O/1172/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003773895

BY THINKCAR TECH CO., LTD

TO REGISTER THE TRADE MARK:

XHINKCAR

IN CLASSES 9, 12, 35, 37 AND 42

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 435200

BY LENOVO (SINGAPORE) PTE. LTD

BACKGROUND AND PLEADINGS

1. On 4 April 2022, THINKCAR TECH CO., LTD ("the applicant") applied to register the trade mark shown on the cover page of this decision, in the UK. The application was published for opposition purposes on 22 April 2022 and registration is sought for the goods and services set out in Annex 1 to this decision.

2. On 22 July 2022, the application was partially opposed by Lenovo (Singapore) Pte. Ltd ("the opponent") based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act").[1] The opposition is directed against the applicant's class 9 goods only.[2] Under section 5(2)(b) of the Act, the opponent relies upon the following trade marks:

THINKPAD
UKTM no. 900198010[3]
Filing date 1 April 1996; registration date 9 September 1999
Seniority date: 16 November 1994 (UK)
("the First Earlier Mark")

THINKSHIELD
UKTM no. 917966138
Filing date 8 October 2018; registration date 6 February 2019
Priority date: 24 July 2018 (United States of America)
("the Second Earlier Mark")

THINKSMART
UKTM no. 917615006

[1] Although the opponent also originally relied upon section 5(4)(a) of the Act, it withdrew reliance upon this ground in its written submissions in lieu (see paragraph 5).
[2] Although the Form TM7 stated that all goods and services covered by the application were subject to the opposition, the opponent confirmed in its written submissions in lieu that this was an error and the intention was to oppose only the class 9 goods (see paragraph 2).
[3] On 1 January 2021, the UK left the EU after the expiry of the transition period. Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM. As a result of the opponent's EUTMs being protected as at the end of the Implementation Period, comparable UK trade marks were automatically created. The 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 retain their original filing dates.

Filing date 19 December 2017; registration date 25 March 2019
Priority date: 7 December 2017 (United States of America)
("the Third Earlier Mark")

THINKSYSTEM
UKTM no. 915755523
Filing date 18 August 2016; registration date 16 December 2016
("the Fourth Earlier Mark")

THINKBOOK
UKTM no. 918051602
Filing date 15 April 2019; registration date 8 April 2020
Priority date: 16 November 2018 (Singapore)
("the Fifth Earlier Mark")

THINKCENTRE
UKTM no. 903014438
Filing date 20 January 2003; registration date 30 March 2007
Priority date: 26 August 2002 (United States of America)
("the Sixth Earlier Mark")

3. Under section 5(2)(b) of the Act, the opponent relies on the goods and services set out in Annex 2 to this decision. The opponent gave a statement of use for the First, Fourth and Sixth Earlier Marks. The goods for which the opponent gave its statement of use are underlined in Annex 2 to this decision. The opponent claims that there is a likelihood of confusion, because the marks are similar and the goods and services are identical or similar. The opponent also claims to have a family of marks characterised by the prefix "THINK" and that the applicant's mark would be viewed by the average consumer as part of that family.

4. Under section 5(3) of the Act, the opponent relies upon the First Earlier Mark only. The opponent claims to have a reputation for the goods set out in Annex 2 to this decision and claims that use of the applicant's mark would, without due cause, take

unfair advantage of, and/or be detrimental to, the distinctive character and/or repute of the First Earlier Mark.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use of the First, Fourth and Sixth Earlier Marks.

6. The applicant is represented by Trademarkit LLP and the opponent is represented by HGF Limited.

7. Only the opponent filed evidence. Neither party requested a hearing and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of the witness statement of Becky Williams dated 15 February 2023, which is accompanied by 25 exhibits. Ms Williams is Senior Counsel and Director of Trademarks for Lenovo (Beijing) Limited. Both the opponent and Lenovo (Beijing) Limited are wholly owned subsidiaries of Lenovo Group Limited. Ms Williams' evidence mostly relates to the use made of the earlier marks.

9. The opponent filed undated written submissions in lieu on 9 June 2023.

10. I have taken the evidence and submissions into account in reaching my decision and will refer to them below where necessary.

RELEVANCE OF EU LAW

11. 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 Act relied upon 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.

DECISION

Preliminary Issue

12. I note that the opponent has filed evidence that the applicant has actually used the mark THINKCAR.[4] It appears as follows:

13. However, under section 5(2)(b) of the Act, the marks that I must consider are those applied-for/registered. Under section 5(3) of the Act, I accept that this evidence may be intended to demonstrate an intention to take unfair advantage on the part of the applicant. However, that was not pleaded. Consequently, I do not consider that this evidence can be of assistance to the opponent.

Section 5(2)(b)

14. Section 5(2)(b) of the Act reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…
>
> (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

[4] Exhibit BW25

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

15. 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."

16. The trade marks upon which the opponent relies qualify as earlier trade marks pursuant to section 6 of the Act. As the First, Fourth and Sixth Earlier Marks had completed their registration process more than 5 years prior to the filing date of the application in issue, they are subject to the use provisions of section 6A of the Act.

Proof of use

17. I will begin by assessing whether there has been genuine use of the First, Fourth and Sixth Earlier Marks. The relevant statutory provisions are as follows:

"(1) This section applies where:

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

18. Section 100 of the Act states that:

> "100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

19. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the First, Fourth and Sixth Earlier Marks is the five-year period ending with the date of the application in issue i.e. 5 April 2017 to 4 April 2022. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use in the EU (including the UK) will be relevant from 5 April 2017 to 31 December 2020. Thereafter, only use in the UK will be relevant.

20. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

> "105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

21. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real" because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark" is, therefore, not genuine use.

The First Earlier Mark

22. Most of the opponent's evidence of use relates to its laptop, desktop and tablet computers, all sold under the mark THINKPAD. Clearly, the THINKPAD is a successful product as, by 2017, over 130million units had been sold worldwide and in 2022 it celebrated its 30-year anniversary.[5] However, the relevant market for assessing genuine use is the EU (prior to and including 31 December 2020) and the UK. The problem with the opponent's evidence is that much of it is not broken down by region. I note that the following figures have been provided for the EMEA region:[6]

2017	$5,248.764
2018	$5,997.368
2019	$6,115.835
2020	$6,185.928

These figures are described as being "USD in millions". However, it is not clear to me whether I should read these figures as, for example, for 2017, 5million, 248 thousand and 764 dollars or 5billion, 248million and 764thousand dollars. No clarification is provided by the witness. I note that the EMEA region includes Europe (both EU and non-EU countries), the Middle East and Africa. Clearly, this is a far wider geographical area than the jurisdictions for which the opponent must demonstrate genuine use.

23. The opponent has provided a selection of invoices which show sales to customers located in the EU.[7] However, only one of these is dated within the relevant period. The invoice is addressed to a business located in Germany in 2019 and represents sales of THINKPAD goods for over €300,000.

24. I note that Ms Williams gives unchallenged narrative evidence that during the relevant period the opponent sold THINKPAD goods in every member state of the EU. However, she does not clarify whether this was prior to 31 December 2020 (and therefore relevant to my assessment) or after. I note that during the relevant period,

[5] Exhibit BW5
[6] Exhibit BW9
[7] Exhibit BW10

the opponent's goods were available from UK retailers such as Argos and John Lewis and Ms Williams gives narrative evidence that this included THINKPAD goods.[8]

25. The opponent's advertising spend for all products which are sold under the mark THINK (which includes goods sold under THINKPAD as well as those not) was over $30million in 2017/2018, over $28million in 2018/2019 and over $40million in 2019/2020.[9] However, no breakdown is provided either: 1) by region to enable me to assess what proportion of this relates to the UK/EU markets, 2) by product to enable me to assess which goods these figures relate to or 3) by trade mark, bearing in mind that the opponent has more than one THINK- prefix mark. The opponent has provided an Activity Review for 2018/2019 which Ms Williams states "portrays the depth of [the opponent's] investment in promoting its brands, including 'ThinkPad', by using influencer marketing, events, reviews, product placement, social content and thought-leadership pieces".[10] This document states "ThinkPad = 27". However, without any further explanation as to what this means, I am unable to draw any conclusions about what this demonstrates regarding the opponent's marketing activities. I note that Ms Williams refers to awards won by the THINKPAD computers, but these all pre-date the relevant period.[11]

26. Plainly there are issues with the opponent's evidence. However, even taking the sales shown in the invoice alone, I am satisfied that there is sufficient evidence to demonstrate that there has been genuine use of the First Earlier Mark during the relevant period in the EU for laptop, desktop and tablet computers. The opponent can, therefore, rely upon the following terms:

Class 9 Computers; portable computers.

The Fourth Earlier Mark

27. In relation to the use of the Fourth Earlier Mark, Ms Williams states as follows:

[8] Exhibit BW11
[9] Exhibit BW12
[10] Exhibit BW13
[11] Exhibit BW15

> "25. [The opponent] offers a comprehensive range of data center hardware consisting of servers, storage and networking systems within the 'ThinkSystem' range. 'ThinkSystem' products were first sold in the UK and EU in July 2017. Our product line includes single-socket through to eight-socket systems, with the latest processors from Intel and AMD. Our servers are suitable for a broad range of customers, from small businesses and line-of-business applications, technical/finance customers with HPC workloads, through to multi-national corporations with mission-critical workload needs."

28. Print outs from the opponent's UK website dated 2017, 2020 and 2021 reference THINKSYSTEM servers.[12] A product guide for the THINKSYSTEM server (dated 2021) has also been provided.[13] There is a review of the various models of THINKSYSTEM from 2018.[14] There is also evidence of THINKSYSTEM servers being offered for sale by third party retailers.[15] However, I have no evidence regarding the number of goods actually sold to UK/EU customers during the relevant period. Further, I have no information regarding advertising expenditure for this particular mark. Taking all of this into account, I am not satisfied that the opponent has demonstrated genuine use of the Fourth Earlier Mark.

The Sixth Earlier Mark

29. In relation to the Sixth Earlier Mark, Ms Williams states as follows:

> "27. Launched by IBM in 2003, [the opponent] acquired the 'ThinkCentre' desktop brand following its purchase of IBM's Personal Computing Division in 2005. [The opponent]'s 'ThinkCentre' business-oriented desktop computers typically include mid-range to high-end processors, options for discrete graphic cards, and multi-monitor support."

[12] Exhibit BW19
[13] Exhibit BW19
[14] Exhibit BW19
[15] Exhibit BW19

30. An undated product specification document has been provided.[16] I note that there is reference in the document to an additional functionality being due to be launched in June 2017 which suggests that the document pre-dates that date. THINKCENTRE products were displayed on the opponent's website during the relevant period and were offered for sale by a third-party retailer in June and July 2017.[17] Three articles that reference the THINKCENTRE computer have been provided which are dated between 2018 and 2021.[18] These appear to have been published on UK-based websites, although no information is provided to me about viewer numbers for these websites. There is also a review article published on the opponent's own website in September 2020 for the THINKCENTRE product. I note that there is also an example of a draft advert for THINKCENTRE goods with a copyright date of 2017.[19] However, I have no evidence of the number of sales that have been made to UK/EU customers (if any). I also have no evidence about the reach of the articles/product specification document referred to above, or how many orders (if any) were placed during the relevant period (either with the opponent itself or the third-party retailer referred to above). Consequently, I have no way of establishing the extent of the use that has been made of the Sixth Earlier Mark. In my view, there is insufficient evidence to conclude that there has been genuine use of the Sixth Earlier Mark in the UK/EU during the relevant period.

31. As the opponent has failed to demonstrate genuine use of the Fourth and Sixth Earlier Marks, it cannot rely upon them for the purposes of this opposition.

Section 5(2)(b) – case law

32. 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*

[16] Exhibit BW20
[17] Exhibit BW20
[18] Exhibit BW20
[19] Exhibit BW13

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 greater 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 to mind the earlier mark, 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

33. The competing goods and services are as follows:

Opponent's goods and services	**Applicant's goods**
The First Earlier Mark Class 9 Computers; Portable computers. **The Second Earlier Mark** Class 9 Computer software. **The Third Earlier Mark** Class 9 Smart TVs; television monitors; computers; mobile computers; mobile communications devices; computer monitors; computer touch screens;	Class 9 Automobile fault diagnosis instruments; automobile testing instruments and equipment; automobile testing instruments; vehicle testing equipment; engine analyzers; speedometers for vehicles; automatic indicators of low pressure in vehicle tires; downloadable software applications for mobile phones; automobile fault maintenance and diagnosis software; computer equipment for automobile fault diagnosis; data processing apparatus; computer peripheral devices; couplers [data

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	processing equipment]; readers [data processing equipment]; computer programs, downloadable; computer software applications, downloadable; personal digital assistants [PDAs]; computer software platforms, recorded or downloadable.

controls, security and camera systems controls, entry system controls, warning system controls, electronic window covering controls, electronic appliance controls, gaming system controls. <u>Class 38</u> 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. <u>Class 42</u> 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. **The Fifth Earlier Mark** <u>Class 9</u> Computers, laptop computers, notebook computers, portable computers, tablet computers, computer peripherals and accessories, computer hardware and software sold as a unit.	

34. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

> "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 are complementary."

35. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> (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.

36. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T-133/05, the General Court ("GC") stated that:

> "29. 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 Lernsysterne 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."

37. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)***,** Case T-325/06, the GC stated that "complementary" means:

> "...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."

38. In *Sanco SA v OHIM,* Case T-249/11, the GC indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-O-255-13*:*

> "It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

Whilst on the other hand:

> ".....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together."

Class 9

Automobile fault diagnosis instruments; automobile testing instruments and equipment; automobile testing instruments; vehicle testing equipment; engine analyzers; speedometers for vehicles; automatic indicators of low pressure in vehicle tires; computer equipment for automobile fault diagnosis.

39. These are all specialist equipment used for diagnosing faults with vehicles. I accept that they may be used with computers, to the extent that computers may be needed to interpret the results of the testing, but they are not, in themselves, computers. In my view, the only point of similarity with the opponent's specifications is "computer software" in the specification of the Second Earlier Mark and "computer hardware and software sold as a unit" in the specification of the Fifth Earlier Mark. The opponent's software might be in the field of automobile fault testing and so could be sold through the same retailers to the same users as those in the applicant's specification. There may also be complementarity. I consider that they are similar to a medium degree.

Downloadable software applications for mobile phones; automobile fault maintenance and diagnosis software; computer programs, downloadable; computer software applications, downloadable; computer software platforms, recorded or downloadable.

40. These terms are all identical on the principle outlined in *Meric* to "computer software" in the specification of the Second Earlier Mark.

Data processing apparatus; couplers [data processing equipment]; readers [data processing equipment].

41. These terms all include goods that could be described as computer peripherals. Consequently, they are identical on the principle outlined in *Meric* to "computer peripherals and accessories" in the specification of the Fifth Earlier Mark.

Computer peripheral devices.

42. This term is self-evidently identical to “computer peripherals and accessories” in the specification of the Fifth Earlier Mark.

43. This term is also clearly similar to “computers” in the specification of the First Earlier Mark, as the goods are likely to be sold through the same trade channels to the same users. There is also complementarity. I consider the goods to be similar to a medium degree.

Personal digital assistants [PDAs].

44. This term is self-evidently identical to “computer hardware, namely, voice controlled personal assistant devices, namely, personal data assistants and personal digital assistants” in the specification of the Third Earlier Mark.

The average consumer and the nature of the purchasing act

45. As the above case law indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46. The average consumer for the parties' goods will be either a member of the general public or a business user. The cost of the goods is likely to vary but they are unlikely to be at the lower end of the scale. Further, as they are all technical in nature, the average consumer is likely to be concerned with assessing specifications and functionality. I consider that a slightly higher than medium degree of attention is likely to be paid during the purchasing process for the goods.

47. The goods are likely to be selected following perusal of signage on packaging, at physical premises, on websites and in advertisements. Consequently, visual considerations will dominate the selection process. However, given that advice may be sought from retail assistants and word-of-mouth recommendations may play a part, I do not discount an aural component to the purchase.

Comparison of trade marks

48. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade 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."

49. 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.

50. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
THINKPAD (the First Earlier Mark) THINKSHIELD (the Second Earlier Mark) THINKSMART (the Third Earlier Mark) THINKBOOK (the Fifth Earlier Mark)	XHINKCAR

51. The First, Second, Third and Fifth Earlier Marks all consist of the word THINK conjoined with another dictionary word (PAD, SHIELD, SMART and BOOK respectively). The opponent suggests that it is the word THINK which is the distinctive element of the earlier marks. I disagree; in my view, the distinctiveness and the overall impression lies in the combination of the words. The applicant's mark consists of the word XHINKCAR, in which the overall impression resides. Where the applicant's mark relates to goods for vehicles, the word CAR at the end of the mark is likely to be recognised as non-distinctive.

52. The marks overlap in the second, third, fourth and fifth letters which are identical – HINK. However, they differ in that the first letter of the opponent's marks is T, whereas the first letter of the applicant's mark is the letter X. I bear in mind that the beginning of marks tend to make more of an impact than the ends.[20] The marks also differ in their endings -PAD, -SHIELD, -SMART and -BOOK in the opponent's marks and -CAR in the applicant's mark. I consider the marks to be visually similar to only a

[20] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

low degree. For the avoidance of doubt, even if I had found the word THINK to be the distinctive element of the opponent's mark, my finding would have been the same. This is because they begin with different letters (X v T) and end with different words (even if these carry less weight in the overall impression).

53. Aurally, the word THINK in the opponent's marks will be given its ordinary English pronunciation. The words PAD, SHIELD, SMART and BOOK in the opponent's marks will also be given their ordinary English pronunciation. The applicant's mark is likely to be pronounced EXX-HINK-CAR. In my view, the marks are aurally dissimilar. If there is any similarity, it is at a very low level.

54. Conceptually, the word THINK will be given its ordinary dictionary meaning in the opponent's marks, as will the words PAD, SHIELD, SMART and BOOK. I accept that the word CAR may be identified in the applicant's mark, particularly as many of the goods relate to vehicles. However, that word does not share any conceptual overlap with the opponent's marks. Further, the letters XHINK in the applicant's mark are likely to be attributed no particular meaning. The opponent submits that:

> "26. The Opponent would also draw the Office's attention to the convention of using the letter 'X' to represent an unknown quantity or variable (e.g. in algebra). It is also not uncommon for brands to feature deliberate and/or fanciful misspellings of dictionary words. The Opponent submits that at least a reasonable proportion of the relevant public are therefore likely to view the letter 'X' as "standing for" another letter of the alphabet. It should be noted that there are only two letters which can replace the letter 'X' and be positioned before the letters 'HINK' to form a recognisable, dictionary word. They are: 'C' (to form the letter 'CHINK') and 'T' (to form the letter "THINK"). As such, a proportion of the relevant public are likely to interpret the word "XHINK" as a representation or misspelling of the word "THINK" or, at the very least, are likely to make a mental connection with this word."

However, I can see no basis for this. I do not think that the average consumer will analyse the marks in that amount of detail or go through the number of mental steps

that are required to reach the conclusion put forward by the opponent. Consequently, the marks are conceptually dissimilar.

Distinctive character of the earlier trade marks

55. 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 1-2779, 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)."

56. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

57. The First, Second, Third and Fifth Earlier Marks all consist of the conjoined dictionary word THINK with -PAD, -SHIELD, -SMART and -BOOK respectively. They are inherently distinctive to an average (or medium) degree.

58. I have no evidence regarding how many sales have been made under the Second, Third or Fifth Earlier Marks in the UK (which is the relevant jurisdiction for assessing enhanced distinctiveness), if any. I have no evidence of advertising and marketing expenditure specifically related to these marks in the UK. I also have no market share figures, or information about the geographical spread of the use. Taking all of this into account, I am not satisfied that the distinctiveness of the Second, Third and Fifth Earlier Marks has been enhanced through use.

59. I have summarised the opponent's evidence of use in relation to the First Earlier Mark above. In addition to this, I note that the opponent's THINKPAD has been referenced in a range of UK online articles, although no information is provided about the reach of most of these articles.[21] However, I do note that there is an online article in *The Guardian* (2018) which is a national publication and likely to attract views from a large number of the UK public. However, I have no breakdown of the opponent's sales figures to enable me to assess what proportion of the sales relate to the UK market; the same issue applies to the advertising figures. I note that national retailers stock the opponent's goods and it has won awards. However, taking the evidence as a whole into account, I am not prepared to find that the distinctiveness of the First Earlier Mark has been enhanced through use.

Likelihood of confusion

60. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. 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

[21] Exhibit BW14

factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods 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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

61. I have found as follows:

a) The goods vary from being similar to a medium degree to identical.

b) The average consumer for the goods will include members of the general public and professional users who will pay a slightly higher than medium degree of attention during the purchasing process.

c) The purchasing process will be predominantly visual, although I do not discount an aural component to the purchase.

d) The marks are visually similar to a low degree, aurally similar to a very low degree (at best) and conceptually dissimilar.

e) The earlier marks are inherently distinctive to a medium degree.

62. Bearing in mind the differences between the marks, I can see no reason why they would be mistakenly recalled or misremembered as each other, even when used on identical goods. Consequently, there is no likelihood of direct confusion.

63. I will now consider whether there is indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr 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)".

64. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin*

Distillery Ltd & Ors v Sazerac Brands, LLC & Ors [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

65. Having identified the differences between the marks, I can see no reason for the average consumer to conclude that the marks originate from the same or economically linked undertakings. The changing of the word THINK to the invented word XHINK is not consistent with a brand extension or sub-brand, even when you factor in that both words have been combined with ordinary dictionary words (particularly given that they are different dictionary words). I do not think that any of the above identified categories of indirect confusion apply in this case, nor have I been able to identify any other basis for indirect confusion to occur.

66. I turn now to consider the opponent's family of marks argument. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the CJEU 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 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'."

67. As noted above, the vast majority of the opponent's evidence relates to use of the First Earlier Mark. However, there is also evidence that relates to the Second, Third and Fifth Earlier Marks, although it is very thin. Even if I proceed on the basis that the opponent has demonstrated that all of these marks were present on the marketplace at the relevant date, I do not consider that the opponent's 'family of marks' argument can succeed. This is because the opponent's marks all consist of the dictionary word THINK plus another ordinary dictionary word. I do not consider that the opponent has established that the average consumer would expect <u>any</u> mark which consisted of the word THINK combined with another ordinary dictionary word to originate from the

opponent. Even if it had, the applicant's mark does not follow that pattern; it consists of the word XHINKCAR which, at best, could be broken down into the word XHINK and the word CAR. Consequently, the family of marks pleading does not assist the opponent.

68. The opposition based upon section 5(2)(b) of the Act is dismissed.

Final remarks

69. For the avoidance of doubt, my finding would have been the same even if I had found that the distinctiveness of the First Earlier Mark had been enhanced through use. This is because the differences between the marks would have been sufficient to offset the benefit to the opponent of any enhancement, which would have been at a relatively modest level given the deficiencies with the evidence in any event.

Section 5(3)

70. Section 5(3) of the Act states:

> "5(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 repute of the earlier trade mark."

71. Section 5(3A) of the Act states:

> "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."

72. 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*).

73. I bear in mind that in relation to this ground, the opponent relies upon the First Earlier Mark only. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that the First Earlier Mark and the applicant's mark are similar. Secondly, the opponent must show that the First Earlier Mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them in the sense of the First Earlier Mark being brought to mind by the later mark. Finally, assuming the first three conditions

have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

74. I bear in mind the case law set out in *General Motors*.[22] I have summarised the opponent's evidence of use in relation to the First Earlier Mark above. Given the issues identified, my primary finding is that the evidence is not sufficient to establish a reputation in the EU or the UK. Consequently, the opposition based upon section 5(3) of the Act falls at the first hurdle. However, for the sake of completeness, I will go on to consider whether the opponent would have been successful if I was wrong in that finding and the opponent does actually have a relatively modest reputation for computers in the UK/EU (which, in my view, is the opponent's best case on the evidence provided).

Link

75. As I 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
>
> I have found the marks to be visually similar to a low degree, aurally dissimilar (or similar to a very low degree, at best) and conceptually dissimilar.
>
> 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

[22] Case C-375/97

The opponent's "computers" are similar to a medium degree to "computer peripheral devices" in the applicant's specification. As that represents the closest point of similarity between the respective specifications, I will proceed on that basis as it represents the opponent's best case.

The strength of the earlier mark's reputation

Given the deficiencies in the opponent's evidence, I will proceed on the basis that the opponent has a relatively modest reputation for computers in the UK/EU, as this represents the opponent's best case.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

The First Earlier Mark is inherently distinctive to a medium degree. My primary finding is that the distinctiveness of the First Earlier Mark has not been enhanced through use. However, for the sake of completeness, I will carry out my assessment under this ground on the basis that it has been enhanced to a relatively modest degree.

Whether there is a likelihood of confusion

I have found there to be no likelihood of direct or indirect confusion.

76. Taking into account all of the above factors, particularly the distance between the marks, I am not satisfied that a link would be made in the mind of the relevant public. In my view, the marks are simply too dissimilar for a link to be made even when used on goods that are similar to a medium degree.

77. The opposition based upon section 5(3) fails in its entirety.

CONCLUSION

78. The opposition is dismissed, and the application may proceed to registration.

COSTS

79. As the applicant has been successful it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£900**, calculated as follows:

Preparing a counterstatement and considering the Notice of opposition	£350
Considering the opponent's evidence	£550
Total	**£900**

80. I therefore order Lenovo (Singapore) Pte. Ltd to pay THINKCAR TECH CO., LTD the sum of £900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 12th day of December 2023

S WILSON
For the Registrar

ANNEX 1

Class 9

Automobile fault diagnosis instruments; automobile testing instruments and equipment; automobile testing instruments; vehicle testing equipment; engine analyzers; speedometers for vehicles; automatic indicators of low pressure in vehicle tires; downloadable software applications for mobile phones; automobile fault maintenance and diagnosis software; computer equipment for automobile fault diagnosis; data processing apparatus; computer peripheral devices; couplers [data processing equipment]; readers [data processing equipment]; computer programs, downloadable; computer software applications, downloadable; personal digital assistants [PDAs]; computer software platforms, recorded or downloadable.

Class 12

Anti-skid chains; trailer hitches for vehicles; bumpers for automobiles; shock absorbers for automobiles; brake pads for automobiles; automobile tyres; spikes for tyres; adhesive rubber patches for repairing inner tubes; vehicle bumpers; anti-theft alarms for vehicles.

Class 35

Advertising; on-line promotion of computer networks and websites; import-export agency services; marketing; provision of an online marketplace for buyers and sellers of goods and services; marketing services in the field of web site traffic optimization; business management and organization consultancy; personnel management consultancy; systemization of information into computer databases; sponsorship search.

Class 42

Computer software design; updating of computer software; maintenance of computer software; software as a Service (SaaS); development of computer platform; design and development of computer software; vehicle performance testing; functional testing of equipment and instruments; product quality testing services; product safety testing services.

ANNEX 2

The First Earlier Mark

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.

The Second Earlier Mark

Class 9

Computer software.

The Third Earlier Mark

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.

The Fourth Earlier Mark

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; network interface modules for servers, switch modules, transceivers and computer accessories; computer switches that enable enhanced

input/output (I/O) for an entire rack of computer servers; computer switches consisting of hardware and software and capable of facilitating or enabling virtual servers and virtual computers through software or hardware design; electrical and electronic connectors, couplers, wires, cables, chargers, docks, docking stations, interfaces and adapters for use with all the aforesaid goods; transceivers; portable digital electronic devices and software related thereto; racks for servers; rack-mount kits; ethernet switches; computer communications software for connecting computer network users and global computer networks; computer software for use in database management; computer software development tools; computer software for application and database integration; computer software and hardware for the management, control and networking of servers; computer software for use with computer servers, data storage devices and computer memory devices; operating systems software; computer software for systems administration; software for managing the network configurations of a network entity based on the location of a computational entity in the network; computer software for performing automatic communications switching in computer networks; virtualization and infrastructure software; software for telecommunication and communication via local or global communications networks, including the internet, intranets, extranets, mobile communication, cellular and satellite networks; user manuals in electronically readable, machine readable or computer readable form for use with and sold as a unit with all the aforementioned goods.

The Fifth Earlier Mark

Class 9

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

The Sixth Earlier Mark

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.