

O-096-16

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3034581

BY HVIVO SERVICES LIMITED TO REGISTER THE TRADE MARK BIOINTEL IN CLASS 35 AND 42

AND IN THE MATTER OF OPPOSITION THERETO UNDER NO 402032

BY INTEL CORPORATION

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF

MR MARK BRYANT DATED 20 MAY 2015

DECISION

1. This is an appeal from a decision of Mr Mark Bryant, the Hearing Officer for the Registrar, in the opposition by Intel Corporation (“Intel”) to the registration of the mark BIOINTEL. Mr Bryant decided that the opposition failed and Intel appeals that decision.

Background

2. Retroscreen Virology Limited applied for the trade mark BIOINTEL No. 3052887 on 12 December 2013 for a specification of services in Classes 35 and 42 (see Annex A). In April 2014, the application was opposed by Intel. Between the hearing before the Hearing Officer and the delivery of his decision, the application was transferred into the name of Hvivo Services Ltd. I should add that at the hearing of the appeal I was told that the Applicant had offered a slight amendment its Class 35 services (as indicated in square brackets in Annex A) and that offer was maintained at the appeal.
3. Intel’s opposition was based solely upon s 5(3) of the Act. It relied upon two earlier UK marks for the plain word INTEL, details of which are set out in Annex B. The first in time is No. 1411048, which is registered for a range of goods in Class 9. In its TM7,

Intel claimed a reputation for that mark only for computer software. The second mark relied upon was No 2108574, which is registered for goods in Classes 9 and 16 and for services in Class 38. In its TM7 Intel claimed that the latter mark had a reputation in relation to “computer hardware; semiconductor processors; semiconductor processor chips; and microprocessors.”

4. The Annex to the TM7 set out pleaded grounds of opposition, and referred to the ‘huge reputation’ enjoyed by the INTEL mark, citing the decision of the Court of Appeal in *Intel Corp v CPM United Kingdom Ltd* [2007] EWCA Civ 431, [2007] RPC 35, in which Jacob LJ said that anyone seeing INTEL “used in relation to computers or computer linked products or services” would see it as showing a trade connection with Intel. Nevertheless, at paragraph 9(i) of the Annex to the TM7, Intel reiterated that “The Opponent’s Marks enjoys [*sic*] a huge reputation in respect of the Opponent’s computer hardware, semiconductor processors, semiconductor processor chips, microprocessors and computer software.” The Annex went on to make comparisons between the various services included within the application and the “computer products in respect of which the Opponent's Mark is famous.”
5. The Hearing Officer held that Intel has a significant reputation in respect of the goods it relied upon, and that the parties' marks were similar, but he considered that no link was established in relation to any of the services within the contested application. He therefore rejected the opposition.

Grounds of the appeal

6. Intel's appeal fell broadly into two parts:
 - a. it complained of the manner in which the Hearing Officer gave effect to a letter which had been provided to it by the IPO on 9 July 2014, stating that the Registry had taken judicial notice of Intel's reputation and goodwill in the name INTEL; and
 - b. it complained of the Hearing Officer's failure to find a link between its marks and the mark applied for, and his consequential failure to find that use of the latter would take unfair advantage of or cause detriment to Intel's marks.

7. Hvivo filed a Respondent's Notice, in which it contended that even if a link should have been established, it would not have led to any unfair advantage or detriment, and contended that Intel had failed to prove a change in the economic behaviour of the average consumer or a serious likelihood of such a change in the future.

Approach to the appeal

8. A number of authorities were cited to me as to the proper approach to this appeal, but there was no real issue between the parties on this point. It was common ground that this appeal is a review not a rehearing. *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") show that neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Instead, I need to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong, as Robert Walker LJ (as he then was) said at [28] in *Reef*:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle."

9. In addition, Ms Reid, for Intel, drew my attention to the judgment of Lewison LJ in *Fage UK Ltd v Chobani UK Ltd* [2014] ETMR 26 as to the need for a judge at first instance to set out his reasoning in sufficient detail:

"114 Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them. The best known of these cases are: *Biogen Inc v Medeva Plc* [1997] R.P.C. 1; *Piglowska v Piglowski* [1999] 1 W.L.R. 1360; *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 W.L.R. 1325; *Re B (A Child) (Care Proceedings)* [2013] UKSC 33; [2013] 1 W.L.R. 1911 and most recently and comprehensively *McGraddie v McGraddie* [2013] UKSC 58; [2013] 1 W.L.R. 2477. These are all decisions either of the House of Lords or of the Supreme Court. The reasons for this approach are many. They include

- i. The expertise of a trial judge is in determining what facts are relevant to the legal issues to be decided, and what those facts are if they are disputed.
- ii. The trial is not a dress rehearsal. It is the first and last night of the show.

iii. Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court, and will seldom lead to a different outcome in an individual case.

iv. In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.

v. The atmosphere of the courtroom cannot, in any event, be recreated by reference to documents (including transcripts of evidence).

vi. Thus even if it were possible to duplicate the role of the trial judge, it cannot in practice be done.

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. ..."

I have kept all of these dicta in mind in assessing the merits of the appeal.

Merits of the appeal

1) Judicial notice

10. In its TM7 Intel relied only upon reputation in relation to certain goods identified in the document. That position was reiterated in a letter which Intel's solicitors wrote to the UKIPO on 3 July 2014:

"The Opponent relies in the opposition on the reputation of its INTEL trade mark in respect of "*Computer Software*" (UK trade mark registration no. 141 1048) and "*Computer hardware; semiconductor processors; semiconductor processor chips; and microprocessors*" (UK trade mark registration no. 2108574). We are writing to ask confirmation that the Registry will take it on judicial notice that the INTEL trade mark has a reputation for such goods.

The Applicant has conceded in its counterstatement that the INTEL trade mark has a reputation in respect of "*semiconductor processors; semiconductor processor chips and microprocessors.*"

Having referred to various decisions in which the reputation of the Intel mark had been recognised, the letter went on:

"On the above basis, we should therefore be grateful for confirmation that the Registry will similarly take it on judicial notice that the INTEL trade mark has a reputation in respect of "*Computer Software*" and "*Computer hardware; semiconductor processors; semiconductor processor chips; and microprocessors*" and that the Opponent is not required to submit evidence of this reputation. The Opponent is of course able to submit such evidence but for reasons of procedural economy it is the Opponent's position that it should not be necessary for it to do so."

The letter of 3 July, therefore, related only to specific Class 9 goods and did not relate to reputation in a wider range of goods or in any services. There is no suggestion in the letter that Intel wished to rely for the purposes of the opposition upon any reputation other than that already pleaded.

11. The response from the IPO to that letter, in a letter dated 9 July 2014, was:

"The Registry has taken on Judicial Notice that the opponent has reputation and goodwill in the name INTEL for computer related goods and services, as per the judgment of the Court of Appeal in *Intel Corporation Inc v CPM United Kingdom Ltd* [2007] ETMR 59 ...

Judicial Notice means that the opponent does not need to provide evidence to establish it has a reputation or goodwill in computer related goods or services."

12. Intel then lodged submissions dated 27 August 2014, in which it referred to the judicial notice letter and repeated Jacob LJ's comments. It did not specifically say that it intended to rely on a reputation for computer related services as well as goods, although I accept that this may have been implied by various references to goods and services.

13. The witness statement in answer of Mr Wilkes made it plain, at paragraphs 4 and 5, that the Applicant was proceeding on the basis that Intel was relying in the opposition upon its reputation only in respect of the limited range of goods identified in the TM7. I do not accept Intel's submissions (made as early as in its evidence in reply in December 2014) that the Applicant had accepted that the IPO's judicial notice letter had expanded the basis of Intel's opposition.

14. The Hearing Officer dealt with the reputation upon which Intel relied at paragraphs 11 to 12 of his decision. He said:

“11) By letter of 3 July 2014, the opponent’s representative requested conformation [sic] that the Registry was prepared to take judicial notice of the opponent’s reputation in the mark INTEL in respect of the goods relied upon. The Registry’s reply of 9 July 2014 went further than confirming this. It accepted a reputation in respect of “computer related goods and services” as per the findings of the Court of Appeal in *Intel Corporation Inc v CPM United Kingdom Ltd* [2007] ETMR 59. It was this broader description of products that Ms Reid wished to rely upon at the hearing and claiming that the opponent intentionally did not file evidence to support its reputation in respect of this broad description of products in light of the Registry’s recognition of its reputation. As I informed Ms Reid at the hearing, the opponent’s earlier marks are limited to a list of goods (and not services) and, as such, this defined the scope of what it may rely upon. Therefore, even if there is recognition that the opponent’s reputation is in respect of broader goods and services than listed in its earlier marks it is not relevant in respect of identifying the scope of reputation for the purposes of considering the case brought under Section 5(3) of the Act.

12) In light of the above, I conclude that the opponent has a significant reputation in the UK in respect of the goods it relies upon, namely *computer hardware, semiconductor processors, semiconductor processor chips, microprocessors* (page 7 of its Form TM7) and *computer software* (page 11 of its Form TM7).”

15. Intel's first point on the appeal was that the Hearing Officer had been wrong to limit its reputation in this way, and he should have considered the opposition on the basis that Intel had the far wider reputation recognised in the Court of Appeal judgment and the IPO’s letter of 9 July 2014. It claimed that the IPO had “determined the scope of the Opponent’s reputation” for the opposition, and the Hearing Officer should not have limited it.
16. Statements of case in IPO proceedings are required to provide a focused statement of the grounds on which a party relies (see e.g. *Coffeemix* [1998] R.P.C. 717). Intel’s TM7 did not plead an intention to rely upon a reputation in relation to services of any kind nor was an application made to expand the basis of the opposition. It seems to me that the terms of the TM7 must and indeed should have “determined the scope of the Opponent’s reputation” upon which it relied for the opposition. The limited claims made in the TM7 were properly reflected in Intel’s solicitors’ letter to the IPO of 3 July. Neither document suggested that Intel wished to rely upon any wider reputation in relation to a wider a range of goods or any services at all, still less that it wished to claim a reputation in the broad terms used by Jacob LJ in the passage quoted in the

TM7. Had Intel wished to expand the basis of the opposition to take advantage of the letter of 9 July, it would have had to apply to amend the TM7 to plead specifically a reputation in computer linked services, either by reference to an additional earlier trade mark registration, or by reference to its goodwill. Indeed, even in Ms Reid's skeleton argument for the hearing before the Hearing Officer she stated that the specification relied on for the opposition was for the range of goods that had been pleaded.

17. There is an important distinction to be made between the invalidity proceedings which culminated in the Court of Appeal's decision in 2007 and the present proceedings. The former were based upon a broader group of Intel marks, some of which were registered for services in Class 42. By contrast, the marks cited in this opposition are not registered for any "computer linked" services. The fact that the IPO took judicial notice of the Court of Appeal's decision and reflected the wording of its judgment in its letter rather than the more precise wording used by Intel cannot, in my view, have expanded the basis of Intel's opposition, certainly it was not a specific response to the specific inquiry made by Intel. In my view, the letter of 9 July did no more than reassure Intel that it did not need to provide evidence of its reputation in the goods relied upon in the TM7.
18. Intel presumably took a tactical decision at the outset to streamline the opposition, not to seek to rely upon all of its registered marks or the full extent of its reputation: it was seeking to protect two particular marks with a reputation for goods, not its reputation at large. In all the circumstances, there was no unfairness to Intel in the Hearing Officer's approach, but on the contrary, I consider that he was right to hold that Intel could not rely upon a reputation for a wider range of goods or services than those identified in the TM7. The appeal on this point is dismissed.

2) Procedural unfairness and similar points

19. Intel raised a second point based on the judicial notice letter. It claimed that judicial notice had also been taken of the similarity between "computer linked goods" and

“computer linked services” so that it had no need to file evidence to prove any such similarity. In the circumstances, it submitted, there was further procedural unfairness in the Hearing Officer’s approach to the assessment of similarity. I do not accept this argument either. The letter of 3 July did not seek any ruling on similarity, and the reference to computer services in the IPO’s response had nothing to do with similarity. The Hearing Officer remained obliged to decide the issues of similarity in the case and it was for Intel to provide appropriate evidence of similarity. There was no procedural unfairness in the decision in this respect, nor do I consider that Intel has identified any error in the Hearing Officer’s decision on this point. The appeal on this point is also dismissed.

20. Next, Intel complained that the Hearing Officer’s reasoning in paragraph 21 of his decision was unclear. I do not agree. The Hearing Officer said:

“21) What is clear to me is that what is offered by the opponent to the healthcare industry is its hardware technologies that have a wider application than just the healthcare industry. In this respect, I accept that its reputation extends into the healthcare sector. However, such a reputation does not extend into the type of services listed in the applicant’s Class 42 services. In this respect, I agree with Mr Malynicz that the opponent does not have a reputation in respect to all services that utilise computers. That is not a conclusion I reach from considering the evidence, nor is it a conclusion I am able to reach in light of the opponent’s two earlier marks that are only in respect of goods.”

The Hearing Officer thus accepted that Intel had proved that it had a reputation for the provision of goods in the healthcare industry, but not for services of the kind included within Class 42 of the Applicant’s specification. Perhaps his reasoning in paragraph 21 could have been better expressed, but in my view the last sentence of that paragraph explains that the Hearing Officer could not find a basis for such an extended reputation either in Intel’s evidence or in the light of its reliance upon its earlier registrations which are only for goods. This ties in with the point discussed above.

21. Again, I do not consider that Intel has identified any error in the Hearing Officer’s decision or reasoning in this regard and this Ground is dismissed.

3) Similarity of Intel's goods to the Applicant's Class 42 services

22. Next, Intel submitted that the Hearing Officer had erred in finding that there was no similarity between Intel's goods and the Applicant's Class 42 services, despite having found that Intel's goods had a reputation in the healthcare sector. It submitted that he had failed to give proper reasoning for that finding in paragraph 22 of the decision. Ms Reid pointed out the inadequacy of the Applicant's pleading in its Counter-statement on this point, but confirmed that she did not wish to "take a pleading point" on it to suggest that the Applicant could not contend that the goods/services were not similar.
23. It is helpful to start with Intel's submission (in paragraphs 8 and 15 of the Grounds of Appeal) that the Hearing Officer had failed to deal with an argument which it had advanced before him that its goods were similar to the Applicant's Class 42 services (especially when such services were provided on technology platforms) because the average consumer sees software not only as goods but also as a service - Software as a Service or "SaaS". The latter point was said to have been evidenced by an exhibit to Ms Day's 1st witness statement (RAD11).
24. It is possible (but I accept that it is not altogether clear) that this point was considered by the Hearing Officer in paragraph 20 of the decision where he referred to "Ms Reid's best efforts to argue that software in Class 9 and research are very closely linked." However, I have had some difficulty in assessing to what extent the SaaS point was argued before the Hearing Officer. It is not evident to me in the observations filed by Intel dated 27 August 2014, nor can I see the point in the skeleton argument for the hearing below, which concentrated upon the argument that the Applicant's services depend upon the use of computer technology. In the circumstances, I do not consider that the Hearing Officer must be said to have erred in failing to deal with this point, if he did so, as it seems unlikely that it was central to Intel's case as put to him.
25. Nor do I consider that the Hearing Officer made a material error in his assessment of the evidence upon which Intel relied on this point, which was a single exhibit, RAD11, containing copies of two articles published by Intel on its website. The Hearing Officer

had clearly read these documents, which he described in paragraph 5 of his decision, and at paragraph 18 he mentioned one page of the second article which showed that Intel “provides solutions for managing health record databases.” It seems to me that his summary of what RAD11 showed was an accurate one. Only the first of the articles mentioned SaaS in terms. It was apparently addressed to US consumers, and mentions SaaS in the context of cloud computing provided in the healthcare sector. It seems to me broadly to explain how various different businesses collaborate to provide secure cloud computing through the provision of a variety of goods and services, including Intel’s Xeon processors. In my view, it does not prove that the average consumer in the UK considers software as a service, far less that the average consumer would therefore be likely to consider that Intel was providing Class 42 services such as medical research services, etc. If the Hearing Officer did fail to address this argument, then it seems to me that he would have rejected it on the basis of this evidence, and rightly so. I dismiss paragraph 15 of the Grounds of Appeal.

26. Returning then to consider the Hearing Officer’s conclusions in paragraph 22, it seems clear to me that these were at least based on his findings in paragraphs 20 and 21. In paragraph 20 he considered the evidence adduced by Intel and found that Intel provides the healthcare industry with both hardware and ‘architecture solutions,’ including solutions for cloud computing designed to protect the privacy and security of stored data. This was all in line with the way in which Intel had pleaded its case in its TM7, although I am not sure that all of the points pleaded were supported by the evidence filed. Ms Reid sought to persuade me that the Hearing Officer’s reference in the first sentence of paragraph 21 only to hardware technologies suggested that he had erred by narrowing down Intel’s reputation, ignoring its computer software. I accept that he rejected the argument that Intel’s reputation extended to cover the types of Class 42 services identified in the Applicant’s specification and referred only to hardware. However, he had just identified in paragraph 20 both the hardware and software provided by Intel in the healthcare sector, and it seems unlikely that he ignored the reputation of the software in paragraph 22. Moreover, it does not seem to me that the existence of a reputation for software provided to the healthcare sector would mean that Intel’s reputation extended into the type of services listed in Class

42 of the Applicant's specification. As I have explained above, such a conclusion would not have been supported by the evidence. The same point disposes of Intel's complaint about the Hearing Officer's reference in paragraph 20 to Laddie J's decision in *Mercury*. In the circumstances, it does not seem to me that Intel has identified a material error in paragraphs 20 or 21 of the decision.

27. In paragraph 22 the Hearing Officer decided that Intel's goods were different in nature, intended purpose, and methods of use, did not share trade channels and were not competitive to the Applicant's services in Class 42. He concluded that they were not similar. Intel submitted that the Hearing Officer had erred and should have found Intel's goods/the Class 42 services to be in competition or to be complementary. Ms Reid pursued only the latter point at the hearing of the appeal, complaining that the Hearing Officer had made no reference to complementarity or to case law such as Case T-196/03, *Sergio Rossi v OHIM* [2005] ECR II-685. In that case the General Court said at [60] that relevant complementarity between goods/services exists "if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking ..."

28. Intel submitted that its evidence proved (and its observations contended) that services of the kinds in the specification applied for would normally be provided in a manner requiring substantial reliance on computers. It said that this was confirmed by the Applicant's evidence about its existing business, providing "medical research and life science services, in particular technology platforms." The Hearing Officer accepted at paragraph 17 that

"... the services listed in the Applicant's specifications of services are all services that can be provided via technology platforms. This raises the question of whether the services listed, *when provided via technology platforms*, are of a nature that use of the Applicant's mark in respect of such services would result in the necessary link being made with the opponent's mark." [*my emphasis*]

Moreover, there was some evidence (e.g. again in RAD11) of collaboration between Intel and others to provide IT “solutions” in the healthcare sector, combining goods and services.

29. The test proposed in *Sergio Rossi* has been revisited and applied in numerous cases. The most significant of these, including the decision of the CJEU of 8 May 2014 in C-411/13, *Sanco SA*, were fully analysed by Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Miss Boo trade mark* [2014] RPC 33. I need refer only to a few passages in his judgment:

“3 Both as between marks and as between goods and services, the evaluation of ‘similarity’ is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is ‘similarity’ of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer (who is taken to be reasonably well-informed and reasonably observant and circumspect) would have attached to them at the relevant point in time.

4 The factors conventionally taken to have a particular bearing on the question of ‘similarity’ between goods and services are: uses, users and the nature of the relevant goods or services; channels of distribution, position in retail outlets, competitive leanings and market segmentation: see C-39/97, *Canon* ... More than just the physical attributes of the goods and services in issue must be taken into account when forming a view on whether there is a degree of relatedness between the consumer needs and requirements fulfilled by the goods or services on one side of the issue and those fulfilled by the goods or services on the other. The relatedness or otherwise of the trading activities involved in the comparison is ultimately a matter of consumer perception.

5 That is recognised in the case law of the General Court relating to ‘complementarity’ as an element to be considered in the context of the overall assessment of ‘similarity’

...

19 The judgment of the General Court [in *Sanco*] stands for three inter-related propositions. First, as part of the overall assessment of ‘similarity’ it is necessary to consider whether there is ‘complementarity’ between the goods and services in issue. Second, there is ‘complementarity’ when the goods and services in issue are closely connected in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services. Third, ‘complementarity’ as thus defined is not adequately addressed by adopting a checklist approach to the factors

conventionally taken to have a particular bearing on the question of ‘similarity’ between goods and services: see [4] above.

...

21 ... the CJEU refuted the suggestion that the Judgment of the General Court provided for a finding of ‘similarity’ to be based solely upon the existence of ‘complementarity’. In [44] and [45] of the reasoned order it was affirmed that the General Court’s approach to the assessment of ‘similarity’ involved consideration of a variety of factors and did not proceed upon the premise that a product and a service given over to that product should automatically be regarded as ‘similar’.

22 It is clear from [43], [52] and [53], in the context of [21] and [22] of the reasoned order, that the General Court was right to require the existence of even a small (*même faible*) degree of ‘complementarity’ to be taken into account as part of the overall assessment of ‘similarity’ between goods and services. However, I do not think that detracts from the previously accepted position that a finding of ‘no similarity’ may legitimately be made despite the existence of ‘a degree of complementarity’ if ‘that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer’s point of view, the goods are similar within the terms of Art.8(1)(b) ... Taken together, the judgment of the General Court and the reasoned order of the CJEU in *Sanco SA* appear to me to confirm that it is obligatory to give effect to the propositions noted in [19] above and to do so on the basis that there is no rule that ‘complementarity’ always or necessarily equals ‘similarity’ for the purposes of art.8(1)(b) CTMR/s. 5(2)(b) of the 1994 Act.”

30. On 11 September 2014, just after Mr Hobbs QC handed down that decision, the General Court dealt again with complementarity in Case T-450/11, *Galileo International Technology LLC v OHIM*[2014] ETMR 59. I note that the Court held :

“67 ... to acknowledge similarity in all cases in which the earlier right covers computers and where the services covered by the mark applied for may use computers clearly exceeds the scope of the protection granted by the legislature to the proprietor of a trade mark (see, to that effect, Case T-336/03 *Éditions Albert René v OHIM — Orange (MOBILIX)* [2005] ECR II-4667, paragraph 69).”

31. The Hearing Officer did not expressly state whether he had considered whether the goods/services were similar because they are complementary. It is not clear to me whether that point was raised expressly before him, although Intel’s skeleton below did refer to the fact that computer hardware/software was fundamental to the provision of the Applicant’s services. Much of the evidence filed by Intel seems to me to have little bearing on the question of the objective similarity of the goods/services, because it related to the activities of a limited number of third parties. However,

hardly surprisingly, the evidence did show that computer hardware and software may be important for the provision of the relevant Class 42 services. Ms Reid submitted that in fact they are indispensable to such services and appointed to evidence which showed that the Applicant currently relies upon technology in the provision of some of those sorts of services.

32. However, it does not seem to me that the evidence can be said to establish that the result of such a close connection would be that consumers might think that the undertaking responsible for producing such hardware/software is the same as the one providing those services. Without evidence, I would not consider it at all likely that the public would think that a manufacturer of computer hardware/software was also responsible for the provision of the sorts of medical research services (medical research services; conducting clinical trials; medical laboratory services etc) in Class 42 of the Applicant's specification. If there is any complementarity, then in my judgment such complementarity would not lead to similarity.
33. In the circumstances, I do not consider that I am in a position to find that the Hearing Officer was wrong to conclude that there is no similarity between Intel's goods and the Applicant's Class 42 services. I dismiss paragraphs 8, 13 and 14 of the Grounds of Appeal.

4) Link in relation to the Class 42 services

34. Ms Reid submitted that the Hearing Officer was manifestly incorrect to find that consumers would not make a link between the parties' marks. Her first point was that he was wrong in paragraph 24 to rely upon a dictionary definition of 'intel' so as to find that "the one and only meaning" that consumers would attribute to the 'intel' part of the Applicant's mark was that it referred to intelligence or information. However, I accept the Applicant's submission that the Hearing Officer's reference to the dictionary merely supported his own view, which he had already expressed, of how that part of the mark would be perceived. The Grounds of Appeal seem to suggest that there is some significant distinction to be drawn between information and

intelligence, but I consider that this is a distinction without a difference and the Hearing Officer was clearly using the words interchangeably. I do not accept that there was any manifest error on his part in taking that view, which plainly was open to him.

35. Next, it was submitted that the Hearing Officer had misunderstood Intel's reliance upon Case T-480/12, *Coca-Cola v OHIM*, despite the fact that he cited the particular paragraph in that judgment, [74], to which Ms Reid had referred in her skeleton argument below. In paragraph 26 the Hearing Officer said that *Coca-Cola* shows that even when marks are only slightly similar a link may sometimes be established, but that is not a rigid rule and all depends upon the facts of the case. Ms Reid's complaint was that he did not also mention the point which she had emphasised below, that it may suffice for the purposes of a s 5(3) objection if "it is not altogether inconceivable" that link could be made, a phrase which has appeared not only in the *Coca-Cola* decision, but in other General Court cases, such as Case T-627/13, *The Tea Board v OHIM*, EU:T: 2015: 740, to which the parties referred me. However, the Hearing Officer cited the whole paragraph which included that phrase, and I do not think that his failure expressly to address that point in those terms necessarily shows that he misdirected himself or that there was any error on his part as to the test which he had to apply

36. I do not consider that there is any reason to think that the Hearing Officer ignored Intel's reputation in reaching his conclusions. He had accepted at paragraph 12 that Intel had a significant reputation for the goods relied upon and repeated at paragraph 13 the factors listed by the CJEU in *Intel* which he had to take into account, including the strength of the earlier mark's reputation. It is also clear from paragraph 23 of the decision, where the Hearing Officer cited Joined Cases C-581/13 and 582/13, *Intra-Press*, that he bore in mind the distinction between the degree of similarity of the marks necessary to establish a likelihood of confusion, and the lower degree of similarity which may suffice for a link to be established. In the circumstances, I do not consider that Intel has shown that the Hearing Officer erred materially simply because he did not expressly refer to the strength of Intel's reputation in paragraphs 24-26. In

my view, the decision shows the Hearing Officer's understanding of the need to decide whether a link exists by reference to all of the factors in the case.

37. Intel also complained that the Hearing Officer had given insufficient weight to the impact of its family of marks which combine Intel with another word, in each case added after Intel, e.g. "Intel Inside." No reliance was placed on these in the TM7 and I am not convinced that Intel can complain about this point at all. In any event, the Hearing Officer appears to have thought, reasonably, that the existence of these marks would not affect his conclusions as to the likelihood of a link being established. I do not consider that Intel has shown any material error in that regard.
38. In my judgment, whilst other minds might have formed a different view, the Hearing Officer was within his decision making powers in finding that the consumer would not make a link to the Intel marks when seeing the Biointel mark used in relation to Class 42 services.

5) Link in relation to the Class 35 services

39. Intel made similar complaints about the Hearing Officer's assessment of the question of the potential for a link to be made between the Intel mark and the Applicant's Class 35 services.
40. The Hearing Officer's reasoning in relation to the Class 35 services was brief. He split the range of services into two groups:

"28) ... In respect of the applicant's *investigation and research services...., statistical information..., registration services for diagnostic testing, product demonstration services...., trade information services...* and *providing results from diagnostic testing...*, these are all services where the consumer is likely to perceive the applicant's mark as an allusive reference to biological intelligence (see paragraph 24, above) and consequently, they will not make any link with the opponent or its INTEL marks.

29) The considerations in respect of the applicant's *systemisation and compilation of medical information...* and its various *collation and provision of business information...* are less clear cut and where the [...] opponent's case is strongest. This is because these services relate more closely to the general actions of business services, and may share the same intended purpose as the computer hardware and software relied upon by the opponent. Consequently, the relevant public, if exposed to the applicant's mark in respect of these services may not

quite so readily make the link to the mark's allusive meaning (discussed in paragraphs 24 and 28). This may have the effect upon increasing the likelihood of the applicant's mark being perceived as the suffix BIO being attached to the opponent's mark. However, whilst I recognise this as a possibility, it is my view that the allusive character of the applicant's mark is robust enough such that it will still be perceived by consumers as suggesting biological intelligence and not BIO plus the opponent's mark. This view is further supported by the fact that the applicant's services are limited in one form or another to being in the medical field. Consequently, the necessary link has not been established for these or any other of the applicant's Class 35 services."

41. I have distinguished in my Annex A between the services to which the Hearing Officer referred in paragraphs 28 and 29 by showing the latter in italics. However, I am unclear what exactly the Hearing Officer intended to cover by his reference in paragraph 28 to "providing results from diagnostic testing..." as that was not a discrete element of the specification. If the Hearing Officer intended to put all of the services which I have underlined in the Annex into the paragraph 28 category, that makes no sense to me, when the services in Class 29 included very similar collation services. I shall therefore treat "collation and provision of business information for the purpose of providing information services providing results from diagnostic testing in relation to medicine and pharmacy" as falling into the group of services dealt with in paragraph 29.

42. The Hearing Officer did not undertake any express analysis of the similarity or lack of similarity of Intel's goods to any of the Applicant's Class 35 services. Instead, he concentrated upon the issue of the likelihood of a link being made. The nearest that the Hearing Officer came to analysing similarity was where he explained in paragraph 29 that Intel's case was strongest in relation to the services identified in that paragraph because (in particular) they may share the same purpose as Intel's hardware and software. That suggests that the Hearing Officer considered that the group of services identified in his paragraph 28 were not similar to Intel's goods, but those in the group identified in paragraph 29 (shown in italics in Annex A) were similar to them. He presumably (though not expressly) first followed and then distinguished the analysis which had been carried out expressly in relation to the Class 42 services. The Hearing Officer did not set out his reasoning in detail. Nevertheless, it seems to me that it is possible to see the basis for the distinction which he drew and to see that his

conclusion in paragraph 28 reflects his reasoning in relation to the Class 42 services. I have concluded, with some hesitation, that there is no material error in paragraph 28.

43. The Hearing Officer then distinguished between the group of services identified in his paragraph 29 (i.e. all of those shown in italics in Annex A to this judgment) and all of the other services at issue. By stating that those services share the same intended purpose as Intel's goods, it seems clear to me that he found some level of similarity between the goods and services. However, he did not consider the various services in any detail or in smaller groups, nor did he otherwise analyse the nature or extent of any similarity. *Intel* provides that the degree of closeness between the goods and services is one of the factors relevant to the assessment of whether a link exists, and I therefore conclude that the Hearing Officer erred in failing to deal with this issue in any detail, such that I should reconsider the point.
44. In my view, the services shown in italics in Annex A fall into two groups. The first comprises the systemisation and compilation of medical information into computer databases and some computer database management services, essentially relating to the diagnosis of disease, or diagnostic testing etc, and the somewhat wider "database management of medical, hospital, insurance or billing records". The second group includes services relating to the collation and provision of business information, relating to medical, health or clinical care, or diagnostic testing in relation to medicine or pharmacy. The specification also includes the rather wider "collation and provision of business information regarding medical, hospital, insurance or billing records".
45. I agree with the Hearing Officer, whose view appears to have been that such services may share the same intended purpose as the computer hardware and software relied upon by Intel. In addition, both groups of services appear to me not only to involve the use of computer software and hardware but to be likely to be sold through the same trade channels as, in particular, software. It seems to me quite possible that a business providing such systemisation, database or information collation services to a third party would also supply the software necessary to provide the services. The users of both the services and the software might overlap and the goods and services might

be provided through the same trade channels. For these reasons, it appears to me that there is some similarity between Intel's goods and this group of Class 35 services.

46. Although the similarity between the parties' marks is relatively low, I consider that having regard to the reputation of the Intel mark and the level of similarity of the goods for which it has a reputation to this group of Class 35 services, it is not altogether inconceivable that the relevant public could make a link between the mark applied for and Intel's marks, in relation to those services. Use of the Biointel mark could bring the Intel mark to the mind of the average consumer, but not strongly so.
47. The Hearing Officer said in paragraph 30 of his decision that even if he was wrong about there being a link, the nature of the link was such that it would not result in any unfair advantage or detriment to the opponent. The only reason he gave for this conclusion was that "Any notion of a commercial link between the two marks would be quickly dismissed in favour of the allusive meaning identified ... above." By the allusive meaning, he was referring to his view, expressed at paragraph 24 decision, that the Biointel mark would be understood as referring both to biology and intelligence, which allusion has a particularly strong significance for these services which are almost exclusively directed to diagnostic testing or other medical or pharmaceutical services. That is the case, it seems to me, in relation to all of this group of services save only for the two references to services relating to "insurance or billing records."
48. Again, it seems to me that the Hearing Officer did not consider the merits of the unfair advantage/detriment arguments in sufficient detail, and it is incumbent upon me to do so now.
49. Intel contends that use of the Biointel mark would be detrimental to the distinctive character of its marks. It is a classic dilution argument: Intel says that its famous mark is strongly associated with its goods in the minds of consumers, and that the use by the Respondent of the mark applied for would have the effect of lessening the distinctiveness of the Intel mark and hence its ability to identify Intel's goods. I am not

persuaded by this argument. In the absence of any likelihood of confusion, as the Respondent contended in its Respondent's notice, what is missing is evidence of any change in the economic behaviour of the average consumer or of a serious likelihood of this. Counsel for the Respondent accepted that the Court of Justice has made it clear in *Environmental Manufacturing* that it is legitimate for the court to draw inferences from the facts and probabilities of the situation. But as Arnold J has since held, for example in *Enterprise Holdings, Inc v Europcar Group UK Limited* [2015] EWHC 17 (Ch) at [222] "it is equally clear that it is not permissible for the court simply to speculate. The dividing line between legitimate inference and impermissible speculation is not always easy to discern." I accept, of course, that it is particularly difficult to produce evidence of possible future detriment where a mark has been applied for but has not been used or has not been much used. However, it does seem to me that to accept the arguments presented by Ms Reid on behalf of Intel would require me to embark upon impermissible speculation as to potential future damage to the Intel marks. For this reason, I reject the objection on the basis of detriment.

50. The basis of a claim based upon unfair advantage was set out by Arnold J in *Jack Wills Ltd v House of Fraser (Stores) Ltd* [2014] EWHC 110 (Ch); [2014] E.T.M.R. 28 at [75]-[83], citing, in particular, the relevant parts of *L'Oréal SA v Bellure*. At [44] of that judgment, the CJEU had made it clear that the assessment of unfair advantage requires a global assessment of all the circumstances of the case:

"In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the degree of distinctive character of the mark, the degree of similarity between the marks at issue and the nature and degree of proximity of the goods or services concerned."

At [80] Arnold J said:

"It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the

reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

At [82] Arnold J referred to the requirement for the unfair advantage to lead to some change in the behaviour of the defendant’s consumers as a result of the use of the allegedly infringing sign, or a serious likelihood of such a change. This may again be established by logical deductions, but (again) not be mere supposition.

51. In my view, there is no more here than supposition that the image of the Intel goods marks will be transferred to the services covered by the mark applied for, making it easier to market the Biointel services by that association with Intel. In all of the circumstances of this case, and especially the allusive nature of the mark applied for, its low level of similarity to the Intel mark and the nature of the services involved, it does not seem to me that I can deduce that the use of the Biointel mark in relation to the Class 35 services would take unfair advantage of the Intel marks.
52. I appreciate that the position is a little different for the services which relate to insurance or billing records, and are not directly linked to medical or diagnostic services, but on balance it still seems to me that the s 5(3) objection fails in respect of those services.
53. For all of these reasons, the appeal is dismissed and the application, as amended, may proceed to registration. I will order the Appellant to make a contribution towards the Respondent’s costs of the appeal in the sum of £1200 to be paid within 14 days.

Amanda Michaels
The Appointed Person
22 February 2016

Ms Jacqueline Reid (instructed by Nabarro LLP) appeared for the Appellant

Mr Simon Malynicz (instructed by Groom Wilkes & Wright LLP) appeared for the Respondent

ANNEX A

BIOINTEL application No. 3034581:

Filed 12 December 2013

Class 35: Investigation and research services relating to cost and business efficiency, all relating to pharmaceuticals, medicine, medicines, vaccines, science, bacteriology, toxicology, chemistry, clinicology, oncology, biochemistry and biotechnology; *systemisation and compilation of medical information into computer databases*; statistical information all relating to pharmaceuticals, medicine, medicines, vaccines, science, bacteriology, toxicology, chemistry, clinicology, oncology, biochemistry and biotechnology; registration services for diagnostic testing; product demonstration services in the field of diagnostic testing; *computer database management services, [including for] information storage and retrieval services in the fields of diagnostic testing and preparations for the treatment, monitoring or diagnosis of disease*; trade information services in the fields of medical, health, or clinical care; *database management of diagnostic testing and results, database management of medical, hospital, insurance or billing records; collation and provision of business information for the purpose of providing referral services in the fields of medical, health or clinical care; collation and provision of business information for the purpose of providing information services providing results from diagnostic testing in relation to medicine and pharmacy; collation and provision of business information regarding medical and pharmaceutical testing procedures; collation and provision of business information for the regarding disease conditions and disease prevention; collation and provision of business information regarding medical, hospital, insurance or billing records.*

Class 42: Medical research services; conducting clinical trials; medical laboratory services; medical laboratory services for the analysis of samples taken from patients; scientific analysis and research services; product development relating to pharmaceuticals, medicines, medicaments and veterinary products; medical and health care testing services, namely clinical testing services, physician testing services for assisting pharmacists, pharmacy testing services, medical laboratory and testing services; medical research into the causes and treatment of influenza and the common cold.

ANNEX B

INTEL's earlier marks:

1411048 INTEL

Filed 12 January 1990

Registered 18 April 1995

Class 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.

2108574 INTEL

Filed 28 August 1996

Registered 17 March 2000

Class 9: Computer operating system software; computer operating programs; computer system extensions; computer system tools; computer system utilities; computer application software; computer firmware; computer hardware; integrated circuits; integrated circuit chips; semiconductor processors; semiconductor processor chips; microprocessors; printed circuit boards; electronic circuit boards; computer memory devices; semiconductor memory devices; video circuit boards; audio circuit boards; audio-video circuit boards; video graphic accelerators; multimedia accelerators; video processors; fax/modems; computer hardware and software for the transmission and receipt of facsimiles; computer hardware and software for the development, maintenance, and use of local and wide area computer networks; computer hardware and software for the development, maintenance, and use of interactive audio-video computer conference systems; computer hardware and software for the receipt, display, and use of broadcast video, audio, and digital data signals; and computer hardware and software for development, testing, programming, and production of all the foregoing.

Class 16: Printed materials, namely publications, periodicals, journals, operating manuals, user guides, pamphlets, and brochures about, for use with, and directed to users of, computer operating system software, computer operating programs, computer system extensions, computer system tools, computer system utilities, computer application software, computer firmware, computer hardware, integrated circuits, integrated circuit chips, semiconductor processors, semiconductor processor chips, microprocessors, printed circuit boards, electronic circuit boards, computer memory devices, semiconductor memory devices, video circuit boards, audio circuit boards, audio-video circuit boards, video graphic accelerators, multimedia accelerators, video processors, fax/modems, computer hardware and software for the transmission and receipt of facsimiles, computer hardware and software for the development, maintenance, and use of local and wide area computer networks, computer hardware and software for development, maintenance, and use of interactive, audio-video computer conference systems, computer hardware and software for the receipt, display, and use of broadcast video, audio, and digital data signals, and computer hardware and software for development, testing, programming, and production of all of the foregoing.

Class 38: Telecommunications, multimedia communications, and digital communications services, namely broadcast, transmission, and receipt of interactive and non-interactive audio, video, and digital signals; electronic transmission and receipt of interactive and non-interactive voice, data, images, paging messages, facsimiles, and information; teleconferencing services; videoconferencing services.