

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

CME

Mailed: January 27, 2015

Opposition No. 91214795

Instagram, LLC

v.

Sean Broihier and Associates, LLC

By the Trademark Trial and Appeal Board:

Applicant seeks registration of the mark INSTAPRINTS, in standard characters, for print products in International Class 16, online retail store services featuring print products, advertising and promotional services, and online business services in International Class 35, and online photographic and imaging services in International Class 40.¹ In its notice of opposition, Opposer alleges prior use and registration of the mark INSTAGRAM for photo and video sharing services and software, and social networking services, and that use of Applicant's mark is likely to cause confusion with and dilute Opposer's pleaded mark.² Applicant timely filed an answer on

¹ Application Serial No. 85742628, filed October 1, 2012, alleging first use in commerce on May 31, 2012.

² Registration No. 4146057, issued May 22, 2012, and Registration No. 4170675, issued July 10, 2012. Opposer has also pleaded seven (7) intent-to-use trademark applications for the mark INSTAGRAM.

March 13, 2014 denying the salient allegations in the notice of opposition and asserting eight affirmative defenses.

This case now comes up on Opposer's motion, filed October 14, 2014, to strike Applicant's affirmative defenses, or in the alternative, for judgment on the pleadings with respect to Applicant's affirmative defenses.³ The motion is fully briefed.

A motion to strike should be filed within 21 days of service of an answer upon a party. *See* Fed. R. Civ. P. 12(f); TBMP 506.02 (2014). As Applicant argues, Opposer's motion to strike is untimely as it was filed more than seven months after Applicant filed and served its answer. However, the Board on its own initiative may strike an insufficient defense from a pleading, and therefore, the Board exercises its discretion to consider Opposer's motion to strike on the merits. Fed. R. Civ. P. 12(f); *see also Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (“[T]he Board, in its discretion, may entertain an untimely motion to strike matter from a pleading.”).

Opposer argues that all of Applicant's affirmative defenses should be stricken because they “are improperly pled, and lack sufficient specificity to put [Opposer] on notice of their legal and factual bases,” Motion, pp. 2 and 4;

³ The Board notes Opposer's substitution of counsel, filed October 1, 2014, and change of correspondence address, filed October 14, 2014. The Board's records have been updated accordingly. The Board also acknowledges Applicant's consented motion, filed October 22, 2014, to withdraw its motion to extend, filed October 6, 2014. Accordingly, Applicant's motion to withdraw is granted, and Applicant's motion to extend will be given no further consideration.

that the affirmative defense of failure to state a claim should be stricken because Opposer has adequately pleaded its standing and claims for likelihood of confusion and dilution, *see id.* at p. 5; that the third and fourth affirmative defenses are not proper affirmative defenses, *see id.* at p. 5-8; and that the affirmative defenses of equitable estoppel, laches and acquiescence “are not applicable to this proceeding.” *Id.* at p. 8.

In opposition to the motion, Applicant argues that motions to strike are not favored; that it has pleaded its affirmative defenses “simply, concisely and directly so as to provide sufficient notice to [Opposer] of their grounds”; that none of the affirmative defenses “amount to a collateral attach [sic] of Opposer’s pleaded registrations”; and that Opposer will not be prejudiced if the affirmative defenses are allowed to stand. Response, pp. 2-3. Applicant further asserts that it “may clearly be prejudiced” if the affirmative defenses are stricken, presumably “because Applicant’s failure to plead the defenses in its Answer results in their waiver and prevents them from being asserted at trial.” *Id.* at p. 3.

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See* Fed. R. Civ. P. 12(f); *Am. Vitamin Prods.*, 22 USPQ2d at 1314; TBMP § 506.01. Motions to strike are not favored, and as such, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. TBMP § 506.01. Moreover,

the primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id*; *see also* TBMP §§ 309.03 and 311.02. Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See Harsco Corp. v. Elec. Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

The Board addresses Opposer's motion with respect to each of Applicant's affirmative defenses in turn below.

Affirmative Defense 1:

1. The Notice of Opposition fails to state a claim upon which relief can be granted.

An assertion that a pleading fails to state a claim upon which relief can be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading rather than a statement of a defense to a properly pleaded claim. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). An assertion that a pleading is insufficient is to be presented by means of a timely and otherwise proper motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6). As such, it is improper for Applicant to raise this issue by way of an affirmative defense.

For purposes of completeness, the Board has reviewed the notice of opposition to determine whether it adequately alleges Opposer's standing and a valid ground for opposition. To state a claim upon which relief can be granted, a plaintiff need only allege such facts as would, if proved, establish

that: 1) it has standing to maintain the proceeding, and 2) a valid ground exists for opposing the registration sought. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982).

Opposer has sufficiently alleged both its standing and a valid ground for opposition by pleading its prior use and registration of the mark INSTAGRAM and a plausible claim for likelihood of confusion. *See Notice of Opposition*, ¶¶ 1-3, 9-18; *see also Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007); TBMP § 309.03(b) and cases cited in footnote 7 therein. Opposer also has pleaded a viable claim for dilution as it has alleged that its INSTAGRAM mark is famous and became famous prior to Applicant's priority date and that the involved mark is likely to dilute the distinctive quality of its INSTAGRAM mark. *See Notice of Opposition* ¶¶ 4, 25, and 27; *see also* 15 U.S.C. § 1125(c); *Research in Motion Ltd. v. Defining Presence Marketing Group, Inc. and Axel Ltd. Co.*, 102 USPQ2d 1187, 1197 (TTAB 2012).

In view of the foregoing, Opposer's motion to strike is **GRANTED** with respect to affirmative defense 1, which is **STRICKEN**.

Affirmative Defenses 2, 6, and 7

2. Opposer's claims for relief are barred by equitable estoppel.
6. Opposer's claims for relief are barred by laches.
7. Opposer's claims for relief are barred by acquiescence.

Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (noting that the primary purpose of pleadings “is to give fair notice of the claims or defenses asserted”); *see also* TBMP § 311.02(b) and the cases cited in footnote 15 therein. Here, Applicant’s defenses of equitable estoppel, laches and acquiescence are merely bald, conclusory allegations that are not supported by any pleading of facts.

Moreover, although Trademark Rule 2.106(b)(1) in principle allows a defendant to plead the defenses of estoppel, laches, and acquiescence, such defenses generally are not available in opposition proceedings. *Barbara’s Bakery*, 82 USPQ2d at 1292, n.14 (noting that amendment of applicant’s answer to assert defenses of laches, acquiescence or estoppel would be futile as such defenses generally are not available in opposition proceedings); *see also Lincoln Logs Ltd. v. Lincoln Pre-Cut Logs Homes Inc.*, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992) (“Inasmuch as [o]pposer has acted at its first opportunity to object to registration of [a]pplicant's current LINCOLN mark and made no representation to [a]pplicant that it would not so oppose, [a]pplicant would appear to have no basis for either a laches or estoppel defense against [o]pposer respecting the application in issue.”); *Nat’l Cable*

Television Assoc. v. Am. Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

For the reasons above, Opposer's motion to dismiss is **GRANTED** with respect to affirmative defenses 2, 6 and 7, which are **STRICKEN**.

Affirmative Defense 3

3. Opposer's claims for relief are barred because Opposer has no valid and enforceable rights in the term "INSTA".

The matter asserted in this paragraph does not constitute an affirmative defense, but rather serves to amplify Applicant's denials of allegations in the notice of opposition. Applicant is allowed to demonstrate, as part of its main case, its positions or theories with respect to the elements of Opposer's claim, and to this end, Applicant is simply left to present its proofs at trial or as otherwise appropriate. Inasmuch as the assertion is not an affirmative defense, Opposer's motion to strike is **GRANTED** and affirmative defense 3 is **STRICKEN**.

Affirmative Defenses 4 and 5

4. Opposer's claim[s] for relief are barred because Opposer effectively abandoned its rights in the allegedly infringed mark due to failure to police its mark.
5. Opposer's claims for relief are barred because Opposer abandoned any rights it may have established in the mark INSTAGRAM through naked licensing.

Abandonment is a statutory ground for cancellation of a trademark registration under § 14(3) of the Trademark Act, 15 U.S.C. § 1064(3). *See also* Trademark Act § 45, 15 U.S.C. § 1127 and TBMP 309.03(c) and the cases

cited in footnote 27 therein. As such, Applicant's allegations of abandonment are attacks on the validity of Opposer's pleaded registrations, and therefore, are not proper affirmative defenses, but are impermissible collateral attacks on Opposer's pleaded registrations. The Board will not entertain a collateral attack against a pleaded registration absent the filing of a timely and properly pleaded counterclaim accompanied by the required fee. *See* Trademark Rules 2.6 and 2.106(b)(2)(ii); *Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (defense attacking validity of pleaded registration must be raised by way of cancellation of registration); *see also* TBMP §§ 313.01 and 313.02.

Accordingly, Opposer's motion to strike affirmative defenses 4 and 5 is **GRANTED** and these defenses are **STRICKEN**.

Affirmative Defense 8

8. Opposer's claims should be denied based upon equitable principles of unclean hands.

As with the defenses of equitable estoppel, laches and acquiescence, Applicant's unclean hands defense is conclusory in nature and not supported by any facts. *See Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (“[R]espondent's fourth affirmative defense does not include allegations that state a defense of unclean hands. There are no specific allegations of conduct by petitioner that, if proved, would prevent petitioner from prevailing on its claim.”). Accordingly,

Opposer's motion is **GRANTED** with respect to affirmative defense 8, which is **STRICKEN**.

In summary, Opposer's motion to strike is **GRANTED**⁴ and Applicant's affirmative defenses are **STRICKEN** from its answer.⁵ In addition, Opposer's motion, filed November 10, 2014, to extend the deadlines in this proceeding by sixty (60) days is **GRANTED** as conceded. *See* Trademark Rule 2.127(a).

Disclosure, discovery, trial and other dates are reset as follows:

Expert Disclosures Due	4/25/2015
Discovery Closes	5/25/2015
Plaintiff's Pretrial Disclosures Due	7/9/2015
Plaintiff's 30-day Trial Period Ends	8/23/2015
Defendant's Pretrial Disclosures Due	9/7/2015
Defendant's 30-day Trial Period Ends	10/22/2015
Plaintiff's Rebuttal Disclosures Due	11/6/2015
Plaintiff's 15-day Rebuttal Period Ends	12/6/2015

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁴ In view hereof, Opposer's motion for judgment on the pleadings is moot and will be given no consideration.

⁵ If, through discovery, Applicant learns of facts to support a proper affirmative defense, Applicant may file a motion to amend its pleading to assert such a defense. *See* Fed. R. Civ. P. 15.