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THE REPUBLIC OF UGANDA
IN THE HIGH COURT OF UGANDA AT KAMPALA
(COMMERCIAL DIVISION)
CIVIL SUIT No. 821 OF 2019

INTEL CORPORATION PLAINTIFF

10

VERSUS

INTEL COMPUTERS LIMITED DEFENDANT

BEFORE: HON. LADY JUSTICE SUSAN ABINYO

JUDGMENT

15 Introduction

The Plaintiff instituted this suit against the Defendant for trademark infringement seeking the following reliefs: a declaration that the Defendant is infringing on the Plaintiff's registered INTEL trademark; an Order for a permanent injunction restraining the Defendant from using the mark INTEL in any manner whatsoever, including in its name "INTEL COMPUTERS LIMITED", and restraining the Defendant from using any resembling or similar name or trademark to that of the Plaintiff's registered INTEL trademark in the future, in relation to any goods or services identical or similar to those covered by the Plaintiff's trademark registration No. 22192 INTEL in class 9, and No. 42587 INTEL in class 42; an Order directing the Defendant to change its company name "INTEL COMPUTERS LIMITED" to one that does not incorporate the Plaintiff's INTEL trademark or any other resembling or similar mark; an Order to deliver- up for destruction all the Defendant's material bearing the "INTEL COMPUTERS LIMITED" name, trademark, and, or get up, and, or any other material belonging to the Defendant which infringes on the Plaintiff's INTEL trademark, and that costs of the suit be provided for.

Facts

During the scheduling proceedings, there were no agreed facts.

The Plaintiff's facts are that the Plaintiff was founded on 18th July, 1968 by semiconductor pioneers Robert Noyce, and Gordon Moore, and the INTEL 'dropped e logo' was adopted in 1968.

5 That the Plaintiff first registered its trademark INTEL in class 9 in the United States of America under registration No. 938,772 on 25th July, 1972. Today, the Plaintiff is the proprietor in Uganda of trademark registration No. 22192 INTEL in class 9 as of 17th February, 1999, and trademark registration No. 42587 INTEL in class 42 as of 9th February, 2011. That the Plaintiff supplies the computing and communication
10 industries with microprocessors, boards, systems, and software building blocks which are the "ingredients" of computer servers, networking and communication products, and that the Plaintiff's customers include individual consumers, businesses, schools, and various government departments.

That for over 50 years, the Plaintiff has used the mark INTEL as a trade name, and
15 trademark to identify virtually its entire line of products, and services. INTEL is one of the world's most valuable, and famous name, and trademark worldwide. That as a result of the Plaintiff's extensive use, and promotion of its INTEL trademark, it has become a household name in Uganda. That the Plaintiff's registration, and use of its trademark INTEL in Uganda commenced before the Defendant was
20 incorporated in Uganda under the name "INTEL COMPUTERS LIMITED", and that the Plaintiff has acquired substantial goodwill, reputation, and well known mark status in its INTEL trademark in Uganda.

The Plaintiff contends that the use of the Defendant's name INTEL COMPUTERS LIMITED, infringes the Plaintiff's registered INTEL trademark in terms of sections 36,
25 and 37 of the Trademarks Act, 2010 (hereinafter referred to as "the Act").

The Defendant on the other hand, is a limited liability company incorporated under the laws of Uganda on 13th May, 2002 under Company No. 53373 in the name INTEL COMPUTERS LIMITED, and that the Defendant "INTEL COMPUTERS LIMITED" deals in computer equipments, repair, refurbishing services, upgrade
30 services, and networking services, and that the Plaintiff's registered trademark class 42 in Uganda was after the incorporation of the Defendant company.



That prior to the Defendant's incorporation, the Defendant's representatives conducted all the necessary verifications in the registry, and established that the name was available for use, and incorporated the Defendant company in the
35 name "INTEL COMPUTERS LIMITED", which has engaged in the business of repairing, and installing software in computers for over 18 years, and that the Defendant owns the same, and is in no way infringing the Plaintiff's or any other trademark.

5 Representation

The Plaintiff was represented by Counsel Sekatawa Mathias jointly with Counsel Ntale Alex of M/S MMAKS Advocates while the Defendant was represented by Counsel Hamuza Sebutta of M/S Nsibambi & Nsibambi Advocates, Legal and Corporate Consultants.

10 Issues for determination

The issues set out in the Joint Scheduling Memorandum filed by the parties on 10th November, 2020 were modified during the hearings of 19th March, 2021, and 25th November, 2021 as follows:

- 15 1. Whether the Defendant's use of the name "INTEL" constitutes infringement of the Plaintiff's "INTEL" trademark.
2. Whether the Defendant's use of the name "INTEL COMPUTERS LIMITED", and the Defendant's logo,  (which imitates the Plaintiff's INTEL "dropped e" logo) , constitutes infringement of the Plaintiff's "INTEL" trademark in terms of sections 36, and 37 of the Act.
- 20 3. What remedies are available to the parties.

Counsel for the parties herein, were directed to file witness statements which they complied with. During the hearings, the said witness statements were admitted on record as their evidence in chief. The Plaintiff adduced the evidence of Mr. Nishan Singh (hereinafter referred to as "PW1") the legal Representative, and
25 holder of Power of Attorney dated 6th November, 2019, marked PE17. The Defendant summoned Mr. Yasser Faisal the Managing Director (hereinafter referred to as "DW1").

Evidence

PW1 gave a background on the foundation of the Plaintiff company in the United
30 States of America, and its incorporation in 1972 in Annexure "NS6" marked PE5; the registration of the Plaintiff's INTEL trademark in Uganda in class 9 on 17th February, 1999 in Annexure "NS7" marked PE6, and class 42 on 9th February, 2011, in Annexure "NS8" marked PE8, and that he has been responsible for the enforcement of the Plaintiff's trademark for over the past decade.

35 It was the evidence of PW1 that the INTEL trademark is the Plaintiff's primary trademark, and is used on or in association with virtually all aspects of the Plaintiff's business, including products, services, packaging, communications, social media

5 and advertising, and that the Plaintiff is not just a microprocessor company but its
business spans the fields of health, computers, communications, the internet etc.
all of which are becoming increasingly interconnected, and in which the Plaintiff
uses its INTEL trademark. That the Defendant's use of the name INTEL COMPUTERS
LIMITED, reflects the INTEL portion of its name in a format identical to the Plaintiff's
10 "dropped e "logo on its storefront signage annexed hereto as "NS11" marked PE
11, and the receipts in Annexure "NS12" marked PE12.

PW1 testified that it is evident from Annexure "NS7" which was marked exhibit PE7
that the Plaintiff registered its INTEL trademark in Uganda in class 9 in respect of
Computers; computer hardware; computer firmware; semiconductors;
15 integrated circuits; microcomputers; computer chipsets; etc. and Annexure
"NS8" marked exhibit PE8 in class 42 in respect of "Computer- related, and
communications -related services, namely installation, repair, maintenance,
support and consulting services for computer- related, and communications-
related goods ; online catalog and mail order services for computer- related, and
20 communications- related goods, and services; etc.

PW1 further testified that the Defendant's name INTEL COMPUTERS LIMITED, which
is being used in a manner as to be taken as a trademark, wholly incorporates the
Plaintiff's registered INTEL trademark, and that the word COMPUTERS in the
Defendant's name increases the likelihood of confusion because it is descriptive
25 of the Plaintiff's field of interest, and that the Defendant is using a mark that so
nearly resembles the Plaintiff's trademark, as to be likely to deceive or cause
confusion in the course of trade. That in light of the above, use of the Defendant's
name INTEL COMPUTERS LIMITED infringes the Plaintiff's registered INTEL trademark
in terms of section 36, and 37 of the Act.

30 PW1 denied the Defendant's allegation that its company name was available for
use on the date of its incorporation in 2002, and stated that the Plaintiff's INTEL
trademark was registered in Uganda as of 17th February, 1999 prior to the
incorporation of the Defendant's company, and that on the date of
incorporation, use of the Defendant's company name infringed the Plaintiff's
35 registered trademark.



DW1 testified on the background of the Defendant's incorporation under the
name INTEL COMPUTERS LIMITED with company No. 53373, a copy of the
certificate of incorporation was attached as Annexure "A", and marked DE1,
and that the Defendant company deals in computer repair, refurbishing,
40 computer upgrade, and computer networking services, and that prior to its

5 incorporation, he conducted all the necessary verifications in the company registry, and established that the name was available to be used by any new company at the time, and belonged to no other, and was not similar to any Ugandan company.

10 It was the testimony of DW1 that the company started business of repairing and installing software in computers, and has been doing it for more than 17 years, and that the INTEL CORPORATION trademark that was registered in Uganda in 1999, related to manufacturing to which the Defendant is not involved. That by the time the Plaintiff registered class 42 on the 9th February, 2011, the Defendant had been in operation for over nine (9) years, and could not have infringed on
15 their trademark.


DW1 further testified that the company has gained substantial good will and recognition in the repair and installation of software to its small scale consumers, and that the company has never suffered any interventions from any third party, and it came as a shock when they received summons from the Plaintiff. That the
20 Defendant company has never owned or registered any trademark, and cannot be infringing on the Plaintiff's trademark.

Counsel for the Plaintiff preferred to deal with issue 2 above, then 1, and lastly 3, which order this Court will adopt hereunder:

Issue No. 2: Whether the Defendant's use of the name "INTEL COMPUTERS LIMITED", and the Defendant's logo,  (which imitates the Plaintiff's INTEL "dropped e" logo) , constitutes infringement of the Plaintiff's "INTEL" trademark in terms of sections 36, and 37 of the Act.

Counsel for the Plaintiff submitted that the Plaintiff has registered its INTEL trademark in black and white colours, and block capital font which affords the
30 Plaintiff wide protection in respect of all colours and all fonts, and that there is no limitation on the Plaintiff's trademark rights.

In reply, Counsel for the Defendant submitted that the operative word is a trademark, and that it was conceded that the Defendant owned no trademark
35 but operates as a duly registered company, and as such it is not true, and inconceivable that by using the duly registered company name INTEL COMPUTERS LIMITED, the Defendant infringes the Plaintiff's registered trademark.

5 In rejoinder, Counsel for the Plaintiff submitted that the Defendant's claim that it is not using a trademark is an illogical argument because the Defendant's company name, and logo are both used as trademarks for its business, and that under section 1 of the Act, a trademark is defined to include a mark or sign, and a "mark or sign" includes any name or logo or any combination of them. That the
10 Defendant is using the name INTEL COMPUTERS LIMITED, and a sign , both of which are trademarks that are infringing the Plaintiff's INTEL trademark.

Decision

15 Section 36 of the Act, provides for the rights given by registration of goods in part A, and what amounts to infringement thereof, while section 37 of the Act, provides for the rights given by registration of services in part A, and infringement of the same.

A trademark means a sign or mark or combination of signs or marks capable of being represented graphically, and capable of distinguishing goods or services
20 of one undertaking from those of another undertaking. A sign or mark includes any word, symbol, design, slogan, logo, sound, smell, colour, brand label, name, signature, letter, numeral or any combination of these capable of being represented graphically. **(See section 1 of the Trademarks Act, No. 17 of 2010)**

25 In the given circumstances of this case before me, protection is extended to the use of logos, once the requirement of registration is done in accordance with the law as hereunder.

It is noteworthy that for a trademark to be eligible for registration, it must relate to particular goods or services, and this is the rationale for classification of registration
30 either under part A or B of the Act. To enable registration under part A, the Applicant must satisfy the requirements of distinctiveness **(See section 4 of the Act)**, and non-descriptive nature of the goods or services. It is descriptive if it describes the nature or identity of the goods or services for which it is used. **(See**
35 **section 9(1) (e) of the Act)**

Upon registration, the owner of the trademark acquires exclusive rights to use the trademark in relation to goods or services for which the trademark is registered for a period of 7 years, and is renewable every 10 years upon payment of a
40 prescribed fee, subject to any limitations entered on the register.

5 Infringement of a trademark occurs when a person, not being the owner of the trademark or authorized by the owner of the trademark, uses in the course of trade a mark identical to or resembling it, in relation to goods or services identical or similar or of the same description with those for which the trademark was registered, and where, the use would result in a likelihood of confusion. (See
10 **sections 36, and 37 of the Act, and Halsbury's Laws of England 4th edition 1984, Butterworths London at 61**; paragraph 81 on the expressions "identical mark for identical goods or services", and paragraph 82 on "identical mark for similar goods or services; similar mark for identical goods or services)

15 Section 36(3) of the Act provides that:

"The right to the use of a trademark given by registration in Part A of the register, shall be subject to conditions or limitations entered on the register and shall not be taken to be infringed by the use of that mark in any mode, in relation to goods
20 to be sold or otherwise traded in a place, in relation to goods to be exported to a market or in any circumstances, to which, having regard to the limitations, the registration does not extend." (Emphasis is mine)

In the instant case, it was the Plaintiff's evidence as above, that from Annexure
25 "NS7" which was marked exhibit PE7, the Plaintiff registered its INTEL trademark in Uganda in class 9 in respect of Computers; computer hardware; computer firmware; semiconductors; integrated circuits; microcomputers; computer chipsets; etc.

The Defendant's evidence was that prior to its incorporation, they conducted all
30 the necessary verifications in the company registry, and established that the name was available to be used by any new company at the time, and belonged to no other, and was not similar to any Ugandan company, and that the company started business of repairing and installing software in computers, and has been doing it for more than 17 years. That the INTEL CORPORATION trademark
35 that was registered in Uganda in 1999 by the Plaintiff related to manufacturing to which the Defendant is not involved.

According to Halsbury's Laws of England(supra), para.70 at 51, the concept of likelihood of confusion is used both for assessing the registrability of a sign, and as
40 a test for infringement. In the context of infringement, the Court must assume that the registered trademark is used in a normal and fair manner in relation to goods or services for which it is registered and then assess a likelihood of confusion in


5 relation to the way the Defendant uses its sign, discounting added matter or circumstances.

In the case of **British Sugar Plc Vs James Robertson & Sons Ltd [1996] RPC 281 at 296 per Jacob. J** stated that:

10 "In relation to the expression "goods of the same description" the Courts found a useful test coined by Romer J in *Re Jellinek's Application* (1946) 63 RPC 59 at 70, namely that regard should be had to the nature and composition of the goods, the respective uses of the articles, and the trade channels through which the commodities are respectively bought and sold."

15 The Judge in that case further observed that the inquiry as to the extent to which the respective goods are competitive may take into account how those in the trade classify goods (eg whether market research companies, who act for the industry, put the goods or services in the same or different sectors).

I have considered the guidance in the authority of **British Sugar Plc Vs James Robertson & Sons Ltd** above, cited by Counsel for the Plaintiff, in relation to the expression "goods of the same description" and taken into account the nature, and composition of goods in class 9, which relates to the manufacture of computers, and computer products, and find that the Defendant's business relates to repair and installation of software in computers. The nature of the Defendant's business is therefore different from that of the Plaintiff, and does not relate to goods in class 9 as alleged by the Plaintiff.


In regard to the trade channels through which the said goods are bought and sold by the Defendant, no evidence was adduced by the Plaintiff to prove that the goods bought and sold originated from the Plaintiff's products that are manufactured under class 9, for which the Plaintiff's INTEL mark was registered or that the Defendant used the name "INTEL COMPUTERS LIMITED", and Logo  , to deal in identical or similar goods for which the Plaintiff registered the INTEL trademark.

35 The burden of proof lies with the Plaintiff to prove the fact of infringement. The Plaintiff has not adduced cogent evidence to prove that the Defendant's use of the name "INTEL COMPUTERS LIMITED" as a company and, or the logo as a mark in the course of trade, was in respect of goods that are identical or similar or of the same description in class 9 for which the Plaintiff's INTEL trademark was registered.

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Decided cases have established that the "test of infringement is likelihood of confusion which is the probability that a reasonable customer in the relevant market will be confused or deceived, and will believe the infringers' goods or services to come from or sponsored or endorsed by the complainant or that the two are affiliated. (See *Vision Impex Limited Vs Sansa Ambrose & Goldman Logistice Import and Export*, HCCS No. 303 of 2013, which cited with approval the cases of *Angelo Fabrics (Bolton) Ltd and Anor Vs Africa Queen Ltd and Anor*, HCCS No. 632 of 2006, and *Standards signs (U) Ltd Vs Standard Signs Ltd and Anor*, HCCS No. 540 of 2006), relied upon by Counsel for Defendant in their submissions.

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I am inclined to find that the Defendant's use of the name "INTEL COMPUTERS LIMITED" and the logo , was not in respect of goods in class 9 of the International Classification of Goods and Services, and that the likelihood of confusion, which would otherwise be created to the public by the way the Defendant uses its sign is far-fetched .

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In the result, this Court finds that the Defendant's name "INTEL COMPUTERS LIMITED", and its business of repairing and installing software in computers, did not in any way interfere with the exclusive rights of the Plaintiff as the registered owner of INTEL trademark in part A of the Act, in respect of goods in class 9 as provided in the International Classification of Goods and Services that relates to Computers; computer hardware; computer firmware; semiconductors; integrated circuits; microcomputers; computer chipsets; etc. for which the Plaintiff registered its INTEL trademark.

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The submission by Counsel for the Plaintiff that the Defendant is using two marks, namely the company name INTEL COMPUTERS LIMITED, and the logo, and that both these marks wholly incorporate the Plaintiff's registered INTEL trademark in a dominant and prominent manner, and therefore the said name and logo so nearly resembles the Plaintiff's INTEL trademark as required by sections 36 and 37 of the Act is untenable.

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For reasons above, I find that the Defendant's use of the name "INTEL COMPUTERS LIMITED", and the Defendant's logo, , does not constitute infringement of the Plaintiff's "INTEL" trademark in respect of goods in class 9 in terms of section 36 of the Act.

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Section 37(3) of the Act provides that:



10 "The right to the use of a trademark given by registration in Part A of the register shall be subject to conditions or limitations entered on the register and shall not be taken to be infringed by the use of that mark in any mode, in relation to services for use or available for acceptance in a place, country or territory or in any other circumstances, to which, having regard to the limitations, the registration does not extend." (Emphasis is mine)

15 The Plaintiff's evidence was that its registered INTEL trademark in class 42 in Annexure "NS8" marked exhibit PE8 was in respect of "Computer- related, and communications-related services, namely installation, repair, maintenance, support and consulting services for computer- related, and communications-related goods; online catalog and mail order services for computer- related, and
20 communications- related goods, and services; etc.

The Defendant's evidence was that by the time the Plaintiff registered class 42 on the 9th February, 2011, it had been in operation for over nine (9) years, and could not have infringed on their trademark.


25 Infringement of a trademark in part A of the Act, occurs when a person, not being the owner of the trademark or authorized by the owner of the trademark, uses in the course of trade a mark identical to or resembling it, in relation to goods or services identical or similar or of the same description with those for which the trademark was registered, and where, the use would result in a likelihood of confusion. (Emphasis is mine)

30 It was submitted for the Plaintiff that it is necessary to compare the trademark as registered, with the mark used by the Defendant to determine whether a person's trademark has been infringed.

35 This Court was unable to make a comparison of the Plaintiffs "dropped e" logo)  , in which the Plaintiff alleges that the Defendant's use of the logo  , imitates, and nearly resembles its "INTEL" trademark, and that it constitutes infringement under sections 36 and 37 of the Act because there was no evidence adduced by the Plaintiff to prove that fact. The logo displayed on
40 the Plaintiff's anniversary brochure attached as Annexure "NS4" marked PE3,

5 and the printouts from the social media pages demonstrating use of the Plaintiff's mark attached as "NS5" marked PE4, bears the name "intel" in lower case as opposed to "INTEL" in upper case, the registered mark of the Plaintiff, without the dropped e logo as alleged by the Plaintiff.


10 I am cognisant of the provision of the law under sections 36, and 37 of the Act, and find that in cases of this nature, the test of infringement is likelihood of confusion, which has been considered above.

This Court made a comparison of the Defendants name "INTEL COMPUTERS
15 LIMITED", and its logo , with the Plaintiffs mark "INTEL" first registered in the United States of America in 1972, a copy of the certificate of registration of the said mark No. 938,772 was marked exhibit PE5, the mark "I N T E L" registered in Uganda under the name "INTEL CORPORATION" in respect of class 9 on 17th February, 1999, a copy of the certificate of registration of the said mark in No.
20 22192 was marked exhibit PE6, and the mark INTEL registered in Uganda under the name "INTEL CORPORATION" in respect of class 42 on 9th February, 2011, a copy of the certificate of registration of the said mark in No. 42587 was marked exhibit PE7.

25 It is notable that the mark "INTEL" or "I N T E L" as seen above, was in black and white colour with capital font however, the spacing in the latter mark, in respect of goods in class 9 by the Plaintiff, does not resemble the former mark except for the use of the word INTEL. The mark "I N T E L" registered in 1999, was prior to the Defendant's registration of the name "INTEL COMPUTERS LIMITED" in respect of
30 class 9 of the International Classification of Goods and Services, for which this Court has made a finding above.

The meaning of the word "use" for purposes of infringement occurs when a person uses a sign, in particular, if he:

- 35 i. affixes it on the goods or the packaging thereof;
ii. offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign or offers or supplies services under the sign;
iii. imports or exports goods under the sign; or
iv. uses the sign on business papers or in advertising. **(See Halsbury's Laws of**
40 **England 4th edition(supra) para.84 at 62)**

5 The comparison further reveals that the Defendant's name "INTEL COMPUTERS LIMITED" as a company name, was registered prior to Plaintiff's name "INTEL CORPORATION", and mark "INTEL" in respect of class 42 of the International Classification of Goods and Services. This notwithstanding the fact that the Defendant's logo , is descriptive of goods or services in class 42.

10 Accordingly, the Defendant cannot be said to have infringed on the Plaintiff's "INTEL" registered trademark in respect of goods or services in class 42, which was used by the Defendant prior to the Plaintiff's registered "INTEL" mark.

15 It is notable that registration of a company is governed by the Companies Act, 2012, and registration of trademarks is by the Trademarks Act, 2010. The prerequisites to enable registration in the respective laws are totally different. However, it's possible for a company to reserve a name under the Registry of Companies, and also use that name as a mark, if it meets the requirement of
20 registrability under the Act.

The Plaintiff did not adduce evidence to prove to the satisfaction of this Court that the Defendant was using its name "INTEL COMPUTERS LIMITED" in the course of trade in respect of goods or services identical or similar or of the same
25 description to the Plaintiff's "INTEL" mark in class 42 of the International Classification of Goods and Services.

In the whole, I find that the Defendant's use of the name "INTEL COMPUTERS LIMITED" compared with the Plaintiff's INTEL trademark, does not constitute
30 infringement of the Plaintiff's "INTEL" trademark in respect of class 42, in terms of section 37 of the Act for which the Plaintiffs INTEL trademark was registered.

Issue No.1: Whether the Defendant's use of the name "INTEL" constitutes infringement of the Plaintiff's "INTEL" trademark.

The ingredients for infringement of a trademark are as follows;

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- i. That the mark is identical or similar to the registered mark.
 - ii. The mark was used in the course of trade in relation to goods or services identical or similar or of the same description.
 - iii. As a result, there is a likelihood of confusion with the registered mark or between the registered marks. **(See L. Bently & B. Sherman Intellectual Property Law 4th edition at 1038)**
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These ingredients have been taken into account in the determination of the 2nd issue above however, the outline herein is for emphasis on this 1st issue.

Section 24 (b) and (c) of the Act provides that:

"The registration of a trademark shall not affect—

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(b) the bona fide use by a person of any description of the character or quality of his or her goods or services, not being a description that is likely to be taken as importing a reference mentioned in section 36(2)(b) or;

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(c) the bona fide use by a person of a description of the character or quality of his or her services, not being a description that is likely to be taken as importing a reference as mentioned in section 37(2)(b)." (Emphasis is mine)

Section 36(2)(b) of the Act provides that:

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"Without prejudice to the general effect of subsection (1), the right conferred by that subsection shall be taken to be infringed by a person who, not being the owner of the trademark or a registered user of the trademark uses by way of permitted use, a mark identical with or so nearly resembling it, as to be likely to deceive or cause confusion in the course of trade in relation to any goods of the same description where the use would result in a likelihood of confusion and in such a manner as to render the use of the mark likely to be taken—

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(b) in a case in which the use of the goods or in physical relation to the goods or in any publishing circular or other publication issued to the public, as importing a reference to some person having the right as owner or as registered user of the trademark or to goods with which that person is connected in the course of trade." (Emphasis is mine)

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Section 37(2)(b) of the Act provides that:

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"Without prejudice to the general effect of subsection (1), the right conferred by subsection (1) shall be taken to be infringed by a person who, not being the owner of the trademark or a person authorised by the owner for that purpose, uses it in connection with the provision of any services a mark identical with or nearly resembling it, in relation to services in respect of which it is registered or in relation to services of the same description where the use would result in a likelihood of confusion and in such a manner as to render the use of the mark likely to be taken—

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5 (b) in a case in which the use is near the place where the services are available
for acceptance or performed or in an advertising circular or other advertisement
issued to the public as importing a reference to some person having a right either
as owner or by his authorisation under the relevant regulations to use the mark or
10 services with the provision of which that person is connected in the course of
business." (Emphasis is mine)

In the instant case, the Defendant adduced evidence to prove the choice of the
name INTEL for its registered company name "INTEL COMPUTERS LIMITED". This
evidence was uncontroverted by the Plaintiff. In the given circumstances, this
15 Court is inclined to find that the Defendant's bonafide use of the description of
the character or quality of his goods thereof, does not amount to a description
that is likely to be taken as importing a reference mentioned in section 36(2)(b) of
the Act. This finding is notwithstanding the Court's finding as above, that the
Defendant's name or logo did not interfere with the Plaintiff's INTEL registered
20 trademark in part A of the Act in respect of goods in class 9.

In regard to class 42 in respect of the Plaintiff's INTEL registered trademark, this
Court found as above, that the Defendant's use of the name "INTEL COMPUTERS
LIMITED", does not constitute infringement of the Plaintiff's "INTEL" trademark in
25 respect of class 42, in terms of section 37 of the Act. The answer in regard to this
1st issue therefore, is in the negative.

It is my considered view that the reading of sections 30, and 35 of the Act
together, is to the effect that non registration of a trademark does not affect any
legal action against a person for passing off the goods and services of another.

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Issue No. 3: What remedies are available to the parties.

This Court having found the issues (2) and (1) above in the negative, none of the
remedies is available to the Plaintiff as sought.

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I am cognisant of the main purpose for which trademarks are registered, and
fortified in my decision that the Defendant's use of the name "INTEL COMPUTERS
LIMITED" cannot prevent the public from distinguishing the goods or services of
Defendant's undertaking from those of the Plaintiff in the course of trade.

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5 For reasons stated above, this suit is dismissed against the Plaintiff with costs to the Defendant.

Dated and delivered by email to Counsel for the parties herein, this 9th day of August, 2022.

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SUSAN ABINYO
JUDGE
9/08/2022

