

O-282-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2620600
BY WESTERN AIR DUCTS (UK) LTD TO REGISTER THE FOLLOWING
TRADE MARK IN CLASS 11:**

Intellair

AND

OPPOSITION THERETO (NO 103969) BY INTEL CORPORATION

The background and the pleadings

1) Western Air Ducts (UK) Ltd (“Western”) applied for the above trade mark on 10 May 2012. It was published in the Trade Marks Journal on 20 July 2012 in respect of:

Class 11: Air control equipment and devices.

2) Intel Corporation (“IC”) opposes the registration of the mark under sections 5(2)(b) & 5(3) of the Trade Marks Act 1994 (“the Act”). For each ground IC relies on a single (but different) earlier mark, both of which consist of the word: intel.

3) Western filed a counterstatement denying the grounds of opposition. Only IC filed evidence. A hearing then took place before me on 5 July 2013 at which IC was represented by Ms Jacqueline Reid, of counsel, instructed by Nabarro LLP; Western was represented by its managing director, Mr Chris Lintern.

The evidence and points of judicial notice

4) Before filing its evidence, IC asked the tribunal whether it would accept, on judicial notice, that the earlier mark(s) possessed a reputation in respect of: semiconductor processors; semiconductor processor chips; microprocessors. The tribunal confirmed that judicial notice could be taken of this fact. Western did not object. This is a sensible approach. Jacob LJ stated in *Intel Corporation Inc v CPM United Kingdom Ltd* [2007] ETMR 59:

“Anyone who saw the mark used in relation to computers or computer-linked products or services would take it as denoting a trade connection with the appellant.”

IC’s earlier mark(s) are so well known in connection with microprocessors that it would be a waste of resource for this to have to be established in evidence.

5) In terms of the evidence filed by IC, this is given by Mr David Parrish, a solicitor with the firm Nabarro LLP. Mr Parrish’s evidence is directed primarily at the section 5(3) ground of opposition. His evidence is intended to demonstrate that air control equipment and devices (the goods Western seeks to register in respect of its mark) make use of technology likely to contain microprocessors. I will not summarise the evidence here, but will return to it later, to the extent that it becomes necessary to do so.

Section 5(2)(b) – the legislation and the leading case-law

6) Section 5(2)(b) of the Act reads:

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

(a)

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

7) The Court of Justice of the European Union (“CJEU”) has issued a number of judgmentsⁱ which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, 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;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier

trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The earlier mark and the notional assessment

8) Under section 5(2)(b), IC relies upon earlier community trade mark ("CTM") registration 005726633. The mark consists of the word: intel. The mark was filed on 19 February 2007 and it completed its registration procedure on 24 November 2008. The date of filing of IC's CTM is well before that of Western's mark; it therefore qualifies as an earlier mark, as per section 6 of the Act.

9) In its counterstatement and written submissions Western made various comments regarding the goods for which IC's mark is actually used. Western considers that there will be no likelihood of confusion between the marks when the difference between such goods and the goods of Western's application are borne in mind. However, as I pointed out to Mr Lintern at the hearing, IC's earlier mark is not limited to the goods for which IC is known. Indeed, the earlier mark is registered in every class of the Nice Classification, including class 11 where Western's goods fall. IC does not need to establish that it has used its mark in relation to the goods for which it is registered. There are specific provisions that relate to having to prove use¹, but simply, an opponent who owns an earlier mark which has been registered for less than five years may rely upon it in respect of its full list of goods or services regardless of whether it has been used or not. Therefore, the comparison to be made is not between the actual trade that IC conducts but, instead, upon a notional comparison with the goods for which the mark is registered.

¹ See section 6A of the Act.

Comparison of goods

10) Western seeks registration of its mark in respect of:

Class 11: Air control equipment and devices.

11) IC's mark is registered for a long list of goods in class 11. In its statement of case IC initially argued that because its specification contained the class heading for class 11 then the specification, de facto, covered everything in that class². However, at the hearing Ms Reid confirmed that this argument was no longer pursued. Instead, she focused on specific terms listed in IC's class 11 specification including:

“Apparatus for steam generating, refrigerating, ventilating; air conditioners for vehicles, air filtering installations; air reheaters, air dryers; evaporators; filters for air conditioning”

12) Goods can be considered identical if they fall within the ambit of a broader term³. Western's goods are air control equipment and devices. Clearly, such goods operate in the field of ventilation. Thus, Western's goods fall within the ambit of apparatus for ventilation. **Identical goods are in play**. The remainder of the class 11 goods referred to above are either identical or highly similar to Western's goods.

13) IC also relies on goods in class 7 (air condensers, air suction machines), services in class 37 (air conditioning apparatus installation and repair services) and services in class 40 (rental of air condition apparatus, air purification). Whilst I agree that there is likely to be some overlap, it is not necessary to probe this in detail given that it will not put IC in any better position over its identical class 11 goods.

The average consumer

14) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer displays when selecting goods and services can vary, depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The goods (in so far as they are identical) are devices and equipment for controlling air. I do not accept Mr Reid's submission that such goods include devices as simple as a fan (even the more sophisticated versions that Ms Reid attempted to explain). Although it is possible

² The argument being based upon the CJEU's judgment in the *IP Translator* case (C/307/10) and the subsequent communication from the President of OHIM (the office which administers the CTM) as to how this judgment was to be interpreted.

³ See *Gérard Meric v OHIM*, Case T-133/05.

for members of the general public to purchase air control equipment and devices, it seems to me that the average consumer is more likely to be a tradesman in the ventilation field. They will possess specialist knowledge and will take at least a reasonable degree of care when the goods are purchased. Perusal of websites and brochures (and subsequent self-selection) is likely to be a common form in which the marks are encountered, although, I will still fully consider any aural similarity as the goods could be purchased over a trade counter. The cost of the goods will vary depending on their exact nature, but even for lower cost items there will still be a reasonable degree of care and attention utilised to ensure compatibility etc.

Comparison of the marks

15) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

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16) Intellair will be perceived as a single word, however, the average consumer will appreciate that the word consists of the conjunction of INTELL and AIR. The average consumer will also appreciate that the word AIR is descriptive in relation to the goods at issue. Whilst I agree with Ms Reid that the INTELL element will garner more attention, it is still a whole mark comparison, particularly, as in this case, the conjunction forms a single combined whole. IC's intel mark has only one word and is its dominant and distinctive element. The presentation of the marks in title and lower case does not matter; notional and fair use of either mark would include upper case, lower case or title case.

17) That both marks begin with the letters "I/intel" creates a degree of similarity. However, I must also bear in mind, as Mr Lintern stressed, the additional letter L (although this is only relevant from a visual perspective as I consider INTEL and INTELL will be articulated in the same way) and the additional word AIR in Western's mark. Weighing the similarities and differences, I consider there to be a reasonably high (but not the highest) degree of aural and visual similarity between the marks.

18) In terms of concept, Mr Lintern considers that Intellair will be seen as a reference to "intelligent air"; I agree that this is the case. However, I consider that intel is also likely to be seen as a reference to the word intelligent. There is a reasonably high degree of conceptual similarity.

The distinctiveness of the earlier mark

19) The more distinctive the earlier mark, the greater the likelihood of confusion. Distinctiveness can come from the mark's inherent characteristics or from the use that has been made of it. IC's reputation for microprocessors does not assist it because these are not the goods at issue here. In terms of the mark's inherent characteristics, I have said above that there is an allusion to the word intelligent. **Given this, the mark has at best an average degree of distinctiveness.**

Likelihood of confusion

20) The factors assessed have a degree of interdependency. A global assessment of them must be made when determining whether there exists a likelihood of confusion. There is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

21) The earlier mark has at best an average degree of inherent distinctive character. There is a reasonably high degree of visual, aural and conceptual similarity between the marks. The goods are identical. I must bear in mind the reasonably considered nature of the selection process. This will militate, to a degree, against imperfect recollection causing confusion. Nevertheless, I still consider that there is a likelihood of confusion. Western's mark is dominated by the word INTELL, AIR being descriptive. Even if the average consumer noticed the difference created by the additional word, they would in my view put the common presence of INTEL/L (the additional L may well be lost due to imperfect recollection) down to the companies responsible for these identical goods being the same or being related. **There is a likelihood of confusion and the opposition, therefore, succeeds.** I should add that even if the intel mark was perceived as an invented word (as opposed to a reference to intelligent/intelligence), I still consider that there would be a likelihood of confusion as the conceptual difference would not, in this instance, counteract the aural and visual similarities so as to avoid confusion.

22) Given the above finding, I do not consider it necessary to probe the ground under section 5(3) of the Act as it does not put IC in any better position.

Costs

23) IC having been successful it is entitled to a contribution towards its costs. My assessment of costs is as follows:

Opposition fee	£200
Preparing a statement and considering the other side's statement	£300
Filing evidence	£500
Attending the hearing	£500

Total

£1500

24) Western Air Ducts (UK) Limited is to pay Intel Corporation the sum of £1500. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of July 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).