



## Intel Corporation v Intelsteer Pte Ltd [2015] SGIPOS 2 – A Case Note

A recent case decided by the Registrar of Trade Marks in Singapore concerns an invalidation action under Sections 8 and 23 of the Trade Marks Act (Cap 332, Rev Ed 2005) (“**the Act**”).

This case is useful to parties intending to pursue a declaration of invalidity of an existing mark and the type of evidence that would assist in such endeavour. In particular, it illustrates that attempting to prove that a registered proprietor had taken unfair advantage of the similarity of an applicant’s mark, is indeed a challenging task. However, it might be easier to succeed in an invalidation action if an applicant is able to prove that amongst others, the applicant has acquired goodwill in Singapore and that the parties are in the same or similar fields of activity.

### A. THE PARTIES AND THE RELEVANT MARKS

The Applicants, Intel Corporation, produce processors that give power to electronic devices. They are an American company founded in 1968, and have grown to become a multibillion dollar global corporation today. Amongst others, they are also involved in network and communications, consumer electronics and peripherals.

The Applicants applied to invalidate trade mark registration number T0903014D



“**the Mark**”). The Mark is registered under Intelsteer Pte Ltd (a Singapore incorporated company dealing in lighting technology and manufacturing of energy saving lamps and fixtures) and in relation to the following services 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”.*

In the present case, the Applicants had relied on the following marks which have all been registered earlier under the same Class 42 to support its claim accordingly (“**the Applicants’ Earlier Marks**”):-

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S/N	Registered Mark	Registration Number	Registration Date	Specification
1.	INTEL	T9801120E	11 February 1998	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
2.	INTEL	T9805379Z	2 June 1998	Leasing of computers, computer hardware, peripherals, computer components, computer software, printers, copiers and office furniture.
3.	INTEL	T0005306J	31 March 2000	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 December 2005	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



				<p>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 software, computer hardware and telecommunications equipment.</p>
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## B. INVALIDATION CLAIMS ON THREE GROUNDS

The Applicants claimed that the Mark should be adjudged invalid, on three grounds: -

- (a) Sections 23(3)(a)(i) read with Section 8(2)(b) of the Act (“**the First Ground**”);
- (b) Section 23(3)(a)(iii) read with Section 8(4)(b)(i) and Section 8(4)(b)(ii) of the Act (“**the Second Ground**”); and
- (c) Section 23(3)(b) read with Section 8(7)(a) of the Act (“**the Third Ground**”).



## **(1) The First Ground**

Under Section 23(3)(a)(i), of the Act, the registration of a trade mark may be declared invalid if the conditions set out in Section 8(1) or (2) of the Act apply. The Applicants therefore relied on the conditions in section 8(2)(b) of the Act, which states that the registration of a trade mark may be declared invalid on the ground that 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.

The First Ground of invalidation *was not successfully made out* as the marks were similar to a low degree in totality. The Registrar found that, amongst others, there was a low level of similarity between the two marks and that the likelihood of confusion was minimal due to the nature of services provided by the contesting parties. The Applicants' Earlier Marks and the Mark contained the dominant component "INTEL" and were considered marginally similar conceptually, and as such were held to be aurally similar. However, the Registrar opined that nevertheless, the average consumer is someone who would exercise care when purchasing the services, and is likely to make a careful and measured decision; there is a low likelihood of confusion on the part of the relevant public.

## **(2) The Second Ground**

### **(i) Section 23(3)(a)(iii)<sup>1</sup> read with 8(4)(b)(i)<sup>2</sup>**

The test of similarity to be considered under this provision is the same as the one exercised in relation to the First Ground. The Registrar was also of the view that for the same reasons as the First Ground, the ground of invalidation under section 8(4)(b)(i) of the Act should also fail.

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<sup>1</sup> Section 23(3)(a)(iii) of the Act states that 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) of the Act apply.

<sup>2</sup> Section 8(4)(b)(i) of the Act states that the later trade mark shall not be registered if use of the later trade mark in relation to the goods or services for which the later trade mark is sought to be registered 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.



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

Under section 8(4)(b)(ii) of the Act, the later trade mark shall not be registered if the following are established:-

- (a) the earlier trade mark is well known to the public at large in Singapore; and
- (b) would cause dilution in an unfair manner of the distinctive character of the earlier trade mark; or
- (c) would take unfair advantage of the distinctive character of the earlier trade mark.

Further, section 2(1) of the Act defines dilution to be the “lessening of the capacity of the trade mark to identify and distinguish goods or services”.

Although the Registrar was prepared to hold that the “INTEL” mark was well known in Singapore, the Registrar held that the Applicants had failed to show that unfair dilution was caused by the Mark, or that the Registered Proprietors had taken unfair advantage of the similarity of the Mark to the Applicants’ Earlier Marks.

It is worth noting that the Registrar found that there was no indication that there was unfair advantage even though the following would have made the Applicants’ arguments persuasive:-

- (a) the reputation of the “INTEL” mark, and in particular, that it was first used in Singapore in 1975 before the Mark; and
- (b) the Registered Proprietors had not brought forward any evidence to prove that the mark was created by a graphic designer in 1995, as it was claimed.



### **(3) *The Third Ground***

Finally, the Applicants sought to rely on an argument of passing off as provided by under section 23(3)(b) of the Act<sup>3</sup> read together with section 8(7)(a) of the Act<sup>4</sup>. It has been well established that there are three elements to be fulfilled in order to establish passing off, namely goodwill, misrepresentation and damage.

The Registrar held that there was sufficient evidence of high net sales revenue and promotional outflow to indicate that the Applicants had considerable goodwill in Singapore.

In addition, the relevancy of the parties' field of activity plays a role in the claim of misrepresentation being successfully made out. It was established that since there is evidence of the Applicant's involvement in the field of energy efficiency and sustainability in the United States of America, the element of damage could be established as the Defendant's logo would compromise on the Applicant's ability to expand into similar fields in Singapore.

Therefore, the Registrar held that there was passing off and the Third Ground was successfully made out.

#### *A final note*

It is interesting to note that the Registered Proprietors were unrepresented in this case. In spite of this, the Applicants faced great difficulty in making their case and only succeeded with their final

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<sup>3</sup> Section 23(3)(b) of the Act states that the registration of a trade mark may be declared invalid on the ground that there is an earlier right in relation to which the condition set out in section 8(7) is satisfied.

<sup>4</sup> Section 8(7)(a) of the Act states that a trade mark shall not be registered if, or to the extent that, its use in Singapore is liable to be prevented 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.

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grounds of submission. One wonders if the outcome of the case could have been any different, if the Registered Proprietors had been represented by legal counsel.

*Should you have any queries as to how this case may affect your organisation or require further information, please do not hesitate to email us. Our relevant particulars are provided below.*



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*This article was prepared with the kind assistance of Ms Jolene Lim, a trainee at Gateway Law Corporation. She can be reached at [jolene.lim@gateway-law.com](mailto:jolene.lim@gateway-law.com). The article however is only intended to be a brief summary of the above case, and is not intended to be comprehensive nor should it be construed as legal advice.*