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

Mailed: June 29, 2016

Opposition No. 91225408

Pixels.com, LLC

v.

Instagram, LLC

George C. Pologeorgis,
Administrative Trademark Judge:

Applicant seeks to register the mark INSTA (in standard characters) for various computer software goods in International Class 9.[1]

On December 16, 2015, Opposer filed a notice of opposition opposing the registration of Applicant's involved mark on the following grounds: (1) the mark is merely descriptive and has not acquired distinctiveness; (2) nonuse; and (3) fraud. In support of its asserted claims, Opposer pleads (1) common law use of the mark INSTAPRINTS in association with photo printing services and online retail store services; (2) ownership of pending application Serial No. 85742628 for the mark INSTAPRINTS for various printed goods in International Class 16, online retail store services featuring various printed products in International Class 35, and photographic and imaging processing services in International Class 40; and (3)

[1] Application Serial No. 86638028, filed on May 21, 2015, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming September 20, 2011 as both the date of first use and the date of first use in commerce.

that Applicant has opposed the registration of its INSTAPRINTS mark in another Board proceeding.

In lieu of filing an answer to the notice of opposition, Applicant, on January 26, 2016, filed a motion to dismiss Opposer's asserted grounds of nonuse and fraud. On February 16, 2016, Opposer filed an amended notice of opposition in response to Applicant's motion to dismiss. Opposer's amended pleading is accepted as a matter of course and now constitutes Opposer's operative pleading in this matter. *See* Fed. R. Civ. 15(a)(1)(B). In view thereof, Applicant's motion to dismiss Opposer's claims of nonuse and fraud alleged in its originally-filed pleading is deemed moot and will be given no further consideration. On March 7, 2016, however, Applicant filed a renewed motion to dismiss the claims of nonuse and fraud asserted in Opposer's amended pleading.

It has come to the Board's attention that the parties to this proceeding are engaged in a civil action in the United States District Court for the Northern District of California.[2] Opposer, as plaintiff in the civil action, seeks a declaratory judgment that its pleaded INSTAPRINTS mark does not infringe or dilute Applicant's INSTAGRAM mark. The Board finds that the final disposition of the civil action may have a bearing on the issues in this case. Specifically, if the district court adjudicates that Opposer's pleaded INSTAPRINTS mark does in fact infringe or dilute Applicant's INSTAGRAM mark and enjoins Opposer from using its

[2] Civil Action No. 3:15-cv-03610, styled *Pixels.com LLC v. Instagram, LLC*, filed on or about August 7, 2015.

INSTAPRINTS mark, such a ruling may have a direct bearing on Opposer's standing to bring this opposition proceeding.

In view thereof, the Board hereby *sua sponte* ***suspends*** this proceeding pending the final disposition of the civil action.[3] Trademark Rule 2.117(a).

Within twenty days after such final determination, the parties shall notify the Board so that this proceeding may be called up for appropriate action. Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action.

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

In light of this order, Applicant's renewed motion to dismiss Opposer's claims of nonuse and fraud asserted in Opposer's amended notice of opposition is **DENIED without prejudice**.

If Applicant believes its renewed motion to dismiss pending at the time of suspension and denied without prejudice by this order was not resolved or made moot by the civil action, Applicant may renew the motion by citing its title, date of filing, and docket entry in the Board's electronic proceeding file. Any motion renewed must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties.

If the renewed motion was contested at the time of suspension and the non-moving party believes that its original response requires supplementation in view of

[3] A proceeding is considered to have been finally determined when an order or ruling that ends the litigation has been rendered, and no appeal has been filed, or all appeals filed have been decided. TBMP § 510.02(b) (2016).

events since suspension, the non-moving party has **FIFTEEN (15) DAYS** from the date of service of the renewal of the motion to file a supplemental response.