

**IN THE HEARINGS AND MEDIATION GROUP OF
THE INTELLECTUAL PROPERTY OFFICE OF SINGAPORE
REPUBLIC OF SINGAPORE**

Trade Mark Registration No. T0903014D
21 October 2014

IN THE MATTER OF A TRADE MARK REGISTRATION BY

INTELSTEER PTE LTD

AND

APPLICATION FOR INVALIDATION BY

INTEL CORPORATION

Hearing Officer: Ms Sandy Widjaja
Principal Assistant Registrar of Trade Marks

Mr Gabriel Ong (Drew & Napier LLC) for the Applicants
Registered Proprietors: Not represented

Cur Adv Vult

GROUNDINGS OF DECISION

1 This is an application for invalidation of the following registered trade mark T0903014D ("**Registered Mark**"):





in relation to the following goods in Class 42:

“Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software”

2 Intel Corporation (“**the Applicants**”) applied to invalidate the Registered Mark on 5 October 2009. IntelSteer Pte Ltd (“**the Registered Proprietors**”) filed their Counter-Statement on 4 February 2010. On 2 August 2012, a Pre-Hearing Review was held. Parties subsequently submitted notifications that they were not willing to mediate at that point. However, on 5 October 2012, the Registered Proprietors indicated that they wish to submit to mediation. Further, at a taxation hearing for a related matter T0903111F on 16 October 2012, parties indicated that they were negotiating both matters at the same time. Unfortunately, on 12 August 2013, the Applicants wrote in to inform that they wish to recommence the invalidation proceedings as they have not received the signed settlement agreement from the Registered Proprietors. At an ad-hoc Case Management Conference on 20 September 2013, while parties indicated that they were still trying to negotiate, the agent for the Registered Proprietors indicated that they were discharging themselves. To that end, Form TM1 was filed on 25 October 2013 which provided the Applicants’ local business address as the address for service. On 30 October 2013, the Applicants indicated again that parties were still trying to negotiate. On 16 December 2013, the Applicants informed that negotiations have broken down and that they wish to recommence the invalidation proceedings. On 19 February 2014, the Registrar wrote to the parties in relation to certain matters in light of the fact that the matter is proceeding to a full hearing. However, the letter to the Registered Proprietors was returned undelivered and Singapore Post Ltd indicated that the Registered Proprietors have moved out (in this regard, the Registered Proprietors also did not turn up for the taxation hearing for a related matter T0903111F on 20 February 2014). Since then, the Registered Proprietors have not been contactable. Correspondences sent to the address on record have been returned undelivered. On 9 June 2014, the Registrar wrote to the parties noting that the Registered Proprietors have not been contactable and indicating the Registrar’s informal understanding that it would appear that the Registered Proprietors have been gazetted to be struck off the Register of Companies on 15 August 2014. The Registrar sought an indication from the parties if they still wish to proceed with the invalidation matter in light of the above. The Applicants responded on 9 July 2014 indicating that they wish to be heard. A hearing was therefore set for 21 October 2014. The Registered Proprietors did not file any written submissions or bundle of authorities. They also did not appear at the hearing. Based on an informal check, the Registrar was given to understand that the Registered Proprietors were officially struck off the Register of Companies on 13 June 2014.

Related Matters

3 For completeness, the current invalidation is related to two other marks namely T0903111F and T0903113B as follows:

S/N	Trade Mark Number	Depiction
1	T0903111F	
2	T0903113B	

4 T0903113B was abandoned by the Registered Proprietors (who filed the application to register that mark) as there was no response by the final deadline of 30 April 2012 to the objections raised in the prosecution of the application. T0903111F was deemed withdrawn as the applicant in the opposition process, which is the Registered Proprietors in the current invalidation, did not file evidence in support of the application by the deadline of 4 March 2012.

5 These 3 marks are related as the parties are the same. The survey evidence that was tendered in the present case was also conducted in relation to all the 3 marks.

Grounds of Invalidation

6 The Applicants rely on the following grounds for this invalidation:

- (i) Sections 23(3)(a)(i) read with Section 8(2)(b) of the Trade Marks Act (Cap 332, 2005 Rev Ed) (“**the Act**”);
- (ii) Section 23(3)(a)(iii) read with Section 8(4)(b)(i) and Section 8(4)(b)(ii) of the Act; and
- (iii) Section 23(3)(b) read with Section 8(7)(a) of the Act.

Applicants' Evidence

7 The Applicants' 1st set of evidence comprises of statutory declarations by:

- (i) Mr Yong Tsui Phoo dated 31st March 2011 (essentially results of a survey “*Yong's Evidence*”); and
- (ii) Ms Ruby A. Zefo dated 1 April 2011 (“*Zefo's Evidence*”).

On the day of the hearing, the Applicants tendered a supplementary statutory declaration made by Ms Ruby A. Zefo to correct an administrative error in the table at paragraph 22 of the Zefo’s Evidence (*Zefo's Supplementary Evidence*). Finally, the Applicants' 2nd set of evidence comprises of a statutory declaration by Mr Christopher George dated 28 June 2012 (*George's Evidence*).

Registered Proprietors' Evidence

8 The Registered Proprietors' evidence comprises of a statutory declaration made by Mr Chung Ting Fai dated 2 March 2012 ("*Chung's Evidence*").

Applicable Law and Burden of Proof

9 The applicable law is the Act and there is no overall onus on the Registered Proprietors either before the Registrar during examination or in invalidation proceedings. Thus the burden of proof in respect of the invalidation proceedings falls on the Applicants.


Background

10 Based on the evidence tendered, the Registered Proprietors were part of the IntelSteer Group, headquartered in Kuala Lumpur, Malaysia. The Registered Proprietors were incorporated in Singapore in 2006 and was a global specialist in the field of energy efficiency. The Registered Proprietors focussed on providing their clients with the latest lighting technology to reduce energy costs and carbon emissions, and improve plant performance. The Registered Proprietors also specialised in manufacturing energy saving lamps and fixtures.

11 The Applicants, Intel Corporation, produces processors that power many of today's computers and other electronic devices. It was founded in the United States in 1968. By the end of 1971, it had expanded outside of the US and is a multi-billion dollar global corporation with offices worldwide. Today, the Applicants are involved in many fields of activity, including but not limited to networking and communications, consumer electronics and peripherals.

12 The Applicants are the registered proprietors of a large number of marks in Singapore. In the current case, they are relying on the following marks in Class 42 (collectively "*Applicants' Earlier Class 42 Marks*"):

S/N	Registered Mark	Registration Number	Registration Date	Class / Specification
1	INTEL	T9801120E	11 Feb 1998	Class 42 Computer-related services, namely support and consulting services for computer-related and communications-related goods; providing information in the field of computer and communications technology via the internet; designing standards for use by others in the design and implementation of computer

				software, computer hardware and telecommunications equipment and services; computer software, computer hardware and network design services for others; all included in Class 42.
2	INTEL	T9805379Z	2 Jun 1998	Class 42 Leasing of computers, computer hardware, peripherals, computer components, computer software, printers, copiers and office furniture.
3	INTEL	T0005306J	31 Mar 2000	Class 42 Web design, engineering and consulting services; internet and web data services; computer services namely providing facilities for access to the global communication network; internet and web service provider services; application service provider services; maintenance and management of web pages and websites; design and implementation of web pages for others; website creation and hosting services; website construction, design and amendment; development of websites.
4		T0526942H	30 Dec 2005	Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; managed web hosting and computer network services; providing online access to

				<p>data storage services [other than by Internet Service Providers]; website hosting and hosting of digital content on the internet; network monitoring services, namely providing information on the operation of computer networks; providing services in the fields of web software customization, user interface design, web site content management and integration; web site development and maintenance; computer and wireless consulting services; providing temporary use of non-downloadable software; computer networks; providing services in the fields of web software customization, user interface design, web site content management and integration; web site development and maintenance; computer and wireless consulting services; providing temporary use of non-downloadable software; computer consulting services; computer custom software and hardware development, design, and consulting services; rental of computer equipment, namely, computers, computer hardware, peripherals, computer components, computer software, computer printers; designing and developing standards for others in the design and implementation of computer</p>
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				software, computer hardware and telecommunications equipment.
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Preliminary Comment

13 It is unfortunate that, in this case, the Registered Proprietors were not present to submit any submissions, written or oral. Issues abound in this case where it would have been profitable to have the counter party put forth an alternative view so as to be able to reach a more rigorous conclusion.

MAIN DECISION

Ground of Invalidation under Section 23(3)(a)(i) read with 8(2)(b)

14 The relevant provisions of the Act provide as follows:

23.—(3)The registration of a trade mark may be declared invalid on the ground —

(a) that there is an earlier trade mark in relation to which —

(i) the conditions set out in section 8(1) or (2) apply;

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

8. —(2) *A trade mark shall not be registered if because...*

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

2. —(1) *In this Act, unless the context otherwise requires —*

“earlier trade mark” means —

(a) a registered trade mark or an international trade mark (Singapore), the application for registration of which was made earlier than the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or

(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was a well known trade mark,

and includes a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (a) subject to its being so registered;

“well known trade mark” means —

(a) any registered trade mark that is well known in Singapore; or

(b) any unregistered trade mark that is well known in Singapore and that belongs to a person who —

(i) is a national of a Convention country; or

(ii) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Singapore;

Decision on Section 23(3)(a)(i) read with 8(2)(b)

Step-by-step approach

15 The most recent authority in relation to this section is the Court of Appeal's decision in *Staywell Hospitality Group v Starwood Hotels & Resorts Worldwide [2014] 1 SLR 911* (“*Staywell*”). In *Staywell*, the Court upheld the 3-step test approach in relation to an objection under section 8(2)(b) and rejected the proposal that the threshold of marks similarity is a low one as follows at [15] to [20]:

[15]...Since this court’s decision in Polo (CA), our courts have given effect to this statutory wording by applying what is now known as the “step-by-step” approach, as opposed to the competing “global appreciation approach” applied in Europe after Sabel BV v Puma AG, Rudolf Dassler Sport [1998] RPC 199 (“Sabel v Puma”). Under the step-by-step approach, the three requirements of similarity of marks, similarity of goods or services, and likelihood of confusion arising from the two similarities, are assessed systematically. The first two elements are assessed individually before the final element which is assessed in the round...

[16] However we do not agree with the Opponents’ approach to the extent that it suggests that any particularly or notably low threshold of marks-similarity applies...

*[17] More fundamentally, the minimal threshold approach is inconsistent with the reality that the similarity of marks is ultimately and inevitably a matter of impression rather than one that can be resolved as a quantitative or mechanistic exercise (see *Polo (CA)* at [35] and *Wagamama Ltd v City Centre Restaurants**

Plc [1995] FSR 713 at 732)...The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar. The three aspects of similarity are meant to guide the court's inquiry but it is not helpful to convert this into a checkbox exercise in which a tick, however faint it might be, in any one box must compel the court to find that the marks are similar when a sensible appraisal of the marks as a whole would show otherwise.

[18] We observed this in Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd [2013] SGCA 26 ("Hai Tong") at [40(a)]. Congruously, there is no prescribed requirement that all three aspects of similarity must be made out before the marks can be found to be similar: MediaCorp News Pte Ltd v Astro All Asia Networks plc [2009] 4 SLR(R) 496 ("MediaCorp") at [32] and Sarika Connoisseur Café Pte Ltd v Ferrero SpA [2013] 1 SLR 531 ("Sarika") at [16]. In short, the criteria of visual, aural and conceptual similarities do not invite a formulaic consideration; rather, they are signposts towards answering the question of whether the marks are similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry: Ozone Community Corp v Advance Magazine Publishers Inc [2010] 2 SLR 459 ("Ozone"), see also Bently and Sherman, Intellectual Property Law (Oxford University Press, 3rd Ed, 2009) ("Bently & Sherman") at p 864.

[19]...A productive and appropriate application of the step-by-step approach necessitates that the court reach a meaningful conclusion at each stage of the inquiry...

[20] Finally, on this issue, we reiterate that the assessment of marks similarity is mark-for-mark without consideration of any external matter: see Mediacorp at [33], Sarika at [17] and Hai Tong at [40(b)]. This means that at the marks similarity stage this even extends to not considering the relative weight and importance of each aspect of similarity having regard to the goods. This does not mean that the court ignores the reality that the relative importance of each aspect of similarity might vary from case to case and will in fact depend on all the circumstances including the nature of the goods and the types of marks, as we observed at [40(b)] of Hai Tong. Rather, such considerations are properly reserved for the confusion stage of the inquiry, because that is when the court is called upon to assess the effect of objective similarity between the marks, on the perception of consumers. We recognise that this reflects a slight departure from the approach taken by the High Court in Festina Lotus SA v Romanson Co Ltd [2010] 4 SLR 552 at [55]–[56], and by this court in Sarika at [38]. We think that this is conceptually clearer because it recognises that the issue of resemblance between the competing marks is distinct from the question of the effect of such resemblance...

[Emphasis as underlined mine.]

Similarity of Marks

16 In relation to similarity of marks, the Court has this to say at [25], [26] and [30]:

[25] Technical distinctiveness is an integral factor in the marks-similarity inquiry (see Sarika at [20], Ozone Community at [47] and Polo (CA) at [36]); a mark which has greater technical distinctiveness enjoys a high threshold before a competing sign will be considered dissimilar to it (Sarika at [36]). While the components of a mark may be inherently technically distinctive, ultimately the ability of the mark to function as a strong badge of origin must be assessed by looking at the mark as a whole. Conversely, the components of a mark may not be inherently distinctive, but the sum of its parts may have sufficient technical distinctiveness...

[26] When speaking of the assessment of a mark as a whole, it may be noted that the cases have consistently stated that the “visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components” (Sabel v Puma at 224, Matratzen Concord GmbH v OHIM, Case T-6/01 [2002] ECR II-4335 (“Matratzen”), Doctor’s Associates Inc v Lim Eng Wah (trading as SUBWAY NICHE) [2012] 3 SLR 193 (“Subway Niche”) at [19] and Bently & Sherman at p 864).

...

[30] We reiterate, as was held in Sarika (at [20]) and in Hai Tong (at [26]), that distinctiveness (in both its technical and non-technical senses) is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar. It is not a separate step within the marks-similarity inquiry.

[Emphasis as underlined mine.]

17 Further, the Court provided the following principles in *Hai Tong Co (Pte) Ltd v Ventree Singapore Pte Ltd* [2013] 2 SLR 941 at [40] (“**Hai Tong**”):

[40] (c) Although the focus of this part of the inquiry is on the marks in question, it is necessary to set out the viewpoint the court should assume. This viewpoint is that of the average consumer who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry (see Polo (CA) ([16] supra) at [34]).



*(d) Furthermore, it is assumed that the average consumer has “imperfect recollection” (see *MediaCorp* at [33], citing *Nautical Concept Pte Ltd v Jeffery Mark Richard* [2007] 1 SLR(R) 1071 (“*Nautical Concept*”) at [30]). As such, the two contesting marks are not to be compared or assessed side by side and examined in detail for the sake of isolating particular points of difference. Instead, the court will consider the general impression that will likely be left by the*

essential or dominant features of the marks on the average consumer (see Saville Perfumery Ld v June Perfect Ld and FW Woolworth & Co Ld (1941) 58 RPC 147 (“June Perfect”) at 161–162).

[Emphasis as underlined mine].

Analysis

18 For ease of reference, the marks are reproduced as follows:

Registered Mark	<i>Applicants' Earlier Class 42 Marks</i>
	INTEL
	(T9801120E, T9805379Z, T0005306J – respectively <i>INTEL Word Mark</i>)
T0903014D	
	(T0526942H – specifically <i>INTEL Stylised Mark</i>)

Distinctiveness

19 I am mindful of the Court’s guidance above that distinctiveness (in both its technical and non-technical senses) is a factor integrated into the visual, aural and conceptual analysis as to whether the competing marks are similar; it is not a separate step within the marks-similarity inquiry. However, due to the voluminous evidence tendered and extensive submissions made in relation to this issue, for ease of analysis, I will summarise my findings first, before applying them within the context of the mark-similarity analysis.

20 The Applicants submitted that the *Applicants' Earlier Class 42 Marks* are inherently distinctive. The Applicants submitted that “INTEL” is a coined term that is short for “Integrated Electronics”.

21 The Applicants also countered *Chung's Evidence* that there are several INTEL formative marks (these are marks which include the word "INTEL" as well as other components) on the Register such that the Applicants cannot claim monopoly over “INTEL” on the basis that the majority of the INTEL formative marks set out in *Chung's Evidence* at Exhibit CTF-4 belong to the Applicants.

22 The argument that many of the INTEL formative marks belong to the Applicants can only be meaningful in the context of this objection if these marks are restricted to Class 42, as this is the relevant class which is being considered under this ground of

objection. In this regard, I am of the view that the *Applicants' Earlier Class 42 Marks* are inherently distinctive, although not to a high degree. I refer to *Chung's Evidence* at pages 27 and 28 which relate to a search result using the key word "INTEL" in Class 42. The first 25 results are displayed. I note that out of 25 items, 8 items belonged to the Applicants. Out of the rest of the items, 7 items do not look remotely similar to the marks at the centre of the current contention at all. As an example, 4 of them belong to WIPO and the only reason why these marks are included in the search result is because of the word "intellectual" (underlining mine) within these marks. The rest of the marks (about 6 as well) which contain "INTEL" would appear to have the word "INTEL" blended into the word mark, for example, INTELSAT which can thus be differentiated from the Registered Mark where "INTEL" stands out as a word. In terms of an approximate gauge then (and I say this as this search result only reflects the first 25 hits), it would appear that the Applicants own about 32% of such marks in Class 42.

23 Importantly, the Applicants also made extensive submissions that the *Applicants' Earlier Class 42 Marks* enjoy a high degree of distinctiveness by reason of their extensive and widespread use both in Singapore and worldwide over the years. In this regard, the Applicants referred to the case of *Hai Tong* at [33] and made particular reference to the following factors:

- (i) The market share held by the registered mark;
- (ii) The nature of its use (whether or not it was intensive, widespread and long-standing);
- (iii) The amount invested in promoting the mark;
- (iv) The proportion of the relevant class of individuals who identified goods sold under the mark as emanating from a particular source; and
- (v) Statements from trade associations and chambers.

The Applicants submitted that although the Court in *Hai Tong* was referring to distinctiveness of a registered mark in the context of trade mark infringement, these principles were derived from *Windsurfing Chiemsee v Boots* (1999) ETMR 585, a trade mark registration case. I will deal with each element in turn.

Market share held by the mark

24 With regard to market share, the Applicants submitted that there is a wide variety of goods and services offered by the Applicants such that the market share figures will depend on the specific goods or services in question. I agree. I add that it is also important to look at the figures in the context of the Singapore market. In this instance, I note that in *George's Evidence* at [11] at page 4 (for example):

[11] "I highlight that the INTEL and the INTEL formative marks have been used in respect of a wide range of goods and services in Singapore, including processors, motherboards, chipsets, modems, demodulators, tuners, expansion modules, microcontrollers, server systems and services, software products and research and development services and the figures in Paragraph 22 of [Zefo's

Evidence and thus Zefo's Supplementary Evidence] relate to these goods and services accordingly."

[Emphasis as underlined mine].

25 Below is the net revenue figures for Singapore as provided in *Zefo's Evidence* at [22] (as the relevant date in this instance is 20 March 2009, I have excluded the figures for the year 2009 itself):

Year	Net Revenue in Singapore (USD)	Net Revenue in Singapore (USD) in MILLIONS
2002	1,079,537,000	1,079
2003	946,558,000	946
2004	1,164,326,000	1,164
2005	1,404,150,000	1,404
2006	1,310,671,000	1,310
2007	1,758,064,000	1,758
2008	1,542,243,000	1,542

Nature of its use, whether intensive, widespread and longstanding

26 In relation to the factor as to whether the nature of the use is intensive, wide spread and longstanding, again, I emphasize that this has to be seen in light of the local market.

27 In this regard, the Applicants referred to the evidence of use in exhibits RZ-14 to RZ-15 of *Zefo's Evidence*. These exhibits show use of the INTEL and INTEL formative marks in the local newspapers from 1975 to about 2011 (evidence dated after the relevant date of 20 March 2009 has been disregarded). The Applicants have helpfully broken up the evidence as follows:

Samples of advertisement in the local media				
S/N	Date Range of Publication	Period (approximately in years)	Description	Number of items
1	3 Apr 1975 – 19 Oct 1982	7	Sample advertisements in The Straits Times (“ST”) for Intel jobs in Malaysia	37
2	4 Jun 1983 – 28 Jan 1989	6	Sample advertisements in the ST for Intel jobs in Singapore	22
3	12 Oct 1983 – 19 Mar 2009	26	Sample advertisements in TODAY, the Business Times (“BT”) and the ST for products which contain an INTEL component	131
4	8 Mar 1987 – 20 Dec 2001	14	Sample advertisements in TODAY, the BT and the ST for INTEL products	17

5	14 Jul 1981 – 28 May 1982	1	Sample advertisements in the ST for fairs, workshops and seminars	12
6	13 Jul 1984 – 3 Apr 2007	23	Miscellaneous advertisements in TODAY and the ST	7
7	30 Aug 1985 – 22 Aug 2008	23	Sample reports in TODAY, the BT and the ST relating to INTEL and its business	58

Amount invested in promoting the mark

28 In relation to the Applicants' advertising figures in Singapore as at the relevant date of 20 March 2009 (*Zefo's Supplementary Evidence* at [3]), the figures are as follows:

Year	Advertising Expenditure in Singapore (USD)	Advertising Expenditure in Singapore (USD) in MILLIONS
2005	728,993,000	728
2006	756,000,000	756
2007	608,633,000	608
2008	627,645,000	627

I note again that the relevant goods / services for which these figures relate to are as provided above in *George's Evidence* at [11] at page 4.

Proportion of the relevant class of individuals who identified goods sold under the mark as emanating from a particular source

29 In relation to this item, the Applicants referred to the survey evidence which has tendered via *Yong's Evidence*. The Applicants submitted that based on the survey evidence, a high proportion ie 85% of the respondents (total sample size of 450) identified the INTEL mark as belonging to the Applicants. The Applicants submitted that it follows from this powerful degree of consumer awareness that the Applicants' INTEL and INTEL formative marks are well known to the public at large in Singapore. In this regard I note from *Yong's Evidence* that the relevant mark for the survey is the *INTEL Stylised Mark* and the survey respondents correctly identified the goods / services which the Applicants deal with as "computer / IT related" (69%) or "microprocessors" (25%).

Statements from trade associations and chambers

30 With regards to statements form trade associations and chambers, the Applicants submitted that the Applicants have, over the years, been accorded extra-ordinary recognition by some of the world's leading publications and organisations. The Applicants submitted that they have received numerous awards both globally and regionally for their corporate business, technical innovation, diversity and inclusion efforts and corporate responsibility initiatives. The Applicants referred to *Zefo's*

Evidence at exhibit RZ-10 for samples of the various awards and recognition received for the years 2006 to 2010 (it is to be noted that the relevant date is 20 March 2009), as per the Applicants' website.

31 In addition, the Applicants submitted that the INTEL and INTEL formative marks have been the subject of other third party articles from internationally distributed publications, books and case studies. For articles in international media publications for the period 1970 – 2008 (taking into account the relevant date of 20 March 2009), an excerpt is as follows:

S/N	Relevant Period	Title of Publication	Number of publications
1	1973 - 2005	Fortune	36
2	1988 - 2004	Business Week	30
3	1992 - 2001	Financial Times	14
4	1997 - 2006	Forbes	4
5	1993 - 2005	Interbrand	4
6	1992 - 2006	CNN	5
7	1992 - 1998	The New York Times	5
8	1992 - 1995	Wall Street Journal	4
9	1993 - 2000	Bloomberg News	2
10	2003	Time Magazine	2
11	1994	NewsWeek	1

32 The addition to the above media publications, the Applicants also provided references to various third party articles from internationally distributed publications, books and case studies. For books and case studies alone, the Applicants have provided a list of 17 books and case studies where the Applicants have been featured and it includes books in relation to brand management as well as strategic management of technology and innovation.

33 Taking into account *all* these factors, I am of the view that the **Applicants Earlier Class 42 Marks** are distinctive, both inherently and through use.

Visual Similarity

34 In terms of visual similarity of composite marks, the Applicants submitted that the Court in **Hai Tong** provided as follows at [62]:

*...(c) The overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components (see *Specsavers* ([54] *supra*) at [52(e)]).*

(d) The textual component of a composite mark or sign could (but will not necessarily or always) be the dominant component of the mark or sign. Some instances where this might be the case include where:

(i) *The two marks or signs in question each contain a similar device. The overall resemblance between them may then be diminished if they bear words which are entirely different from each other (see Lee Cooper at 501).*

(ii) *The textual component is large, and is in a prominent location in relation to the other components or stands out from the background of the mark or sign (see the decision of the CFI in Shaker di L Laudato & C Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (Case T-7/04) [2009] ETMR 16 (“Shaker (CFI)”) at [41]–[43]).*

(iii) *The textual component is in itself already widely known (see Festina ([52] supra) at [33], Medion at [34] and Crazy Ron’s at [99])*

(iv) *The composite mark or sign is applied to goods or services marketed or sold primarily through online trade channels (see Festina at [55] and Intuition Publishing ([30] supra) at [64]–[65]).*

(e) *The device component has been found to be an equally significant, if not the dominant, component of a composite mark or sign where:*

(i) *the device is significant and large (see, eg, the decision of the European General Court in New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Case T-415/09) (29 September 2011));*

(ii) *the accompanying word(s) are devoid of any distinctive character, or are purely descriptive of the device component (see Quelle AG ([58] supra) at [60]; see also Sime Darby ([37] supra) at [18] and [20]–[21]) or of similar goods of a superior quality (see the decision of the CFI in Saiwa SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (Case T-344/03) [2006] ECR II-1097 at [41] and [45]);*
or

(iii) *the device component is of a complicated nature (see, eg, Waseem Ghias t/as Griller v Mohammed Ikram t/as The Griller Original, Esmail Adia t/as Griller King, Shahzad Ahmad t/as Griller Hut, Griller Original Limited, Griller Hut Limited [2012] EWPC 3).*

But usually not where:

(iv) *the device is simple and will not evoke any particular concept for the average consumer (see, eg, the decision of the European General Court in Kavaklidere-Europe v Office for Harmonisation in the Internal Market*

(Trade Marks and Designs) (OHIM) and Yakult Honsha Kabushiki Kaisha (Case T-276/09) [2012] ETMR 45);

*(v) the device component does not attract the attention of the average consumer of the goods in question because such a consumer is regularly confronted with similar images in relation to those goods (see *Shaker (CFI)* at [42]); or*

*(vi) the device component is more likely to be perceived as a decorative element rather than as an element indicating commercial origin (see *Trubion ([56] supra)* at [45] and *Oberhauser ([56] supra)* at [47]; see also *Wassen ([56] supra)*).*

35 Applying the above principles to the current case, I am of the view that the marks are similar visually to a low degree for the reasons set out below.

36 From the above analysis, I am of the view that in the current case, the overall impression of the Registered Mark is dominated by the word "INTEL" within the mark. The reason is that the word "INTEL" is large in comparison to the rest of the textual components, is in a prominent location (having regard to the fact that consumers will read from the left to the right) and stands out from the background of the mark as it is in bold font relative to the rest of the marks. This is in comparison to the word "Steer" which is not in bold font. I also note, and agree with the Applicants' submissions, that the word "Steer" starts with a capital "S" and thus distinguishes "Steer" from the word "INTEL". Further and importantly, based on the analysis above, I am of the view that the word "INTEL" is distinctive.

37 In this regard, I note that although the Registered Mark appears in colour, there is no clause in the Register to the effect of the colours.

38 I am of the view that the device on the other hand is relatively simple having regard to the overall scheme of the Registered Mark. At most, I am of the view that the device appears to reinforce the slogan "*efficiency in electrical energy*". In this regard, I am of the view that such a concept would likely be regarded as common in relation to Class 42 services, since Class 42 in the Nice Classification, as the heading already suggests, relates to "*Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software*".

39 In relation to the words "*efficiency in electrical energy*" they appear in much smaller font and are placed at the bottom right hand corner of the Registered Mark. Therefore, in terms of placement in the overall scheme of the Registered Mark, as well as optical prominence, the slogan is much less conspicuous. Further, following the line of thought above, I am of the view that the slogan would also be common in relation to Class 42 services.

40 In light of the above, I am of the view that the Applicants' *INTEL Word Mark* is to a low degree, visually similar to that of the Registered Mark. I draw this conclusion based on an overall visual impression of the marks, bearing in mind, the distinctive and dominant component (this being the word INTEL).

41 The same can be said with regard to the *INTEL Stylised Mark*. I agree with the Applicants that the stylisation (the circular device) only serves to emphasize the word "INTEL" and thus heighten the similarity between the *INTEL Stylised Mark* and the Registered Mark, the Registered Mark having the word "INTEL" "boxed" within a rectangle.

Aural Similarity

42 With regard to aural similarity, I note the Court in *Staywell* stated at [31] and [32] that there are two approaches. One approach is to consider the dominant component of the mark and the other is to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not:

[31] At [21], [24] and [27] of the GD, the Judge considered the word "REGIS" to be the dominant and distinctive component of both marks when each is read out. In our view, she was perfectly entitled to come to this view. Staywell's argument that the Judge erred in considering the dominance of "REGIS" because the Opponents had never used or registered the component "REGIS" alone was misconceived simply because, as we have pointed above, a component can clearly be dominant even if it is part of the mark as a whole and is not and has never been used on its own. In fairness to the Judge, it should be noted that she specifically considered that the "ST." and "Park" portions of the competing marks, though not as dominant as the "Regis" portion, were not to be ignored. Staywell's argument that any distinctiveness of the Opponent's mark lay in "ST. REGIS" as a whole rather than in "REGIS" overlooked the permissibility of examining the distinctive components of the competing marks in both the technical and non-technical senses. At least in relation to hotels and hospitality services, "REGIS" enjoys a substantial degree of technical distinctiveness. In relation to both the competing marks "REGIS" is the element that is distinctive in the non-technical sense because it is what will stand out in the imperfect recollection of the consumer. The Judge was therefore entitled to find this the common dominant element of both marks in assessing the question of whether the competing marks as a whole were similar. The Judge found on this basis that the marks were aurally similar and we agree.

*[32] An alternative approach which does not involve considering the dominant components of the marks would have been simply to undertake a quantitative assessment as to whether the competing marks have more syllables in common than not. This was the approach taken in *Ozone Community* at [55]. Even on this approach it is clear that the two marks, each taken as a unified whole, have more syllables in common than not.*

[Emphasis as underlined mine].

43 The preliminary question in the current case is how would the principles as expounded in *Staywell* be applied to the Registered Mark, which is a composite mark (in this case to refer to a mark which includes a device, words as well as a slogan)?

44 I refer to the recent case of *Fox Racing, Inc. v Fox Street Wear Pte Ltd [2014] SGIPOS 13 ("Fox Case")* where the Registrar had to decide on the application of the principles propounded in *Staywell* to the mark T0503947C as follows:



45 The issue which arose in the *Fox Case* is as follows at [67]:

An interesting issue arises as to how the marks in the present case should be compared from the perspective of aural similarity. Should both marks be regarded simply as “FOX” for the purposes of this comparison? Or would the Opponents’ marks be pronounced “F...X” instead? And, for the Application Mark, must we take into account the presence of the name “Fox Street Wear” and the slogan “What’s stopping you?” as well?

[Emphasis as underlined mine.]

46 After referring to the Court in *Staywell* at [31] and [32], the Registrar concluded as such at [70]:

It could be that the proper approach to take would depend on the facts of each individual case. In the current situation, I am of the view that both marks would be pronounced by the average consumer as “FOX”...

[Emphasis as underlined mine].

I agree. I am of the view that, in the current case, in normal circumstances, the Registered Mark would most likely be pronounced by the average consumer as "INTELSTEER", that is, the slogan "efficiency in electrical energy" will be disregarded.

47 The next question would then be whether the *Applicants’ Earlier Class 42 Marks* would be considered to be aurally similar to the Registered Mark? In this regard, I note that the Registered Mark is pronounced as IN-TEL-STEER (i.e. there are 3 syllables) while the *INTEL Word Mark* and the *INTEL Stylised Mark* would simply be pronounced as "IN-TEL" (i.e. there is only 2 syllables). However, having regard to my opinion (above) that "INTEL" is the more dominant component, I am of the view that

the **INTEL Word Mark** and the **INTEL Stylised Mark** are similar aurally to the Registered Mark to some extent.

Conceptual Similarity

48 The Court in **Staywell** expounded at [35] as follows:

[35]...Unlike the aural analysis, which involves the utterance of the syllables without exploring the composite meaning embodied by the words, the conceptual analysis seeks to uncover the ideas that lie behind and inform the understanding of the mark as a whole (Bently & Sherman at p 866). Greater care is therefore needed in considering what the conceptually dominant component of a composite mark is, because the idea connoted by each component might be very different from the sum of its parts.

[Emphasis as underlined mine]

49 In the current case, the Applicants have submitted that INTEL is a coined word, short for "Integrated Electronics" such that there is no particular conceptual significance.

50 On the other hand, the Registered Proprietors, in **Chung's Evidence** at [8] and [15], stated that the Registered Mark was independently created by a graphic designer on or before 1 July 1995.

51 The Applicants submitted that even if the Registered Proprietors' contention is taken at face value, it has no bearing whatsoever on the objective comparison of the marks. The distinctive and dominant element of the Registered Mark, which is further emphasised by the stylisation, is "INTEL". In that respect, the marks are conceptually similar. The Applicants further submitted that the suffix "Steer" is descriptive and has an ordinary meaning of directing or guiding someone or something in a particular direction. It is not distinctive in nature. If at all "Steer" holds any conceptual significance in the Registered Mark, it is this: "Steer" serves to further highlight the distinctive portion "INTEL" as going towards a specific guided objective. To that extent, it serves to heighten the conceptual similarity.

52 The **Applicants' Earlier Class 42 Marks**, whether it is the **INTEL Word Mark**, or the **INTEL Stylised Mark**, are conceptually meaningless following the Applicants' submission that INTEL is a coined term.

53 With regards to the Registered Mark, I agree with the Applicants to the extent that whatever was the initial concept in creating the Registered Mark, objectively, the Registered Mark, at least in relation to the dominant component "INTEL" is conceptually meaningless. In this regard, I refer to the Court of Appeal in *Sarika Connoisseur Cafe Pte Ltd v Ferrero SpA [2013] 1 SLR 531* ("**Sarika (CA)**") at [34] where the Court referred to *Hyundai Mobis v Mobil Petroleum Co, Inc [2007] SGIPOS 12*:

[34] ...The words “Mobil” and “Mobis” were invented. The PAR observed that while the applicants there argued that “Mobis” was derived from the words “mobile” and “system”, it was not obvious when one sees the word “Mobis” that it meant so...

[Emphasis as underline mine].

54 Following the above, the Registered Mark is conceptually meaningless, at least for the “INTEL” component of the Registered Mark, "Steer" being a common English verb, and having regard to the fact that "Steer" is reflected as a separate word, bearing in mind the overall design of the Registered Mark.

55 This brings me to the next point. In relation to "Steer", being an ordinary English word, I agree with the Applicants that, to the extent that 'steer' means "to direct the course of; guide" in plain English (Dictionary.com), it seems to heighten the conceptual similarity, whatever “INTEL” may mean.

56 Following the above analysis, the only other issue left to be dealt with is whether the device and the slogan "efficiency in electrical energy" colours, and if so, the extent to which it colours, the concept behind the Registered Mark. I have already alluded above that I am of the view that the device seems to reinforce the slogan "*efficiency* in electrical energy". Taken together, I am of the view that both the device and the slogan will imbue the Registered Mark with the concept of “energy efficiency” to some extent.

57 Being mindful of the principle as propounded by the Court in *Staywell* above, I am of the view that the *Applicants’ Earlier Class 42 Marks* (i.e. both the *INTEL Word Mark* and the *INTEL Stylised Mark*) are at most, only marginally conceptually similar to the Registered Mark.

Conclusion on the similarity of marks

58 It is to be recalled following *Staywell* at [17] and [18] above:

[17] ... *The court must ultimately conclude whether the marks, when observed in their totality, are similar rather than dissimilar...*

[18] ... *In short, the criteria of visual, aural and conceptual similarities do not invite a formulaic consideration; rather, they are signposts towards answering the question of whether the marks are similar. Trade-offs can occur between the three aspects of similarity in the marks-similarity inquiry...*

59 Further, the average consumer has an “imperfect recollection” and there is a need to consider the general impression that will likely be left by the essential or dominant features of the marks. However, it is also important to remember that the average consumer is one who would exercise some care and a measure of good sense in making his or her purchases, not that of an unthinking person in a hurry.

60 In light of the analysis above, I am of the view that the marks are similar visually to a low extent, somewhat similar aurally while they are only marginally similar conceptually. Therefore, on the whole, I am of the view that the marks are similar to a low degree in totality.

Similarity of Services

61 As submitted by the Applicants, in relation to this limb, the Court in *Staywell* provided the following principles (albeit *obiter*) at [40], [41] and [43]:

[40] ...Following the dictum of *Lai Kew Chai J in Polo (HC)* at [33], the Judge stated that registration in the same category establishes a *prima facie* case for similarity. This invites some clarification. We think that what *Lai J* was referring to was registration in the same specification. We would go further to say that registration in the same specification within a class establishes a prima facie case for identity.


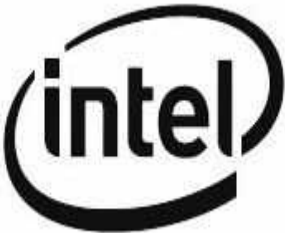
[41] ...Where a good or service in relation to which registration is sought falls within the ambit of the specification in which the incumbent mark is registered, the competing goods or services would be regarded as identical...

[43]...the real question is whether *Staywell's* services that were sought to be registered under Class 35 are similar to the Opponents' services under Class 43, having regard to all relevant factors relating to the services themselves. Some of the factors set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*") at 296 would be relevant at the goods-similarity stage of the inquiry, in particular the consideration of the uses and the end-users of the services. The question is how the services are regarded, as a practical matter, for the purposes of trade...

62 The factors set out in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 ("*British Sugar*"), as submitted by the Applicants, are as follows:

- (a) the respective uses of the respective goods or services;
- (b) the respective users of the respective goods or services;
- (c) the physical nature of the goods or acts of service;
- (d) the respective trade channels through which the goods or services reach the market;
- (e) in the case of self-serve consumer items, whether in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) the extent to which the respective goods or services are competitive.

63 For ease of comparison, the respective services of the *Applicants' Earlier Class 42 Marks* are as follows:

S/N	<i>Applicants' Earlier Class 42 Marks</i>	Registered Mark
1	<p>INTEL T9801120E (11 Feb 1998)</p> <p><u>Computer-related services, namely support and consulting services for computer-related and communications-related goods; providing information in the field of computer and communications technology via the internet; designing standards for use by others in the design and implementation of computer software, computer hardware and telecommunications equipment and services; computer software, computer hardware and network design services for others; all included in Class 42.</u></p>	
2	<p>INTEL T9805379Z (02 Jun 1998)</p> <p>Leasing of computers, computer hardware, peripherals, computer components, computer software, printers, copiers and office furniture.</p>	
3	<p>INTEL T0005306J (31 Mar 2000)</p> <p><u>Web design, engineering and consulting services; internet and web data services; computer services namely providing facilities for access to the global communication network; internet and web service provider services; application service provider services; maintenance and management of web pages and websites; design and implementation of web pages for others; website creation and hosting services; website construction, design and amendment; development of websites.</u></p>	<p><i>“Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software”</i></p>
4		

	T0526942H (30 Dec 2005)	
	<u>Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; managed web hosting and computer network services; providing online access to data storage services [other than by Internet Service Providers]; website hosting and hosting of digital content on the internet; network monitoring services, namely providing information on the operation of computer networks; providing services in the fields of web software customization, user interface design, web site content management and integration; web site development and maintenance; computer and wireless consulting services; providing temporary use of non-downloadable software; computer consulting services; computer custom software and hardware development, design, and consulting services; rental of computer equipment, namely, computers, computer hardware, peripherals, computer components, computer software, computer printers; designing and developing standards for others in the design and implementation of computer software, computer hardware and telecommunications equipment.</u>	

64 It is clear from the above that in relation to the *INTEL Stylised Mark* ie T0526942H, there is a precise overlap in relation to some of the services (as underlined) such that that portion of the services can be considered as identical.

65 In relation to the *INTEL Word Mark*, for example, T9801120E, it would appear that the services (as underlined) are similar. The same can be said of the *INTEL Word Mark* T0005306J. Applying the factors in *British Sugar*, the uses, users and nature of the said services can be said to be similar. The services can also be said to be competitive.

Likelihood of confusion

66 In relation to this limb, the Court in *Staywell* clarified at [56] that there is a distinction between the approach to the confusion inquiry in opposition proceedings and infringement proceeds.

67 The Court elucidated as follows:

[60] Accordingly in opposition proceedings the inquiry must take into account the full range of the competing monopoly rights that are already enjoyed on the one hand, namely the actual and notional fair uses to which the incumbent proprietor has or might fairly put his registered trade mark, and compare this against the full range of such rights sought by the applicant by reference to any actual use by the applicant (assuming there has been prior use) as well as notional fair uses to which the applicant may put his mark should registration be granted...

[Emphasis as underlined mine]

68 The Court in *Staywell* was silent as to the applicable principles in relation to an invalidation action. However, I agree with the Applicants' submission that the principles which relate to an opposition action are more relevant and thus apply in this instant invalidation action.

69 The consequence of the above conclusion is that the Registered Proprietors' evidence that they are "a global specialist in the field of energy efficiency" can only be taken as one instance of the type of services which are within the contemplated uses for which the mark has been registered. Ultimately, it is still necessary to consider the full specification of the services for which the Registered Mark is protected for.

70 In relation to the extraneous factors which can be taken into account at this stage, the Court in *Staywell* expounded as follows at [83] and [96]:

[83] On the effect of the foregoing on the relevant segment of the public – extraneous factors may be considered to the extent that they inform the court as to how the similarity of marks and goods will likely affect the consumer's perception as to the source of the goods...

[96] Based on these considerations, the following represents a non-exhaustive list of factors which we regard as admissible in the confusion inquiry:

*(a) Factors relating to the impact of marks-similarity on consumer perception: the degree of similarity of the marks themselves (see *Hai Tong* at [85(c)(iii)]), the reputation of the marks (see *Polo (CA)* at [34]), the impression given by the marks (see *Polo (CA)* at [28]), and the possibility of imperfect recollection of the marks would all be relevant. Clearly, the greater the similarity between the marks, the greater the likelihood of confusion. As to the reputation of the mark, *Mobil**

Petroleum Co, Inc v Hyundai Mobis [2010] 1 SLR 512 (“Mobil”) at [74] makes it clear that a strong reputation does not necessarily equate to a higher likelihood of confusion, and could in fact have the contrary effect as in McDonald’s Corp v Future Enterprises Pte Ltd [2005] 1 SLR(R) 177 (see at [64]).

*(b) Factors relating to the impact of goods-similarity on consumer perception: it would be legitimate to take into account factors concerning the very nature of the goods without implicating any steps that are taken by the trader to differentiate the goods. This includes the normal way in or the circumstances under which consumers would purchase goods of that type (see [20] above, *Mystery Drinks* at [48], *Lloyd Schuhfabric Meyer v Klijsen Handel BV, Case C-342/97 [1999] 2 CMLR 1343 at 1352; and Philips-Van Heusen Corp v OHIM [2004] ETMR 60 at [55]*). This factor is not directly dependent on the marketing choices that the trader makes. As alluded to at [94] above, it would also be relevant to have regard to whether the products are expensive or inexpensive items, the nature of the goods and whether they would tend to command a greater or lesser degree of fastidiousness and attention on the part of prospective purchasers (see generally *Hai Tong* at [85(c)(i)]), and the likely characteristics of the relevant consumers and whether they would or would not tend to apply care or have specialist knowledge in making the purchase. We refer here to *In the matter of an Application by the Pianotist Company for the Registration of a Trade Mark (1906) 23 RPC 774 (“Pianotist”)* where it was observed that, having regard to the nature of the article in question (musical instruments), the (high) price at which it was likely to be sold, and the nature of the consumers who are likely to purchase such products (“generally persons of some education”), a man of ordinary intelligence was unlikely to be confused (at 778). The price of the type of product being sold is distinct from the issue of price disparity between the parties’ products. The former consideration directly impinges on the degree of care the consumer is likely to pay to his purchase and therefore his ability to detect subtle differences. As observed in *Reed Executive Plc v Reed Business Information Ltd [2003] RPC 12 at [103]*, “a 50 pence purchase in the station kiosk will involve different considerations from a once-in-a-lifetime expenditure of 50,000 pounds”. On the other hand, superficial price disparity between the competing goods, which speak more about the trader’s marketing choices rather than differences in the nature of the goods themselves, is not a factor we find relevant to the inquiry.*

[Emphasis as underlined mine].

71 I will proceed to apply the above principles to the current case.

72 With regards to mark similarity, I have already concluded above that the Applicants' Earlier Class 42 Marks are only similar to a low degree to the Registered Mark. The general impression that is generated is that the marks are similar to a low extent, given the dominant component of the Registered Mark being the word "INTEL" (despite the Registered Mark being a composite mark) and given the distinctiveness, both inherent or acquired, of the word “INTEL” in the *INTEL Word Mark* and the *INTEL*

Stylised Mark. Given the possibility of imperfect recollection of the marks, I am of the view that there is a low likelihood of confusion.

73 In terms of the factors relating to similarity of services, at the outset, I note that the specification under the Registered Mark in question:

“Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software”

being the class heading of Class 42, is rather broad to begin with. I also note that the services tend to be rather technical / specialist in nature. I note the following Explanatory note to Class 42 extracted from the WIPO website:

Explanatory Note

Class 42 includes mainly services provided by persons, individually or collectively, in relation to the theoretical and practical aspects of complex fields of activities; such services are provided by members of professions such as chemists, physicists, engineers, computer programmers, etc.

[Emphasis as underlined mine]

74 Before I proceed any further, it is to be recalled that there is a precise overlap in relation to some of the services under the ***INTEL Stylised Mark*** (i.e. T0526942H) and the Registered Mark while there is a similarity in the services of interest between the ***INTEL Word Mark*** (in particular T9801120E and T0005306J) and the Registered Mark.

75 With regard to the overlapping ie identical services (namely “*scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software*”), it would appear that following the above observations (that the range of services is rather broad), the purchasing circumstances, price range and the character of the purchaser of the services will vary depending on the actual service sought to be bought. However, it would appear that the services, being technical in nature, would not tend to be inexpensive. Further, given the technical as well as specialist nature of the service, it would not be far fetched to imagine that the purchaser would probably need to enquire, deliberate or even seek the advice of the sales personnel before embarking on the purchase. The same can be said in relation to ***INTEL Word Mark*** T9801120E.

76 In relation to a comparison between the ***INTEL Word Mark*** and the Registered Mark, I refer in particular to T0005306J where an excerpt of the services registered under this mark, are, for example, “*design and implementation of web pages for others and development of websites*”. Again, these services are not inexpensive and although they are not as technical as those referred to above, the purchasing process is likely to be an unhurried one which involves some enquiry as to the specifics and some deliberation.

77 In both examples, they are not services that are purchased off the cuff without much thought. The consumer is likely to go through a process of deliberation and interactive engagement with a sales person, before coming to a purchase decision.

78 On balance, taking into account the permissible extraneous factors, I do not find a reasonable likelihood of confusion that services bearing the Registered Mark and the *Applicants' Earlier Class 42 Marks* emanate from the same undertaking.

79 Before I leave this ground, I note that the Applicants made extensive reference to the survey encompassed in *Yong's Evidence*. In fact, the Applicants relied extensively on the results of the survey for the purpose of this element.

80 However, I am of the view that the survey does not assist much in relation to *this element* for the following reasons.

Survey Evidence

81 *Yong's Evidence* essentially comprises of a survey which was conducted under the instructions of the Applicants (or Opponents for the related opposition matter in relation to T0903111F) at [8]. In particular, I refer to exhibit YTP-1 of *Yong's Evidence* at page 12 which is the final report prepared for the agent for the Applicants, Drew & Napier LLC.

(i) Key Objectives

82 I refer to page 15 of of *Yong's Evidence*. The key objectives of the survey are:

- (i) to understand if the Applicants are well known to the public at large;
- (ii) to understand the impressions of the INTEL brand and 3 other brands (see "Related Matters" above) namely:-
 - Identifying whether the test brands are causing confusion with the INTEL brand;
 - Assessing whether consumers perceive the test brands to be linked to the INTEL brand in any way.

Methodology

83 I refer to exhibit YTP-1 at page 15 of of *Yong's Evidence*. Face-to-face intercept interviews were conducted from 3 – 10 June 2010 around three areas: Bugis area in Central Singapore, Tampines Mall and Century Square in eastern Singapore and Jurong Point in western Singapore.

84 In terms of the sample composition for the survey, the target audience is the general adult population aged 18-55 who are English literate. Demographics quotas applied are based on national proportions according to the yearbook of statistics 2008/2009:

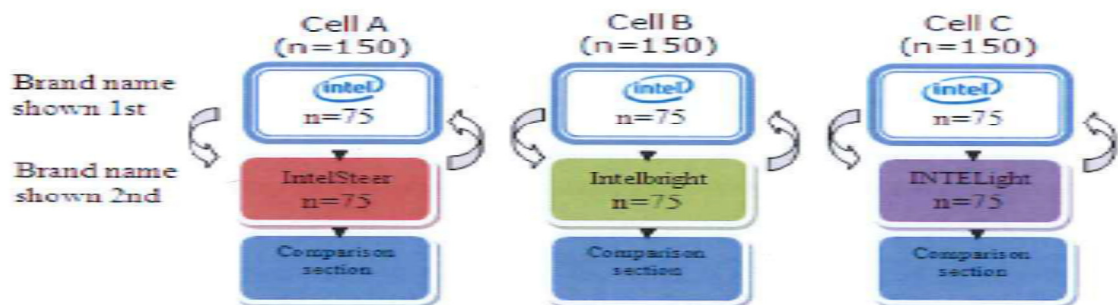
Age (years old)		Gender		Monthly Household Income (SGD)		Race	
18-24	16%	Male	50%	Below 2000	23%	Chinese	75%
25-29	12%			2000 - 3499	27%	Malays	13%
30 -34	13%			3500 - 4999	24%	Indians	9%
35 - 39	14%	Female	50%	5000 - 7999	20%	Others	3%
40 - 44	14.5%			8000 and above	6%		
45 - 55	30.5%						

85 The first 5 screening questions were asked to respondents regarding their citizenship, occupation, participation in market research studies, gross household monthly income and age. Those who are in the media and market research industries and those who are in the computing industries were screened out to prevent conflict of interest and to reach a neutral general public sample. Every 5th passer by was approached to ensure randomness.

Research Design and Questionnaire

86 *Each* consumer was asked about their level of awareness, impressions and understanding of the INTEL brand and *one* of the test brands (as mentioned above, this action is related to 2 other matters – see above at [3]). There were 3 cells. In each cell, the respondents evaluated one of the test brands together with the INTEL brand sequentially monadically. The order of evaluating each of the test brands was rotated equally to avoid trial order bias.

87 In order to ensure a sufficiently robust sample size, *each* of the test brands was evaluated with the INTEL brand amongst 150 respondents in a separate cell. Given that the INTEL brand was evaluated in all 3 cells, the survey had a total sample size of 450 for the INTEL brand. The table below is a figurative representation of the survey:



Assessment of Potential Confusion

88 Assessment of confusion was done at 2 levels. First, based on just hearing the brand names aurally and second with the aid of brand logos.

89 The brand names were first read out to the respondents. The respondents were then asked whether they felt that the test brand belonged to the same business organisation as the INTEL brand on the basis of just hearing the brand names aurally. The results would indicate whether the general public, with no knowledge about the brands apart from having heard of the brand name aurally, is likely to think that these brands are part of the same group as the INTEL brand (see *Yong's Evidence* at [16] and [17]).

90 Next, the 2 logos of the respective brands were shown to the respondents. The respondents were then asked the same question, that is, whether they felt that the test brand belonged to the same business organisation as the INTEL brand (see *Yong's Evidence* at [19]).

91 An excerpt of the key findings are as follows:

- (i) The survey found that a majority of the general public in Singapore ie 85% is aware of the Applicants and what they do as a company. When asked of their awareness of the INTEL brand, 85% of the respondents mentioned that they have heard of the Applicants, and they correctly indicated that the Applicants are an IT / computer related company (specifically "IT / computer related" - 69% and for "processors / chips" - 25%).
- (ii) Based on just hearing the names aurally, a significant proportion of the respondents felt that the respective test brands are associated with the INTEL brand and perceive that they are in the IT / computer related business. 51% of the respondents agreed that the INTELSTEER brand is part of the same business organisation as the INTEL brand (see *Yong's Evidence* at [22]).
- (iii) When the respondents were shown logos of the test brands, they were significantly less likely to think that they are from the same business as INTEL. However, a third of the respondents (31%) still felt that the "INTEL" brand and the INTELSTEER brand belong to the same business organisation (see *Yong's Evidence* at [23]).

92 The Applicants submitted that where a survey is tendered, a court or a tribunal must determine the weight to be accorded to the survey results. The Applicants referred to the guidelines which were provided in *Imperial Group Ltd v Philip Morris & Co [1984] RPC 293* ("**Imperial Group**") which was considered by the High Court in *Ferrero SPA v Sarika Connoisseur Cafe Pte Ltd [2011] SGHC 176* ("**Sarika (HC)**"), and submitted that out of all the guidelines, the most difficult to comply is the guideline which provides that:

The questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put.

93 The Applicants submitted that the survey was a rigorous one. They submitted that the questions asked were of a broad nature. As far as possible, they were not leading questions. In this regard, the following points are noted:

- (i) in the survey, when comparing the marks, half of the respondents were asked “have you heard of the brand INTEL” first whereas the other half were asked “have you heard of the brand INTELSTEER” first. The Applicants submitted that this evens out the effect of having the first brand stick in the mind of the respondent.
- (ii) The survey respondents were asked questions aurally before being given a chance to see a visual representation of the marks. If it had been the other way round, the visual representation would have stayed in the mind of the customer possibly affecting the accuracy of the aural comparison.
- (iii) The questions asked were very broad in nature. Respondents were asked questions such as “Anything comes to mind? Anything else? Do you know what XXX does?” They were not leading questions nor did they lead the respondent into the realm of speculation.

94 The full list of questions is as follows:

S/N	Questions
1/2	Have you heard of the brand [Interviewer read out – INTEL / INTELSTEER]?
3/4	Regardless of whether you have heard of the brand [Interviewer read out - INTEL / INTELSTEER] can you tell me anything that comes to your mind when I say the brand [Interviewer read out - INTEL / INTELSTEER]? Anything else? And do you know what the brand [Interviewer read out - INTEL / INTELSTEER] does as a company? Anything else?
5	Thinking about [INTEL / INTELSTEER] and [INTEL / INTELSTEER], do you think they are part of the same group or business organisation?
6	Now looking at the logos for these two brands, do you think they are part of the same group or business organisation?

95 The High Court in *Sarika (HC)* at [134] provided the guidelines as expounded in *Imperial Group* as follows:

[134] In Imperial Group, albeit in the context of “confusion” in the law of passing off, Whitford J provided useful analysis of the market surveys in that case, as well as the weight to be accorded to them. The following guidelines may be distilled from the learned judge’s observations. These should, of course, not be taken as an exhaustive list – they are merely guidelines to consider in determining the weight to be accorded to survey results. The guidelines are:

- (a) the interviewees in the survey must be selected so as to represent the relevant cross-section of the public;*

- (b) the size of the survey must be statistically significant;*
- (c) the survey must be conducted fairly;*
- (d) all the surveys carried out must be disclosed, including the number of surveys carried out, how they were conducted and the totality of the persons involved;*
- (e) the totality of the answers given must be disclosed and made available to the defendant;*
- (f) the questions must neither be leading, nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put;*
- (g) the exact answers and not some abbreviated form should be recorded;*
- (h) the instructions to the interviewers as to how to carry out the survey must be disclosed; and*
- (i) where the answers are coded for computer input, the coding instructions must be disclosed.*

96 To the extent that the survey evidence tendered by the Applicants have tried to address the issue of leading questions, I agree that the survey evidence tendered is rigorous *in this regard*.

97 However, I do not think it is appropriate for the Applicants to draw an analogy with the Courts (both High Court and the Court of Appeal) in the case of *Sarika (HC)* and *Sarika (CA)* at [92] of their submissions:

*Following [*Sarika (HC)* and *Sarika (CA)*], it is clear that whether the 51% (aural comparison only) figure is taken or the lower 31% (visually aided comparison) figure is taken, the evidence is more than sufficient to establish a likelihood of confusion on the part of a substantial portion of the public.*

This is because while it is true that in *Sarika (HC)* in the High Court, in relation to this element of confusion, approximately 30% of the each of the Defendant's (see [105] of the case) and the Plaintiff's (see [123] of the case) survey showed that there was confusion in that case, however, critically, the *base number* for the Registered Mark in the current case is only 150. In *Sarika (HC)* in the High Court, the sample size of the survey conducted by the Defendants was 500 (see [104] of the case) while the sample size of the survey conducted by the Plaintiffs was 410 (see [123] of the case). 30% of 500 is 150 whilst 30% of 410 is 123. In contrast, 51% of 150 is 76 whilst 31% of 150 is 46.

98 I am mindful that the Court of Appeal in *Sarika (CA)* held that:

The test for determining likelihood of confusion was whether a substantial portion of the relevant public would be confused. There had to not be an insubstantial number of the relevant public being confused. This standard was above de minimis and had to be appreciable, though it was unnecessary to show confusion of a majority of the relevant public

[Emphasis as underlined mine].

However, the Applicants did not make any further submissions as to what would be an appropriate base sample size apart from drawing an analogy with the *Sarika (HC)* and *Sarika (CA)*.

99 The Court in *Staywell* has clarified that the doctrine of initial interest confusion does not apply to the trade marks law in Singapore. The author, Ng-Loy Wee Loon, in *Law of Intellectual Property of Singapore (Sweet & Maxwell, 2014 Rev Ed)* ("**Law of Intellectual Property of Singapore**") provided an explanation of what the doctrine entails at [18.3.3]:

[18.3.3] In some cases, it is possible that the relevant public was confused at some point in time prior to the purchase, but this confusion was dispelled by the time of purchase. This dispelling of the initial confusion may be the result of the potential purchaser making further enquiries or other checks. This type of confusion – which initially existed but was no longer present at the purchase point - has been referred to as “initial interest confusion”.

100 I am of the view that even if there is some possibility of initial confusion between the Registered Mark and the *Applicants’ Earlier Class 42 Marks*, as discussed above, in light of (i) the nature of the services which are not cheap; (ii) the fact that they are technical / specialist in nature; and (iii) the purchasing process of the services, any possibility of confusion would be dispelled by the time of purchase.

In any event I note that the Court of Appeal in *Sarika (CA)* commented at [64]:

[69] Survey evidence is relevant in assessing whether there is a likelihood of confusion on the part of the relevant public. That said, we agree with the Judge that survey evidence should not be conclusive (see [129] of GD). Rather, it is only one factor in the global confusion analysis.

101 In light of the above, the survey evidence does not assist the Applicants much (perhaps only to some extent for the purposes of the mark to mark comparison) for the purposes of this objection. I am heartened to note that the approach which I have taken is consistent with the approach taken by the High Court in the recent case of *Societe Des Produits Nestlé SA and another v Petra Foods Ltd and another [2014] SGHC 252*, which was published only after the hearing of this matter.

102 The ground of invalidation under Section 23 read with Section 8(2)(b) therefore fails.

Ground of Invalidation under Section 23(3)(a)(iii) read with Section 8(4)(b)(i)

103 The relevant provisions of the Act read:

23.—(3) *The registration of a trade mark may be declared invalid on the ground —*

(a) that there is an earlier trade mark in relation to which —

(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8(4) apply...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

8.—(4) *Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —*

(a) the earlier trade mark is well known in Singapore; and

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or

Decision on Section 23(3)(a)(iii) read with Section 8(4)(b)(i)

Similarity of marks

104 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark".

105 The Applicants repeat their submissions in relation to the ground under Section 8(2)(b).

106 In relation to this element, my view is primarily the same in relation to the similar element under Section 8(2)(b), that is, the ***INTEL Word Mark*** and the ***INTEL Stylised Mark*** are similar to the Registered Mark to a low degree. I will not repeat my analysis here.

Well-known in Singapore

107 The critical question is whether the ***Applicants' Earlier Class 42 Marks*** are well known in Singapore as at the relevant date of 20 March 2009, which is the date registration of the Registered Mark.

108 The relevant provisions in the Act in relation to this element are as follows:

Section 2(7) of the Act states:

Subject to subsection (8), in deciding, for the purposes of this Act, whether a trade mark is well known in Singapore, it shall be relevant to take into account any matter from which it may be inferred that the trade mark is well known, including such of the following matters as may be relevant:

- (a) the degree to which the trade mark is known to or recognised by any relevant sector of the public in Singapore;*
- (b) the duration, extent and geographical area of –
 - (i) any use of the trade mark; or*
 - (ii) any promotion of the trade mark, including any advertising of, any publicity given to, or any presentation at any fair or exhibition of, the goods or services to which the trade mark is applied;**
- (b) any registration or application for the registration of the trade mark in any country or territory in which the trade mark is used or recognised, and the duration of such registration or application;*
- (d) any successful enforcement of any right in the trade mark in any country or territory, and the extent to which the trade mark was recognised as well known by the competent authorities of that country or territory;*
- (e) any value associated with the trade mark.*

Section 2(8) of the Act reads:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

Section 2(9):

In subsections (7) and (8), “relevant sector of the public in Singapore” includes any of the following:

- (a) all actual consumers and potential consumers in Singapore of the goods or services to which the trade mark is applied;*
- (b) all persons in Singapore involved in the distribution of the goods or services to which the trade mark is applied;*
- (c) all businesses and companies in Singapore dealing in the goods or services to which the trade mark is applied.*

109 In relation to the provisions above, case law, specifically *Novelty Pte Ltd v Amanresorts Ltd and another* [2009] 3 SLR(R) 216 ("*Amanusa*") has provided much guidance:

[137]...It appears that the court is ordinarily free to disregard any or all of the factors listed in s 2(7) as the case requires (subject to [Section 2(7)(a) of the Act]), and to take additional factors into consideration....

...

[139] Despite what has been said earlier, it can be persuasively said that s 2(7)(a) is arguably the most crucial factor when determining whether a trade mark is well known in Singapore. This is because, by virtue of s 2(8) of the current TMA:

Where it is determined that a trade mark is well known to any relevant sector of the public in Singapore, the trade mark shall be deemed to be well known in Singapore.

...

[229] Finally, it will be recalled that it is not too difficult for a trade mark to be regarded as "well known in Singapore" – essentially, the trade mark in question need only be recognised or known by "any relevant sector of the public in Singapore" [emphasis added] (see s 2(7)(a) of the current TMA), which sector could in certain cases be miniscule...

[Emphasis as underlined mine].

110 Finally, the Court in *Amanusa* discussed the ambit of the phrase "all actual consumers and potential consumers in Singapore of the goods" at [152] and concluded that "the inquiry is much more focused and manageable if one looks only at the specific goods or services to which the Applicants' trade mark has been applied (that is, if one considers only the Applicants' goods or services)."

111 In light of the above, I am prepared to hold that the *Applicants' Earlier Class 42 Marks* are well known in Singapore.

Confusing connection

112 In this regard, the Court at *Staywell* provided as such at [120]:

...As for the third element, the detailed analysis in Amanresorts has put it beyond doubt that the connection requirement of s 8(4)(b)(i) and s 55(3)(a) of the Act will be satisfied where there is a likelihood of confusion (see Amanresorts at [226] and [233])....

113 For the same reasons that I have held that there is no likelihood of confusion under Section 8(2)(b), I am of the view that this limb has not been made out as well.

Damage

114 As the element above has not been made out, there is no need for me to dwell on this element of damage.

115 Before I leave this ground I note that *even if* I consider this ground in relation to the other goods / services rendered by the Applicants, in particular, in relation to the Applicants' goods in Class 9 (for reasons which will be obvious below; it is pertinent to note that there is no requirement for the goods / services in question to be similar under this ground of objection), the result would, in all likelihood, be similar to that of the ground of objection under passing off (see below). In *Sarika (CA)*, the Court of Appeal held at [77] that:

[77] The Judge found that there was a confusing connection based on his finding of confusing misrepresentation in the passing off action (see GD at [166]), which was in turn based on his finding of a likelihood of confusion under s 27(2)(b) TMA (see GD at [212]). Given that the test for the “connection” requirement is similar in substance to the test for the misrepresentation requirement in passing off (the findings of which were in turn based on the findings made in relation to the likelihood of confusion element in s 27(2)(b) TMA), and the distinction between the tests (see [76] above) does not result in any effective difference on the present facts, we find no reason to disagree with the Judge that there is the requisite confusing connection under s 55(3)(a) TMA here.

116 It will be pertinent to note before I leave this limb that while the test for the “likelihood of confusion” / “misrepresentation” / “confusing connection” is the same and therefore may result in the same conclusion, in some circumstances, this may not be so. The reason is that the ground objection under Section 8(2)(b) only relates to similar goods / services whilst there is no such restriction for the grounds of objection under Section 8(4)(b)(i) and passing off.

117 For the purposes of the current case, as concluded above, I am of the view that an application of the test for “likelihood of confusion” / “confusing connection” will result in the same conclusion for the purposes of the services in relation to Class 42, while an application of the test for “confusing connection” / “misrepresentation” will also result in the same conclusion in relation to the Applicants’ products in Class 9.

Conclusion on Section 23(3)(a)(iii) read with 8(4)(b)(i)

118 The objection under this Section 23 read with Section 8(4)(b)(i) fails.

Ground of Invalidation under Section 23(3)(a)(iii) read with 8(4)(b)(ii)

119 The relevant provisions of the Act read:

23.—(3) *The registration of a trade mark may be declared invalid on the ground —*

(a) that there is an earlier trade mark in relation to which —

(iii) where the trade mark has been registered pursuant to an application for registration of the trade mark made on or after 1st July 2004, the conditions set out in section 8(4) apply...

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

8.—(4) *Subject to subsection (5), where an application for registration of a trade mark is made on or after 1st July 2004, if the whole or an essential part of the trade mark is identical with or similar to an earlier trade mark, the later trade mark shall not be registered if —*

(b) use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered —

(ii) if the earlier trade mark is well known to the public at large in Singapore;
(A) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or

(B) would take unfair advantage of the distinctive character of the earlier trade mark.

Decision on Section 23(3)(a)(iii) read with 8(4)(b)(ii)

Similarity of marks


120 In relation to this ground, it is clear that the first element that must be satisfied is that "the whole or essential part of the trade mark must be identical or similar to an earlier mark".

121 I have already concluded that the Applicants' ***INTEL Word Mark*** and the ***INTEL Stylised Mark*** in Class 42 are somewhat similar to the Registered Mark under the ground under Section 8(2)(b). I will not repeat my analysis here.

122 However, in relation to the ground of objection under Section 8(4), it is pertinent to note that there is no restriction that the goods / services must be similar. The significance of this for the purposes of the current case is that it opens up the different marks which have been registered by the Applicants in relation to a whole host of goods / services (it is noted that there is another list of marks applied for by the Applicants but these will not be considered here).

123 It is noted that aside from Class 42, the Applicants also own numerous registrations of variants of the INTEL marks in Singapore. A list of such marks is provided at Annex A of the Applicants' Grounds of Invalidation attached to Form TM 28. At this point, I note that there are several variants of the Applicants' marks registered in relation to Class 9, an excerpt of which is as follows (collectively, including the *Applicants' Earlier Class 42 Marks*, "*Applicants' Earlier Marks*"):

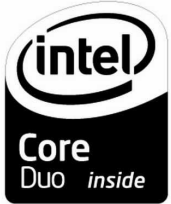

S/N	Registered Mark	Registration Number /Date	Class / Specification
1	INTEL	T9501736I	<p>Class 09 Apparatus and instruments, all for processing, storage retrieval, transmission, display, input, output and printout of data; computers, computer terminals and printers for use therewith; video display units; 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 recognizing 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; workstations; 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 programs and computer</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			software; all included in class 9.
5		T0526938Z	<p>Class 09 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; 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 and computers; fire extinguishing apparatus; navigation, electronic, regulating and rescue apparatus and instruments; tape recorders, sound records; apparatus and instruments, all for monitoring, detecting, testing and measuring; floppy disc driving apparatus; electronic security apparatus; surveillance apparatus; apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, images, graphics, and data; algorithm software programs for the operation and control of computers; electronic apparatus and instruments, all for recognizing digital and analog codes; control apparatus for all the aforesaid goods; computer operating system software; computer operating programs; computer system extensions, tools and utilities in the field of application software for connecting personal computers,</p>



S/N	Registered Mark	Registration Number /Date	Class / Specification
			<p>networks, telecommunications apparatus and global computer network applications; computerized telecommunications and networking equipment consisting of operating system software, modems, cameras, headsets, microphones, cables and adaptors; computer games; racks, cabinets and holders, all adapted for the aforesaid goods; audio and video graphics apparatus for real time information and image transfer, transmission, reception, processing and digitizing; computer firmware; computers; handheld computers; microcomputers; minicomputers; computer installations; memory boards; processing apparatus; personal digital assistants; cellular telephones; smart phones; portable and handheld personal organizers; computer hardware; integrated circuits; integrated circuit memories; integrated circuit chips; computer chip-sets; semiconductor processors; semiconductor processor chips; semiconductor chips; microprocessors; printed circuit boards; electronic circuit boards; computer motherboards and daughterboards; chipsets; computer memory devices; operating systems; computer programs; microcontrollers; data processors; central processing units; semiconductor memory devices; software programmable processors; digital and optical processors; computer peripherals; video circuit boards; audio circuit boards; audio-video circuit boards; video graphic accelerators; multimedia accelerators; video processors; video processor boards; semiconductor processor die packing and casings [interfaces for</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			<p>computers]; cards, discs, tapes, wires, records, microchips and electronic circuits, all for the recordal and transmission of data; modems; apparatus and instruments, all for processing, storage, retrieval, transmission, display, input, output, compressing, decompressing, modifying, broadcasting and printout of data; computer input and output devices; work stations [computers]; data memories; storage devices; security systems for computer hardware and software; set electronic chips; components for computers and printed circuits; voice accelerators; data, image and video; voice, data, image and video accelerators; flash memories; flash memory devices; memory systems for computers; telecommunications equipment and computer networks, namely processing and operating systems programs; headsets; mice; microphones; cables and adapters; computer terminals and printers for use therewith; video display units; telecommunications apparatus and instruments; cameras; 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; set-top boxes, electronic control devices for the interface and control of computers and</p>


S/N	Registered Mark	Registration Number /Date	Class / Specification
			<p>global computer and telecommunications networks with television and cable broadcasts and equipment; routers; hubs; servers; switches, electric; apparatus for testing and programming integrated circuits; peripheral memory apparatus and devices; computer firmware, namely computer operating systems software; fixed function servers; computer networking hardware; semiconductor devices; computer hardware and software for creating, facilitating, and managing remote access to and communication with local area networks (LANs), virtual private networks (VPN), wide area networks (WANs) and global computer networks; router, switch, hub and server operating software; network interface cards, routers, and adaptors; computer software and hardware for use in providing multiple user access to a global computer information network for searching, retrieving, transferring, manipulating and disseminating a wide range of information; computer software tools for the facilitation of third party software applications; computer hardware and software for wireless network communications; downloadable electronic publications in the area of electronics, semiconductors and integrated electronic apparatus and devices, computers, telecommunications, entertainment, telephony, and wired and wireless telecommunications; instructional materials relating to computers recorded magnetically, electronically or optically; equipment, apparatus and devices that collect, measure, record, process, transmit,</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			receive, reproduce, modify, compress, decompress, broadcast, merge and/or enhance data and information related to the welfare and well being of individual patients; parts and fittings for all the aforesaid goods; and electronic manuals (downloadable) sold as a unit and downloadable from a global computer network.
	INTEL CORE	T0517121E	Class 09 Data processing hardware, computers, semiconductors, microprocessors and other semiconductor devices, integrated circuits, computer chipsets, computer motherboards and daughterboards, software, programmable processors.
		T0525559A	Class 09 Data processing hardware, computers, semiconductors, microprocessors and other semiconductor devices, integrated circuits, computer chipsets, computer motherboards and daughterboards, software, programmable processors.
		T0525556G	Class 09 Data processing hardware, computers, semiconductors, microprocessors and other semiconductor devices, integrated circuits, computer chipsets, computer motherboards and daughterboards, software, programmable processors.
	INTEL INSIDE	T0902498E	Class 09 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission


S/N	Registered Mark	Registration Number /Date	Class / Specification
			<p>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 and computers; Fire-extinguishing apparatus; Apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, signals, software, information, data and code; Computers; Notebook computers; Laptop computers; Portable computers; Handheld computers; Personal digital assistants; Personal media players; Mobile telephones; Smart phones; Digital cameras; Servers; Computer workstations; Computer hardware; Computer and telecommunications networking hardware; Computer network adaptors, switches, routers and hubs; Wireless and wired modems and communication cards and devices; Computer firmware for use in operating and maintaining the computer system; Computer software; Semiconductors; Microprocessors; Integrated circuits; Central processing units; Microcomputers; Computer chipsets; Computer motherboards and daughterboards; Computer graphics boards; Computer peripherals and electronic apparatus for use with computers; Parts, fittings, and testing apparatus for all the aforesaid goods; Downloadable electronic publications in the area of computers, telecommunications, telephony, and wireless communications; Digital video recorders; Set top and set back</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			boxes; Televisions.
		T9105906G	Class 09 Microprocessors in international class 9.
		T0526768I	Class 09 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; 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; fire extinguishing apparatus; notebook computers; laptop computers; portable computers; handheld computers; personal digital assistants; personal media players; mobile telephones; smart phones; digital cameras; computer workstations; servers; computer hardware; computer and telecommunications networking hardware; computer network adaptors, switches, routers and hubs; wireless and wired modems and communication cards and devices; computer firmware for use in operating and maintaining the computer system; computer software; semiconductors; microprocessors; integrated circuits; central processing units; microcomputers; computer chipsets; computer motherboards and daughterboards; computer graphics

S/N	Registered Mark	Registration Number /Date	Class / Specification
			boards; computer peripherals and electronic apparatus for use with computers; parts, fittings, and testing apparatus for all the aforesaid goods; downloadable electronic publications in the area of computers, telecommunications, telephony, and wireless communications.
	INTEL INSIDE CENTRINO	T0218457Z	<p>Class 09 Microprocessors, telephones, computer hardware and software for telecommunications; computers and their parts and peripherals, data processing units and their parts; computer software; semiconductors, and other semiconductor devices; integrated circuits; computer chipsets; computer motherboards and daughterboards; microcomputers; computer workstations; software programmable processors; notebook and laptop computers; portable computers; handheld computers; personal digital assistants; computer firmware and operating system software; computer and telecommunications networking hardware and software; servers; computer network adapters, switches, routers and hubs; wireless and wired modems and communication cards and devices; mobile telephones; accessories, parts, fittings and testing apparatus for the aforementioned goods; photographic, cinematographic, optical, weighing, measuring, signaling, controlling, teaching apparatus and instruments; apparatus for recording, transmission and reproduction of sound, video and data; magnetic data carriers.</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
		T0219750G	<p>Class 09 Scientific, electric apparatus and instruments, as far as included in Class 9, optical signalling, checking and teaching apparatus and instruments; apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data; apparatus and instruments, all for processing, storage retrieval, transmission, display, input, output and printout of data; apparatus and instruments, all for monitoring, detecting, testing and measuring; magnetic data carriers; data processing equipment; computers; computer hardware; semiconductors; microprocessors and other semiconductor devices; integrated circuits; computer chipsets; computer motherboards and daughterboards; microcomputers; computer workstations; software programmable processors; notebook and laptop computers; portable computers; handheld computers; computer peripherals; personal digital assistants; computer software; computer firmware and operating system software; computer and telecommunications networking hardware and software; servers; computer network adapters, switches, routers and hubs; wireless and wired modems and communication cards and devices; global communications network and web servers; global communications network and web caching servers; global communications network and web terminals; global communications</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			network and web appliances; telecommunications apparatus and instruments; telephones; mobile telephones; apparatus and equipment for use in video-conferencing, teleconferencing, document exchange and editing; accessories, parts, fittings and testing apparatus for the aforementioned goods; all included in Class 9.
	INTEL INSIDE XEON	T9907501J	<p>Class 09</p> <p>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,</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			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 global communications network; 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 user manuals for use with, and sold as a unit with, all the aforesaid goods; all included in Class 9.
		T0525466H	Class 09 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; 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 and computers; fire-extinguishing apparatus; computers; computer hardware; computer firmware for use in operating and maintaining the computer system; semiconductors; microprocessors; integrated circuits; microcomputers; computer chipsets; computer motherboards and daughterboards; computer graphics boards; computer networking

S/N	Registered Mark	Registration Number /Date	Class / Specification
			<p>hardware; computer network adaptors, switches, routers and hubs; computer peripherals and electronic apparatus for use with computers; keyboards; trackballs; computer mouse devices; computer input devices; computer monitors; video apparatus; video circuit boards; apparatus and equipment for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging and/or enhancing sound, video images, graphics, and data; algorithm software programs for the operation and control of computers; computer component testing and calibrating electronic units; set-top boxes, namely, electronic control boxes for the interface and control of computers and global computer networks with television and cable broadcasts and equipment; 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 global computer networks; telecommunications apparatus and instruments; apparatus and equipment for use in video-conferencing, teleconferencing, document exchange and editing; cameras and digital cameras for use with computers; headsets for use with computers, computer software, video-conferencing equipment and</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			teleconferencing equipment; parts, fittings, and testing apparatus for all the aforesaid goods; and electronic user manuals (downloadable) for use with, and sold as a unit with, all the aforesaid goods.
	INTEL XEON	T9907502I	<p>Class 09 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</p>

S/N	Registered Mark	Registration Number /Date	Class / Specification
			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 user manuals for use with, and sold as a unit with, all the aforesaid goods; all included in Class 9.

124 The issue that has to be addressed at this point is whether the Applicants' marks in relation to Class 9 above can be considered to be similar to the Registered Mark. For the same reasons that I am of the view that the *Applicants' Earlier Class 42 Marks* are similar to the Registered Mark, I am of the view that they are.

125 In this regard I am of the opinion that the *Applicants' Earlier Marks* all contain the word INTEL which remains, consistently, as the main distinctive component of the Applicants' marks. In coming to this conclusion, I make particular note of the fact that the word "INTEL" is distinctive (both inherently and particularly, through use). The evidence that has enabled me to come to this conclusion has been referred to above and I will not belabour the point (further elaboration of the evidence which relates to the distinctiveness issue can be found below).

Well-known to the public at large

126 Again, the critical question is whether the *Applicants Earlier Marks* are well known to the public at large (in Singapore) as at the relevant date of 20 March 2009, which is the date registration of the Registered Mark.

127 In relation to the element, it is clear that the relevant provisions and case law which relate to the limb "well known in Singapore" (as referred to above) applies. The Court in *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier [2009] SGCA 53* held:

In the context of s 55(3)(b)(i) of the Act, the test "well known to the public at large in Singapore" had to mean more than just "well known in Singapore". To come within the former test, the mark had to necessarily enjoy a much higher degree of recognition. It had to be recognised by most sectors of the public though the court would not go so far as to say all sectors of the public.

128 In addition to those provisions, the Court in *Amanusa* provided at [233]:

...A second, much more extensive level of protection is granted to trade marks which have attained the coveted status of being “well known to the public at large in Singapore”. These trade marks, which form a rare and exclusive class, are entitled to protection from use of the defendant’s trade mark on dissimilar goods or services even in the absence of a likelihood of confusion; that is, such trade marks are entitled to protection against the unfair dilution and the taking of unfair advantage of their distinctive character...

[Emphasis as underlined mine].

129 In relation to this element, the Applicants submitted at [101] of their submissions, that it is plain from the evidence adduced and the submissions made that the **INTEL Word Mark** and the **INTEL Stylised Mark** not only meet but far outstrip the threshold of being well known to the public at large in Singapore. The Applicants highlighted the following which relates to the factors under Section 2(a), (b) and (e) of the Act:

- (i) There is survey evidence demonstrating 85% consumer awareness of the INTEL mark;
- (ii) there has been vast expenditure on marketing and advertising in Singapore at an average of SGD 454, 910, 566.29 per year from the years 2005 – 2011;
- (iii) the annual net revenue is at USD 1.277 billion a year for Singapore alone;
- (iv) there are numerous advertisements taken out in ST, TODAY and BT from 1975 to 2008 relating to the Applicants’ business and/or relating to the INTEL marks;
- (v) there are articles in major publications relating to the Applicants’ business and/or relating to the INTEL marks (including major publications such as BusinessWeek, Financial Times, Fortune), most of which would have been read by consumers in Singapore.

130 Further, in relation to the factors under Section 2(c) and (d) of the Act, the Applicants highlighted as follows:

- (i) the Applicants’ evidence of its worldwide and Singapore registrations / applications for INTEL and INTEL formative marks, is voluminous (**Zefo’s Evidence** at exhibits RZ-6,7,12 and 13). In this regard, the Applicants have provided a list as follows:
 - Annex G-1: Summarised list of trade mark registrations in Singapore (both INTEL and INTEL formative);
 - Annex G-2: Summarised list of applications and registrations world wide (INTEL only);
 - Annex G-3: Summarised list of registrations for INTEL and INTEL formative marks in commonwealth jurisdictions in Class 42).

(ii) The Applicants' evidence of various court and tribunal decisions wherein it was found that INTEL and/or the INTEL formative marks are famous and distinctive. In this regard, the Applicants provided a list as follows:

- Annex F-1: short case note on some of the Commonwealth cases exhibited to *Zefo's Evidence*;
- Annex F-2: full list of the judgements exhibited to *Zefo's Evidence*.

131 The Applicants submitted that in light of the above, the *INTEL Word Mark* and the *INTEL Stylised Mark* are well known to the public at large in Singapore.

132 In considering whether the *Applicants' Earlier Class 42 Marks* have acquired distinctiveness above I have taken into consideration several factors. These same factors are also relevant in considering whether the *Applicants' Earlier Marks* are well – known to in Singapore at large. The survey evidence which I have dealt with to some extent when considering the issue of “likelihood of confusion” is also relevant here. In summary, the factors are as follows:

- (i) Evidence of net sales revenue in Singapore;
- (ii) Evidence of promotional expenditure in Singapore;
- (iii) Samples of advertisements in the local media;
- (iv) Samples of articles about the Applicants in local media;
- (v) Survey evidence;
- (vi) Evidence of third party articles from internationally distributed publications;
- (vii) Evidence of third party articles from books and case studies.

I will deal with each item in turn.

Evidence of net sales revenue in Singapore

133 The actual net revenue figures in Singapore have been provided above and I will not replicate it here. However, I make the following points in relation to the same. From the figures, it is clear that the Applicants have been in the local scene for a substantial period of time. The revenue net figures span a period of 8 years taking into account the relevant date (2002 – 2008). The revenue net figures in the Singapore context, are very extensive. For the revenue figures, it is clear that except for 2003 (which, incidentally, is also an impressive amount of 946 MILLION US Dollars), for the rest of the 7 years, each year the Applicants managed to earn a net revenue in excess of 1 BILLION US Dollars. This is clearly no mean feat.

Evidence of promotional expenditure in Singapore

134 Again, the actual figures have been provided above and they will not be replicated here. I make the following points in relation to the figures. The promotional figures span 4 years taking into account the relevant date (2005 – 2008). The promotional expenditure in Singapore, while not as large an amount as the net revenue figures, is also impressive.

In the span of 4 years, the average amount expended for each year is approximately 600 MILLION US Dollars.

Samples of advertisements in the local media

135 A summary of the various advertisements in the local media is as follows:


Samples of advertisement in the local media			
S/N	Date Range of Publication	Description	Number of items
1	3 Apr 1975 – 19 Oct 1982	Sample advertisements in the ST for Intel jobs in Malaysia	37
2	4 Jun 1983 – 28 Jan 1989	Sample advertisements in the ST for Intel jobs in Singapore	22
3	12 Oct 1983 – 19 Mar 2009	Sample advertisements in TODAY, the BT and the ST for products which contain and INTEL component	131
4	8 Mar 1987 – 20 Dec 2001	Sample advertisements in TODAY, the BT and the ST for INTEL products	17
5	14 Jul 1981 – 28 May 1982	Sample advertisements in the ST for fairs, workshops and seminars	12
6	13 Jul 1984 – 3 Apr 2007	Miscellaneous advertisements in TODAY and the ST	7
7	30 Aug 1985 – 22 Aug 2008	Sample reports in TODAY, the BT and the ST relating to INTEL and its business	58

136 In relation to the sample advertisements for jobs in Singapore, the details are as follows:

Sample advertisements in the ST for Intel jobs in Singapore				
S/N	Date	Publication	Mark	Page in Zefo's Evidence
1	4 Jun 1983	ST	<i>Intel Word Mark</i>	4129
2	22 Oct 1983	ST	<i>Intel Word Mark and Intel with a displaced "e"</i>	4133
3	9 Dec 1983	ST	<i>Intel Word Mark and Intel with a displaced "e"</i>	4137
4	16 Jul 1984	ST	<i>Intel Word Mark</i>	4140
5	22 Aug 1984	ST	<i>Intel Word Mark</i>	4142
6	1 Sep 1984	ST	<i>Intel Word Mark</i>	4145
7	13 Oct 1984	ST	<i>Intel Word Mark</i>	4147
8	8 Dec 1984	ST	<i>Intel Word Mark</i>	4150
9	12 Jan 1985	ST	<i>Intel Word Mark and Intel with</i>	4153

			a displaced "e"	
10	18 May 1985	ST	<i>Intel Word Mark</i>	4160
11	27 Jul 1985	ST	<i>Intel Word Mark</i>	4164
12	1 Feb 1986	ST	<i>Intel Word Mark</i>	4170
13	15 Mar 1986	ST	<i>Intel Word Mark</i>	4175
14	21 Jun 1986	ST	<i>Intel Word Mark</i>	4180
15	16 Aug 1986	ST	<i>Intel Word Mark</i>	4183
16	20 Sep 1986	ST	<i>Intel Word Mark and Intel with a displaced "e"</i>	4186
17	25 Oct 1986	ST	<i>Intel Word Mark</i>	4191
18	4 May 1987	ST	<i>Intel Word Mark</i>	4205
19	5 Oct 1987	ST	<i>Intel Word Mark</i>	4214
20	12 Dec 1987	ST	<i>Intel Word Mark</i>	4217
21	22 Aug 1988	ST	<i>Intel Word Mark</i>	4234
22	28 Jan 1989	ST	<i>Intel Word Mark</i>	4244

137 In relation to the sample advertisements in TODAY, the BT and the ST for products which contain an INTEL component, I note that there are a total of 131 items and spans from 1983 – 2009 ie a period of 26 years. Taking into account the relevant date of 20 March 2009, this is still an impressive number of 25 years. However for purposes of providing the details (and thus a feel) of these advertisements, I will only take a sample of 85 items from the approximate period 2001 – 2009:

Sample advertisements in TODAY, the BT and the ST for products which contain an INTEL component				
S/N	Date	Publication	Mark	Page in ZEFO SD
1	31 Mar 2001	TODAY	 <i>Intel Inside Mark</i>	4286
2	17 May 2001	TODAY	<i>Intel Inside Mark</i>	4287
3	18 Jun 2001	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4288
4	30 Jul 2001	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4289
5	31 Aug 2001	TODAY	<i>Intel Inside Mark</i>	4290
6	11 Sep 2001	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4291
7	24 Oct 2001	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4292
8	28 Nov 2001	TODAY	<i>Intel Inside Mark with</i>	4293

			"Pentium"	
9	29 Nov 2001	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4294
10	5 Dec 2001	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4295
11	14 Jan 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4297
12	22 Feb 2002	TODAY	<i>Intel Inside Mark</i>	4298
13	26 Mar 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4299
14	5 Apr 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4300
15	21 May 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4301
16	28 Jun 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4302
17	17 Jul 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4304
18	5 Aug 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4305
19	20 Sep 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4306
20	22 Oct 2002	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4307
31	22 Jan 2003	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4310
32	4 Feb 2003	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4311
33	14 Mar 2003	TODAY	 <i>Intel Inside Mark with "Centrino"</i>	4312
34	8 Apr 2003	TODAY	<i>Intel Inside Mark with "Centrino"</i>	4313
35	17 May 2003	TODAY	<i>Intel Inside Mark with "Centrino"</i>	4314
36	20 Jun 2003	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4315
37	4 Jul 2003	TODAY	<i>Intel Inside Mark with "Centrino"</i>	4316
38	26 Aug 2003	TODAY	<i>Intel Inside Mark with "Pentium"</i>	4317
39	4 Sep 2003	TODAY	<i>Intel Inside Mark with</i>	4318

			"Centrino"	
40	16 Oct 2003	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4319
41	14 Jan 2004	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4323
42	25 Feb 2004	TODAY	<i>Intel Inside Mark</i> with "Pentium"	4324
43	17 Mar 2004	TODAY	<i>Intel Inside Mark</i>	4325
44	15 Apr 2004	TODAY	<i>Intel Inside Mark</i> with "Pentium"	4326
45	27 May 2004	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4327
46	3 Jun 2004	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4328
47	23 Jul 2004	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4329
48	5 Aug 2004	TODAY	<i>Intel Inside Mark</i> with "Pentium"	4330
49	24 Sep 2004	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4331
50	1 Oct 2004	TODAY	<i>Intel Inside Mark</i> with "Pentium"	4333
51	19 Jan 2005	TODAY	<i>Intel Inside Mark</i> with "Pentium"	4337
52	23 Mar 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4338
53	13 Apr 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4339
54	13 May 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4340
55	14 Jun 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4341
56	12 Jul 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4342
57	11 Aug 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4343
58	30 Sep 2005	TODAY	<i>Intel Inside Mark</i> with "Pentium"	4345
59	14 Oct 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4346
60	25 Nov 2005	TODAY	<i>Intel Inside Mark</i> with "Centrino"	4348
61	24 Feb 2006	TODAY	<i>Intel Stylised Mark</i> with "Pentium 4 inside"	4351
62	31 Mar 2006	TODAY	<i>Intel Stylised Mark</i> with "Centrino Duo"	4352

63	28 Apr 2006	TODAY	<i>Intel Inside Mark with "Centrino"</i>	4353
64	5 May 2006	TODAY	<i>Intel Inside Mark with "Centrino"</i>	4354
65	15 Jun 2006	TODAY	<i>Intel Inside Mark with "Centrino"</i>	4356
66	13 Jul 2006	TODAY	<i>Intel Stylised Mark with "Centrino Duo"</i>	4357
67	10 Aug 2006	TODAY	<i>Intel Stylised Mark with "Pentium D inside"</i>	4358
68	19 Sep 2006	TODAY	<i>Intel Stylised Mark with "Centrino Duo"</i>	4359
69	19 Oct 2006	TODAY	<i>Intel Stylised Mark with "Centrino Duo"</i>	4360
70	30 Nov 2006	TODAY	<i>Intel Stylised Mark with "Centrino Duo" and "Core 2 Duo Inside"</i>	4361
71	11 Jan 2007	TODAY	<i>Intel Stylised Mark with "Centrino Duo"</i>	4363
72	7 Feb 2007	TODAY	<i>Intel Stylised Mark with "Centrino Duo"</i>	4364
73	2 Mar 2007	TODAY	<i>Intel Stylised Mark with "Core 2 Duo Inside"</i>	4365
74	9 Mar 2007	TODAY	<i>Intel Stylised Mark with "Centrino Duo" and "Core 2 Duo Inside"</i>	4367
75	31 May 2007	TODAY	<i>Intel Stylised Mark</i>	4369
76	29 Jan 2008	TODAY	<i>Intel Stylised Mark with "Core 2 Duo Inside"</i>	4381
77	6 Mar 2008	TODAY	<i>Intel Stylised Mark with "Centrino Inside" and "Core 2 Duo Inside"</i>	4384
78	28 Apr 2008	TODAY	<i>Intel Stylised Mark with "Core 2 Duo Inside"</i>	4386
79	6 May 2008	TODAY	<i>Intel Stylised Mark with "Centrino Inside"</i>	4387
80	18 Jun 2008	TODAY	<i>Intel Stylised Mark with "Xenon Inside"</i>	4388
81	9 July 2008	TODAY	<i>Intel Stylised Mark with "Xenon Inside"</i>	4389
82	10 Jan 2009	TODAY	<i>Intel Stylised Mark with "Core 2 Duo Inside"</i>	4396
83	21 Jan 2009	TODAY	<i>Intel Stylised Mark with "Centrino 2 Inside"</i>	4395
84	12 Mar 2009	TODAY	<i>Intel Stylised Mark with</i>	4397

			"Centrino 2 Inside"	
85	19 Mar 2009	BT	<i>Intel Stylised Mark</i> with "Xenon Inside"	4398

138 I make the following points in relation to the above evidence:

- (i) Firstly, it is to be noted that in categorising the marks, for convenience, I have taken the most "prominent" mark from the advertisement. By that I mean the mark that "jumps" out at the reader. It is natural for the word "INTEL" to be included in the advertisement since it is expected that the advertisements, which promote computers containing the Applicants' microprocessor, would necessarily need to describe the fact that the computer contains the microprocessor and the necessary details of the microprocessor. Therefore, for the avoidance of doubt, in addition to the "main" mark of the Applicants which has been reflected in the table above, it is to be noted that the word INTEL is included in most, if not all, of these advertisements.
- (ii) The second point that I wish to make is that it is noted that the *Applicants' Earlier Marks* used above are variants of the Applicants' *INTEL Word Mark* as well as the *INTEL Stylised Mark*. However, I am of the view that given particular distinctiveness (both inherent and acquired) of the word INTEL, it is the word "INTEL" that stands out for the different variants. The evidence in relation to this issue has been discussed above. I make the observation that where the variants include the *INTEL Word Mark* or the *INTEL Stylised Mark*, the *INTEL Word Mark* or the *INTEL Stylised Mark* usually makes up approximately 40% to 50% of the mark. Finally, I add that "centrino" is a platform that includes the microprocessor itself while "core" refers to the microprocessor itself.
- (iii) The third point that I wish to make is that all the above relate to the item/good "microprocessor".
- (iv) Last but not least, these publications are the main stream local media. It is noted that the majority of the above promotions are in TODAY which, as at today, is one of the more popular news publications, given that it provides bite size news which is more palatable to the general reader.

139 I now consider news reports about the Applicants. It is noted that there are a total of 59 such articles from 1985 – 2008 taking into account the relevant date (ie 24 years). However, for purposes of providing the details (and thus a feel) of these advertisements, I will only take a sample of 35 items from the approximate period of 1991 – 2007:

Sample reports in TODAY, the BT and the ST relating to the Applicants and their business

S/N	Date	Publication	Title of article ¹	Page in ZEF0 SD
1	30 Aug 1985	BT	Intel of the US has become the 19 th company to set up a major international purchasing office in Singapore.	3900
2	31 Dec 1990	ST	Intel to enhance its operations in Singapore	3901
3	7 Jan 1991	ST	Intel to set up \$3M R&D centre here by year end	3903
4	2 Jun 1991	ST	US firm Intel unveils world's fastest supercomputer	3905
5	21 July 1992	ST	Cash on the chip	3916
6	25 Aug 1992	ST	Breaking speed limits	3919
7	<i>7 Jan 1993</i>	<i>ST</i>	<i>Intel now world's top chip producer</i>	3926
8	24 Mar 1993	ST	Intel's new chip set to revolutionise PCs	3928
9	30 Sep 1993	ST	Intel sets up regional HQ in Singapore	3931
10	<i>9 Nov 1993</i>	<i>ST</i>	<i>Creative Tech enters into strategic tie-up with Intel</i>	3932
11	<i>14 Jan 1995</i>	<i>BT</i>	<i>Pentium flaw fails to unseat Intel as world's top chip maker</i>	3942
12	8 Jan 1997	BT	Intel to launch new MMX multi media chip here this week	3944
13	7 May 1997	ST	Intel in global launch of Pentium II chip	3948
14	20 Apr 1998	BT	Feel the power in Intel's latest chip	3956
15	15 Jun 1998	BT	Intel going into e commerce in Asia	3958
16	31 Aug 1998	BT	Intel brings new 450Mhz processor into Asia	3962
17	23 Dec 1998	BT	Intel eyes Asia in e-trade	3965
18	17 Apr 1999	ST	Intel to spend almost SGD850M on equity stakes	3970
19	20 Sep 1999	BT	Intel goes big on e-commerce in the Asia Pacific	3972
20	15 Dec 1999	ST	Asia leads in online sales of Intel chips	3974
21	<i>13 Jan 2000</i>	<i>BT</i>	<i>Intel invests in Singapore e-</i>	3976

¹ Some of the titles are italicised as they are sample reports which demonstrate that the Applicants are known for microprocessors as well as sample reports of tie-ups between the Applicants and companies in Singapore.

			<i>commerce provider bex.com</i>	
22	16 Jun 2000	ST	<i>stt.com links up with giant Intel</i>	3978
23	17 May 2001	BT	Up to USD 250M for Asian start-ups	3979
24	6 Sep 2001	BT	Intel positioning itself for Net domination	3981
25	15 Jul 2002	BT	Why all eyes are on Intel	3983
27	14 Mar 2003	ST	\$30,000 IT boost for rural folk in the region	3983
28	19 Mar 2004	BT	<i>NUS, IBM, Intel team up on grid computing</i>	3989
29	26 Sep 2005	BT	Intel trounces rivals with USD 16.85B in H1 sales	3994
30	24 Aug 2006	BT	<i>Intel buys into Anytime in S'pore</i>	3996
31	8 Nov 2006	TODAY	<i>1,500 electronic jobs; Intel and Micron to build a multi-billion flash chip plant here</i>	4001
32	29 Jan 2007	ST	Intel achieves major chip breakthrough	4003
33	19 Mar 2007	BT	<i>Plans to build Intel-Micron plan on track</i>	4006
34	19 Apr 2007	BT	Portal to match tech firms with investors launched	4008
35	17 Jul 2007	BT	<i>S'pore to be regional hub for STM, Intel joint venture</i>	4013

140 I make the following points in relation to the evidence above:

- (i) The reference to the Applicants is in relation to them as a company rather than a reference to the Applicants' marks in general. This is natural, as these are articles or write-ups about the Applicants as a company, as well as the products and services provided by them, rather than an advertisement about their products / services.
- (ii) It is observed, nevertheless, that there were several articles which referred to the Applicants as the "top" chip maker (for example see items 7 and 11 above).
- (iii) It can be seen from the above that the Applicants are involved in Singapore, the region and the global scene.
- (iv) These publications are in the local main stream media ie the ST as well as the BT.

Survey Evidence

141 I have already made some comments in relation to the survey evidence tendered by the Applicants. The Applicants have tendered survey evidence for several purposes and

one of them is to show that the Applicants' marks are well known to the public at large. The details as to the methodology as well as the full list of the questions asked during the survey have been discussed above. I have also commented in relation to the general reliability of the survey evidence tendered, having regard to the general wariness in relation to survey evidence.

142 In this regard, I am of the view that the survey evidence tendered is useful to show that the Applicants are well known to the public at large since, unlike the issue of "likelihood of confusion", in this instance, there is a sufficiently robust sample size of 450 respondents, out of which 85% were aware of the Applicants and what they do as a company ie " I.T. / computer related" (69%) and "processors / chips" (25%). I would add that I am of the view that "microprocessors" can actually be subsumed within the description "computer related" since a microprocessor is essentially a component within a computer.

Evidence of third party articles from internationally distributed publications

143 I have provided a summary of the publications above. For the purposes of this limb, I simply wish to note that these are relatively reputable publications and that whilst these are international media publications, they are available for circulation in Singapore.

Evidence of third party articles from books and case studies

144 Last but not least, the Applicants have also provided a list of 17 books and case studies where the Applicants have been featured. As mentioned above, this includes books in relation to brand management as well as strategic management of technology and innovation.

Conclusion on well known to the public at large

145 The Applicants referred to *Taylor, Fladgate & Yeatman Limited v Taylors Wines Pty Ltd [2014] SGIPOS 11* at [132] for a summary of the type of evidence tendered for marks held to be well-known to the public at large to date:

*"... In these cases [i.e. CLINIQUE, NUTELLA and SEIKO], there was, inter alia, relevant survey evidence demonstrating more than 70% of consumer awareness of the mark (in **Sarika (HC)** at [155(b)] and **Seiko** at [104]), generous expenditure on marketing and advertising (e.g. \$3 million each year for 4 years in **Clinique** at [39], more than \$4 million each year for 5 years in **Seiko** at [96(v)]) as well as exposure of the mark to the public through physical sales outlets in Singapore (13 stores and counters in Singapore in **Clinique** at [41], 100 optical shops in Singapore in **Seiko** at [96(iii)], 94-98% of stores in Singapore that sell food items in **Sarika (HC)** at [155(a)]). There is also evidence of very large sales figures in each of these cases: about \$10 million per annum from 2004 to 2008 in **Clinique** at [39], \$14 million per annum from 2005 to 2010 in **Seiko** at [96(ii)], and 2*

million units of "Nutella" bread spread sold every year in Singapore (to 1.1 million households) in Sarika (HC) at [155(a)]."

146 Having regard to all of the evidence above, I am of the view that this element has been made out, at least in relation to microprocessors / computers.

147 I am mindful of the caution provided by the Court that to come within this limb, a mark must be recognised by most sectors of the public. However, I am of the view that in this day and age where a computer is an indispensable tool both in the business world as well as in the normal household, it would be hard to miss the Applicants, which is one of the largest makers of computer microprocessors.

148 I will leave this limb with the following quote from the local media. The following article is from BT and titled "*Intel trounces rivals with US\$16.85b in H1 sales*", dated 26 Sep 2005 (see item 29 above):

For the first half of this year, Intel Corp saw sales of US\$16.85 billion. That was almost double the H1 sales of its nearest competitor, Samsung Electronics, and more than the combined H1 sales of the bottom four – NEC, Freescale Semiconductor, Taiwan Semiconductor Manufacturing Company (TSMC), and Infineon Technologies AG – in the top 10 semicon suppliers by sales.

[Emphasis as underlined mine]

Dilution in an Unfair Manner

149 I now consider whether the use of the Registered Mark in relation to the goods / services would cause dilution in an unfair manner of the distinctive character of the ***Applicants' Earlier Marks***.

150 The definition of "dilution" is set out in Section 2(1) of the Act as follows:

"dilution", in relation to a trade mark, means the lessening of the capacity of the trade mark to identify and distinguish goods or services, regardless of whether there is –

- (a) any competition between the proprietor of the trade mark and any other party; or
- (b) any likelihood of confusion on the part of the public.

151 The following can be gleaned from ***Law of Intellectual Property of Singapore*** at [21.5.51]:

- (c) *The marks, if not identical, must be sufficiently similar such that the public will make a mental association between the two marks, i.e. the perception of the later mark must call to mind the memory of the special well-known mark.*

- (d) But proving this mental association per se is not good enough. It must be further shown that there is a real and serious risk that this mental association would cause dilution of the distinctive character of the special well-known mark.
- (e) There are two ways in which the distinctive character of the earlier trade mark can be diluted: (i) by blurring; or (ii) by tarnishing.
- (f) Dilution by blurring reduces or erodes the strong capacity of the special well-known to exclusively identify the goods / services of its proprietor...
- (g) Dilution by tarnishing degrades the reputation or the positive image of the special well-known trade mark...Another example is the U.S. case where it was found that the use of the mark CHEWY VUITON in relation to toy products for pet animals would cause dilution by tarnishing the fame of the LOUIS VUITTON mark...
- (h) The dilution, by blurring or by tarnishing, must be caused "in an unfair manner"...

[Emphasis as underlined mine.]

Dilution by blurring

152 It is noted that the Registrar in *Seiko Holdings Kabushiki Kaisha (trading as Seiko Holdings Corporation) v Choice Fortune Holdings Limited* [2014] SGIPOS 8 ("**Seiko**") stated at [117]:

[117] *In practice, there is much subjectivity in application of the test for dilution. In **Sarika**, the Court of Appeal considered the issue from multiple angles and factors. In particular, at [100], the Court of Appeal singled out five factors which led to a finding of dilution by blurring: (i) the degree of recognition of the earlier trade mark; (ii) the distinctive quality of the earlier trade mark given the invented nature of the word; (iii) the close similarity between the marks increasing the likelihood that the public will make a mental connection between them; (iv) the admission of the Applicants that the sign "NUTELLO" was derived from the "NUTELLA" mark and the intention was to inform consumers that the Applicants' "NUTELLO" product was a mixture of espresso and "Nutella" chocolate cream spread; and (v) the similarity of the parties' respective goods increasing the likelihood that consumers would draw a mental link between the sign "NUTELLO" and the "NUTELLA" mark.*

153 Similarly, the Applicants argued:

- (i) That the **INTEL Word Mark** and the **INTEL Stylised Mark** are recognised by many in Singapore (85% - see survey).

- (ii) INTEL is an invented word, derived from "Integrated Electronics".
- (iii) The whole of the INTEL mark is substantially reproduced in the Registered Mark. The close similarity between the marks is supported by the survey evidence (51% and 31%) increases the likelihood of a mental association.
- (iv) The services under the Registered Mark are identical to or at least very similar to, the Applicants' goods and services.

154 In light of the above, the Applicants submitted that the use of the Registered Mark in relation to the services for which it is registered creates a serious and real likelihood that the distinctiveness of the *INTEL Word Mark* and the *INTEL Stylised Mark* may be weakened. There will be a diminished ability on the part of Applicants' marks to identify products for which they are registered and used and they may no longer have the capacity to conjure immediate association with the Applicants' products. The Applicants submitted therefore that the ground of dilution by blurring has been made out.

155 First and foremost, I note that there is also an admission as to the derivation of the mark in the Court of Appeal in *Sarika (CA)* which is clearly missing in the current case.

156 In any event, I am of the view that it has not been shown that dilution occurred in an unfair manner.

157 The Registrar stated in *Seiko* at [141] – [144]:

[141] As I have found that there is no dilution by blurring, there is no necessity to consider if such blurring is "in an unfair manner". However, the Opponents made a point in their oral submissions that dilution in an unfair manner is treated as a whole by the Court of Appeal. The Opponents remarked that it was preposterous to say there could be dilution in a fair manner. I would take the opportunity to address the latter point here.

[142] Article 4(1)(b)(ii) of the WIPO Joint Recommendation is the inspiration for the legislative language in Section 55 and Section 8(4) of the Act. The relevant section of Article 4(1)(b)(ii) of the WIPO Joint Recommendation provides guidance on what is meant by dilution "in an unfair manner" as follows:

... The meaning of the words "in an unfair manner" implies that third-party use of a well known mark which is not contrary to honest commercial practice (e.g. reference to a well known mark for review or parody) does not constitute dilution.

*[143] The Opponents' suggestion could not have been the legislative intent behind the provision, which would otherwise render the phrase "in an unfair manner" superfluous. The proper interpretation and application of the phrase is illustrated by the Principal Assistant Registrar's decision in **Doctor's Associates Inc v Sim Meng Seh** [2011] SGIPOS 15 ("**Subway**"). Although the Opponents' trade mark "SUBWAY" was not found to be well known to the public at large, the Principal Assistant Registrar went on to consider whether there was blurring, and*

if so, whether this was in an unfair manner. Being persuaded that there would be dilution by blurring, she nevertheless was unable to find that the Applicants' continued use of the application mark in that case, to which goodwill has attached since 1988, before the Opponents entered the Singapore market, has caused dilution "in an unfair manner", Subway at [49].

*[144] Therefore, I cannot agree with the Opponents' interpretation of the phrase "in an unfair manner". While the Court of Appeal in **Sarika** did not specifically consider whether the dilution there was caused "in an unfair manner", this was not a point raised by the defendant either. Hence, the Court of Appeal may not have had the full opportunity to consider arguments whether the dilution of "NUTELLO" was caused "in an unfair manner". It should therefore not be construed, as the Opponents sought to, that the Court of Appeal has definitively treated the requirement "cause dilution in an unfair manner" as a whole rather than as two distinct elements.*

[Emphasis as underlined mine]

158 In the current case, as pointed out above, the Applicants concluded that this limb has been made out on the basis of an application of the factors enumerated above. In particular, the Applicants have not argued that dilution by blurring, if any, had occurred in an unfair manner.

159 Thus I am of the view that it has not been shown that there is dilution by blurring in an unfair manner.

Dilution by tarnishing

160 For this limb, the Applicants simply submitted that it is highly undesirable that the Applicants be economically linked to the Registered Proprietor, which has since been struck off the companies register.

161 First of all, from a reading of the relevant provision in the legislation, tarnishment must occur as a result of the mark rather than the business. Further, I note that, again, the Applicants did not address how such "dilution by tarnishing", if any, was caused in an unfair manner.

Conclusion on Section 23(3)(a)(iii) read with Section 8(4)(b)(ii)(A)

162 In light of the above, the ground of objection under Section 23 read with Section 8(4)(b)(ii)(A) fails.

Unfair Advantage

163 In relation to this ground, I refer to **Law of Intellectual Property of Singapore** at [21.5.52]:

...

(a) Like dilution, existence of a mental association between the two marks per se is not sufficient. It must also be shown that there is a serious and real risk that, as a result of this mental association, there is "taking unfair advantage" of the distinctive character of the earlier trade mark.

(b) There is no statutory definition of what constitutes "taking unfair advantage". Case law has interpreted it to mean an attempt by a trader to increase his sales by "free-riding" or like a parasite feeding on the reputation of the earlier mark. In dilution, the reputation of the earlier mark is diminished or damaged, that is, there is a negative impact on its goodwill. In "taking unfair advantage", the complaint is that the proprietor of the later mark is unfairly deriving a positive benefit from the reputation of the earlier mark.

(c) A good gauge that there has been "taking unfair advantage" is where there was an impact on the economic behaviour of the consumer, that is, evidence that the goods/services bearing the later mark sold because of the mental association (albeit non-confusing) with the earlier trade mark.

164 The High Court in **Sarika (HC)** provided at [181] – [188]:

[181] It should be noted that the mere taking of advantage is insufficient – there must be unfair advantage taken. The English Court of Appeal in Whirlpool Corporation & Ors v Kenwood Ltd [2010] RPC 2 (“Whirlpool”) at [113] disagreed with counsel’s contention that “where the third party, using a sign which is sufficiently similar to a mark with a reputation for a link to be established, obtains any commercial boost or other advantage from the link, then that advantage is of itself unfair, without proof of any additional factor”. The Court of Appeal opined that such a reading would equate any advantage with an unfair advantage, and would effectively deprive the word “unfair” of any added meaning (Whirlpool at [114]-[115]). On the facts of Whirlpool itself, the court held that it was not sufficient for the proprietor to show that the alleged infringer had obtained an advantage; there must be an “added factor of some kind for that advantage to be categorised as unfair” (Whirlpool at [136]).

[182] The question of unfair advantage has to be considered using a global assessment (Intel at [79], Whirlpool at [137]). On a reading of the decisions of Intel, L’Oreal and Whirlpool, it is evident that there are several factors to consider in determining whether an unfair advantage had been taken. It is trite that none of the factors are determinative, and in the final analysis, it must be shown that the alleged infringer had drawn some unfair advantage from the use of the similar sign (Whirlpool at [137]). Each of these factors will be discussed in the context of the present factual circumstances.

[183] The first factor to consider is the strength of the mark's reputation and the degree of distinctive character of the mark (Intel at [65], L'Oreal at [44] and Whirlpool at [137]). With regard to this factor, I had earlier found that the "Nutella" mark is distinctive (see [74] above). I would also note that the evidence of the Plaintiff's survey, the Internet blogs and the newspaper articles (all referred to in [155]) suggest that the "Nutella" mark had a strong reputation.

[184] The second factor is the degree of similarity between the marks at issue (L'Oreal at [44], Whirlpool at [137]). With regard to this factor, I had earlier found that although the "Nutella" mark and the "Nutello" sign were not identical, they were similar visually, aurally and conceptually.

[185] The third factor is the nature and degree of proximity of the goods or services concerned (L'Oreal at [44], Whirlpool at [137]). With regard to this factor, I had also earlier found that there is similarity in the goods represented by the "Nutello" sign with the product specification ("chocolate products") for which the "Nutella" mark is registered.

[186] The fourth factor is the immediacy and strength with which the mark is brought to mind by the sign (L'Oreal at [44]):

... the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign is taking, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to them ...

In this regard, I note that Mr Christopher Tan had stated that the "Nutello" sign was derived from the "Nutella" mark. I would also note that Mr Christopher Tan conceded that it was intended that customers would be reminded of and attracted to the name "Nutello", and that the name per se— without any description on the website and in the Defendant's booklet – would inform customers that the drink contained both espresso and Nutella.

[187] Ultimately, however, and as was earlier alluded to, it must be shown that the alleged infringer had drawn some unfair advantage from the use of the similar sign. On the facts of Whirlpool, the English Court of Appeal found that the alleged infringer had no need to ride on the proprietor's coat-tails, and that despite the goods being "very similar (even identical...)" (emphasis added) and the mark being "distinctive, but not strongly so", there was insufficient proof that the association of the earlier mark would enhance the performance of the later sign (Whirlpool at [138]). In other words, there was insufficient evidence to show that the alleged infringer had in fact drawn, or was likely to draw, any commercial advantage from the perceived similarity (Whirlpool at [138]).

[188] In the final analysis, there was insufficient proof to convince me on the balance of probabilities that the Defendant gained any advantage from naming

the drink “Nutello”, let alone an unfair advantage. In cross-examination, counsel for the Plaintiff suggested to Mr Christopher Tan that the good sales of “Nutello” in the first four months since its release was due to the fact that the drink was being marketed using a mark similar to the Plaintiff’s “Nutella” mark. Mr Christopher Tan admitted that this was “possible”, but that it was “[n]ot necessarily so” because the Defendant trained staff to “upsell” every new drink to customers and accordingly it was natural that new items on the menu would sell better. The Plaintiff had no other evidence that “Nutello” sold better because it was named in a manner similar to “Nutella”. Therefore, I conclude that the claim under s55(3)(b)(ii) is not made out, because it had not been satisfactorily proven that the Defendant had taken unfair advantage of the “Nutella” mark.

[Emphasis as underlined mine]

165 Applying the above factors to the case at hand, the ***Applicants' Earlier Marks*** are distinctive and there is some proximity in relation to the goods / services of both parties in the sense that they are related (it is to be noted that the relevant goods / services in this instance is “microprocessors / computers versus Class 42 services”). Further, in light of the fact that there is only a low similarity between the marks, the strength and the immediacy of the Registered Mark in calling up the ***Applicants' Earlier Marks*** in the minds of consumers is low.

166 In the final analysis, I am of the view, as per the High Court in ***Sarika (HC)***, that there is insufficient proof on a balance of probabilities that the Registered Proprietors have gained any advantage, let alone unfair advantage in this instance.

167 It is noted that the plaintiff in the High Court in ***Sarika (HC)*** had admitted to that fact that “NUTELLO” was derived from “NUTELLA” such that “*customers would be reminded of and attracted to the name “Nutello”, and that the name per se...would inform customers that the drink contained both espresso and Nutella*”. Further, the plaintiffs also adduced evidence of increased sales which the Court rejected as there is a possibility that the enhanced sales may be due to factors other than the mental link between the marks. As “[t]he Plaintiff had no other evidence that “Nutello” sold better because it was named in a manner similar to “Nutella”” the Court concluded that the claim under s55(3)(b)(ii) was not made out as it had not been satisfactorily proven that the Defendant had taken unfair advantage of the “Nutella” mark.

168 On the other hand, the Applicants have taken into consideration the following factors in concluding that there is unfair advantage taken in the current case (i) the fame and awareness of the INTEL marks; (ii) that INTEL was first used in Singapore in or around 1975 while in contrast, the Registered Mark was only first used in Singapore in 2006; (ii) that the Registered Proprietors made bare claims that the Registered Mark was created by a graphic designer on or before 1 July 1995, with no evidence to substantiate it in that the graphic designer himself has not come forward to give evidence by way of a Statutory Declaration or otherwise.

169 I am of the view that even if the above factors point to the *possibility* of an "advantage" being taken of the Applicants, there is nothing in the submission to the effect that such an advantage taken, if any, is "unfair".

Conclusion on Section 23(3)(a)(iii) read with Section 8(4)(b)(ii)(B)

170 In light of the above, the ground of objection under this Section 23 read with Section 8(4)(b)(ii)(B) fails.

Ground of Invalidation under Section 23(3)(b) read with Section 8(7)(a)

171 The relevant provisions of the Act read:

*23.—(3)The registration of a trade mark may be declared invalid on the ground —
(b)that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied,*

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

8. —(7) A trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented —

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

Decision on Section 23(3)(b) read with Section 8(7)(a)

172 The Applicants did not make extensive submissions in relation to this ground except to refer to their submissions in relation to the objections above. For example, in relation to the element of misrepresentation, the Applicants submitted that this element has been made out on the basis that the element of "likelihood of confusion" under the ground of objection under Section 8(2)(b) has been made out. While this is usually acceptable, in this case, I am of the view that it warrants a good look at the Applicants' actual objection on the ground of passing off.

173 It is trite law that there are 3 elements to be satisfied to establish passing off, namely:

- (i) goodwill;
- (ii) misrepresentation;
- (iii) damage.

174 The definition of goodwill is as follows (see *The Commissioners of Inland Revenue v Muller & Co's Margarine, Limited* [1901] AC 217) at *Law of Intellectual Property of Singapore* at [17.1.1]:

“It is the benefit and advantage of the good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has a power of attraction sufficient to bring customers home to the source from which it emanates.”

[Emphasis as underlined mine].

175 It is important to focus on goodwill in Singapore as the Court in *Staywell* at [136] and [137] has clarified that the local approach, unlike other jurisdictions like Australia, is still the "hardline" approach, albeit such an approach having been softened by *CDL Hotels International Ltd v Pontiac Marina Pte Ltd* [1998] 1 SLR(R) 975 to include pre-trading activity.

176 It is important to note that the Applicants must establish that they have acquired goodwill as at the relevant date and this date is the date on which the defendant's conduct complained of started: *Law of Intellectual Property of Singapore* at [17.2.5]). Applying the principle to the current case, the relevant date in this instance is the date of the registration of the Registered Mark which is 20 March 2009.

177 It is also important to note that passing off protects goodwill and not the mark used to promote it. I refer to *Law of Intellectual Property of Singapore* at [17.1.3]:

Although the subject matter of protection in an action for passing off is the plaintiff's business or goodwill and not the mark per se, the role of the mark is nevertheless important in the goodwill element. This is because the definition of goodwill also emphasises that there must be an attractive force that brings in custom for the plaintiff. The plaintiff must show that the public is drawn to buy or seek out his goods or services. This is where the plaintiff's mark becomes important: the plaintiff's mark is the symbol or indicia that can point the public to the plaintiff's goods or services...Thus, the first step that the plaintiff takes in the goodwill element is proving that his mark is used by the public to locate his goods or services or business.

[Emphasis as underlined mine].

178 Having said the above, it is clear that under the law the "get up" can include various aspects of the business, including a mark, as per *Reckitt & Colman Products Ltd v Borden Inc* [1990] 1 WLR 491, and quoted in *Amanusa* at [36], the relevant excerpt of which is as follows:

"The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More specifically, it may be

expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services

[Emphasis as underlined mine].

179 The significance of this for the purposes of the current case is that it opens up the 'get-up' which has been used for a whole host of goods / services by the Applicants.

180 In relation to proving goodwill I refer to ***Law of Intellectual Property of Singapore*** at [17.2.1 and 17.2.2]:

[17.2.1] The following is the test used by the Courts to determine if the plaintiff's mark performs the function of aiding the public to locate the plaintiff's goods or services or business: as at the relevant date, has the plaintiff's mark or get up become distinctive of his goods or services in the sense the relevant public in Singapore associates or identifies the mark or get up exclusively with the plaintiff's goods or services or business?

[17.2.2] Proving the relevant public's awareness of the plaintiff's mark or get-up and association of this mark or get-up with the plaintiff's goods or services or business is a factual inquiry. The plaintiff usually tenders evidence of his use and promotion of this mark or get-up in Singapore such as sales volume, the extent and amount of advertisement and media coverage of his goods or services or business conducted under this mark or get-up or market surveys.

[Emphasis as underlined mine].

181 In applying these observations, I refer to the references made above in relation to the extensive net sales revenue as well as promotional expenditure etc of the Applicants in Singapore for a whole range of goods / services.

182 It is clear that the Applicants have the relevant goodwill in Singapore as at the relevant date.

Misrepresentation

183 However, in relation to the element of misrepresentation, there is a need to consider the actual goods / services which the Registered Proprietors deal with.

184 I refer to the principles in relation to the element of misrepresentation as gleaned from *Law of Intellectual Property of Singapore* at [18.3.9] – [18.3.17]:

- (i) The first issue is whether the relevant public would be confused ie proof of likelihood of confusion suffices;
- (ii) The relevant public are those who are "probably purchasers of the kind in question" such that the relevant public is not necessarily the general public;
- (iii) The relevant public is the segment of the public who are the target audience of "the plaintiff's goods or services";
- (iv) Confusion amongst "a substantial portion" must simply mean the need to prove that a "not insubstantial" number in the relevant public would be confused;
- (v) The nature of the relevant public has been identified as not unobservant morons in a hurry but ordinary sensible people using ordinary care. This level of ordinary care will vary depending on various factors including:
 - Whether the goods / services are expensive
 - The length and complexity of the purchase transaction
 - Whether the goods / services are of a specialised nature which are purchased by professionals
 - Level of education of the purchaser.

Using the factors including those above, the court will calibrate the degree of "consumer sophistication" of the ordinary or average person in the relevant public to determine the level of care that this person would exercise when making purchasing decisions.

- (vi) The question whether there would be confusion is a matter to be decided by the judge. Further the results of market surveys which show the opinion of the relevant purchasers may be used to assist the judge in making this assessment of confusion but not to conclude the matter.
- (vii) The finding of confusion is a question of fact to be determined by the court in light of surrounding circumstances. Some factors which have been applied by the Courts are as follows:
 - Degree of similarity between the parties' get-ups
 - Degree of distinctiveness of the plaintiff's get-up
 - Price differences between the parties' goods or services
 - Proximity of the parties' fields of activity.

185 I propose to deal with the factors as listed in item (vii) first.

Degree of distinctiveness of the plaintiff's get-up

186 I am of the view that the Applicants' get-up, which clearly include the ***Applicants' Earlier Marks*** (which in turn include the ***Applicants' Earlier Class 42 Marks***), can be considered to be distinctive for the same reasons that I am of the view that the ***Applicants' Earlier Class 42 Marks*** are distinctive.

Degree of similarity between the parties' get-ups

187 Following the above, I am also of the view that there is similarity between the parties' get-ups for the same reasons that I am of the view that the ***Applicants' Earlier Class 42 Marks*** are similar to the Registered Mark.

Proximity of the parties' fields of activity

188 Under this ground of objection, the relevant fields of activity for consideration are, in particular, microprocessors / computers versus the actual goods / services which the Registered Proprietors dealt with. In this regard, I refer to the Registered Proprietors' evidence at [6]:

[6] The Respondent was incorporated in Singapore in 2006 and is a global specialist in the field of energy efficiency. The Respondent focuses on providing their clients with the latest lighting technology to reduce energy costs, reduce carbon emissions and improve plant performance. The Respondent also specialises in manufacturing energy saving lamps and fixtures...

189 While the goods / services are not identical, there are related. It is not difficult to envisage that the Applicants, who are engaged in the business of manufacturing microprocessors / computers, could expand into the area of energy efficiency. From the evidence it is clear that the Applicants, whilst they are primarily known for microprocessors / computers, are also actively engaged in a wide range of goods / services. In addition to the list at [11] of ***George's Evidence***, examples abound in exhibit C (pages 63 and 64) of the same evidence.

190 In particular, I refer to ***George's Evidence*** at exhibit A which provides the areas of research and development which the Registered Proprietors are involved in in the United States. I note that one of the areas of research under Intel Labs is "Sustainability". I refer to ***George's Evidence*** at page 15 of Exhibit A:

Sustainability

As global demand for energy increases, technologies such as smart grid need to be built to bring power where it is needed and keep up with energy demands. Going beyond smart grids, Intel Labs researchers investigate technologies that

could enable sustainable cities. For example, Microgrids let neighbourhoods share energy intelligently...Find out how Intel Labs researchers create the technologies that help you manage, control and reduce energy consumption for a more sustainable and energy efficient planet...

The above is extracted from the webpage of the Applicants in the US (www.intel.com). Thus it can be seen that the Applicants are already involved in the area of energy efficiency, at least in the United States.

Price differences between the parties' goods or services

191 It has been commented (see *Law of Intellectual Property of Singapore* at [18.3.26]) that this factor featured in the confusion inquiry of a few cases. In essence, the point is that in the competitive consumer market, if there was anything that the consumers will take notice of at all, the one thing that they would notice would be the price that they pay for the product. I agree, and thus the conclusion which has been drawn in relation to the ground of objection under Section 8(2)(b). However, in relation to this limb under this ground, I am of the view that this issue does not have much impact as the goods / services for the purposes of comparison under this instance are not competitive.

Relevant public and their nature

192 In this case, the relevant public of the Applicants' goods, in this case, microprocessors / computers, would be specialists in the relevant industries. In a sense, it would not be so much the general public, although I note that it is possible that a member of the general public who has peculiar interests may perhaps, for example, be keen to purchase a chip in order to customise his computer hardware.

Level of care

193 With regards to the level of care, I make the following observations. I note that the services are generally not cheap since they pertain to research into energy saving technologies. However, I have already noted that while price is a factor which is usually taken into account, in this instance where the goods / services are not competitive, price may not be something which is featured as highly as in the instance of competitive goods / services. The services are likely to be purchased by in-house personnel and not by the man on the street. The purchasing process may involve some enquiries as to the type of services involved given that these are rather technical in nature.

Market survey

194 It is pertinent to note that it is provided above that the results of market surveys which show the opinion of the relevant purchasers may *assist* in the confusion inquiry but *not* conclude the matter. I have already commented above in relation to the issue of the likelihood of confusion under the ground of objection under Section 8(2)(b) that the

market survey which has been tendered by the Applicants via *Yong's Evidence* is not helpful in relation to the confusion issue to the extent that the sample size is only 150.

Conclusion in relation to misrepresentation

195 I am of the view that taking all of the above into consideration, there is a likelihood of misrepresentation that the Registered Proprietors and the Applicants are somehow economically linked. There are already reports in the local media of tie-ups between the Applicants and local companies / companies which are locally based / companies having a local presence. See, for example, above at item 10 "*Creative Tech enters into strategic tie-up with Intel*" or item 31 "*1,500 electronic jobs; Intel and Micron to build a multi-billion flash chip plant here*" (more examples are italicised in the table above). Having already delved into the area of energy efficiency in the United States, it would not be surprising if the Applicants enter into some form of partnership / joint venture with another local company / locally based company / company having a local presence in the area of energy efficiency in the local context.

196 In this regard, I note that page 3976 of *Zefo's Evidence* is an article from the BT dated 13 January 2000 and titled "*Intel invest in Singapore e-commerce provider bex.com*":

Last year, Intel invested in about 25 companies in six Asia-Pacific countries...

To-date, Intel has invested US\$4.8 billion in over 300 technology companies worldwide, making it one of the biggest technology investors.

197 I am mindful of the fact that these services are technical / scientific services and would be purchased by personnel within the industries, in contrast to the man on the street. I am also mindful of the fact that there is a possibility that the confusion contemplated is only an "initial confusion" as envisaged under the initial confusion doctrine. However, I am of the view that, on a balance of probabilities, the effects of the 2 considerations would be offset by the fact that the Applicants are already involved in the area of energy efficiency and the probability of tie-ups in the local context.

198 Taking into account all of the surrounding factors, I am of the view that, on a balance of probabilities, there is a likelihood of misrepresentation.

Damage

199 In relation to damage, it suffices to show a likelihood of damage (see *Law of Intellectual Property of Singapore* at [19.1.2]).

200 One instance of damage in this case would be restriction on expansion in the local context into the related field of energy efficiency. I refer to *Law of Intellectual Property of Singapore* at [19.4.1]:

[19.4.1] This head of damage is built on the idea of business diversification. When a trader has built up a goodwill for his goods or services, it is natural for him to want to diversify and move into other related businesses where his goodwill can be further exploited in relation to related goods or services.

[19.4.2] This head of damage applies only when the plaintiff and the defendant are not in the same field of business activities. Further to establish this head of damage, there must be a close relation or connection between the plaintiff's existing field of business activity and the defendant's field of activity. If the plaintiff can show that he has plans to move into the defendant's field of business or has in fact expanded into this other field of business in other countries, this can help establish that the two fields are closely related.

[Emphasis as underlined mine].

201 I have already referred above to the fact that the Registered Proprietors are already involved in the area of energy efficiency in the United States. Therefore I am of the view that there is a likelihood of damage in this case. Before I leave this point, I note that the Applicants are already involved in a local tie-up for grid technology (see item 29 above which refers to an article dated 19 March 2004 in the BT entitled "*NUS, IBM, Intel team up on grid computing*").

202 In light of the above, the ground of objection under this Section 23 read with Section 8(7)(a) succeeds.

Conclusion

203 Having considered all the pleadings and evidence filed and the submissions made in writing and orally, I find that the invalidation fails on all grounds except for the ground of objection under Section 23 read with Section 8(7)(a). Accordingly, the Registered Mark is invalidated although this shall not affect transactions past and closed. The Applicants are to only have 30% of their costs having regard to the fact that the Applicants only succeeded in their application under Section 23 read with Section 8(7)(a). This is to be taxed, if not agreed.

Dated this 16th day of January 2015

Sandy Widjaja

Principal Assistant Registrar of Trade Marks

Hearings and Mediation Group

Intellectual Property Office of Singapore