

O/685/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NOS. 3557573 & 3563551  
BY INSTAGOODS PTY LTD  
TO REGISTER THE FOLLOWING TRADE MARKS:

**INSTAGOODS**

AND

**INSTADATE**

AND

IN THE MATTER OF OPPOSITIONS THERETO  
UNDER NOS. 424273 & 424271  
BY INSTAGRAM, LLC

## **BACKGROUND AND PLEADINGS**

1. On 18 November 2020, Instagoods Pty Ltd (“the applicant”) applied to register the trade mark **INSTAGOODS** in the UK, under number 3557573 (“the INSTAGOODS mark”). The application claims a US priority date of 19 May 2020. The INSTAGOODS mark was published for opposition purposes on 5 March 2021. Registration is sought for goods and services in classes 9 and 35, as set out in Annex A.

2. On 3 December 2020, the applicant applied to register the trade mark **INSTADATE** in the UK, under number 3563551 (“the INSTADATE mark”). The INSTADATE mark was published for opposition purposes on 5 March 2021. Registration is sought for goods and services in classes 9, 35 and 45, as outlined in Annex A.

3. On 5 May 2021, Instagram, LLC (“the opponent”) opposed both applications in full under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

4. For the purposes of its claims under section 5(2)(b), the opponent relies upon the following trade marks:

### **INSTAGRAM**

IREU No. 1129314

International Registration date: 15 March 2012

Designation date: 15 March 2012

Priority date: 19 September 2011 (US)

Protection granted date: 6 August 2013

(“the first earlier mark”)

### **INSTAGRAM**

UKTM No. 3123325

Filing date: 20 August 2015

Registration date: 15 January 2016

(“the second earlier mark”)

**INSTAGRAM**

EUTM No. 17972897

Filing date: 26 October 2018

Priority date: 27 September 2018 (US)

Registration date: 19 April 2019

("the third earlier mark")

**INSTA**

UKTM No. 3279115

Filing date: 22 December 2017

Registration date: 13 April 2018

("the fourth earlier mark")

**INSTA**

EUTM No. 14810535

Filing date: 19 November 2015

Priority date: 21 May 2015 (US)

Registration date: 23 May 2018

("the fifth earlier mark")

**INSTA**

UKTM No. 3570393

Filing date: 21 December 2020

Priority date: 23 October 2020 (US)

("the sixth earlier mark")<sup>1</sup>

5. The goods and services relied upon by the opponent are detailed in Annex B. The opponent contends that the applicant's marks are similar to each of its earlier marks and the respective goods and services are identical or similar, giving rise to a likelihood of confusion, including a likelihood of association.

---

<sup>1</sup> The sixth earlier mark is only relied upon for the opposition against the INSTADATE mark.

6. Under section 5(3), the opponent relies upon the first, second and third earlier marks. The opponent claims that its earlier marks have a reputation in respect of the goods and services underlined in Annex B. The opponent argues that the similarity between its earlier marks and the applicant's marks is such that the relevant public will believe that they are used by the same undertaking, or that there is an economic connection between the users thereof. Moreover, the opponent claims that the applicant would gain an unfair commercial advantage through free riding on the reputation of the earlier marks, in respect of which the opponent has made significant investment. Further, the opponent argues that there would be detriment to the reputation of the earlier marks because a lack of control over the goods and services sold by the applicant may result in tarnishing. Finally, the opponent contends that the distinctive character of the earlier marks is at risk of dilution through the average consumer's loss of capacity to identify and distinguish the opponent's goods and services from those of other undertakings.

7. Under section 5(4)(a), the opponent claims that it has a protectable goodwill in relation to which it has used the sign **INSTAGRAM** throughout the UK since October 2010 and September 2014. The goods and services in respect of which the sign is said to have been used are set out in Annex B. The opponent argues that the similarity between the sign and the applicant's marks, as well as the identity or similarity between the parties' respective goods and services, would give rise to misrepresentation and damage.

8. The applicant filed counterstatements denying the claims made.

9. On 16 July 2021, the proceedings were consolidated pursuant to rule 62(g) of the Trade Marks Rules 2008.

10. A hearing took place before me, by video conference, on 24 May 2022. The opponent was represented by Mr Jeremy Reed QC of Counsel, instructed by D. Young & Co. LLP. The applicant was represented by Ms Ashton Chantrielle of Counsel, instructed by Fladgate LLP. Both parties filed skeleton arguments in advance of the hearing.

## **EARLIER MARKS**

11. In its counterstatement, the applicant claims that, as of 1 January 2021, the opponent's EU-based rights are no longer valid and subsisting in the UK. Further, it argued that the UKIPO no longer has jurisdiction in respect of proceedings based on such rights. I do not accept these arguments as a basis for rejecting the opposition. Under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, EUTMs and IREUs are still relevant in proceedings against applications filed before IP Completion Day (31 December 2020). Given the respective filing/priority dates, as well as the impact of the transitional provisions, all the opponent's marks constitute earlier marks in accordance with section 6 of the Act.

12. The first earlier mark had completed its protection process more than five years before the filing/priority dates of the applications. As such, it is subject to the proof of use requirements specified within section 6A of the Act. In its notices of opposition, the opponent made statements of use in relation to all the goods and services relied upon. In its counterstatements, the applicant indicated that it would require the opponent to provide proof of use of this earlier mark.

13. As for the second earlier mark, I note that the opponent has made statements of use in relation to all the goods and services relied upon. Further, the applicant indicated that it would require the opponent to provide proof of use of this earlier mark. However, the second earlier mark had not completed its registration process five years or more before the filing/priority dates of the applications. As such, the opponent is entitled to rely upon all the goods and services identified, without having to establish genuine use.

14. The third, fourth and fifth earlier marks had not completed their registration/protection processes more than five years before the filing/priority dates of the applications. As a consequence, the opponent is not required to demonstrate genuine use and may rely upon all the goods and services identified.

15. I note that the sixth earlier mark has not yet completed its registration process. Therefore, the opponent is not required to establish genuine use and is entitled to rely

upon all the services identified. However, if and to the extent that any conclusion against the INSTADATE mark is solely reached on the basis of this earlier mark, my decision will be provisional pending the registration of the same.

### **RELEVANCE OF EU LAW**

16. 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 and, therefore, this decision continues to refer to the trade mark case law of the EU courts.

### **EVIDENCE AND SUBMISSIONS**

17. The opponent's evidence in chief consists of the witness statement of Mr Matthew Dick, dated 15 September 2021, together with Exhibits MJD1 to MJD21, and the witness statement of Mr Allen Lo, dated 15 September 2021, together with Exhibits AL1 to AL7. Mr Dick is a partner and solicitor at D. Young & Co. LLP, the opponent's representatives in these proceedings. The purpose of his statement is to give evidence on a number of issues including the use of the INSTAGOODS mark in the marketplace, global brand rankings, growth and popularity of INSTAGRAM in the UK, media coverage, services provided by the opponent, proceedings in other jurisdictions and the use of INSTA. Mr Lo confirms that he is Vice President of the opponent company. The purpose of his statement is to give evidence on the history, growth and use of INSTAGRAM.

18. The applicant's evidence comprises the witness statement of Mr Benjamin Milloy, dated 22 November 2021 together with Exhibits BCM1 to BCM4. Mr Milloy is a solicitor at Fladgate LLP, the applicant's recorded representatives. Mr Milloy comments upon Mr Lo's employment and provides dictionary definitions, Google search results and extracts from the Register relating to the term INSTA.

19. The applicant also filed written submissions during the evidence rounds. The submissions largely consist of the applicant's criticisms of the opponent's evidence in chief.

20. The opponent filed evidence in reply in the form of the second witness statement of Mr Dick, dated 31 January 2022, together with Exhibits MJD22 to MJD31, and the second witness statement of Mr Lo, dated 24 January 2022, together with Exhibit AL8. Broadly speaking, Mr Dick seeks to respond to the applicant's criticisms of the opponent's evidence in chief. He also provides a previous decision of this Tribunal which, he says, was predicated on "virtually identical" evidence. Mr Lo seeks to respond to Mr Milloy's comments on the subject of his employment.

21. Whilst the parties' evidence and submissions will not be summarised here, I have taken it all into consideration in reaching my decision and will refer to it below, as and where necessary.

## **MY APPROACH**

22. I note that only the first earlier mark is subject to proof of use, that it is identical to the second and third earlier marks and that its specification does not appear to put the opponent in a more favourable position. As such, I will proceed to determine the opponent's claims under sections 5(2)(b) and 5(3) of the Act on the basis of the opponent's other earlier marks,<sup>2</sup> returning to consider the position in respect of the first earlier mark should it become necessary to do so.

---

<sup>2</sup> Whilst noting that only the first, second and third earlier marks are relied upon under section 5(3).

## **DECISION**

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

#### **The law**

23. Sections 5(2)(b) and 5A of the Act read as follows:

“5(2) 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.”

“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.”

24. 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**

25. In *Canon*, Case C-39/97, the Court of Justice of the European Union (“CJEU”) stated (at paragraph 23 of its judgment) that:

“In assessing the similarity of the goods or services concerned [...] 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”.

26. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(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.

27. Furthermore, 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 OHIM*, Case T-325/06, the General Court (“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”.

28. 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. 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.

29. Moreover, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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 the 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”.

30. In *Separode Trade Mark*, BL O/399/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person confirmed (at paragraph 5) that:

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

31. The goods and services to be compared can be found in the annexes to this decision.

*The INSTAGOODS mark*

#### Class 9

32. The applicant's *'downloadable mobile applications for purchasing a wide variety of consumer goods and obtaining information on designers, influencers, shopping events and promotions'* and *'computer software for transmission of audio-visual content, data, advertisements, media advertising communications and information'* in class 9 of the second earlier mark and *'computer software for the [...] transmission [...] and sharing of data and information'* in class 9 of the fifth earlier mark all consist of types of computer software. The transmission of audio-visual content, data, advertisements, media advertising communications and information could include the transmission of information about consumer goods, designers, influencers, shopping events and promotions. As such, there is an overlap in nature and intended purpose. Nevertheless, I accept that the nature and intended purpose of the respective goods also differs insofar as the applicant's goods are intended for purchasing and, therefore, will have specific features such as those enabling payment, whereas the opponent's goods are only for the transmission of information. The method of use of the respective goods may also overlap in that they both consist of computer software which could be in the form of a downloadable application that users access on a mobile phone, with users viewing the same type of information on the screen. However, I acknowledge

that there may be differences where the applicant's goods have specific functions (such as users making payments) that are not shared by the opponent's goods. Moreover, it is my view that the respective goods may share overlapping trade channels and users. The goods are not complementary as, although the transmission of information may be important to the use of the applicant's goods, consumers are unlikely to believe that responsibility for the respective goods lies with the same undertaking. The respective goods are not in direct competition. Overall, I find that there is a medium degree of similarity between the respective goods.

### Class 35

33. The applicant's class 35 services consist of retail store services (both physical and online) in respect of a wide range of goods. The nature of these services differs from that of *'providing online facilities for connecting sellers with buyers; providing online marketplaces for sellers of goods and/or services; facilitating the exchange and sale of services and products of third parties via computer and communication networks'* in class 35 of the third earlier mark and *'providing online facilities for connecting sellers with buyers'* in class 35 of the fourth earlier mark. However, the intended purpose of the respective services is similar in that they both enable consumers to conveniently view and purchase a variety of goods. In respect of the opponent's services, the buying and selling could relate to the same range of goods as the applicant's retail services. Further, I consider that there is a degree of competition between the respective services: a consumer could reasonably choose between visiting the applicant's retail site or visiting the opponent's online marketplace (or other online facility) to view and purchase goods. In addition, there is also likely to be an overlap in user. There is also likely to be an overlap in method of use when considering the applicant's services website (even when considering retail store services, which could reasonably include online stores), as consumers would typically access the services via a website. However, I accept that this would be applicable to many, sometimes disparate, services. In my view, whilst the respective services may both reach the market through similar means (such as an e-commerce website), such an overlap is on too broad a level to conclude that they share trade channels. Taking all of this into account, I find that there is between a low and medium degree of similarity between the respective services.

## *The INSTADATE mark*

### Class 9

34. In the absence of any submissions to the contrary, I understand the applicant's '*computer software for the provision of retail services in respect of goods that are only otherwise available for purchase in physical outlets and/or online outlets through computers, computer networks and the internet*' to be referring to computer software which enables users to buy and sell goods. As '*computer software for transmission of audio-visual content, data, advertisements, media advertising communications and information*' in class 9 of the second earlier mark and '*computer software for the [...] transmission [...] and sharing of data and information*' in class 9 of the fifth earlier mark could include the transmission of information, advertisements and promotional materials relating to goods, it is my view that there is an overlap in nature and intended purpose. Nevertheless, there is also a difference as the applicant's goods are intended for purchasing and, therefore, will have specific features such as those enabling payment, whereas the opponent's goods are only for the transmission of information. Method of use is also likely to overlap, given the respective goods both consist of computer software, such as an application, which will be accessed by end users in the same way. However, I recognise that there may be differences as a result of specific functions possessed by the applicant's goods (such as users making payments) that are not common to the opponent's goods. Furthermore, it is my view that the respective goods may share overlapping trade channels and users. The goods are not complementary as, although the transmission of information may be important to the use of the applicant's goods, consumers are unlikely to believe that responsibility for the respective goods lies with the same undertaking. The respective goods are not in direct competition. Overall, I find that there is a medium degree of similarity between the respective goods.

35. Whilst the applicant's '*computer software for dating, match making and personal introduction services*' clearly differs in nature when compared with '*online social networking services; internet based social introduction and networking services*' in class 45 of the second earlier mark and '*internet based social introduction, networking*

*and dating services*' in class 45 of the sixth earlier mark, there is an overlap in intended purpose. This is because the applicant's computer software and the opponent's services are both, broadly, for enabling social introductions. However, I accept that the services of the second earlier mark do not explicitly cover dating or match making services because they are typically for connecting with friends, rather than pursuing romantic interests. Moreover, there may be an overlap in the method of use of the goods and services, particularly considering that the opponent's online services may be provided to the consumer via computer software such as a mobile application. The goods and services are likely to reach the market through overlapping trade channels and may also be provided by the same undertakings. The applicant's computer software plays an integral and important part in the delivery of the opponent's services, and consumers are likely to believe that the responsibility for them lies with the same undertaking. As such, there is a degree of complementarity between them. Users are also likely to overlap. In light of all the above, I find that there is a medium degree of similarity between the respective goods and services.

### Class 35

36. The applicant's class 35 services comprise retail, retail store and online retail store services in relation to a wide variety of goods. Although the nature of these services differs from that of *'providing online facilities for connecting sellers with buyers; providing online marketplaces for sellers of goods and/or services; facilitating the exchange and sale of services and products of third parties via computer and communication networks'* in class 35 of the third earlier mark and *'providing online facilities for connecting sellers with buyers'* in class 35 of the fourth earlier mark, the respective services have a similar intended purpose. This is because both enable consumers to conveniently view and purchase goods. The opponent's services could reasonably relate to the same type of goods as the applicant's retail services. In my view, given that the applicant's services would be accessed via a website (even when considering retail store services, which could reasonably include online stores), there is also likely to be an overlap in method of use. Moreover, there is an element of competition between the respective services in that a consumer looking to purchase goods could reasonably use either the applicant's services or the opponent's services. In my view, whilst the respective services may both reach the market through similar

means (such as an e-commerce website), such an overlap is on too broad a level to conclude that they share trade channels. Users are also likely to overlap. Overall, I find that there is between a low and medium degree of similarity between the respective services.

#### Class 45

37. *'Dating services'* appears in the specifications of both the INSTADATE mark and the sixth earlier mark. They are self-evidently identical.

38. Although *'internet [...] personal introduction services'* in class 45 of the INSTADATE mark and *'internet based social introduction [...] services'* in class 45 of the sixth earlier mark are worded slightly differently, they describe the same services. They are identical.

39. To my mind, the applicant's *'match making services; internet dating, matchmaking [...] services; video dating services; dating agency services'* fall within the scope of *'dating services'* in class 45 of the sixth earlier mark. Consequently, they are identical under the principle outlined in *Meric*.

40. In my view, the applicant's *'dating services; match making services; internet dating, matchmaking and personal introduction services; video dating services; dating agency services'* and *'online social networking services; Internet based social introduction and networking services'* in class 45 of the second earlier mark overlap in nature and intended purpose; the respective services both introduce individuals to each other and increase connections. However, I accept that the opponent's services do not explicitly cover dating or match making services because they are typically for connecting with friends, rather than pursuing romantic interests. Moreover, there is an overlap in method of use; the respective services may all be provided by similar online means. The respective services may reach the market through shared channels of trade and may be provided by the same undertakings. There is also likely to be an overlap in users. The respective services are not complementary in the sense described in case law. Nevertheless, there is a degree of competition between the services as a user could reasonably choose the opponent's services to expand their romantic prospects



by social introductions rather than using a specific dating or match making service. In light of the above, I find that there is between a medium and high degree of similarity between the respective services.

### **The average consumer and the nature of the purchasing act**

41. The average consumer is deemed to be reasonably well informed, 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.<sup>3</sup>

42. 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. 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.”

43. The goods and services at issue in these proceedings are all available to the general public. However, some goods and services, such as ‘*computer software for transmission of audio-visual content, data, advertisements, media advertising communications and information*’ and ‘*providing online marketplaces for sellers of goods and/or services*’, for example, are likely also to be purchased by business users.

44. In respect of the general public, the frequency at which the goods and services are purchased, and their cost, is likely to vary. However, overall, I am of the view that the goods and services constitute neither overly frequent nor infrequent purchases and

---

<sup>3</sup> *Lloyd Schuhfabrik Meyer, Case C-342/97*

are likely to attract an average outlay, with none being overly expensive. The purchasing act will not require an overly considered thought process, though neither will it be merely casual. The general public will consider factors such as the cost, nature and features of the goods in class 9, as well as compatibility with their hardware devices. As for class 35 services, the general public will consider factors such as the range of goods on offer and the quality of the service. In respect of services in class 45, the general public will consider factors such as ease of use, functionality and previous outcomes. In light of the above, I find that the general public would demonstrate a medium level of attention during the purchasing process. The goods and services are typically selected by the general public from physical retail establishments and websites after viewing information on displays, in catalogues or on the internet, or following an inspection of the premises' frontage on the high street. In these circumstances, visual considerations will dominate. Nevertheless, I do not discount aural considerations entirely in the form of word of mouth recommendations, discussions with sales assistants or telephone enquiries.

45. As for business users, the goods and services may be more frequent purchases for the ongoing operational and technological needs of the business. The selection of the goods would be relatively important for business users as they will wish to ensure that they are selecting products which reflect their specification requirements and are aligned with the needs of the business. The selection of the services would also be relatively important, in respect of which business users will consider factors such as reach, ease of use and whether the provider can deliver required outcomes. In light of all of this, I find that business users would demonstrate an above medium level of attention during the purchasing process. The goods are typically sold in physical retail establishments, or their online equivalents, where they are likely to be purchased after viewing information on displays or on the internet. The services are likely to be purchased after viewing information on the internet, in business prospectuses or brochures. I am of the view that the purchasing process for the goods and services would be predominantly visual in nature. However, I do not discount aural considerations entirely as it is possible that business users may wish to engage in discussions with sales representatives prior to purchasing the goods and services. I also do not discount that the selection process may involve verbal consultations or word of mouth recommendations.

## **Distinctive character of the earlier marks**

46. 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).”

47. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the goods or services, to those with high inherent distinctive character, such as invented words. Dictionary words which do not allude to the goods or services will be somewhere in the middle. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion. The distinctive character of a mark may be enhanced as a result of it having been used in the market.

48. The second and third earlier marks are in word-only format and comprise the word 'INSTAGRAM'. As there are no other elements in the marks, their distinctiveness lies in this word. It is my view that both groups of relevant consumers will perceive the marks as an invented word with no obvious meaning. The marks have no descriptive or allusive qualities. Therefore, I find that that the second and third earlier marks enjoy a high level of inherent distinctive character.

49. The fourth, fifth and sixth earlier marks are in word-only format and comprise the word 'INSTA', with no other elements. As such, the distinctiveness of these marks lies in the word itself. The applicant has provided dictionary evidence which suggests that the prefix 'insta-' is used to refer to something that is instant or happening immediately.<sup>4</sup> I am prepared to accept this evidence. Consequently, it is my view that the fourth, fifth and sixth earlier marks will be perceived by consumers as a strongly allusive (if not descriptive) indication that the goods and services offered under those marks are provided quickly. Overall, I find that they possess a low level of inherent distinctive character.

50. Evidence of use has been filed by the opponent and I am now required to assess whether the opponent has demonstrated that the earlier marks had an enhanced degree of distinctive character, at the relevant dates of 19 May 2020 and 3 December 2020.

51. Mr Dick explains that INSTAGRAM has been used in relation to the “renowned photo/video sharing and editing service, software application, social network and retail platform”. He says that, whilst most users access the platform through a downloadable software application, most features can also be accessed through the instagram.com website.

52. Mr Lo says that INSTAGRAM was launched on 6 October 2010. From the information he provides, I note that it had 1m monthly active accounts worldwide in December 2010, increasing to 1bn monthly active accounts worldwide in June 2018.

---

<sup>4</sup> Exhibit 2

The platform had 100s of millions of monthly active users per year throughout the relevant periods. According to Mr Lo, 150m photographs had been uploaded by users by August 2011, whilst INSTAGRAM was named as iPhone App of the Year in December 2011; in addition, in September 2015, more than 80m photographs were shared globally each day on INSTAGRAM. He explains that over 1bn people worldwide currently use INSTAGRAM, with 500m active users every day. Mr Lo says that more than 80% of its active accounts are associated with users outside the US. Mr Lo exhibits printouts from App Annie (an independent mobile application data and analytics platform),<sup>5</sup> which show that INSTAGRAM was in the top 5 photo and video apps for iOs in 152 countries and in the top 10 overall apps in 103 countries. Moreover, it was in the top 5 social Android apps in 102 countries and top 10 overall Android apps in 34 countries. I note that all of this evidence, however, refers to the global position; as such, it does nothing to establish the position in respect of consumers in the UK.

53. Mr Lo explains that INSTAGRAM was first used in the UK in 2010. Further printouts from App Annie have been evidenced,<sup>6</sup> which specifically relate to the UK. They show that INSTAGRAM was consistently in the top 4 iOs apps for photo and video from October 2010 to December 2020; consistently in the top 10 overall iOs apps from April 2012 to December 2020; the number 10 overall iOs app and number 1 photo and video iOs app in May 2020; consistently in the top 20 overall Android apps from April 2012 to December 2020; consistently in the top 4 social Android apps from April 2012 to December 2020; the number 18 overall Android app and the number 2 social Android app in May 2020. Evidence from [www.rankingthebrands.com](http://www.rankingthebrands.com) (consolidated globally published brand rankings) has been provided, which shows that INSTAGRAM was consistently placed highly in brand rankings prior to the relevant dates. For example, it was 38<sup>th</sup> in the Top 50 Prophet Brand Relevance Index UK 2017.<sup>7</sup> Evidence from NapoleonCat (a SaaS social media customer service and analytics tool) shows that there were 25.43m INSTAGRAM users in the UK in May 2020, which rose to 30.6m

---

<sup>5</sup> Exhibit AL2

<sup>6</sup> Exhibit AL4

<sup>7</sup> Exhibit MJD2

users in December 2020; respectively, this accounted for 37.5% and 45.1% of the UK population.<sup>8</sup>

54. A representative selection of UK press articles, dated between 10 April 2012 and 6 October 2015, are in evidence.<sup>9</sup> The articles are from a range of national UK media outlets including *BBC News*, *The Observer*, *The Guardian* and *The Independent*. Although INSTAGRAM began as a “photo-sharing smartphone app”, video-sharing was added in 2013, while adverts began appearing in the application in the UK in September 2014. The articles discuss the growth and success of the INSTAGRAM brand globally, and within the UK, in the five years since its launch. It is described in the articles as “popular” and “ubiquitous”; one article says that INSTAGRAM is “used by almost everyone”. Charts from Statista (a German market and consumer data company) and printouts from celebrity INSTAGRAM accounts have been provided,<sup>10</sup> which show that these celebrity users have millions of followers. For example, as of December 2019, David Beckham had 59.71m followers. However, there is no indication as to how many of these accounts’ followers are based in the UK. Further UK press articles, dated between 24 February 2014 and 26 January 2018, which refer to INSTAGRAM have been provided.<sup>11</sup> The articles are from a range of national UK media outlets including *The Telegraph*, *The Sun* and *The Mail Online*. INSTAGRAM is described as an “image sharing site” and a “social network”, whilst one article from 2016 reports that INSTAGRAM “has changed the face of photography forever”.

55. In addition to use by individuals, Mr Lo says that INSTAGRAM is used by a wide variety of companies and brands to promote and sell products and services. He states that in November 2017 the platform had 25m business profiles and currently has more than 2m monthly advertisers. Further, more than 200m INSTAGRAM users visit at least one business profile every day and over 80% of accounts follow a business profile. A printout from [business.instagram.com](https://business.instagram.com) dated 30 November 2017 confirms these statistics.<sup>12</sup> Again, I note that these statistics refer to the global position. They are, therefore, of no assistance in establishing the position in the UK. According to Mr

---

<sup>8</sup> Exhibit MJD6

<sup>9</sup> Exhibit MJD3

<sup>10</sup> Exhibits MJD4 and MJD5

<sup>11</sup> Exhibit MJD7

<sup>12</sup> Exhibit AL6

Lo, INSTAGRAM launched a shopping service in November 2016 that allows businesses to tag a product featured in their posts and stories; users can view the name and price of the product, as well as build shopping lists through saving tags. This feature was launched in the UK on 20 March 2018. A history of its rollout, as well as details of its features, can be found in printouts of the instagram.com website.<sup>13</sup>

56. Mr Dick says that the launch of a shopping feature on 'INSTAGRAM' generated a significant amount of media attention in the UK. He provides a representative selection of press articles, dated between 18 November 2016 and 10 March 2021.<sup>14</sup> The articles are from a variety of national UK media outlets, including *The Sun*, *Mail Online*, *The Independent* and *The Sunday Times*. From the articles, I note that adverts were introduced to INSTAGRAM in 200 countries in 2015 and that, as of November 2016, there were 500,000 advertisers using INSTAGRAM for targeted advertising. Such undertakings were able to place a 'shop now' button on posts to enable users to navigate outside the application to make a purchase, as well as tagging products in posts and stories. However, this does not establish the position in the UK. Articles from 2018 detail the launch of the shopping feature in the UK. These describe users being able to purchase directly from advertisers within the application. A payments feature within the app also appears to have been introduced in 2018. By this time, there were said to be 25m businesses using an INSTAGRAM business profile, whilst INSTAGRAM was said to have raised \$1bn in fees from advertisers between 2014 and 2018. These statistics, however, appear to relate to the global position. According to an Advertising Association report (2019), a third of UK companies that have a Facebook or INSTAGRAM page say they have built their businesses on the platforms.<sup>15</sup> The articles describe the shopping feature as "seamless" and "smooth", whilst INSTAGRAM is described as a "major shopping ecosystem". According to Global Data (article dated 22 May 2019), 38.7% of UK 16-24 year olds, 34.3% of 25-34 year olds and 20.8% of 35-44 year olds have used INSTAGRAM shopping to purchase an item.

---

<sup>13</sup> Exhibit AL7

<sup>14</sup> Exhibit MJD8

<sup>15</sup> Exhibit MJD25

57. The evidence provided by the opponent is not without its limitations. For instance, no details of the relevant market(s) have been provided, nor is there any evidence before me to that effect. Moreover, there is no evidence regarding the opponent's annual turnover or its advertising expenditure in promoting INSTAGRAM. As noted above, much of the evidence corresponds to the global picture, which is of no assistance in establishing the position in the UK. Nevertheless, taking the evidential picture as a whole into account, and in particular, a) the very substantial userbase in the UK prior to the relevant dates, b) the consistently high rankings for downloads of the app on both iOS and Android in the UK, c) the consistently high brand rankings in the UK, and d) the scale and frequency of coverage of INSTAGRAM in UK media outlets (concerning both photo/video sharing and shopping/advertising functions), I am satisfied that the distinctive character of INSTAGRAM had been enhanced to a very high level by the relevant dates in respect of '*computer software for transmission of audio-visual content, data, advertisements, media advertising communications and information*' in class 9 of the second earlier mark and '*providing online facilities for connecting sellers with buyers; facilitating the exchange and sale of services and products of third parties via computer and communication networks*' in class 35 of the third earlier mark.

58. Turning to the fourth, fifth and sixth earlier marks, Mr Dick says that the opponent also uses INSTA to refer to its platform within the UK. He states that it is recognised and understood by third parties and consumers as a reference to the opponent's photo/video sharing software application, social network and retail platform. A wide range of press articles from UK media outlets such as *Metro*, *The Independent*, *The Sun* and *The Guardian*, dated between 2015 and 2020, have been provided.<sup>16</sup> These show that INSTA was commonly used to refer to the opponent's business prior to the relevant dates. Many refer to the opponent's business as INSTA, while INSTAGRAM appears further into the body of the articles. The word INSTA is often combined with other words to describe a range of activities involving the opponent's software application, e.g. "Insta lust", "our fave insta-brands", "here are women leading the way on Insta" and "Insta-stars". Some articles only use INSTA when referring to the opponent's software application. Further, the opponent has provided a reference from

---

<sup>16</sup> Exhibit MJD18



the Collins Dictionary (2018) which defines INSTA as relating to the opponent's photo-sharing application.<sup>17</sup> A small number of representative printouts from Twitter have also been provided.<sup>18</sup> These are said to show use by UK consumers and businesses of the term INSTA to refer to INSTAGRAM. The printouts are dated between August 2012 and November 2020. From the location tags on the tweets, I note that some of the accounts are clearly based in the UK. Although the tweets do not show use of the INSTA marks by the opponent in relation to any particular goods or services, they are at least indicative that there is a level of knowledge amongst a proportion of consumers in the UK that INSTA refers to the opponent's software application. Again, the evidence is not without its deficiencies. For example, there is no evidence of the size of the relevant market(s), the opponent's advertising expenditure or any turnover generated under INSTA. Further, the evidence could certainly be more specific in terms of what goods and services have been provided. Nevertheless, taking the evidential picture as a whole into account, I am satisfied that the distinctive character of INSTA had been enhanced to a medium level by the relevant dates in respect of 'providing online facilities for connecting sellers with buyers' in class 35 of the fourth earlier mark and 'computer software for the [...] transmission [...] and sharing of data and information' in class 9 of the fifth earlier mark.

### **Comparison of trade marks**

59. 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

---

<sup>17</sup> Exhibit MJD29

<sup>18</sup> Exhibit MJD20

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.”

60. Therefore, it would be wrong to dissect the trade marks artificially, though it is necessary to take into account the distinctive and dominant components of the marks; due weight must be given to any other features which are not negligible and hence contribute to the overall impressions created by the marks.

61. The second and third earlier marks both consist of the word ‘INSTAGRAM’, while the fourth, fifth and sixth earlier marks all consist of the word ‘INSTA’. As such, for ease of reference, I will refer to them collectively (i.e. “the INSTAGRAM marks” and “the INSTA marks”, unless it becomes necessary to differentiate between them.

62. The competing trade marks are as follows:

<b>The earlier marks</b>	<b>The contested marks</b>
INSTAGRAM	INSTAGOODS
INSTA	INSTADATE

### Overall impressions

63. The INSTAGRAM marks and the INSTA marks are in word-only format and consist of the words ‘INSTAGRAM’ and ‘INSTA’, respectively. As there are no other elements in the marks, the overall impressions lie in the words themselves.

64. The contested marks are in word-only format and comprise the words ‘INSTADATE’ and ‘INSTAGOODS’, respectively. As there are no other elements in the marks, their overall impressions lie in the words themselves as wholes.

## Visual comparison

### *The contested marks and the INSTAGRAM marks*

65. Visually, the contested marks are similar to the INSTAGRAM marks in that they all share five identical letters in the same order at their beginnings, a position which is generally considered to have more impact.<sup>19</sup> The contested marks visually differ from the INSTAGRAM marks in their respective endings (i.e. 'DATE' and 'GOODS', rather than 'GRAM'). Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of visual similarity between the competing marks.

### *The contested marks and the INSTA marks*

66. Again, the contested marks are similar to the INSTA marks in that they all share five identical letters in the same order; these letters appear at the beginning of the contested marks and comprise the entirety of the INSTA marks. The competing marks visually differ in that the contested marks contain additional letters, i.e. 'DATE' and 'GOODS', which are not replicated in the INSTA marks. Overall, I find that there is a medium degree of visual similarity between the competing marks.

## Aural comparison

### *The contested marks and the INSTAGRAM marks*

67. The competing marks all comprise three syllables, i.e. "IN-STA-DATE", "IN-STA-GOODS" and "IN-STA-GRAM". The contested marks are aurally similar to the INSTAGRAM marks in that they all share two identical syllables, i.e. "IN-STA", at their beginnings. The competing marks are aurally different insofar as the syllables that follow, i.e. "DATE", "GOODS" and "GRAM", are different. Overall, I find that there is a medium degree of aural similarity between the competing marks.

---

<sup>19</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

### *The contested marks and the INSTA marks*

68. As noted above, the contested marks comprise three syllables. The INSTA marks consist of two syllables, i.e. “IN-STA”. The competing marks are aurally similar as the two syllables comprising the INSTA marks are identically reproduced at the beginning of the contested marks. The competing marks are aurally different insofar as the contested marks both contain an additional syllable at their ends. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of aural similarity between the competing marks.

### Conceptual comparison

#### *The contested marks and the INSTAGRAM marks*

69. As noted above, the INSTAGRAM marks will be perceived as an invented word. They have no obvious meaning and are, therefore, conceptually neutral. The contested marks are also invented words. Nevertheless, whilst perceiving trade marks as wholes, consumers tend to break them down into elements which suggest a concrete meaning or which resemble words known to them.<sup>20</sup> Consumers will recognise the words ‘GOODS’ and ‘DATE’ because they are ordinary dictionary words. Consequently, the contested marks will evoke the meanings associated with these words. Moreover, as explained previously, ‘INSTA’ will be understood as meaning something that is instant or happening immediately. As such, the string at the beginning of the contested marks will be understood in this manner. Overall, it is my view that the contested marks will be perceived as allusive references to the goods and services, e.g. online retail services which enable users to purchase goods quickly. To my mind, the ‘insta-’ prefix will not be perceived in the same way when consumers encounter the INSTAGRAM marks. This is because the letters that follow, i.e. ‘GRAM’, do not form a word with any tangible meaning. As ‘GRAM’ does not describe anything that can be instant or produced quickly, the meaning of the prefix will not be immediately obvious to consumers. As the contested marks convey meanings that are

---

<sup>20</sup> *Usinor SA v OHIM*, Case T-189/05

not replicated in the INSTAGRAM marks, the competing marks are conceptually dissimilar.

#### *The contested marks and the INSTA marks*

70. The contested marks and the INSTA marks conceptually coincide in that they both convey the meaning of something that is instant or happening immediately; the competing marks all allude to goods and services that are provided quickly. However, the contested marks also include the words 'DATE' and 'GOODS', the meanings of which are not conveyed by the INSTA marks. Bearing in mind my assessment of the overall impressions, I find that there is a medium degree of conceptual similarity between the competing marks.

#### **Likelihood of confusion**

71. 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. One such factor 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 services, and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade marks, the average consumer for the 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 trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

72. 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 and services down to the responsible undertakings being the same or related.

73. Earlier in this decision, I concluded that:

- The class 9 goods of the INSTAGOODS mark are similar to those of the second and fifth earlier marks to a medium degree;
- The class 35 services of the INSTAGOODS mark are similar to those in class 35 of the third and fourth earlier marks to between a low and medium degree;
- Some of the class 9 goods of the INSTADATE mark are similar to those of the second and fifth earlier marks to a medium degree, whilst others are similar to the class 45 services of the second and sixth earlier marks to a medium degree;
- The class 35 services of the INSTADATE mark are similar to those of the third and fourth earlier marks to between a low and medium degree;
- The class 45 services of the INSTADATE mark are identical to those of the sixth earlier mark and similar to those of the second earlier mark to between a medium and high degree;
- Relevant consumers of the goods and services include members of the general public and business users;
- The general public will demonstrate a medium level of attention during the purchasing process, whereas that of business users will be above medium;
- The purchasing process for the goods and services will be predominantly visual in nature, though aural considerations have not been excluded;
- The second and third earlier marks possess a high level of inherent distinctive character, which has been enhanced to a very high level through use in respect of certain goods and services;

- The fourth, fifth and sixth earlier marks possess a low level of inherent distinctive character, which has been enhanced to a medium level through use for certain goods and services;
- The overall impression of the earlier marks is dominated by the words 'INSTAGRAM' and 'INSTA', respectively, being the only elements of the marks;
- The overall impression of the contested marks is dominated by the words 'INSTAGOODS' and 'INSTADATE', respectively, being the only elements of the marks;
- The second and third earlier marks and the contested marks are visually and aurally similar to a medium degree, though they are conceptually dissimilar;
- The fourth, fifth and sixth earlier marks and the contested marks are visually, aurally and conceptually similar to a medium degree.

74. Before addressing whether there is a likelihood of confusion, I note that the applicant has filed evidence of other trade mark registrations which consist of, or begin with, INSTA, covering classes 9, 35 and 45. I must clarify that the existence of these other marks will not have any bearing on the outcome of this opposition. In *Zero Industry Srl v OHIM*, Case T-400/06, the GC 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 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).”

75. I note that printouts have also been provided of the websites of a limited number of undertakings which use the prefix ‘insta-’ in their marks.<sup>21</sup> However, I do not consider this to be compelling evidence that these marks are in use, or that consumers have become accustomed to differentiating between them. The printouts all post-date the relevant dates, many of the websites do not appear to specifically target consumers in the UK and the undertakings appear to provide very different goods and services under their marks.

*The contested marks and the INSTAGRAM marks*

76. I acknowledge that the competing marks share five identical letters at their respective beginnings. I also accept that the INSTAGRAM marks have a high level of inherent distinctive character. Nevertheless, there are differences between the marks which are not negligible. The variant endings, i.e. ‘GOODS’ and ‘DATE’, contribute to the overall impressions of the contested marks and would not be overlooked by consumers during the purchasing process, even by those paying no more than a medium level of attention. This is particularly the case, considering the INSTAGRAM marks have no discernible meaning, whereas the contested marks have meanings which allude to the goods and services. It is my view that the differences between the competing marks are likely to be sufficient for consumers to distinguish between them and avoid mistaking one for the other. Consequently, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion.

---

<sup>21</sup> Exhibits 3 and 4



77. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., sitting 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).”

78. These three categories are not exhaustive. Rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal.<sup>22</sup> However, indirect confusion has its limits. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>23</sup> The Court of Appeal has also emphasised that, where there is no direct confusion, there must be a “proper basis” for finding indirect confusion.<sup>24</sup>

79. Having regard to all the above principles, I do not believe that consumers will assume the opponent and the applicant are economically linked undertakings on the basis of the competing trade marks. I am unconvinced that consumers, paying at least a medium level of attention, would assume a commercial association between the parties, or sponsorship on the part of the opponent, merely because of the shared string INSTA. Although the earlier marks have a high level of distinctive character – which, as the case law above sets out, means that there is a greater likelihood of confusion – it does not automatically follow that consumers will be indirectly confused. The endings of the contested marks, i.e. ‘GOODS’ and ‘DATE’, have no obvious connection to that of the earlier marks, i.e. ‘GRAM’, and I do not consider that consumers will perceive the contested marks to be indicative of sub-brands or brand extensions of the INSTAGRAM marks. I can see no reason why an undertaking would dissect an invented word with no obvious meaning and add descriptive words to the first five letters, resulting in marks with clear allusive meanings. In light of the above, I find that there is no likelihood of indirect confusion.

80. For the avoidance of doubt, I do not consider there to be a likelihood of direct or indirect confusion even when considering that the INSTAGRAM marks have an

---

<sup>22</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

<sup>23</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>24</sup> *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207

enhanced level of distinctive character in respect of certain goods and services. This is because the difference between a high and a very high level of distinctiveness is not sufficient to alter the outcome, i.e. the additional protection afforded to the INSTAGRAM marks by virtue of the use made of them is not such that it would counteract the aforementioned differences. Taking into account all the relevant factors, it is not considered that a degree more distinctiveness would result in consumers mistaking the competing marks for one another or assuming that there is a commercial relationship between the opponent and the applicant.

*The contested marks and the INSTA marks*

81. I acknowledge that the INSTA marks are entirely reproduced at the beginning of the contested marks and that this common element is likely to be understood in the same way by consumers. I also recognise the overall levels of similarity between the competing marks and that the INSTA marks enjoy an enhanced level of distinctive character in relation to some goods and services. However, the additional letters in the contested marks contribute to their overall impressions and, despite describing the goods and services, are not likely to be overlooked by consumers. It is my view that the differences between the competing marks resulting from these additional letters are likely to be sufficient for consumers, even those paying no more than a medium level of attention during the selection process, to distinguish between them and avoid mistaking one for the other. Therefore, notwithstanding the principles of imperfect recollection and interdependency, it follows that there will be no direct confusion, even for services that I have found to be identical.

82. Turning to indirect confusion, although I have found that consumers will immediately notice and recall the differences between the competing marks, they will also recognise the identical element 'INSTA'. Whether consciously or unconsciously, this will lead consumers through the mental process described in *L.A. Sugar*. This element, being the only element of the INSTA marks, is reproduced in its entirety at the beginning of the contested marks. Following this element in the contested marks are the words 'DATE' and 'GOODS'. These words describe characteristics of the goods and services offered under the contested marks. The addition of these non-distinctive words readily lends itself to brand extensions or sub-brands, i.e. the

contested marks as wholes will be perceived as alternative brands of the INSTA marks which inform consumers of the type of products or services that are said to be offered quickly. In my view, this is particularly the case where the INSTA marks have an enhanced level of distinctive character. Taking all of the above into account, I am satisfied that the consumers – paying at least a medium level of attention – would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the presence of the identical word ‘INSTA’. Accordingly, I find that there is a likelihood of indirect confusion. This finding also extends to circumstances where INSTA has not been shown to have an enhanced level of distinctive character. This is because, taking account of the interdependency principle, the overall levels of similarity between the competing marks and the respective goods and services are, in my view, sufficient to counteract the low level of inherent distinctive character possessed by the INSTA marks.

83. The oppositions under section 5(2)(b) of the Act have succeeded in full.

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

#### **Legislation and case law**

84. At the relevant date, sections 5(3) and 5(3A) of the Act stated as follows:

“(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 (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.”

(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”.

85. 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'Oréal v Bellure*, 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-Salomon*, 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'Oréal 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'Oréal v Bellure*).

86. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its earlier marks are similar to the contested marks. Secondly, the opponent must show that the marks have achieved a level of knowledge, or reputation, amongst a

significant part of the public. Thirdly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier marks being brought to mind by the contested marks. Fourthly, assuming the foregoing conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3) that the goods or services are 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.

87. The relevant dates for the assessment under section 5(3) are the filing/priority dates of the contested applications, namely, 19 May 2020 and 3 December 2020, respectively.

## **Reputation**

88. 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.”

89. Mr Dick says that the EUIPO has repeatedly confirmed that the opponent’s earlier marks enjoy a reputation for a wide range of goods and services. He provides a number of decisions in support of this contention, namely, Cancellation No. 9414 C (Cancellation Division), Case R 2430/2015-5 (Fifth Board of Appeal), Opposition Nos. B2942392 and B3053738 (Opposition Division) and Case R 2432/2015-5 (Cancellation Division and Board of Appeal).<sup>25</sup> A decision from IP Australia (relating to Australian application no. 1955633) has also been provided.<sup>26</sup> Finally, I note that a previous decision of this Tribunal (O/623/21) is in evidence.<sup>27</sup> Whilst the content of these decisions is noted, it is well established that I am not bound by previous decisions of this Tribunal, the EUIPO or other National Offices. I must assess whether the opponent has established a reputation based upon the evidence that has been filed in these proceedings. As such, I do not derive my findings from the decisions to which the opponent refers.

90. Taking the evidential picture as a whole into account, and for the same reasons outlined at paragraph 57, I do not hesitate to conclude that INSTAGRAM had a very strong reputation in the UK at the relevant dates in respect of *‘computer software for transmission of audio-visual content, data, advertisements, media advertising communications and information’* in class 9 of the second earlier mark and *‘providing online facilities for connecting sellers with buyers; facilitating the exchange and sale of services and products of third parties via computer and communication networks’* in class 35 of the third earlier mark. I note that the applicant has conceded that the earlier marks have a reputation in respect of a social media platform for editing and sharing photographs, videos and other multimedia, though argues that it does not extend to anything else. However, on the balance of the evidence filed, it is clear that there was also a substantial level of knowledge amongst a significant part of the public in respect of the opponent’s class 35 services listed above.

---

<sup>25</sup> Exhibits MJD11 to MJD14 and Exhibit MJD19

<sup>26</sup> Exhibit MJD21

<sup>27</sup> Exhibit MJD31



## Link

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

### The degree of similarity between the conflicting marks

I have found that the INSTAGRAM marks and the contested marks are visually and aurally similar to a medium degree, though 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

Relevant consumers of the goods and services at issue have been discussed above at paragraphs 43 to 45.

I have found that some of the parties' respective goods and services are similar to between a low and medium degree, some are similar to a medium degree and others are similar to between a medium and high degree.

### The strength of the earlier marks' reputation

I have found that the INSTAGRAM marks have a very strong reputation in the UK.

### The degree of the earlier marks' distinctive character, whether inherent or acquired through use

I have found that the INSTAGRAM marks enjoy a high level of inherent distinctive character, which has been enhanced to a very high degree through use for the reasons given at paragraphs 57.

### Whether there is a likelihood of confusion

I have found there to be no likelihood of direct or indirect confusion for the reasons stated at paragraphs 76 and 79.

92. The competing marks all coincide in the identical five-letter string 'INSTA', which appears at their respective beginnings. Taking this in combination with the similarity between the majority of the parties' goods and services, the very high level of distinctive character of the INSTAGRAM marks, the overall levels of visual and aural similarity between the marks, as well as the very strong reputation enjoyed by the INSTAGRAM marks, I consider that a significant part of the relevant public will make a link between them. Although I have found that there would be no direct or indirect confusion between the competing marks, it is, in my view, highly likely that the earlier marks will be brought to mind upon encountering the contested marks. Whilst I accept that there is no material similarity between the applicant's services in class 45 of the INSTADATE mark and any of the goods or services for which the opponent has demonstrated a reputation, the provisions of section 5(3) offer additional protection which takes into account the repute and distinctiveness of earlier trade marks; the parties' respective goods or services are not required to be similar. Even in respect of these services, it is my view that the reputation and enhanced distinctiveness of the INSTAGRAM marks is such that a significant part of the relevant public is highly likely to make a link between the competing marks.

### **Damage**

93. I must now assess whether any of the three pleaded types of damage will arise.

94. The proprietor of an earlier mark does not need to demonstrate actual or present damage under section 5(3).<sup>28</sup> Furthermore, it is not necessary for evidence to be

---

<sup>28</sup> *Intel*, Case C/252/07, paragraph 38

adduced of actual damage; it is permissible to deduce from the evidence that there is a serious risk of such damage.<sup>29</sup>

### Unfair competition

95. Taking advantage of the distinctive character or reputation of an earlier mark means that consumers are more likely to buy the goods or services of the later mark than they would have otherwise been if they had not been reminded of the earlier mark. As a result, the marketing of the later mark will not require as much effort or investment due to the familiarity that the relevant public would already feel with it or the message they are sent about what to expect.

96. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

97. I have already found that consumers would not be prone to the effects of direct or indirect confusion. Therefore, I do not believe that consumers would purchase the

---

<sup>29</sup> *Environmental Manufacturing*, Case C383/12P

applicant's goods or services in the mistaken belief that they are provided by, or economically connected with, the opponent. Nevertheless, upon encountering the contested marks, it is my view that consumers of the contested marks will certainly be reminded of the INSTAGRAM marks; they will appear instantly familiar, thereby making it easier for the applicant to establish its marks and to sell its computer software, retail services and dating services without incurring the marketing costs that would usually be required. The contested marks would be able to attract more consumers to purchase goods and services offered under them than would be the case if the INSTAGRAM marks were not brought to mind. This would essentially allow the contested marks to free-ride on the reputation of the INSTAGRAM marks and gain an unfair commercial advantage. This is, in my view, particularly the case given the very strong reputation and very high level of distinctive character of the INSTAGRAM marks.

98. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider detriment to repute or distinctive character.

99. The applicant has not shown that it has due cause for using the contested marks. Therefore, the oppositions based upon section 5(3) succeed in full.

#### **Section 5(4)(a)**

100. At the hearing, Mr Reed made no submissions on the opponent's claims under section 5(4)(a) of the Act. Further, this ground takes the opponent's case no further than its successful claims under sections 5(2)(b) and 5(3). As a result, I do not consider it necessary to consider it.

#### **CONCLUSION**

101. The oppositions under sections 5(2)(b) and section 5(3) of the Act have succeeded in full. Subject to any appeal against my decision, the applications will be refused.

102. As the oppositions have succeeded on the basis of the second, third, fourth, fifth and sixth earlier marks, it has not been necessary to consider the position in respect of the first earlier mark.

103. Finally, I should add that, although the opposition against the INSTADATE mark under section 5(2)(b) has succeeded in relation to some of the goods and services on the basis of the sixth earlier mark, the opposition under section 5(3) has succeeded in full, without reliance upon that particular mark. As such, this decision is final.

### **COSTS**

104. As the opponent 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 opponent the sum of £3,000 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing statements and considering the applicant's counterstatements	£800
Preparing evidence and considering the applicant's evidence	£1,000
Preparing for and attending a hearing	£800
Official fees	£400
<b>Total</b>	<b>£3,000</b>

105. I therefore order Instagoods Pty Ltd to pay Instagram, LLC the sum of £3,000. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings (subject to any order made by the appellate tribunal).

**Dated this 16<sup>th</sup> day of August 2022**

**James Hopkins  
For the Registrar,  
The Comptroller General**

## **ANNEX A**

### **Goods and services of the INSTAGOODS mark**

Class 9: Downloadable mobile applications for purchasing a wide variety of consumer goods and obtaining information on designers, influencers, shopping events and promotions.

Class 35: Online retail store services in relation to fashion accessories, aftershave, electrical appliances for cooking, audio apparatus, audio equipment, backpacks, bags, bakeware, bathrobes, beauty products, bedding, beds, belts [clothing], bed blankets, books, briefcases, cameras, candles, carpets, clothing, clutches [purses], coats, cologne, compact discs, computer hardware, computer software, computers, cookers, cooking apparatus, cooking appliances, cookware, cosmetics, cutlery, dinnerware, dresses, eau de toilette, sports equipment, eyeglasses, fragrances, furniture, games, game consoles, console gaming devices, glassware, gloves, hair care preparations, hats, headphones, headwear, headgear, heels, hosiery, electronic household appliances, household utensils, jackets, jeans, jewellery, jogging bottoms, jumpers, kitchen utensils, knitwear, lighting, linen, lingerie, lip gloss, lip stick, makeup, mats, microwave [ovens], moisturiser, monitors, hair oils, pants, perfume, playthings, pouches, purses, quilts, radios, rugs, sandals, satchels, scarves, shirts, shoes, shorts, silverware [cutlery, forks and spoons], skin care cosmetics, skirts, sleepwear, hair slides, slippers, smart phones, sneakers, socks, software, speakers, sporting articles, sportswear, sports equipment, stationery, data storage devices, suitcases, suits, sunglasses, swimwear, tablet computer, telephones, televisions, ties, toiletries, tops, towels, track pants, travel bags, t-shirts, umbrellas, underwear, video devices, video games software, video games cartridges, video game machines, vitamin supplements, food supplements, wall hangings, wallets, watches; Retail store services in relation to fashion accessories, aftershave, electrical appliances for cooking, audio apparatus, audio equipment, backpacks, bags, bakeware, bathrobes, beauty products, bedding, beds, belts [clothing], bed blankets, books, briefcases, cameras, candles, carpets, clothing, clutches [purses], coats, cologne, compact discs, computer hardware, computer software, computers, cookers, cooking apparatus, cooking appliances, cookware, cosmetics, cutlery, dinnerware, dresses, eau de toilette, sports equipment,

eyeglasses, fragrances, furniture, games, game consoles, console gaming devices, glassware, gloves, hair care preparations, hats, headphones, headwear, headgear, heels, hosiery, electronic household appliances, household utensils, jackets, jeans, jewellery, jogging bottoms, jumpers, kitchen utensils, knitwear, lighting, linen, lingerie, lip gloss, lip stick, makeup, mats, microwave [ovens], moisturiser, monitors, hair oils, pants, perfume, playthings, pouches, purses, quilts, radios, rugs, sandals, satchels, scarves, shirts, shoes, shorts, silverware [cutlery, forks and spoons], skin care cosmetics, skirts, sleepwear, hair slides, slippers, smart phones, sneakers, socks, software, speakers, sporting articles, sportswear, sports equipment, stationery, data storage devices, suitcases, suits, sunglasses, swimwear, tablet computer, telephones, televisions, ties, toiletries, tops, towels, track pants, travel bags, t-shirts, umbrellas, underwear, video devices, video games software, video games cartridges, video game machines, vitamin supplements, food supplements, wall hangings, wallets, watches.

### **Goods and services of the INSTADATE mark**

Class 9: Computer software for the provision of retail services in respect of goods that are only otherwise available for purchase in physical outlets and/or online outlets through computers, computer networks and the internet; and computer software for dating, match making and personal introduction services.

Class 35: Retail services in respect of fashion accessories, aftershave, electrical appliances for cooking, audio apparatus, audio equipment, backpacks, bags, bakeware, bathrobes, beauty products, bedding, beds, belts [clothing], bed blankets, books, briefcases, cameras, candles, carpets, clothing, clutches [purses], coats, cologne, compact discs, computer hardware, computer software, computers, cookers, cooking apparatus, cooking appliances, cookware, cosmetics, cutlery, dinnerware, dresses, eau de toilette, sports equipment, eyeglasses, fragrances, furniture, games, game consoles, console gaming devices, glassware, gloves, hair care preparations, hats, headphones, headwear, headgear, heels, hosiery, electronic household appliances, household utensils, jackets, jeans, jewellery, jogging bottoms, jumpers, kitchen utensils, knitwear, lighting, linen, lingerie, lip gloss, lip stick, makeup, mats, microwave [ovens], moisturiser, monitors, hair oils, pants, perfume, playthings, pouches, purses, quilts, radios, rugs, sandals, satchels, scarves, shirts, shoes, shorts,



silverware [cutlery, forks and spoons], skin care cosmetics, skirts, sleepwear, hair slides, slippers, smart phones, sneakers, socks, software, speakers, sporting articles, sportswear, sports equipment, stationery, data storage devices, suitcases, suits, sunglasses, swimwear, tablet computer, telephones, televisions, ties, toiletries, tops, towels, track pants, travel bags, t-shirts, umbrellas, underwear, video devices, video games software, video games cartridges, video game machines, vitamin supplements, food supplements, wall hangings, wallets, watches; Online retail store services in relation to fashion accessories, aftershave, electrical appliances for cooking, audio apparatus, audio equipment, backpacks, bags, bakeware, bathrobes, beauty products, bedding, beds, belts [clothing], bed blankets, books, briefcases, cameras, candles, carpets, clothing, clutches [purses], coats, cologne, compact discs, computer hardware, computer software, computers, cookers, cooking apparatus, cooking appliances, cookware, cosmetics, cutlery, dinnerware, dresses, eau de toilette, sports equipment, eyeglasses, fragrances, furniture, games, game consoles, console gaming devices, glassware, gloves, hair care preparations, hats, headphones, headwear, headgear, heels, hosiery, electronic household appliances, household utensils, jackets, jeans, jewellery, jogging bottoms, jumpers, kitchen utensils, knitwear, lighting, linen, lingerie, lip gloss, lip stick, makeup, mats, microwave [ovens], moisturiser, monitors, hair oils, pants, perfume, playthings, pouches, purses, quilts, radios, rugs, sandals, satchels, scarves, shirts, shoes, shorts, silverware [cutlery, forks and spoons], skin care cosmetics, skirts, sleepwear, hair slides, slippers, smart phones, sneakers, socks, software, speakers, sporting articles, sportswear, sports equipment, stationery, data storage devices, suitcases, suits, sunglasses, swimwear, tablet computer, telephones, televisions, ties, toiletries, tops, towels, track pants, travel bags, t-shirts, umbrellas, underwear, video devices, video games software, video games cartridges, video game machines, vitamin supplements, food supplements, wall hangings, wallets, watches; Retail store services in relation to fashion accessories, aftershave, electrical appliances for cooking, audio apparatus, audio equipment, backpacks, bags, bakeware, bathrobes, beauty products, bedding, beds, belts [clothing], bed blankets, books, briefcases, cameras, candles, carpets, clothing, clutches [purses], coats, cologne, compact discs, computer hardware, computer software, computers, cookers, cooking apparatus, cooking appliances, cookware, cosmetics, cutlery, dinnerware, dresses, eau de toilette, sports equipment, eyeglasses, fragrances, furniture, games, game consoles, console gaming devices,

glassware, gloves, hair care preparations, hats, headphones, headwear, headgear, heels, hosiery, electronic household appliances, household utensils, jackets, jeans, jewellery, jogging bottoms, jumpers, kitchen utensils, knitwear, lighting, linen, lingerie, lip gloss, lip stick, makeup, mats, microwave [ovens], moisturiser, monitors, hair oils, pants, perfume, playthings, pouches, purses, quilts, radios, rugs, sandals, satchels, scarves, shirts, shoes, shorts, silverware [cutlery, forks and spoons], skin care cosmetics, skirts, sleepwear, hair slides, slippers, smart phones, sneakers, socks, software, speakers, sporting articles, sportswear, sports equipment, stationery, data storage devices, suitcases, suits, sunglasses, swimwear, tablet computer, telephones, televisions, ties, toiletries, tops, towels, track pants, travel bags, t-shirts, umbrellas, underwear, video devices, video games software, video games cartridges, video game machines, vitamin supplements, food supplements, wall hangings, wallets, watches.

Class 45: Dating services; match making services; internet dating, matchmaking and personal introduction services; video dating services; dating agency services.

## **ANNEX B**

### **Goods and services of the first earlier mark**

Class 9: Downloadable computer software for modifying the appearance and enabling transmission of photographs.

Class 42: Computer services, namely, providing an interactive website featuring technology that allows users to manage their online photograph and social networking accounts.

### **Goods and services of the second earlier mark**

Class 9: Computer software for social networking; Computer software for creating, managing, and interacting with an online community; Computer software for transmission of audio-visual content, data, advertisements, media advertising communications and information; Computer software for disseminating advertising for others.

Class 45: Online social networking services; Internet based social introduction and networking services; Providing information in the form of databases featuring information in the fields of social networking and social introduction.

### **Services of the third earlier mark**

Class 35: Providing online facilities for connecting sellers with buyers; providing online marketplaces for sellers of goods and/or services; facilitating the exchange and sale of services and products of third parties via computer and communication networks; business and advertising services, namely, managing, tracking, analyzing, reporting, measuring and optimizing electronic payment transaction data for others; marketing, advertising and promotion services, namely, providing information regarding discounts, coupons, rebates, vouchers, links to retail websites of others, and special offers for the goods and services of others.

### **Services of the fourth earlier mark**

Class 35: Marketing, advertising and promotion services, namely, providing information regarding discounts, coupons, rebates, vouchers, links to retail websites of others, and special offers for the goods and services of others; Provision of market research and information services; Promoting the goods and services of others via the internet and communication networks; Business and advertising services, namely, media planning and media buying for others; Business and advertising services, namely, advertising services for tracking advertising performance, for managing, distributing and serving advertising, for analyzing advertising data, for reporting advertising data, and for optimizing advertising performance; Consulting services in the fields of advertising and marketing, namely, customizing advertising and marketing efforts of others; Providing online facilities for connecting sellers with buyers; Advertising, marketing and promoting the goods and services of others by means of providing photo and video equipment at special events; Providing online facilities for live streaming video of promotional events; Arranging and conducting special events for commercial, promotional or advertising purposes; Providing online business directories featuring the businesses, products and services of others; none of the aforementioned services for the areas of energy, heating, cooling, water, oil, electricity, gas, smoke and fire detection, environmental light control, temperature, room climate, and utilities, as well as for the measuring, regulating, control, checking, recording, display, collection, processing, management, billing, and transmission of data and information relating thereto.

### **Goods of the fifth earlier mark**

Class 9: Downloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; all aforementioned goods not for the areas of energy, heating, cooling, water, oil, electricity, gas, smoke and fire detection, environmental light control, temperature, room climate and utilities, as well

as for the measuring, regulating, control, checking, recording, display, collection, processing, management, billing and transmission of data and information relating thereto.

### **Services of the sixth earlier mark**

Class 45: Internet based social introduction, networking and dating services.

### **Goods and services in relation to which use of the unregistered INSTAGRAM sign is claimed**

Since October 2010: Online social networking services; software and downloadable software applications for providing and facilitating online social networking services; software and downloadable software applications for photo/video-sharing and -editing.

Since September 2014: Promoting the goods and services of others via the internet and communication networks; providing online facilities for connecting sellers with buyers; facilitating the exchange and sale of services and products of third parties via computer and communication networks; marketing, advertising and promotion services, namely, providing links to retail websites of others, and special offers for the goods and services of others; software and downloadable software applications for providing and facilitating all the aforesaid services.