

1 THE PATENT OFFICE

Court 1,
Harmsworth House,
13- 15 Bouverie Street,
London EC4

4 Monday, 24th November 2008

5 Before:

6 MR. GEOFFREY HOBBS QC
7 (Sitting as the Appointed Person)

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10 In the Matter of an Appeal to the Appointed Person
11 In the Matter of Application No: 2404164 by Gary Milton Munroe
12 to Register a Series of Marks in classes 9 and 42, opposition
13 thereto under no. 94454 by Intel Corp., and appeal against the
14 decision by the Registrar dated 29 May 2008

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15 (Transcript of the Stenograph notes of Marten Walsh Cherer
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20 MR. MARK ENGELMAN appeared as counsel on behalf of the
21 Applicant.
22 MR. JAMES MELLOR QC (instructed by Messrs. CMS Cameron McKenna
23 LLP) appeared as counsel on behalf of the Opponent.

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24 APPROVED DECISION RE APPLICATION TO ADDUCE FRESH EVIDENCE

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1 THE APPOINTED PERSON: The question is whether Mr. Munroe should
2 be permitted to adduce fresh evidence on appeal. The answer
3 to that question is no.

4 It is appropriate at the outset to refer to the Form TM8
5 defence and counterstatement which Mr. Munroe prepared and
6 filed on 5th October 2006. In box 5 of that statement he
7 specifically confirmed that he accepted the statement of use
8 of the cited earlier trade marks which had been filed by the
9 Intel Corporation in support of its opposition. In box 7 he
10 confirmed that there was no dispute as to the reputation of
11 Intel. Further, in box 7 he specifically adopted the position
12 that the word "'Intel' stands for Integrated Electronics and
13 has nothing to do with 'intel' (intelligence colloquially
14 abbreviated)".

15 There were ample opportunities for Mr. Munroe to file
16 evidence during the course of the proceedings if he wished to.
17 He communicated with the Registry on that subject in 2007 and
18 at an earlier point via an enquiry made, as I understand it,
19 by his wife.

20 On 4th December 2007 he filed a form TM9 asking for an
21 extension of time within which to file evidence. In the
22 result, no evidence was filed.

23 He put forward written observations for the hearing
24 which took place before Mr. Landau on 14th May 2008. With
25 regard to those written observations it is clear to me from

1 what he said that he was accepting that INTEL was
2 a distinctive trade mark -- indeed a highly distinctive trade
3 mark -- and that it was well known. I would refer in
4 particular to paragraphs 3, 4, 6 and 7 of the document he put
5 forward for consideration.

6 In the notice and grounds of appeal filed on 25th June
7 2008, there was an intimation in paragraph 8 under the heading
8 "Comparison of the respective goods/services" that Mr. Munroe
9 would be seeking to file further evidence in relation to the
10 use he has made of his mark -- the mark under opposition.

11 At paragraph 14 there was a longer statement to the
12 following effect:

13 "The HO was wrong to find the primary meaning
14 of INTEL to denote the goods/services of the
15 Respondent. The Appellant will seek leave to
16 file further evidence in these proceedings
17 which will show that INTEL is not as
18 inherently distinctive as the HO found it to
19 be at Paragraph 25 of the Decision. That
20 evidence will show INTEL to be (i) an ordinary
21 dictionary word, a notorious fact the HO
22 should have taken into account; (ii) that
23 there are many third parties within the
24 United Kingdom which employ INTEL as
25 a component part of their trading names and
trade marks and have done for some time; (iii)
that the word is descriptive of the
Appellant's goods/services, namely, for use
specifically within the military intelligence
sector of the business-to-business market.
The HO should have taken these into account in
his finding upon the question of
distinctiveness. This was an error of fact."

24 It is now sought to put in two witness statements. The
25 first witness statement of Gary Munroe with attachments A to F

1 is dated 11th September 2008. In paragraphs 1 to 5 of that
2 witness statement Mr. Munroe deals with his personal
3 background. This evidence shows that he is the holder of
4 a Bachelor of Engineering degree in Electrical and Electronics
5 Engineering, with a specialisation in Satellite and Data
6 Communications. He was an engineering officer in the RAF and
7 an IT manager. He held positions of considerable
8 responsibility and during the period of his service with the
9 RAF rose to the rank of Flight Lieutenant.

10 Paragraphs 6 and 7 deal with the creation of his @I
11 ACTIVINTEL Business. Paragraphs 8 to 11, under the heading
12 "Descriptiveness of intel", refer to the fact that there are
13 names which can be found on searching, primarily Internet
14 searching, out of which the word "intel" can be extracted by
15 someone who is minded to make the extraction.

16 Paragraphs 12 to 18 deal with an alleged lack of use of
17 the trade mark INTEL in relation to goods or services for
18 which the earlier trade marks were registered. That evidence
19 is sought to be brought forward notwithstanding the express
20 confirmation in the defence that was originally filed in which
21 Mr. Munroe accepted the statement of use that had been put
22 forward by Intel Corporation.

23 Paragraphs 19 to 20 deal with the differences, as he
24 sees them to be, between the products -- the actual products
25 offered by Intel and the actual products offered by his

1 company and the way in which they reach the market.

2 Paragraphs 23 to 26 address the question of why the evidence
3 he wishes to bring forward was not adduced before.

4 In the second witness statement he seeks to put in
5 (which is a witness statement of 27th October 2008 with two
6 attachments) he further elaborates on the evidence in his
7 first witness statement by producing examples of use of names
8 in the telecommunications and IT sectors out of which the
9 component "intel" can be extracted.

10 The case law clearly establishes that it is necessary in
11 appeals under section 76 of the Trade Marks Act for due
12 deference to be given to the decisions of the Registrar's
13 hearing officers. For that to be a workable approach all
14 parties to Registry proceedings must exercise due diligence in
15 the preparation and presentation of their cases at first
16 instance. It has been emphasised on more than one occasion
17 that proceedings before the Registrar are not to be regarded
18 as a dry run for the purpose of deciding how a case might
19 subsequently be improved on appeal.

20 The first point I would mention in relation to the
21 evidence now sought to be filed is that it was not needed for
22 the purposes of the case that Mr. Munroe intended to put
23 forward and did put forward in defence of his application for
24 registration. I am not persuaded by the suggestion that
25 Mr. Munroe was somehow caught unawares in relation to the

1 presentation of the case he wished to advance. It seems to me
2 that the present request to adduce further evidence is based
3 on a change of position adopted in the aftermath of the
4 hearing officer's decision. I think it is clear that
5 Mr. Munroe is now endeavouring to outflank the decision by
6 adducing evidence in support of a case that backtracks to
7 a not insignificant degree on the position he adopted at first
8 instance.

9 The evidence in question could undoubtedly have been
10 obtained with reasonable diligence directed to the
11 presentation of that case at the hearing in the Registry. It
12 appears to me to raise no real basis for disputing the
13 distinctive character or the repute of the trade mark INTEL
14 within the areas of trading activity covered by the opposed
15 application for registration.

16 The question whether the trade marks in issue are
17 distinctively similar or distinctively different marks remains
18 for all practical purposes unilluminated by the evidence in
19 the two witness statements. I cannot see that any useful
20 purpose would be served by allowing the statements to be
21 introduced into the proceedings on appeal. In my view it
22 would be more conducive to a just and fair determination of
23 the appeal to refuse permission for the evidence to be adduced
24 than it would be to grant permission for the evidence to be
25 adduced. I therefore exercise my discretion adversely to the

1 appellant by refusing the application to adduce fresh evidence
2 on appeal.

3 I would wish to deal with the costs of this now because
4 we are dealing with things as we go.

5 MR. MELLOR: Sir, I would ask for the costs of the application.

6 THE APPOINTED PERSON: Can you give me some indication? It is now
7 11.30; so this has taken about an hour of this hearing.
8 Skeleton time, preparation time -- can you give me some
9 indication?

10 MR. MELLOR: Skeleton time is not that lengthy to be honest.

11 THE APPOINTED PERSON: It is fairly boilerplate stuff.

12 MR. MELLOR: It is fairly boilerplate stuff and actually the
13 application was pretty hopeless, I have to say.

14 THE APPOINTED PERSON: Fine; so an hour at the hearing and in
15 terms of your time perhaps an hour's prep or something like
16 that?

17 MR. MELLOR: Sir, perhaps a bit more than that because you have to
18 get your head round the case and the evidence they are trying
19 to get in.

20 THE APPOINTED PERSON: You were reading into the case anyway.

21 MR. MELLOR: Yes.

22 THE APPOINTED PERSON: Is there anything you want to say?

23 MR. ENGELMAN: Sir, suffice to say this, and it probably does not
24 affect your answer on this, but Mr. Munroe is a litigant in
25 person, although at the point of final service he was

1 represented. There were enormous difficulties in trying to
2 compile this evidence. When we talk about the word
3 "outflanked", there were two law firms he was communicating
4 with during the course of the proceedings. That was CMS
5 Cameron McKenna as well as Saunders & Dolleymore, both
6 concurrently communicating with him at the same time.

7 THE APPOINTED PERSON: There was an indication in the papers that
8 your client was communicating with Kennedys for advice.

9 MR. ENGELMAN: He was for a short period of time, sir, but when he
10 was alone and unrepresented he was communicated with by two
11 firms, sir. I am just saying that it should weigh in the
12 balance in terms of how you are minded to grant the award of
13 costs because conduct is relevant to a costs application.

14 THE APPOINTED PERSON: Is there anything more you want to say?

15 MR. ENGELMAN: No.

16 MR. MELLOR: No, sir.

17 THE APPOINTED PERSON: Costs in Registry proceedings are not
18 normally, and indeed are only very rarely, on an indemnity
19 basis. The normal approach is for there to be a contribution
20 towards the costs of the party which prevailed on the issue
21 concerned.

22 Taking a rough and ready view of this matter, on the
23 basis of the materials before me, I direct Mr. Munroe to pay
24 as a contribution towards the costs of Intel Corporation on
25 this issue the sum of £600 within 14 days of today's date.

(See separate transcript for proceedings)

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