

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: January 25, 2024

Mailed: July 15, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
—

Instagram, LLC

v.

Instasize, Inc.
—

Opposition No. 91253078
—

Kollin J. Zimmermann, Gia L. Cincone, Larry W. McFarland, YeWon Min and
Heming Xu of Kilpatrick Townsend & Stockton LLP for Instagram, LLC.

Michael J. Leonard, Christopher D. Olszyk, Brian A. Berkley, Ryan N. Miller, Cali
R. Spota and Camila Chediak of Fox Rothschild LLP for Instasize, Inc.
—

Before Goodman, English, and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:¹

¹ This decision cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board and the Director, this decision will cite to the LEXIS legal database. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 101.03(a) (2024). The proceeding or application number for cited Board decisions is included in the citation, if available. Decisions issued prior to 2008 may not be available in TTABVUE. Practitioners should similarly adhere to the citation form recommended in TBMP § 101.03(a).

Instasize, Inc. (“Applicant”) seeks registration on the Principal Register of the mark INSTASIZE (in standard characters) for “Downloadable mobile applications for photo editing” in International Class 9.²

Instagram, LLC (“Opposer”) opposes registration of Applicant’s mark on the ground of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its ownership of the following registered marks:³

- INSTAGRAM (in standard characters) for “Downloadable computer software for modifying the appearance and enabling transmission of photographs” in International Class 9;⁴
- INSTAGRAM (in standard characters) for, inter alia, “Downloadable computer software for modifying the appearance and enabling transmission of images, audio-visual and video content,” in International Class 9;⁵
- INSTAGRAM (in standard characters) for “Internet based Social [sic] introduction, networking and dating services; providing information in the form of databases featuring information in the fields of social networking, social introduction and dating,” in International Class 45;⁶

² Application Serial No. 86171343 was filed on January 21, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), and, after the entry of a preliminary amendment filed on March 25, 2014, Applicant alleged first use as early as October 7, 2012 and use in commerce as early as November 21, 2012.

The mark appears on the drawing page as “InstaSize” but “this does not change the nature of the mark from standard character to special form.” *New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, at *4 n.1 (TTAB 2020) (citing *In re Calphalon Corp.*, Ser. No. 86356713, 2017 TTAB LEXIS 98, at *1 n.1 (TTAB 2017)). Our presentation of the mark in all uppercase letters reflects the fact that an applied-for term in standard character form is not limited to any particular font style, size, or color. *Id.* (citing Trademark Rule 2.52, 37 C.F.R. § 2.52).

³ 1 TTABVUE. Citations to the record and brief reference TTABVUE, the Board’s online docket system. *See, e.g., New Era Cap*, 2020 TTAB LEXIS 199, at *4 n.1. Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of that particular docket entry.

⁴ Reg. No. 4146057; maintained. 1 TTABVUE 11-15.

⁵ Reg. No. 4822600; maintained. 1 TTABVUE 16-19.

⁶ Reg. No. 4827509; maintained. 1 TTABVUE 20-23.

- INSTAGRAM (in standard characters) for, inter alia, “Providing use of online temporary non-downloadable software for enabling transmission of images and audiovisual and video content,” in International Class 42;⁷
- INSTAGRAM (in standard characters) for “Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content; publishing of electronic publications for others,” in International Class 41;⁸ and
- INSTAGRAM (in standard characters) for, inter alia, “Telecommunications services, namely, electronic transmission of data, messages, graphics, images, videos and information,” in International Class 38.⁹

In its operative Answer, Applicant denied the salient allegations of the Notice of Opposition and asserted as an affirmative defense an express reservation of “right to assert any affirmative defenses when and if they are appropriate[.]”¹⁰ which was subsequently stricken by the Board.¹¹

The case is fully briefed.¹² To prevail on its likelihood of confusion claim, Opposer must prove by a preponderance of the evidence its entitlement to a statutory cause of

⁷ Reg. No. 4856047; maintained. 1 TTABVUE 24-28.

⁸ Reg. No. 4863594; maintained. 1 TTABVUE 29-32.

⁹ Reg. No. 4863595; maintained. 1 TTABVUE 33-36.

¹⁰ 18 TTABVUE 5.

¹¹ 49 TTABVUE 4 n.9, November 23, 2022 Board Order.

¹² Opposer’s nonconfidential brief is available at 77 TTABVUE and its confidential brief is at 79 TTABVUE. Applicant’s nonconfidential brief appears at 81 TTABVUE, while its confidential brief appears at 80 TTABVUE. Opposer’s reply brief is available at 83 TTABVUE.

The parties designated portions of their briefs and portions of other materials in the record as confidential under the Board’s Standard Protect Order and filed the unredacted versions under seal. Except as otherwise indicated, all TTABVUE citations in this opinion are to the redacted publicly accessible versions of materials. Consistent with our need “to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of [our] decision,” *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, Can. No. 92057394, 2016 TTAB LEXIS 100, at *11 n.21 (TTAB

action, priority and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945-46, 951 (Fed. Cir. 2000). Having considered the evidentiary record, the parties' arguments and applicable authorities, we find that Opposer has carried this burden, and, therefore, sustain the opposition.

I. The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application. The record also includes the parties' stipulation that "all documents produced by a producing Party to date under Federal Rule of Civil Procedure 34 are deemed authentic and may be made evidence of record and relied upon by the receiving Party in this proceeding under applicable rules."¹³

A. Opposer's Case in Chief

- First Notice of Reliance on Official Records:
 - Copies of records from the USPTO's Trademark Status and Document Retrieval ("TSDR") electronic database showing the current status and title of Opposer's pleaded registrations.¹⁴

2016), we have discussed all evidence designated as confidential in general terms in this opinion to the extent possible.

Opposer attached to its reply brief an appendix (83 TTABVUE 27), which Opposer asserts "inventories the evidence regarding third-party registrations and includes descriptions of the goods and services for which the marks are registered, as well as citations to evidence regarding the manner of the marks' use." *Id.* at 18 n.7. We consider the appendix, if at all, only to the extent it identifies evidence properly made of record during the time assigned for taking testimony. *See, e.g., Hole in 1 Drinks, Inc. v. Lajtay*, Can. No. 92065860, 2020 TTAB LEXIS 9, at *4-5 (TTAB 2020).

¹³ 52 TTABVUE.

¹⁴ 53 TTABVUE 8-31 (Exhibits 1-1 through 1-6). Copies of the TSDR printouts of the pleaded registrations were made of record when they were attached to the Notice of Opposition, so it was unnecessary to submit them again under a Notice of Reliance.

- Copies of TSDR printouts of additional, unpleaded trademark registrations owned by Opposer, including the INSTA mark.¹⁵
- Pleadings filed by Opposer in other inter partes proceedings before the Board and select additional filings from these proceedings, intended to show Opposer's enforcement efforts as to other INSTA-formative marks.¹⁶
- Second Notice of Reliance on:
 - Excerpts from the transcript of the discovery deposition of Hector Lopez, Chief Executive Officer ("CEO") of Applicant, and related exhibits ("Lopez Depo. Tr.").¹⁷
 - Excerpts from the transcript of the discovery deposition of Eddy Homez, Chief Financial Officer ("CFO") of Applicant, and related exhibits ("Homez Depo. Tr.").¹⁸
- Third Notice of Reliance on certain of Opposer's discovery requests and Applicant's responses thereto:
 - Applicant's responses to select interrogatories served by Opposer.¹⁹
 - Applicant's responses to select requests for admission served by Opposer.²⁰

¹⁵ 53 TTABVUE 32-65 (Exhibits 1-7 to 1-13).

¹⁶ *Id.* at 66-360 (Exhibits 1-14 to 1-27).

¹⁷ 54 TTABVUE 5-66 (Exhibits 2-1 to 2-3).

¹⁸ The public version is available at 54 TTABVUE (Exhibits 2-4 to 2-8). Exhibit 2-5 is a video interview saved on a disk; it was filed by mail and is of record at 59, 67 TTABVUE. Exhibit 2-8, which is confidential, is available at 61 TTABVUE 4-5.

¹⁹ 55 TTABVUE 4-11, 23-28 (Exhibits 3-1 and 3-3).

²⁰ *Id.* at 12-22 (Exhibit 3-2). Opposer indicates that one of the responses it relies on is Applicant's denial of Request for Admission No. 26. 55 TTABVUE 3, 17. We have not considered this denial as denials of requests for admission are inadmissible. *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, Opp. No. 91189692, 2015 TTAB LEXIS 96, at *6 n.11 (TTAB 2015) (Board considered only opposer's admissions, not denials, in response to applicant's requests for admission).

- Fourth Notice of Reliance on documents produced by Applicant, including communications with Opposer and emails with customers.²¹
- Fifth and Sixth Notices of Reliance on Printed Publications and Internet Materials.²²
- Testimony Declaration of Itamar Simonson, Ph.D. (“Simonson Test. Decl.”), with exhibits comprising: (1) Dr. Simonson’s expert report evaluating a fame survey regarding the INSTAGRAM mark previously conducted by Dr. Gerald Ford; and (2) Dr. Simonson’s expert report evaluating a secondary meaning survey of the INSTA element previously conducted by Dr. Ford.²³
- Testimony Declaration of Erich Joachimsthaler, PhD, the founder and Chief Executive Officer of Vivaldi Partners Group, and attached expert report evaluating the strength of the INSTAGRAM mark as of April 10, 2012 (“Joachimsthaler Test. Decl.”).²⁴
- Testimony Declaration of Danielle Henry, Meta Platforms, Inc., Global Director, Brand Marketing Instagram (“Henry Test. Decl.”).²⁵

²¹ The public version is available at 56 TTABVUE and the confidential exhibits are available at 61 TTABVUE 6-16.

Both parties introduced documents under a Notice of Reliance that were produced by the other party during discovery. Some of these documents are not self-authenticating and, therefore, generally are not admissible under a Notice of Reliance. However, the parties essentially agreed to the introduction of such materials under a Notice of Reliance because they stipulated that documents produced in these proceedings are “deemed authentic and may be made evidence of record and relied upon by the receiving Party in this proceeding under applicable rules.” 52 TTABVUE.

²² 57, 58, 60 TTABVUE. We consider these website printouts, and other printouts not supported by testimony made of record by Applicant, only for what they show on their face. *See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, Opp. No. 91224000, 2020 TTAB LEXIS 3, at *7 (TTAB 2020) (“[W]e consider Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony only for what they show on their face rather than for the truth of the matters asserted therein.”).

²³ 62 TTABVUE.

²⁴ 63 TTABVUE. Although some portions of this filing are marked “confidential,” *see* 63 TTABVUE 6-59, the entire document is publicly available.

²⁵ 64 TTABVUE (public); 65 TTABVUE (confidential).

- Testimony Declaration of Hal Poret, President of Hal Poret, LLC, Opposer’s survey expert on the issue of likelihood of confusion, and attached expert report (“Poret Test. Decl.”).²⁶

B. Applicant’s Case in Chief

- [First] Notice of Reliance on:
 - Trademark Electronic Search System (TESS) printout of the involved application.²⁷
 - TSDR printouts of third-party registrations for INSTA- and INST-formative marks.²⁸
 - Expert Report of Hal Poret, in the unrelated matter of *Combe Inc. v. Dr. Aug. Wolff GmbH & Co.*, 851 Fed. Appx. 357 (Fed. Cir. 2021) (the “VAGISIL matter”), offered to show that Opposer’s expert, Mr. Poret, chose the wrong control in his survey in the present proceeding on the issue of likelihood of confusion.²⁹
- [Second] Notice of Reliance on documents produced by Opposer.³⁰
- [Third] Notice of Reliance on Internet materials, showing third-party use of the INSTA element.³¹
- [Fourth] Notice of Reliance on Opposer’s supplemental responses to Applicant’s first set of interrogatories.³²

²⁶ 66 TTABVUE.

²⁷ 68 TTABVUE 7-9 (Exhibit 1-1). The file of Applicant’s involved application is automatically of record by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). Therefore, it was unnecessary for Applicant to file a copy under a Notice of Reliance.

²⁸ 68 TTABVUE 10-60 (Exhibits 1-2 to 1-17).

²⁹ 68 TTABVUE 61-145 (Exhibit 1-18).

³⁰ Publicly available version is available at 68 TTABVUE 147-270 (Exhibits 2-1 to 2-20). Confidential Exhibit 2-2 is available at 69 TTABVUE 1-9.

These documents were produced by Opposer during discovery. As discussed in footnote 21, *supra*, the parties essentially agreed to the introduction of such materials under notice of reliance.

³¹ 68 TTABVUE 271-728 (Exhibits 3-1 to 3-88).

³² *Id.* at 729-42 (Exhibit 4-1).

- Applicant’s “Rebuttal Notice of Reliance under 37 C.F.R. § 2.120(k)(4)” on:
 - Select excerpts of the discovery deposition transcript of Hector Lopez, Applicant’s CEO, “which should in fairness be considered so as to make not misleading what was offered by the submitting party.”³³
 - Select excerpts of the of the discovery deposition transcript of Eddy Homez, Applicant’s CFO, to “provide context to the excerpts already introduced by the submitting party”³⁴
- Applicant’s Notice of Reliance on the confidential Fed. R. Civ. P. Rule 30(b)(6) discovery deposition transcript of Opposer’s designee.³⁵
- Testimony Declaration of Eddy Homez, Applicant’s CFO and one of its co-founders, and related exhibits (“Homez Test. Decl.”).³⁶
- Testimony Declaration of Hector Lopez, Applicant’s CEO and one of its founders, and related exhibits (“Lopez Test. Decl.”).³⁷

C. Opposer’s Rebuttal Case

- Rebuttal Testimony of Hal Poret, Opposer’s survey expert, explaining why he used a different methodology in the VAGISIL matter (“Rebuttal Perot Test. Decl.”).³⁸
- Seventh Notice of Reliance on rebuttal discovery deposition excerpts of Opposer’s Rule 30(b)(6) designee (confidential).³⁹
- Eighth Notice of Reliance on Official Records.⁴⁰
- Ninth and Tenth Notices of Reliance on Internet materials, intended to show, inter alia, that many third-party mobile applications using “insta”

³³ *Id.* at 743-751 (Exhibit 6-1).

³⁴ *Id.* at 752-57 (Exhibit 6-2).

³⁵ *Id.* at 147 (public Exhibit 2-2); 69 TTABVUE 13-79 (confidential Exhibit 2-2).

³⁶ 70 TTABVUE 2-19 (public); 71 TTABVUE 2-57 (confidential).

³⁷ 70 TTABVUE 20-84 (public); 71 TTABVUE 58-172 (confidential).

³⁸ 74 TTABVUE.

³⁹ 76 TTABVUE (confidential).

⁴⁰ 72 TTABVUE.

have been taken down, third-party use of “Insta” to refer to INSTAGRAM, and website evidence regarding the total number of apps available.⁴¹

II. Evidentiary Matters

Before discussing the merits of the case, we address each party’s motion to strike.

A. Opposer’s Motion to Strike

Simultaneous with the filing of its trial brief, Opposer moved to strike certain evidence made of record by Applicant, including (1) certain portions of the trial testimony of Messrs. Homez and Lopez, (2) the third-party registration evidence and third-party website evidence filed by Applicant under a Notice of Reliance, (3) certain portions of the discovery deposition transcript of Opposer’s designee under Fed. R. Civ. P. 30(b)(6), and (4) certain discovery deposition testimony of Messrs. Homez and Lopez.⁴² As an initial matter, we note that Opposer filed a redacted version of its motion but did not file a corresponding unredacted version.

Turning first to Opposer’s request that we strike certain discovery deposition testimony of its Rule 30(b)(6) designee relied upon by Applicant, we deny the motion. Opposer’s arguments are entirely redacted.⁴³ Because Opposer neglected to file an unredacted copy of its motion, we do not know the basis for its objection. Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a) (requiring motion contain a full statement of the grounds therefore).

⁴¹ 73, 75 TTABVUE. Both documents are titled “Ninth” notice of reliance. Because the version at 75 TTABVUE contains exhibits with the format “Exhibit 10-1,” “Exhibit 10-2,” etc., and because it appears on the docket as “10th Notice of Reliance,” we will refer to it as such.

⁴² 78 TTABVUE (redacted).

⁴³ *Id.* at 7.

Second, Opposer requests that we strike Applicant's third-party registration and third-party website evidence as irrelevant.⁴⁴ Opposer contends that the registration evidence is irrelevant because, for example, there is no evidence that the marks are in use or that the term "insta" has any normally understood meaning.⁴⁵ Similarly, Opposer contends that the third-party webpages are irrelevant because they are not available and the apps are for unrelated goods and services.⁴⁶ Because Opposer's objections go to the weight to be afforded this evidence, not its admissibility, we decline to strike it and will consider this evidence for whatever probative value it may have. *See, e.g., Double Coin Holdings Ltd. v. Tru Dev.*, Can. No. 92063808, 2019 TTAB LEXIS 347, at *12 (TTAB 2019) (Board is capable of assessing the proper evidentiary weight to be accorded evidence, including its imperfections and admissibility, and according it whatever probative value it may have).

Third, we deny Opposer's request that we strike certain portions of the trial testimony of Applicant's co-founders, Messrs. Homez and Lopez, for lacking foundation, improper opinion, misstating the evidence, improper legal conclusion, and being argumentative.⁴⁷ We see no reason to deviate from our well-established policy of declining to strike declaration testimony on the basis of a substantive objection if the testimony was taken in accordance with the applicable rules. As usual, we will consider the objection when evaluating the probative value of the testimony.

⁴⁴ *Id.* at 6.

⁴⁵ *Id.*

⁴⁶ *Id.* at 6-7.

⁴⁷ *Id.* at 3-6.

Spiritline Cruises, 2020 TTAB LEXIS 3, at *13-14. Additionally, Opposer’s objection based on a lack of foundation, made via a motion to strike filed concurrently with its trial brief, is untimely. *See, e.g., Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, Can. No. 92025859, 2022 TTAB LEXIS 454, at *11 n.21 (TTAB 2022) (“[O]bjections that the submitting party failed to establish the proper foundation for evidence are procedural in nature and must be raised promptly to allow an opportunity to cure.”).

We also decline to strike the discovery deposition transcript designations of Messrs. Homez and Lopez made by Applicant,⁴⁸ which Opposer seeks to strike on the ground that Applicant mischaracterizes the testimony,⁴⁹ and will accord the evidence its appropriate weight. *Double Coin Holdings*, 2019 TTAB LEXIS 347, at *12.

For the reasons discussed above, Opposer’s motion to strike is denied.

B. Applicant’s Evidentiary Objections

Applicant seeks to strike several of Opposer’s exhibits, asserting that the evidence is not relevant “because the ‘INSTA’ registration was not pleaded in the proceeding and is not probative to the claims in this proceeding.”⁵⁰ We decline to strike this evidence. As the Board indicated in its earlier order where it addressed substantially similar arguments by Applicant, an unpleaded registration may be considered for whatever probative value it may have. 49 TTABVUE 8 n.14 (Board Order, dated November 23, 2022 (citing *FujiFilm SonoSite, Inc. v. Sonoscape Co., Ltd.*, Opp. No.

⁴⁸ 68 TTABVUE 743-57 (Exhibits 6-1 and 6-2).

⁴⁹ 78 TTABVUE 8.

⁵⁰ 82 TTABVUE 6.

91201727, 2014 TTAB LEXIS 232, at *5 (TTAB 2014) (“While an unpleaded registration cannot be used as a basis for the opposition, it, like third-party registrations, may be considered for ‘whatever probative value’ it may lend to opposer’s showing under the *duPont* factors in its case in chief.”) (quoting *Safer, Inc. v. OMS Invs., Inc.*, Opp. No. 91176445, 2010 TTAB LEXIS 51, at *8 (TTAB 2010))). Therefore, we decline to strike Opposer’s evidence but will keep Applicant’s objection in mind when we consider the probative value of it.

Applicant also seeks to strike the testimony of Hal Poret, Opposer’s likelihood of confusion survey expert, asserting that his survey is “not relevant to whether there is likelihood of confusion because it contradicts the actual statistics of alleged confusion in the marketplace.”⁵¹ For the reasons discussed above, namely, that this testimony was taken in accordance with the applicable rules, and because the objection goes to the weight of the evidence, not its admissibility, we overrule Applicant’s objections. *Spiritline Cruises*, 2020 TTAB LEXIS 3, at *13-14.

Finally, Applicant objects to Opposer’s evidence showing images of Applicant’s use of a stylized INSTASIZE mark.⁵² Applicant argues that “[t]hese exhibits are not relevant because the images of Applicant’s use of INSTASIZE in a special script it used a decade ago is not how the Mark is used [currently] and cannot be properly used to identify Applicant’s Mark in a likelihood of confusion analysis.”⁵³ We disagree.

⁵¹ *Id.* at 7.

⁵² *Id.*

⁵³ *Id.*

Applicant has applied to register its mark in standard character format. Therefore, if registered, the mark could be depicted in any font style, size or color. Trademark Rule 2.52(a), 37 C.F.R. § 2.52(a). Applicant's prior use of a stylized INSTASIZE mark shows one manner in which Applicant would be permitted to display its standard-character mark if the involved application were to mature to registration. This evidence is also relevant to the first *DuPont* factor, as discussed herein.

Accordingly, we deny Applicant's motion to strike.

III. Background

A. Opposer's Business and Mark

Opposer launched its INSTAGRAM app and website in 2010.⁵⁴ The app, which allows users to post and edit photos, was immediately popular and was named the iPhone App of the Year by Apple about a year after its launch.⁵⁵ The INSTAGRAM app, which is free to download and available in the United States primarily through the Google Play and Apple App stores, had 10 million monthly active accounts worldwide by September 2011, 80 million monthly active accounts by July 2012, and 100 million monthly active accounts worldwide by February 2013.⁵⁶ By November 2022, there were 2 billion monthly active accounts worldwide.⁵⁷

The app is used by members of the general public, celebrities and businesses, and the celebrity usage is itself the subject of media reports, as the media often tracks,

⁵⁴ 64 TTABVUE 2 (Henry Test. Decl. para. 2).

⁵⁵ *Id.* at 3-4 (Henry Test. Decl. paras. 7, 9); 75 TTABVUE 97-99 (Exhibit 10-20).

⁵⁶ 64 TTABVUE 3, 4 (Henry Test. Decl. paras. 6, 9).

⁵⁷ *Id.* at 5 (Henry Test. Decl. para. 9).

for example, the number of followers celebrities have, and when one celebrity obtains more followers than another.⁵⁸ Articles tell users “how to get famous on Instagram” and advise businesses to use Instagram, noting that brands “can’t afford to not be on Instagram.”⁵⁹ Instagram posts themselves regularly make news: media outlets reported when Queen Elizabeth II wrote her first Instagram post, when Jennifer Aniston and Derek Jeter joined the platform, when Miley Cyrus blacked out her Instagram account, and when Selena Gomez “dethroned” Kylie Jenner as Instagram’s “most-followed woman,” for example.⁶⁰

B. Applicant’s Business and Mark

Applicant, originally known as Munkee Apps LLC, was founded by Applicant’s current Chief Financial Officer Eddy Homez, Chief Executive Officer Hector Lopez, and Chief Operating Officer Omar Arambula.⁶¹

When Instagram launched in 2010, its app technology only allowed users to post square photos.⁶² Mr. Lopez was not satisfied with this; he wanted a tool that permitted him to resize his photos from the default rectangular format to the square format needed for Instagram, thereby allowing an entire photo to be posted on Instagram without cropping.⁶³ In the summer of 2012, while Mr. Lopez and Mr.

⁵⁸ *Id.* at 5-8 (Henry Test. Decl. paras. 10-12, 15).

⁵⁹ *Id.* at 6-7 (Henry Test. Decl. para. 15); 58 TTABVUE 63-91, 200-01 (Exhibits 6-8, 6-31).

⁶⁰ 64 TTABVUE 6-7 (Henry Test. Decl. para. 15); 58 TTABVUE 98-117, 251-52 (Exhibits 6-10 to 6-13, 6-41).

⁶¹ 70 TTABVUE 2 (Homez Test. Decl. paras. 1-2).

⁶² 64 TTABVUE 3-4 (Henry Test. Decl. para. 7).

⁶³ 70 TTABVUE 20-22 (Lopez Test. Decl. paras. 3, 8, 10).

Homez were at the gym discussing this problem, they came up with the idea for the INSTASIZE app.⁶⁴ The app launched on Black Friday in 2012.⁶⁵

By January 2013, the INSTASIZE app, available in both the Apple App and the Google Play stores, had 100,000 active users.⁶⁶ Six months later, by June 2013, Applicant had 1,000,000 active users.⁶⁷ About a decade later, as of May 2023, Applicant had over 150 million downloads of its INSTASIZE app.⁶⁸

Applicant promotes its INSTASIZE app on various social media platforms, such as Twitter (now X)⁶⁹ and Instagram,⁷⁰ has its own account on Instagram,⁷¹ and its app is available in the same channels of trade as Instagram, meaning both apps are available in the same app stores.⁷²

Opposer eventually changed its INSTAGRAM app technology, and in 2015 it permitted rectangular photos to be posted without cropping.⁷³ When that happened,

⁶⁴ 70 TTABVUE 21 (Lopez Test. Decl. para. 8).

⁶⁵ *Id.* at 20-21 (Lopez Test. Decl. paras. 4, 8).

⁶⁶ *Id.* at 4 (Homez Test. Decl. para. 13).

⁶⁷ *Id.*

⁶⁸ *Id.* at 21 (Lopez Test. Decl. para. 5).

⁶⁹ We take judicial notice that the social media platform TWITTER is now called X. *See* <https://www.britannica.com/money/Twitter>, accessed June 28, 2024. “The Board may take judicial notice of information from encyclopedias.” *In re White Jasmine LLC*, Ser. No. 77115548, 2013 TTAB LEXIS 9, at *20 n.24 (TTAB 2013); *see also In re Mr. Recipe, LLC*, Ser. No. 86040643, 2016 TTAB LEXIS 80, at *8 n.3 (TTAB 2016).

⁷⁰ 70 TTABVUE 23 (Lopez Test. Decl. para. 19).

⁷¹ 55 TTABVUE 21.

⁷² 70 TTABVUE 26 (Lopez Test. Decl. para. 31).

⁷³ *Id.* at 24 (Lopez Test. Decl. para. 21).

this rendered obsolete the core service of Applicant's app and Applicant saw its number of downloads drop.⁷⁴

Opposer sent a demand letter to Applicant in February 2014, and asked it to abandon its involved application.⁷⁵ The matter was not resolved,⁷⁶ and this proceeding ensued.

IV. Entitlement to a Statutory Cause of Action

Applicant does not dispute Opposer's entitlement to bring a statutory cause of action or even address the issue in its brief; nonetheless, entitlement to a statutory cause of action is an element of the plaintiff's case in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303-08 (Fed. Cir. 2020) (citing *Lexmark*, 572 U.S. at 129-34). Demonstrating a real interest in opposing registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.*

⁷⁴ *Id.*

⁷⁵ 70 TTABVUE 3 (Homez Test. Decl. para. 9); 56 TTABVUE 7-8 (Exhibit 4-1).

⁷⁶ 56 TTABVUE 10-26 (Exhibits 4-2 to 4-6); 61 TTABVUE 7-9 (confidential Exhibit 4-4).

Here, Opposer properly made of record TSDR printouts of its pleaded registrations, attaching them to the Notice of Opposition and submitting copies under a Notice of Reliance.⁷⁷ “The pleaded registrations establish Opposer’s direct commercial interest in the proceeding that entitles it to bring a statutory cause of action, namely, to oppose registration of Applicant’s mark on the ground of priority and likelihood of confusion.” *Monster Energy Co. v. Lo*, Opp. No. 91225050, 2023 TTAB LEXIS 14, at *15 (TTAB 2023) (valid and subsisting pleaded registration made of record establishes entitlement to oppose) (citing *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161 (Fed. Cir. 2002) (“In most settings, a direct commercial interest satisfies the ‘real interest’ test.”) and *Cunningham*, 222 F.3d at 945 (pleaded registrations “suffice to establish ...direct commercial interest”)). Thus we find that Opposer has established its entitlement to bring a statutory action.

V. Opposer’s Section 2(d) Claim

Under Section 2(d) of the Trademark Act, a mark may not be registered if it “consists of or comprises a mark ... or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion....” 15 U.S.C. § 1052(d).

We focus our analysis on the standard-character mark INSTAGRAM shown in Opposer’s pleaded Registration No. 4146057 for “Downloadable computer software for modifying the appearance ... of photographs”⁷⁸ (the “057 Registration”) and its

⁷⁷ 1 TTABVUE 11-36; 53 TTABVUE 8-31 (Exhibits 1-1 through 1-6).

⁷⁸ 1 TTABVUE 11-15; 53 TTABVUE 8-11.

standard-character mark INSTAGRAM shown in Registration No. 4822600 for “Downloadable computer software for modifying the appearance ... of images” (the “’600 Registration”) (collectively, the “INSTAGRAM mark”).⁷⁹ Of the pleaded registrations, these two have the most points in common with Applicant’s mark. Because, as explained more fully below, we find that there is a likelihood of confusion between the INSTAGRAM mark and Applicant’s mark for “Downloadable mobile applications for photo editing,” there is no need for us to consider the likelihood of confusion with the marks of Opposer’s other pleaded registrations. *See, e.g., Monster Energy*, 2023 TTAB LEXIS 14, at *16-17 (citing *Sock It To Me, Inc. v. Fan*, Opp. No. 91230554, 2020 TTAB LEXIS 201, at *20-21 (TTAB 2020) (confining likelihood of confusion analysis to most similar pleaded mark)).

A. Priority

Because Opposer relies on its asserted INSTAGRAM registrations that have been made of record, which includes the ’057 Registration and the ’600 Registration, and Applicant has not challenged these registrations by way of a cancellation counterclaim, Opposer’s priority is not at issue with respect to the goods identified in its ’057 and ’600 Registrations. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 1400-01 (CCPA 1974).

⁷⁹ 1 TTABVUE 16-19; 53 TTABVUE 13-15.

B. Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“*DuPont*”). See *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379 (Fed. Cir. 2019). Varying weight may be assigned to each *DuPont* factor depending on the evidence presented. See *Citigroup Inc. v. Cap. City Bank Grp., Inc.*, 637 F.3d 1344, 1354-55 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 998 (Fed. Cir. 2020) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406-07 (Fed. 1997)).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). We discuss below these factors, and the other *DuPont* factors for which there is evidence and argument.

1. Similarity or Dissimilarity and Nature of the Parties' Goods and the Similarity or Dissimilarity of Established, Likely-to-Continue Channels of Trade and Classes of Consumers

We first address the second and third *DuPont* factors, assessing the similarity or dissimilarity of the parties' goods and channels of trade. *DuPont*, 476 F.2d at 1361. Our determination must be based on the identification of goods in the '057 and '600 Registrations and the subject application. *Stone Lion Cap. Partners, LP v. Lion Cap. LLP*, 746 F.3d 1317, 1322-23 (Fed. Cir. 2014); *Octocom Sys. Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.").

Applicant's involved application identifies "Downloadable mobile applications for photo editing". First, focusing on Opposer's '057 Registration, it covers "Downloadable computer software," i.e., downloadable mobile applications "for modifying the appearance ... of photographs". "Photo editing" is broad enough to encompass "modifying the appearance of photographs." *In re Hughes Furniture Indus., Inc.*, Ser. No. 85627379, 2015 TTAB LEXIS 65, at *10 (TTAB 2015) ("Applicant's broadly worded identification of 'furniture' necessarily encompasses Registrant's narrowly identified 'residential and commercial furniture.'"). Thus, we find that Applicant's goods are legally identical to the goods identified in the '057 Registration.

Turning next to Opposer's '600 Registration, it covers "Downloadable computer software," i.e., downloadable mobile applications "for modifying the appearance ... of

images.” We take judicial notice that the term “image” means “A representation of the form of a person or object, such as a painting or photograph.”⁸⁰ Inasmuch as “images” is broad enough to encompass “photos,” we find that “photo editing” is broad enough to encompass “modifying the appearance ... of images.” *In re Hughes Furniture*, 2015 TTAB LEXIS 65, at *10. Thus, we find that Applicant’s goods are legally identical to the goods identified in Opposer’s ’600 Registration.

Because there are no limitations on trade channels or consumers in Opposer’s registrations and Applicant’s application, we must presume that the legally identical goods travel in the same channels of trade to the same classes of consumers. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372 (Fed. Cir. 2018) (“[T]he TTAB properly followed our case law and ‘presume[d] that the identical goods move in the same channels of trade and are available to the same classes of customers for such goods’”) (*quoting Diamond Hong, Inc. v. Cai*, Can. No. 92062714, 2018 TTAB LEXIS 43, at *14 (TTAB 2018)); *Stone Lion*, 746 F.3d at 1322-23 (Board correctly presumed that the trade channels and consumers were the same with respect to the parties’ legally identical services); *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012) (identical goods are presumed to travel in same channels of trade to same class of purchasers).

In its brief, Applicant argues that the parties’ apps perform different functions – Applicant’s app is for photo editing while Opposer’s app is for photo sharing – and

⁸⁰ THE AMERICAN HERITAGE DICTIONARY, <https://www.ahdictionary.com>, accessed on May 29, 2024. The Board may take judicial notice of dictionary definitions, including online dictionaries and encyclopedias that exist in printed format. *In re Cordua Rests. LP*, Ser. No. 85214191, 2014 TTAB LEXIS 94, at *6 n.4 (TTAB 2014), *aff’d* 823 F.3d 594 (Fed. Cir. 2016).

that, as a result, the goods are not identical or even related, and consumers would not be confused.⁸¹ This argument is not persuasive, however, as we must base our finding on the language of the identifications of goods and not “real world conditions.” *Stone Lion*, 746 F.3d at 1322-23.

Applicant also disputes that the channels of trade are similar.⁸² While acknowledging that both parties’ apps are marketed in “**some** of the same or similar channels[,]” such as Google Play and Apple App stores,⁸³ Applicant argues that this is not enough as “**virtually all** mobile apps are distributed through platform-locked app stores.”⁸⁴ Based on the apps’ purported different functions, and making a brick-and-mortar-store analogy, Applicant argues that the apps can be found in different aisles of the same department store, and, consequently, are not likely to be confused.⁸⁵

As an initial matter, Applicant does not cite to any record evidence to support its argument that “virtually all” mobile apps are distributed through platform-locked app stores. *Cai v. Diamond Hong*, 901 F.3d at 1371 (“Attorney argument is no substitute for evidence.”). Regardless, Applicant’s arguments are inapposite. Having found that the parties’ goods are legally identical, we must rely on the presumption that they travel in the same channels of trade to the same consumers. *In re Viterro*, 671 F.3d at 1362.

⁸¹ 81 TTABVUE 24-25 & n.6.

⁸² *Id.* at 24.

⁸³ *Id.* at 25 (citing 55 TTABVUE 19 (Exhibit 3-2); 55 TTABVUE 9-10 (Exhibit 3-1)) (emphasis in original in bold and italics, and just bold here).

⁸⁴ 81 TTABVUE 25 (emphasis in bold and italics in original, and just bold here).

⁸⁵ *Id.* at 24-25.

The second and third *DuPont* factors weigh heavily in favor of finding a likelihood of confusion.

2. Purchasing Conditions and Consumer Sophistication

We turn now to the fourth *DuPont* factor, the conditions under which the goods are likely to be purchased, e.g., whether on impulse or after careful consideration, as well as the degree, if any, of sophistication of the consumers. A heightened degree of care when making a purchasing decision may tend to minimize likelihood of confusion. Conversely, impulse purchases of inexpensive goods may tend to have the opposite effect. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1376 (Fed. Cir. 2005).

Opposer argues that this factor weighs in favor of likelihood of confusion because “[b]oth parties’ apps can be downloaded for free from the same app stores, making it more likely that consumers will not be taking great care with their purchase.”⁸⁶

Applicant counters that Opposer’s argument does not take into account the “near ubiquitous warnings regarding mobile app security[,]” whereby “[t]hrough such media reports, consumers are conditioned to pay close attention to where their apps come from and exercise greater care than a typical ‘impulse buy.’”⁸⁷ Applicant adds that its app is subscription-based, “therefore making consumers much more discerning before entering into a pay-to-use based subscription.”⁸⁸ Additionally, Applicant contends that the details on each app’s description page, such as the

⁸⁶ 77 TTABVUE 44.

⁸⁷ 81 TTABVUE 25-26.

⁸⁸ *Id.*

identity of the owner/developer, the app's function and user reviews, serve to educate the consumer about each mobile app and mitigate any possibility of confusion.⁸⁹

Applicant's identification of goods does not specify that the app is available only through a subscription and we cannot import any such restriction into the identification. *See, e.g., New Era Cap*, 2020 TTAB LEXIS 199, at *47 (in the absence of price point restriction "[w]e must assume that the products are sold at all price points"); *In re Kysela Pere et Fils, Ltd.*, Ser. No. 77686637, 2011 TTAB LEXIS 70, at *17 (TTAB 2011) ("[W]e must consider the goods as identified in the application and the cited registrations to include all price points, including those at the low end of the range."). In any event, Mr. Lopez, Applicant's CEO, testified that Applicant's mobile app is free to download,⁹⁰ and that while some of Applicant's app functions are subscription-based, 90% of users use the free version.⁹¹

The fact that the parties offer their apps for free is evidence that these types of mobile apps are offered at a very low (i.e., free) price point. Consumers of low-cost products "have long been held to a lesser standard of purchasing care." *Kimberly-Clark Corp. v. H. Douglas Enters., Ltd.*, 774 F.2d 1144, 1146 (Fed. Cir. 1985); *Made in Nature v. Pharmavite*, Opp. No. 91223352, 2022 TTAB LEXIS 251, at *64 (TTAB 2022) (recognizing that low cost items are subject to impulse buying).

⁸⁹ *Id.* at 26.

⁹⁰ 54 TTABVUE 7 (Lopez Depo. Tr. 17:8-10).

⁹¹ *Id.* (Lopez Depo. Tr. 17:11-22).

Under the fourth *DuPont* factor, we also must consider all potential consumers of the goods and base our decision on the least sophisticated consumer. *Stone Lion*, 746 F.3d at 1325 (the analysis must focus on the “least sophisticated potential purchasers” of the goods). The parties’ mobile apps are the type of product that would be used by ordinary consumers who have smartphones, including teens.

In view of the foregoing, we find that the least sophisticated consumers of the parties’ mobile apps are likely to exercise a lesser degree of care. Were we to presume purchaser care and sophistication as Applicant would have us do (which we cannot on this record), “even consumers who exercise a higher degree of care are not necessarily knowledgeable regarding the trademarks at issue, and therefore immune from source confusion.” *Top Tobacco LP v. N. Atl. Operating Co.*, Opp. No. 91157248, 2011 TTAB LEXIS 367, at *20 (TTAB 2011).

Accordingly, the fourth *DuPont* factor weighs in favor of finding a likelihood of confusion.

3. The Strength of Opposer’s INSTAGRAM Mark

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco*, 2011 TTAB LEXIS 367, at *25 (the strength of a mark is determined by assessing its inherent strength and its commercial strength);

Tea Bd. of India v. Republic of Tea, Inc., Opp. No. 91118587, 2006 TTAB LEXIS 330, at *61 (TTAB 2006).

Opposer argues that its INSTAGRAM mark is conceptually strong and commercially strong, indeed famous.⁹² Applicant, for its part, expressly “concedes that Opposer’s Instagram app is a widely used social media app—used by billions of people[,]”⁹³ but argues that evidence of record shows that the mark is both commercially and conceptually weak.

a. Fame or Commercial Strength

Likelihood of confusion fame varies along a spectrum from very strong marks to very weak marks. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 1325 (Fed. Cir. 2017). A famous mark is commercially strong and has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002). A mark is considered “famous” for likelihood of confusion purposes when “a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imps.*, 396 F.3d at 1375. Such a mark “casts a long shadow which competitors must avoid.” *Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1333 (Fed. Cir. 2012) (quoting *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992)). The relevant public comprises ordinary consumers who have smartphones, who are interested in and who use mobile apps, which includes teens.

⁹² 77 TTABVUE 40; 83 TTABVUE 14-15.

⁹³ 81 TTABVUE 26.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012) (citing *Leading Jewelers Guild, Inc. v. LJOW Holdings LLC*, Opp. No. 91160856, 2006 TTAB LEXIS 35, at *12 (TTAB 2007)).

Fame (for likelihood of confusion purposes) may be measured indirectly by, for example, the volume of sales and advertising expenditures in connection with the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the goods identified by the mark; and the general reputation of the goods. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, Opp. No. 91199352, 2014 TTAB LEXIS 2, at *18-19 (TTAB 2014); *see also Bose*, 293 F.3d at 1371 (recognizing indirect evidence as appropriate proof of strength).

As an initial matter, we note that for purposes of likelihood of confusion, the Board generally accepts and considers evidence related to the fame of a plaintiff's mark up to the time of trial. This is distinct from a claim of dilution under Section 43(c) of the Trademark Act, where an element of the claim is the acquisition of fame prior to the defendant's first use or application filing date. *Inter IKEA Sys. B.V. v. Akea, LLC*, Opp. No. 91196527, 2014 TTAB LEXIS 166, at *15 n.18 (TTAB 2014) (citing *Gen. Mills Inc. v. Fage Dairy Processing Indust. SA*, Opp. No. 91118482, 2011 TTAB LEXIS 280, at *24 n.13 (TTAB 2011), *judgment set aside on other grounds*, 2014 TTAB

LEXIS 5 (TTAB 2014)). To the extent that Applicant argues that Opposer must show its mark was famous prior to Applicant's use of or application for its mark,⁹⁴ Applicant misstates the legal standard.

Opposer launched its INSTAGRAM platform in 2010.⁹⁵ Ms. Henry, who is employed by Meta Platforms, Inc., as Global Director, Brand Marketing Instagram, testified about the success of the INSTAGRAM platform, and summarized its remarkable growth in a chart, which we reproduce below in its entirety:⁹⁶

2010	December	Instagram community grows to 1 million monthly active accounts worldwide
2011	July	100 million photographs uploaded to Instagram
	August	150 million photographs uploaded to Instagram
	September	Instagram community grows to 10 million monthly active accounts worldwide
	December	Apple named Instagram as iPhone App of the year
2012	July	Instagram community grows to 80 million monthly active accounts
2013	February	Instagram community grows to 100 million monthly active accounts worldwide

⁹⁴ *Id.* at 27.

⁹⁵ 64 TTABVUE 2-3 (Henry Test. Decl. paras. 2, 6).

⁹⁶ *Id.* at 4-5 (Henry Test. Decl. para. 9).

2014	December	Instagram community grows to 300 million monthly active accounts worldwide
2015	September	Instagram community grows to 400 million monthly active accounts worldwide
2016	June	Instagram community grows to 500 million monthly active accounts worldwide
	December	Instagram community grows to 600 million monthly active accounts worldwide
2017	April	Instagram community grows to 700 million monthly active accounts worldwide
	September	Instagram community grows to 800 million monthly active accounts worldwide
2018	June	Instagram community grows to 1 billion monthly active accounts worldwide
2022	November	Instagram community grows to 2 billion monthly active accounts worldwide

While there is no dispute that the INSTAGRAM platform is wildly popular, the problem with Ms. Henry’s testimony and her corresponding chart is that, to the extent that a geographic region is specified, it is “worldwide” and, as a result, the evidence is not specific to the United States. Use of a mark outside of the United States is not probative. *Hard Rock Cafe Licensing Corp. v. Elsea*, Opp. No. 93,436, 1998 TTAB LEXIS 124, at *13 (TTAB 1998) (“The renown of opposer’s marks outside the United States or exposure of the foreign public to opposer’s marks is irrelevant [to Section 2(d) claim].”); *Lever Bros. Co. v. Shaklee Corp.*, Opp. No. 61,926, 1982 TTAB LEXIS 129, at *9 n.8 (TTAB 1987) (because “any trademark activity outside the United States is ineffective to create rights within this country, ... evidence of such use is irrelevant to any of the issues in the Section 2(d)] proceeding before us[.]”). However, given the extremely high number of users, it is reasonable to infer that a substantial portion of active accounts holders are based in the United States, particularly in light of the fact that Opposer is a U.S.-based company.

Ms. Henry addressed the broad consumer appeal of INSTAGRAM, testifying that “Instagram is regularly used by celebrities, sports figures and teams, and brands – some of whom are followed by tens or even hundreds of millions of people – to post photos and news.”⁹⁷ To illustrate this point, Ms. Henry provided a chart identifying some accounts with the most followers, which we repeat below:⁹⁸

Cristiano Ronaldo	557 million followers
Selena Gomez	395 million followers
Dwayne Johnson	367 million followers
Kim Kardashian	347 million followers
Beyonce	299 million followers
Nike	275 million followers
Disney	36.6 million followers
Golden State Warriors	28.4 million followers

Although this chart fails to identify which account holders and how many of their followers are based in the United States, we again infer that a substantial number of them are U.S.-based for the reasons explained earlier. Notably, Applicant does not dispute this evidence or even address it, nor did Applicant cross-examine Ms. Henry.

As for advertising and promotions, Ms. Henry testified that Opposer “runs broad scale consumer marketing to its target audience through media on the Instagram

⁹⁷ 64 TTABVUE 5 (Henry Test. Decl. para. 12).

⁹⁸ *Id.* at 5-6 (Henry Test. Decl. para. 12). Although not attached to Ms. Henry’s testimony declaration, Opposer made of record printouts of the Instagram profile pages for Nike, Disney, Beyonce, Kim Kardashian, Solena Gomez and the Golden State Warriors (which are shown in the chart) under a notice of reliance. 58 TTABVUE 120, 123, 126, 129, 132.

platform and through off-platform media placements that include broadcast video, out of home, online, social media, audio/radio, and experiential, among others.”⁹⁹ With regard to advertising and marketing expenditures, here Ms. Henry’s testimony is specifically limited to the United States and, while the exact amount is confidential, it is substantial.¹⁰⁰

Turning to revenues, Opposer also made of record its advertising revenues, which, although confidential, are also specifically limited to the United States and are also without doubt properly characterized as substantial.¹⁰¹

i. Unsolicited Media Attention

Turning next to unsolicited media attention, Opposer itself has been the subject of much media attention, as have changes to the INSTAGRAM app, together with, for example, the platform’s users, their posts and their follower activity.¹⁰² Shortly after its launch, in April 2012, an article about the app appeared in *The New Yorker* magazine, titled “Instagram’s Instant Nostalgia,” which observed that “Much of Instagram’s appeal ... comes from something more simple: it makes everything in our lives, including and especially ourselves, look better.”¹⁰³ A representative sampling of other third-party articles, which are properly of record, is set out below:

⁹⁹ 64 TTABVUE 6 (Henry Test. Decl. para. 13).

¹⁰⁰ 65 TTABVUE 6, 13 (Henry Confidential Test. Decl. para. 13 and Exhibit A).

¹⁰¹ *Id.* at 6, 15 (Henry Confidential Test. Decl. para. 14 and Exhibit B).

¹⁰² 64 TTABVUE 6-7 (Henry Test. Decl. para. 15).

¹⁰³ 60 TTABVUE 66-68 (Exhibit 6-53); 64 TTABVUE 4 (Henry Test. Decl. para. 8).

- “Is **Instagram** the New Google for Travel? These Startups Say It Is,” published on Skift.com on June 2, 2022, predicting that “**Instagram** is the Next Big Thing in selling travel[.]”¹⁰⁴
- “A True **Instagram** queen: Queen Elizabeth II writes her first post on social media platform,” published on abc7ny.com, on March 7, 2019, describing and featuring Queen Elizabeth’s first **Instagram** post.¹⁰⁵
- “Jennifer Aniston joins **Instagram** with help from some ‘Friends,’” published on cnn.com on October 16, 2019. The article states that “[t]he actress on Tuesday joined the social media platform with a bang, posting a photo with former co-stars Courteney Cox, Lisa Kudrow, David Schwimmer, Matthew Parry and Matt LeBlanc.” According to the article, the post read, “And now we’re **instagram** FRIENDS too... ‘Hi **INSTAGRAM.**”¹⁰⁶
- “Derek Jeter joins social media, amasses huge following and conducts AMA [Ask Me Anything on Instagram],” published on espn.com on May 31, 2022. According to the article, after creating both Twitter and **Instagram** profiles, by later that evening, “the former New York Yankees shortstop [had] amassed over 270,000 followers combined on both platforms.”¹⁰⁷
- “Miley Cyrus Fans Have a Theory on Why She Blacked Out Her Entire Instagram Account,” published on narcity.com. “If you happen to be one of Miley Cyrus’ 76 million **Instagram** followers, you may already know that her entire account has been wiped....**Whatever Miley Cyrus has planned**, she’s definitely gotten the world’s attention.”¹⁰⁸
- “**Instagram** blows up with White House photos,” published on washingtonpost.com on July 1, 2015. “**Instagram** users rushed to post shots from inside 1600 Pennsylvania Avenue on Wednesday after a

¹⁰⁴ 58 TTABVUE 95-97 (Exhibit 6-9) (emphasis added).

¹⁰⁵ 58 TTABVUE 100-01 (Exhibit 6-10) (emphasis added); *see also* 64 TTABVUE 7 (Henry Test. Decl. para. 15).

¹⁰⁶ 58 TTABVUE 104-05 (Exhibit 6-11) (emphasis added); *see also* 64 TTABVUE 7 (Henry Test. Decl. para. 15).

¹⁰⁷ 58 TTABVUE 108-10 (Exhibit 6-12) (emphasis added); *see also* 64 TTABVUE 7 (Henry Test. Decl. para. 15).

¹⁰⁸ 58 TTABVUE 113-17 (Exhibit 6-13) (emphasis in original, and added); *see also* 64 TTABVUE 7 (Henry Test. Decl. para. 15).

decades-old photography ban was lifted... So let the debate begin: how much filter is too much filter when it comes to the White House?”¹⁰⁹

- “Food” published by cnn.com on October 10, 2018, “Black Tap calls itself the ‘classic luncheonette modernized for the **Instagram** age.” “Black Tap’s giant and colorful shakes went viral on **Instagram**.” “And [the restaurant décor is] all very **Instagram**-friendly.” One expert interviewed for the article discussed how the food and restaurant scene “[is] consciously thinking through how **Instagrammable** [a dish] is It’s starting to make its way into all aspects of the décor elements, plating and presentation.”¹¹⁰
- “Kate Eichhorn on the Rise of **Insta**-Artists and **Insta**-Poets,” published on lithub.com on May 19, 2022, recounting Amalia Ulman’s **Instagram** trajectory: “[i]n a 2015 *Art Review* article, Eric Morse observed that in Ulman’s **Instagram** work, eventually titled *Excellence & Perfections*, ‘promises of voyeuristic spectacle and salacious confession ignited her account’s real-time fan base and drew mainstream coverage from pop culture glossies like *New York Magazine*, *i-D* and *Dazed and Confused*.”¹¹¹
- “10 Reasons Your Brand Needs to Be on **Instagram**,” published on Forbes.com on July 8, 2015. “**Instagram** has morphed from a trendy teen hangout to a serious social networking site with great promise for businesses. With 34% of US internet users now using **Instagram**, **Instagram** is second only to Facebook in terms of US audience penetration.”¹¹²
- “Did Zayn Malik, Gigi Hadid make their romance **Insta**-official?” published on financialexpress.com on December 21, 2015. “The 22-year-old singer shared a sweet selfie of him and his rumoured girlfriend Hadid on **Instagram** without any caption, Us Magazine reports.”¹¹³
- “Did Gwyneth Paltrow’s rumored boyfriend just **Insta**-confirm their romance?!” published on entertainthis.usatoday.com on September 22, 2015, describing an **Instagram** post by Brad Falchuk .¹¹⁴

¹⁰⁹ 58 TTABVUE 137-48 (Exhibit 6-20) (emphasis added).

¹¹⁰ *Id.* at 151-55 (Exhibit 6-21) (emphasis added).

¹¹¹ *Id.* at 158-64 (Exhibit 6-22) (emphasis in in original, and added).

¹¹² *Id.* at 167-69 (Exhibit 6-23) (emphasis added).

¹¹³ *Id.* at 171 (Exhibit 6-24) (emphasis added).

¹¹⁴ *Id.* at 173-75 (Exhibit 6-25) (emphasis added).

- “Watch Kevin Hart & Tiffany Haddish **Insta**-Stalk Each Other,” published on elle.com on October 2, 2018. “Kevin Hart and Tiffany Haddish star in *Night School* together, but what can they learn from each other’s **Instagrams**? We asked the hilarious co-stars to **Insta**-Stalk each other, and their social media deep dives were spectacular.”¹¹⁵
- “This California architect built an **Insta**-ready home gym for two fitness Influencers,” published on businessofhome.com on January 26, 2022. “The pair started posting **Instagram** Live workouts early in the pandemic, which grew so popular that they launched a membership program.”¹¹⁶
- “Sipping Martha-ritas With Martha Stewart at Her **Insta**-Famous Farm,” published in wmagazine.com on May 10, 2022. “[Martha Stewart’s] chow chows, for example, were among the pets who figured prominently in a recent post that’s emblematic of why the 80-year-old mogul’s burner **Instagram** account has gained a cult following among people who ordinarily couldn’t care less about domesticity.”¹¹⁷
- “**Instagram**’s New Features Will Turn You Into a Photography Pro,” published on time.com on June 1, 2014.¹¹⁸
- “Selena Gomez Dethrones Kylie Jenner On **Instagram**, Later Announces Another Social Media Break,” published on cnnentertainment.com on February 23, 2023.¹¹⁹

ii. **Opposer’s Internal Market Research and Expert Survey Evidence**

Opposer introduced its internal marketing research and several expert surveys to support its argument that its INSTAGRAM mark is famous, which we address in turn.

¹¹⁵ *Id.* at 178 (Exhibit 6-26) (emphasis added).

¹¹⁶ *Id.* at 184-87 (Exhibit 6-28) (emphasis added).

¹¹⁷ *Id.* at 191-93 (Exhibit 6-29) (emphasis added).

¹¹⁸ 60 TTABVUE 25 (Exhibit 6-50) (emphasis added). Additional articles, not discussed herein, are available at 60 TTABVUE.

¹¹⁹ 58 TTABVUE 251-52 (Exhibit 6-41) (emphasis added); 64 TTABVUE 7 (Henry Test. Decl. para. 15).

(a) Opposer’s Internal Market Research

Opposer internally tracks its brand recognition in the United States, and the survey results for August 2017 through the first quarter of 2021 are of record and, due to their confidential nature, filed under seal.¹²⁰ In each periodic survey, each participant was asked the following question: “Which of the following mobile apps, if any, have you heard of before today? Please check all that apply.”¹²¹ Given the widespread use of the INSTAGRAM app, it is no surprise that Opposer’s internal survey showed that, when participants were asked if they were aware of the INSTAGRAM brand, an extremely high number of both teens and adults acknowledged they were.

(b) The Joachimsthaler Declaration, Report and Exhibits

In addition, Opposer offered into evidence the testimony declaration of Mr. Erich Joachimsthaler, the founder and CEO of Vivaldi Partners Group, who testified that he was retained by Opposer.¹²² He was specifically “asked to evaluate whether or not INSTAGRAM was a strong brand and mark at least as early as April 10, 2012[.]”¹²³ which is prior to Applicant’s filing date of January 21, 2014.

Based on his accompanying expert report, Mr. Joachimsthaler concluded that, among other things, “INSTAGRAM was a strong brand and mark at least as early as

¹²⁰ 65 TTABVUE 7, 16-40 (Henry Confidential Test. Decl. para. 16 and Exhibits C-E).

¹²¹ 65 TTABVUE 21, 26, 29, 35, 38.

¹²² 63 TTABVUE 2 (Joachimsthaler Test. Decl. para. 1).

¹²³ *Id.* (Joachimsthaler Test. Decl. para. 2). Although all of the pages of the expert report except the cover page are marked “confidential,” the expert report in its entirety appears in unredacted form on the docket.

April 10, 2012, and that awareness of the INSTAGRAM brand was high as of that date.”¹²⁴ Mr. Joachimsthaler’s testimony declaration is dated March 31, 2023,¹²⁵ which is during Opposer’s trial testimony period.¹²⁶ However, his accompanying expert report on which he bases his conclusions is dated June 2, 2017,¹²⁷ more than five years earlier, and, as mentioned, assesses the fame of Opposer’s mark as of April 10, 2012, which is about five years earlier than that. Accordingly, this evidence is somewhat stale and, as a result, less probative of the current fame of Opposer’s mark.

Applicant does not meaningfully address the merits of Opposer’s expert by seeking to discredit his credentials or his survey methodology, for example. Rather, Applicant mentions Mr. Joachimsthaler’s report in a single footnote and only as support for its argument attempting to distinguish the parties’ goods,¹²⁸ which is not relevant to the topic at hand.

(c) The Simonson Declaration, Report and Exhibits

To further support its argument that the INSTAGRAM mark is famous, Opposer submitted the declaration and related expert report of Itamar Simonson, Ph.D. (“Simonson Report”). Dr. Simonson testified that he was retained by Opposer to evaluate a fame survey previously conducted by Dr. Gerald Ford, in the fall of 2014,

¹²⁴ 63 TTABVUE 2-3, 5-60 (Joachimsthaler Test. Decl. para. 3 and Exhibit 1).

¹²⁵ 63 TTABVUE 3.

¹²⁶ 51 TTABVUE.

¹²⁷ 63 TTABVUE 5, 32.

¹²⁸ 81 TTABVUE 25 n.6.

which was “designed to measure the degree of recognition of the INSTAGRAM trademark for a photo-sharing app for mobile devices[].”¹²⁹

Details about the survey screener and questionnaire, the response frequencies, questionnaire design, and interviewing procedures are provided.¹³⁰ Dr. Simonson evaluated Dr. Ford’s survey and concluded that it was properly conducted; therefore, he stands behind Dr. Ford’s determination that in total, on a net basis, approximately 86% of the general public recognized the INSTAGRAM mark, and, among the “general consuming public, marginally more past and/or potential downloaders of apps for a mobile device (i.e., 89.37%/88.63%) recognized the INSTAGRAM mark and marginally more past and/or potential users of photo sharing apps for a mobile device (i.e., 88.14%/86.34%) recognized the INSTAGRAM mark.”¹³¹ Accordingly, Dr. Simonson concludes that “[t]he INSTAGRAM mark is famous both among the general public and among the general consuming public, whether defined as past and/or potential downloaders of apps for a mobile device, or past and/or potential users of photo-sharing apps for a mobile device.”¹³² Opposer argues that “[g]iven the exponential growth of Instagram throughout its history, rising to two billion monthly users worldwide, the fame of INSTAGRAM is if anything even more pronounced now than at the time of the survey [in 2014].”¹³³

¹²⁹ 62 TTABVUE 2, 25-26 (Simonson Test. Decl. para. 2; Ford Test. Decl. paras. 2, 5).

¹³⁰ *Id.* at 26-27 (Ford Test. Decl. paras. 5-6).

¹³¹ *Id.* at 9 (Simonson Ex. Rep. paras. 11-13).

¹³² 62 TTABVUE 10 (Simonson Ex. Rep. para. 14).

¹³³ 77 TTABVUE 15.

As an initial matter, Applicant does not provide any critique of Dr. Simonson's credentials or of his or Dr. Ford's survey methodology or survey results. There also is no indication in the record that Applicant cross-examined Dr. Simonson. Applicant's sole argument is that the survey is flawed because "Opposer inappropriately uses the alleged fame of the mark 'INSTA' to support its assertion[]" but "INSTA is not a mark at issue in this case."¹³⁴ However, Dr. Simonson's testimony and expert report, and Dr. Ford's declaration and exhibits, on which they rely, all expressly address the INSTAGRAM mark in its entirety,¹³⁵ not the INSTA element alone. Applicant's arguments are relevant to the other survey about which Dr. Simonson also testified, i.e., Dr. Ford's survey regarding the secondary meaning of the INSTA element alone,¹³⁶ which we do not consider for purposes of establishing fame of the INSTAGRAM mark.

The only troubling aspect of this fame related evidence is its date. Dr. Simonson's declaration was signed on March 28, 2023, attaching his expert report dated June 23, 2016, and assessing Dr. Ford's declaration, which confirms that the survey addressing the issue of fame of the INSTAGRAM mark was designed and conducted in October 2014.¹³⁷ Thus, the Ford survey is somewhat stale, having been conducted more than eight years before Dr. Simonson's testimony declaration. It therefore is less probative on the issue of the current fame of Opposer's mark.

¹³⁴ 81 TTABVUE 26.

¹³⁵ 62 TTABVUE 2, 5-43 (Simonson Test. Decl. paras. 2-3 and Exhibit 1).

¹³⁶ *Id.* at 3, 44-79 (Simonson Test. Decl. para. 4-5 and Exhibit 2).

¹³⁷ *Id.* at 3, 10, 25 (Ford Decl. para. 2).

(d) Summary: Marketing Research and Survey Evidence

Notwithstanding the dated nature of some of Opposer's survey evidence, taken together, Opposer's marketing reports and combined survey evidence show that at several times relative to this proceeding, INSTAGRAM has been shown to be a strong brand and that, as succinctly put by Opposer: "[g]iven the exponential growth of Instagram throughout its history, rising to two billion monthly users worldwide, the fame of INSTAGRAM is if anything even more pronounced than at the time of the [Dr. Simonson] survey."¹³⁸

iii. Opposer's Enforcement Efforts

Opposer also made of record evidence of its enforcement efforts, which is pertinent to the strength of a mark. *Burns Philp Food, Inc. v. Modern Prods. Inc.*, Opp. No. 77,433, 1992 TTAB LEXIS 35, at*2 n.2 (TTAB 1992) (policing efforts go to the strength of the mark); 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11.91 (5th ed. 2024) ("It has been observed that an active program of prosecution of infringers, resulting in elimination of others' uses of similar marks, enhances the distinctiveness and strength of a mark: 'since no one else uses a similar sounding name, plaintiff's name looks and sounds all the more unique.'") (quoting *Dictaphone Corp. v. Dictamatic Corp.*, 1978 U.S. Dist. LEXIS 19802, at *18 (D. Or. 1978)).

As part of its enforcement efforts, Ms. Henry testified that Opposer has filed approximately 60 opposition and cancellation proceedings with this Board, opposing

¹³⁸ 77 TTABVUE 15.

applications or seeking to cancel registrations for marks that include the INSTA element.¹³⁹ Of these approximately 60 proceedings, Ms. Henry testified that “all that are now concluded have been successful.”¹⁴⁰ By “successful,” Ms. Henry explained that she means that “the applicant or registrant has (a) failed to file a response, resulting in a judgment that the mark is deemed abandoned; (b) agreed to withdraw the application or registration at issue; or (c) amended the application or registration to clarify that the trademark does not cover goods and services that compete with Instagram’s core offerings.”¹⁴¹

Honing in on successful enforcement actions against third-party INSTA-formative trademark users, Ms. Henry identified the following specific enforcement efforts as exemplary: (1) a successful cancellation action against a registration for INSTAVOICE, wherein the registrant amended its registration to delete references to visual images, and (2) a successful opposition proceeding, wherein the applicant amended its application for INSTANEWS “to delete references to sharing visual content.”¹⁴² Opposer made of record copies of filings from these matters and others,¹⁴³ and, because of Opposer’s overall enforcement efforts, Ms. Henry testified that

¹³⁹ 64 TTABVUE 8 (Henry Test. Decl. para. 19).

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.* (Henry Test. Decl. para. 20).

¹⁴³ 53 TTABVUE 66-360 (Exhibits 1-14 to 1-27).

“Instagram is not currently aware of any U.S. trademark registrations for INSTA-formative marks for mobile apps for photo editing, other than its own.”¹⁴⁴

In addition to evidence of its enforcement efforts through inter partes proceedings, Opposer also submitted “a sampling of third-party apps including INSTA in their names that have been **removed** from app stores due to Instagram’s enforcement efforts[,]”¹⁴⁵ which we address in some detail here and in more detail below. For purposes of this discussion, however, it is sufficient to note that Opposer made of record evidence of about 60 different INSTA mobile apps that are no longer available in the app stores.¹⁴⁶

The enforcement documentary evidence Opposer provided consists of inter partes proceedings that were resolved well before a decision on the merits, either by the defending party’s default, voluntary abandonment or withdrawal of an application, or the like. Thus, we cannot say that Opposer’s enforcement matters resolved in this fashion are “probative of the ... [fame] of ... [its] mark as opposed to the ... [defending] parties’ desire to avoid litigation.” *In re Dimarzio, Inc.*, Serial No. 87213400, 2021 TTAB LEXIS 457, at *17 n.24 (TTAB 2021) (citing *In re Wella Corp.*, 565 F.2d 143, 144 n.2 (CCPA 1977)). Opposer argues that in those cases involving applications for INSTA-formative marks that matured to registration, the applications and associated specimens of use made it clear that the marks at issue did not cover mobile

¹⁴⁴ 64 TTABVUE 9 (Henry Test. Decl. para. 21).

¹⁴⁵ 83 TTABVUE 20 (emphasis in italics in original, bold here).

¹⁴⁶ 73 TTABVUE (Exhibits 9-1 to 9-132).

apps for photo editing – and in some instances, were amended specifically to exclude any goods or services related to photo editing.¹⁴⁷ We acknowledge that in some instances the applications were so amended, but we cannot discern from the evidence of record, including the specimens, that such amendments were due to the fame of the INSTAGRAM mark or the applicant’s desire to avoid litigation.

We draw a distinction, however, between inter partes proceedings initiated with the Board and policing efforts directed to third-party uses of INSTA-formative apps removed from the app store. The evidence that third-parties ceased use of INSTA for apps under these circumstances appears more compelling evidence of the fame of Opposer’s mark. 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11.91 (“It has been observed that an active program of prosecution of infringers, resulting in elimination of others’ uses of similar marks, enhances the distinctiveness and strength of a mark: ‘since no one else uses a similar sounding name, plaintiff’s name looks and sounds all the more unique.’”) (quoting *Dictaphone*, 1978 U.S. Dist. LEXIS 19802, at *18).

Thus, we give Opposer’s evidence of its enforcement efforts some probative weight.

b. Applicant’s Attempts to Diminish the Conceptual and Commercial Strength of Opposer’s Mark

As the INSTAGRAM mark of both the ’057 and ’600 Registrations is registered on the Principal Register without a claim of acquired distinctiveness, and Applicant has not counterclaimed to cancel either registration, we must presume that the

¹⁴⁷ 77 TTABVUE 26 (*compare* 68 TTABVUE 10-60 (Exhibits 1-2 to 1-17) with 72 TTABVUE 59-286 (Exhibits 8-5 to 8-25)).

INSTAGRAM mark is inherently distinctive for the identified goods, i.e., that it is presumed to be at least suggestive of Opposer's goods. *Monster Energy*, 2023 TTAB LEXIS 14, at *26 ("With respect to its conceptual strength, Opposer's pleaded mark MONSTER ENERGY is registered on the Principal Register without a claim of acquired distinctiveness and so is treated as inherently distinctive."); *Made in Nature*, 2022 TTAB LEXIS 251, at *24 (mark registered on Principal Register without a claim of acquired distinctiveness presumed to be inherently distinctive). Nonetheless, we may acknowledge the conceptual weakness of a registered mark, if proven, in the course of a *DuPont* analysis. *In re Fat Boys Water Sports LLC*, Ser. No. 86490930, 2016 TTAB LEXIS 150, at *23 (TTAB 2016).

Applicant argues that the INSTA element of Opposer's mark is descriptive, relying on testimony of one of its co-founders, Mr. Lopez, who stated that "insta" is a common abbreviation for the word "instant."¹⁴⁸ Similarly, Applicant contends that the GRAM element is also descriptive, relying on a statement made by Opposer's co-founder, Kevin Systrom, who stated that "gram" means "the idea of recording something in your life (hence the suffix -gram)."¹⁴⁹ Because Opposer's mark is registered on the Principal Register and there is no counterclaim to cancel it, we cannot entertain an argument that the mark is descriptive, so we construe Applicant's arguments to mean that the mark is highly suggestive of Opposer's identified goods. *Am. Lebanese Syrian Associated Charities, Inc. v. Child Health Research Inst.*, Opp. No. 91190361, 2011

¹⁴⁸ 81 TTABVUE 23 (citing 70 TTABVUE 22 (Lopez Test. Decl., para. 11)).

¹⁴⁹ *Id.* (citing 68 TTABVUE 153 (Exhibit 2-1)).

TTAB LEXIS 260, at *20 (TTAB 2011) (“[O]pposer’s marks cannot be treated as merely descriptive; at worst the wording in opposer’s marks must be viewed as highly suggestive.”).

Opposer, for its part, contends that the mark is “at least suggestive, if not arbitrary.”¹⁵⁰ Even considering Mr. Systrom’s account of the origin of the mark, Opposer contends that “it **suggests** the concept of recording one’s life in the moment, but does not **describe** the features of the Instagram app that allow users to edit their photos, share content, and interact with friends and family.”¹⁵¹ Opposer also argues that Mr. Lopez’s testimony that INSTA means “instant” flies in the face of record evidence that demonstrates that INSTA is synonymous with Instagram, which includes (1) the dictionary definition that defines INSTA as meaning Instagram, (2) Dr. Simonson’s expert testimony that consumers associate INSTA with Instagram, and (3) that consumers and the media alike commonly use and recognize INSTA as a shorthand reference to Instagram, i.e., “Insta-worthy,” “Insta-ready,” “Insta-popular,” “Insta-famous,” and “Insta-stories.”¹⁵² Moreover, even assuming as Applicant alleges, that the term “insta” means “instant,” Opposer argues that this

¹⁵⁰ 77 TTABVUE 37.

¹⁵¹ *Id.* at 38 (emphasis in italics in original, bold here).

¹⁵² *Id.* at 10-11 (dictionary definition at 58 TTABVUE 196-97; INSTA registration at 72 TTABVUE 33; Dr. Simonson’s expert report regarding the secondary meaning of the INSTA element at 62 TTABVUE 3, 4-79; and consumer references to INSTA at, for example, 58 TTABVUE 158, 170-94).

does not render the INSTA component descriptive because “Instagram’s features – in particular its photo editing features – are not ‘instant.’”¹⁵³

“Instant,” defined as “[a] period of time so short as to be almost imperceptible”¹⁵⁴ and “Gram” is defined as “[s]omething written or drawn; a record.”¹⁵⁵ We find that the mark INSTAGRAM is suggestive of the identified goods, as the user must undertake a few mental steps to arrive at an understanding that INSTAGRAM suggests the act of photographing one’s life in the moment, editing and posting images of it.

Applicant seeks to diminish the conceptual strength of Opposer’s mark by making of record 16 third-party registrations for INSTA-formative marks.¹⁵⁶ Arguing that these third-party registrations show the INSTA segment has a well-recognized descriptive or suggestive meaning, Applicant contends that collectively the registrations show the INSTA element is relatively weak.¹⁵⁷

“[T]hird-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Made in Nature*, 2022 TTAB LEXIS 251, at *28-29 (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, Can. No. 92057132, 2017 TTAB LEXIS

¹⁵³ *Id.*

¹⁵⁴ The AMERICAN HERITAGE DICTIONARY, <https://ahdictionary.com/word/search.html?q=instant>, accessed on June 10, 2024.

¹⁵⁵ THE AMERICAN HERITAGE DICTIONARY, <https://ahdictionary.com/word/search.html?q=gram>, accessed on June 10, 2024.

¹⁵⁶ 68 TTABVUE 10-60 (Exhibits 1-2 to 1-17).

¹⁵⁷ 81 TTABVUE 41.

437, at *47 (TTAB 2017)); *see also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976) (Third-party registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used.”).

As discussed above, Applicant’s identified goods are legally identical to the goods identified in both the ’600 and ’527 Registrations. In its brief, Applicant simply assumes that all 16 of the third-party registrations for INSTA-formative marks identify “related goods” to Opposer’s mobile app for modifying the appearance and enabling the transmission of images, photographs, audio-visual and video content without any supporting argument, much less evidence. As shown below, some of these third-party registrations do not even identify mobile apps, and, to the extent that some do, the apps themselves are for completely unrelated purposes and functions. Mobile apps that have a purpose or function unrelated to Opposer’s mobile app are not probative of the conceptual weakness of the INSTA element in Opposer’s mark for Opposer’s goods. Said another way, because the parties’ goods are legally identical, in order for the third-party registrations to be relevant, they must identify a mobile app that has the same function or purpose as Opposer’s mobile app. *Sabhnani v. Mirage Brands, LLC*, Can. No. 92068086, 2021 TTAB LEXIS 464, at *31-32 (TTAB 2021) (After finding the parties’ goods identical, the Board considered only third-party registrations for identical goods in assessing weakness of Petitioner’s mark.). *See also Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 1326 (Fed. Cir. 2018) (where the parties’ goods were identical meat products, third-party uses on other food products were “properly understood as having no real probative

value for the analysis at hand.”); *In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration).

With this background in mind, we find that the following third-party registrations have no probative value:

- 1) INSTAX for “unexposed photographic film” and “photographic cameras” (Reg. No. 3990182).¹⁵⁸
- 2) INSTACART for, inter alia, “downloadable software for browsing and purchasing consumer goods of others” (Reg. No. 4903628).¹⁵⁹
- 3) INSTAPROOFS for “[p]roviding an online retail store for professional photographers to allow the photographers to sell their photographs and other photography related products” (Reg. No. 3647232).¹⁶⁰
- 4) INSTABRICK and Design for, inter alia, “downloadable web applications for displaying images and videos, capturing images, inventory management; all of the aforementioned goods for toy brick identification, classification and inventory and not for photo/video editing or sharing or social networking services” (Reg. No. 6913942).¹⁶¹
- 5) INSTAIMAGE for, inter alia, “digital imaging services; photography [services]” (Reg. No. 4263901).¹⁶²

¹⁵⁸ 68 TTABVUE 14-15 (Exhibit 1-3).

¹⁵⁹ *Id.* at 20-22 (Exhibit 1-5). The record shows that the application was amended post publication, together with the specimen, to limit goods and services to accessing recipes and information related to food, which Opposer contends was due to its enforcement efforts. 72 TTABVUE 132-137 (Exhibit 8-7).

¹⁶⁰ 68 TTABVUE 24-25 (Exhibit 1-6).

¹⁶¹ *Id.* at 31-32 (Exhibit 1-8). Applicant’s argument and chart is misleading to the extent that it fails to indicate that the identification contains the express limitation “all of the aforementioned goods for toy brick identification, classification and inventory and not for photo/video editing or sharing or social networking services”. 81 TTABVUE 42 & n.11.

¹⁶² 68 TTABVUE 34-35 (Exhibit 1-9).

- 6) INSTAKLIP for “videography services” (Reg. No. 5710324).¹⁶³
- 7) INSTAPAWN for “Computer application software for mobile phones, namely, e-commerce software for pawn shops to buy and sell pre-owned merchandise via auction or in person with the use of geofencing” (Reg. No. 5387483).¹⁶⁴
- 8) INSTAPRINTS for, inter alia, print products, retail store services for print products and photographic processing services (Reg. No. 5075947).¹⁶⁵
- 9) INSTACARD and Design for “[p]roviding a website featuring on-line non-downloadable software for use that enables users to create digital business cards and manage contacts” (Reg. No. 6641790).¹⁶⁶
- 10) INSTAX SHARE and Design for, inter alia, “mobile application software to enable the printing of photographic images from smartphones” (Reg. No. 4753778).¹⁶⁷
- 11) INSTANEWS for, inter alia, “Computer application software for mobile phones, namely, software for collection, syndication, and dissemination of news, information, editorials, opinions, announcements, advertisements, and user commentaries” (Reg. No. 5189204).¹⁶⁸

Other evidence that we completely disregard includes INSTA-FILM MAKER for, inter alia, “apparatus for the recording, transmission, and reproduction of sound and images” (Reg. No. 5357489),¹⁶⁹ which was filed not based on use in commerce but rather issued under Trademark Act Section 44(e), 15 U.S.C. §§ 1126(e), and for which

¹⁶³ *Id.* at 44-45 (Exhibit 1-12).

¹⁶⁴ *Id.* at 50-51 (Exhibit 1-14).

¹⁶⁵ *Id.* at 53-54 (Exhibit 1-15).

¹⁶⁶ *Id.* at 56-57 (Exhibit 1-16).

¹⁶⁷ 68 TTABVUE 11-12 (Exhibit 1-2). Although this application was originally filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), a combined Section 71 and 15 affidavit was subsequently filed and accepted, so we consider it. *Made in Nature*, 2022 TTAB LEXIS 251, at *30-31.

¹⁶⁸ 68 TTABVUE 59-60 (Exhibit 1-17).

¹⁶⁹ *Id.* at 26-29 (Exhibit 1-7).

there is no evidence that proof of use in commerce has been made. *Made in Nature*, 2022 TTAB LEXIS 251, at *30-31.

Having dispensed with the third-party registrations for unrelated goods or services and for which use in commerce has not been made, we are left with the following arguably relevant registrations with broad identifications of goods:

- 1) Insta360 (Stylized) for “downloadable computer software applications for panoramic imaging technology” (Reg. No. 5,271,872).¹⁷⁰
- 2) INSTAPLY for “Computer application software for mobile devices, namely, software that enables users to transmit and exchange messages with businesses” (Reg. No. 4530667).¹⁷¹
- 3) INSTAVOICE for “[c]ommunication services, namely, transmission of voice, audio, and voice and audio data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks” (Reg. No. 4269874).¹⁷²
- 4) INSTACHAT for “Downloadable software in the nature of a mobile application for video chatting and text chatting” (Reg. No. 5141127).¹⁷³

Even assuming these third-party registrations are relevant, this handful of “registrations of varying probative value . . . is a far cry from the large quantum of evidence of third-party use and registration that was held to be significant” in both *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015) and *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334 (Fed. Cir. 2015). *In re Inn at St. John’s, LLC*, Ser. No. 87075988, 2018 TTAB

¹⁷⁰ *Id.* at 37-38 (Exhibit 1-10).

¹⁷¹ *Id.* at 40-41 (Exhibit 1-11).

¹⁷² *Id.* at 47-48 (Exhibit 1-13).

¹⁷³ *Id.* at 17-18 (Exhibit 1-4).

LEXIS 170, at *12 (TTAB 2018), *aff'd*, 777 Fed. Appx. 516 (Fed. Cir. 2019). *See also*, *New Era Cap*, 2020 TTAB LEXIS 199, at *30 (“[We have ... minimal evidence of registrations of marks comprised of ERA for the same or similar goods that might demonstrate the inherent weakness of the ERA component as a source identifier. Thus, on this record, Opposer’s NEW ERA mark for the identified goods is conceptually strong, and ... Applicant has not shown that the mark has been weakened.”).

To further show that the INSTA element is weak, Applicant submitted Internet evidence showing a number of third-party mobile apps that contain the INSTA element in their app names.¹⁷⁴ Applicant contends that “[s]imply browsing the app listings in the Apple App store yields almost **90** instances of third-party use of INSTA-formative mobile apps, more than 60 of which are photo-related and video related.”¹⁷⁵ Applicant appears to concede that approximately 30 of these 90 uses are irrelevant, however, because it states that “60 of which are photo-related and video related.”¹⁷⁶ In any event, we are left to guess which 60 uses are most relevant, as Applicant’s brief includes details of only 8 such uses.¹⁷⁷

As discussed above, the parties’ goods are legally identical, and the Federal Circuit has held that where identical goods are involved, only third-party uses of marks for identical goods are probative of the possible weakness of the plaintiff’s mark. *Omaha*

¹⁷⁴ 81 TTABVUE 38-39.

¹⁷⁵ *Id.* at 39 (emphasis in underline in original, bold here).

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at 39-40.

Steaks, 908 F.3d at 1326; *see also Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Eds., Inc.*, 937 F.2d 1572, 1579 (Fed. Cir. 1991) (“ACE for canned, large peas could not escape likelihood of confusion with a prior use of ACE for canned, small peas because ACE is concurrently used by unrelated third parties on aircraft, clothing, computer services, hardware or even bread, bananas, milk and canned carrots. Properly defined, the relevant public in the example need be defined no broader than purchasers of canned peas, and the third party ACE marks outside the segment become essentially irrelevant.”). Thus, to the extent that the third-party INSTA-formative marks are for apps that do not function to modify the appearance and enable the transmission of photographs, images, audio-visual content and video content they are not probative.

Turning to the evidence in detail, we can immediately disregard the INSTALIGHTS app, as the record shows that it is not available.¹⁷⁸

We can also immediately disregard those apps whose function is not identical to or encompassed by Opposer’s identifications, which includes:

- InstaSun – allows the user to take time-lapse videos of sunsets, sunrises and other events.¹⁷⁹
- Instaswipecy – allows users to “[d]iscover and chat with potential dates around you.”¹⁸⁰
- InstaChatty – allows chatting with close friends.¹⁸¹

¹⁷⁸ Compare Applicant’s evidence 68 TTABVUE 325-28 (Exhibit 3-9) to Opposer’s evidence (73 TTABVUE 8, 530-533 (Exhibits 9-131 to 9-132)).

¹⁷⁹ 68 TTABVUE 315-17 (Exhibit 3-7).

¹⁸⁰ *Id.* at 351-53 (Exhibit 3-14).

¹⁸¹ *Id.* at 376-78 (Exhibit 3-19).

- Instamag Nature – provides green forest frames.¹⁸²
- InstaVideo – adds background music to videos.¹⁸³
- InstaMag – Cute Pet Camera – provides “adorable pets” with which the user can take photos.¹⁸⁴
- InstaVideo Add music to videos – adds background music to videos.¹⁸⁵
- Insta15 – allows a user to autorecord video without holding down a button.¹⁸⁶
- Instaweather –provides “[t]emperature on camera picture!”¹⁸⁷
- InstaWeather – allows users to select backgrounds for different weather conditions.¹⁸⁸
- Instadawg – allows users to connect with friends and dogs.¹⁸⁹
- InstaB For Baby – allows users to share baby’s milestones, growth and advice.¹⁹⁰
- Instaday. There is not enough information from which to discern the purpose or function of this app.¹⁹¹
- InstaSanta Camera–Christmas – allows users to send holiday photo cards.¹⁹²

¹⁸² *Id.* at 396-98 (Exhibit 3-23).

¹⁸³ *Id.* at 411-13 (Exhibit 3-26).

¹⁸⁴ *Id.* at 416-17 (Exhibit 3-27).

¹⁸⁵ *Id.* at 435-37 (Exhibit 3-31).

¹⁸⁶ *Id.* at 450-52 (Exhibit 3-34).

¹⁸⁷ *Id.* at 460-62 (Exhibit 3-36).

¹⁸⁸ *Id.* at 483-85 (Exhibit 3-41).

¹⁸⁹ *Id.* at 493-95 (Exhibit 3-43).

¹⁹⁰ *Id.* at 513-14 (Exhibit 3-47).

¹⁹¹ *Id.* at 517-19 (Exhibit 3-48).

¹⁹² *Id.* at 526-28 (Exhibit 3-50).

- Instashowing – allows users to schedule and manage real estate listings.¹⁹³
- InstaMini – This is “[a]n instant camera in your smartphone!”¹⁹⁴
- Instablog9ja App –a news app.¹⁹⁵
- Insta-Meet – an appointment app.¹⁹⁶
- InstaBioLink – allows users to add social media links easily to a bio.¹⁹⁷

Having determined that the above apps are not relevant, we are left with the following apps that arguably have functions identical to or encompassed by the functions of the mobile apps identified in Opposer’s ’057 and ’600 Registrations:

- “Selfie Cam – Instabeauty,”¹⁹⁸
- InstaLab – Retro Camera. This is a “disposable camera with a date stamp that gives your beautiful photos and [sic] the precious retro feel of the vintage camera.”¹⁹⁹
- Insta Safe – allows for the storage and management of photos but does not appear to allow users to edit or alter photos.²⁰⁰
- InstaMag – a photo collage maker.²⁰¹
- InstaTweet – allows the user to save a tweet as an image and share it on social media.²⁰²

¹⁹³ *Id.* at 561-62 (Exhibit 3-57).

¹⁹⁴ *Id.* at 623-25 (Exhibit 3-70).

¹⁹⁵ *Id.* at 638-39 (Exhibit 3-73).

¹⁹⁶ *Id.* at 700-01 (Exhibit 3-86).

¹⁹⁷ *Id.* at 613-15 (Exhibit 3-68).

¹⁹⁸ *Id.* at 565-67 (Exhibit 3-58).

¹⁹⁹ *Id.* at 295-97 (Exhibit 3-3).

²⁰⁰ *Id.* at 305-07 (Exhibit 3-5).

²⁰¹ *Id.* at 366-68 (Exhibit 3-17).

²⁰² *Id.* at 381-83 (Exhibit 3-20).

- Instacollage Maker – create video collages.²⁰³
- Insta frame –adds frames to photos.²⁰⁴
- Instamail Photos and Videos– allows users to attach multiple photos and videos to email, sms, and Facebook.²⁰⁵
- Insta Retro Collage – allows users to post multiple photos simultaneously.²⁰⁶
- Insta Video Converter MP4 – reduces the bit rate and resolution when converting videos.²⁰⁷
- Instaquote photos – photos that can speak. Allows users to show “amazing photos on Instagram.”²⁰⁸
- InstaGirls: Dress Up.²⁰⁹
- InstaSantaCamera – Christmas+.²¹⁰
- Insta Save – RepostWithColor.²¹¹
- Insta Animal Face Maker Pro – Change Your Face with Animal Stickers.²¹²
- Insta Animal Gif Creator.²¹³
- InstaPhotoFrame – Beauty Camera – Photo Editor.²¹⁴

²⁰³ *Id.* at 406-08 (Exhibit 3-25).

²⁰⁴ *Id.* at 465-67 (Exhibit 3-37).

²⁰⁵ *Id.* at 685-87 (Exhibit 3-83).

²⁰⁶ *Id.* at 291-92 (Exhibit 3-2).

²⁰⁷ *Id.* at 425-27 (Exhibit 3-29).

²⁰⁸ *Id.* at 401-03 (Exhibit 3-24).

²⁰⁹ *Id.* at 531-33 (Exhibit 3-51).

²¹⁰ *Id.* at 546-48 (Exhibit 3-54).

²¹¹ *Id.* at 574-76 (Exhibit 3-60).

²¹² *Id.* at 286-88 (Exhibit 3-1).

²¹³ *Id.* at 300-02 (Exhibit 3-4).

²¹⁴ *Id.* at 320-22 (Exhibit 3-8).

- Insta Shape Effects – Helps You to Decorates Picture with many Shape and Effects.²¹⁵
- Insta Art Photo Filters.²¹⁶
- Insta-Celebrity Camera.²¹⁷
- InstaPix Photo Editor –Bit Pixel Stickers for your Pictures.²¹⁸
- Insta Brasil – Brazil Carnival Rio de Janeiro Pics.²¹⁹
- Insta Square Art Photo Editor.²²⁰
- InstaPixel – A Funny Retro Photo Booth Editor with 8 Bit Stickers for your Pictures.²²¹
- Insta Toon: Cartoon & Art Cam.²²²
- Insta Emoji Photo Editor – adds stickers to pictures.²²³
- InstaRage – Photo Editor.²²⁴
- InstaCool Cam.²²⁵
- Insta Face Swap – Amazing Face Swapr.²²⁶

²¹⁵ *Id.* at 331-33 (Exhibit 3-10).

²¹⁶ *Id.* at 336-38 (Exhibit 3-11).

²¹⁷ *Id.* at 346-48 (Exhibit 3-13).

²¹⁸ *Id.* at 341-43 (Exhibit 3-12).

²¹⁹ *Id.* 356-58 (Exhibit 3-15).

²²⁰ *Id.* at 361-63 (Exhibit 3-16).

²²¹ *Id.* at 371-373 (Exhibit 3-18).

²²² *Id.* at 391-93 (Exhibit 3-22).

²²³ *Id.* at 420-22 (Exhibit 3-28).

²²⁴ *Id.* at 430-32 (Exhibit 3-30).

²²⁵ *Id.* at 440-42 (Exhibit 3-32).

²²⁶ *Id.* at 445-47 (Exhibit 3-33).

- InstaReka ~ Create Text/Themes Overlay on Photo.²²⁷
- Instacurves Pro – Body Shaper.²²⁸
- Insta360Moment.²²⁹
- InstaFun – Joke & Troll Frames – Wonder Photo.²³⁰
- Insta3D GifMoji.²³¹
- InstaRoo – Show Your Australian Side with An #AussieGram!²³²
- Insta Editor – edit photos.²³³
- InstaPhoto Collage - Photo Collage Maker + FX.²³⁴
- InstaEaster Happy Easter Day Photo Editor.²³⁵
- InstaPhoto Editor – Blurry Photo Effect.²³⁶
- InstaPic Frame.²³⁷
- InstaEditor – Instant photo filters.²³⁸
- InstaSnap. A versatile picture editor app.²³⁹

²²⁷ *Id.* at 455-57 (Exhibit 3-35).

²²⁸ *Id.* at 470-72 (Exhibit 3-37).

²²⁹ *Id.* at 475-76 (Exhibit 3-39).

²³⁰ *Id.* at 488-90 (Exhibit 3-42).

²³¹ *Id.* at 498-500 (Exhibit 3-44).

²³² *Id.* at 503-05 (Exhibit 3-45).

²³³ *Id.* at 508-10 (Exhibit 3-46).

²³⁴ *Id.* at 522-23 (Exhibit 3-49).

²³⁵ *Id.* at 536-38 (Exhibit 3-52).

²³⁶ *Id.* at 541-43 (Exhibit 3-53).

²³⁷ *Id.* at 551-53 (Exhibit 3-55).

²³⁸ *Id.* at 556-58 (Exhibit 3-56).

²³⁹ *Id.* at 570-71 (Exhibit 3-59).

- InstaSquare Photo Editor.²⁴⁰
- InstaHairColor2.²⁴¹
- Instasquare Photo Editor: Neon.²⁴²
- InstaStory – Funny overlays for your pictures, share them to [sic] your friends.²⁴³
- Insta Christmas Photo Frame – appears to allow users to add Christmas-themed frames around images.²⁴⁴
- Insta Filters Pro.²⁴⁵
- Insta Neon™ Pro Light FX Photo Editor.²⁴⁶
- InstaFace: face eyes blend morph with animal effect.²⁴⁷
- Insta Perfect Photo Editor 365 – Touch up photos, share to Facebook, Instagram, Snapchat in seconds.²⁴⁸
- Instand: Video FX and filters.²⁴⁹
- InstaFlower Photo Frame – Wonder Photo.²⁵⁰
- InstasBeauty – Makeup Camera!²⁵¹

²⁴⁰ *Id.* at 579-81 (Exhibit 3-61).

²⁴¹ *Id.* at 584-86 (Exhibit 3-62).

²⁴² *Id.* at 589-91 (Exhibit 3-63).

²⁴³ *Id.* at 599-600 (Exhibit 3-65).

²⁴⁴ *Id.* at 386-88 (Exhibit 3-21).

²⁴⁵ *Id.* at 603-05 (Exhibit 3-66).

²⁴⁶ *Id.* at 608-10 (Exhibit 3-67).

²⁴⁷ *Id.* at 618-20 (Exhibit 3-69).

²⁴⁸ *Id.* at 628-30 (Exhibit 3-71).

²⁴⁹ *Id.* at 633-35 (Exhibit 3-72).

²⁵⁰ *Id.* at 642-44 (Exhibit 3-74).

²⁵¹ *Id.* at 647-49 (Exhibit 3-75).

- InstaKitty – A funny Photo Booth Editor with Cute Kittens and Cool Cat Stickers for Your Pictures.²⁵²
- InstaBoo!: Happy Halloween.²⁵³
- Instsanty – Extract photos from videos.²⁵⁴
- InstaBeauty – Selfies.²⁵⁵
- InstaKitty – A Funny Picture Editor with Cute Cats and Kitties Stickers.²⁵⁶
- Insta Love Collage – Wonder Photo – Camera Sticker.²⁵⁷
- Insta Loop Boomerang Video Editor.²⁵⁸
- InstaMeme! – Photo Editor with Funny Meme Stickers.²⁵⁹
- Insta Kid Photo Fram – Babe photo collage – cute.²⁶⁰
- InstaCamera – simple cam.²⁶¹
- InstaRoid.²⁶²
- Instamemo.²⁶³
- InstaNRoll.²⁶⁴

²⁵² *Id.* at 656-58 (Exhibit 3-77).

²⁵³ *Id.* at 661-63 (Exhibit 3-78).

²⁵⁴ *Id.* at 666-68 (Exhibit 3-79).

²⁵⁵ *Id.* at 671-73 (Exhibit 3-80).

²⁵⁶ *Id.* at 676-77 (Exhibit 3-81).

²⁵⁷ *Id.* at 680-82 (Exhibit 3-82).

²⁵⁸ *Id.* at 690-92 (Exhibit 3-84).

²⁵⁹ *Id.* at 695-97 (Exhibit 3-85).

²⁶⁰ *Id.* at 704-06 (Exhibit 3-87).

²⁶¹ *Id.* at 310-12 (Exhibit 3-6).

²⁶² *Id.* at 479-80 (Exhibit 3-40).

²⁶³ *Id.* at 594-96 (Exhibit 3-64).

²⁶⁴ *Id.* at 652-53 (Exhibit 3-76).

To rebut Applicant's evidence of third-party use of the INSTA element in app names (discussed above), Opposer's submitted rebuttal evidence showing that it is engaged in an ongoing effort to stop this exact type of use. To that end, Opposer made of record evidence consisting mostly of archived webpages showing the availability of INSTA-named apps and evidence showing the apps are no longer available.²⁶⁵ The archived pages range in date from Oct. 4, 2013 to March 7, 2023, the latter of which was ten days before Opposer's Notice of Reliance was filed.²⁶⁶ For example, the record shows that the following apps are no longer available: Instabike app (Exhibits 9-1 to 9-2); InstaFishEye fur Instagram app (Exhibits 9-3 to 9-4); InstaFishEye Video app (Exhibits 9-5 to 9-6); InstaFishEye Live app (Exhibits 9-7 to 9-8); InstaFishEye Live Pro (No Ads) app (Exhibits 9-9 to 9-10); and InstaFishEye Video Pro app (Exhibits 9-11 to 9-12).²⁶⁷ Evidence of sixty additional apps having INSTA-formative marks that are no longer available is also of record.²⁶⁸ It is well established that a trademark owner is not required to challenge every arguably similar mark in the marketplace. *See, e.g., Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 889 F.2d 1070, 1074 (Fed. Cir. 1989) (noting that opposer "has been vigilant in protecting its marks from encroachment by others").

Opposer made additional evidence of record to support its position that the INSTA element is strongly associated with Opposer and, as a result, not weak. This includes

²⁶⁵ 73 TTABVUE.

²⁶⁶ *Id.*

²⁶⁷ *Id.* at 12-58 (Exhibits 9-1 to 9-12).

²⁶⁸ *Id.* at 59-533 (Exhibits 9-13 to 9-132).

(1) a dictionary definition that defines INSTA as meaning Instagram;²⁶⁹ (2) Opposer's registration for the INSTA mark (as opposed to the INSTAGRAM mark);²⁷⁰ (3) Dr. Simonson's expert testimony, based on a second survey conducted previously by Dr. Ford establishing that "INSTA' had acquired strong secondary meaning in the domain of photo sharing apps[;]"²⁷¹ and (4) media articles showing that consumers and the media alike commonly use and recognize INSTA as a shorthand reference to Instagram, i.e., "Insta-worthy," "Insta-ready," "Insta-popular," "Insta-famous," and "Insta-stories."²⁷²

Applicant goes to great lengths to challenge Opposer's INSTA (as opposed to INSTAGRAM) evidence, arguing that "[t]he Simonson report regarding the purported secondary meaning of INSTA is irrelevant to the issues in this proceeding as INSTA is not a mark at issue in the case."²⁷³ That is, Applicant clarifies, "Opposer has **not** pleaded the INSTA mark in this Opposition proceeding, nor established [its] priority over INSTASIZE."²⁷⁴ Applicant adds that "[t]o the extent any of Instagram's

²⁶⁹ 58 TTABVUE 196-98 (Exhibit 6-30) (CAMBRIDGE DICTIONARY (US version) showing: (1) "insta" means "someone's Instagram account: She shared her new look on her insta." and (2) "insta-" means "on Instagram or relating to Instagram: ... Fashion brands are taking notice on this Insta-phenomenon, too."). We do not consider the definition from the COLLINS DICTIONARY (collinsdictionary.com) because it refers to "British English." 75 TTABVUE 9 (Exhibit 10-1).

²⁷⁰ 72 TTABVUE 33-41 (Exhibit 8-2). INSTA (in standard characters) is registered for, inter alia, "[d]ownloadable computer software for modifying the appearance and enabling transmission of photographs" (Reg. No. 5061916); Section 8 accepted.

²⁷¹ 62 TTABVUE 3, 4-79 (Test. Decl. of Dr. Simonson and related Exhibit 2).

²⁷² 58 TTABVUE 158, 170-94.

²⁷³ 81 TTABVUE 26.

²⁷⁴ *Id.* at 26-27 (emphasis is italics in original, bold here).

arguments regarding fame rest on the alleged fame of INSTA, the Board must reject them out of hand.”²⁷⁵

Opposer counters that Applicant has misconstrued Opposer’s evidence and argument. “[Opposer] does not rely in this opposition proceeding on its trademark rights in INSTA, but that does not mean this Board can or should disregard the evidence that INSTA, as used in the INSTASIZE mark, means Instagram.”²⁷⁶

Opposer adds that it offers Dr. Simonson’s testimony about second meaning only to show that Applicant’s inclusion of the INSTA element in its mark is likely to cause confusion between INSTASIZE and INSTAGRAM.²⁷⁷

In short, we find Opposer’s evidence of the strength of the INSTA element to be persuasive, and we specifically address Dr. Simonson’s secondary meaning testimony in detail. As with the fame survey previously discussed, here again Dr. Simonson was asked by Opposer to evaluate a survey previously conducted by Dr. Ford in the spring of 2015, this one a secondary meaning survey.²⁷⁸ Dr. Simonson’s expert report, dated June 23, 2016, evaluated Dr. Ford’s secondary meaning survey and concluded that it was properly conducted and followed the appropriate standards for such surveys.²⁷⁹ “Based on the results of that survey, [Dr. Simonson] opined that ‘INSTA’ had

²⁷⁵ *Id.* at 27.

²⁷⁶ 83 TTABVUE 11.

²⁷⁷ 83 TTABVUE 11 & n.11.

²⁷⁸ 62 TTABVUE 3 (Simonson Test. Decl., para. 4).

²⁷⁹ *Id.*

acquired strong secondary meaning in the domain sharing apps.”²⁸⁰ Dr. Simonson’s current testimony is that he “stand[s] by that conclusion today.”²⁸¹

Specifically, “[t]he secondary meaning survey was designed to measure the level or degree, if any, to which the mark INSTA is associated with a photo-sharing app emanating from the named source Instagram or a sole, yet anonymous, source.”²⁸² In short, “a net ... of 67% of the participants associated ‘INSTA’ just with Instagram ... which strong supports the conclusion that the ‘INSTA’ component of INSTAGRAM has acquired secondary meaning.”²⁸³ Although Applicant argues that this secondary meaning survey evidence is not relevant,²⁸⁴ it does not otherwise seek to discredit this evidence or the survey’s methodology, nor did Applicant cross-examine Dr. Simonson or offer a rebuttal expert.

c. Conclusion as to Strength or Weakness of the INSTAGRAM Mark

In view of the above, we find that Opposer has established that its pleaded registered INSTAGRAM mark falls on the much higher end of the commercial strength spectrum from very strong to very weak and, in fact, is famous for a mobile app for modifying the appearance and enabling the transmission of photographs, images, audio-visual content and video content. The fame of Opposer’s mark is particularly significant because the evidence shows that it is well known to the

²⁸⁰ *Id.*

²⁸¹ *Id.*

²⁸² 62 TTABVUE 49 (Dr. Simonson’s Expert Report, para. 12).

²⁸³ *Id.* (Dr. Simonson’s Expert Report, para. 13).

²⁸⁴ 81 TTABVUE 26.

general public, as well as to users of mobile apps. Thus, Opposer's mark is "accorded more protection precisely because [it is] more likely to be remembered and associated in the public mind." *Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000) (citing *Kenner Parker Toys*, 963 F.2d at 352 and *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675 (Fed. Cir. 1984)).

We base our finding on Opposer's evidence discussed above, including its impressively high number of users (and Applicant's concession as to the same), its exceedingly high advertising expenses and revenues, and it being the subject of significant and consistent unsolicited media attention. We rely on Opposer's own commissioned periodic market research surveys and the surveys of Mr. Joachimsthaler and Dr. Simonson only to the extent they corroborate our findings.

Not all of Applicant's evidence of third-party use of INSTA-formative marks is pertinent and Opposer has demonstrated that it has successfully policed many uses. In addition, it is apparent that Opposer's survey results, including Dr. Poret's likelihood of confusion survey (discussed in detail below), rebut the inference we usually draw from widespread third-party use. That is if the third-party uses of INSTA-formative marks have been so pervasive as to cause purchasers to look to other portions of the marks to distinguish them, as Applicant argues, it should logically follow that not many of the respondents to the survey questions would associate INSTASIZE with INSTAGRAM because of the common INSTA portion. Accordingly, the fact that so many respondents **did** associate INSTASIZE with INSTAGRAM demonstrates to us that the third-party uses proffered by Applicant

have not yet had very much debilitating effect on the source-indicating significance of the INSTA element. In sum, while there is some evidence that the INSTA element of Opposer's mark has some conceptual and commercial weakness, this evidence is significantly outweighed by Opposer's evidence that the mark INSTAGRAM and the prefix INSTA are commercially strong. Overall, the evidence shows that even though there is some relevant third-party use of the INSTA element, the INSTAGRAM mark is strong and entitled to protection against INSTASIZE. We find the conceptual and commercial strength (and fame) of Opposer's inherently distinctive INSTAGRAM mark strongly supports a finding that confusion is likely.

4. Similarity or Dissimilarity of the Marks

“Under the first *DuPont* factor, we consider ‘the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.’” *Sabhnani*, 2021 TTAB LEXIS 464, at *33 (quoting *Palm Bay Imps.*, 396 F.3d at 1371-72). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *Id.* (quoting *In re Inn at St. John's*, 2018 TTAB LEXIS 170, at *13 (quotation omitted), *aff'd mem.*, 777 F. Appx. 516 (Fed. Cir. 2019)). “Similarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003)).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entirety, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. Nonetheless, there is nothing improper in stating

that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 746 F.3d at 1322. The focus is on the recollection of the average purchaser, who normally “retains a general rather than a specific impression of marks.” *In re i.am.symbolic*, Ser. No. 85916778, 2018 TTAB LEXIS 281, at *11-12 (TTAB 2018). As discussed above, the average customers of the identified goods are members of the general public who use mobile apps for editing images.

Moreover, where the parties’ goods are legally identical, as they are here, “the degree of similarity necessary to support a conclusion of likely confusion declines.” *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877 (Fed. Cir. 1992); *see also Bridgestone Ams. Tire*, 673 F.3d at 1337.

a. The Parties’ Arguments

Opposer argues that the parties’ marks are highly similar because both marks start with INSTA, which is the dominant element of the marks because it comes first and because it is more distinctive than the second portion (GRAM and SIZE) in both marks.²⁸⁵ Opposer argues that the distinctiveness of the INSTA portion is evidenced by its registration of the term alone (apart from the term INSTAGRAM) for an app for photo editing, which Opposer acknowledges, it did not plead but which is nonetheless relevant to the present analysis.²⁸⁶ Even apart from the registration, Opposer contends that the record shows that the INSTA element is strongly

²⁸⁵ 77 TTABVUE 31.

²⁸⁶ *Id.* at 31-32 & n.2.

associated with Opposer, as evidenced by (1) uses of INSTA-formative terms, such as “INSTA-worthy” in connection with Opposer’s app, and (2) the secondary meaning survey of the INSTA element, which shows that it has acquired strong secondary meaning in the domain of photo-sharing apps.²⁸⁷

Applicant disputes that INSTA is the dominant element of Opposer’s mark, that to arrive at Opposer’s conclusion one must necessarily improperly dissect the mark, and that the selection of INSTA as dominant is arbitrary.²⁸⁸ Moreover, Applicant contends that Opposer’s reliance on “any alleged rights in the word ‘INSTA’ ... is not a proper consideration by the Board[]”²⁸⁹ because Opposer did not plead its INSTA registration and it may not rely on any unpleaded registration in support of its claim.²⁹⁰ Even if INSTA is considered to be the dominant portion, Applicant contends that its mark is not a reference to Instagram but rather is a common abbreviation for the word “instant”²⁹¹ and that, when combined with the word “size,” the mark “signal[s] to consumers that its mark is used in connection with a tool that enables one to instantly size (or here resize) [one’s photos].”²⁹² Consequently, Applicant’s mark has an entirely different connotation and makes a different commercial impression, rendering the marks dissimilar.

²⁸⁷ *Id.* at 31-33; 83 TTABVUE 7-11.

²⁸⁸ 81 TTABVUE 19-21.

²⁸⁹ *Id.* at 19.

²⁹⁰ *Id.* at 19-20.

²⁹¹ *Id.* at 21-23.

²⁹² *Id.* at 23.

b. What is the Dominant Portion of the Parties' Marks?

Despite Applicant's arguments that it is improper to dissect the marks, its own arguments distinguish the constitute elements of its mark. In any event, Applicant's mark is a compound mark and it consists of the constituent elements INSTA and SIZE. Applicant does not argue that its mark has a distinct meaning apart from its constitute elements, and it is settled that compound marks may have a dominant portion. *See, e.g., Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, Opp. No. 91194148, 2015 TTAB LEXIS 260, at *27 (TTAB 2015) (“[W]hen a compound term [such as WINEBUD] comprises two ordinary English words, consumers often recognize them as such, rather than considering the combination to be a fanciful term with no meaning at all.”). In this regard, consumers are more likely to recall the first part of such a mark (here, INSTA). *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 1303 (Fed. Cir. 2018) (“The identity of the marks’ two initial words is particularly significant because consumers typically notice those words first.”); *Presto Prods., Inc. v. Nice-Pak Prods. Inc.*, Opp. No. 74797, 1988 TTAB LEXIS 60, at *7-8 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered[.]”). Moreover, Applicant's acknowledgement that the word SIZE is descriptive, i.e., that the app is used to “size” or “resize” an image,²⁹³ reinforces the notion that INSTA is the dominant portion. *See, e.g., In re Detroit Athletic*, 903 F.3d at 1305 (rational to give non-source identifying words “Co.” and “Club” less weight in the likelihood of confusion analysis); *In re Chatam Int’l Inc.*,

²⁹³ *Id.* at 23.

380 F.3d 1340, 1342-43 (Fed. Cir. 2004) (“Board properly accorded ... less weight” to generic term ALE because it had “nominal commercial significance”).

In view thereof, we conclude that INSTA is the dominant element in Applicant’s mark. For the reasons discussed above in considering the strength of the INSTAGRAM mark, we find INSTA is also the dominant element in Opposer’s mark. As a result, both marks share the same dominant element.

c. Comparison of the Marks

The marks’ different suffixes distinguish them somewhat, but we find that because the marks share the dominant prefix INSTA, the marks are more similar than different in overall appearance and sound. In addition, in terms of sound, the INSTASIZE mark is similar in structure and cadence to INSTAGRAM inasmuch as the marks share the term INSTA followed by a single-syllable word, i.e., SIZE versus GRAM. *Nat’l Pork Bd. v. Supreme Lobster and Seafood Co.*, Opp. No. 91166701, 2010 TTAB LEXIS 225, at *62 (TTAB 2010) (“[W]e find that the two marks involved herein [THE OTHER RED MEAT vs. THE OTHER WHITE MEAT] are highly similar, having the same structure and cadence and three of the same words.”); *H.D. Lee Co., Inc. v. Maidenform, Inc.*, Opp. No. 91168309, 2008 TTAB LEXIS 21, at *38 (TTAB 2008) (ONE FAB FIT vs. ONE TRUE FIT: “In terms of appearance and sound, the marks are similar to the extent that they share the same structure.”).

With respect to connotation and commercial impression, Applicant argues that INSTA is a common abbreviation for “instant.”²⁹⁴ The only support for this, however,

²⁹⁴ *Id.* at 23.

is the testimony of Mr. Lopez, one of Applicant's co-founders.²⁹⁵ Along these same lines, Applicant attempts to recast history to support its position that the prefix INSTA in its mark means "instantly" and does not evoke an association with Instagram. Specifically, Applicant cites Mr. Lopez's testimony to argue that Applicant created its app to be compatible with any social media platform (Instagram included) that was capable of sharing an edited photo, rather than created to work specifically with Instagram.²⁹⁶

However, Mr. Lopez's testimony is inconsistent with and belied by other evidence of record which shows that Applicant consistently and repeatedly referred to the app's use for posting to Instagram and that instead of promoting the app for use with a variety of social media platforms, Applicant explicitly and consistently referenced Instagram.

For example, in his deposition, Mr. Lopez described a tweet he sent on November 21, 2012, to let his followers know that the INSTASIZE app had launched:



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²⁹⁵ 70 TTABVUE 22 (Lopez Test. Decl., para. 11).

²⁹⁶ 81 TTABVUE 12 (citing 70 TTABVUE 25 (Lopez Test. Decl. para. 24)).

²⁹⁷ 54 TTABVUE 66.

Noticeably, the tweet explicitly touts its purpose, i.e., to “[q]uickly fit photos onto **Instagram**[.]” and it provides a link to INSTAGRAM;²⁹⁸ it does not reference or link to any other social media platforms.

Mr. Lopez also tweeted a great many individuals, essentially telling all of them to use the INSTASIZE app. The record contains slightly over 20 pages of posts that are essentially the same, the following of which are representative:



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²⁹⁸ *Id.* at 24 (Lopez Depo. Tr. 93:11-95:9) (emphasis in original).

²⁹⁹ *Id.* at 44-66 (Exhibit 2-3).

According to Mr. Lopez's deposition testimony, his Twitter account was temporarily suspended and his "guess is that it's ... due to the frequency" of the tweets.³⁰⁰ No other platforms are mentioned in these tweets.

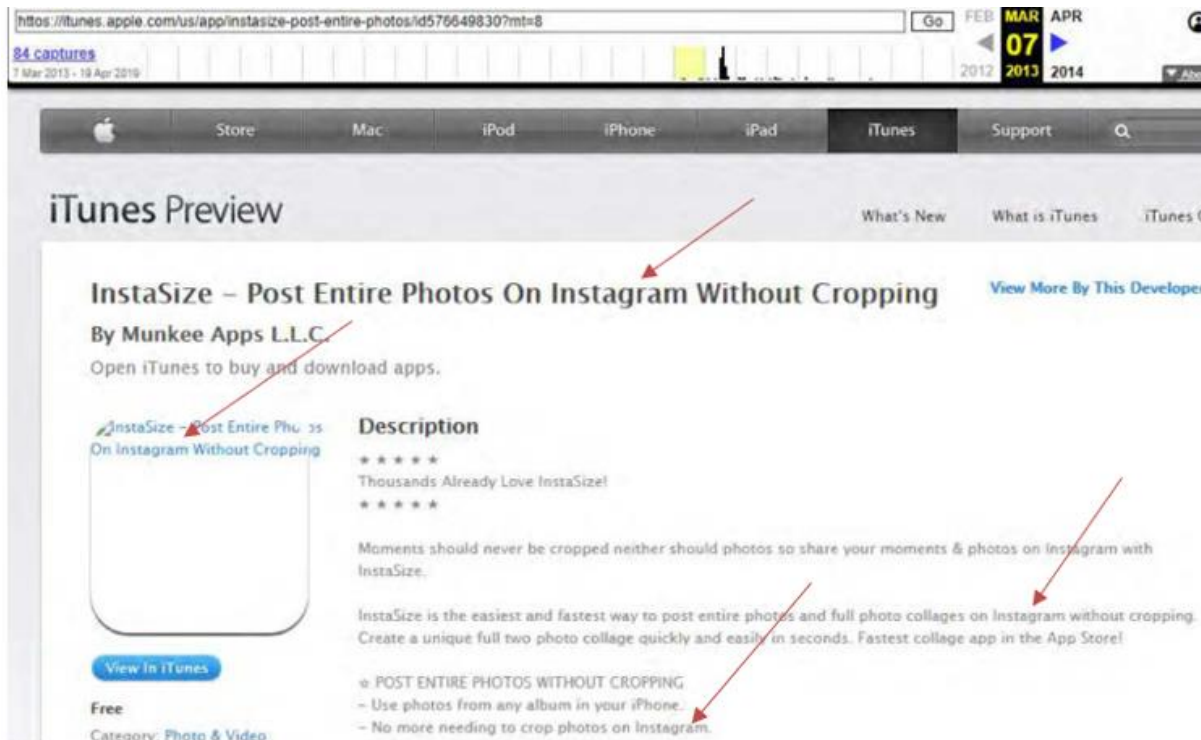
Similarly, Mr. Homez testified in his deposition that "the primary purpose of the app [was] so that users could post better fitting photos for **Instagram**."³⁰¹

An early archived version of Applicant's iTunes page includes multiple references to Instagram, including one reference in the app's title and five in its description, only two of which are shown in the cropped image below, including (not shown) "Support your favorite app for **Instagram!**"³⁰² No other social media platforms are mentioned.

³⁰⁰ *Id.* at 27 (Lopez Depo. Tr. 95:10-97:25).

³⁰¹ *Id.* at 70 (Homez Depo. Tr. 16:3-6) (emphasis added).

³⁰² *Id.* at 95 (Exhibit 2-7) (emphasis added).



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Further suggesting that Applicant intended its INSTA prefix to evoke an association with INSTAGRAM rather than the term “instantly,” the record shows that Applicant even originally used its mark in a script font and color scheme similar to that of Opposer’s:

³⁰³ *Id.* at 95 (Exhibit 2-7) (arrows added).



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Sometime after the launch of its app, some of Applicant’s advertising makes general references to social media but many ads still continue to explicitly reference Instagram:

- “instasize: The best **Instagram** filters you didn’t know you needed.”³⁰⁵
- “instasize: Get the vintage overlays you’ve seen on **Instagram**.”³⁰⁶
- “instasize: Best free stock photos for **Instagram**.”³⁰⁷
- “instasize: Aesthetic backgrounds to up your **Instagram** game.”³⁰⁸
- “instasize: Meet your new fave fonts for **Instagram**.”³⁰⁹

³⁰⁴ 56 TTABVUE 29; 57 TTABVUE 14, 15, 18, 22, 205.

³⁰⁵ 56 TTABVUE 31 (emphasize added).

³⁰⁶ *Id.* at 48 (emphasize added).

³⁰⁷ *Id.* at 54 (emphasize added).

³⁰⁸ *Id.* at 65 (emphasize added).

³⁰⁹ *Id.* at 69 (emphasize added).

Opposer, on the other hand, made of record evidence that INSTA is strongly associated with Instagram and is used as a reference to Instagram, evidence that we addressed to some extent earlier in this opinion. For example, the record contains a dictionary definition from the Cambridge Dictionary (US version) for the term “Insta”, which defines it in noun form as “short for Instagram: a social media service for sharing photographs and video” and “someone’s Instagram account: She shared her new look on her insta.”³¹⁰ The record also includes third-party uses of INSTA formative terms by consumers, celebrities, and media alike, such as “Insta-Artists,” “Insta-Poets,” “Insta-Official,” “Insta-Confirm,” “Insta-Stalk,” “Insta-Worthy,” “Insta-Ready,” “Insta-Popular,” “Insta-Famous” (also shown as “Insta Famous,” and “InstaFamous” i.e., as one or two words, and without the hyphen), “Insta-Story” and “Insta-stories” to refer to the presence of and posts on Instagram.³¹¹ In each of these instances, INSTA was used as a shorthand reference to Instagram.

We find that the record as a whole establishes that the INSTA portion of Applicant’s mark is more likely to be perceived as a reference to Instagram, particularly when considered in light of the identified goods, which are legally identical to Opposer’s identified goods. Accordingly, we find that Applicant’s mark conveys a meaning and commercial impression that its app is intended to be used to resize photos for sharing on Opposer’s INASTAGRAM app. Consumers encountering

³¹⁰ 58 TTABVUE 196 (Exhibit 6-30), which is a printout from the CAMBRIDGE DICTIONARY (US version).

³¹¹ 58 TTABVUE 158, 170-193 (Exhibits 6-22, 6-24 to 6-29); 75 TTABVUE 21-74 (Exhibits 10-4 to 10-17).

Applicant's mark are thus likely to mistakenly believe that INSTASIZE is an app sponsored or approved by Opposer for use with Opposer's INSTAGRAM app.

In sum, although the marks have different suffixes, when we compare them in their entireties, we find that on the whole they are more similar than dissimilar. Thus this *DuPont* factor favors a finding of likelihood of confusion.

5. The Nature and Extent of Any Actual Confusion

The parties vigorously dispute the seventh *DuPont* factor, i.e., the nature and extent of any actual confusion. "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion." *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317 (Fed. Cir. 2003). Both parties' produced documents that Opposer contends show actual confusion, while Applicant dismisses their significance. Some of the evidence is marked confidential, so, when necessary, we discuss it in general terms. As evidence responsive to the seventh *DuPont* factor, Opposer also produced a survey showing likelihood of confusion. We discuss this evidence in turn.

a. Incidents of Actual Confusion

Applicant produced emails with consumers that reference Instagram, which are summarized below:

- 10/19/13 email to Instasize.com from user asking, "Why am I not able to create a user name and password for my newly installed Instagram app? Please help!" Applicant replied, "We are a separate app from Instagram. You'll have to email them for question."³¹²

³¹² 56 TTABVUE 89.

- 9/4/16 email to Instasize.com from user regarding the user’s password change for an Instagram account. Applicant responded: “We are InstaSize, not Instagram. We are not affiliated with Instagram.”³¹³
- 8/14/17 email to Instasize.com from user regarding problems with the user’s Instagram account. Applicant responded, “We aren’t affiliated with Instagram and it sounds like this is an Instagram issue.” The user replied: “Oh yeah, I use InstaSize for every post that **I thought you were one and the same**. I love your app!!!!”³¹⁴
- 2/27/2017 user emailed Instasize.com to complain that the app kept kicking him off when he tried to save messages. Applicant responded: “With InstaSize, you can’t message anyone. Are you referring to Instagram? We aren’t affiliated with Instagram.”³¹⁵
- 6/18/18 email exchange between Applicant and user regarding the user’s inability to enter the user’s Instagram account. Applicant responded, “this is Instasize the photo and video editing application. Do you mean to email Instasize or Instagram?”³¹⁶
- 6/28/18 user emailed Instasize.com complaining: “I have been blocked out of signing into my Instagram app for almost a week now.” Applicant responded, “We are not Instagram, that is a separate application.” The user was sent the link to Applicant instead of Opposer by Apple support.³¹⁷
- 6/19/17 a user emailed Instasize requesting that the user’s Instagram account be deleted. Applicant responded, “We are not affiliated with Instagram. This is InstaSize.”³¹⁸

Additionally, Ms. Henry, Meta Platforms, Inc., Global Director of Brand Marketing Instagram, testified about instances of confusion demonstrated by “bug

³¹³ *Id.* at 91.

³¹⁴ *Id.* at 93-94 (emphasis added).

³¹⁵ *Id.* at 96-97.

³¹⁶ *Id.* at 99.

³¹⁷ *Id.* at 101-04.

³¹⁸ *Id.* at 106.

reports.”³¹⁹ Because these bug reports are confidential, we do not discuss their specifics but suffice it to say that Ms. Henry testified about five incidents spanning November 2016 through April 2020 showing users contacting Opposer with questions about Applicant’s app.³²⁰

Applicant makes a series of arguments seeking to discredit all this evidence. First, Applicant argues that the emails are “inquiries” and that, in some instances, the users clearly understand that the two apps are different, so these incidents do not show confusion.³²¹ Second, even assuming that all incidents show confusion, these handful of incidents spread out over a decade are de minimus when compared to the billions of users of Opposer’s app and are, therefore, insufficient to prove likelihood of confusion.³²²

Opposer counters that true inquiry evidence would consist of users inquiring as to whether the two entities are related; here, the users clearly believe that there is an affiliation, even if they do understand that the apps are different.³²³ Moreover, Applicant in its own reply emails to the users acknowledges the confusion and tries to correct it, generally explaining that the two apps are unaffiliated.³²⁴ Further,

³¹⁹ 64 TTABVUE 9 (Henry Test. Decl. para. 22); confidential exhibits F-J available at 65 TTABVUE 41-59.

³²⁰ In its brief, Applicant acknowledges four incidents, not five; however, Applicant listed all five incidents. Applicant appears to have miscounted because the fifth incident was not separately bulleted. 80 TTABVUE 33.

³²¹ 81 TTABVUE 31-32.

³²² *Id.* 33-34.

³²³ 83 TTABVUE 21-22.

³²⁴ 77 TTABVUE 23.

because any evidence of confusion is notoriously hard to come by, this evidence is highly probative, even if it is spread out over several years.³²⁵

We agree with Opposer that the email exchanges are more than mere inquiry and that they show consumer confusion.³²⁶ Moreover, Applicant's employees understand that the users are confused, not merely inquiring, because Applicant's employees clarify that there is no relationship between the apps, illustrated by the representative response, "We are not affiliated with Instagram. This is InstaSize."³²⁷

While it is true that actual confusion experienced by eleven users, given the combined billions of users of the parties' apps, could be deemed insignificant, we find it persuasive due to the fact that the parties' apps are free to download, as in this setting even a few instances of actual confusion can be very persuasive. *See Beer Nuts v. Clover Club Foods Co.*, 805 F.2d 920, 928 (10th Cir. 1986) ("Purchasers are unlikely to bother to inform the trademark owner when they are confused about an inexpensive product.").

b. The Perot Declaration, Report and Exhibits

We now turn to Opposer's survey on likelihood of confusion.³²⁸ Historically, a properly conducted survey has been considered akin to actual confusion. *See Blue Cross and Blue Shield Ass'n v. Harvard Comty. Health Plan Inc.*, Opp. No. 78,270, 1990 TTAB LEXIS 43, at *8 n.7 (TTAB 1990) (Even though "applicant's study/survey

³²⁵ 83 TTABVUE 21-22.

³²⁶ 56 TTABVUE 93-94 (emphasis added).

³²⁷ *Id.* at 106.

³²⁸ 66 TTABVUE.

... had certain defects ... it nevertheless constitutes evidence of specific instances of actual confusion.”). More recently, it has been considered not direct evidence of actual confusion, but rather circumstantial evidence from which we may infer likelihood of confusion. *ProMark Brands, Inc. v. GFA Brands, Inc.*, Opp. No. 91194974, 2015 TTAB LEXIS 67, at *49 (TTAB 2015).

Mr. Poret has been qualified as a survey expert in previous court and Board cases, and on the basis of his experience, education and training,³²⁹ we find that he is qualified to opine on the issue of likelihood of confusion here on the basis of his survey. Mr. Poret was retained to conduct a survey to assess whether the INSTASIZE mark in connection with a photo editing app is likely to cause confusion with the INSTAGRAM mark.³³⁰

A total of 400 US consumers of mobile apps for photo editing participated in this online survey.³³¹ Because it was conducted online, all instructions and questions were displayed on each survey respondent’s computer screen.³³² Utilizing the Eveready³³³

³²⁹ *Id.* at 37-47.

³³⁰ *Id.* at 7.

³³¹ *Id.* at 9.

³³² *Id.* at 11.

³³³ *Id.* at 9. Named for a case in which it was used with approval, *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366 (7th Cir. 1976). “The ‘Eveready’ survey format does not inform survey respondents what the senior mark is, but assumes that they are aware of the mark from their prior experience.... ‘In cases involving strong marks, the Eveready test should be considered the gold standard for fundamental cognitive and marketing reason.’” 5 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11.91 (quoting J.B. Swann, LIKELIHOOD OF CONFUSION STUDIES AND THE STRAIGHTENED SCOPE OF SQUIRT, 98 Trademark Rptr. 739, 746 (2008)).

survey design, the 400 respondents were evenly divided into two groups.³³⁴ The survey used the accepted protocol of showing one group of respondents (the “Test Group”) the involved mark and a separate group of respondents (the “Control Group”) a different mark intended to determine the level of survey “noise,” which Mr. Perot described as “the tendency of survey respondents to identify Instagram for reasons that cannot be attributed to the genuine confusing similarity of the Instagram mark and InstaSize mark, such as similarity of app type, guessing, or other forms of respondent or survey error.”³³⁵

The Test Group was shown the involved mark: INSTASIZE.³³⁶ In contrast, the Control Group took an identical survey, with the sole exception that the INSTASIZE mark was replaced with the control mark: QUICKSIZE.³³⁷ Mr. Poret explained that the control mark conformed with the standard for creating an ideal control, as articulated in the Reference Guide on Survey Research: “In designing a control group study, the expert should select a stimulus for the control group that shares as many characteristics with the control group as possible, with the key exception of the characteristic whose influence is being assessed.”³³⁸ As Mr. Poret explained, “The control mark QuickSize was ideal because it held constant the SIZE portion of the

³³⁴ 66 TTABVUE 9.

³³⁵ *Id.* at 9.

³³⁶ *Id.* at 10.

³³⁷ *Id.*

³³⁸ *Id.* at 10-11.

mark and also retained the same structure of a five-letter prefix (Quick) that has a related connotation to ‘Insta.’”³³⁹

In the survey, respondents were shown the mark, described as a mobile app for photo editing, and asked what company put out the app, whether that company puts out other products or apps, and what those other products or apps were.³⁴⁰ In the Test Group, 47.5% of respondents named INSTAGRAM in response to the confusion questions; in the Control Group, 3.5% named INSTAGRAM.³⁴¹ This resulted in a net confusion finding of 44%.³⁴² Mr. Poret concluded that the survey showed that the “InstaSize mark creates a very high likelihood of confusion with respect to Instagram’s marks.”³⁴³

Applicant did not depose Mr. Poret or submit any rebuttal expert testimony, but argues that the control stimulus, QUICKSIZE, was improper because it tested the likelihood of confusion between INSTASIZE and INSTA, rather than INSTASIZE and INSTAGRAM. For support for its argument, Applicant compares the present survey to a different survey conducted by Mr. Poret in an unrelated proceeding: *Combe Inc. v. Dr. Aug. Wolff Gm.EH & Co.*, 382 F.Supp.3d 429, 461 (E.D. Va. 2019), in which Combe Inc., owner of the mark VAGISIL, opposed an application to register

³³⁹ *Id.* at 11.

³⁴⁰ *Id.* at 12-16.

³⁴¹ *Id.* at 17.

³⁴² *Id.* at 17.

³⁴³ *Id.* at 3, 17.

the mark VAGISAN.³⁴⁴ In that case, Applicant contends that Mr. Poret tested the likelihood of confusion between VAGISAN and VAGISIL by using the control VAGIPUR.³⁴⁵ Based on this unrelated survey, Applicant concludes that Mr. Poret should have used an INSTA-formative mark as the control, not a QUICK-formative one.³⁴⁶

Opposer disagrees and offers rebuttal testimony from Mr. Poret to explain the differences in the issues in the two cases, and the impact that the issues had on the selection of the control mark:

4. Applicant previously submitted my expert report in the [VAGISIL matter] in its opposition to Instagram’s motion for summary judgment in this proceeding, in support of their argument that I chose the wrong control in my survey regarding INSTASIZE. In particular, Applicant criticized my survey because the Control Group replaced the mark INSTASIZE with a mark that did not contain the “INSTA” prefix, namely QUICKSIZE. In support of its position, Applicant pointed to my expert report in the **Combe** case, in which the senior user (the owner of the VAGISIL mark) opposed registration of the mark VAGISAN, and I used a control that retained the “VAGI” prefix, namely changing VAGISAN to VAGIPUR.

5. The reason for the difference in controls in the different cases is straightforward. In the case of the VAGISIL mark, the “VAGI” prefix was the root of the generic term (“vaginal”) for the category at issue – vaginal care products, such as vaginal creams and gels. The Applicant (owner of the VAGISIL mark) did not claim that the prefix “VAGI” for vaginal care products was distinctive on its own, and did not object to the use of the “VAGI” prefix on its own for Applicant’s “vaginal” care product. Accordingly, for the purposes of creating a control, I did not alter the “VAGI”

³⁴⁴ 81 TTABVUE 36-37 & n.10.

³⁴⁵ *Id.*

³⁴⁶ *Id.*

prefix, but rather changed the suffix to reduce the overall similarity to VAGISIL (changing VAGISAN to VAGIPUR).

6. The present situation is entirely different. Here, the “INSTA” prefix is not the root of a generic term for the relevant product category. The Applicant’s product is not an “Instant,” it is a photo editing app. Furthermore, Opposer in the present case does claim that the “INSTA” prefix is distinctive of Instagram in the context of photo editing apps, and it is precisely Applicant’s use of “INSTA” (not SIZE) that is alleged to cause confusion. Accordingly, it is appropriate, and in fact **necessary**, for the control to alter the “INSTA” prefix, as this is the cause of the alleged confusing similarity.

7. In addition, to the extent that Applicant claims that it has a right to use a term that suggests speed or quickness of its product, I purposefully selected a control term that does so – QUICKSIZE. Retaining a term (QUICK) that conveys something similar to “INSTA” properly removed the allegedly confusing similarity to INSTAGRAM while allowing the control mark to retain the connotation of speed or quickness.

8. It is also easy to see that Applicant’s position is meritless (and in fact completely backwards) when considering what would have occurred if Applicant’s position had been implemented. Applicant’s position is that the control term should have retained the “INSTA” prefix. This begs the question of how then, if at all, the test term INSTASIZE could have been altered to create a control. If the control for INSTASIZE had retained the “INSTA” prefix, the only way to create a control would have been to replace the term “SIZE.” This, however, makes no sense at all, as the term “SIZE” is not alleged to be the cause of any confusion, and Applicant [sic] has no objection to use of the word SIZE. As this makes clear, Applicant’s suggestion is that I should have done the exact **opposite** of a proper control – namely, I should have created a control that retains the allegedly confusing aspect.³⁴⁷

³⁴⁷ 83 TTABVUE 14; 74 TTABVUE 3-4 (Perot Rebuttal Test. Decl. paras. 4-8) (underline in original, bold here).

Our review of the Poret survey satisfies us that Mr. Poret properly conducted the survey. In particular: the survey's universe was properly defined as US consumers of mobile apps for photo editing; the survey questions followed the generally-accepted Eveready format by posing non-leading, open-ended questions and by asking appropriate follow-up questions, *see Union Carbide Corp. v. Ever-Ready*, 531 F.2d at 385-89, and the survey employed an acceptable control.³⁴⁸ *ProMark Brands*, 2015 TTAB LEXIS 67, at *57 (Board found the survey proper where the test group was shown a stimulus card on which was printed SMART BALANCE, while the control group was shown RIGHT BALANCE, in a proceeding to determine the likelihood of confusion between Applicant's SMART BALANCE mark and Opposer's SMART ONES mark).

Having found Applicant's criticism of the choice of control mark unpersuasive, we find that the net rate of 44.0% confusion here is strongly probative of a likelihood of confusion. *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463-64 (Fed. Cir. 1991) (A consumer survey in which 30% of the respondents were confused supports a finding of likely confusion.). While the survey is not necessary to reach a conclusion that there is a likelihood of confusion, it is strong confirmation of this conclusion in this case.

c. Summary of the Seventh *DuPont* Factor

Evidence of actual confusion is typically difficult to find because many incidents are unreported, particularly where, as here, the goods are inexpensive. Accordingly,

³⁴⁸ 66 TTABVUE 9-16.

we find the evidence discussed above causes this factor to weigh in favor of a finding of a likelihood of confusion. *See, e.g., Majestic Distilling*, 315 F.3d at 1317. Our finding is corroborated by Opposer’s survey on likelihood of confusion.³⁴⁹

Accordingly, this factor weighs heavily in favor of likely confusion. We hasten to add that proof of actual confusion is not necessary to establish likelihood of confusion, *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571 (Fed. Cir. 1983), and we would reach the same outcome in this case even without the evidence of actual confusion or the survey evidence.

6. Other Probative Evidence of the Effect of Use

Under the thirteenth *DuPont* factor, we consider any other established fact probative of the effect of use, including an applicant’s intent in adopting its mark. *L.C. Licensing, Inc. v. Berman*, Opp. No. 91162330, 2008 TTAB LEXIS 756, at *20 (TTAB 2008).

“[P]roof of intent to trade on another’s goodwill” can provide “persuasive evidence of likelihood of confusion[.]” *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 891 (Fed. Cir. 1988). “To show intent, [O]pposer must establish that [A]pplicant had more than mere knowledge of [O]pposer’s prior mark.” *Bd. of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, Opp. No. 91183196, 2014 TTAB LEXIS 92,

³⁴⁹ Having found evidence of actual confusion under the seventh *DuPont* factor, we need not consider Applicant’s arguments that the eighth *DuPont* factor - the length of time during and conditions under which there has been concurrent use without evidence of actual confusion – weighs in its favor. 81 TTABVUE 37-38.

at *45 (TTAB 2014) (citing *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1565 (Fed. Cir. 1987)).

Opposer contends that Applicant chose its app name with the intent to trade off Instagram’s goodwill and the evidence from which such intent can be found is overwhelming.³⁵⁰

The InstaSize app was expressly designed to fix a “problem” with Instagram regarding the “sizing” of photographs, and video evidence confirms that the name of the app originated at the same time the concept for the app was developed. Marketing for the launch of the InstaSize app was targeted directly at Instagram users, including by tweeting to individual users and suggesting they try the InstaSize app. The app store listings for the InstaSize app, as well as many articles and features on the Instasize website, expressly invoked Instagram – including by imitating Instagram’s script font and blue background, offering tips for posting on Instagram, and instructing users how to take the most “Instagrammable” photos. Moreover, Instasize has seized every opportunity to draw out this opposition proceeding as long as possible, [redacted portion]. The conclusion that Instasize is attempting to deceive consumers into thinking that InstaSize and Instagram are related, is inescapable.³⁵¹

The redacted portion in the quote above is confidential and is a statement made by one of Opposer’s co-founders, which, suffice it to say, does not paint Applicant in a favorable light.

³⁵⁰ 77 TTABVUE 46.

³⁵¹ *Id.* at 47 (citation omitted).

Applicant contends that its lack of bad faith adoption is supported by Opposer's own 2012 API Terms of Use, which expressly authorized the use of either "insta" or "gram" in app names, and that this alone precludes a finding of bad faith.³⁵²

By way of background, API is an initialism for Application Programming Interface.³⁵³ Opposer's API allows app developers, who agree to its Terms of Use, to integrate their apps with the Instagram platform.³⁵⁴ By its terms, Opposer expressly reserves the right to update its Terms of Use from time to time and without notice, which Opposer did during the pertinent time period here, so different versions of the Terms of Use are in the record.³⁵⁵ Overall, the API Terms of Use specify the conditions under which Instagram granted developers a license to use Instagram's API.

At the time Instagram launched its API in February 2011, Instagram's API Terms of Use provided in part: "While you cannot use the word 'Instagram' or 'IG' in your product's name, it's okay to use one (but not both) of the following: 'Insta' or 'gram.'"³⁵⁶

Ms. Henry, Global Brand Director for Instagram, testified that on or about July 30, 2012, the sentence that stated "While you cannot use the word 'Instagram' or 'IG' in your product's name, it's okay to use one (but not both) of the following: 'Insta' or 'gram'" was removed from the API Terms of Use.³⁵⁷

³⁵² 81 TTABVUE 28.

³⁵³ 64 TTABVUE 9 (Henry Test. Decl. para. 23).

³⁵⁴ *Id.* at 9 (Henry Test. Decl. para. 23).

³⁵⁵ *Id.* at 13-26 (Exhibits K-M to the Henry Test. Decl.).

³⁵⁶ *Id.* at 17 (Exhibit K to the Henry Test. Decl.). Ms. Henry testified that Exhibit K is a true and correct copy of the API Terms of Use that Opposer had in place as of April 2012. 64 TTABVUE 9 (Henry Test. Decl. para. 23).

³⁵⁷ 64 TTABVUE 9, 18-22 (Henry Test. Decl. para. 24 and Exhibit L).

Ms. Henry further testified that about a year later, “[o]n or about July 22, 2013, Instagram published new API Terms of Use that incorporated by reference Instagram’s Brand Guidelines[,]” which expressly prohibited the use of, for example, “insta” in app names.³⁵⁸ “Since then, Instagram’s API Terms of Use and/or its Brand Guidelines have prohibited using ‘insta’ or ‘gram’ as part of an app name or brand.”³⁵⁹

Applicant contends that Opposer’s 2012 API Terms of Use “conveyed a public policy statement of the Opposer as to its blessing of third parties adopting marks containing either the prefix INSTA- or suffix -GRAM for use in association with the INSTAGRAM platform[,]” and “provided explicit permission to those entering the market to use either the wording ‘INSTA’ or ‘GRAM’ in their names[.]”³⁶⁰ Mr. Homez, Applicant’s CFO, testified that he “reviewed Instagram’s API Terms of Use” and “understood them to permit third parties to use the INSTA formative in app names.”³⁶¹ Applicant maintains that regardless of when Opposer changed the terms, the terms of the API existing at the time Applicant adopted the INSTASIZE mark evidenced a business-driven conclusion and belief by Opposer that use of either the INSTA or GRAM formative would not result in confusion.³⁶² Lastly, Opposer’s assertion that because Applicant did not connect to Opposer’s API and therefore its

³⁵⁸ 64 TTABVUE 10, 28-32 (Henry Test. Decl. paras. 25-26 and Exhibit N).

³⁵⁹ *Id.* at 10, 33-40 (Henry Test. Decl. para. 27 and Exhibit O).

³⁶⁰ 81 TTABVUE 12, 13.

³⁶¹ *Id.* at 29; 70 TTABVUE 3 (Homez Test. Decl. para. 8).

³⁶² 81 TTABVUE 29.

Terms of Use do not pertain to it, is “a narrow view [that] simply ignores the relevance of what that policy meant and how it impacts any likelihood of confusion analysis.”³⁶³

The record is clear that Applicant never integrated with Opposer’s API, which was established in Mr. Homez’s deposition:

8. Are you familiar with the ability to

9 connect to Instagram’s API?

10 A. Yes, I am.

11 Q. What does that mean?

12 A. Instagram has -- you just connect to

13 Instagram and they provide you tools for developers or

14 allow you to use certain features.

15 Q. Has Instasize ever been integrated with

16 Instagram’s API?

17 A. Never.

18 Q. Why not?

19 A. We never needed to.³⁶⁴

Similarly, Mr. Lopez testified in his deposition:

14 Q. Was Instasize ever connected to Instagram’s

15 API?

16 A. No.

17 Q. So did Instasize ever agree to the API terms

³⁶³ 81 TTABVUE 29-30.

³⁶⁴ 54 TTABVUE 81 (Homez Depo. Tr. 85:8-19).

18 of service?

19 A. I'm not sure. I think you would have to use
20 the API to be bound by the terms. I don't know if
21 there's some other way to be bound by them, but I
22 assume, if we had never used the API, then I believe
23 we would never be bound by those terms.

24 Q. And so why is it that you felt it was okay to
25 call your app Instasize when, in fact, you had not
1 entered into an agreement with Instagram that would
2 even relate to any sort of potential permission to use
3 "insta" in a name?

....

5 THE WITNESS: I don't think it's relevant to
6 make a consideration of what Instagram's policy is
7 regarding our own app name, or API policy regarding
8 our own app name.

....

10 Q. It's just not relevant to whether Instasize
11 can or cannot use that name. Is that what you're
12 saying?

13 A. That's what I'm saying. It's not -- we
14 wouldn't even make a consideration looking at an

15 Instagram API for our own app name.

....

5 Q. Did you read these API terms prior to

6 launching in November 2012?

7 A. No, I did not.³⁶⁵

We find unpersuasive Applicant's argument that Opposer's Terms of Use serve as a public policy statement publicizing Instagram's belief at that time as to the absence of confusion for marks containing either INSTA or GRAM. The Terms of Use are clear on their face. Any developer using Instagram's API is granted a license:

Thank you for using the Instagram application programming interfaces (the "Instagram APIs"). By using the Instagram APIs, you agree to the terms below. If you disagree with any of these terms, Instagram does not grant you a license to use the Instagram APIs.³⁶⁶

This license is not a "public policy statement" to the general public, and Opposer's publishing its Terms of Use does not change this. By the face of the agreement, and consistent with general contract law principles, the terms apply only to the parties to the agreement. As Mr. Lopez clearly testified, Applicant did not connect to Instagram's API, therefore, it could not as a non-licensee avail itself of any of the provisions of the Terms of Use, such as the ability to use of the term "insta" in its app name. To the extent that the Terms of Use reflect a business decision by Opposer, as Applicant alleges, such a decision benefited only its licensees and even then, only up

³⁶⁵ 54 TTABVUE 19-21 (Lopez Depo. Tr. 84:14 to 87:7).

³⁶⁶ 64 TTABVUE 14 (Exhibit K to the Henry Test. Decl.).

and until around July 22, 2013 when Opposer changed its Terms of Use to prohibit inclusion of the INSTA or GRAM elements in its licensee's app names.

Applicant's reliance on *Travelers Indem. Co. v. Trou, Inc.*, Can No. 92067396, 2020 TTAB LEXIS 369 (TTAB 2020) (non-precedential)³⁶⁷ is misplaced. Here, as in *Travelers*, the parties did not enter into an agreement. The Board considered the lack of an agreement under the tenth *DuPont* factor, i.e., lack of market interface, which is different than the issue here—bad faith adoption under the thirteenth *DuPont* factor. As the Board acknowledged in *Travelers*, the lack of evidence of a prior agreement would support the defendant's affirmative defenses of laches or acquiescence, but no affirmative defenses have been pursued in the present matter. *Id.* at *52. Similarly, Applicant's reliance on *Bongrain Int'l Corp. v. Delice de Fr., Inc.*, 811 F.2d 1479 (Fed. Cir. 1987)³⁶⁸ is inapposite because in that case, the parties entered into a written agreement.

Applicant's characterization of a licensing provision as a "public policy statement" strains logic and Applicant's early marketing strategies and the redacted statement suggest Applicant sought and continues to seek to take advantage of its situation. The record establishes that Applicant was familiar with Opposer's mark before it adopted its own mark and that Applicant sought to market its app specifically to Instagram users. We have discussed our consideration of some of Applicant's more dubious actions in connection with other factors (e.g., Applicant's early archived

³⁶⁷ 81 TTABVUE 29.

³⁶⁸ *Id.*

iTunes page including multiple references to Instagram and Applicant's tweets touting "[q]uickly fit photos onto **Instagram**["³⁶⁹). Under the thirteenth *DuPont* factor, this evidence is probative of the effect of Applicant's use and further suggests confusion is likely. *See Tao Licensing*, 2017 TTAB LEXIS 437, at *71-72.

This factor weighs in favor of a likelihood of confusion.

7. The Market Interface Between Applicant and Opposer

Market interface (the tenth *DuPont* factor) concerns whether there has been any interaction between the parties indicating a lack of confusion between the marks, such as a consent agreement, contractual provisions designed to preclude confusion, an assignment, or laches or estoppel. *Cunningham*, 222 F.3d at 949 (citing *DuPont*, 476 F.2d at 1361). Here Opposer argues that it has consistently objected to Applicant's use and, for the most part, rehashes its arguments about that its API Terms of Use did not authorize Applicant's use.³⁷⁰ Applicant does not address this factor at all in its brief.

Given that the type of market interface contemplated under this factor consists of consent agreements, coexistence agreements, and the like, none of which are present here, and given that we have previously addressed the API Terms of Use, we do not further consider Opposer's arguments.

This factor is neutral.

³⁶⁹ *Id.* at 24 (Lopez Depo. Tr. 93:11-95:9) (emphasis in original).

³⁷⁰ 77 TTABVUE 44-45.

8. The Extent of Potential Confusion

The twelfth *DuPont* factor is “The extent of potential confusion, i. e., whether *de minimis* or substantial.” *DuPont*, 476 F.2d at 1361. Here, Opposer argues that the potential for extensive confusion is clear, given that users of both Opposer and Applicant’s apps number in the millions.³⁷¹

Both parties’ mobile apps target the general public, their marks are similar, and, together, the parties have millions of users, if not more. Consequently, we find that the potential for confusion is not *de minimis*, but substantial. *See In re Davey Prods. Pty Ltd.*, Ser. No. 77029776, 2009 TTAB LEXIS 524, at *26 (TTAB 2009) (“[W]e find that the goods involved here are the type of goods that would be marketed to and purchased by significant numbers of purchasers, and that the potential for confusion therefore cannot be deemed to be *de minimis*.”).

Accordingly, this *DuPont* factor favors a finding of likelihood of confusion.

9. Weighing of the *DuPont* Factors

In sum, we find that the goods identified in Applicant’s involved application and Opposer’s ’057 and ’600 Registrations are legally identical. Because the parties’ goods are legally identical and unrestricted as to trade channels, we must presume that the goods move in the same channels of trade and are available to the same classes of customers. The second and third *DuPont* factors thus weigh heavily in favor of finding confusion likely, as does the factor regarding the nature and extent of any actual confusion. As the evidence of record shows that unsophisticated consumers are

³⁷¹ 77 TTABVUE 45.

potential consumers, the factor regarding consumer sophistication also weighs in favor of a finding of likelihood of confusion. Considering the strength of Opposer's mark, the evidence demonstrates that the INSTAGRAM mark is strong and famous; as a result, the mark is accorded "a wide latitude of legal protection." *Recot, Inc. v. Becton*, 214 F.3d at 1327. Opposer's INSTAGRAM mark is suggestive and Applicant was not successful in diminishing its conceptual or commercial strength. Comparing Applicant's mark to Opposer's mark, we find them to be more similar than dissimilar. The factors regarding the extent of potential confusion (the twelfth *DuPont* factor) and other probative evidence of the effect of use (the thirteenth *DuPont* factor) also weigh in favor of confusion. The factor regarding market interface is neutral.

Weighing all of the factors, we find that they weigh in favor of a likelihood of confusion. Accordingly, Opposer has met its burden of proof regarding its claim of likelihood of confusion.

Decision

The opposition to registration of the mark of Application Serial No. 86171343 is sustained on the ground of likelihood of confusion under Section 2(d) of the Trademark Act.