

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2229067
BY DIGITALL INC
TO REGISTER THE TRADE MARK:**



IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER No 51915
BY INTEL CORPORATION
BASED UPON THE EARLIER TRADE MARK:**



AND OTHERS

TRADE MARKS ACT 1994

**In the matter of application no 2229067
by Digitall Inc
to register a trade mark in class 9
and the opposition thereto under no 51915
by Intel Corporation**

BACKGROUND

1) On 12 April 2000 Digitall Inc (referred to afterwards as Digitall) applied to register the trade mark:



The application was published in the "Trade Marks Journal" for opposition purposes on 20 September 2000 with the following specification:

coin-operated apparatus and systems

The above goods are in class 9 of the International Classification of Goods and Services.

2) On 20 December 2000 Intel Corporation (referred to afterwards as Intel) filed a notice of opposition to this application.

3) Intel states that it is the owner of the following trade mark registrations:

- United Kingdom trade mark registration no 1466900 of the trade mark:



It was filed on 10 June 1991 and registered on 24 February 1995 for the following goods:

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

The above goods are in class 9 of the International Classification of Goods and Services.

The registration includes the following disclaimer: "Registration of this mark shall give no right to the exclusive use of the word "Inside".

- United Kingdom trade mark registration no 2108759 of the trade mark **INTEL INSIDE**. It was filed on 28 August 1996 and registered on 11 July 1997 for the following goods and services:

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 of the foregoing

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 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

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

The above goods and services are in classes 9, 16 and 38 respectively of the International Classification of Goods and Services.

- United Kingdom trade mark registration no 2108775 of the trade mark:



It was filed on 28 August 1996 and registered on 11 July 1997 for the same goods and services as registration no 2108759 above.

- United Kingdom trade mark registration no 2200613 of the trade mark:



It was filed on 17 June 1999 and registered on 9 June 2000 for the following goods and services:

photographic and cinematographic apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment; computers; computer software; computer hardware; computer firmware; computer workstations; notebook and laptop computers; portable computers; servers; semiconductors; microprocessors; integrated circuits; microcomputers; computer chipsets; computer motherboards and daughterboards; computer graphics boards; networking hardware; computer network adapters, switches, routers and hubs; computer peripherals and electronic apparatus for use with computers; keyboards; trackballs; computer mouse devices; computer input devices; monitors; video apparatus; video circuit boards; video systems products; apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data; algorithms for the compression and decompression of data;

computer component testing and calibrating apparatus; set-top boxes; computer programs for network management; computer utility programs; computer operating system software; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sounds, video, images, graphics, and data; computer programs for web page design; computer programs for accessing and using the Internet; telecommunications apparatus and instruments; apparatus and equipment for use in video conferencing, teleconferencing, document exchange and editing; cameras; headsets; parts, fittings, and testing apparatus for all the aforesaid goods; electronic manuals for use with all the aforesaid goods

printed matter; publications, books, periodicals, newsletters, magazines, brochures, pamphlets and user manuals related to the computer industry, computer hardware, computer software, computer peripherals, computer components, computer-related services, and/or communications goods and services; instructional matter, teaching aids and manuals; paper; stationery; writing paper; notepads; computer paper; and paper tape and cards for the recordal of computer programs

communications services; but not including satellite transmission services; providing access to global computer networks; electronic transmission of messages, web pages, computer programs and any other data; electronic mail services; provision of telecommunications access and links to computer databases and the Internet; providing multiple user access to computer networks and bulletin boards for the transfer and dissemination of a wide range of information; consultancy services relating to communications, video-conferencing and communications and video-conferencing apparatus; information, advisory and consultancy services relating to all of the above services including such services provided on-line or via the Internet

computer-related services namely, installation, repair, maintenance, support and consulting services for computer-related goods; providing information in the field of computer technology via the Internet; Internet consulting services, particularly by providing access to global computer networks for interactive use and similar services; consultancy, design, testing, research and advisory services, all relating to computing and computer programming; support services relating to computer hardware, computer software and computer networks; computer services; providing multiple user access to computer networks and bulletin boards for the transfer and dissemination of a wide range of information; providing and leasing access time to computer databases, computer bulletin boards, computer networks, and interactive computer communications networks, providing on-line facilities for real-time interaction with other computer users over computer networks or the Internet; providing information on the installation, use, configuration, repair, maintenance, support, upgrading and updating of computer software, computer networks, videoconferencing and communications related goods; consulting services for computer hardware, computer software, computer network, videoconferencing and communications equipment; providing on-line publications, namely books, brochures, white papers, technical papers, catalogues and pamphlets in the fields of computing and information technology designing standards and/or specifications for use by others in the fields of computer hardware, computer software, computer network, teleconferencing and communications equipment; design services for computer software, computer hardware and computer networks; information, advisory and consultancy services

relating to the aforesaid including such services provided on-line or via the Internet

The above goods and services are in classes 9, 16, 38 and 42 respectively of the International Classification of Goods and Services.

- United Kingdom trade mark registration no 2204440 of the trade mark **INTEL THE COMPUTER INSIDE**. It was filed on 29 July 1999 and registered on 14 January 2000 for the same goods in classes 9 and 16 as registration no 2108759 above.
- Community trade mark registration no 539 of the trade mark:



It was filed on 1 April 1996 and registered on 15 October 1997 for the following goods and services:

computers; computer hardware; computer software; computer firmware; semiconductors; electronic, electrical and electromechanical apparatus for use with computers; video apparatus; video circuit boards; video systems products; apparatus and equipment for recordal, reproduction and alteration of sound, video and data; sound, video and data recordings; 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

printed matter; books; periodicals; newsletters; magazines; brochures; pamphlets; instructional matter, teaching aids and manuals; paper; stationery; writing paper; notepads; computer paper; paper tape and cards for the recordal of computer programmes; office requisites; storage boxes, cabinets, racks, trays, baskets, holders for discs, all being office requisites; parts and fittings for all the aforesaid goods

communication services

computer services

The above goods and services are in classes 9, 16, 38 and 42 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 658575 of the trade mark **INTEL INSIDE**. It was filed on 20 October 1997 and registered on 17 April 2000 for the following goods:

radio alarm clocks

precious metals and their alloys and goods in precious metals or coated therewith; jewellery; watches and measuring instruments; clocks; bracelets; buckles; charms; cuff links; earrings; key rings; chains; scarf pins; brooches; money clips; napkin rings; pendants; money boxes; decorations for shoes; tie pins; trophies; alarm clocks; buttons and holders for all the aforesaid goods

printed matter; writing paper; periodicals; instructional material; ring binders; book ends; bookmarks; pen trays; calendars; writing pads; cards; blocks of paper; pens; pencils; folders; paperweights; pen and pencil holders; photograph frames; rulers; school requisites; giftwrap; erasers; felt-tip pens; wax crayons; chalk; handicraft materials; desk sets; bumper stickers

leather and imitations of leather, and goods made of these materials; travelling bags; luggage; satchels; rucksacks; beach bags; pocket wallets; purses; kit bags; umbrellas

household or kitchen utensils; mugs; cups; glasses; water bottles

clothing; shoes; hats and caps; T-shirts; shirts; vests; beach clothing; casual wear; pants; leather jackets; sweaters; sports shirts; tracksuits; kerchiefs; jackets; trousers; shorts; neckties; shawls; neckties; knitted jackets; suits; gloves; fitness clothing; hats; jackets; tracksuits; shawls; polo shirts; neckties; aprons; socks; sun visors

games and playthings; gymnastic and sporting articles; soft toys; plush toys; puppets; dolls; toys filled with beans or similar fillings; board games; video games; portable computer games; toy vehicles; seasonal decorations

The above goods are in classes 9, 14, 16, 18, 21, 25 and 28 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 897793 of the trade mark **INSIDE**. It was filed on 5 August 1998 and registered on 12 May 2000 for the following goods and services:

computers; computer hardware; computer firmware; semiconductors; microprocessors; integrated circuits; microcomputers; computer chipsets; computer motherboards and daughterboards; computer graphics boards; networking hardware; computer network adapters, switches, routers and hubs; computer peripherals and electronic apparatus for use with computers; keyboards; trackballs; computer mouse devices; computer input devices; monitors; video apparatus; video circuit boards; video systems products; apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data; algorithms for the compression and decompression of data, computer component testing and calibrating apparatus; set-top boxes; computer programs for network management; computer utility programs; computer operating system software; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sound, video, images,

graphics, and data; computer programs for web page design; computer programs for accessing and using the internet; telecommunications apparatus and instruments; apparatus and equipment for use in video-conferencing, teleconferencing, document exchange and editing; cameras; headsets; parts; fittings, and testing apparatus for all the aforesaid goods

telecommunication services

computer-related and communications-related services, namely, updating of computer hard and software, maintenance, support and consulting services for computer-related and communications-related goods; providing information in the field of computer technology via the internet; providing and posting electronic versions of documents on-line, namely, books, brochures, white papers, catalogs and pamphlets in the fields of computer and information technology; designing standards for use by others in the design and implementation of computer software, computer hardware and telecommunications equipment; computer software, computer hardware and network design services for others

The above goods and services are in classes 9, 38 and 42 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1277607 of the trade mark **THE COMPUTER INSIDE**. It was filed on 13 August 1999 and registered on 13 November 2000 for the following goods and services:

data processing apparatus; computers and parts therefor; computer software; computer programs; apparatus for telecommunications including internet communications; 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; computer hardware and software for development, testing, programming, and production of all of the foregoing; electronic format publications including user manuals, books, brochures, white papers, catalogs and pamphlets in the fields of computer and information technology

printed publications including printed publications regarding data processing, computers, telecommunications, software, internet; printed materials, namely publications, periodicals, journals, operating manuals, user guides, pamphlets, and brochures about, for use with, and directed to users of, computer operating systems 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; computer hardware and software for development, testing, programming, and production of all of the foregoing

computer-related and communications-related services, including installation, repair, maintenance, support and consulting services for computer-related and communications-related goods; organization and management of on-line catalogue and mail order services for computer-related and communications-related goods and services; organization and management of retail services for computer-related and communications-related goods and services; on-line processing of information relating to the delivery of computer-related and communications-related goods and services; organization and management of internet sites for providing information in the field of computer technology; organization of on-line publication services including books, brochures, white papers, catalogues and pamphlets, in the fields of computer and information technology; designing standards for use by others in the design and implementation of computer software, computer hardware and telecommunications equipment; computer software, computer hardware and network design services for others

The above goods and services are in classes 9, 16, and 42 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1216225 of the trade mark:



It was filed on 22 June 1999 and registered on 28 March 2001 for the following goods and services:

computers; computer hardware; computer workstations; notebook and laptop computers, portable computers, microcomputers; servers, computer firmware; semiconductors; microprocessors; integrated circuits; computer chipsets; computer motherboards and daughterboards; computer graphics boards; networking hardware; computer network adapters, switches, routers and hubs; computer peripherals and electronic apparatus for use with computers; keyboards; trackballs; computer mouse

devices; computer input devices; monitors; video apparatus; video circuit boards; video systems products; apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data; algorithms for the compression and decompression of data; computer component testing and calibrating apparatus; set-top boxes; computer programs for network management; computer utility programs; computer operating system software; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sound, video, images, graphics, and data; computer programs for web page design; computer programs for accessing and using the Internet; telecommunications apparatus and instruments; apparatus and equipment for use in video-conferencing, teleconferencing, document exchange and editing; cameras, headsets; parts, fittings, and testing apparatus for all the aforesaid goods; and user manuals for use with, and sold as a unit with, all the aforesaid goods

printed matter, namely, publications, books, periodicals, newsletters, magazines, brochures, pamphlets and user manuals related to the computer industry, computer hardware, computer software, computer peripherals, computer components, computer-related services, and/or communications goods and services; instructional matter, teaching aids and manuals; paper; stationery; writing paper; notepads; computer paper; and paper tape and cards for the recordal of computer programs

computer-related and communications-related services, namely, installation, repair, maintenance, support and consulting services for computer-related and communications-related goods; organization and management of computerized on-line catalogue and mail order services for computer hardware, computer software, computer network, teleconferencing and communications-related goods and services; providing information in the field of computer technology via the Internet; providing on-line publications; namely, books, brochures, white papers, catalogues and pamphlets in the fields of computer and information technology; designing standards for use by others in the design and implementation of computer software, computer hardware and telecommunications equipment; computer software, computer hardware and network design services for others

The above goods and services are in classes 9, 16, and 42 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1241520 of the trade mark **INTEL INSIDE XEON**. It was filed on 9 July 1999 and registered on 27 November 2000 for the following goods and services:

computers; computer hardware; computer workstations; notebook and laptop computers; portable computers; microcomputers; servers; computer firmware; semiconductors; microprocessors; integrated circuits; computer chipsets; computer motherboards and daughterboards; computer graphics boards; networking hardware; computer network adapters, switches, routers and hubs; computer peripherals and electronic apparatus for use with computers; keyboards; trackballs; computer mouse devices; computer input devices; monitors; video apparatus; video circuit boards; video systems products; apparatus and equipment for recording, processing, receiving,

reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data; algorithms for the compression and decompression of data; computer component testing and calibrating apparatus; set-top boxes; computer programs for network management; computer utility programs; computer operating system software; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sound, video, images, graphics, and data; computer programs for web page design; computer programs for accessing and using the Internet; telecommunications apparatus and instruments; apparatus and equipment for use in video-conferencing, teleconferencing, document exchange and editing; cameras; headsets; parts, fittings, and testing apparatus for all the aforesaid goods; and user manuals for use with, and sold as a unit with, all the aforesaid goods, in international class 9

user manuals for use with, and sold as a unit with computers, computer hardware, computer workstations, notebook and laptop computers, portable computers, microcomputers, servers, computer firmware, semiconductors, microprocessors, integrated circuits, computer chipsets, computer motherboards and daughterboards, computer graphics boards, networking hardware; computer network adapters, switches, routers and hubs; computer peripherals and electronic apparatus for use with computers, keyboards, trackballs, computer mouse devices, computer input devices, monitors, video apparatus, video circuit boards, video systems products, apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data, algorithms for the compression and decompression of data, computer component testing and calibrating apparatus, set-top boxes, computer programs for network management, computer utility programs, computer operating system software, computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sound, video, images, graphics, and data, computer programs for web page design, computer programs for accessing and using the Internet, telecommunications apparatus and instruments, apparatus and equipment for use in video-conferencing, teleconferencing, document exchange and editing, cameras, headsets, parts, fittings, and testing apparatus for all the aforesaid goods

The above goods are in classes 9 and 16 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1532571 of the trade mark **INSIDE**. It was filed on 29 February 2000 and registered on 11 October 2002 for the following goods:

surgical, medical, dental and veterinary apparatus and instruments

vehicles; apparatus for locomotion by land, air or water

The above goods are in classes 10 and 12 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1531904 of the trade mark **INSIDE**. It was

filed on 29 February 2000 and registered on 4 April 2002 for the following goods and services:

toys, stuffed toys, plush toys, puppets, dolls, bean bags, games, board games, video games, toy vehicles and seasonal ornamentation

beer, ale and porter; mineral and aerated waters and other non alcoholic drinks; syrups and other preparations for making beverages

advertising and business services

The above goods are in classes 28, 32 and 35 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1532365 of the trade mark **INSIDE**. It was filed on 29 February 2000 and registered on 20 March 2002 for the following services:

computerized on-line catalog and mail order services for computer hardware, computer software, computer network, teleconferencing and communications related goods and services and general consumer goods; retail services for computer hardware, computer software, computer network, teleconferencing and communications related goods and services and general consumer goods

construction and repair; providing information on the installation, configuration, repair, maintenance, support, upgrading and updating of computer hardware, videoconferencing and communication related goods

providing information on the use, configuration, support, upgrading and updating of videoconferencing and communication related goods

educational services, namely conducting classes, seminars, conferences, and workshops in the field of computer and software use, Internet navigation, computer management, and computer purchases and distributing course materials in connection therewith; education and entertainment services relating to computers and computer consultancy; provision of interactive and non-interactive electronic information services in the fields of education and entertainment all relating to computers and computer consultancy; providing on-line publications namely books, brochures, technical papers, catalogs and pamphlets in the field of computing and information technology and general consumer goods

internet consulting services, particularly by providing access to global computer networks for interactive use; computer services, namely the leasing of access time for multiple user access to computer networks and bulletin boards for the transfer and dissemination of a wide range of information; providing and leasing access time to computer databases, computer bulletin boards, computer networks, and interactive computer communications networks all in the fields of information technology, computing, computer hardware, computer software, computer installation, computer repair, computer maintenance, computer support, computer security, teleconferencing, business, finance, games, music, multimedia, graphics, education, entertainment, theatre, movies, news, weather, sports, travel, lifestyles, shopping, hobbies and general

interests; providing on-line facilities for real-time interaction with other computer users; providing information on the installation, use, configuration, repair, maintenance, support, upgrading and updating of computer software and computer networks; consulting services for computer hardware, computer software, computer network, videoconferencing and communications equipment; designing standards and/or specifications for use by other in the fields of computer hardware, computer software, computer network, teleconferencing and communications equipment; design services for computer software, computer hardware and computer networks, in international class 42

The above services are in classes 35, 37, 38, 41 and 42 respectively of the International Classification of Goods and Services.

- Community trade mark registration no 1534411 of the trade mark **THE JOURNEY INSIDE**. It was filed on 1 March 2000 and registered on 5 February 2001 for the following services in class 41 of the International Classification of Goods and Services:

educational services, including conducting classes, seminars, conferences, and workshops in the field of computer and software use, Internet navigation, computer management, and computer purchases and distributing course materials in connection therewith; education and entertainment services; provision of interactive and non-interactive electronic information services via a world wide computer network, including Internet in the fields of education and entertainment

4) Intel states that it is also the owner of Community trade mark application no 1531755 for the trade mark **INSIDE**. This application was filed on 29 February 2000 for the following goods:

pharmaceutical, veterinary, and sanitary substances; infants and invalids foods; plasters, material for bandaging; material for stopping teeth, dental wax, disinfectants; preparations for killing weeds and destroying vermin

unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway tracks; chains; cables and wires; locksmith's work; metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in non precious metal not included in other classes; ores

machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators

The above goods are in classes 5, 6 and 7 respectively of the International Classification of Goods and Services.

5) Intel also states that it is the owner of United Kingdom trade mark application no 2202800. However, since the filing of the opposition this application has been withdrawn.

6) Intel states that trade marks listed above have been used continuously since at least the application dates for the goods that they encompass. It states that Intel began using the trade

mark INTEL INSIDE in 1991 and invested millions of US dollars launching the INTEL INSIDE program. Intel states that INTEL INSIDE and the format “_____ INSIDE” are popular, well-known and associated exclusively with itself. Intel states that it has established a family of trade marks that have contributed to the association of INSIDE and the “_____ INSIDE” format with itself and its INTEL INSIDE trade mark.

7) Intel states that Digitall’s trade mark (the trade mark) should be refused under section 5(2)(b) of the Trade Marks Act 1994 (the Act). It states that the trade mark is similar to its earlier trade marks and some of the goods in the specifications are identical to the goods of the application and some are similar to the goods of the application. Intel states that the goods of the application are identical to *automatic vending machines and mechanisms for coin-operated apparatus*” of United Kingdom trade mark registration no 2200613. Intel states that the goods of the application are similar to *apparatus and instruments, all for processing, storage, retrieval, transmission, display, input, output and printout of data*” of United Kingdom trade mark registration no 1466900.

8) Intel states that in the alternative the application should be refused under section 5(3) of the Act because the trade mark is similar to its earlier trade marks, being trade marks with a reputation in the United Kingdom, and use of the trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of its earlier trade marks.

9) Intel states that the application should be refused under section 5(4)(a) of the Act, in particular the law of passing-off, due to its common law rights in the trade marks listed in paragraphs 3 and 4.

10) Intel seeks refusal of the application either partially or in its entirety, as the registrar may see fit and seeks an award of costs.

11) Digitall filed a counterstatement in which it denies the grounds of opposition. In particular it states that the only common element between the respective trade marks is the element INSIDE in which Intel cannot claim a monopoly. Digitall also states that *apparatus and instruments, all for processing, storage, retrieval, transmission, display, input, output and printout of data* are not similar to the goods of the application.

12) Digitall requests that the opposition is dismissed and seeks an award of costs.

13) The case was heard on 12 February 2003. Intel was represented by Mr Mellor of counsel, instructed by Frank B Dehn & Co and Eversheds. Digitall was represented by Mr Panzeri and Mr O’Dwyer, both from Digitall. Mr Panzeri and Mr O’Dwyer are not professional legal representatives.

EVIDENCE

Main evidence of Intel

14) This consists of a witness statement by Benoit Philippe. Mr Philippe is an attorney at Intel Corporation (UK) Ltd, he is responsible for Intel’s trade marks in Europe, the Middle East and Africa.

15) Mr Philippe begins his evidence by giving a background to Intel. His main points are as follows:

- Intel was founded in 1961 to build semiconductor memory products. At the end of 1971 Intel's Dynamic Random Access Memory (DRAM) was the world's largest selling semiconductor device.
- Intel created the world's first manufacturable microprocessors, the 4004. In 1979 IBM decided to build its first personal computer (PC) using Intel's microprocessors.
- Intel's products are currently used in a wide variety of industries and within virtually all computerised applications including computers, mainframes, desktops, laptops, handheld devices and cellular telephones.
- Intel's business has expanded to include software/operating systems/compilers in 1978, networking peripherals in 1982, workstations and servers in 1984, motherboards in 1985, flash memory and chip sets in 1990, imaging/graphics and digital imaging products and services in 1991.
- Intel has expanded its business to include branded consumer products such as PC accessories, publications, software, clothing items and accessories, luggage and travelling gear, toys, musical devices, scientific instruments, video cameras, writing implements and watches.
- Intel has expanded the services it offers to include educational services, training services, web design and computer consulting services and financial services and a broad range of computer, Internet, communication and e-commerce related services.

16) Mr Philippe states that Intel began using the INTEL INSIDE trade mark in July 1991. He states that since 1991 Intel has sought formal protection for INTEL INSIDE in every country that offers trade mark protection.

17) Mr Philippe states that Intel has used the trade mark THE COMPUTER INSIDE since 1991 in connection with hardware products. He states that THE JOURNEY INSIDE has been used since 1994 in association with educational services. Mr Philippe exhibits a schedule of Intel's applications and registrations worldwide for INTEL INSIDE trade marks and "_____ INSIDE" trade marks. He states that these trade marks are collectively referred to as the "INTEL INSIDE marks".

18) Mr Philippe states that consumers in all market segments have seen Intel's and its licensees' advertising and promotion of the INTEL INSIDE trade mark through extensive print and television campaigns. He states that since the inception of the INTEL INSIDE program advertisements carrying the INTEL INSIDE logo have created over 500 billion impressions on consumers. Mr Philippe does not indicate how this figure has been arrived at or by whom. He also does not advise what is meant by creating an impression.

19) Mr Philippe lists various trade marks which he describes as being "_____ INSIDE" trade marks which are registered in the United Kingdom or as Community trade marks. All of these registrations form part of Intel's ground of opposition.

20) Mr Philippe states that because microprocessors are ubiquitous Intel's goods play a rôle in almost every walk of life. Mr Philippe states that Intel's microcontrollers, special purpose chips that are programmed to control specific functions in other products, can be found in a range of goods including coin-operated machines such as arcade style gaming machines. Mr Philippe exhibits at BP3 documentation which he states shows Intel's involvement with arcade

style gaming machines.

21) Mr Philippe states that Intel microprocessors are embedded in numerous products sold and advertised in the United Kingdom. He states that such products are branded with “_____ INSIDE” trade marks. He states that the INTEL INSIDE trade mark is used in the United Kingdom through display at the point of sale and on personal computers and servers containing Intel microprocessors. Mr Philippe states that personal computers containing Intel microprocessors bear a label fixed to the outside of the computer. He states that the label is produced to exact specifications set by Intel which stipulate where the label is to be used, its colour, size etc. Mr Philippe exhibits at BP4 copies of samples of labels, printed specifications and product packaging showing how INTEL INSIDE is used on computer products.

22) Mr Philippe states that Intel began using the INTEL INSIDE trade mark in 1991 when it launched the “Intel Inside Program”. He states that this program was a combined logo licensing and co-operative advertising program that marketed PCs containing INTEL microprocessors directly to the end user instead of marketing microprocessors solely to the original equipment manufacturers. Under the INTEL INSIDE program, original equipment manufacturers (OEMs), as licensees, assemble products that integrate INTEL microprocessors.

23) Mr Philippe states that “this was the first time that a “component” or “ingredient” manufacturer in the computer industry reached out to the ultimate customer, convincing customers to look out for the INTEL brand when buying a personal computer”. Mr Philippe states that Intel indicated that there was an INTEL component within the computer by using the INTEL INSIDE trade mark and logo. Mr Philippe exhibits an article from an intranet site about the tenth anniversary of the INTEL INSIDE program. This article gives the history of the INTEL INSIDE program.

24) Mr Philippe states the INTEL INSIDE program now has over 40,000 licensees worldwide. He states that these licensees range from OEMs, including the world’s largest computer makers and smaller computer makers, to computer resellers and retailers. Mr Philippe states that as a result the INTEL INSIDE logo appears directly on “millions and millions of home, business, government, and school computers worldwide as well as in all forms of advertising and promotions used by the computer makers and resellers”.

25) Mr Philippe states that since the start of the INTEL INSIDE program in 1991 Intel has reimbursed over 3.5 billion dollars (US) in advertising expenditure to its licensees. He states that in most cases, because Intel’s reimbursement only covers a portion of the licensees’ total advertising costs, the licensees spend an equal amount approximately.

26) Mr Philippe states that Intel has reimbursed its INTEL INSIDE licensees the following amounts (in US dollars):

1992	1,170,000
1993	2,700,000
1994	3,300,000
1995	7,300,000
1996	14,100,000
1997	40,600,000

1998 42,800,000
1999 30,700,000
2000 64,500,000
2001 27,200,000 (up to July)

The date of the application (the relevant date) is 12 April 2000. Consequently, expenditure after this date does not have a bearing upon the case. Mr Philippe states that the above figures do not include monies spent by United Kingdom INTEL INSIDE licensees for goods bearing the INTEL INSIDE trade mark. Mr Philippe does not directly state that the above figures relate to the United Kingdom. However, within the context of his other statements and comments I consider that this is the inevitable conclusion.

27) Mr Philippe exhibits what he describes as a representative example of advertisements placed by licensees. The first few examples appear to be North American usage rather than United Kingdom usage. All of the United Kingdom material is from 1994 and 1995. With the exception of three examples all the United Kingdom material shows use of the trade mark:



with a reference, outside of the trade mark, to a Pentium processor of some description. All of the material relates to computers of some type eg personal computers and laptops.

28) Mr Philippe states that fifty-three per cent of consumers spontaneously named INTEL when asked to name a producer of microprocessors. Mr Philippe does not exhibit any documentation in relation to this claim.

29) Mr Philippe states that OEMs place INTEL INSIDE trade marks prominently on the outside of many millions of PCs where the consumer can see it. He comments that companies such as Dell, Compaq and Gateway use INTEL INSIDE trade marks on their goods and in advertising. Mr Philippe states that many retailers are members of the INTEL INSIDE program. He states that these retailers use INTEL INSIDE trade marks in a variety of ways to promote the "qualifying" products which they sell. He states that these retailers sell in traditional shops and also are "e-tailers" or on on-line retailers. Mr Philippe states that Dixons, PC World, Tempo, John Lewis Partnership and Comet are examples of such retailers.

30) Mr Philippe states that INTEL INSIDE trade marks are displayed throughout Intel's website and in association with specific computer software and Internet service.

31) Mr Philippe states that Intel has for many years sold a wide variety of non-computer products which can be seen at Intel's on-line store, SHOP INTEL, which he states is a revenue producing business which is more than merely selling promotional items. Mr Philippe states that the products include clothing, desk accessories, watches, dolls and novelty items. Mr Philippe gives two web addresses from where non-computer related products can be purchased. He exhibits at BP7 and BP8 various materials relating to these goods. In BP7 there is a Uniquely Intel Shop catalogue for spring/summer 1999. This shows such things as playing cards, pens, t-shirts, mouse mates, caps, American footballs, mugs, key rings, polo

shirts, bags and watches bearing an INTEL INSIDE trade mark. There is catalogue for fall/winter 1999/2000 In this catalogue the following is written:

“Being dedicated to Uniquely Intel means that your Personal Shopper will help you to select appropriately Intel branded merchandise for your next event, sales meeting or employee incentive program. Customize merchandise with a special event logo.”

The catalogues give an employee price and a retail price – all in dollars. The clothes sizes are only in one form – ie US sizes. They refer to Canadian and other international orders. The order form at its second line has a space for company name.

32) Everything in the catalogue, despite the claims of Mr Philippe, indicates that the goods are primarily for promotional use and use in North America – down to the use of fall instead of autumn. Mr Philippe produces no figures to show any sales in the United Kingdom.

33) Exhibit BP8 consists of pages downloaded from the Shop Intel website. The pages were downloaded on 21 September 2001 and so well after the relevant date. As well as emanating from outside the relevant date there is nothing in them that contradicts the impression created by the catalogues.

34) Mr Philippe states that Intel’s approximate annual turnover in goods and services in the United Kingdom from 1990-2000 was at least the following (figures in United States dollars):

1990	138 million
1990	166 million
1991	257 million
1992	508 million
1993	629 million
1994	928 million
1995	1,309 million
1996	1,585 million
1997	1,428 million
1998	1,425 million
2000	1,398 million

No explanation is given as to why there are two figures quoted for 1990. Mr Philippe states that the figures includes sales of goods bearing INTEL INSIDE trade marks. He states that the INTEL INSIDE United Kingdom licensees’ turnover of goods bearing the INTEL INSIDE trade mark are separate from these figures.

35) Mr Philippe exhibits copies of Intel’s annual reports for the years 1994 to 2000. In the context of these proceedings it is useful to refer to the list of principal products which are listed on the penultimate page of the 1999 annual report. These are:

- microprocessors for servers, workstations, desktop PCs and mobile PC systems
- chipsets
- motherboards
- component-level hardware and software for applications needing both low-power processing and reprogrammable, retained memory capability (flash memory)

- system level products consisting of hardware, software and support services, the products include hubs, switches and routers for Ethernet networks and computer telephony components

36) Mr Philippe states that in 1998 Intel sold goods and services worldwide with a value of over US \$26 billion. He states that since its inception Intel has sold products and services worldwide with a value of over US \$180 billion.

37) Mr Philippe states that Intel has invested heavily in marketing and advertising. He states that the advertisements usually include the INTEL INSIDE trade mark. He states that the amounts spent by Intel in advertising and promotion in the United Kingdom in United States dollars were not less than:

1995	12 million
1996	11 million
1997	8 million
1998	11.9 million
1999	16.1 million
2000	12.1 million
2001	5.9 million (up to July)

The date of the application (the relevant date) is 12 April 2000. Consequently, expenditure after this date does not have a bearing upon the case. Mr Philippe exhibits at BP10 and BP11 examples of advertising. The vast majority of the material produced at BP10 does not have an indication of where it was distributed. Where there are details which indicate the area of use these indicate United States use rather than United Kingdom use eg United States free phone telephone numbers and prices in dollars. The only clear United Kingdom usage comes from “Computing” and “The Independent” magazine. However, both of these emanate from after the relevant date. Consequently, exhibit BP10 tells me little useful about the position as to use of trade marks by Intel in the United Kingdom at or before the relevant date.

38) The material exhibited at BP11 consists of two CD-ROMS and a video cassette. The first CD-ROM contains advertisements for the United Kingdom for the Intel Pentium III processor. There is no indication of the date the advertisements were shown, or where they were shown. The second CD-ROM contains two advertisements for the Intel Pentium IV processor. The advertisements are labelled US and the .com address is given rather than the .co.uk address of the first CD-ROM advertisements. It would appear, therefore, that these were United States advertisements. In all the advertisements that the INTEL INSIDE and device trade mark can be seen. The video-cassette contains two advertisements which appear to have been recorded directly from television broadcasts. They show the INTEL INSIDE and logo trade mark and appear to have been broadcast in the United Kingdom. However, there is no indication of the date when the advertisements were broadcast and so the exhibit does not assist me.

39) Mr Philippe states that Intel works with PC makers, software developers and PC users. He exhibits at BP12 some information in the form of press articles and press releases about recently announced research and development projects. This material all seems to emanate from after the relevant date.

40) Mr Philippe states that he exhibits at BP16 examples of press clippings referring to the INTEL INSIDE brand. This consists of a large amount of material, which does not appear to

have been tailored specifically for these proceedings. The exhibits consists of various articles downloaded from the Internet. A couple of volumes contain articles after the relevant dates. All of the volumes contain many articles from outside the United Kingdom.

41) Mr Philippe exhibits copies of press articles at BP13. A good number of the articles are not from United Kingdom publications, certain of them emanate from after the relevant date. They deal with the fame of Intel rather than of the INTEL INSIDE trade mark, although some of the articles do show this trade mark. An article from “Microscope” of 27 January 1998, which appears to be a United Kingdom publication, refers to INTEL INSIDE “ingredient marketing”.

42) Mr Philippe states that Intel polices and protects the integrity of the INTEL INSIDE trade mark. He states that Intel has issued guidelines to licensees and newsletters under the name THE INSIDE STORY. He exhibits at BP14 a copy of “inside” volume 1 issue 1 of March 1992 and three copies of “The Inside Story”, from 1994, 1995 and 1996. All of these publications give information to INTEL INSIDE licensees about the INTEL INSIDE program.

43) Mr Philippe then makes what can be best described as submissions, at some length. As this is not evidence of fact I will say no more about it here but take his comments on board in reaching my decision.

Evidence of Digital

Witness statement of Penelope Ann Nicholls

44) Ms Nicholls is a trade mark attorney.

45) She exhibits at PAN1 printouts downloaded on 3 April 2002 from the website www.intel.com, operated by Intel. She states that the printouts give a list of Intel’s trade marks. Ms Nicholls states that the listing includes the INTEL INSIDE trade mark and the trade marks “THE COMPUTER INSIDE” and “THE JOURNEY INSIDE”. She states that the printout comprises a list of the Intel trade marks together with an index and details of the goods/services for which they are used. Ms Nicholls states that in respect of INTEL INSIDE the list includes microprocessors and in respect of THE COMPUTER INSIDE the description given is “a promotional slogan; no noun required”. Ms Nicholls states that THE JOURNEY INSIDE has the SM symbol, indicating a service mark, against it and the first statement beneath the mark is “educational program”. She states that the list contains no other trade marks which comprise the word “inside” in conjunction with other elements and does not include the word INSIDE alone as a trade mark of Intel.

46) Ms Nicholls exhibits a copy of a paper produced by Benoit Philippe. She states that this paper was extracted from the conference handbook papers for a conference entitled “International Trade Mark Enforcement” held in London on 28 and 29 February 2001. She states that Mr Philippe focuses on what are described as “Intel’s most renowned marks”, INTEL, PENTIUM and INTEL INSIDE. Ms Nicholls states that there is no reference to the word INSIDE alone as a trade mark.

47) It is to noted that both of Ms Nicholl’s exhibits emanate from after the relevant date.

Witness statement of Ezio Panzeri

48) Mr Panzeri is a director of Digital.

49) Mr Panzeri states that Digital “has devised and “Pioneer” patented a digital (sic) laser technology in 36 countries which enables coin operated apparatus and equipment to detect or recognise the coins which are inserted and assess whether they reach the correct totals”. Mr Panzeri states that the product is “retrofitted ‘inside’ existing and newly made coin operated apparatus”. He states that the “technology” is licensed to manufacturers of coin detectors and used inside vending machines; it has also been licensed for gaming and gambling machines. Mr Panzeri states that the trade mark was adopted in February 2000. He exhibits at EP1 an extract from Digital’s website which shows use of the trade mark and describes the product, very much in the terms already used by Mr Panzeri. He exhibits at EP2 samples of promotional material produced by Fage SpA, an Italian company which has been licensed to use the technology and trade marks in Europe, including the United Kingdom. Mr Panzeri states that the material was produced “recently”. As his statement is dated 28 March 2002 this would suggest it emanates from after the relevant date. There are two leaflets. They both bear a Fage trade mark and one the trade mark Jedy and the other trade mark Giody. Each of the leaflets shows the trade mark of Digital.

50) Mr Panzeri states that 16,000 units have been sold throughout Europe, the United Kingdom and Latin America by Fage SpA, all featuring the trade mark. He gives details of the European distributors, including one in the United Kingdom. Mr Panzeri states that the first sale of goods under the trade mark occurred at the Avex-International Vending Exhibition at Olympia, London between May 26 and 29 2001. He states that from February 2002 2,500 to 3,000 units are fitted with the technology monthly and that the United Kingdom represents four per cent of the business. Mr Panzeri estimates that sales so far in the United Kingdom amount to £40,000.

51) Mr Panzeri states that the European distributor for Digital’s electronic payment systems is Eurovend GmbH. I am not sure how this tallies with the list of other distributors in Europe that he gives earlier. Mr Panzeri refers to matters in Germany, Austria and Switzerland. I do not see that these have an influence on the position in the United Kingdom. He also produces pages from a magazine, the text of which is in German. Again I do not see the relevance of this in these proceedings and if Mr Panzeri considered that it does have relevance he should have translated the pages into English.

52) Mr Panzeri states that Digital have never encountered any instances of confusion arising from its use of the trade mark.

Intel’s evidence in reply

53) This consists of a further witness statement by Benoit Philippe.

54) A large part of the statement of Mr Philippe consists of a critique of the evidence of Digital and what can best be described as submissions. This is not evidence of fact and so I will say no more about it, although I take on board the points raised in reaching my decision.

55) Mr Philippe exhibits at BP17 articles which he states show a connection between Intel and its products and coin operated apparatus and in particular coin operated Internet access

facilities found in cyber cafés and coin operated arcade games. Mr Philippe states that Intel is strongly associated with arcade style games and exhibits evidence at BP18 to support this statement. The material in exhibit BP17 shows that various equipment, including computer games, that is or can be coin operated also includes Intel processors as parts of the equipment. There is no indication that these processors have a function specifically in relation to the coin operation. A great deal of the material of BP18 relates to references to the requirements for operation of games software which refers to Intel Pentium products ie microprocessors. A paper entitled “Open Arcade Architecture Device Data Format Specification” makes mention of coin door devices and game controller interface cards which may provide coin door and coin lockout “functionality”.

56) Mr Philippe states that there are a number of products which are referred to as “convergence products”, allowing the user to watch DVDs, browse the Internet and play games with the same system. He exhibits documentation in relation to this at BP19.

57) Mr Philippe states that people do not just associate Intel and its microprocessors and microcontrollers with computers. He states that they are increasingly aware that computer chips are embedded in all sorts of everyday items. He exhibits at BP20 various articles commenting on computer chips being embedded in various goods, such as cars, cameras and credit cards. Mr Philippe goes on to exhibit more documentation at BP21, 22, 23 and 24 to sustain his statement as to the pervasiveness of microprocessors in products other than computers. This includes an at BP23 a paper from the School of Architecture at The Queen’s University of Belfast, dated January 2000, which states that roughly eighty per cent of microprocessors are used in devices other than computers. Mr Philippe continues by commenting on Intel’s long term involvement in digital technology. He also comments on the functions of the Pentium 4 processor; evidence in relation to these matters is exhibited at BP25 and BP26.

58) Mr Philippe exhibits at BP27 a copy of a patent owned by Digitall. He states that it is clear that Digitall’s products involve the use of signal processors and microcontrollers. He states that Intel designs and manufactures microcontrollers and digital sensor processors and exhibits a large amount of material at BP28 in relation to this. A lot of this material emanates from after the relevant date. Various Intel trade marks appear in the documentation, however, I can find none of the trade marks upon which Intel rely in this case. Mr Philippe states that Intel microcontrollers, digital sensor processor chips and microprocessors are embedded in many non PC applications. He exhibits at BP29 an extract from the webopedia.com web site which gives a definition of the word microprocessor. The extract states, amongst other things, that “microprocessors also control the logic of almost all digital devices, from clock radios to fuel-injection systems for automobiles”. Mr Philippe states that it is clear that Digitall’s technology is a type of processor that could not work without gathering, reading and processing data.

59) Mr Philippe exhibits at BP30 material relating to the public knowledge of the INTEL INSIDE brand.

DECISION

60) Having read Mr Mellor’s skeleton argument I raised a couple of matters for clarification. I could not see that the “family of trade marks” argument was being run. Mr Mellor indicated that Intel were not relying upon this argument. I think that this was eminently sensible as I

could find no exhibits which clearly show other Intel “_____ INSIDE” being used in the United Kingdom on or before the relevant date. In *Easyrooms Ltd v Easygroup IP Licensing Limited* BL 0/473/02 I dealt with the issue of families of trade marks in some detail. As I pointed out in that case one of the essential requirements for the establishment of a family of trade marks is actual use. In the absence of this use a claim to a family of trade marks collapses. I also queried whether the section 5(4)(a) – passing-off – ground was still being run. Mr Mellor advised that if Intel did not win under section 5(2)(b) and/or section 5(3) he could not envisage it doing any better under section 5(4)(a).

61) I began the hearing by putting forward my view of the



trade mark. I advised that from the evidence I had come to the conclusion that it is a famous trade mark. The evidence shows that it is used for microprocessors in computers. However, I was of the view that the average consumer would be unlikely to be so specific or necessarily be aware exactly of what a microprocessor does. I indicated that I considered the renown would effectively be for the innards of a computer, the thing or things that make it work. Neither Mr Panzeri or Mr O’Dwyer dissented from the view that I had formed. Mr Mellor also seemed quite content with it, especially as I did not limit the fame, renown (whatever you wish to call it) to just microprocessors.

Section 5(3) objection

62) Section 5(3) of the Act states:

“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.”

63) The European Court of Justice stated in *General Motors Corporation v Yplon SA Case C-375/97* [2000] RPC 572 (*Chevy*):

“Article 5(2) of the First Council Directive (89/104/EEC) of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that, in order to enjoy protection extending to non-similar products or services, a registered trade mark must be known by a

significant part of the public concerned by the products or services which it covers. In the Benelux territory, it is sufficient for the registered trade mark to be known by a significant part of the public concerned in a substantial part of that territory, which part may consist of a part of one of the countries composing that territory.”

64) The court also stated the following:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant factors of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use and the size of the investment made by the undertaking in promoting it.”

“The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.”

65) I have already commented on the fame of the INTEL INSIDE trade mark. I have not the least doubt that it satisfies the *Chevy* criteria for reputation for the innards of computers, the bits that make computers work.

66) To succeed under this ground the respective trade marks have to be similar. Intel has relied on several trade marks. In terms of specification and trade mark I cannot see that any of them would put it in a better position than United Kingdom trade mark registration no 2108775.

67) The trade marks, therefore, to be compared are:

Intel’s registration:



Digitall’s application:



68) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* [1998] RPC 199 at page 224). The visual, aural and conceptual similarities of the trade 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* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 at page 84, paragraph 27).

69) Both trade marks contain the word INSIDE and in both cases it is in lower case. As well as containing the word INSIDE both trade marks follow a similar pattern in that they contain the main element of the company name before the word INSIDE. This would not be the normal grammatical way of using the company name. In normal English it would be used as an adjective but in both cases it is being used as a noun. So instead of saying, for instance, INTEL microprocessor inside or DIGITALL coin reader inside, the trade marks cut out the product noun and rely on the company name as a kind of short hand. Digitall in its defence referred to other trade marks on the trade mark register which include the word INSIDE, state of the register of the evidence. As has been said time and time again state of the register evidence says nothing about what is happening in the market place. It is the market place that is relevant, not what is on a trade mark register – see *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281.

70) Mr Panzeri indicated at the hearing that Digitall's equipment digitises, that the word digital is effectively descriptive for the equipment Digitall sells. Of course in the trade mark the word DIGITALL is misspelled and has a highly stylised D. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). The D certainly stands out but the actual word DIGITALL is, despite the misspelling, a weak element I believe. It does not dominate and subsume the word INSIDE.

71) Taking into account the common use of the word INSIDE and the common pattern of the two trade marks I consider that the respective trade marks are similar; not overwhelmingly similar but definitely similar.

72) I now need to consider the respective goods. Mr Mellor referred me to *Davidoff & Cie and Zino Davidoff SA v Gofkid Ltd* Case C-292/00 in the European Court of Justice. It was his argument that the effect of this decision is that section 5(3) of the Act applies to trade marks encompassing similar goods as well as to those encompassing dissimilar goods. This might be the effect of the judgment. However, I do not consider that I need to consider this issue as I believe I can stick with section 5(3) on the basis of non-similar goods.

73) Evidence has been put in to show the nature of Digitall's product. As has been referred to above it essentially consists of a laser, a laser receptor and a signal processor. I would describe it as a coin reading device. Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267 stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

The specification for the application is *coin-operated apparatus and systems*. I consider that it is a moot point whether Digital's product falls within that specification, whether the natural meaning of the specification would encompass the product. Intel have gone to the trouble of exhibiting Digital's patent to show the nature of the goods. Of course I have to work on the basis of the specification before me but if Digital's actual product falls within that specification it is illustrative of some of the goods that the specification could encompass. Equally if they do not fall within that specification the evidence relating to the actual product does not have a bearing upon the case. I consider that the natural reading of *coin-operated apparatus and systems* is of complete equipment or systems which are operated by coins eg vending machines, arcade games. The equipment of Digital can form a part of such machines but that is all it is, a part. I think that it would be putting an immense strain upon the English language to fit the actual product of Digital into the specification. Consequently, I will just consider *coin-operated apparatus and systems* in what I believe is its natural and normal meaning; the vending machines, arcade games and the like that I mentioned above.

74) The goods for which Intel can claim a reputation in the specification of its registration are, in my view, at least:

integrated circuits; integrated circuit chips; semiconductor processors; semiconductor processor chips; microprocessors; printed circuit boards; electronic circuit boards; computer memory devices; semiconductor memory devices

The above goods can reasonably be described as the innards of computers. The European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117 held in relation to the assessment of the similarity of goods, that the following factors, amongst other things, should be taken into account: their nature, their end users and their method of use and whether they are in competition with each other or are complementary. Do the above goods coincide with *coin-operated apparatus and instruments*? Intel's goods are parts of finished products, the goods of the application are finished goods. This shows a different nature. The end users and method of use are very much defined by the nature of the goods. Intel's end users are those constructing a product, Digital's, on the basis of the specification, are those buying a completed product. Intel's goods are used to construct goods. Digital's are complete products which vend products, allow for a game to be played and the like. One would not substitute one set of goods for another, therefore, I cannot see that they are in competition. The goods of Digital's application might require certain of the goods of Intel but Intel's goods do not require the existence of Digital's goods. I consider, therefore, that there is no mutually dependant or symbiotic relationship and so I do not see that the goods are complementary. I, therefore, do not consider that the respective goods are similar. Based on the actual specification this is very much about ingredients against finished products, the butter as against the cake. If I took on board the goods that Digital actually seem to be interested in, what I describe as coin reading devices, I still do not consider that they would coincide in the categories that are set out in *Canon*. Although I consider that there is such goods are not quite so distant, being positioned between the goods of Intel and the goods of the application. The coin reading device could be a part of the same machine as a product for which Intel have a reputation. I also note that Digital states in its counterstatement that *apparatus and instruments, all for processing, storage, retrieval, transmission, display, input, output and printout of data* are not similar to the goods of the application. Such goods appear to me to include the innards of computers.

75) Intel have the requisite reputation. The trade marks are similar. The goods are not similar. Having satisfied these criteria have Intel established that use of Digitall's trade mark would take advantage of its trade mark? Mr Mellor emphasised the advantage aspect of the case, although not abandoning the possibility of detriment through dilution. Indeed it could be argued that detriment through dilution is the other side of the coin of unfair advantage.

76) For Intel to succeed I must consider that any advantage, if any there be, accruing to Digitall will be more than de minimis - *Barclays Bank plc v RBS Advanta* [1996] RPC 307.

In *Daimler Chrysler AG v Javid Alavi trading as MERC* [2001] RPC 42 Pumfrey J stated

“...but Jacobs AG emphasises that the provision is not to be used to give marks ‘an unduly extensive protection’, emphasising that there is a question of a risk of unfair advantage or detriment: there must be actual unfair advantage or detriment. But, for this to happen, there must be some sort of connection formed (I avoid the word association) between the sign used by the defendant and the mark and its associated reputation”

A mere association, a bringing to mind, will not do for Intel to succeed. For there to be an unfair advantage I will need to believe that, for instance, people will purchase Digitall's product in the belief that it there is a connection with Intel; that Digitall's trade mark is or will ride on the coat tails of Intel's trade mark, that Digitall will gain sustenance from Intel's trade mark as the mistletoe does from the apple tree.

77) If all the criteria of section 5(3) are satisfied it is for Digitall to show that it has “due cause” for using the trade mark (see *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 at pages 789 to 791). If Digitall can show that it has then the grounds of opposition will fail. Mr Panzeri indicated that the word INSIDE was used to indicate that the product of Digitall was inside a piece of equipment. This might be the intent, and an honest intent, but it does not necessarily justify the means. The format of trade mark and the word INSIDE from the evidence is unique to Intel, or at least until Digitall arrived on the scene. The concept of “ingredient marketing” in relation to electrical equipment is also unusual. Although I would suggest not unique, I can think of Dolby in relation to sound reproduction equipment. However, it is certainly unusual. The concept, however, is not the issue. The issue is the use of the word INSIDE with the trade mark to indicate the ingredient in the finished product. It is not a normal way or grammatical way of referring to the concept. Digitall could have indicated the ingredient in other ways, other more grammatical ways. Owing to the fame of the INTEL INSIDE trade mark I can have little doubt that Digitall knew of it and thought the use of INSIDE was a good short hand to have the effect it wanted. I do not consider that Digitall had an improper motive for adopting its trade mark. However, although the motive might not be improper this is not the same as showing that it had due cause. It had no necessity to adopt the trade mark. Digitall has not put forward any sustainable reason, in my opinion, for adopting the trade mark. I do not consider, therefore, that it can claim that use of its trade mark would be with due cause.

78) This leaves me with the crux of the matter, would Digitall gain an unfair advantage? The goods of the application encompass a large variety of goods; from the drinks vending machine to an arcade game. Intel has put in evidence in relation to the pervasiveness of microprocessors and the like in domestic electrical and electronic objects. I do not think that this can be contested. However, I think that this blurs the issue. I am not considering Intel at

large or microprocessors at large. I am considering the INTEL INSIDE trade mark and that has been used in relation to computers and not, on the basis of the evidence, on other types of goods. Intel has emphasised its relationship with computer games. This has been based on three main planks. Its relationship with games manufacturers and the consequent designing of its products to cope with the demands of the games software. The presence on advertisements for games software of the INTEL INSIDE trade mark, the advertisements also mention the type of Intel product that will be required to play the game. Finally, that players at home of games will be confronted with the INTEL INSIDE trade mark on their computers when they play the games. There is no doubt in my mind that Intel has built up an identification of its products with computer games, even though it is not a manufacturer of such games. The presence in advertisements for games of the INTEL INSIDE shows the conscious intent to make this connection. If the home computer games player sees Digitall's trade mark upon an arcade games machine would he make a connection with Intel? In coming to a conclusion I bear various factors in mind:

- The extent of the reputation of the INTEL INSIDE trade mark. This is not just an enormously well known trade mark but one that has regular post purchase reinforcement. Every time some one sits down at a computer with an Intel product inside it he or she sees that trade mark.
- The unconventional grammatical nature of the trade marks. This is something I have discussed above.
- The limited distinctiveness of the DIGITALL part of Digitall's trade mark. Again this is a matter that I have discussed above.
- "Ingredient marketing" being unusual in the sphere of coin operated apparatus and instruments.

Taking all these factors into account I consider that there is a likelihood that the consumer, however circumspect and intelligent he or she may be, will believe that there is a connection between the goods of Intel and those of Digitall. A connection with a company with the reputation of Intel must, in my view, take unfair advantage of the reputation of the INTEL INSIDE trade mark. I cannot see that it can be anything other than a boon for sales.

79) I have taken the example of coin operated arcade games as this, in my view, most clearly exemplifies the potential for unfair advantage that Digitall could gain.

80) I have commented above that I do not consider that the goods that Digitall actually make are encompassed by the specification. These goods sit somewhere between the goods of the specification and the goods for which INTEL INSIDE has a reputation. Use for such goods, which include signal processors, would make a connection even the more likely; such goods are clearly ingredient goods like Intel's goods and are high tech goods, like Intel's goods.

81) Intel succeeds in its opposition under section 5(3) of the Act. The application is refused in its entirety.

Grounds of objection under sections 5(2)(b) and 5(4)(a) of the Act

82) As Intel has succeeded under section 5(3) of the Act I do not need to consider the other grounds of opposition. However, I will briefly deal with them. For section 5(2)(b) the case of Intel would have rested very firmly upon the goods for which it has a reputation. Without this reputation I cannot see that on a global appreciation that it could succeed. However, I have

decided that the goods for which it has a reputation are not similar to the goods of the application. Section 5(2)(b) requires similarity of goods. As the goods upon which the issue would have revolved are dissimilar this ground of opposition would have failed. Mr Mellor submitted that if Intel could not win under section 5(2)(b) and/or section 5(3) of the Act it could not win under section 5(4)(a). As he accepts that Intel's position cannot be any better under section 5(4)(a) I do not consider it necessary to say anything further about this ground of opposition.

COSTS

83) I have indicated in my summary of the evidence that parts of the evidence of Intel did not appear to be tailor made for these proceedings. A good deal of the evidence was non-United Kingdom use or emanated from after the relevant date or related to the reputation of Intel rather than that of the relevant trade mark(s), or combinations of these. Exhibit BP16 runs to some fifteen A4 volumes, a large amount of this does not have a bearing upon the case. Coleman J in *O Co. v. M Co. (1996) 2 Lloyd's Rep 347* in relation to disclosure referred to the increase in costs due to the development of the copying machine. The curse of the Internet search now seems to have been added to that of the photocopier. As far as BP16 is concerned it would seem that a simple search term was fed into the Internet and the results were bundled up without concern to their direct relevance to the proceedings. Exhibit BP10 was of no assistance, there was no indication from where the material emanated – although a lot of it had United States free phone numbers. The only two pieces which clearly related to the United Kingdom were after the relevant date. Exhibit BP28, which is very extensive, shows no use of INTEL INSIDE at all. Sorting the wheat from the chaff in this case was almost on a par with one of the labours of Hercules. It is, of course, reasonable for a side in proceedings to put in “belt and braces” evidence to make sure that it has fully covered its position. In this case I do not consider that the volume of evidence represents a “belt and braces” approach but rather a blunderbuss approach, with the wheat and the chaff all rammed into the barrel of the gun for discharge. In this case this has been an awful lot of chaff. This clearly has implications for the other side. A large volume of evidence requires a large amount of time to analyse it, this could lead to the abandoning of a case or the discharging of legal representation simply because of unnecessary cost. It puts the other party at an extreme disadvantage. Where evidence is untargeted the effort in considering it becomes more difficult as the reader of the evidence has to try and discriminate between the relevant and the irrelevant within the parameter of the pleaded case. (In this case a pleaded case for a family of trade marks which was not supported by the evidence and claims to use of all the trade marks for all the goods that they encompass).

84) *Rizla Ltd's Application* [1993] RPC 365 confirms that in the matter of costs the registrar has a wide discretion. In *BUD and Budweiser Budbräu Trade Marks* [2002] RPC 38, Mr Simon Thorley QC, sitting as a deputy judge of the High Court, accepted that off the scale costs could be awarded where a side had behaved unreasonably or put in a large amount of evidence that is of little or no relevance. In that case Mr Thorley was considering the actions of the losing side. However, I consider that such a consideration can equally apply to the winning side. It is a matter of whether the other side was put to effort and expense which, taking into account the nature of the evidence, served no purpose.

85) Subsequent upon the above I consider that Digitall will have been put to a good deal of time and effort in considering a large amount of evidence that is either irrelevant or of dubious relevance. In such circumstances I consider that Digitall deserves some compensation. I have, therefore, decided that although Intel is the winning side I will make no award of costs to it. Each side will bear its own costs.

Dated this 20TH day of February 2003

**David Landau
For the Registrar
the Comptroller-General**