-use relating to the period of 5 years ending with the date of publication of the opposed application for registration.

22. The legislative underpinning for Section 6A can be found in Article 11 of the Trade Marks Directive.<sup>5</sup> This (in its current form) provides as follows:

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<sup>4</sup> Article 42(2) of Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark, formerly Article 43(2) of Council Regulation (EC) No.40/94 of 20 December 1993 on the Community trade mark.

<sup>5</sup> Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States codifying with effect from 28 November 2008 the provisions of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

*Article 11*

**Sanctions for non-use of a trade mark in legal or administrative proceedings**

1. ...
2. Any Member State may provide that registration of a trade mark not be refused on the ground that there is an earlier conflicting trade mark if the latter does not fulfil the requirements of use set out in Article 10(1) and (2) or in Article 10(3), as the case may be.
3. ...
4. If the earlier trade mark has been used in relation to part only of the goods or services for which it is registered, it shall, for purposes of applying paragraphs 1, 2 and 3, be deemed to be registered in respect only of that part of the goods or services.

Article 10 of the Directive (in its current form) provides as follows with emphasis added:

*Article 10*

**Use of trade marks**

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the Member State in connection with the goods or services in respect of which it is registered, **or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Directive, unless there are proper reasons for non-use.**

The following shall also constitute use within the meaning of the first subparagraph:

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

(b) affixing of the trade mark to goods or to the packaging thereof in the Member State concerned solely for export purposes.

2. Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.

3. In relation to trade marks registered before the date of entry into force in the Member State concerned of the provisions necessary to comply with Directive 89/104/EEC:

(a) where a provision in force prior to that date attached sanctions to non-use of a trade mark during an uninterrupted period, the relevant period of five years mentioned in the first sub-paragraph of paragraph 1 shall be deemed to have begun to run at the same time as any period of non-use which is already running at that date;

(b) where there was no use provision in force prior to that date, the periods of five years mentioned in the first subparagraph of paragraph 1 shall be deemed to run from that date at the earliest.

23. Section 6A of the Act implements Articles 11(2) and 11(4) of the Directive by reference to '*an uninterrupted period of five years*' ending with the date of publication of the opposed application. Article 10(1) of the Directive clearly does not prevent the Member States from giving effect to the provisions of Articles 11(2) and 11(4) on the basis of '*an uninterrupted period of five years*' ending (in the same way as the parallel provisions of the Community Trade Mark Regulation) with the date on which the opposed application was published. I do not think it can seriously be suggested that Section 6A is invalid for incompatibility with the Directive.

24. Even if I had thought that it might seriously be suggested that Section 6A was invalid for incompatibility with the Directive, I would not have accepted that the invalidity of that section could have the repercussive effects envisaged by the argument advanced on behalf of Mr. Munroe. In simple terms, the opponent stated and Mr. Munro accepted that separately identified earlier trade marks had been used within the period of 5 years ending with the date on which the opposed application for registration was published (31 March 2006) for all goods and services in respect of which they were registered. That, from a procedural and evidential point of view, amounted to an admission that the statements of use were in fact correct. I think it would be unjust, in the absence of any application to amend Mr. Munroe's Form TM 8 so as to qualify or withdraw the acceptance in box 5, to proceed on any other basis.

25. For the reasons I have given the appeal will be dismissed. As confirmed at the hearing<sup>6</sup>, there is no need for me to consider any aspects of the Respondent's Notice filed on behalf of the Intel Corporation. It is appropriate to make an award of costs in favour of the respondent to the appeal. The costs of the appeal were increased by the way in which it was approached in the arguments unsuccessfully advanced on behalf of the appellant. Looking at matters in the round I think it is appropriate to award the Intel Corporation £1,800 as a contribution towards its costs of the appeal. Mr. Munroe is directed to pay that sum to the Intel Corporation within 28 days of the date of this decision. It is payable in

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<sup>6</sup> Transcript pp.134, 135.



addition to the sums awarded in respect of my earlier decisions under reference BL O-330-08 and BL O-331-08 and in addition to the sum awarded by the Hearing Officer in respect of the proceedings in the Registry.

Geoffrey Hobbs Q.C.  
22 July 2009

Mark Engelman appeared as Counsel on behalf of the appellant (Mr. Munroe).

James Mellor Q.C. instructed by CMS Cameron McKenna LLP appeared as Counsel on behalf of the respondent (Intel Corporation).

The Registrar was not represented at the hearing.