

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2016121
of 20 December 2022

Opponent: **Instagram, LLC CA**
Willow Road 1601
94025 Menlo Park California
United States of America

Representative: **Merkenbureau Knijff & Partners B.V.**
Leeuwendeldseweg 12
1382 LX Weesp
Netherlands

1st Invoked right: **European Union trademark registration 12111746**

Instagram

2nd Invoked right: **European Union trademark registration 17739392**

INSTAGRAM

3rd Invoked right: **European Union trademark registration 17651472**

GRAM

4th Invoked right: **European Union trademark registration 17642729**

GRAM

against

Defendant: **KIMERU, besloten vennootschap met beperkte aansprakelijkheid**
Mechelsesteenweg 151
2018 Antwerpen
Belgium

Representative: **Bureau M.F.J. Bockstael nv**
Arenbergstraat 13
2000 Antwerpen
Belgium

Contested trademark: Benelux trademark application 1412069



I. FACTS AND PROCEEDINGS

A. Facts


1. On 21 February 2020 the defendant filed a Benelux trademark application for the combined



word/figurative mark **SIGNAGRAM** for goods and services in classes 9, 38 and 42. This application was processed under number 1412069 and was published on the 12 March 2020.

2. On 16 June 2020 the opponent filed an opposition against the registration of the application¹. The opposition is based on:

Instagram

1. the European Union trademark 12111746 of the word/figurative mark , filed on 3 September 2013 and registered on 6 March 2014 for goods and services in classes 9, 38, 41, 42 and 45.
 2. the European Union trademark 17739392 of the wordmark "INSTAGRAM", filed on 25 January 2018 and registered on 24 January 2019 for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44 and 45.
 3. the European Union trademark 17651472 of the wordmark "GRAM", filed on 29 December 2017 and registered on 15 April 2019 for goods and services in classes 9 and 38.
 4. the European Union trademark 17642729 of the wordmark "GRAM", filed on 28 December 2017 and registered on 23 March 2019 for goods and services in classes 16, 18, 21, 24, 25, 35, 41, 42, 43 and 45.
3. According to the register the opponent is the actual holder of the trademarks invoked.
4. The opposition is directed against all of the goods and services covered by the contested application and is based on all of the goods and services covered by the trademarks invoked. However, in his arguments the opponent bases the comparison for the trademarks invoked only on goods and services in classes 9, 38 and 42.
5. The grounds for opposition are those laid down in article 2.14, 2 (a) of the Benelux Convention on Intellectual Property (hereinafter: "BCIP").
6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office" or "BOIP") to the parties on 24 June 2020. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated

¹ Pursuant to the Rule issued by the Director General of 20 March 2020 on compliance with deadlines during the period of public health restrictions caused by the corona virus, the opposition was filed timely.

in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 23 December 2020.

II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 2 (a) BCIP, in accordance with the provisions of articles, 2.2ter, 3 (a) BCIP: infringement of a trademark with a reputation and 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of trademark and sign and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent starts his arguments by comparing the goods and services covered by the contested trademark to goods and services covered by the invoked trademarks in classes 9, 38 and 42 and concludes that they are identical if not at least similar.

10. Comparing the signs in question visually, the opponent notes that the first two invoked rights share the sequence "AGRAM" with the contested right and are composed of the same number of letters. The figurative elements of the trademarks are, according to the opponent, of a lesser impact on the consumer than the verbal elements, making the trademarks overall visually similar. As regards the comparison with the third and fourth invoked rights, the opponent notes that these are comprised in the contested right making the latter partially identical to these and therefore similar.

11. Phonetically, the opponent argues that the first two trademarks and the contested trademark all contain the sequence I-A-GRAM and are therefore aurally similar. Furthermore, the opponent considers that the contested trademark consists exclusively of the third and fourth invoked rights to which non distinctive word elements have been added, making these trademarks similar.

12. Conceptually, the opponent considers the trademarks devoid of any meaning making a conceptual comparison impossible.

13. As regards the distinctiveness of the invoked trademarks, the opponent notes that these do not have a meaning in relation to the relevant goods. Furthermore, referring to the material submitted in support of his arguments for unfair advantage and detriment to the distinctive character of the trademark, the opponent argues that the trademark "INSTAGRAM" has been used intensively in the European Union and the Benelux and has acquired a reputation through use.

14. According to the opponent, the goods and services in question are directed towards the public at large and their level of attention should therefore be considered average.

15. Addressing the ground of unfair advantage or detriment to the distinctive character or reputation of a trademark, the opponent submits elements to show the reputation of the "INSTAGRAM" trademark due to its widespread use and market share.

16. As concerns unfair advantage the opponent notes that due to the previously established similarity of the trademarks, the reputation of the trademark "Instagram" and the proximity of the goods and services covered by the contested right and the ones for which the trademark "Instagram" is used and known for, there exists a risk that consumers would establish a link between both. As a result, the contested sign would also take advantage of the reputation of the trademark "Instagram" and there exists a risk of dilution of the distinctive character of the latter.

17. As a result of the above, the opponent considers that there exists likelihood of confusion and that the contested application takes unfair advantage of the reputation of the invoked trademarks. Thus, he asks the Office not to register the contested trademark and to order that the costs be borne by the defendant.

B. Defendant's arguments

18. In the first place the defendant addresses the comparison of the goods and services covered and notes that, generally, the contested trademark covers goods and services related to B2B signalling not covered by the invoked trademarks which are predominantly linked to the field of social networking.

19. Comparing the trademarks concerned, the defendant notes that visually the invoked trademarks differ from the contested trademark due to the figurative element present in the latter. Furthermore, the trademarks also differ in their beginning "SIGNA" and "INSTA" respectively.

20. Phonetically, the defendant notes that the trademarks in question differ in their first syllables.

21. Conceptually, the defendant notes that the trademarks differ in that the word elements at the beginning of the signs have different meanings. In that regard the defendant argues that the prefix "INSTA" of the invoked trademarks refers to the word "instant" and "SIGNA" in the contested trademark to the word "signage".

22. As a result of the above, the defendant considers that there is no likelihood of confusion and asks the Office to register the contested trademark.

III. DECISION

A.1 Likelihood of confusion

23. In accordance with article 2.14 BCIP, the holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.2ter BCIP.

24. Article 2.2ter (1) BCIP stipulates insofar as relevant that, *"A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark."*²

25. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.³

² Art. 2.2ter (1)(b) BCIP implements art. 5 (1)(b) Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

³ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

26. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.⁴

Comparison of the trademarks


27. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.⁵

28. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.⁶ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.⁷

29. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

30. The trademarks to be compared are the following:

Concerning the second trademark invoked (European Union trademark registration 17739392)

Opposition based on:	Opposition directed against:
INSTAGRAM	

⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

⁷ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

Visual comparison

31. The invoked trademark consists of the word element "INSTAGRAM" composed of 9 letters. The contested trademark is composed of the word element "SIGNAGRAM" also composed of 9 letters. Above the verbal element of the contested trademark is a figurative element composed of two blue "U" shapes placed as to evoke the letter "S" with, at both sides, the extremities of a black disk shape showing.

32. Where a sign consists of both verbal and figurative elements, the former are, in principle, considered more distinctive than the latter, because the average consumer will more easily refer to the goods or services in question by quoting their name than by describing the figurative element of the trademark.⁸ The figurative element of the contested trademark in this case would probably not go unnoticed to the average customer. Nonetheless, the Office is of the opinion that the relevant public will perceive the verbal element as the dominant element of the contested trademark due to its size and placement within the trademark.

33. The consumer normally attaches more importance to the first part of a sign.⁹ In the case at hand, while the first part of both trademarks differ, they are nonetheless composed of the same amount of letters and share the same 5 letter sequence "AGRAM" at the end of the trademarks resulting in some level of visual similarity between the trademarks as a whole.

34. The trademarks are visually similar to a certain degree.

Aural comparison

35. Concerning the aural comparison, it must be pointed out that, in the strict sense, the aural reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level.¹⁰

36. The verbal elements of the trademarks concerned are both composed of 3 syllables and share the same rhythm. Furthermore, the sequence "AGRAM" is identically present in both trademarks. The trademarks coincide in their last syllable and, while the first two syllables of the trademarks, [IN] [STA] and [SIG] [NA] respectively, are not identical, they share a certain similarity due to the fact that both contain the vowel I in the beginning and the consonants S and N.

37. Thus, the Office considers the trademarks to be aurally similar.

Conceptual comparison

38. The invoked trademark, "INSTAGRAM" does not have a meaning. Indeed, while the prefix "INSTA" may refer to the word "INSTANT" the average consumer normally perceives a trademark as a whole and does not proceed to analyse its various details. As a result, even if the relevant public were to perceive the word "INSTA" as a reference to "INSTANT", the fact that the suffix "GRAM", to which it refers, does not have a meaning renders the trademark as a whole devoid of any meaning.

⁸ General Court (EU) 9 November 2016, T-290/15, ECLI:EU:T:2016:651, point 36 and the case-law mentioned there (Smarter Travel).

⁹ EGC 17 March 2004, T-183/02 and T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

¹⁰ General Court (EU) 21 April 2010, T-361/08, ECLI:EU:T:2010:152, point 58 (Thai Silk).

39. The same reasoning applies to the contested trademark, which, irrespective of whether the word "SIGNA" would be understood by the average consumer as referring to the word "SIGNAL", does not, as a whole, have a meaning due to the fact that the same suffix "GRAM", to which the prefix would refer, is devoid of meaning.

40. As a result, both trademarks do not have a conceptual meaning for the Benelux consumer, making a conceptual comparison of the trademarks irrelevant.

Conclusion

41. The trademarks in question are visually similar to a certain degree, phonetically similar and a conceptual comparison is irrelevant.

Comparison of the goods and services

42. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. These factors include, inter alia, their nature, their end-users, and their method of use and whether they are in competition with each other or are complementary.¹¹

43. Complementarity only exists where the products and/or services are so closely related to each other that one is indispensable or important for the use of the other so that consumers may believe that the same undertaking is responsible for those products.¹²

44. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register and not the actual or intended use.¹³

45. The goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
CI 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking [supervision], life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; software applications;	CI 9 Digitale signalisatie monitoren; digitale signalisatie displays; beeldschermen; interactieve grafische schermen; gegevensoverdracht (apparatuur voor interactieve-); communicatie-installaties (elektronische-); computer hardware; computer software die bedrijven toelaat om in een B2B toepassing informatie te plaatsen op eigen signalisatieschermen, al dan niet interactief, voor gebruik in winkelruimtes, toonzalen, musea, inkomhallen van bedrijfsgebouwen, publieke ruimtes en op openlucht locaties, dit ter bevordering van de veiligheid, om bezoekers te helpen hun weg te vinden, voor het vlot communiceren van bedrijfsinformatie, om de aandacht van bezoekers te vestigen op belangrijke mededelingen in het kader van noodsituaties, om wachtrijen op een

¹¹ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹² General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

¹³ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

<p>electronic game software; video game software; 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 for use as an application programming interface (API); application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; 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; downloadable electronic publications; downloadable video recordings in the nature of creative tutorials in the field of advertising on social media; information technology and audio-visual equipment; information technology and audio-visual, multimedia and photographic apparatus and instruments; cameras [photography]; software, namely, an application providing social networking functionalities; software for social networking; software for opinion polling; software allowing users to post questions with answer options; software allowing users to join discussions and post comments about opinion polls, questions and answers; software allowing users to give compliments and positive feedback; software for creating, managing, and interacting with an online community; software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing electronic media or information via computer and communication networks; software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; software for sending and receiving electronic message alerts, notifications and reminders; software for remote</p>	<p>efficiënte manier te beheren, en om het winkelcomfort van klanten te verbeteren.</p> <p><i>Cl 9 Digital signage monitors; digital signage displays; displays; interactive graphic screens; data transmission (interactive equipment); communication installations (electronic); computer hardware; computer software allowing companies to place information in a B2B application on their own signalling screens, whether interactive or not interactive, for use in retail spaces, showrooms, museums, entrance halls of company buildings, public spaces and open-air locations to promote safety, to help visitors navigate their way, to communicate business information smoothly, to draw visitors' attention to important emergency announcements, to manage queues efficiently, and improve customer shopping comfort.</i></p>
--	--

<p>communication; software for sending and receiving electronic messages, graphics, images, audio and audio visual content via the internet and communications networks; software for wireless content, data and information delivery; messaging software; virtual reality helmets adapted for use in playing video games; wearable peripherals for playing video games specially adapted for computers, video game consoles, handheld video game consoles, tablet computers, and mobile telephones; parts and fittings for the aforesaid goods.</p>	
<p>CI 38 Telecommunications; telecommunications services, namely, electronic transmission of data, messages, graphics, photographs, images, audio, video and information; providing chatrooms, instant messaging services, and electronic bulletin boards; broadcasting services; data broadcasting services; audio, text and video broadcasting service over the internet or other communications networks; computer aided transmission of messages and images; providing access to computer, electronic and online databases; providing online forums for communication on topics of general interest; providing user access to global computer networks; rental of access time to global computer networks; streaming of data; transmission of digital files; electronic transmission of electronic media, data, messages, graphics, images, audio, video and information; chatroom services for social networking; providing online chat rooms and electronic bulletin boards; providing access to computer, electronic and online databases in the fields of social networking; broadcasting services over computer or other communication networks namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, and images; instant messaging services; peer-to-peer photo sharing, video sharing and data sharing services, namely, electronic transmission of digital photo files, audio, videos, audio-visual content and graphics among users; photosharing and data</p>	<p>CI 38 Digitale transmissie van audio-en videogegevens in het kader van digitale signalisatie in een B2B toepassing; communicatiefaciliteiten (verstrekken van-) voor de uitwisseling van digitale gegevens in het kader van digitale signalisatie in een B2B toepassing; narrowcasting van videobeelden in het kader van digitale signalisatie in een B2B toepassing; geen van voornoemde diensten ten behoeve van sociale media netwerken.</p> <p><i>CI 38 Digital transmission of audio and video data in the context of digital signalling in a B2B application; communication facilities (provision of) for the exchange of digital data in the context of digital signalling in a B2B application; narrowcasting of video images in the context of digital signalling in a B2B application; none of the aforementioned services are offered in the field of social media networks.</i></p>

<p>sharing services, namely, electronic transmission of digital photo files, videos, audio visual content and data among internet and mobile device users; providing access to computer databases in the fields of online networking, online introduction and dating; information, advisory and consultancy services relating to the aforesaid services.</p>	
<p>CI 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; conversion of data or documents from physical to electronic media; software as a service; electronic data storage; electronic storage of photographs; updating of computer software; application service provider (ASP) services, namely hosting software applications of others; interactive hosting services which allow the users to publish and share their own content and images online; hosting on-line web facilities for others; hosting online web facilities for others for sharing online content; hosting a web site that gives users the ability to upload photographs; computer services, namely, hosting an interactive website featuring technology that allows users to manage their online photograph and social networking accounts; providing online software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, hosting a website featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; providing technical information from searchable indexes and databases of information; providing on-line non-downloadable software for database management; online data storage; providing search engines for obtaining data via the internet and communications networks; provision of Internet search engines; providing search engines for obtaining data via communications networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer network services;</p>	<p>CI 42 Ontwerp, installatie, onderhoud, reparatie en verhuur van computer software die bedrijven toelaat om in een B2B toepassing informatie te plaatsen op eigen signalisatieschermen, al dan niet interactief, voor gebruik in winkelruimtes, toonzalen, musea, inkomhallen van bedrijfsgebouwen, publieke ruimtes en op openlucht locaties, dit ter bevordering van de veiligheid, om bezoekers te helpen hun weg te vinden, voor het vlot communiceren van bedrijfsinformatie, om de aandacht van bezoekers te vestigen op belangrijke mededelingen in het kader van noodsituaties, om wachtrijen op een efficiënte manier te beheren, en om het winkelcomfort van klanten te verbeteren; geluids- en beelddragers (ontwikkeling en ontwerp van digitale-); geen van voornoemde diensten ten behoeve van sociale media netwerken.</p> <p><i>CI 42 Design, installation, maintenance, repair and rental of computer software that allows companies to place information in a B2B application on their own signalling screens, whether or not interactive, for use in retail spaces, showrooms, museums, entrance halls of company buildings, public spaces and open-air locations, to promote safety, to help visitors navigate their way, to communicate business information smoothly, to draw visitors' attention to important emergency announcements, to manage queues efficiently, and to improve customer shopping comfort; sound and image carriers (development and design of digital); none of the aforementioned services are offered in the field of social media networks.</i></p>

providing interactive online facilities featuring technology that allows users to manage images, photographs, text, graphics, audio-visual, video content, data and personal social networking accounts; providing online facilities that give users the ability to upload, modify and share audio, video, photographic images, text, graphics and data; application service provider (ASP); application service provider (ASP) featuring software to enable or facilitate the editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing audio and video content, photographic images, text, graphics and data; application service provider (ASP) featuring software to enable or facilitate voice over internet protocol (VOIP) calls, phone calls, video calls, text messages, electronic messages, instant messages, and online social networking services; application service provider (ASP), namely, providing, hosting, managing, developing, and maintaining applications, software, web sites, and databases in the fields of wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices; computer services, namely, hosting electronic facilities in the nature of internet websites, mobile applications and other similar communication platforms for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks; peer-to-facilities photo sharing services, namely, providing online facilities featuring technology enabling users to edit, upload, download, access, view, post, display, tag, blog, stream, link, annotate,

indicate sentiment about, comment on, embed, transmit, or share images, photographs, text, graphics, audio-visual, video content, and data; application service provided (ASP) featuring software to enable or facilitate taking and editing photographs and recordings and editing videos; computer services, namely, creating virtual communities for registered users to organize groups, meeting and events, participate in discussions and engage in social, business and community networking; providing online facilities featuring technology that enables users to create personal profiles featuring social networking information and to transfer and share such information among multiple online facilities; providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple websites; hosting a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple websites; providing software in the nature of a mobile application; providing software for social networking, creating a virtual community, and transmission of audio, video, images, text, content and data; providing software for opinion polling; providing technical information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks; providing software allowing users to post questions with answer options; providing software allowing users to join discussions and post comments about opinion polls, questions and answers; providing software allowing users to give compliments and positive feedback; computer services, namely, hosting online facilities for others for interactive discussions via communication networks; providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or specified information,

<p>personal profiles, audio, video, photographic images, text, graphics and data; computer services in the nature of customized electronic accounts featuring user-defined or user-specified information, personal profiles, audio, video, photographic images, text, graphics and data; information, advisory and consultancy services relating to the aforesaid services; Software as a service (SAAS) services featuring software for sending and receiving electronic messages, notifications and alerts; software for electronic messaging; Providing online facilities featuring software for sending and receiving electronic messages, instant messages, electronic message alerts and reminders, photographs, images, graphics, data, audio, videos and audio-visual content via the internet and communication networks; providing user authentication services in e-commerce transactions; providing user authentication of electronic funds transfer, credit and debit card and electronic check transactions via a global computer network; information, advisory and consultancy services relating to all of the aforesaid.</p>	
	<p>(N.B.: The original language of the mark concerned is Dutch. The English translation of the list of goods and services has been added to increase the readability of this decision).</p>

Class 9

46. The goods “*Digital signage monitors; digital signage displays; displays; interactive graphic screens; data transmission (interactive equipment); communication installations (electronic)*” of the contested trademark are covered by the broader category of goods “*apparatus for recording, transmission or reproduction of sound or images*” of the invoked trademark and are such to be considered identical to the latter.

47. The goods “*computer hardware*” of the contested trademark and the “*data processing equipment, computers*” of the invoked trademark are at least highly similar, if not identical as these goods have the same nature, production, distribution channels and relevant public. Furthermore, they may have the same purpose and method of use which would lead to identity.

48. Finally the goods “*computer software allowing companies to place information in a B2B application on their own signalling screens, whether interactive or not interactive, for use in retail spaces, showrooms, museums, entrance halls of company buildings, public spaces and open-air locations to promote safety, to help visitors navigate their way, to communicate business information smoothly, to draw visitors' attention to important emergency announcements, to manage queues efficiently, and improve customer shopping*”

comfort.” covered by the invoked trademark fall within the broader category of “software for creating, editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing electronic media or information via computer and communication networks; software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information” covered by the invoked trademark and are thus identical.

Class 38

49. The contested services *“Digital transmission of audio and video data in the context of digital signalling in a B2B application; communication facilities (provision of) for the exchange of digital data in the context of digital signalling in a B2B application; narrowcasting of video images in the context of digital signalling in a B2B application; none of the aforementioned services are offered in the field of social media networks”* are covered by the invoked trademark’s *“Telecommunications; telecommunications services, namely, electronic transmission of data, messages, graphics, photographs, images, audio, video and information; providing chatrooms, instant messaging services, and electronic bulletin boards;”* and are as such identical to the latter. The fact that the contested trademark specifically excludes services in this class related to social media networks does not alter this conclusion since the invoked trademark’s services are not limited to these.

Class 42

50. The services *“Design, installation, maintenance, repair and rental of computer software that allows companies to place information in a B2B application on their own signalling screens, whether or not interactive, for use in retail spaces, showrooms, museums, entrance halls of company buildings, public spaces and open-air locations, to promote safety, to help visitors navigate their way, to communicate business information smoothly, to draw visitors’ attention to important emergency announcements, to manage queues efficiently, and to improve customer shopping comfort; sound and image carriers (development and design of digital); none of the aforementioned services are offered in the field of social media networks”* covered by the contested trademark in this class fall within the broader categories of services covered by the invoked trademark, namely: *“Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; software as a service; updating of computer software; application service provider (ASP); application service provider (ASP) featuring software to enable or facilitate the editing, uploading, downloading, accessing, viewing, posting, displaying, tagging, blogging, streaming, linking, annotating, indicating sentiment about, commenting on, embedding, transmitting, and sharing or otherwise providing audio and video content, photographic images, text, graphics and data;”*. As a result these services are to be considered identical.

Conclusion

51. The goods and services covered by the contested trademark are identical or at least highly similar to the goods and services covered by the trademark invoked.

A.2 Global assessment

52. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him.

It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.¹⁴ In the present case, the goods and services concerned are directed at the public at large. The level of attention of the eligible public can therefore be considered normal.

53. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.¹⁵ In the present case, the earlier mark has normal inherent distinctiveness as it is not descriptive for any of these goods or services. Furthermore, the elements submitted by the opponent concerning an acquired higher level of distinctiveness (paragraph 13) do not need to be examined considering that such a finding would not alter the outcome of the decision. Thus, the Office considers that the earlier trademark has a normal distinctiveness, as it is not descriptive of the goods or services concerned.

54. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and, in particular, between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.¹⁶

55. Based on the abovementioned circumstances, the Office finds that due to both trademarks being visually similar to a certain degree, phonetically similar and a conceptual comparison being irrelevant, the relevant public might believe that the goods and services which are highly similar or identical come from the same undertaking or from economically-linked undertakings.

B. Other factors

56. In an opposition procedure there is no question of the other party being ordered to bear the costs incurred (see paragraph 17). Only a referral of the costs set at the established opposition fee in case the opposition is totally justified (or rejected) is provided for.

C. Conclusion

57. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

58. Since the opposition is already justified on the basis of the second trademark invoked, there is no need to proceed to the assessment of likelihood of confusion with regard to the other trademarks invoked or the potential infringement of a trademark with a reputation based on 2.2ter, 3 (a) BCIP.

IV. DECISION

59. The opposition with number 2016121 is justified.

60. The Benelux application with number 1412069 will not be registered.

¹⁴ CJEU 22 Juni 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹⁵ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

61. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.



The Hague, 20 December 2022

François Châtellier
(rapporteur)

Pieter Veeze

Eline Schiebroek

Administrative officer: Jeanette Scheerhoorn