

INTEL CORPORATION,	}	IPC No. 14-2009-00058
Opposer,	}	Opposition to:
	}	
-versus-	}	Serial No. 4-2008-009013
	}	Date Filed: July 28, 2008
FRANKLIN C. BARBERAN,	}	Trademark: "INTELNURSE
	}	ITALICIZED WITH LINE
	}	UNDERNEATH & CLINICAL
	}	INFORMATICS SOCIETY UNDER" [sic]
Respondent-Applicant.	}	
x-----x		Decision No. 2009-115

DECISION

This is an opposition proceeding commenced by Opposer INTEL CORPORATION, a corporation duly organized and existing under the laws of the State of Delaware, United States, with principal place of business at 2200 Mission College Boulevard, Santa Clara, California 95052, U.S.A., against the application for trademark "INTELNURSE IS ITALICIZED WITH LINE UNDERNEATH & CLINICAL INFORMATICS SOCIETY UNDER" (sic) Bearing Application Serial No. 4-2008-009013, which application was filed on July 28, 2008 by Respondent-Applicant FRANKLIN C. BARBERAN, with address at Blk. 6, Lot 18, St. Rafael Subdivision, Pangpang Sorsogon City.

The Opposer respectfully states the following:

1. Opposer is not licensed to do, nor is it doing, business in the Philippines. it sues herein only upon its intellectual property rights, pursuant to Section 3 of Republic Act No. 8293, otherwise known as the Intellectual Property Code (the "IP Code"), as well as Rule 2, Section 4 of the Rules and Regulations on *Inter Partes* Proceedings. Opposer is a national and domiciliary of the United States, which extends reciprocal rights, by treaty, convention or law, to nationals of the Philippines. Like the Philippines, the United States is a signatory of the Paris Convention for the Protection of Industrial Property and the Agreement on Trade Related Aspects of Intellectual Property ("TRIPS Agreement").
  
2. Respondent FRANKLIN C. BARBERAN is the applicant for the registration of the trademark "INTELNURSE IS ITALICIZED WITH LINE UNDERNEATH & CLINICAL INFORMATICS SOCIETY UNDER" (sic; "Respondent's trademark") under Application No. 4-2008-009013 (the "Subject Application"), filed on 28 July 2008, for goods and services under Class 41. The Subject Application was published for opposition in the Intellectual Property Office "IPO" e-Gazette on 24 October 2008.
  - a. Respondent BARBERAN is, on information, an incorporator, director, and stockholder of INTELNURSE CLINICAL INFORMATICS CLUB, INC. ("Respondent's Company"), a corporation organized and existing under the laws of the Philippines.

3. Opposer is primarily engaged in the business of designing, producing, distributing and selling microprocessors, integrated circuit components, system boards and other computer or computer-related electronic and electronic-related products. It is the world's largest producer of microprocessors, integrated circuits and other computer-related electronic products. Also, as part of its business, Opposer provides various computer-related services.
  - a. Opposer has over two hundred (200) offices and facilities around the world, which are all authorized to use the trademark and corporate name "INTEL". As of 29 December 2007, it had approximately 86,300 employees worldwide.
4. Opposer owns the trademark "INTEL" by prior registration, adoption and widespread use. The trademark "INTEL" is also well-known internationally and in the Philippines as the mark of Opposer. Since 1969, the "INTEL" trademark has gained international fame and worldwide recognition, mainly through Opposer's introduction of products using the said trademark which revolutionized not only the computer industry, but also the electronic and communication industries, including the first microprocessor launched in 1971. The microprocessors produced and sold by Opposer are installed in personal computers worldwide and are identified by consumers primarily under the trademark, trade name and corporate name "INTEL".
5. In 2007 alone, Opposer sold over US\$ 38.3 Billion of goods and services worldwide. In the period 1993 up to 2007 sold over US\$ 400 Billion worth of products and services under the "INTEL" mark. Opposer has also invested over US\$ 22.6 Billion for worldwide advertising from 1993 to 2007. In 2007, for example, it spent approximately US\$ 1.9 Billion on advertising.
6. As a result of Opposer's extensive efforts in promoting and advertising the mark, as well as the superior quality and innovativeness of its products, "INTEL" has become well-known internationally (including in the Philippines). In 2008, it was recognized as the seventh most valuable brand in Interbrand's Survey of the World's Most Valuable Brands, with an estimated value of US\$ 31.26 billion. It ranked as high as the third most valuable brand in the world in Interbrand's survey in 1993, and has consistently been ranked in the top ten since then.
7. To protect the goodwill and reputation of its internationally well-known trademark, trade name and corporate name, Opposer has registered "INTEL" as a trademark/service mark in one hundred ninety-seven (197) countries, including Australia, Austria, Brazil, Canada, china, France, Germany, Hong Kong, India, Indonesia, Italy, Japan, Mexico, Singapore, South America, to name but a few. To date, Opposer has about one thousand seventy-three (1,073) valid registrations and eighty-one (81) pending applications for the "INTEL" trademarks or trade name.
8. In the Philippines, Opposer is the owner and registrant of several "INTEL" trademark. In particular, Opposer is the owner and registrants of the "INTEL" word mark for Class 41 (the same class of goods/services being applied for by the subject

Application) under Registration No. 4-2006-000094. The application for the said trademark was filed on 3 January 2006 (more than two years before the filing of the subject Application), and the corresponding certificate of registration was issued on 25 December 2006. A copy of the pertinent certificate of registration, taken from this Honorable Office's On-line Trademark Registry, is attached hereto as Exhibit "C". Other "INTEL" trademarks registered in Opposer's name in the Philippines are evidenced and attached hereto as Exhibits C-series".

9. The foregoing documents prove that the "INTEL" mark, name and brand is famous and well-known internationally and in the Philippines. In addition thereto, the documents attached as Exhibit "D-series" hereof can also be taken into account.
10. That "INTEL" is an internationally well-known brand has been recognized by tribunals all over the world. To mention a few:
  - a. In Benelux (Belgium-Netherlands-Luxembourg), The District Court of Dordrecht issued a decision dated March 24, 2004 declaring that:
    - i. "[T]he distinctive power of the trademark INTEL is high, because the trademark is a fantasy name which does not describe the goods nor refers to the properties of the goods. It has been established between parties that the INTEL trademark has been used for years by Intel and, as a result of extensive promotional and publicity activities and wide-spread use of the products designated by the trademark INTEL, it has worldwide a high general repute
  - b. In Paraguay, the Ministry of Industry and Commerce ruled that "... the denomination INTEL is a well known trademark with international and domestic fame and reproducing the applied trademark [PROINTEL] such denomination constitute a deletion of the trademark registered, creating an unfair competition in the market and inducing to association in the public consumer. (sic)"
  - c. In Greece, the Greek Trademark Administrative Committee issued a decision dated 23 February 2001 acknowledging that Intel Corporation "is one of the largest and internationally well known enterprises... and produces products of exceptional quality marketed in most countries during more than 32 years..."
11. In the Philippines, this Honorable Office, being a "competent authority" to determine whether a trademark is well-known, has recognized that the "INTEL" mark is famous. In its Decision dated 21 December 2007 in *Intel Corporation v. Inteltech Resources, Inc.*, Inter Partes Case No. 14-2007-00168, this Honorable Office ruled:
  - i. "Based on the evidence consisting of excerpts from magazine articles and articles in publication (Exhibits "C" and "D"), the INTEL mark enjoys fame and popularity, it being a name of respected company

engaged in the marking [sic] of computer chips and processors. The article submitted depicts [sic] INTEL as a leading computer chip maker using advanced technologies in developing the latest chips for usage in personal computers. It appears from the articles submitted that INTEL processors have gained recognition and distinction in the IT field.”

12. It is likewise worth noting that another government agency, the Securities and Exchange Commission (SEC), also recognizes that the “INTEL” mark is a globally-known and internationally-famous mark, which cannot be appropriated in corporate and partnership names without Opposer’s consent. Proof of such recognition is the inclusion of the “INTEL” mark in the list of restricted names in the SEC’s “i-Register” system. The “INTEL” mark, together with the other core marks of Opposer, have been encoded in the SEC’s registration system as globally-known marks which cannot be used as part of a corporate or partnership name. Hence, the SEC’s “i-Register” system automatically rejects any proposed registration of a company name which bears the “INTEL” mark, specifically stating that “INTEL” is a globally known trade or brand name – it cannot be part of corporate or partnership name.”
13. All the foregoing point to the conclusion that Respondent-Applicant’s trademark, which uses the dominant feature “INTEL”, is not registrable as it is confusingly similar to Opposer’s registered and well-known “INTEL” mark. The IP Code provides:

“SECTION 123. *Registrability.* – 123.1 A mark cannot be registered if it:

“(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

“(e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided: That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

“(f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with

respect to which registration is applied for: Provided, That use of the mark in relation to those goods or services would indicate a connection between those goods or service, and the owner of the registered mark: Provided further, that the interests of the owner of the registered mark are likely to be damaged by such use;

“(g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services;” x x x (Underscore supplied)

14. More specifically, Respondent-Applicant’s trademark “INTELNURSE IS ITALICIZED WITH LINE UNDERNEATH & CLINICAL INFORMATICS SOCIETY UNDER” [sic] includes or incorporates Opposer’s “INTEL” marks the dominant, and discernable, feature thereof. Use of “INTEL” as a discernable, dominant and distinctive element makes Respondent-Applicant’s trademark confusingly similar to Opposer’s “INTEL” mark, particularly since the Subject Application is also for Class 41, which is the same as covered by Opposer’s earlier Registration No. 4-2006-000094.
15. It is noteworthy that the primary purpose of Respondent-Applicant’s Company, according to its Articles of Incorporation (attached hereto as Exhibit “H”), includes the following:
  - “1. Construction of a database of learning materials in multimedia form (including but not limited to printed materials and computer memory devices) and deliver them to clients in any form and manner feasible;
  - “2. Operation of a dedicated centralized cyberspace online library, accessible to target institutions and individual clients;”
  - a. To this end, Respondent-Applicant’s Company has created its website, which prominently displays the mark with the “INTELNURSE.” This website includes an online library, a test bank, and a book shop. Attached as Exhibit “I” hereof is a printout from the worldwide web/internet of the home page of such website.
16. Such inclusion of Opposer’s “INTEL” mark in Respondent-Applicant’s trademark is likely to cause confusion and deceive or mislead the public into believing that Respondent-Applicant’s Company and its activities, products and services are associated or connected with those of Opposer or are under Opposer’s sponsorship or have the same quality as those of Opposer. The public may be deceived into believing that Respondent-Applicant’s Company’s uploading of materials to its website and the running of its online testing service are related to the business of Opposer, which, in the words of this Honorable Office, has “gained recognition and distinction in the IT field.”

17. Opposer would be damaged by the allowance of the Subject Application. Opposer's right to the exclusive use of its previously registered and well-known "INTEL" trademark would be violated if Respondent-Applicant is allowed to register his trademark which is confusingly similar to Opposer's. If registration is allowed, Respondent-Applicant would be able to take a free ride on the hard-earned goodwill and reputation which Opposer has built on its "INTEL" mark, thus impairing Opposer's economic rights. Moreover, the copying of Opposer's "INTEL" trademark, if allowed and left unchecked, would necessarily diminish the distinctiveness of the said mark, causing Opposer grave and irreparable injury.

Attached to the Verified Notice of Opposition are the following exhibits for the Opposer:

Exhibits	Description
"A-series"	Copies of Opposer's audited Consolidated Financial Statements from 2003 o 2007.
"B"	Alpha List of registered "INTEL" trademarks, taken from Intel Corporation's website, as certified by Opposer's IPO resident agent, Atty. Gilbert R.T. Reyes.
"B-1" to "B-19"	Copies of a sampling of Opposer's legalized certificates of registration for "INTEL" issued in foreign jurisdictions, certified as true copies by Opposer's IPO resident agent, Atty. Gilbert R.T. Reyes.
"C"	Copy of the pertinent certificate of registration, taken from this Honorable Office's On-line Trademark Registry.
"C-series"	Copies of certificates of registration, taken from this Honorable Office's On-line Trademark Registry.
"D-series"	Documents proving that "INTEL" mark, name and brand is famous and well-known internationally and in the Philippines.
"E-series"	Copies of decisions recognizing the worldwide fame of the mark "INTEL", taken from Opposer's database, certified by Opposer's IPO resident agent.
"F"	Affidavit of Atty. Gilbert R.T. Reyes.
"G"	Copy of the Decision entitled "Intel Corporation v. Inteltech Resources, Inc., IPC No. 14-2007-000168, 21 December 2007."
"H"	Respondent-Applicant's Articles of Incorporation.
"I"	A printout from the worldwide web/internet of the home page of Respondent-Applicant's Company's website.

On March 17, 2009, this Bureau issued a Notice to Answer to Respondent-Applicant. For failure of the Respondent-Applicant to file its Answer, the case was submitted for decision.

The main issue is to be resolved in this case is:

WHETEHR OR NOT RESPONDENT-APPLICANT'S MARK INTELNURSE IS CONFUSINGLY SIMILAR WITH THE OPPOSER'S INTEL MARKS.

The test of confusing similarity which would preclude the registration of a trademark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public. The law does not require that the competing marks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law, that the similarity between the two labels be such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.

Thus, the Supreme Court in resolving the issue of confusing similarity has developed two kinds of tests – the Dominancy Test and the Holistic Test.

As its title implies, the test of dominancy focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception. It is necessary if the competing trademark contains the main, essential or dominant features of another, and confusion or deception is likely to result. Indeed, the question lies as to whether the use of the marks involved is likely to cause confusion or mistake in the mind of the public or deceive purchasers.

On the other side of this spectrum, the holistic test requires that the entirety of the marks in question be considered in resolving confusing similarity. Comparison of words is not the only determining factor. The trademarks in their entirety as they appear in their respective labels or hang tags must also be considered in relation to the goods to which they are attached. The discerning eye of the observer must focus not only on the predominant words but also on the other features appearing in both labels in order that he may draw his conclusion whether one is confusingly similar to the other.

In several cases decided by the Supreme Court, it has been consistently held that the question of infringement of a trademark is to be determined by the test of dominancy. Now, as to what constitutes a dominant feature of a label, no set of rules can be deduced. Usually, these are signs, color, design, peculiar shape or name, or some special, easily remembered earmarks of the brand that easily attracts and catches the eye of the ordinary consumer.

Relative thereto, it has been ruled in the case of Philippine Nut Industry, Inc. that:

“An ordinary word like PLANTERS may be considered as the dominant and striking mark of a label where it is used not merely to describe the nature of the product, but to project the source or origin thereof, and it is so printed across the label in bold letters that it easily attracts and catches the eye of the ordinary consumer and it is that word and none other that sticks in his mind when he thinks of the product.”

Relying on the above ruling, it can be deduced that the trademark itself “INTEL” is the dominant feature in the Opposer’s mark. Likewise, in the Respondent-Applicant’s mark

“INTELNURSE IS ITALICIZED WITH LINE UNDERNEATH & CLINICAL INFORMATICS SOCIETY UNDER” [sic], it is compound word mark, the dominant element of which is the word “INTEL” because it is the easily remembered earmark of the brand and the one that easily attracts and catches the eye of the ordinary consumer; the word “NURSE” being only a descriptive portion of the mark.

Applying the dominancy test, Opposer and Respondent-Applicant’s mark is similar in the sense that Respondent-Applicant’s mark “INTELNURSE” contains the word “INTEL” which is Opposer’s mark. Although Respondent-Applicant added the word “NURSE” to vary it from Opposer’s mark, nonetheless, confusing similarity cannot be eluded. The rule is that, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of other terms. On top of it, the similarity in the herein competing marks is made more evident in the class of goods, to which these two marks is used, i.e., they are used in same goods belonging to Class 41. As such, since the goods belong to the same class, they are so closely related that confusion is likely to occur as to the source or origin of the goods. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other. An unfair competitor need not copy the entire mark to accomplish its fraudulent purposes. It is enough if he takes the one feature which the average buyer is likely to remember. Indeed, measured against the dominant-feature standard, Respondent-Applicant’s mark must be disallowed. For undeniably, the dominant and essential feature of the article is the trademark itself. Therefore, to allow registration of Respondent-Applicant’s mark would violate not only Section 123 (d) of the IP Code but also the jurisprudential precepts laid down by the Supreme Court on this matter.

Moreover, Opposer is also the registered owner of the mark “INTEL”. According to Section 138 of Republic Act No. 8293, “the certificate of registration is a prima facie evidence of the registrant’s ownership of the mark, and of the exclusive right to use the same in connection with the goods or services specified in the certificate and those that are related thereto.” Thus, a registered owner should be protected against anyone who impinges on this right.

WHEREFORE, premises considered, the Notice of Verified Opposition filed by Opposer, Intel Corporation against Respondent-Applicant Franklin C. Barberan, is, as it is hereby SUSTAINED. Consequently, the trademark application for the registration of the mark “INTELNURSE IS ITALICIZED WITH LINE UNDERNEATH & CLINICAL INFORMATICS SOCIETY UNDER” (sic) of Respondent-Applicant bearing Application Serial No. 4-2008-009013 filed on 28 July 2008 for educational consultancy under Class 41 of the international classification of goods is, as it is hereby, REJECTED.

Let the file wrapper of “INTELNURSE IS ITALICIZED WITH LINE UNDERNEATH & CLINICAL INFORMATICS SOCIETY UNDER” (sic) of the instant case together with a copy of this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 4 September 2009.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs