

I am submitting some comments on behalf Intel Corporation.

As you may know, Intel Corporation is the world's largest semi-conductor company.

Key areas of our business include the manufacture of silicon chips and technology for the PC, server, and telecommunications market segments.

We have offices throughout Australia, with our head-office based in Sydney, and we operate in Australia through our Australian subsidiary company Intel Australia Pty. Ltd.

Our website [www.intel.com](http://www.intel.com) averages 2.4 million hits a week, and our website [www.intel.com.au](http://www.intel.com.au) is averaging around 2500 hits a week.

Our trade mark "Intel" was recently ranked by Interbrand as the world's 4th most valuable mark (after Coca Cola, IBM, and Microsoft), and our "Intel", "Pentium" and "Celeron" marks, among others, are very well known by our Australian customers, and the Australian public generally.

We have registered our trade marks in numerous classes in over 170 countries.

In Australia, we have registered more than 200 trademarks, covering classes 9, 14, 16, 18, 21, 25, 28, 36, 38 and 42.

We actively enforce and protect our trademarks world wide, including in Australia.

Our comments on the issues Paper dated February 2002 are set out below:

***4.8.3 - Well known marks/dilution.***

In our view it would be desirable for Australia to introduce provisions to further assist in the protection of well-known and famous marks. As owners of numerous well-known/famous marks such as "Intel" and "Pentium" (which we have registered in numerous classes worldwide including Australia), we submit that the existing legislation in Australia does not presently provide adequate protection against unauthorised or diluting use of such marks.

We would welcome anti-dilution provisions similar to those in the Lanham Act in the US.

We do not view the establishment of a Register of "well-known" or "famous" marks as essential for protection to be given to such marks against dilution. We have confidence in the Australian courts to establish whether or not a mark is "well-known" or "famous" based on the evidence submitted to it in any trademark related dispute where the fame of a trade mark is an issue.

Factors to be taken into account when considering an application of inclusion in the Register should include:

- Advertising expenditure

- Revenue under mark
- Any evidence of consumer recognition including survey evidence
- World fame ranking statistics from trademark rating organisations
- Worldwide TM portfolio
- Any other evidence which establishes that the mark is well-known to consumers.

We would encourage the rights which are accorded to owners of well-known/famous marks to include the ability to restrain other's from making use of an identical or similar mark for any goods or services.

Further comments:

#### **4.1.1.a**

We agree that there are sometimes misunderstandings in Australia about the effect of registering a TM, a business name, and a company name. We have found this to be the case, especially among smaller business who have not sought the advice of intellectual property lawyers prior to adopting a company name or business name.

We have taken action many times against companies who have had business and/or company names "validly granted", only to realise later that they are in fact infringing our TM rights. This results in correspondence, legal fees, and sometimes legal proceedings and costs, all of which are disruptive and burdensome on both parties, and which would not have been incurred had the business owner been properly informed at the outset.

We support initiatives by the Government to seek to educate those who advise businesses at an early stage of development, such as accountants and financial managers, of the distinction between the rights derived from registering a TM as opposed to a business name, or a company name.

We support more extensive searching of the Australian TM Register by the Government departments responsible for the approval of company names and business names and encourage closer co-operation and communication between IP Australia and the computer systems used by ASIC and state government business names departments.

#### **4.7.2 - Action against counterfeiting**

We support empowering local government agencies with powers of seizure and allowing TM owners certain powers of seizure, coupled with contemporaneous court procedures.

#### **4.8.4 - Infringement and dilution on the Internet**

We do not support seeking international protection for TM owners of Australian marks who make use of their mark on the Internet which infringes a mark in another jurisdiction. A mark used on the Internet arguably constitutes use in another country, regardless of where the user is based, especially if used on a web-site which is designed to solicit business from countries

outside of Australia. We believe the onus to ensure such use does not infringe a 3rd party's rights outside of Australia should fall on the user of the mark and that the existing principles of jurisdiction are adequate to address this area of law.

We further do not see the use of a disclaimer such as that suggested in 4.8.4 as being an acceptable way for a TM owner to seek to avoid liability for infringement. Such conduct would be no different from, for example, the owner of a mark in Australia registered for clothing using the mark in countries in which its mark infringes another's TM rights, trying to avoid liability for TM infringement, by adding such a disclaimer phrase somewhere on the packaging. The primary function of a TM is to indicate the source of origin of the goods or services, and it would be undesirable to permit companies to commit what would otherwise be a TM infringement by using a mark in combination with a disclaimer stating, in effect, that the user has no TM rights in the country in which the mark is being used.

Yours faithfully

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