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

Proceeding	91225408
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**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**

<b>PIXELS.COM, LLC</b>	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91225408
	)	Serial No. 86/638,028
<b>INSTAGRAM, LLC</b>	)	
	)	
Applicant	)	
	)	

**AMENDED 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 May 21, 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 oppose 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. 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 complement 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.

5. 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.

6. 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](http://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).

7. Under these Terms of Use, Instagram allowed – or even encouraged – numerous companies, including Opposer to incorporate the alleged mark "INSTA" in third party marks. 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.

8. On or around June 15, 2012, Opposer requested and received API credentials from Applicant for use in connection with its Instaprints.com business. As part of this process, Opposer received and approved Opposer's documentation to receive and use the Instagram API, including the mark INSTAPRINTS in connection with Opposer's business and URL (which incorporated and/or referenced Opposer's INSTAPRINTS mark).
9. 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.
10. On January 19, 2013, Applicant adopted new terms of use, which, contrary to its previous terms of use, no longer permitted third parties to use either of the components "insta" or "gram" in their product names.
11. On November 6, 2013, Applicant sent Opposer a cease and desist letter, instructing Opposer to change the mark INSTAPRINTS and withdraw the application for registration of INSTAPRINTS. On February 5, 2014, Applicant filed a Notice of Opposition to registration of Opposer's INSTAPRINTS mark before the United States Patent and Trademark Office Trademark Trial and Appeal Board, claiming that Opposer's use and registration of its INSTAPRINTS mark infringes and dilutes Applicant's rights in its INSTAGRAM mark.
12. Additionally, Applicant has undertaken an aggressive campaign before the Board, filing a series of opposition proceedings and/or filing extensions of time to initiate opposition proceedings directed to a large number of marks that incorporate the formative "INSTA":  
INSTABABES 86/419, 119, INSTAHITCHED 86/577,953, INTSALIFE 86/575,807,  
INSTAMATIC 79/164,380, INSTACAST 86/496,627, INSTAEDU 86/233,316, INSTAJAMZ  
86/073,614, INSTASTIX 86/030,687, INSTASNAGG 86/248,253, INSTACLIQUE 86/241,091,

INSTACELEBS 86/290,902, INSTA PHOTO BOOTH 86/335,622, INSTAMOUR 86/122,354, INSTAPICS 86/218,129, INSTASONG 86/131,994, INSTAVEME 86/227,189, INSTALOVE 86/433,541, INSTADME 86/229,331, INSTAGATOR 86/441,518, INSTAPRAYER 86/022,405, INSTAAPPT 86/414,621, INSTAPLY 85/850,549, INSTAMEET 85/826,116, INSTACURITY 85/882,797, INSTAPICFRAME 85/857,016; 85/933,904, INSTACUBE 85/960,968, INSTAFRAME 85/857,021, INSTAGOOD 85/883,219, INSTABANG 86/036,656, INSTAPEER 86/156,316, INSTAFAN 85/827,826, and INSTAGRILLE 85/619,623, among others.

13. Many of these opposition proceedings filed by Applicant were filed against parties to which Applicant had previously granted API credentials and previously encouraged to use the component “insta” through Applicant’s original terms of use, such as Opposer and Opposer’s INSTAPRINTS mark.

14. The formative “insta” is in use by numerous third parties in Applicant’s field of photosharing and photography. In fact, Applicant is aware that 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.

15. Despite knowledge of the widespread use of the formative “insta” by third parties for highly related services and despite Applicant’s previous encouragement of others to use the formative “insta” in connection with highly related services through Applicant’s terms of use, Applicant filed the instant application for registration of INSTA, falsely claiming exclusive rights to use the formative INSTA in connection with the goods listed in the application.

**COUNT 1: APPLICANT'S MARK IS DESCRIPTIVE AND HAS NOT ACQUIRED  
SECONDARY MEANING**

16. Applicant incorporates the foregoing paragraphs as if fully set forth herein.
17. The term “insta” is a commonly used, descriptive prefix meaning “instant” *See* [yourdictionary.com/insta](http://yourdictionary.com/insta).
18. Applicant acknowledges that the “INSTA” term or component means “instant.”
19. Through its previously published policies on its website [Instagram.com](http://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.
20. 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.
21. Accordingly, Applicant’s alleged mark is merely descriptive and has not achieved secondary meaning and is not capable of achieving secondary meaning. The alleged mark “INSTA” cannot 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**

22. Opposer incorporates the foregoing paragraphs as if fully set forth herein.
23. 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.

24. Applicant filed U.S. Serial No. 86/638,028 on the basis of use under 15 U.S.C. § 1051(a).

25. The specimen of use filed with U.S. Serial No. 86/638,028 shows a mark that is materially different from the alleged mark shown in the drawing submitted with the application, and the specimen therefore cannot support registration of the purported mark INSTA alone under 15 U.S.C. § 1051(a).

26. Applicant is not entitled to registration under 15 U.S.C. § 1051(a).

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

### **COUNT III: OPPOSITION BASED ON FRAUD**

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

29. 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 fraudulently stated that, to the best of its knowledge, no other person, firm, corporation or association had the right to use “INSTA” “in such near resemblance as to be

likely, when used in connection with the goods of such other person, to cause confusion or mistake, or to deceive”. However, Applicant knew prior to the filing of the Application that Applicant had acquiesced to the use of the formative INSTA by others in marks for complementary and highly related goods and services, and, in fact, knew that many third parties had actually used the formative INSTA for such complementary and highly related goods and services. Further, Applicant knew that it considered these marks to be in such near resemblance as to be likely to cause confusion or mistake, or to deceive, and has filed numerous opposition and cancellation proceedings against such marks, based on alleged priority and likelihood of confusion.

30. For example, Applicant had actual knowledge of Opposer’s adoption and use of the INSTAPRINTS trademark June of 2012 when Applicant received and approved Opposer’s documentation to receive and use the Instagram API, including the name of Opposer’s company and business and URL (which incorporated and/or referenced Opposer’s INSTAPRINTS mark).

31. Additionally, Applicant is aware of other third parties, which began using the formative INSTA in connection with goods and services highly related to those listed in the Application. Applicant’s terms of use policy encouraged many of these third parties to adopt marks containing the formative INSTA for such goods and services. Despite this, Applicant has now undertaken an aggressive campaign before the Board, filing a series of opposition proceedings and/or filing extensions of time to initiate opposition proceedings directed to a large number of marks that incorporate the formative “INSTA”: INSTABABES 86/419, 119, INSTAHITCHED 86/577,953, INTSALIFE 86/575,807, INSTAMATIC 79/164,380, INSTACAST 86/496,627, INSTAEDU 86/233,316, INSTAJAMZ 86/073,614, INSTASTIX 86/030,687, INSTASNAGG 86/248,253, INSTACLIQUE 86/241,091, INSTACELEBS 86/290,902, INSTA PHOTO BOOTH

86/335,622, INSTAMOUR 86/122,354, INSTAPICS 86/218,129, INSTASONG 86/131,994, INSTAVEME 86/227,189, INSTALOVE 86/433,541, INSTADME 86/229,331, INSTAGATOR 86/441,518, INSTAPRAYER 86/022,405, INSTAAPPT 86/414,621, INSTAPLY 85/850,549, INSTAMEET 85/826,116, INSTACURITY 85/882,797, INSTAPICFRAME 85/857,016; 85/933,904, INSTACUBE 85/960,968, INSTAFRAME 85/857,021, INSTAGOOD 85/883,219, INSTABANG 86/036,656, INSTAPEER 86/156,316, INSTAFAN 85/827,826, and INSTAGRILLE 85/619,623, among others. Applicant had acquiesced to and was aware of many of these marks at the time it filed its Application.

32. Further, in the prosecution of U.S. Serial No. 86/638,028, Applicant falsely represented that the alleged mark INSTA had been used as a mark, though Applicant knew that in fact the alleged mark was no more than a very small component of a materially different mark, as shown in U.S. Registration No. 4,531,884. The alleged mark was a non-registrable mutilation of the mark shown in U.S. Registration No. 4,531,884.

33. Applicant knowingly made the false representations identified in the preceding paragraphs, and these false representations were material to the prosecution of U.S. Serial No. 86/638,028. Applicant knew that the representations were false. 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 mark shown in U.S. Registration No. 4,531,884. The false representations of fact 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. In allowing the application to pass for publication,

the Examining Attorney relied on the Applicant's misrepresentations as to descriptiveness, distinctiveness and use.

**COUNT IV: ABANDONMENT BASED ON ACQUIESCENCE**

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

35. 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.

36. 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.

37. 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.

38. 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: February 16, 2015

*/s/ Mari-Elise Gates*

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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing AMENDED NOTICE OF OPPOSITION was served on counsel for Applicant, this 16<sup>th</sup> day of February, 2016, by sending it via First Class Mail, postage prepaid, to:

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