O/0752/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATIONS NO. 3735502 & NO. 3735504

IN THE NAME OF THINKWARE CORPORATION

TO REGISTER AS UK TRADE MARKS

IN RESPECT OF GOODS IN CLASS 9

SNAP G **&** 

AND

THE CONSOLIDATED OPPOSITIONS THERETO

NOs. 433785 AND 433789

BY SNAP INC

BACKGROUND AND PLEADINGS

1. On 21 December 2021, Thinkware Corporation ("**the Applicant**") filed two applications to register as trade marks in the United Kingdom the marks shown on the cover of this decision. This decision refers to the Applicant's marks as "the SNAP G marks" (though one is a plain word mark and the other figurative). Both trade mark applications are in respect of the following goods:

   Class 9: *Cameras; digital still and motion cameras; camera mounts; photography appliance bags and cases; mounting devices for cameras and monitors; camera cases; cases for camera lens; camera tripods; portable rechargers; wireless charging devices; wearable activity trackers; target trackers [electronic]; batteries; batteries for cameras; auxiliary battery packs; lens filters [for cameras]; light filters for cameras; LCD protective film for digital cameras; protective film for portable multimedia players; microphones.*

2. The applications were published for opposition purposes on 25 February 2022, and were opposed on 25 May 2022 by Snap Inc ("**the Opponent**"). The Opponent owns various registrations for trade marks that include the element "SNAP" in respect of goods and services across various classes (the Opponent's "**Earlier Marks**"). The details of the Earlier Marks as relied on by the Opponent are set out below.

3. The Opponent relies on grounds of opposition under **section 5(2)(b)** and **section 5(3)** of the Trade Marks Act 1994 ("**the Act**"). Each ground is directed against all of the goods under the applications.

4. The **section 5(2)(b)** claims rely on each of the five of the Earlier Marks.

5. The **section 5(3)** claims are made relying only on the Earlier Marks "SNAP" and "SNAPCHAT".

6. **The Earlier Marks:**

   (i) UKTM 3404987: **SNAPCODE**

   Filing date: 6 June 2019 Registration date: 20 September 2019

Class 9: *Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; downloadable software; digital emblems, namely, downloadable graphics or images; digital emblems encoded with data, namely, downloadable graphics or images encoded with data; software for generating emblems in the nature of encoded data for printing or electronic display; software for reading printed or digital emblems in the nature of encoded data; software for importing encoded data from printed or digital emblems; software for displaying digital emblems in the nature of encoded data; interactive software; software enabling users to design interfaces; multimedia software; media and publishing software; media content; downloadable media; media streaming software; digital media streaming devices; downloadable multimedia files; multimedia apparatus and instruments; audiovisual apparatus and instruments; data storage devices and media; devices for streaming media content over local wireless networks; computer software for the display of digital media; computer software platforms for social networking; application software for social networking services via internet; parts and fittings for all the aforesaid goods.*

Class 42: *Scientific and technological services and research and design relating thereto; industrial analysis and industrial research services; design and development of computer hardware and software; providing online tools that give users the ability to create digital emblems, downloadable graphics and images; computer services, namely, providing an interactive mobile application featuring technology that allows users to manage their online photograph and social*

networking accounts; providing online web facilities (software and applications) for managing and sharing online photographs, videos, text, music and digital content; providing graphics, text and other information in the field of software and applications from searchable indexes and databases, by means of the internet and communication networks; software as a service [SaaS]; hosting services, software as a services, and rental of software; consulting services in the field of software as a service [SaaS]; hosting of websites, podcasts, databased, weblogs, videocasts, multimedia entertainment content, educational content, web portals, digital content, memory space for websites, websites for others; server hosting; hosting of communication platforms on the internet; hosting of website portals; providing interactive tools via a global computer network for use in the fields of social networking and social introduction; information, advisory and consultancy services relating to the aforesaid

(ii) UK TM No. 3390820: **SNAP ORIGINALS**

Filing date: 9 April 2019 Registration date: 19 July 2019

Class 9: *software for streaming audiovisual and multimedia content by the Internet*

(iii) UK TM No. 912925971: **SNAPCHAT**

Filing date: 30 May 2014 Registration date: 22 October 2014

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 for use as an application programming interface (API); computer software in the nature of an 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, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks*.

Class 38: *Telecommunications services, namely, electronic transmission of data, messages, graphics, images and information; peer-to-peer photo sharing services, namely, electronic transmission of digital photo files among internet users; providing access to computer, electronic and online databases; providing online forums for communication, namely, transmission on topics of general interest; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, and images; telecommunications services, namely, electronic transmission of photos and videos*.

Class 41: *Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content*.

Class 42: *Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site featuring technology that allows users to manage their online photograph and social networking accounts; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, providing a web site 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 information from searchable indexes and databases of information; 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 services, namely, hosting online web facilities 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, linking, sharing or otherwise providing electronic media or information over communication networks; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information; providing information on topics of general interest from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; 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 user-specified information, personal profiles, audio, video, photographic images, text, graphics and data.

Class 45: *Internet based social introduction and networking; providing online computer databases in the fields of social networking and social introduction*.

(iv) UK TM no. 917436411: **SNAP** ("**the 411 Mark**")

Filing date: 4 November 2017 Registration date: 10 May 2018

Class 42: *Providing information and advice regarding secure electronic communication*.

Class 45: *Internet based social introduction and networking services; providing computer databases via the Internet in the fields of social networking and social introduction; licensing of intellectual property, namely, user created avatars, graphical icons, symbols, fanciful designs, comics, phrases, and graphical depictions of people, places and things; identification verification services, namely, providing authentication of personal identification information*.

(v) UK TM no. 3268553: **SNAP** ("**the 553 Mark**")

Filing date: 6 November 2017 Registration date: 16 March 2018

Class 42: *Hosting digital content and providing online web facilities for managing and sharing online photographs, videos, text, music and digital content; providing photographic images, videos, music, audio, music, text, graphics, and other*

information from searchable indexes and databases, by means of the internet and communication networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; 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, editing, modifying, posting, displaying, linking, sharing, transmission or otherwise providing photographs, videos, music and electronic media or information over the internet and communication networks; providing temporary use of non-downloadable software applications for photo and video sharing; providing software as a service (SAAS) for processing electronic payments; providing electronic computer generated codes to identify products and process electronic payments; providing electronic verification of on-line orders of digital content and generating electronic permission codes which then allow users to access digital content; providing temporary use of on-line non-downloadable authentication software for controlling access to and communications with computers and computer networks..

7. **The section 5(2)(b) claim**: For the purposes of this ground, the Opponent relies on each of the five Earlier Marks insofar as they are registered for goods in Class 9 or services in Class 42. In its statements of grounds, the Opponent's expresses its objections under section 5(2)(b) in broad terms, grouping together all of its Earlier Marks. The Opponent submits that:

(i) both of the Applicant's marks are "highly similar" visually, aurally and conceptually, to all five of the Earlier Marks;

(ii) the applied-for goods are "identical or highly similar to the goods and services covered by the Earlier Marks."

(iii) "the identity and similarity is clear insofar as the Opponent is relying on Class 9";

(iv) "… terms such as "design and development of computer hardware and software" in class 42 would be similar to terms such as "cameras" and "microphones" in class 9 of the application" because those goods can be seen as computer hardware, or at least would interact with pieces of computer hardware" and "would be provided by the same party", and "in many cases" would be complementary;

(v) as a result of (i) – (iv) above, there exists a likelihood of confusion on the part of the public, including the likelihood of association.

8. **The section 5(3) claim**: For the purposes of this ground, the Opponent relies on all the goods and services listed above under its SNAP and SNAPCHAT marks. The Opponent states that it "has developed a massive reputation in respect of its SNAP and SNAPCHAT trade marks" throughout the UK and the European Union in relation to its core social networking and entertainment services." It states that the Opponent has spent "a great deal of time, effort and money to develop its brand and create a reputation in its SNAP and SNAPCHAT marks" which is "young, trendy, cool and high tech". It claims that the reputed marks will be brought to mind and that use of the Applicant's trade marks "would, without due cause, take unfair advantage of the distinctive character or repute of the earlier trade marks."

The Applicant's defence

9. The Applicant filed a notice of defence and counterstatement, from which I note the following points.

i. It denies that each of the (undifferentiated) Earlier Marks is highly similar to the applied-for marks.
ii. Given the very limited degree of particularisation of what is alleged to be identical or similar, the Applicant did not admit the claims based on the Class 9 goods.
iii. It denies the similarity claimed between "cameras" and "microphones" in class 9 of the application and the Opponent's "design and development of computer hardware and software" services in Class 42.[1]
iv. It denies a likelihood of confusion.
v. It did not admit the claimed reputation in the UK in relation to "social networking and entertainment services."
vi. It requested proof of the claimed reputation in respect of both SNAP and SNAPCHAT.
vii. It denied that use of the applied-for trade marks would give rise to any of the damaging consequences claimed.

1 I note that this term, singled out in the statement of grounds to illustrate the claimed similarity, appears only in the specification in respect of the Earlier Mark SNAPCODE.

viii. It requested proof of use in relation to the Earlier Mark SNAPCHAT in respect of the goods and services relied upon in classes 9 and 42.

Representation Papers filed and hearing

10. The Applicant is represented by J A Kemp LLP; the Opponent by Stobbs. Only the Opponent filed evidence, to which this decision refers to the extent warranted. A hearing was held by Teams video conference on 24 October 2023. Stephanie Wickenden of counsel attended for the Applicant; Julius Stobbs for the Opponent. Both parties filed helpful skeleton arguments ahead of the hearing. I make this decision having read all of papers filed and taken account of the oral submissions made at the hearing.

PROOF OF USE

11. Of the five Earlier Marks, only SNAPCHAT had been registered long enough at the filing date of contested applications to engage the use conditions under section 6A of the Act. In its defence Form TM8, the Applicant requested that the Opponent provide proof of use of the Earlier SNAPCHAT Mark in respect of the goods and services relied upon in classes 9 and 42. By the time of the hearing, the Applicant accepted that the evidence filed established that genuine use; consequently, the Opponent is able to rely on all five of the Earlier Marks without consideration of use.

THE EVIDENCE

12. While the question of genuine use of the SNAPCHAT mark had been resolved by the Applicant's concession by the time of the hearing, the evidence is of course also required to establish the claimed reputations in respect of the Earlier Marks SNAP and SNAPCHAT, and may also be considered in the assessment of distinctive character of the Earlier Marks. Given its potential relevance for both of those purposes, I find it convenient to my overview of the evidence at this point of this decision.

13. The Opponent's evidence is a Witness Statement of Matthew Stratton, dated 5 January 2023, together with Exhibits MS1 – MS9. Mr Stratton is Associate General Counsel and Director at the Opponent, and gives his evidence to establish the claimed reputation in respect of its Earlier Marks SNAP and SNAPCHAT.

14. I note that the very first page of the first exhibit is an extract a webpage from investor.snap.com from January 2021, where the headline on that extracted page reads “Snap Inc. is a camera company.”[2] I also note that none of evidence has been challenged by the Applicant during the evidence rounds. The headline assertion at that page could potentially be a useful point in favour of the Opponent in the context of the contested goods of the Applicant. However, I firstly note that there is little in the exhibited investor presentation to suggest that its content was directed to, or reached, the UK consumer (though I acknowledge that there was UK Press coverage of the highly profitable launch of shares in the Opponent as a publicly traded company).[3] Secondly, I do not regard the bold opening headline that “Snap Inc. is a camera company” as sufficient to establish the asserted point as fact or to establish the perception of the UK consumer. That headline is followed by the words “We believe that reinventing the camera represents our greatest opportunity to improve the way people live and communicate. We contribute to human progress by empowering people to express themselves, live in the moment, learn about the world, and have fun together.” In my view, these extracted headlines are more in the way of publicity tags to attract share purchases, rather than a simple statement of descriptive fact in the way that say, “Nikon is a camera company” would be (and would be perceived to be by the UK consumer).

15. Whereas brands such as Nikon, Canon and Leica sell cameras, camera components and accessories, the evidence in the present case shows that the Opponent developed the multimedia messaging app “Snapchat”. Exhibit 1 shows the Wikipedia entry for SNAPCHAT, which identifies that one of its principal features is that pictures and messages are usually available only for a short time before they vanish, becoming inaccessible to their recipients. The images and/or messages shared are known as “snaps”. Snaps may be overlaid with filters and stickers to enhance or to add comic visual effects.

16. Mr Stratton himself refers to the Snapchat mobile app as being among the top multimedia messaging and photo and video sharing applications the world. He states that, as of September 2020, over 4 billion snaps were created every day on average

2 A similar investor presentation is shown more fully at Exhibit 2.
3 Exhibit MS4.

and that, as of September 2021, there were over 300 million daily active users. These appear to be global figures. He states that over 75% of the population aged between 13 and 34 years in the USA uses Snapchat and that "as of October 2022 the same statistics applied to the UK."

17. Mr Stratton states that Snapchat has "one of the most used cameras in the world." This seems to me a slightly strained and unnatural way of describing the situation. I accept that there is ample evidence to show the very great success of SNAPCHAT as a camera app, photo and video content sharing app, with consequential advertising and entertainment purposes (and revenues). However, it seems that the actual camera being used is that on whatever smart mobile phone that a user happens to own. This conclusion accords with the nature of the goods and services that are specified under the SNAPCHAT and SNAP registrations.

18. Mr Stratton states that in September 2016 Snapchat Inc was renamed to Snap Inc. He states that this change coincided with Snap's first hardware product named "Spectacles", which smart-glasses featured a built-in camera. The evidence shows no reputation for those goods in the UK, and nor are such goods anyway specified for protection under the Earlier Marks relied on under section 5(3). He states that "the rebrand and dedication to the SNAP house mark was intended to better reflect Snap's expanding fleet of product and services offerings" and that the Opponent "has a family of well-known SNAP marks which are used under the SNAP brand, namely SNAP ORIGINALS, SNAP ADS, SNAP KIT, SNAPCODE, SNAP PARTNER SUMMIT, SNAP MAP, SNAP, SNAP GAMES and SNAP PIXEL." Mr Stratton's evidence also refers to SNAP CAMERA.[4] The nature of some of those offerings is outlined at Exhibit MS3, and I note that "Snap Camera" is described as a free application designed for use on a desktop device – it is not a camera as such. It was introduced in October 2018, but no information is provided about the extent to which it has been adopted in the UK. "Snap Originals", also introduced in October 2018, are TV-like shows, including comedy, thrillers and docuseries. Again, no information is provided about the extent of its uptake in the UK.

4 Paragraph 11(j)

RELEVANCE OF EU LAW

19. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts, such as the General Court and the Court of Justice of the European Union ("**CJEU**").

THE SECTION 5(2)(B) CLAIM

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

> "A trade mark shall not be registered if because–
>
> …
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,
>
> there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

21. The Opponent's trade mark registrations were all filed before the filing dates of the Applicant's trade marks, and all therefore qualify as an "earlier trade mark" for the purposes of section 5.[5]

22. An assessment under section 5(2)(b) is multi-factorial and the claim must be determined in light of the following principles, which 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.*

5 Section 6 of the Act.

Laudato & C. Sas v OHIM, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P. The relevant principles are:

(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 the goods and services

23. Section 60A(1)(a) of the Act provides that for the purpose of the Act goods and services are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

24. It is a well-established principle that goods (or services) can be considered as identical when the goods (or services) designated by trade mark application are included in a more general category designated by the earlier mark, or vice versa.[6]

25. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[7]

i. the physical nature of the goods;

ii. their intended purpose;

iii. their method of use / uses;

iv. who the users of the goods and services are;

v. the trade channels through which the goods reach the market;

6 See for instance the judgment of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05

7 See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

vi. in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and

vii. whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);

viii. whether they are complementary to each other. Complementary has been described as meaning that *"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"*.[8] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity.[9] Complementarity should be distinguished from 'use in combination', where goods are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses[10]) but are not essential or important to one another's use such that they would be assumed to share source.

26. I bear in mind too that when interpreting terms in a specification that it is *"necessary to focus on the core of what is described* [... and that] *trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise",* although *"where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods* [and services] *in question"*.[11]

27. For the purposes of making a comparison, goods can be grouped together where the same reasoning applies.[12]

8 *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82
9 *Kurt Hesse v OHIM, Case C-50/15 P*
10 As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited,* BL-0-255-13 - *"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."*
11 *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), paragraphs 11 - 12
12 *Separode Trade Mark* BL O/399/10, paragraph 5

The parties' goods and services

28. The Applicant's defence position is that it admits that some of the applied-for goods are at least similar to some elements of the specification relied on by the Opponent in respect of the Earlier Mark "SNAPCODE", while others are not similar.

29. However, the Applicant denies that the applied-for goods are similar to any of the goods and services relied upon under the Earlier SNAP, SNAPCHAT, and SNAP ORIGINALS Marks. If I find that to be so, it inevitably follows that there can be no likelihood of confusion, irrespective of any similarity of those marks (which, in any event the Applicant denies). Since a finding of no similarity between the goods and services will defeat the section 5(2)(b) opposition based on those Earlier Marks, I reproduce the respective specified goods and services in the tables below to assess whether any similarity exists. For ease of consideration, the table groups the Applicant's goods according to their own similar natures, slightly re-ordering the goods as listed in the specification of the application.

Applied-for Goods
Class 9: **a.** *Cameras; digital still and motion cameras;* **b.** *camera mounts; mounting devices for cameras and monitors; camera tripods;* **c.** *photography appliance bags and cases; camera cases; cases for camera lens;* **d.** *portable rechargers; wireless charging devices; batteries; batteries for cameras; auxiliary battery packs;* **e.** *lens filters [for cameras]; light filters for cameras; LCD protective film for digital cameras; protective film for portable multimedia players;* **f.** *microphones;* **g.** *wearable activity trackers; target trackers [electronic].*

Goods of Earlier Mark - **SNAP ORIGINALS**
Class 9: *software for streaming audiovisual and multimedia content by the Internet* The above goods may overlap with the applied-for goods insofar as a consumer who uses *digital still and motion cameras* and *microphones* may also use the above software "for streaming audiovisual content by the Internet" (to others). However, the goods differ in physical nature, intended purpose, method of use / uses, trade channels, are not found on the same shelves in shops, are not in competition and are not complementary as conceived in trade mark case law. Overall, I find that none of the applied-for goods listed at a. – g. above is similar to the goods under SNAP ORIGINALS.
Goods and Services of Earlier Mark – SNAPCHAT
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 for use as an application programming interface (API); computer software in the nature of an 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, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks*. **Class 42:** *Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site*

featuring technology that allows users to manage their online photograph and social networking accounts; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, providing a web site 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 information from searchable indexes and databases of information; 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 services, namely, hosting online web facilities 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, linking, sharing or otherwise providing electronic media or information over communication networks; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information; providing information on topics of general interest from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; 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 user-specified information, personal profiles, audio, video, photographic images, text, graphics and data.

The Opponent's goods in Class 9 above include "*Downloadable computer software for modifying the appearance and enabling transmission of photographs".* Such goods may overlap with the applied-for goods insofar as a consumer who uses *digital still and motion cameras* may also use the above software "*for modifying the*

appearance of photographs." There is a connection between digital cameras and software that facilitates changing the look of a digital photograph, but I am not satisfied that customers would anticipate that responsibility for such goods lies with the same undertaking. I therefore doubt that the goods are complementary in the trade mark sense. The goods differ in physical nature, intended purpose, method of use / uses, trade channels, are not found on the same shelves in shops, are not in competition or complementary.

Overall, I find that none of the applied-for goods listed at a. – g. above is similar to the goods under SNAPCHAT. However, if the overlap I describe above is sufficient to warrant a finding of similarity to some degree between the Applicant's goods at a. above – namely, *cameras*; *digital still and motion cameras* – the degree of similarity is low at best.

None of the other goods or services under the SNAPCHAT registration improve the Opponent's position. For instance, the Opponent's services in Class 42 include *providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs.* These software services are no more similar than the software goods in Class 9, and as services, differ in essence (nature) from the goods of the Applicant.

Services of Earlier Mark – SNAP (411)

Class 42: *Providing information and advice regarding secure electronic communication*.

These services are not in any way similar to any of the applied-for goods.

Services of Earlier Mark – SNAP (553)

Class 42: *Hosting digital content and providing online web facilities for managing and sharing online photographs, videos, text, music and digital content; providing photographic images, videos, music, audio, music, text, graphics, and other information from searchable indexes and databases, by means of the internet and communication networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; 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, editing, modifying, posting, displaying, linking, sharing, transmission or otherwise providing photographs, videos, music and electronic media or information over the internet and communication networks; providing temporary use of non-downloadable software applications for photo and video sharing; providing software as a service (SAAS) for processing electronic payments; providing electronic computer generated codes to identify products and process electronic payments; providing electronic verification of on-line orders of digital content and generating electronic permission codes which then allow users to access digital content; providing temporary use of on-line non-downloadable authentication software for controlling access to and communications with computers and computer networks.*.

These services are not in any way similar to any of the applied-for goods, and the Opponent provided no convincing explanation to support the claim. For the sake of clarity I do not consider even "*providing online web facilities for managing and sharing online photographs, videos* .." sufficient to give rise to a finding of similarity even with the applied-for *digital cameras* – still less any other of the applied-for goods.

Class 42: *Providing information and advice regarding secure electronic communication*.

30. I turn now to consider the goods and services under the Earlier Mark "SNAPCODE". Ms Wickenden noted that the goods and services the Opponent relies upon are extensive, yet the Opponent's pleadings particularise alleged identity and/or similarity of the goods and services only as I recorded at paragraph 7(iii) and (iv) above.

Cameras; digital still and motion cameras; microphones

31. The Applicant conceded that there is a medium level of similarity between Applicant's Goods ""*Cameras; digital still and motion cameras; microphones*" and the following goods the Opponent relies upon in relation to the Earlier SNAPCODE Mark under class 9: "*apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; multimedia apparatus and instruments; audiovisual apparatus and instruments*." It seems to me that although the terms of the Opponent's specification are more expansively expressed, they designate a more general category that would not be strained to include "*Cameras; digital still and motion cameras; microphones*" and may therefore be considered **identical** based on the established case law principle.

batteries for cameras; lens filters [for cameras]; light filters for cameras; LCD protective film for digital cameras; protective film for portable multimedia players

32. The Applicant also accepts that there is a medium level of similarity between Applicant's Goods "*batteries for cameras; lens filters [for cameras]; light filters for cameras; LCD protective film for digital cameras; protective film for portable multimedia players"* and the following goods the Opponent relies upon in relation to the Earlier SNAPCODE Mark under class 9: "*parts and fittings for: apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; multimedia apparatus and instruments; audiovisual apparatus and instruments*". I find these goods are at least similar to a medium degree, but may again be considered to be **identical** based on the inclusion principle under case law.

"**Camera Accessory Goods**": *camera mounts; photography appliance bags and cases; mounting devices for cameras and monitors; camera cases; cases for camera lens; camera tripods*

33. The Applicant denies that the above applied-for Camera Accessory Goods are similar to any of the goods and services covered by the Earlier SNAPCODE Mark. Ms Wickenden submitted that the above goods are dissimilar to the Opponent's goods referenced at paragraphs 31 and 32 above, arguing that the Camera Accessory Goods are distinct and separate from the camera itself, and are therefore not "*parts and fittings*" thereof. Nor are they electronic items or fittings, and the average consumer will not consider that such goods and services originate from the same undertaking.

34. I agree that the Camera Accessory Goods differ in nature, purpose, method of use and are not in competition with cameras (i.e. the Opponent's *photographic apparatus and instruments; apparatus and instruments for recording, transmitting, reproducing images*). However, I find that there is an inevitable connection between the Opponent's photographic instruments and fittings and the applied-for Camera Accessory Goods, since they would be sold in the same specialist shops (camera stores) and have camera users in common. In my view, there is at least a **low degree** of similarity. Moreover, the Opponent relies on its SNAPCODE registration in respect of *computer peripheral devices*. It seems to me that this term could encompass "*camera mounts*" and "*mounting devices for cameras and monitors"* which, case law would therefore cast as **identical**.

"**Generic Electronic Goods**": *portable rechargers; wireless charging devices; wearable activity trackers; target trackers [electronic]; auxiliary battery packs; batteries*

35. The Applicant denies that the applied-for **Generic Electronic Goods** are similar to any of the goods and services covered by the Earlier SNAPCODE Mark. Ms Wickenden submitted that the Generic Electronic Goods are distinct and separate from the camera itself, and the respective use for such items self-evidently is not connected to photography, further differentiating these goods from the Opponent's. I largely agree with that analysis. However, it is also the case that *auxiliary battery packs; batteries* could include "*batteries for cameras"*, for which the Applicant has admitted at least a medium degree of similarity to *parts and fittings for apparatus and instruments for recording, sound or images.* There is therefore some logic in finding that the wider terms *auxiliary battery packs; batteries* are likewise at least similar to a **medium**

degree. I agree that there is no similarity in respect of *portable rechargers; wireless charging devices; wearable activity trackers; target trackers [electronic].*

The other goods and services relied on

36. I note that Skeleton Argument of the Applicant refers to "SNAP formative marks", and in its table of comparison of goods and services, listed goods in Class 9 under UK trade mark No. 3631211 "SNAP MAP". It is my understanding that the inclusion of the SNAP MAP specification is simply an error, since it is not one of the Earlier Marks relied on. (That said, I note that the Skeleton Argument also refers to SNAP MOJI as being among the Opponent's Earlier Rights, which again is not an Earlier Mark relied on and is not relevant to these proceedings.)

37. Elsewhere in the Applicant's skeleton argument, and at the hearing, it was argued that similarity arises in respect of the "applied-for camera and camera-related terms", based on the specification under the SNAPCODE mark of *downloadable software*. The significance of this line of argument is very limited, since I have already found some of the applied-for goods to be identical or similar to terms under the SNAPCODE registration, and I find there is no other term under the SNAPCODE specification that further advances or strengthens the Opponent's attack.

38. For completeness, however, I note that in support of its position, the Applicant submitted that "the modern camera is controlled by software, such that the goods are complementary and would be sold to the same end user by the same party." The Applicant cited several first instance decisions of the EUIPO in support of that argued similarity.[13] In my view, the Opponent's *downloadable software* and the applied-for *Cameras; digital still and motion cameras* are not similar goods. They differ in nature, method of use, purpose, are not in competition, and are not sold on the same shelves. While I of course acknowledge that a digital camera incorporates software, the Opponent has not filed evidence that demonstrates that it is usual for manufacturers of digital cameras to also produce downloadable software. Alternatively,

13 *EU Opp B3152425 JK Imaging v Pixpro; EU Opp B3159759 Sharp v Wuhan Guide Sensmart Tech*; *EU Opp B3159727 Altair Engineering v Hangzhou Jing Drive; EU Opp B3158403 TITAN Technology v Sungrow Power Supply.*

acknowledging that the latter could include, for instance, *Downloadable computer software for modifying the appearance and enabling transmission of photographs* (which goods I have considered previously), if there is a degree of similarity, based at least on shared users (digital photographers), I find the level of similarity between the applied-for goods at a. above (*cameras*; *digital still and motion cameras*) and the Opponent's *downloadable software* to be no more than low. I find that none of the applied-for goods listed at b. – g. above is similar to the software goods under SNAPCODE.

39. Although the Opponent claimed to rely on all of the numerous other goods and services covered by the Earlier SNAPCODE Mark, it did not particularise the basis of the claimed similarity in its pleadings nor elaborate the claims at the hearing, beyond the points that I have mentioned. I find that none of those remaining goods or services to be similar to the applied-for goods.

Consequences of my findings on similarity of the goods and services

40. Since some similarity of goods or services is a required constituent element of a section 5(2)(b) objection, the claims under this ground may proceed based on the Earlier Marks, only to the following extent:

i. SNAP ORIGINALS – in the absence of any similarity of goods/services, this Earlier Mark cannot sustain the opposition claim;

ii. SNAPCHAT - this Earlier Mark remains to be considered further in support of the section 5(2)(b) opposition claim, at best, only in respect of the applied-for *cameras*; *digital still and motion cameras* based on a possible low degree of similarity with this Earlier Mark's *Downloadable computer software for modifying the appearance and enabling transmission of photographs.*

iii. SNAP – in the absence of any similarity of goods/services, these Earlier Marks (411 and 553) cannot sustain the opposition claim.

iv. SNAPCODE – this Earlier Mark remains to be considered further in support of the section 5(2)(b) opposition claim, in respect of the following applied-for goods that are identical or similar (at least to a low degree) to the Opponent's specified goods:

Cameras; digital still and motion cameras; microphones; batteries for cameras; lens filters [for cameras]; light filters for cameras; LCD protective film for digital cameras; protective film for portable multimedia players; camera mounts; photography appliance bags and cases; mounting devices for cameras and monitors; camera cases; cases for camera lens; camera tripods; auxiliary battery packs; batteries

The following goods are not similar to any of the goods/services under any of the Earlier Marks: *portable rechargers; wireless charging devices; wearable activity trackers; target trackers [electronic].* These goods therefore survive the opposition insofar as it is based on section 5(2)(b) of the Act.

The average consumer and the nature of the purchasing act

41. Trade mark questions must be approached from the point of view of the presumed expectations of the average consumer - a legal construct who is reasonably well informed and reasonably circumspect; "average" denotes that the person is typical.[14] It is necessary to determine who is the average consumer for the respective goods and services and how the consumer is likely to select them. 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.[8]

42. In the present case, the average consumer of the goods that I have found to be identical or similar (broadly camera and photography equipment) will be a member of the public at large who uses photographic goods (whether recreationally or professionally). When selecting the goods and services at issue, the average consumer will take into account factors such as size, portability, functionality, capacity and compatibility. Some of the goods may be costly, other not expensive. They are generally not goods likely to be purchased repeatedly or routinely and I find that, even for the cheapest, more ancillary goods, the average consumer is likely to pay at least a medium level of attention to the selection of the goods. In the purchasing process, the trade marks may likely be seen on websites, advertising material, on packaging and on the goods themselves. Visual considerations will be most important, though I

14 Per Birss J (as he then was) 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), paragraph 60.

bear in mind that the goods and services may sometimes be the subject of word-of-mouth recommendations and, therefore, aural considerations are also relevant.

Distinctive character of the Earlier Trade Marks

43. Registered trade marks possess varying degrees of inherent distinctive character - ranging from low because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. A greater degree of distinctiveness of an earlier mark may tend to increase the likelihood of confusion. In *Lloyd Schuhfabrik* 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 …*
>
> *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)."*[15]

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services specified in the registration and, secondly, by reference to the way it is perceived by the relevant public.[16] As an overlay observation to this standard account of the case law, it seems to me logical that the distinctive character of the

15 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97.
16 *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

Earlier Trade Mark is only relevantly assessed in respect of such goods and services in the registration that are at least similar to at least some of the contested goods of the Applicant.

45. SNAPCHAT –The Mark "SNAPCHAT" appears to be an invented coinage, albeit a portmanteau of two ordinary English words. While it may be allusive in respect of communications apps involving photographs, in respect of *Downloadable computer software for modifying the appearance and enabling transmission of photographs*, which is the term on which a degree of similarity may be based, the Mark "SNAPCHAT" is inherently distinctive. Moreover, its distinctive character for those registered similar goods has been enhanced by virtue of its extensive use in the UK, such that "SNAPCHAT" is very highly distinctive in respect of *Downloadable computer software for modifying the appearance and enabling transmission of photographs.*

46. SNAPCODE – The Mark "SNAPCODE" appears to be an invented coinage, albeit a portmanteau of two ordinary English words. The registered goods on which a degree of similarity may be based are *apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; multimedia apparatus and instruments; audiovisual apparatus and instruments; photographic apparatus and instruments; parts and fittings for apparatus and instruments for recording, sound or images* and – on a possibly overstretched assessment of similarity - *downloadable software*. For these goods the Mark "SNAPCODE" is inherently distinctive to a medium degree, the word being a confection of two ordinary English words, one of which is highly allusive in respect of photographic goods. I noted no reference to the Earlier Mark "SNAPCODE" in the evidence filed, and I do not consider that its distinctive character has been shown to have been enhanced.

Comparison of the marks

The relevant Earlier Marks	The Applicant's Marks
SNAPCODE	SNAP G

SNAPCHAT	

47. As the case law principles make clear,[17] 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.

48. The overall impression of the Applicant's plain word mark is simply that it is the word "SNAP" followed by the separate letter "G". With regard to the overall impression of the Applicant's figurative mark, it is possible that the average consumer would perceive that too as the word SNAP followed by a stylised G. However, the manner of stylisation of the G in the figurative mark is such that I am doubtful that it would readily be perceived as that letter. It more closely appears as the sort of symbol that signifies "Play" on a digital electronic device; the up-stem on the lower right, with the small circle at its top interferes with that symbol, but I am not sure that the device successfully conveys the intended impression of a letter G.

49. In any event, I find that the dominant element of both of the Applicant's marks is "SNAP" - it is the first and longer part of the marks and is a familiar and instantly meaningful English word. The G elements, whether perceived as that letter or as a symbol device, are much smaller. The SNAP element is also more distinctive than the less meaningful, single letter G (or device), though in connection with photographic goods I consider it to be allusive and of low distinctive character (in line with my consideration below of the conceptual similarity of the marks).

50. The overall impression of the Earlier Mark "SNAPCODE" is that it is the result of the combination of two ordinary English words "SNAP" and "CODE". It is an unusual term, and the overall impression lies in the (invented) word as a whole, neither component dominating.

17 Paragraph 22 above.

51. The overall impression of the Earlier Mark “SNAPCHAT” is that it is the result of the combination of two ordinary English words “SNAP” and “CHAT”. It is an unusual (invented) word, and the overall impression lies in the coinage as a whole, neither component dominating.

SNAPCODE comparison:

52. The marks share the identical opening component “SNAP”, but visually, whereas SNAPCODE, is a single continuous mark of 8 letters, the applied-for marks comprise two distinct components – “SNAP” and “G” /  - which total 5 letters. The second half of the Earlier Mark, “CODE”, is absent from the applied-for marks and the G component (including the figuration) is absent from the Earlier Mark. The Applicant submits that the applied-for marks have at most similar a low level of visual similarity, to the Earlier SNAPCODE Mark. Taking account of the overall impressions, the dominance in the applied-for marks of the shared element, and the differences I have listed, I find the **visual similarity is lower than medium**.

53. The marks share the identical opening component “SNAP”, but the second syllable of the applied-for marks will be spoken as “JEE”. If the device is not recognised as a figurative letter, it will not be spoken at all. Ms Wickenden highlighted the difference in pronunciation from the Earlier Mark’s “code” as being distinct and contrasting because the applied-for marks ends with a vowel sound (“ee”), whereas “SNAPCODE” ends with a blunt and recognisable voiced consonant (“d”). The Applicant submits that the applied-for marks have at most a low level of aural similarity to the Earlier SNAPCODE Mark. Taking account of the overall impressions and the dominance in the applied-for marks of the shared element, and the differences listed, I find the **aural similarity is no more than medium**.

54. On the conceptual comparison of the respective marks, Ms Wickenden submitted that:

    i. “SNAP” is a common English word whose meanings include a game, a photograph or something breaking or instantaneous;

ii. Coupling “SNAP” with the second component, “G” /  , produces a construction which “in the first instance has no ordinary meaning, or may allude to the Applicant’s Goods”;

iii. Whilst the average consumer would discern the common English words “SNAP” and “CODE in the Earlier SNAPCODE Mark, the conjoined form has no ordinary meaning.

55. I consider those to be reasonable submissions, though I would add that in the context of the applied-for goods, the word SNAP would most likely carry the photographic connotation of the word. Ms Wickenden concluded that the marks are conceptually neutral or share a low level of similarity. I find that taking account of the overall impressions and the dominance in the applied-for marks of the shared element, there is some similarity based on that word, though the additional word “CODE” contributes its own concept, introducing some conceptual difference. Overall **the conceptual similarity is lower than medium**.

SNAPCHAT comparison:

56. The **visual** similarity in respect of SNAPCHAT is **lower than medium** for the reasons set out in paragraph 53 above mutatis mutandis.

57. The **aural** similarity in respect of SNAPCHAT is **no more than medium** for the reasons set out in paragraph 54 above, mutatis mutandis, where CHAT will be pronounced with the distinct vowel “ah” and ending with an abrupt and recognisable “t”.

Conceptually, the Earlier SNAPCHAT Mark comprises two common English words “SNAP” and “CHAT”, the conjoined form having no ordinary meaning. Ms Wickenden submitted that SNAPCHAT is “descriptive” when used in relation to the Opponent’s main software product that allows consumers to alter photographs and add text,[18] and that the marks are conceptually dissimilar, or share a low level of similarity. I find that taking account of the overall impressions and the dominance in the applied-for marks of the shared element, there is some similarity based on that word, though the

18 *Downloadable computer software for modifying the appearance and enabling transmission of photographs* being the only arguable point of similarity of goods.

additional word “CHAT” contributes its own concept, introducing some conceptual difference. Overall **the conceptual similarity is lower than medium**.

Conclusion on likelihood of confusion

58. There are two possible types of confusion – direct and indirect - as explained in the much quoted passage from the decision of Iain Purvis QC (as he then was), sitting as the Appointed Person in the *L.A. Sugar* appeal case:[19]

> “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 recognised 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).

19 L.A. Sugar Limited v Back Beat Inc, BL O/375/10

(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).”

59. It is well understood that the above example instances are not exhaustive, but are intended to be illustrative of the general approach to provide helpful focus.

60. In *Liverpool Gin* Arnold LJ approved Mr Purvis’s formulation but added:

> “13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] ‘a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”[20]

61. Deciding whether there is a likelihood of confusion is not based on simply applying a formula and seeing what comes out at the end; rather, it requires a global assessment of all relevant factors in accordance with case law principles, especially those outlined at my paragraph 22 above. The factors are interdependent and include the consideration that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services, and vice versa. It is also necessary for me to keep in mind the distinctive character of the Opponents’ trade marks, the average consumer for the services and the nature of the purchasing process. I must also note that the average consumer

20 *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

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

62. It is perhaps worth recapping my findings as follows:

(i) The average consumer is a member of the general public paying a medium degree of attention in the purchasing decision, where visual considerations are most important.

(ii) The visual and conceptual similarity of both SNAPCODE and SNAPCHAT - as compared against SNAP G /  - is lower than medium, even though the dominant element of both of the Applicant's marks is "SNAP". The aural similarity is no more than medium.

(iii) The overall impression of both of the Earlier Marks rests in their coined combinations of two ordinary English words. The overall impression of the Applicant's marks is of the word "SNAP" followed by the separate letter "G" / device.

(iv) Of the applied-for goods, a likelihood of confusion remains to be considered under the SNAPCHAT mark only in respect of "*cameras*; *digital still and motion cameras"* and that assessment is based only on the possibility that there could be a low degree of similarity with SNAPCHAT's *Downloadable computer software for modifying the appearance and enabling transmission of photographs*, in respect of which goods SNAPCHAT is very highly distinctive.

(v) A likelihood of confusion remains to be considered under the SNAPCODE mark in respect of most of the applied-for goods. Some of the applied-for goods are similar to goods in the specification relied on, and some of the goods are identical - such as the applied-for *Cameras* and the Earlier Mark's *photographic apparatus and instruments,* in respect of which goods SNAPCODE is inherently distinctive to a medium degree.

63. I bear in mind 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. Taking all factors into account, I find that there is no likelihood of confusion. Visually, the overall impressions of the applied-for Marks – involving two separate components, totalling five letters - are sufficiently different from the 8-letter single words of the two Earlier Marks to prevent a consumer mistaking them. I acknowledge that case law has indicated that consumers tend to pay more attention to the beginning of trade marks, but that is at best a rule of thumb and although all marks begin with the same four letters, I consider the shared element - "SNAP" - to be of low distinctive character in connection with photographic goods.

64. Nor do I consider that the circumstances give rise to a "proper basis" to conclude that a likelihood of *indirect* confusion arises. The marks coincide in an element with a low level of distinctiveness (though I recognise that the distinctiveness of the non-coinciding G element is just as low or lower (in itself). The overall impressions of the marks are different and I see no reason to conclude that the average consumer would be confused into believing that the goods and services come from the same undertaking or economically linked undertakings.

65. Whilst SNAPCHAT is very well known and highly distinctive as a multimedia messaging / photo and video sharing application, those goods are at best of low similarity to the applied-for camera goods. The common element in the marks is not so strikingly distinctive that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all; nor do the applied-for marks strike me as an "entirely logical" brand extension given the presence of the G/symbol, the omission of the CHAT element and presentation (the separated components) involved in the Applicant's marks.

66. The goods under SNAPCODE include some that are identical, and I have acknowledged the potential for a high degree of similarity of goods or services to offset a lower degree of similarity between the marks. However, I do not consider that consideration sufficient to create a likelihood of confusion in the present case. This Earlier Mark has no enhancement to its inherent medium degree of distinctiveness

and my reasoning against a likelihood of confusion as set out in the second sentence of the paragraph above likewise applies in respect of SNAPCODE.

67. **OUTCOME**: The opposition based on section 5(2)(b) fails.

THE SECTION 5(3) CLAIM

68. Section 5(3) of the Act is as follows:

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

69. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L'Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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 and/or services, the extent of the overlap between the relevant consumers for those goods and/or 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 that 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal*, paragraph 44.

g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods and/or 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 and/or services for which the earlier mark is registered, or a serious risk that this will happen in the future; *Intel*, paragraphs 76 and 77, and *Environmental Manufacturing*, paragraph 34.

h) 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.

i) 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 on the earlier mark; *L'Oréal*, paragraph 40.

j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal.*

70. The Earlier Marks relied on for the section 5(3) claims are SNAP and SNAPCHAT. There is clearly some similarity with the contested marks, as required under this ground. The next requirement is that the Earlier Marks must be shown to have had, at the 21 December 2021 filing date of the contested applications, a reputation in the UK in respect of the goods and services specified in the earlier registrations.

71. I will consider first the claim based on the Earlier SNAPCHAT Mark.

Reputation

72. I summarised the evidence of use in paragraphs 12-18 above (and considered enhanced distinctive character in paragraph 45). By the time of the hearing, the Applicant admitted the existence of a reputation for the Earlier SNAPCHAT Mark (though not for the SNAP Marks). There therefore appears no dispute with regard to the Opponent's claim that, by the filing date of Applicant's contested trade marks, it had developed a "massive reputation" in the UK in respect of its SNAPCHAT trade mark "in relation to its core social networking and entertainment services."

73. I do not consider it necessary to carry out a forensic assessment of the extent to which the evidence establishes the claimed reputation for all of the goods and services relied on in Classes 9, 38, 41, 42 and 45. It is enough that I find that the evidence readily establishes that SNAPCHAT known, by a significant part of the UK public,[21] as an enormously popular messaging and photo and video sharing software application and

21 See paragraphs 25 – 28 of the ruling of the CJEU in *General Motors Corp v Yplon SA*, Case C-375/97.

that the reputation certainly extends to SNAPCHAT's *Downloadable computer software for modifying the appearance and enabling transmission of photographs* in Class 9, which is the only basis for a possible finding of (low) similarity between the parties' goods. To succeed in an opposition based on a section 5(3) ground, it is not necessary that there be any similarity between the respective goods or services, but is a factor to be taken into account when considering whether the public, when confronted with the later SNAP G marks will make a mental link to the earlier reputed mark SNAPCHAT.

Mental Link

74. Will SNAPCHAT be called to mind if the public were to see the contested SNAP G marks used in respect of the Class 9 applied-for goods? The case law principles set out above make clear that to answer this question of whether a mental link exists requires a global assessment taking account of all relevant factors. In the Opponent's favour, the earlier mark SNAPCHAT has a very strong reputation in respect of its registered goods and services in the context of its messaging and photo/video sharing app. I have also found the marks to be visually, aurally and conceptually similar – though to degrees that are lower than medium, or no more than medium.

75. However, the degree of similarity between the respective the goods and/or services – to the extent that it exists at all, based on "*Downloadable computer software for modifying the appearance and enabling transmission of photographs"* – is low at best.

76. Nor, in my view, is there a great overlap between the relevant consumers for the respective goods and/or services, since although the reputed SNAPCHAT goods and services involve the manipulation and sharing of digital photos, the evidenced reality is that the reputation is founded on the prevalent use of smartphones, which invariably have their own in-built camera. The actual reputation is intrinsically attached to smartphone (or possibly mobile device) usage. I acknowledge that photographers are of course part of the general public, and that users of the SNAPCHAT app are drawn from the general public (especially a younger tranche), but the evidence has not shown a particular overlap between the users of the reputed goods / services and the applied-for goods – cameras and camera accessories and so on.

77. More significantly, the point of similarity between the marks is the word "SNAP", and I find this to be of low distinctive insofar as it is used in respect of camera goods. The average consumer is a member of the UK general public and will understand that one of the familiar meanings of the word is as "snapshot" – referring to a photograph – as, for example, in 'holiday snaps'.

78. While the two-word combination "SNAPCHAT" has become very highly distinctive as a software app for sending snaps or snapshots, I find that the relevant consumer will make no mental link between the parties' respective trade marks. The consumer will perceive the applied-for marks as highly allusive in respect of photographic goods and accessories. I agree with Ms Wickenden's submission that the common element "SNAP" alone will not be sufficient to call to mind "SNAPCHAT" outside of the Opponent's "*core social networking and entertainment services*".

79. I also agree with Ms Wickenden's submission that even if a mental link were made, the Opponent has not established that (a non-theoretical) injury would arise. I see no reason why, if the applied-for goods were sold under the applied-for marks, which comprise an ordinary English word and single letter (or simple device), and which are of a low distinctive (and somewhat allusive in a photographic context), that would lead to any change in economic behaviour that would support a case of detriment to distinctive character or repute of the SNAPCHAT trade mark. The only shared element between the parties' marks is the word "SNAP", which is of course a pre-existing, ordinary English word, whose significance is allusive and gives rise to a low distinctive character in respect of (at least most) of the applied-for goods. I therefore do not accept that there would be any unfair advantage obtained by the use of the applied-for marks.

80. **OUTCOME**: The opposition based on section 5(3) fails insofar as the claim is based on the SNAPCHAT registration.

81. I turn next to consider the section 5(3) claim based on the Earlier SNAP Marks, for which marks the Opponent also claims a massive reputation in the UK in relation to its core social networking and entertainment services. The Applicant's admission of reputation was in respect of the combination word "SNAPCHAT" – not of its two

individual component words. The Applicant denies that the evidence establishes that the two Earlier SNAP trade marks benefitted from a reputation in respect of the registered services (being those in Class 42, which I have previously found have no similarity to the applied-for goods).

82. Having reviewed the evidence, I agree that the evidence does not show that the word SNAP benefitted from a trade mark reputation in respect of the claimed services. It is not used to market the Opponent's registered services, rather the evidence demonstrates that SNAP is, from time to time, referred to as an abbreviation of the Opponent company.

i. Where the Opponent's main product (an app which allows consumers to alter photographs and add text) is marketed on app stores, it is under the sign "SNAPCHAT".[22] There is no direct evidence of advertisement expenditure on the Earlier SNAP Marks in the UK (or otherwise). The Opponent's (limited) evidence in relation to advertisement expenditure either: (i) does not delineate between advertisement expenditure as between the Earlier Marks;[23] or (ii) plainly only concerns advertisement of the Earlier SNAPCHAT Mark.[24]

ii. No direct evidence is provided with respect to the market share figures for the Earlier SNAP Marks in the UK. The Opponent's market share figures relate to the Earlier SNAPCHAT mark and/or do not delineate between the Earlier Marks.[25]

iii. No direct evidence is provided with respect to the revenue generated in relation to the Earlier SNAP Marks in the UK. The Opponent's revenue figures referred to at MSW [29 – 34] and MS9 relate to the Earlier SNAPCHAT mark and/or do not delineate between the Earlier Marks.

iv. In the Press coverage at Exhibit MS4, the authors use the sign "SNAPCHAT" when referring to the Opponent's goods and services, and use "SNAP", from time to time, to refer to the Opponent company, Snap Inc. For example, of the 22 articles

22 MS1 pp 36 – 37 and MS6
23 MS7, p229
24 ("Meet the Snapchat Generation" brand campaign at MS7, p231).
25 MSW [19 – 25], MS6 and MS9

exhibited, 17 refer to the sign "SNAPCHAT" in the title, whereas only one article refers to "SNAP" in the title, namely, "*A tiny London firm run by a couple of 30-somethings won a slice of Snap's IPO at the last minute*".[26] Such a reference to "SNAP" is consistent with authors referring to the company Snap Inc as Snap, rather than evidencing any reputation of the Earlier SNAP Marks in relation to the goods or services in question.

v. The awards received by the Opponent marking the success of its main product are evidenced at MS5, where again all references are to the sign SNAPCHAT not SNAP.

OVERALL OUTCOME: Since the Opponent has not evidenced the necessary reputation in respect of its SNAP Marks, the section 5(3) ground cannot succeed. The Opposition fails on all grounds and subject to successful appeal of this decision, trade mark applications 3735502 and 3735504 may proceed to registration.

COSTS

83. The Applicant is entitled to a contribution towards its costs in these proceedings, in line with the scale set out in Tribunal Practice Notice 2/2016. I award the sum of £3400, which is calculated as follows:

Considering the statements of grounds and preparing a counterstatement: £400
Considering the other side's evidence: £1400
Preparation for and attending a hearing: £1600

84. I order SNAP Inc to pay Thinkware Corporation the sum of £3400, which sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of August 2025

Matthew Williams

For the Registrar

26 MS4 p133