

O/0373/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003744140  
IN THE NAME OF SWEETCOW LTD  
FOR THE TRADE MARK

**Think Memory. Think MemoryCow.**

IN CLASSES 9 AND 35

AND

THE OPPOSITION THERETO UNDER NO. 432367  
BY LENOVO (SINGAPORE) PTE. LTD

## Background and pleadings

1. On 18 January 2022 SWEETCOW LTD (“the applicant”) applied to register the trade mark shown in the cover page of this decision in the UK.

2. The application was accepted and published in the Trade Marks Journal on 04 February 2022 in respect of the following goods and services:

**Class 9:** *Flash memory devices (portable); Portable hard disk drives for computers; Blank flash memory cards; Blank USB cards; Blank USB flash drives; External computer hard drives; External hard drives; Flash memory; Flash memory card; Flash memory cards; Hard drives; Memory cards; Memory cards for cameras; Memory devices; Memory sticks; Memory storage devices; Mobile hard drives; RAM [random access memory] card; USB adapters; USB card readers; USB flash drives; USB hardware; USB hubs; USB port cards; USB readers; USB sticks; Blank USB cards; Blank USB flash drives; Solid-state drive [SSD].*

**Class 35:** *Retail services in relation to computer hardware, software and peripheral devices.*

3. On 04 April 2022, Lenovo (Singapore) Pte. Ltd (“the opponent”) opposed the application under Sections 5(2)(b) and 5(3)<sup>1</sup> of the Trade Marks Act 1994 (“the Act”).

4. Under Section 5(2)(b), the opponent relies on the seven earlier marks set out below:

UK00900198010

THINKPAD

Filing date: 01 April 1996; Registration date: 09 September 1999; Seniority date: 16 November 1994.

Relying on some of the goods covered by the registration, namely:

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<sup>1</sup> The opponent initially pleaded a Section 5(4)(a) ground, however, it subsequently requested to remove it in its submissions in lieu.

**Class 9:** *Computers, adapters for computers, any components and peripheral devices for computers Portable computers Documentation and instruction manuals recorded on machine readable medium and relating to computers and peripheral devices for computers, and to portable computers.*

UK00917966138

THINKSHIELD

Filing date: 08 October 2018; Registration date: 06 February 2019; Priority date: 24 July 2018.

Relying on all of the goods covered by the registration, namely:

**Class 9:** *Computer software..*

UK00003344037

THINKSHIELD

Filing date: 08 October 2018; Registration date: 28 December 2018; Priority date: 24 July 2018.

Relying on all of the goods covered by the registration, namely:

**Class 9:** *Computer software.*

UK00917615006

THINKSMART

Filing date: 19 December 2017; Registration date: 25 March 2019; Priority date: 07 December 2017.

Relying on all of the goods and services covered by the registration, namely:

**Class 9:** *Smart TVs; television monitors; computers; mobile computers; mobile communications devices; computer monitors; computer touch screens; computer joysticks; computer keyboards; telephones; speakerphones; video display monitors; video cameras; adapters; cables; microphones; electronic devices for receiving and reading text, images and sound through wireless Internet access; monitors for television and radio signal transmitters and receivers; set-top boxes; electronic controllers for use with power controllers; electronic controllers to impart sensory feedback, namely, sounds and vibrations that are perceptible to the user; receivers; remote controls for television receivers; headphones and earphones; remote controls for portable and handheld electronic devices and computers; wireless controllers to monitor and control the functioning of other electronic devices; computer hardware, namely, voice controlled personal assistant devices, namely,*

*personal data assistants and personal digital assistants; voice controlled audio speakers, voice controlled information devices, namely, portable computers and portable communications devices, namely, tablets, smart phones, smart watches and mobile computing devices; voice controlled home and office automation electronic control devices, namely, lighting controls, audio/video controls, HVAC controls, humidity controls, security and camera systems controls, entry system controls, warning system controls, electronic window covering controls, electronic appliance controls, gaming system controls.*

**Class 38:** *Telecommunication access services; telecommunications services, namely, electronic transmission of streamed and downloadable audio and video files via computer and other communications networks, providing on-line electronic bulletin boards for the transmission of messages among computer users in the field of consumer product information; web casting services; delivery of message by electronic transmission; telecommunication services namely, electronic transmission of streamed and downloaded audio and video and multimedia content files via computer and other communications networks; providing an online Internet forum for the transmission of messages and information; providing online chat rooms for social networking; providing access to databases; providing telecommunication connectivity services for the transfer of images, messages, audio, visual, audiovisual and multimedia works among e-readers, mobile phones, smartphones, portable electronic devices, portable digital devices, tablets or computer; streaming of audio, visual and audiovisual material via the Internet or other computer or communications network; electronic and wireless transmission and streaming of digital media content for others via global computer networks to handheld computers, laptops, and mobile electronic devices.*

**Class 42:** *Computer services, namely, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops, and mobile electronic devices; software as a service (SAAS), namely, hosting software for use by others for use for collecting and processing log and event data from devices, web sites and other software applications.*

UK00915755523

THINKSYSTEM

Filing date: 18 August 2016; Registration date: 16 December 2016.

Relying on some of the goods covered by the registration, namely:

**Class 9:** *Computer servers; computer storage apparatus; Data storage systems and accessories, namely, electronic information storage server systems for use in enterprise storage applications, network storage, network attached storage and storage area networks, consisting of computer hardware, computer peripherals, and operating system software; racks for servers; rack-mount kits.*

UK00918051602

THINKBOOK

Filing date: 15 April 2019; Registration date: 08 April 2020; Priority date: 16 November 2018.

Relying on all of the goods covered by the registration, namely:

**Class 9:** *Computers, laptop computers, notebook computers, portable computers, tablet computers, computer peripherals and accessories, computer hardware and software sold as a unit.*

UK00903014438

THINKCENTRE

Filing date: 20 January 2003; Registration date: 30 March 2007; Priority date: 26 August 2002.

Relying on all of the goods and services covered by the registration, namely:

**Class 9:** *Computers; computer hardware and computer software; computer programs excluding computer games; adapters for computers; components and peripherals for computers; computer hardware, namely an illumination device for computer keyboards and terminals; computer memories; interfaces for computers; data processing equipment; printers; integrated circuits; printed circuits; magnetic disks; disk drives; compact discs; magnetic tapes; tape recorders; calculating machines; pocket calculators; cash registers; facsimile; video screens; video recorders; video tapes; computer programs; documentation and instruction manuals recorded on machine-readable media and relating to computers or computer programs.*

**Class 16:** *Instructional and teaching material; documentation and publication relating to computers or computer programs; manuals; printed publications; printed*

*matter related to computers and to computer hardware and computer software, excluding computer games.*

**Class 42:** *Computer programming; design, updating and maintenance of computer software, excluding computer games; technical project studies in the field of computer hardware and software; consultancy in the field of computer hardware; computer systems analysis; advice and consulting relating to use of Internet; rental of computers and computer software, excluding computer games; services for providing user access to computers for business management; legal services; scientific and industrial research.*

5. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent's earlier marks were automatically converted into comparable UK trade marks. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

6. The opponent's marks have filing dates (or priority/seniority dates) that are earlier than the filing date of the contested application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. Although some of the opponent's marks had completed their registration process more than five years before the filing date of the contested application and are subject to the proof of use conditions as per Section 6A of the Act, when the applicant filed its Form TM8 it elected not to request proof of use. Consequently, the opponent can rely on all of the goods and services it has identified in its notice of opposition without having to prove use.

7. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the applicant's mark is similar to its own marks, and the respective goods and services are identical or similar. In particular, the opponent states that the component 'MEMORY' in the applied-for mark will be understood by the average consumer as a descriptive term, indicating that the contested goods and services are related to memory devices, and that this element being wholly non-distinctive, it will

be disregarded by the average consumer. Under this ground, the opponent relies on all of the earlier marks to support its family of mark argument. It states that the likelihood of confusion is further increased by the fact that the opponent is the owner of a family of trade marks characterised by the presence of the word "THINK" and that the applied-for mark is not only highly similar to the individual marks belonging to the opponent's family, but also displays characteristics capable of associating it with the family itself.

8. Under Section 5(3), the opponent relies only on one mark, namely the UK00900198010 mark and claims reputation for all class 9 goods. The opponent claims that use of the applicant's mark would, without due cause, take unfair advantage of or be detrimental to the distinctive character or repute of its mark.

9. The applicant filed a defence and counterstatement, denying all the grounds in which it states:

- That since June 2014 the applicant has been in the business of selling third-party branded memory devices using the trading name 'MEMORYCOW' on its main website at [www.memorycow.co.uk](http://www.memorycow.co.uk);
- The applicant's main website [www.memorycow.co.uk](http://www.memorycow.co.uk) has received the gold seal of approval from the prestigious e-commerce feedback company eKomi following product reviews from 4,490 customers who collectively awarded an approval rating of 4.8 out of 5. Accordingly, it cannot be reasonably doubted that the applicant's 'MEMORYCOW' business and trademark are well-known in the relevant industry and to the relevant public;
- The applicant's mark 'THINK MEMORY - THINK MEMORYCOW' is essentially in the form of a slogan of the type which encourages customers and prospective customers who are thinking of upgrading their memory capacity for their products to think about products available from the applicant. Customers can enter the website and insert details of their product, such as manufacturer and model number, following which the configurator tool will carry out a search from a list of some 290,000 possible products in the applicants' product database to provide a list of suitable products for each particular product, thereby allowing

the customer to choose a preferred manufacturer or a preferred range of memory storage required or add-on's, such as cables and card readers or any combination of these;

- The applicant has built up a substantial reputation as a re-seller of branded goods under and by reference to the trade mark 'MEMORYCOW';
- The opponent is a well-known manufacturer and vendor of computer devices and peripherals sold under a range of trademarks such as 'ThinkPad', 'Think Book', 'Think Vision', 'Think Station' and 'Think Smart' where, in every instance, the letter "i" is composed of a prominent red dot above the rest of the letter in black or greyscale. The use of the red dot in the letter "i" indicates that the opponent accepts that the word "think" *simpliciter* is one of the most ubiquitous words in the English language, to the extent that by adding the red dot there is at least something arguably distinctive present;
- The word "think" is common in ordinary everyday written or spoken communication. It is not an invented word and when used in the sense intended by the applicant's mark, it is effectively there to direct customers to the applicant's 'MEMORYCOW' website and business;
- In contrast, use of the word "Think" as the prefix for each of the opponent's marks is always followed by terms such as Pad, Book, Vision, Centre, Station, etc. which indicate the product itself or some characteristic relating to the product;
- The opponent has no monopoly in the word "think", and the term "think" is commonly used in trade in the context of computer devices and peripherals such as memory upgrades. The applicant conducted a search of UKIPO trade mark register which identified no less than 361 entries for marks containing the word "think" in class 9;
- It is admitted that the respective goods, or at least some of them, are identical or similar but it is denied that there is any risk of confusion or any risk that use of the applicant's mark would take unfair advantage of or be detrimental to the distinctive character of any of the opponent's marks;
- It is denied that the opponent has a reputation in the word 'THINK' *simpliciter* or that it has been used as a trade mark in its own right. For the same reasons, it is denied that the applicant's mark offends any of the provisions of Section



5(2) in circumstances where the applicant acts as a re-seller of third-party branded goods, or even goods bearing its own 'MEMORYCOW' trade mark.

10. Both parties filed evidence during the evidence rounds. I shall refer to the evidence only to the extent that I consider necessary.

11. The opponent is represented by HGF Limited and the applicant by Richard R Halstead & Co Ltd. Neither party asked to be heard but they both filed submissions in lieu.

## **EU Law**

12. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **The evidence**

13. The opponent's evidence consists of a witness statement by Becky Williams, the Senior Counsel and Director of Trademarks for the opponent's company. Ms Williams' witness statement is dated 9 February 2022 and is accompanied by 23 exhibits (BW1-BW23).

14. The applicant's evidence is provided by Leigh James Cowell, the managing director and majority shareholder of the applicant's company. Mr Cowell's witness statement is dated 27 October 2022 and is accompanied by 3 exhibits (LJC1-LJC3).

## **DECISION**

### **Section 5(2)(b)**

15. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

16. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the

imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

18. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

19. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

21. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

22. The goods and services to be compared are as follows:

The applicant’s goods	The opponent’s goods
<p><b>Class 9:</b> <i>Flash memory devices (portable); Portable hard disk drives for computers; Blank flash memory cards; Blank USB cards; Blank USB flash</i></p>	<p><b>THINKPAD</b>  <b>Class 9:</b> <i>Computers, adapters for computers, any components and peripheral devices for computers</i></p>

*drives; External computer hard drives; External hard drives; Flash memory; Flash memory card; Flash memory cards; Hard drives; Memory cards; Memory cards for cameras; Memory devices; Memory sticks; Memory storage devices; Mobile hard drives; RAM [random access memory] card; USB adapters; USB card readers; USB flash drives; USB hardware; USB hubs; USB port cards; USB readers; USB sticks; Blank USB cards; Blank USB flash drives; Solid-state drive [SSD].*

*Portable computers Documentation and instruction manuals recorded on machine readable medium and relating to computers and peripheral devices for computers, and to portable computers.*

**THINKSHIELD**

**Class 9:** *Computer software.*

**THINKSMART**

**Class 9:** *Smart TVs; television monitors; computers; mobile computers; mobile communications devices; computer monitors; computer touch screens; computer joysticks; computer keyboards; telephones; speakerphones; video display monitors; video cameras; adapters; cables; microphones; electronic devices for receiving and reading text, images and sound through wireless Internet access; monitors for television and radio signal transmitters and receivers; set-top boxes; electronic controllers for use with power controllers; electronic controllers to impart sensory feedback, namely, sounds and vibrations that are perceptible to the user; receivers; remote controls for television receivers; headphones and earphones; remote controls for portable and handheld electronic devices and computers; wireless controllers to monitor and control the functioning of*

*other electronic devices; computer hardware, namely, voice controlled personal assistant devices, namely, personal data assistants and personal digital assistants; voice controlled audio speakers, voice controlled information devices, namely, portable computers and portable communications devices, namely, tablets, smart phones, smart watches and mobile computing devices; voice controlled home and office automation electronic control devices, namely, lighting controls, audio/video controls, HVAC controls, humidity controls, security and camera systems controls, entry system controls, warning system controls, electronic window covering controls, electronic appliance controls, gaming system controls.*

**THINKSYSTEM**

**Class 9:** *Computer servers; computer storage apparatus; Data storage systems and accessories, namely, electronic information storage server systems for use in enterprise storage applications, network storage, network attached storage and storage area networks, consisting of computer hardware, computer peripherals, and operating system software; racks for servers; rack-mount kits.*

	<p><b>THINKBOOK</b></p> <p><b>Class 9:</b> <i>Computers, laptop computers, notebook computers, portable computers, tablet computers, computer peripherals and accessories, computer hardware and software sold as a unit.</i></p> <p><b>THINKCENTRE</b></p> <p><b>Class 9:</b> <i>Computers; computer hardware and computer software; computer programs excluding computer games; adapters for computers; components and peripherals for computers; computer hardware , namely an illumination device for computer keyboards and terminals; computer memories; interfaces for computers; data processing equipment; printers; integrated circuits; printed circuits; magnetic disks; disk drives; compact discs; magnetic tapes; tape recorders; calculating machines; pocket calculators; cash registers; facsimile; video screens; video recorders; video tapes; computer programs; documentation and instruction manuals recorded on machine-readable media and relating to computers or computer programs.</i></p>
	<p><b>THINKCENTRE</b></p> <p><b>Class 16:</b> <i>Instructional and teaching material; documentation and publication relating to computers or computer</i></p>



	<p><i>programs; manuals; printed publications; printed matter related to computers and to computer hardware and computer software, excluding computer games.</i></p>
<p><b>Class 35:</b> <i>Retail services in relation to computer hardware, software and peripheral devices.</i></p>	
	<p><b>THINKSMART</b></p> <p><b>Class 38:</b> <i>Telecommunication access services; telecommunications services, namely, electronic transmission of streamed and downloadable audio and video files via computer and other communications networks, providing on-line electronic bulletin boards for the transmission of messages among computer users in the field of consumer product information; web casting services; delivery of message by electronic transmission; telecommunication services namely, electronic transmission of streamed and downloaded audio and video and multimedia content files via computer and other communications networks; providing an online Internet forum for the transmission of messages and information; providing online chat rooms for social networking; providing access to databases; providing telecommunication connectivity services for the transfer of images, messages,</i></p>

	<p><i>audio, visual, audiovisual and multimedia works among e-readers, mobile phones, smartphones, portable electronic devices, portable digital devices, tablets or computer; streaming of audio, visual and audiovisual material via the Internet or other computer or communications network; electronic and wireless transmission and streaming of digital media content for others via global computer networks to handheld computers, laptops, and mobile electronic devices.</i></p>
	<p><b>THINKSMART</b></p> <p><i>Class 42: Computer services, namely, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops, and mobile electronic devices; software as a service (SAAS), namely, hosting software for use by others for use for collecting and processing log and event data from devices, web sites and other software applications.</i></p> <p><b>THINKCENTRE</b></p> <p><i>Class 42: Computer programming; design, updating and maintenance of computer software, excluding computer games; technical project studies in the field of computer hardware and software; consultancy in the field of computer hardware; computer systems analysis;</i></p>

	<p><i>advice and consulting relating to use of Internet; rental of computers and computer software, excluding computer games; services for providing user access to computers for business management; legal services; scientific and industrial research.</i></p>
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23. In its counterstatement the applicant states that it is admitted that the respective goods, or at least some of them, are identical or similar. As the applicant did not say which goods it considers to be identical and which goods it considers to be similar (and to what degree), I will carry out my own assessment.

24. The applicant's goods in class 9 are various types of data storage and memory devices for computers. In my view the applicant's goods are:

- Identical to some of the goods covered by the opponent's 'THINKPAD' mark, namely *computers, adapters for computers, any components and peripheral devices for computers* – these goods are broad enough to encompass all of the opponent's goods (*Meric*);
- Identical to some of the goods covered by the opponent's 'THINKSYSTEM' mark, namely *computer storage apparatus* – these goods are broad enough to encompass all of the opponent's goods (*Meric*);
- Identical to some of the goods covered by the opponent's 'THINKBOOK' mark, namely *computer peripherals and accessories* – these goods are broad enough to encompass all of the opponent's goods (*Meric*);
- Identical to some of the goods covered by the opponent's 'THINKCENTRE' mark, namely *components and peripherals for computers* - these goods are broad enough to encompass all of the opponent's goods (*Meric*);
- Similar to a low to medium degree to *computers; mobile computers* (in the 'THINKSMART' mark) and *computer software* (in the 'THINKSHIELD' mark). The competing goods all being computer-related, they target the same professional or general public, are complementary and usually coincide in

producers and trade channels, i.e. Internet online purchasing, electronics retailers, etc. For example, suppliers of software/hardware will usually be able to supply computers related equipment and that is true also the other way round. These goods are similar to a low to medium degree.

25. The application also covers *Retail services in relation to computer hardware, software and peripheral devices* in class 35. Computer hardware, software and peripheral devices are all covered by the opponent's marks. Retail services concerning the sale of specific goods are similar to an average degree to these specific goods.<sup>2</sup> Although the nature, purpose and method of use of these goods and services are not the same, they are similar because they are complementary and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public. These goods and services are similar to a low to medium degree.

### **Average consumer**

26. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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<sup>2</sup> *Oakley, Inc v OHIM*, Case T-116/06

“average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

27. The average consumer of the parties’ computer-related goods in class 9 and services in class 35 may be both a professional consumer and the general public.

28. Both types of consumers will generally purchase the goods at issue from specialist retail outlets and specialist websites online, although many of the goods can also be purchased from large supermarket chains. The selection of these goods will be largely a visual process, with the average consumer selecting the product from shelves in shops or from websites, catalogues and other printed matter, but also aurally, through discussion with sales assistants and appropriate experts.

29. Whilst some of the goods at issue will be purchased with particular care, for example computers, computers hardware and computer software, others, such as memory cards and memory devices will not. Nevertheless, consumers will still display a degree of attention necessary to select the correct product, taking into account factors such as compatibility, storage space and technical requirements. The level of attention will therefore range from medium to above medium.

### **Comparison of marks**

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall

impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

31. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The respective marks are shown below:

The applicant’s mark	The opponent’s marks
Think Memory. Think MemoryCow.	THINKPAD THINKSHIELD THINKSMART THINKSYSTEM THINKBOOK THINKCENTRE

**Overall impression**

32. The opponent’s earlier marks are word marks consisting of two words, namely, the word ‘THINK’ in combination with one of the following words: ‘PAD’, ‘SHIELD’, ‘SMART’, ‘SYSTEM’, ‘BOOK’ and ‘CENTRE’. I find that the average consumer is likely to see each mark as made up of two dictionary words, although conjoined. The opponent states that the second word in each mark is *“associated with or allusive of the computer industry, computer products and/or characteristics thereof”*. The applicant accepts that the opponent’s marks are made up of the word ‘THINK’ combined with *“descriptive or semi-descriptive suffixes such as “Pad” when used relative to certain computer hardware and associated software”*.

33. I bear in mind that the case-law cited above requires marks to be considered as wholes. In this case, the overall impressions created by the marks lie in the combination of two words. I also bear in mind that (a) it is common ground that the second word in each mark is descriptive or semi-descriptive and that (b) words which

appears at the end of the marks will tend to have less visual impact than the word that precedes it. Balancing out those facts, I find that even if the second words in the opponent's marks are non-distinctive for the goods covered by the registrations, they contribute to the overall impression created by the marks. However, given the descriptiveness or semi-descriptiveness of 'PAD', 'SHIELD', 'SMART', 'SYSTEM', 'BOOK' and 'CENTRE' and the position of 'THINK' at the beginning of the marks, it is the latter element which is more dominant.

34. The applied-for mark consists of the words 'Think Memory. Think MemoryCow.' The opponent states as follows:

*"The [applicant's] mark has no element that could be considered more dominant (i.e. visually eye-catching). The presence of the full stop after "THINK MEMORY" creates the perception of a mark being made up of two parts i.e. "THINK MEMORY" and "THINK MEMORYCOW". The full stop creates a natural separation / break between these elements which will be visually and aurally perceptible to the consumer. As such, the elements "THINK MEMORY" and "THINK MEMORYCOW" will be seen as two units having independent trade mark significance. Given that the component "THINK MEMORY" appears at the beginning of the Contested Mark, a position which is generally considered to have more impact due to consumers in the UK reading trade marks from left to right, and is indeed repeated in the second part of the mark, further strengthening its presence in the consumer's mind, it is submitted that the words "THINK MEMORY" have more impact in the Contested Mark than any other words".*

35. The applicant states:

*"The Applicant's Mark is a slogan which includes the Applicant's trade name and trademark MemoryCow and so it is self-evident that it is the dominant feature of the slogan, otherwise there would be no point in the Applicant adopting the slogan"*

36. The words 'Think Memory' appear in the applicant's mark twice. Although the applicant states that it has used the words 'MemoryCow' as part of its domain name www.memorycow.co.uk, this fact cannot be part of the assessment I must conduct, which is limited to the mark as it is applied-for. Further, the contested mark seeks registration for goods in class 9 and services in class 35, so the scenario I must consider is that of the mark 'Think Memory. Think MemoryCow' being used to denote the origin of the goods, for example on packaging, or the services, for example on a shop signage with the wording 'Think Memory. Think MemoryCow' shown on it. I also bear in mind that the goods and services involved are computer memory devices and related retail services. In those circumstances, I think it is unlikely that the average consumer will perceive the mark 'Think Memory. Think MemoryCow' in the way suggested by the applicant, i.e. as a slogan which encourages customers and prospective customers who are thinking of upgrading their memory capacity for their computers to think about products available from the applicant.

37. Given that the words 'Think Memory' appear in the mark twice, the average consumer is likely to see it as playing an independent role within the mark whilst being the dominant and distinctive element of the mark. The average consumer is also in my view likely to understand the words 'Memory' as a reference to a characteristic of the goods and services, all of which relate to memory devices for computers. For similar reasons to those which I have expressed in relation to the opponent's marks, I find that even if the word 'Memory' is non-distinctive for the goods covered by the registrations, it contributes to the overall impression created by the mark and given the position of the element 'THINK' at the beginning of the mark, it is the more dominant element of the mark. The word 'COW' at the end of the mark has no relevance in relation to the goods and/or services and will be perceived as a fanciful/arbitrary addition to the element 'Think Memory'.

### **Visual and aural similarity**

38. Visually, as the competing marks are word marks, they may be used in upper- or lower-case letters. Consequently, no weight can be attached to the use of lower case letters in the applicant's mark and upper case letters in the opponent's marks. The competing marks coincide in the word 'THINK' which appears at the beginning of the



marks, and it is repeated twice in the applicant's mark. The opponent's marks and the applicant's mark also have the same pattern, i.e. the word 'THINK' followed by a descriptive or semi-descriptive word, insofar as the element 'Think Memory' is concerned, although the repetition of the same element and the addition of the word 'COW' in the applicant's mark, create points of difference and make the applicant's mark look and sound much longer than any of the opponent's marks. The marks are visually and aurally similar to a low to medium degree.

### **Conceptual similarity**

39. In its submissions in lieu the opponent's states:

*"Conceptually, the Earlier Marks call to mind an invitation to consider ("Think") a computer related term, feature or function ("Pad, Shield, System etc.). The same concept is conveyed by the first part of the Contested Mark, with this being reinforced by the nature of the Contested Goods and Services. This leads to a notable overlap in the semantic content of the marks. The second part of the Contested Mark - "THINK MEMORYCOW" - may be perceived in two ways:*

*a. the consumer may recognise this component as a simple repetition of the first part with an arbitrary addition in the form of the word "COW". The word "COW" would, in this case, add a new conceptual element to the Contested Mark thereby resulting in an overall medium level of conceptual similarity; or*

*b. the consumer may recognise the word "MEMORYCOW" as designating the parent brand to which the "THINK MEMORY" branded goods and services belong. In this case, the word "MEMORYCOW" does nothing to modify the meaning of the words "THINK MEMORY" or create a new conceptual image in the Contested Mark. Following this reasoning, the trade marks should be considered conceptually similar to a high degree"*

40. I agree that the opponent's marks are likely to be perceived as an invitation (introduced by the element 'THINK') to consider, , a computer-related term, feature or function, i.e. Pad, Shield, System etc. The same goes for the element 'Think Memory'

in the applicant's mark. The element 'Cow' at the end of the applicant's mark is likely to be perceived as an arbitrary addition which does not alter the meaning of the distinctive element 'Think Memory' nor does it affect its perception as an independent unit. The marks are conceptually similar to a medium to high degree.

### **Distinctive character of earlier mark**

41. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

42. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as

invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

43. The opponent correctly pointed out that absent the requirement to demonstrate genuine use in these proceedings, the opponent's evidence serves two aims, namely, (1) to demonstrate its reputation in the 'THINKPAD' mark; and (2) to demonstrate the opponent's ownership of a family of trade marks characterised by the presence of the component 'THINK' at the beginning of the marks followed by a word which alludes to the computer industry, computer products and/or characteristics thereof.

44. In its submissions in lieu the opponent states that the earlier mark 'THINKPAD' enjoys an enhanced degree of distinctive character as a result of its extensive use and that the remaining marks enjoy a normal level of distinctive character.

45. The opponent's evidence is as follows:

- The opponent was founded in 1984 and it is a Chinese multinational technology company. Incorporated in Hong Kong, with global headquarters in China and US, the opponent designs, develops, manufactures, and sells personal computers, tablet computers, smartphones, workstations, servers, supercomputers, electronic storage devices, IT management software, and smart televisions. According to Statista, the opponent's worldwide market share for personal computers over the period 2014 - 2019 varied between approximately 15% and 25%;<sup>3</sup>
- The opponent's predecessor was a company called Legend Group Company ("Legend"). In 1990, Legend started to introduce self-branded computers into China and became China's top selling PC brand, and began expanding into portables, workstations, servers, and later digital entertainment products. In 1999, China's Ministry of Information Industries placed Legend at the top of its annual list of China's top 100 electronic companies;
- In 2003, Legend announced its international ambitions and intention to build a global brand. The company changed its name from Legend to Lenovo (i.e. the

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<sup>3</sup> Exhibit BW1

opponent's current name) in 2004, and in December 2004, Lenovo and IBM announced an agreement by which Lenovo would acquire IBM's PC Division for approximately US\$1.25 billion. The success of this acquisition initiated a period of rapid growth and was a critical expansionary step which allowed Lenovo to eventually obtain the largest share of the international PC market;

- As stated in a 2015 press release:<sup>4</sup> *"Prior to its acquisition of IBM's PC business in 2005, Lenovo ranked #9 in the worldwide PC industry with 2.3 percent market share and annual revenue of just \$3 billion. Fast forward to 2015 and Lenovo has risen to become #1 in worldwide PCs with market share at 20% and revenue growing roughly thirteen-fold over the past ten years to \$39 billion. Notably, the IBM PC acquisition and its growth gave Lenovo the fuel to accelerate its expansion which today encompasses three growth engines with global scale: PC, mobile and enterprise. No other company can match this diversity [...]"*;
- Included in the acquisition of IBM's PC Division was IBM's flagship and very popular brand of business-oriented laptop computer, 'ThinkPad'. The product was launched in 1990 and 10 million 'ThinkPad' products were sold in 2000. After the acquisition of IBM's PC division in 2005, the first 'ThinkPad' product under the opponent was introduced in 2006. 60 million 'ThinkPad' products were sold in 2010 and 100 million in 2015;
- In 2012 and 2017, the opponent celebrated the 20<sup>th</sup> and 25<sup>th</sup> anniversaries of the 'ThinkPad' brand. Various articles confirming the worldwide fame of the 'THINKPAD' laptops are produced, although they are not UK specific;<sup>5</sup>
- Copies of webpages from the opponent's website at Lenovo.com are exhibited showing 'THINKPAD' laptops available for sale with the price in pound sterling;<sup>6</sup>
- Since the first 'ThinkPad' products were introduced in 1992, they have collectively sold over 130 million units worldwide. Revenue figures are provided as shown in the table below. They are said to represent products sold under the opponent's 'Think' family marks, in which 'ThinkPad' is the flagship brand, in the EMEA region (which I understand stands for Europe, Middle East, and Africa) for the years 2015 – 2021:

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<sup>4</sup> BW4

<sup>5</sup> BW7

<sup>6</sup> BW8

**Sales Revenue for EMEA Region for THINK Branded Products (USD in millions)**


		EMEANEW 2015.total	EMEANEW 2016.total	EMEANEW 2017.total	EMEANEW 2018.total	EMEANEW 2019.total
		TOTREV	TOTREV	TOTREV	TOTREV	TOTREV
Desktop - Think / QT / YT	LPDT	1,225.499	1,168.340	1,388.284	1,536.742	1,459.288
Desktop Workstation - Think	LPWT	119.375	121.105	165.475	233.348	331.215
Notebook - Think	LPNT	2,570.079	2,890.463	3,657.441	4,137.866	4,252.986
Tablet - Think (Win)	LPNTBW	64.824	44.825	37.563	89.412	72.346
		<b>3,979.777</b>	<b>4,224.733</b>	<b>5,248.764</b>	<b>5,997.368</b>	<b>6,115.835</b>

- Samples of invoices are provided from various EU countries. One of the invoices is from the UK, it is dated 9 February 2017 and it is for £13,524;<sup>7</sup>
- Worldwide advertising expenditure are shown below:


**Advertising Spend for EMEA Region for THINK Branded Products**

FY1617	FY1718	FY1819	FY1920	Grand Total
\$ 31,791,302.40	\$ 30,172,754.37	\$ 28,757,327.13	\$ 40,228,418.31	\$ 130,949,802.20

- Sample of articles published on UK and EU publications about various products sold under the 'ThinkPad' mark are provided, including an article from the UK dated 2018:



**Lenovo ThinkPad X1 Extreme review: The ThinkPad, perfected**  
*Souped-up performance, an immaculate display and layer upon layer of security tools make the ThinkPad X1 Extreme worth its high price*



★★★★★  
 Price : £2,141 exc VAT

**Pros :**  
 Superb display; Fast CPU performance; Lots of business tools

**Cons :**  
 Basic GPU; Middling battery life; Expensive

**Verdict :**  
 Few laptops can cost this much and still feel worth it, but the ThinkPad X1 Extreme is no ordinary laptop. From performance to the keyboard, from connectivity to the display, it succeeds at almost every turn, and business buyers in particular can take advantage of a host of security and management tools.

What do you need when a £1,500 ultrabook like the **Lenovo ThinkPad X1 Carbon** isn't enough? The answer could be the ThinkPad X1 Extreme, which looks awfully similar but comes ready with a larger screen, an even more powerful CPU, discrete graphics and a host of added features for business users.

<sup>7</sup> BW10

- Copies of adverts for 'THINKPAD' laptop products from well-known UK newspapers, including The Times, The Guardian and the Daily Telegraph are also produced.<sup>8</sup> Although they are undated the date from December 2018 is visible (if enlarged) as shown below:



46. The opponent's global turnover figures (amounting to about \$24 billion between 2015 and 2019) and market share (amounting to between 15% and 20% of the global market) are impressive and although there are no specific UK figures, the applicant has admitted in its counterstatement that the opponent is a well-known manufacturer and vendor of computer devices and peripherals sold under a range of trade marks such as 'ThinkPad', 'Think Book', 'Think Vision', 'Think Station' and 'Think Smart'. The

<sup>8</sup> BW14

evidence also seems to corroborate the opponent's claim that its main brand is 'ThinkPad'. Hence, notwithstanding the gaps in the evidence, given the applicant's concessions and the global figures produced, I am satisfied that the distinctiveness of the mark 'ThinkPad' has been enhanced to a high degree through use in the UK. The other marks are distinctive to a medium degree.

### **Likelihood of confusion**

47. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

48. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

49. Earlier in this decision I found that:

- the competing goods in class 9 are either identical or similar to a low to medium degree;
- some of the contested services in class 35 are similar to a low to medium degree;
- relevant consumers of the goods at issue will include members of the general public and professional users;
- the purchasing process will be predominantly visual although I do not discount aural considerations and the goods and services will be selected with a medium to above medium degree of attention;
- the earlier marks and the contested mark are visually and aurally similar to a low to medium degree and conceptually similar to a medium to high degree;



- the earlier marks are inherently distinctive to a medium degree and the distinctiveness of the mark 'THINKPAD' has been enhanced to a high degree through use.

50. Before I turn to the question of likelihood of confusion, I will address the applicant's argument about the distinctiveness of the word 'THINK' and the state of the register evidence.

51. As regard the distinctiveness of the word 'THINK', the fact that the word is a dictionary word used in common parlance, does not make it non-distinctive in the context of the goods or services at issue. The word 'THINK' is a verb which, according to the Cambridge Online Dictionary means "*to use the brain to decide to do something*" or "*to believe something or have an opinion or idea*". Whilst laptops and computers are electronic machines used to process information they do not think, and the word 'think' clearly refers to a human activity, so the word does not describe any characteristic of the goods or services at issue. Furthermore, the fact that the word 'THINK' in 'THINKPAD' will be perceived as an invitation to consider the goods (the word 'PAD' being used in the sense of laptop) does not make it non-distinctive. In any event, since the opponent's 'THINKPAD' mark is registered, it must be treated as having at least the minimum degree of distinctiveness necessary to obtain registration<sup>9</sup> and I have found that its distinctiveness has been enhanced to a high degree through use.

52. As regard the applicant's argument about the high number of marks on the UKIPO register which incorporate the word 'THINK', state of the register evidence is recognised as being non-relevant. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks

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<sup>9</sup> C-196/11 Formula One

are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

53. Moving to the family of marks argument, the opponent has filed evidence of use of the trade marks 'ThinkSmart' (since 2017)<sup>10</sup>, 'Think Shield' (since 2018)<sup>11</sup> and 'ThinkSystem' (since 2021).<sup>12</sup> I do not need to summarise this evidence in detail as the applicant also admitted such use. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

"62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a 'family' or 'series' of trade marks, the likelihood of confusion results more specifically from the possibility

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<sup>10</sup> BW16

<sup>11</sup> BW17-18

<sup>12</sup> BW19

that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

54. Taking all of the above into account I find that whilst it is unlikely that the competing marks will be directly confused, there is a likelihood of indirect confusion, insofar as the similarities between the marks, in particular the use of the word 'THINK' followed by the descriptive word 'MEMORY' for identical or similar computer-related goods or services, will lead the average consumer to think that the applied-for mark is a brand extension of the opponent's 'THINKPAD' mark. This likelihood of confusion is in this case also reinforced by the existence of a family of marks, all of which present a similar pattern, namely use of the word 'THINK' followed by a descriptive or semi-descriptive word. Whilst the structure of applied-for mark is more complex, because the element 'THINK MEMORY' is repeated twice, and the mark contains the additional word 'COW'

at the end, the element 'THINK MEMORY' plays an independent distinctive role in the mark as a whole and the addition of the arbitrary element 'COW' is not in my view sufficient to overcome the similarities created by the element 'THINK MEMORY'. There is a likelihood of indirect confusion.

55. The opposition under Section 5(2)(b) succeeds in its entirety.

### **Section 5(3)**

56. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

57. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

58. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such

a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L’Oreal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L’Oreal v Bellure*).

59. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 18 January 2022.

## **Reputation**

60. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market

share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

61. Under its Section 5(3) ground, the opponent relies on the 'THINKPAD' registration only. For the same reasons which I have discussed above, I find that the opponent had a strong reputation in the mark 'THINKPAD' in relation to laptops at the relevant date.

## **Link**

62. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in Intel are:

*The degree of similarity between the conflicting marks.* The earlier mark and the contested mark are visually and aurally similar to a low to medium degree and conceptually similar to a medium to high degree;

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.* The competing goods and services are identical or similar to a low to medium degree;

*The strength of the earlier mark's reputation.* The opponent's reputation is strong;

The degree of the earlier mark's distinctive character, whether inherent or acquired through use. The earlier mark is inherently distinctive to a medium degree and its distinctiveness has been enhanced to a high degree through use.

Whether there is a likelihood of confusion. There is a likelihood of indirect confusion.

63. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's registrations to mind when confronted with the applicant's mark, thereby creating the necessary link. Taking all of the above into account, I am of the view that the relevant public will make a link between the parties' marks. Given my finding that there will be a likelihood of confusion, I also find that the applied-for mark will gain an unfair advantage. Damage is made out.

64. The opposition under Section 5(3) is also successful.

## **OUTCOME**

65. The opposition succeeds, and the applicant's mark is refused.

## **COSTS**

66. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the opponent the sum of £1,700 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing a statement and considering the applicant's statement:	£200
Filing evidence And commenting on other party's evidence:	£1,000



Preparing submissions in lieu	£300
Official fees:	£200
Total	£1,700

67. I therefore order SWEETCOW LTD to pay Lenovo (Singapore) Pte. Ltd the sum of £1,700. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

**Dated this 19<sup>th</sup> day of April 2023**

**Teresa Perks  
For the Registrar**