

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Intel Corporation	§	
	§	Opposition NO.: 123,312
Opposer,	§	
	§	Applicant Serial No.
v.	§	75/825,218
	§	
Steven Emeny	§	International Classes: 35, 38, and 42
	§	
Defendant	§	Published: April 24, 2001

Box TTAB
NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

**OPPOSITION TO OPPOSER'S MOTION TO AMEND NOTICE OF
OPPOSITION AND CONCURRENT REQUEST FOR SUSPENSION, AND
REQUEST BY APPLICANT FOR DISMISSAL OF OPPOSITION**

Applicant is opposing Intel's request to amend its Notice of Opposition to remove the likelihood of confusion and dilution as grounds for opposition of Application Serial No. 75/825,218. It is also asking the Board to dismiss the Opposition case completely and rule in favor of the Applicant.



Background

02-27-2006

U.S. Patent & TMO/TM Mail Rpt Dt. #30

The Applicant, Steve Emeny, filed his U.S. Trademark application IDEAS INSIDE on Nov 5, 1999. The business plan focuses on the start up of an online service that targets the demographic of the internet generation. Intel Corporation, a manufacturer of microprocessors, opposed the trademark application on the basis that it was confusing and would dilute the value of the trademark INTEL INSIDE as depicted in

the listed trademarks of Intel's Notice of Opposition, see Exhibits A – L..

The issue of confusion was considered November 24, 2005 in the Canadian Intellectual Property Office and the decision brought forth by Madam Jill W. Bradbury – Member Trade-marks Opposition Board, found that there was no reasonable likelihood of confusion between the two marks IDEAS INSIDE and INTEL INSIDE, see page 20 of Exhibit M.

I. Argument

A. The Board Should Deny The Intel Request to Amend its Opposition and Dismiss Without Prejudice the Infringement and Dilution Causes of Action

It has always been the position of the Applicant that there is no confusion between the Marks as the channels of trade and wares and services are distinctly different as well as the look and sound of the marks.

In addition the Applicant has demonstrated his intent to use the trademark by filing the intent to use Trademark Application and defending the Application throughout the Opposition since Nov. 5, 1999 and allowing the trademark application to be decided by the rule of law. These actions demonstrate a bona fide intent and commitment to the Application IDEAS INSIDE.

Opposer has argued that by removing the likelihood of confusion and dilution grounds that it will prevent the courts from expending unnecessary resources on this case. The Opposer has spent six years pursuing this course of confusion and dilution and is now requesting to amend those grounds as it deems them no longer pertinent. It appears that INTEL has used up the courts resources unnecessarily. The lack of confusion and lack of dilution to the INTEL INSIDE mark is the basis of the Applicant's case. To

remove those grounds would be unfair to the Applicant.

The Applicant hereby requests that the Trial and Appeal Board deny Intel's request to amend its Notice of Opposition to remove likelihood of confusion and dilution as grounds for opposition of Application Serial No. 75/825,218.

REQUEST BY APPLICANT FOR DISMISSAL OF OPPOSITION

The Applicant, Steve Emeny, hereby requests that the Opposition of the Trademark IDEAS INSIDE Application serial No. 75/825, 218 be dismissed and decision in favor of the Applicant be made for the following reasons.

1. Intel Corporation initially Opposed the mark IDEAS INSIDE on the grounds it was confusing with the marks that branded INTEL, the INTEL INSIDE & Swirl Logo, See Exhibits A – L.
2. Intel Corporation Opposed the mark IDEAS INSIDE on the grounds that it would dilute the value of the INTEL INSIDE brand.
3. Based on evidence that was not available prior to January, 2006 it has become clear that Intel has evolved to meet the changing marketplace. It has ceased the use of the marks INTEL INSIDE & Swirl Design as outlined in the NOTICE OF OPPOSITION, See Exhibits A – L.

<u>Exhibit</u>	<u>Registration No.</u>	<u>Registered</u>	<u>Mark</u>
A	1,702,463	on July 21, 1992	INTEL INSIDE & SWIRL Logo
B	1,705,796	August 4, 1992	INTEL INSIDE
C	2,179,209	August 4, 1998	INTEL INSIDE

D	2,188,280	September 8, 1998	INTEL INSIDE & SWIRL Logo
E	2,194,122	October 6, 1998	INTEL INSIDE & SWIRL Logo
F	2,198,880	October 20, 1998	INTEL INSIDE
G	2,252,046	June 8, 1998	INTEL INSIDE
H	2,256,061	June 22, 1998	INTEL INSIDE
I	2,261,580	July 13, 1999	INTEL INSIDE
J	2,289,657	October 26, 1999	INTEL INSIDE
K	2,451,273	May 15, 2001	INTEL INSIDE & SWIRL Logo
L	2,942,936	April 19, 2005	INTEL INSIDE Logo

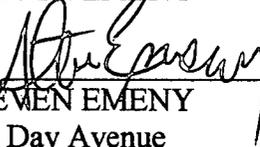
4. Intel has had a complete BRAND makeover. It has created a new stable of Trademarks that clearly define the 'NEW' Intel as outlined in Exhibit N INTEL'S NEW BRAND ARCHITECTURE. Intel is focusing specifically on the INTEL name and the catch phrase LEAP AHEAD. In addition it has an advertising budget of \$2.5 billion dollars to make the world aware of this change in the company. See Exhibits O, P.
5. The original trademarks that were filed in Opposition, exhibits A – L, no longer exist in use as a branding mechanism for the Intel Corporation. Therefore if the trademarks no longer exist there are no grounds for confusion and/or dilution.
6. The Applicant is absolutely committed to the business of IDEAS INSIDE.

As the opposing trademarks, Exhibits A-L, no longer exist in use there is no possibility for confusion and/or dilution. Therefore the Applicant requests that the board dismiss the Opposition No. 123,312 and find for the Applicant, Steve Emeny.

Respectfully submitted,

STEVEN EMENY

Date: Feb. 15 / 2006

By: 
STEVEN EMENY
121 Day Avenue
Toronto, Ontario
M6E 3W1
(416) 651-7346

Defendant

Certificate of Service

A copy of the

**OPPOSITION TO OPPOSER'S MOTION TO AMEND NOTICE OF
OPPOSITION AND CONCURRENT REQUEST FOR SUSPENSION, AND
REQUEST BY APPLICANT FOR DISMISSAL OF OPPOSITION**

was sent to the OPPOSER on February 15, 2006 via overnight courier.


Steve Emeny

EXHIBIT

A

Int. Cl.: 9

Prior U.S. Cl.: 26

United States Patent and Trademark Office

Reg. No. 1,702,463
Registered July 21, 1992

TRADEMARK
PRINCIPAL REGISTER



INTEL CORPORATION (DELAWARE CORPORATION)
3065 BOWERS AVENUE
SANTA CLARA, CA 95051

FOR: MICROPROCESSORS, IN CLASS 9 (U.S.
CL. 26).
FIRST USE 1-0-1992; IN COMMERCE
1-0-1992.

OWNER OF U.S. REG. NOS. 914,978, 1,022,563,
AND OTHERS.

SN 74-139,672, FILED 4-22-1991.

TODD BRAVERMAN, EXAMINING ATTORNEY

EXHIBIT

B

Int. Cl.: 9

Prior U.S. Cl.: 26

United States Patent and Trademark Office

Reg. No. 1,705,796

Registered Aug. 4, 1992

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
3063 BOWERS AVENUE
SANTA CLARA, CA 95051

FIRST USE 1-0-1992 IN COMMERCE
1-0-1992
OWNER OF U.S. REG. NOS. 1,143,978, 1,021,563,
AND OTHERS.

FOR: MICROPROCESSORS, IN CLASS 9 (U.S.
CL. 26).

SN 74-199,671, FILED 4-22-1991.
GLENN CLARK, EXAMINING ATTORNEY

EXHIBIT

C

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 2,179,209

Registered Aug. 4, 1998

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BOULEVARD
SANTA CLARA, CA 950521119 INTEL CORPORATION (DELAWARE CORPORATION)

2200 MISSION COLLEGE BOULEVARD
SANTA CLARA, CA 950521119

FOR: COMPUTER OPERATING SYSTEM SOFTWARE; COMPUTER OPERATING PROGRAMS; COMPUTER SYSTEM EXTENSIONS, TOOLS AND UTILITIES IN THE FIELD OF APPLICATION SOFTWARE FOR CONNECTING PERSONAL COMPUTERS, NETWORKS, TELECOMMUNICATIONS APPARATUS AND GLOBAL COMPUTER NETWORK APPLICATIONS; AUDIO AND VIDEO GRAPHICS FOR REAL TIME INFORMATION AND IMAGE TRANSFER, TRANSMISSION, RECEPTION, PROCESSING AND DIGITIZING; COMPUTER FIRMWARE; COMPUTER HARDWARE; COMPUTER PERIPHERALS; INTEGRATED CIRCUITS; INTEGRATED CIRCUIT CHIPS; SEMICONDUCTOR PROCESSORS; SEMICONDUCTOR PROCESSOR CHIPS; MICROPROCESSORS; PRINTED CIRCUIT BOARDS; ELECTRONIC CIRCUIT BOARDS; COMPUTER MEMORY DEVICES; SEMICONDUCTOR

MEMORY DEVICES; VIDEO CIRCUIT BOARDS; AUDIO CIRCUIT BOARDS; AUDIO-VIDEO CIRCUIT BOARDS; VIDEO GRAPHIC ACCELERATORS; MULTIMEDIA ACCELERATORS; VIDEO PROCESSORS; FAX/MODEMS; 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, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-0-1992; IN COMMERCE 1-0-1992

OWNER OF U.S. REG. NOS. 1,702,463 AND 1,703,796.

SN 75-160,103, FILED 9-4-1996

SOPHIA S. KIM, EXAMINING ATTORNEY

EXHIBIT

D

Int. Cl.: 9

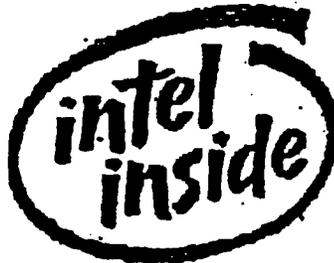
Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 2,188,280

Registered Sec. 8, 1996

TRADEMARK
PRINCIPAL REGISTER



INTEL CORPORATION (DELAWARE CORPORATION)
2208 MISSION COLLEGE BOULEVARD
SANTA CLARA, CA 95052-1175

FOR: COMPUTER OPERATING SYSTEM SOFTWARE, COMPUTER OPERATING PROGRAMS, COMPUTER SYSTEM EXTENSIONS, TOOLS AND UTILITIES IN THE FIELD OF APPLICATION SOFTWARE FOR CONNECTING PERSONAL COMPUTERS, NETWORKS, TELECOMMUNICATIONS APPARATUS AND GLOBAL COMPUTER NETWORK APPLICATIONS, AUDIO AND VIDEO GRAPHICS FOR REAL TIME INFORMATION AND IMAGE TRANSFER, TRANSMISSION, RECEPTION, PROCESSING AND DIGITIZING, COMPUTER FIRMWARE, COMPUTER HARDWARE, COMPUTER PERIPHERALS, INTEGRATED CIRCUITS, INTEGRATED CIRCUIT CHIPS, SEMICONDUCTOR PROCESSORS, SEMICONDUCTOR PROCESSOR CHIPS, MICROPROCESSORS, PRINTED CIRCUIT BOARDS, ELECTRONIC CIRCUIT BOARDS, COMPUTER MEMORY DEVICES, SEMICONDUCTOR

MEMORY DEVICES, VIDEO CIRCUIT BOARDS, AUDIO CIRCUIT BOARDS, AUDIO VIDEO CIRCUIT BOARDS, VIDEO GRAPHIC ACCELERATORS, MULTIMEDIA ACCELERATORS, VIDEO PROCESSORS, FAX/ROUTERS, 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 IN CLASS 9 (U.S. CLS. 21, 23, 24, 26 AND 36)

FIRST USE 1-8-1992; IN COMMENCE 1-8-1992

OWNER OF U.S. REG. NOS. 1,702,443 AND 1,702,176

SN 75-188,100 FILED 8-4-1996

SOPHIA E. KIM, EXAMINING ATTORNEY

EXHIBIT

E

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

Reg. No. 2,194,122

United States Patent and Trademark Office

Registered Oct. 6, 1998

**TRADEMARK
PRINCIPAL REGISTER**



INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BOULEVARD
SANTA CLARA, CA 950528119

FOR: PRINTED MATERIALS, NAMELY, BOOKS, MAGAZINES, NEWSLETTERS, JOURNALS, OPERATING MANUALS, USERS GUIDES, PAMPHLETS, AND BROCHURES ABOUT, FOR USE WITH AND DIRECTED TO USERS OF, COMPUTER OPERATING SYSTEM SOFTWARE; COMPUTER OPERATING PROGRAMS; COMPUTER SYSTEM EXTENSIONS; COMPUTER SYSTEM TOOLS; COMPUTER SYSTEM UTILITIES; COMPUTER APPLICATION SOFTWARE; COMPUTER FIRMWARE; COMPUTER HARDWARE; COMPUTER PERIPHERALS; COMPUTER COMPONENTS; INTEGRATED CIRCUITS; INTEGRATED CIRCUIT CHIPS; SEMICONDUCTOR PROCESSORS; SEMICONDUCTOR PROCESSOR CHIPS; MICROPROCESSORS; PRINTED CIRCUIT BOARDS; ELECTRONIC CIRCUIT BOARDS; COMPUTER MEMORY DEVICES; SEMICONDUCTOR MEMORY DEVICES; VIDEO CIRCUIT BOARDS; AUDIO CIRCUIT BOARDS; AUDIO-VIDEO CIRCUIT BOARDS; VIDEO GRAPHIC ACCELERATORS; MULTIMEDIA

ACCELERATORS; VIDEO PROCESSORS; FAX/MODEMS; 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; AND COMPUTER HARDWARE AND SOFTWARE FOR DEVELOPMENT, TESTING, PROGRAMMING, AND PRODUCTION OF HARDWARE AND SOFTWARE, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 1-0-1992; IN COMMERCE 1-0-1992.

OWNER OF U.S. REG. NOS. 1,573,324, 1,723,243, AND OTHERS.

SN 75-160,174, FILED 9-4-1996.

SOPHIA S. KIM, EXAMINING ATTORNEY

EXHIBIT

F

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

Reg. No. 2,198,880

United States Patent and Trademark Office

Registered Oct. 20, 1998

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BOULEVARD
SANTA CLARA, CA 950528119

FOR: PRINTED MATERIALS, NAMELY, BOOKS, MAGAZINES, NEWSLETTERS, JOURNALS, OPERATING MANUALS, USERS GUIDES, PAMPHLETS, AND BROCHURES ABOUT; FOR USE WITH, AND DIRECTED TO USERS OF, COMPUTER OPERATING SYSTEM SOFTWARE; COMPUTER OPERATING PROGRAMS; COMPUTER SYSTEM EXTENSIONS; COMPUTER SYSTEM TOOLS; COMPUTER SYSTEM UTILITIES; COMPUTER APPLICATION SOFTWARE; COMPUTER FIRMWARE; COMPUTER HARDWARE; COMPUTER PERIPHERALS; COMPUTER COMPONENTS; INTEGRATED CIRCUITS; INTEGRATED CIRCUIT CHIPS; SEMICONDUCTOR PROCESSORS; SEMICONDUCTOR PROCESSOR CHIPS; MICROPROCESSORS; PRINTED CIRCUIT BOARDS; ELECTRONIC CIRCUIT BOARDS; COMPUTER MEMORY DEVICES; SEMICONDUCTOR MEMORY DEVICES; VIDEO CIRCUIT BOARDS; AUDIO CIRCUIT BOARDS; AUDIO-VIDEO CIRCUIT BOARDS; VIDEO GRAPHIC ACCELERATORS; MULTIMEDIA

ACCELERATORS; VIDEO PROCESSORS; FAX/MODEMS; 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; AND COMPUTER HARDWARE AND SOFTWARE FOR DEVELOPMENT, TESTING, PROGRAMMING, AND PRODUCTION OF HARDWARE AND SOFTWARE, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 1-0-1992; IN COMMERCE 1-0-1992.

OWNER OF U.S. REG. NOS. 1,573,324, 1,723,243, AND OTHERS.

SN 75-160,102, FILED 9-4-1996.

SOPHIA S. KIM, EXAMINING ATTORNEY

EXHIBIT

G

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,252,046

United States Patent and Trademark Office

Registered June 8, 1999

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BLVD.
SANTA CLARA, CA 95052

FOR: T-SHIRTS, SHIRTS, BEACHWEAR,
LOUNGEWEAR, SWEATSHIRTS, SWEAT
SUITS, COVERALLS, JACKETS, TIES, HEAD-
WEAR, CARDIGANS, GYM SUITS, HATS, JOG-
GING SUITS, NECKTIES, POLO SHIRTS,

INFANT KOMPERS, IN CLASS 25 (U.S. CLS. 22
AND 39).

FIRST USE 12-0-1993; IN COMMERCE
12-0-1993.

OWNER OF U.S. REG. NOS. 1,723,243,
1,725,692, AND OTHERS.

SN 75-978,306, FILED 10-10-1997.

NANCY L. HANKIN, EXAMINING ATTORNEY

EXHIBIT

H

Int. Cl.: 21

Prior U.S. Cls.: 2, 13, 23, 29, 30, 33, 40, and 50

Reg. No. 2,256,061

United States Patent and Trademark Office

Registered June 22, 1999

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BLVD.
SANTA CLARA, CA 95052

FIRST USE 12-0-1993; IN COMMERCE
12-0-1993.

OWNER OF U.S. REG. NOS. 1,723,243,
1,725,692, AND OTHERS.

SN 75-371,546, FILED 10-10-1997.

FOR: MUGS, SPORTS BOTTLES, IN CLASS
21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

NANCY L. HANKIN, EXAMINING ATTORNEY

EXHIBIT

I

Int. Cl.: 28

Prior U.S. Cls.: 22, 23, 38, and 50

Reg. No. 2,261,580

United States Patent and Trademark Office

Registered July 13, 1999

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BLVD.
SANTA CLARA, CA 95052

MENTS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 10-0-1995; IN COMMERCE 10-0-1995.

FOR: TOYS, NAMELY, STUFFED TOYS, PLUSH TOYS, DOLLS, BEAN BAGS, GAMES, NAMELY, BOARD GAMES, STAND ALONE VIDEO GAMES, AND CHRISTMAS ORNA-

SN 75-371,544, FILED 10-10-1997.

NANCY L. HANKIN, EXAMINING ATTORNEY

EXHIBIT

J

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

Reg. No. 2,289,657

United States Patent and Trademark Office

Registered Oct. 26, 1999

**TRADEMARK
PRINCIPAL REGISTER**

INTEL INSIDE

INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BLVD.
SANTA CLARA, CA 95052

FOR: BINDERS, BOXES FOR PENS, TABLETS, NOTE CARDS AND PLAYING CARDS, SELF-ADHESIVE PADS, DESK PADS, AND CALENDAR PADS, PENS, PENCILS, FOLDERS, PHOTOGRAPH STANDS, RULERS,

MARKERS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 12-0-1993; IN COMMERCE 12-0-1993.

OWNER OF U.S. REG. NOS. 1,723,243, 1,725,692, AND OTHERS.

SN 75-978,352, FILED 10-10-1997.

NANCY L. HANKIN, EXAMINING ATTORNEY

EXHIBIT
K

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 2,451,273

Registered May 15, 2001

TRADEMARK
PRINCIPAL REGISTER



INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BLVD.
SANTA CLARA, CA 95052

FOR: COMPUTERS; COMPUTER HARDWARE; SOFTWARE FOR USE IN OPERATING AND MAINTAINING COMPUTER SYSTEMS; SEMICONDUCTORS; MICROPROCESSORS; INTEGRATED CIRCUITS; MICROCOMPUTERS; COMPUTER CHIPSETS; COMPUTER MOTHERBOARDS AND DAUGHTERBOARDS; COMPUTER GRAPHICS BOARDS; 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; COMPUTER UTILITY PROGRAMS; COM-

PUTER 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 A GLOBAL COMPUTER NETWORK; AND USER MANUALS FOR USE WITH, AND SOLD AS A UNIT WITH, ALL THE AFORESAID GOODS, IN CLASS 9 (U.S. CLS. 21, 26, 36 AND 38).

FIRST USE 1-0-1992; IN COMMERCE 1-0-1992.

OWNER OF U.S. REG. NOS. 914,976, 1,022,563, AND OTHERS.

SN 75-412,489, FILED 12-31-1997.

TERESA M. RUPP, EXAMINING ATTORNEY

EXHIBIT

L

Int. Cls.: 9 and 38

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101, and 104

Reg. No. 2,942,936

United States Patent and Trademark Office

Registered Apr. 19, 2005

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER



INTEL CORPORATION (DELAWARE CORPORATION)
2200 MISSION COLLEGE BOULEVARD
SANTA CLARA, CA 950528119

FOR: COMPUTER OPERATING SYSTEM SOFTWARE; COMPUTER OPERATING PROGRAMS; COMPUTER SYSTEM EXTENSIONS, TOOLS AND UTILITIES IN THE FIELD OF APPLICATION SOFTWARE FOR CONNECTING PERSONAL COMPUTERS, NETWORKS, TELECOMMUNICATIONS APPARATUS AND GLOBAL COMPUTER NETWORK APPLICATIONS; AUDIO AND VIDEO GRAPHICS FOR REAL TIME INFORMATION AND IMAGE TRANSFER, TRANSMISSION, RECEPTION, PROCESSING AND DIGITIZING; COMPUTER HARDWARE; INTEGRATED CIRCUITS; INTEGRATED CIRCUIT CHIPS; SEMICONDUCTOR PROCESSORS; SEMICONDUCTOR PROCESSOR CHIPS; COMPUTER HARDWARE, NAMELY MICROPROCESSORS; PRINTED CIRCUIT BOARDS; ELECTRONIC CIRCUIT BOARDS; COMPUTER MEMORY HARDWARE; SEMICONDUCTOR MEMORY HARDWARE; VIDEO CIRCUIT BOARDS; AUDIO CIRCUIT BOARDS; AUDIO-VIDEO CIRCUIT BOARDS; VIDEO GRAPHIC ACCELERATORS; MULTIMEDIA ACCELERATORS; VIDEO PROCESSORS; MODEMS; 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; COMPUTER NETWORK ROUTERS; HUBS; SERVERS; SWITCHES; COMPUTER FIRMWARE, NAMELY COMPUTER OPERATING SYSTEMS SOFTWARE; COMPUTER HARDWARE, NAMELY 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, VIRTUAL PRIVATE NETWORKS, WIDE AREA NETWORKS AND GLOBAL COMPUTER NETWORKS; ROUTER, SWITCH, HUB AND SERVER OPERATING SOFTWARE; COMPUTER SOFTWARE 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; AND MANUALS SOLD AS A UNIT AND DOWNLOADABLE FROM A GLOBAL COMPUTER NETWORK, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 3-0-2003; IN COMMERCE 3-0-2003.

FOR: TELECOMMUNICATIONS VIA A GLOBAL NETWORK OF COMPUTERS WITH THE EXCEPTION OF SATELLITE COMMUNICATIONS; MULTIMEDIA COMMUNICATIONS AND DIGITAL COMMUNICATIONS SERVICES, NAMELY, BROADCAST, TRANSMISSION, AND RECEIPT OF INTERACTIVE AND NON-INTERACTIVE AUDIO, VIDEO, AND DIGITAL SIGNALS; ELECTRONIC TRANSMISSION AND RECEIPT OF INTERACTIVE AND NON-INTERACTIVE VOICE, DATA, IMAGES,

PAGING MESSAGES, FACSIMILES, AND INFORMATION; TELECONFERENCING SERVICES; VIDEOCONFERENCING SERVICES; CHAT ROOM AND INSTANT MESSAGING SERVICES, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

FIRST USE 3-0-2003; IN COMMERCE 3-0-2003.

SN 78-198,761, FILED 12-30-2002.

JEFF DEFORD, EXAMINING ATTORNEY

EXHIBIT

M

For reasons similar to those expressed in the above-cited decisions, I find that the present proceedings are not a nullity because the application has not become abandoned as submitted by the opponent.

Section 12(1)(d) Grounds of Opposition

This ground pleads that the applicant's mark is confusing with the opponent's registered trade-marks. The opponent has met its initial burden with respect to this ground by the provision of particulars of its registrations Nos. TMA 408,395 and 512,081 for INTEL INSIDE Design and THE COMPUTER INSIDE, respectively.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in s. 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Those factors specifically set out in s. 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

I will first consider the likelihood of confusion between INTEL INSIDE Design and IDEAS INSIDE. The INTEL INSIDE Design mark is shown below:



I consider each of the marks to be inherently distinctive, but the opponent's mark has a greater degree of inherent distinctiveness since it includes the invented word INTEL. Only the opponent has shown that its mark has acquired distinctiveness.

The length of time that each mark has been used favours the opponent.

INTEL INSIDE Design is registered for microprocessors. There is therefore no overlap between the opponent's registered wares and the applicant's applied for wares and services. I consider the following wares and services of the applicant to be the most closely related to the opponent's registered wares:

computer games; software computer discs for use in the areas of graphic design and web page creation, accounting, word processing, database maintenance, e-mail, video conferencing, e-commerce; as well as in the specific area of finance namely to operate and maintain financial portfolios, to seek out real time stock quotes and stock trade execution; provision of live entertainment namely tradeshows in the field of computers and computer related products; production of video software games; production of educational software.

I will assume that the parties' channels of trade could overlap to some extent.

There is only a small degree of resemblance between the two marks in appearance, sound and idea suggested. This resemblance stems from the common last word INSIDE. Traditionally, it is the first word of a trade-mark, not the last, that is considered to be the dominant component. [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]

Additional surrounding circumstances put forward by the parties include i) the opponent's claim to have a family of marks that end with the word INSIDE, ii) the opponent's extension of use of its INTEL INSIDE Design mark to other wares, iii) third party adoption/use of INSIDE, and iv) foreign decisions that ruled in favour of the opponent against third parties. My comments concerning these points are as follows:

i) In order to support its claim that it has a family of INSIDE marks, the opponent must show use of the alleged members of the family. [*McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.)] However, there is no evidence before me of use, in accordance with s. 4, of the other members of the opponent's alleged family.

ii) Although there is evidence of the opponent extending its mark beyond its primary wares, I do not consider this to be a strong surrounding circumstance since there is no evidence of the extent of such sales in Canada.

iii) Mr. Emeny has provided a list of more than twenty domain names, which comprise one or more words followed by INSIDE.COM, which he says were registered as of March 1, 2002. However, in October and November 2002, Ms. Hemming found that it was not possible to access at least 8 of those domain names. A number of the domain names were available for registration and those that were not, listed non-Canadian entities as their owners.

iv) Cases decided in foreign jurisdictions have no precedential binding authority on this Board. [see *Origins Natural Resources v Warnaco U.S.* (2000), 9 C.P.R. (4th) 540 (T.M.O.B.) at 548] Moreover, every decision with respect to confusion is fact driven.

Having considered all the surrounding circumstances, I conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between IDEAS INSIDE and INTEL INSIDE Design. Although the opponent has established that it has been very successful in its marketing of its trade-mark, that does not lead me to conclude that the use of IDEAS INSIDE is likely to cause confusion as to source of the associated wares and services. The marks are in themselves sufficiently different to prevent confusion and the most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70].

A similar analysis with respect to the likelihood of confusion between IDEAS INSIDE and THE COMPUTER INSIDE would result in a similar conclusion.

For the foregoing reasons, I dismiss the s. 12(1)(d) grounds of opposition.

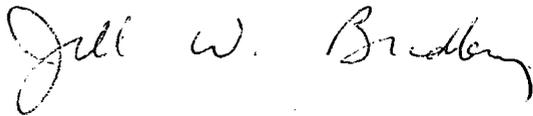
Section 16(3) and Distinctiveness Grounds of Opposition

I do not propose to discuss these grounds of opposition in any detail but note that most likely they would have been dismissed on the basis that there was not a likelihood of confusion, for reasons similar to those set out above with respect to the s. 12(1)(d) grounds of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 28th DAY OF OCTOBER 2005.



Jill W. Bradbury
Member
Trade-marks Opposition Board

EXHIBIT

N

EXHIBIT O

Exhibit N

Intel Drops Logo After 37 Years; Seeks to Take Image Beyond PCs

Dec. 30 (Bloomberg) -- Intel Corp., whose marketing made its computer chips a household name, is changing its logo for the first time in 37 years.

The dropped "e" in Intel will be shed in favor of a swoop around the company's name with the tag line "Leap Ahead." The "Intel Inside" phrase, a fixture since 1991, will be dropped, Santa Clara, California-based Intel said yesterday.

Intel's image change, to coincide with next week's Consumer Electronics Show in Las Vegas, is part of an effort by new Chief Executive Officer Paul Otellini to push Intel into home entertainment. The company, whose processors run more than 80 percent of personal computers, is trying to gain a foothold in the consumer market to counter slowing growth in PC chips.

"Intel has been struggling to find a way out of PCs for the last six or seven years," said Eric Ross, an analyst at ThinkEquity Partners in New York, who rates the stock "buy" and doesn't own it. "I never dreamed they'd drop 'Intel Inside.' Their marketing has been exceptionally successful."

Intel shares, up 7.2 percent this year, fell 37 cents to \$25.07 yesterday in Nasdaq Stock Market composite trading.

The change in Intel's brand is the first step in a \$2.5 billion marketing campaign, BusinessWeek reported earlier, without making clear where it got the information. Intel spokesman Bill Calder declined to comment on the number.

Intel also plans to introduce a new chip, which will be called "Core," to complement its Centrino laptop and Viiv home entertainment components.

After averaging growth of more than 13 percent for three years, Intel is expected to increase sales 8 percent next year to about \$42.3 billion, according to analysts' estimates.

Outside Intel

Intel marketing chief Eric Kim, hired in September 2004 from Samsung Electronics Co., outlined a plan to replace the Intel logo at an Oct. 20 meeting of company executives, Calder said.

Kim, Intel's first chief marketing officer, was brought in by Otellini, 55, to oversee the creation of a new image and catch phrase. He is credited with helping Samsung transform its image from that of a maker of cheap household appliances to having a brand more valuable than Sony Corp.'s.

McCann Worldgroup, a unit of Interpublic Group of Cos., was picked by Intel in March to run a global advertising campaign promoting the Viiv chips for home entertainment devices. Havas SA had handled Intel's advertising business.

Broader Changes

The new logo reflects broader changes inside Intel. Otellini, who took over from Craig Barrett in May, is the first company leader without a background in science or engineering.

In January, Otellini began Intel's largest reorganization since its founding in 1968. He created business divisions, including one called digital home, based on the uses of Intel chips, and said he is making the company "outward facing" rather than focused on producing faster semiconductors.

"Otellini isn't a technologist," Ross said. "He has more of a marketing and sales background. He's attacking the problem from a different angle. A good brand in consumer electronics can double your margins, even with the same components. That's something Sony did for years."

Central to Otellini's plan for Intel's future growth is getting the PC into the living room to replace digital video recorders, videocassette recorders, satellite set-top boxes and other home entertainment products.

The first step came with the announcement of the `Viiv" chips and platform in August. The chips and label will go with home PCs that let users download music and films to be played and shown on home audio systems and televisions. Otellini is expected to unveil new products next week at the Las Vegas convention.

Viiv Label

The Viiv label, like Pentium and ``Intel Inside," will show up on computers made by Intel customers including Dell Inc. and Hewlett-Packard Co., the world's two largest PC makers. Intel will continue to foot some costs for computer makers that display and advertise the labels and logo, Intel's Calder said.

``Intel Inside" was introduced in 1991 and was used to persuade consumers and businesses that the processor inside a computer was more important than the brand name on the outside.

That helped make Intel's brand worth \$35.6 billion in 2005, or No. 5 in the annual survey by London-based market researcher Interbrand Corp. General Electric Co., International Business Machines Corp., Microsoft Corp. and Coca-Cola Co. are the top four.

Intel's marketing was ready for a shakeup, said Doug Freedman, an analyst at American Technology Research in San Francisco.

``That they're going to focus on `Leap Ahead' makes me think about the technology," said Freedman. ``Not, `buy me because I'm inside,' but `buy me because I'm doing something unique.'"

To contact the reporter on this story:
Ian King in San Francisco at ianking@bloomberg.net
Last Updated: December 30, 2005 00:16 EST

EXHIBIT P

Exhibit ©

Related Topics: The Intel Transition

'Intel Inside' out, 'Leap ahead' in for new year

By Dan Nystedt, IDG News Service

After more than 20 years of service as a tool to teach consumers what brand of chip to ask for inside a personal computer, Intel Corp. has decided it's out with the old "Intel Inside" campaign in favor of a new logo and tag line that includes the phrase "Leap ahead." The logo and tag line will be formally announced on Jan. 3.

As part of the major re-branding effort, the 37-year old Intel logo, its name in lower case letters and a dropped "e," which was created by Silicon Valley pioneers Robert Noyce and Gordon Moore, has been, well, dropped. The new logo is simply "intel" with the same swoop around the word that has circled the phrase "Intel Inside" for over two decades.

"We're aligning our brand strategy with our platform strategy," said Bill Calder, a spokesman for Intel. The "Intel Inside" campaign focused solely on the company's microprocessors, such as its popular Pentium line of chips. But Intel has changed its focus to include entire platforms, including the microprocessor as well as other surrounding chips and chip sets, such as Centrino for laptops able to surf the Internet using Wi-Fi, and the upcoming Viiv platform for home entertainment computers. The new logo aims to reflect Intel's focus on whole platforms, instead of just on its microprocessors.

"As we evolve as a company, it makes sense to evolve our brand," said Calder.

Still, "Intel Inside," which launched in 1991, went a long way in teaching PC users something about the important components inside their computers, and helped separate the identity of the microprocessor from, say, the memory chip or graphics chip. It's a major change.

“It was a great campaign and it really put us on the map with consumers,” said Calder. And the term “inside” won’t disappear completely from Intel’s microprocessor lines. The company will use its new logo alongside the name of the processor and the word “inside” with its chips, such as “intel’ Pentium M inside”.

The new tag line, “Leap ahead” is meant to express what the company has made possible in the past in terms of technology, and what it intends to continue doing going forward, said Calder.

The company has been mulling the logo change for a few years, Calder said, ever since it shifted its focus to its platform strategy, which it reinforced earlier this year by reorganizing the company into five new business units: the Mobility Group, the Digital Home Group, the Digital Enterprise Group, the Digital Health Group and the Channel Products Group. Previously, the company had divided its units around chip architectures used in specific products, such as the Intel Architecture Group and Intel Communications Group.

The company spent much of this year working on the new logo, Calder said, but he declined to say how much the re-branding effort would cost the world’s largest chip maker.

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