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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214795
Party	Plaintiff Instagram, LLC
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Date	11/10/2014
Attachments	Reply ISO Motion to Strike Applicant's Affirmative Defenses.pdf(559388 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Instagram, LLC,	§	Opposition No. 91214795
	§	
Opposer,	§	Serial No.: 85/742,628
	§	
v.	§	Mark: INSTAPRINTS
	§	
Sean Broihier and Associates, LLC,	§	International Classes: 16, 35, 40
	§	
Applicant.	§	Published: October 8, 2013
	§	

**OPPOSER INSTAGRAM, LLC’S REPLY IN SUPPORT OF MOTION TO STRIKE OR,  
IN THE ALTERNATIVE, MOTION FOR JUDGMENT AS A MATTER OF LAW AS TO  
APPLICANT’S AFFIRMATIVE DEFENSES**

Ignoring precedent, Applicant’s Opposition incorrectly argues that the Board should never strike affirmative defenses prior to the end of discovery. Applicant instead suggests that it is acceptable to plead conclusory affirmative defenses without any supporting facts. It further states – without explanation – that the defenses of laches, estoppel, and acquiescence are appropriate here when Opposer timely opposed the INSTAPRINTS application. The Board should grant Opposer’s motion in its entirety.

**I. APPLICANT’S AFFIRMATIVE DEFENSES SHOULD BE STRICKEN OR  
DISMISSED AT THIS TIME**

Applicant incongruously argues both that Opposer’s Motion to Strike cannot be heard because it is untimely (Opposition at 1-2), and premature because discovery has not closed (Opposition at 2). Both positions are incorrect.

As Opposer notes in its motion, and Applicant does not address, the Board “in its discretion, may entertain an untimely motion to strike matter from a pleading.” TBMP §506.02; *see also Order of Sons of Italy in Am. v. Profumi Fratelli Nostra Ag*, 36 U.S.P.Q.2d 1221 (TTAB 1995) (the Board “may act on its own initiative at any time to strike certain types of material

from pleadings”). This is a case in which the Board can, and should, exercise its discretion to strike Applicant’s impertinent and improper affirmative defenses at this stage of the proceedings.

Applicant simultaneously argues that the motion is premature because “it is difficult to understand how Opposer can meet the high burden imposed by the TBMP and the Federal Rules of Civil Procedure, particularly while the discovery period remains open, of showing that the defenses have ‘no bearing upon the issues in the case.’” Opposition at 2. There are at least two problems with Applicant’s argument.

First, Applicant fails to acknowledge that the purpose of a Motion to Strike is to remove from the pleadings “any insufficient defense” (TBMP § 506.01). Similarly, the purpose of a Motion for Judgment on the Pleadings “is a test solely of the undisputed facts appearing in all the pleadings” (TBMP § 504.01). Whether an applicant may hope to learn facts during discovery supporting an affirmative defense, without more, does not give it free reign to plead a laundry list of affirmative defenses in conclusory form.

Second, discovery in this case has been open for months and Applicant has not produced anything relating to its affirmative defenses. Nor has it taken any steps to pursue discovery in those areas. It is therefore an appropriate time for the Board to consider the sufficiency of Applicant’s affirmative defenses.

**II. APPLICANT CONCEDES THAT FOUR OF ITS AFFIRMATIVE DEFENSES MUST BE STRICKEN**

Opposer moved to strike all eight of Applicant’s affirmative defenses on the grounds that they were insufficiently pleaded. Motion at 3-4. Opposer also moved, on a separate basis, to strike affirmative defenses of “failure to state a claim,” “lack of rights,” “failure to police,” and “unclean hands” because they are legally insufficient and impossible under the pleaded facts. Motion at 5-8. Applicant argues generally that its defenses are properly pleaded, but does not explain why. It does not point to the factual bases underlying these so-called defenses, and

ignores the legal authorities cited by Opposer regarding their insufficiency. Because Applicant has failed to address the legal sufficiency of these defenses, they should be stricken. *See Kinetic Concepts, Inc. v. Convatec Inc.*, No. 1:08CV00918, 2010 WL 1667285, at \*8-9 (M.D. N.C. Apr. 23, 2010) (“Moreover, in a variety of different contexts, a large number of courts [] have recognized the general principle that a party who fails to address an issue has conceded the issue.”) (collecting cases).

**III. APPLICANT’S OPPOSITION CONFIRMS THAT ITS LACHES, ACQUIESCENCE, AND EQUITABLE ESTOPPEL DEFENSES SHOULD BE STRICKEN**

Opposer moved to strike Applicant’s second, sixth, and seventh affirmative defenses of “equitable estoppel,” “laches,” and “acquiescence,” (respectively) because they are not applicable to this Opposition proceeding. Motion at 8-9. Rather than address the authority cited by Opposer, or explain why the defenses might be applicable to this proceeding, Applicant offers the excuse that “Applicant’s failure to plead the defenses in its Answer results in their waiver and prevents them from being asserted at trial.” Opposition at 3. This is hardly a justification for affirmative defenses that have no application to this case. As set forth in the Motion, Opposer timely opposed the subject application, thereby mooting any laches, acquiescence, and equitable estoppel defenses. Motion at 8-9. Applicant does not argue otherwise or provide any other basis for maintaining these defenses. These three affirmative defenses must be stricken.

**IV. APPLICANT DID NOT ADEQUATELY PLEAD ITS DEFENSES AND OPPOSER WILL BE PREJUDICED IF THE DEFENSES ARE NOT STRICKEN**

Without addressing any of Opposer’s authority on the issue, Applicant claims that its defenses are properly pleaded because they “are pled simply, concisely and directly so as to provide sufficient notice to Instagram of their grounds.” Opposition at 3. Applicant misses the point. Applicant has not put Opposer on notice of the *grounds* of any of the defenses because it

has not alleged a factual basis for any of them, as required. *See Monster Cable Prods. v. Avalanche Corp.*, 2009 U.S. Dist. LEXIS 23747 at \*2 (N.D. Cal. 2009) (citing *Shecter v. Comptroller*, 79 F.3d 265, 270 (2d Cir. 1996) (affirmative defenses that amount to nothing more than mere conclusions of law and are not warranted by any asserted facts have no efficacy).

Applicant also argues that “allowing the affirmative defenses to remain in Applicant’s Answer will not result in prejudice to the Opposer.” That is not so. If the affirmative defenses remain, Opposer will be forced to suffer the expense of taking discovery just to understand the basis of the defenses. Opposer is further prejudiced by the burden of preparing disclosures and rebuttal evidence during the testimony period on these defenses, despite the fact that Applicant has never articulated the factual basis for these alleged defenses. And, even if this were not deemed prejudicial, an alleged lack of prejudice is hardly a reason to allow legally insufficient affirmative defenses to survive.

Following Applicant’s reasoning, a party could plead innumerable affirmative defenses in conclusory fashion, whether or not it has reason to believe that the defenses apply. Opp. at 2 (arguing “should sufficient evidence fail to be developed in support of any or all of the affirmative defenses, then the defenses will fail of their own accord.”) There is no support for this fishing expedition-approach to pleading. The Board should not allow Applicant to proceed with inapplicable, boilerplate defenses that will force Opposer – and the Board – to devote time and resources to discovery exploring Applicant’s hypothetical factual bases.

Applicant has not adequately pleaded its defenses and has no factual basis for asserting any of them. Further, Opposer will be prejudiced by discovery on issues with no bearing on this matter. All of the affirmative defenses should therefore be stricken.

**V. APPLICANT’S OPPOSITION CONFIRMS THAT THE MOTION FOR JUDGMENT ON THE PLEADINGS SHOULD BE GRANTED**

Opposer moved, as an alternative to its Motion to Strike, for judgment on the pleadings as to Applicant’s affirmative defenses. This is because Applicant has not alleged any facts to support its defenses and they can be decided as a matter of law. Motion at 10. Applicant argues that all of its “well-pleaded allegations must be accepted as true.” Opposition at 4. Although this principle may be correct with respect to factual allegations, Applicant has not articulated any well-pleaded allegations. Hence, there is nothing for the Board to “accept as true” because Applicant has pleaded only legal conclusions.

If the Board does not grant Opposer’s Motion to Strike, it should grant judgment on the pleadings as to all of Applicant’s affirmative defenses.

**VI. CONCLUSION**

Applicant’s affirmative defenses should be stricken or dismissed as a matter of law because they are insufficiently pleaded, improper, or otherwise inapplicable. Because Applicant cannot cure these defects, its affirmative defenses should be stricken or dismissed with prejudice, and without leave to amend.

Date: November 10, 2014

By: /s/ Bobby Ghajar  
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CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT November 10, 2014

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

/s/ Marcus Peterson  
Marcus Peterson

**CERTIFICATE OF SERVICE VIA FIRST CLASS MAIL**

I, Marcus Peterson, hereby certify that a true and complete copy of the foregoing OPPOSER INSTAGRAM, LLC'S REPLY IN SUPPORT OF MOTION TO STRIKE, OR IN THE ALTERNATIVE, FOR JUDGMENT AS A MATTER OF LAW AS TO APPLICANT'S AFFIRMATIVE DEFENSES was served on Applicant's counsel, Amy Sullivan Cahill, Stites & Harbison PLLC, 400 W. Market St., Suite 1800, Louisville, KY 40202-3352, via postage prepaid first-class mail on November 10, 2014.

/s/ Marcus Peterson  
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Marcus Peterson