

ESTTA Tracking number: **ESTTA715155**

Filing date: **12/16/2015**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	PIXELS.COM, LLC
Granted to Date of previous extension	12/16/2015
Address	1450 SECOND STREET SANTA MONICA, CA 90401 UNITED STATES
Correspondence information	Mari-Elise Gates Stites & Harbison PLLC 1800 Diagonal Road, Suite 325 Alexandria, VA 22315 UNITED STATES mgates@stites.com Phone:703.837.3932

Applicant Information

Application No	86638028	Publication date	08/18/2015
Opposition Filing Date	12/16/2015	Opposition Period Ends	12/16/2015
Applicant	Instagram, LLC 1601 Willow Road Menlo Park, CA 94025 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2011/09/20 First Use In Commerce: 2011/09/20 All goods and services in the class are opposed, namely: Downloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	non-use and abandonment based on acquiescence

Attachments	Notice of Opposition to INSTA.pdf(113782 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/mari-elise gates/
Name	Mari-Elise Gates
Date	12/16/2015

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

**IN THE MATTER OF TRADEMARK
APPLICATION SERIAL NO. 86/638,028**

PIXELS.COM, LLC)	
)	
Opposer)	
)	
v.)	Opposition No.
)	
INSTAGRAM, LLC)	
)	
Applicant)	
)	

NOTICE OF OPPOSITION

PIXELS.COM, LLC., a corporation organized under the laws of the state of Illinois, with a principal address of 1450 Second Street, Santa Monica, California 90401 (“Opposer”), believes that it would be damaged by registration of the mark “INSTA” (Serial No. 86/638,028) in the name of **INSTAGRAM, LLC**, a Delaware limited liability company having its principal place of business at 1601 Willow Rd., Menlo Park, California 94025 (“Applicant”), and Opposer, by its undersigned attorneys, hereby requests that registration of the mark be denied based on the following:

1. Opposed U.S. Application Serial No. 86/638,028, was filed on August 18, 2015, with a claimed date of first use in commerce of September 20, 2011, seeking registration of the alleged mark “INSTA” under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), in connection with “[d]ownloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or

otherwise providing electronic media or information via computer and communication networks” in International Class 9.

2. Applicant is the owner of the mark INSTAPRINTS and of U.S. Serial No. 85/742,628 for use in connection with “[p]rint products, namely, art prints on canvas, framed art prints, art prints, acrylic art prints, art prints on metal, posters, and greeting cards” in International Class 16 on an in-use basis; “[o]nline retail store services featuring print products, namely, art prints on canvas, framed art prints, art prints, acrylic art prints, art prints on metal, posters, and greeting cards; advertising services, namely, promoting the artwork of other artists; promoting visual arts events by means of providing an online events calendar, and information about art, artists, and art events via an internet website, all for promotional purposes; online business networking services for artists; online advertising and marketing in the field of artwork” in International Class 35 on an in-use basis; and “[o]nline photographic and image processing services, namely, photographic printing, reproduction and retouching; transferring photographic and digital images from uploaded digital images to imprintable surfaces, namely, printing of photographic images from digital media” in International Class 40 on an in-use basis.

3. On September 17, 2015, Opposer filed a Request for Extension of Time to U.S. Application Serial No. 86/638,028 with the Trademark Trial and Appeal Board. The Trademark Trial and Appeal Board granted this Request on September 17, 2015.

4. Through widespread use of the “INSTAPRINTS” mark throughout the United States, Opposer’s “INSTAPRINTS” mark has developed considerable good will and customer recognition in connection with its photo printing services and online retail store services.

COUNT 1: OPPOSITION BASED ON DESCRIPTIVENESS LACKING SECONDARY MEANING

5. Applicant incorporates the foregoing paragraphs as if fully set forth herein.

6. The term “insta” is a commonly used, descriptive prefix meaning “instant” or “quickly produced.”
7. Applicant acknowledges that the “INSTA” term or component means “instant.”
8. Through its previously published policies on its website Instagram.com, Applicant expressly consented to extensive third party use of the term “insta,” thus admitting that “insta” was descriptive and freely available for use by third parties.
9. The term “insta” is in use by numerous third parties in Applicant’s field of photosharing and photography. In fact, the term “insta” has been in use in the photography field by parties other than Applicant since at least as early as the 1960s, including among numerous others, the Instamatic camera by Kodak and the Instax camera by Fuji. Accordingly, consumers do not associate “insta” exclusively with Opposer, even within its own field.
10. Applicant’s mark is not inherently distinctive.
11. Accordingly, Applicant’s mark is merely descriptive and has not achieved secondary meaning. Opposer asserts that the alleged mark “INSTA” could not acquire secondary meaning because of the extensive prior third party use of mark containing the component “INSTA” in Applicant’s field and otherwise. Opposer therefore requests that U.S. Serial No. 86/638,028 be refused registration pursuant to 15 U.S.C. § 1052(e).

COUNT II: OPPOSITION BASED ON NON-USE

12. Opposer incorporates the foregoing paragraphs as if fully set forth herein.
13. Applicant has engaged in an overzealous and baseless enforcement campaign to challenge any trademark application containing the commonly used descriptive term “insta,” regardless of the overall similarities (or lack thereof) in the marks or the services.
14. Upon information and belief, Applicant does not currently and has never used the term “INSTA” separate and apart from the composite logo, as shown in U.S. Registration No.

4,531,884 for “[d]ownloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks.” “INSTA” does not create a separate and distinct commercial impression from the mark shown in U.S. Registration No. 4,531,884 and is therefore not registrable.

15. On information and belief, there has been no actual use in the United States of the mark INSTA for the goods listed in U.S. Serial No. 86/638,028 by Applicant, separate and apart from the design component as shown in U.S. Registration No. 4,531,884.

COUNT III: OPPOSITION BASED ON FRAUD

16. Applicant incorporates by references the foregoing paragraphs as if fully set forth herein.

17. Applicant’s alleged mark “INSTA” should also be refused registration on equitable grounds at least in that the file history of the application shows that false and/or fraudulent declarations and representations were made to the United States Patent and Trademark Office for the purpose of obtaining registration of the mark “INSTA”. In the declaration of U.S. Serial No. 86/638,028, Applicant falsely and/or fraudulently stated that no other person, firm, corporation or association had the right to use “INSTA”, though, on information and belief, Applicant knew that in fact for many years prior to Applicant’s alleged adoption of the alleged mark “INSTA”, third parties including but not limited to those in the photography field had used the very term or equivalents thereof for which Applicant was now attempting to obtain a registration and exclusive rights and that, whether such term is or is not a mark, the third parties had the right to continue to use the descriptive term “INSTA”.

18. Further, in the prosecution of U.S. Serial No. 86/638,028, Applicant represented that the alleged mark INSTA had been used as a mark, though, on information and belief, Applicant knew that in fact the mark was only used as a component of the design mark, as shown in U.S. Registration No. 4,531,884, thereby constituting a non-registrable manipulation of U.S. Registration No. 4,531,884.

19. U.S. Serial No. 86/638,028 is invalid under Section 1 of the Trademark Act, 15 U.S.C. § 1051(a)(3), since, on information and belief, Applicant's declarations that it is the owner of the alleged mark "INSTA" and that no other person had the right to use the alleged mark INSTA in commerce was false. U.S. Serial No. 86/638,028 is invalid under Section 2(f) of the Trademark Act (15 U.S.C. § 1052 (f)), since the claims of distinctiveness is, at least in that Applicant is claiming substantially exclusive and continuous use of alleged mark "INSTA". U.S. Serial No. 86/638,028, which is based on use in commerce, is also invalid under Section 1, 15 U.S.C. § 1051(a)(1), since it is not properly based on use in commerce in that there has been no actual use in the United States of the mark INSTA for the goods listed in U.S. Serial No. 86/638,028 by Applicant, separate and apart from the design component as shown in U.S. Registration No. 4,531,884.

20. On information and belief, the false representations identified in the preceding paragraphs were material to the prosecution of U.S. Serial No. 86/638,028, and Applicant knew that the representations were false. On information and belief, the application for registration of "INSTA" was filed with full knowledge that Applicant did not possess exclusive rights in the alleged mark "INSTA" and that the alleged mark "INSTA" had not been used in such a way to make a separate and distinct commercial impression apart from the design mark shown in U.S. Registration No. 4,531,884. The false representations made by Applicant were made with the

intention of inducing the Examining Attorney to pass U.S. Serial No. 86/638,028 for publication based on the misrepresentations. On information and belief, in allowing the applications for publication, the Examining Attorney relied on the Applicant's misrepresentations as to descriptiveness, distinctiveness and use. The registration of Applicant's alleged marks "INSTA" will cause Opposer and others injury and damage in appropriately describing their products and services and will limit the ability of Opposer and others to continue to appropriately describe their products and services to the public.

21. The passage for publication of the "INSTA" application by the Examining Attorney plays a material role in Applicant's scheme to harass potential competitors in its baseless trademark enforcement campaign over the unprotectable component parts of its composite INSTAGRAM mark to clear its path to enter and monopolize product and service markets related to its social media platform.

COUNT IV: ABANDONMENT BASED ON ACQUIESCENCE

22. Applicant incorporates by references the foregoing paragraphs as if fully set forth herein.

23. While Opposer alleges that Applicant has never nor could ever gain any enforceable rights in the alleged mark "INSTA", in the alternative, Opposer alleges that insofar as Applicant may have had rights in the descriptive component "INSTA", Opposer alleges that Applicant has abandoned any such rights through acquiescence.

24. In 2010, Applicant launched a social networking website designed to allow individuals to share photographs by posting photographs to the site or by sharing them through other social media platforms such as Facebook. To promote its services and build its social network, Applicant developed an application programming interface ("API") meant to encourage third party software developers such as Opposer to develop new services to compliment Applicant's

online services. Applicant provided Opposer and others with API credentials that allow Internet users to import materials from Applicant's site to third-party sites.

25. Applicant's website contained Terms of Use, which stated that third-parties were permitted to use the component "INSTA" or the component "GRAM" in trademarks, but were not permitted to use both components in a product name.

26. The relevant portion of the terms of use presented on Instagram's web site in April, 2012 are reproduced from a screen capture taken from www.web.archive.org:

INSTAGRAM API TRADEMARK AND BRAND GUIDELINES

- You are not allowed to use the word "Instagram", "IG" or any variation in your product name, domain name, or images.
- You are not allowed to use the Instagram icon or logo unless specifically allowed in the development documentation.
- If you do incorporate Instagram's logos, you must include the following statement clearly on your website: "This [application website] uses the Instagram™ API and is not endorsed or certified by Instagram or Burbn, Inc. All Instagram™ logos and trademarks displayed in this [application website] are property of Burbn, Inc."
- While you cannot use the word "Instagram" or "IG" in your product's name, **it's ok to use one (but not both) of the following: "Insta" or "gram"**.
- Note that we reserve the right to reject any use of these terms in connection with the use of the Instagram API. (Emphasis supplied).

27. Under these Terms of Use, Instagram allowed – or even encouraged – numerous companies, including Opposer to incorporate the alleged mark "INSTA" in third party marks, which constitutes abandonment by acquiescence, pursuant to 15 U.S.C. § 1127. If Applicant ever had any rights in the descriptive component "INSTA", which Opposer denies, Applicant's conduct described herein caused the alleged mark "INSTA" to lose its significance as a mark.

28. The grant of a registration to Applicant of the alleged mark “INSTA” would cause damage and injury to Opposer and third parties and thereby be refused registration.

WHEREFORE, Opposer believes that it would be damaged by grant to Applicant of registration on U.S. Application Serial No. 86/638,038 for “INSTA” and prays that its opposition be sustained and that registration be denied.

Respectfully submitted,

STITES & HARBISON, PLLC

Dated: December 16, 2015

/s/ Mari-Elise Gates

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Counsel for Pixels.com, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served on counsel for Applicant, this 16th day of December, 2015, by sending it via First Class Mail, postage prepaid, to:

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/mari-elise gates/ _____
Mari-Elise Gates