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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**

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

OPPOSER’S RESPONSE TO APPLICANT’S MOTION TO DISMISS

Pursuant to 37 C.F.R. § 2.127(a), **PIXELS.COM** (hereinafter “Opposer”), hereby responds to the Motion to Dismiss Counts II and III of Opposer’s Notice of Opposition (hereinafter “Motion”) pursuant to Fed. R. Civ. P. 12(b)(6) filed by Applicant, **INSTAGRAM, LLC** (hereinafter “Applicant”). In its Motion, Applicant argues that Opposer’s opposition to registration of the alleged mark INSTA on the ground of non-use and on the ground of fraud should be dismissed.¹

Pursuant to Fed. R. Civ. P. 15(a)(1), Applicant has amended its Notice of Opposition, and submits that the amendments to Count III address the allegations raised in the Motion in regard to Opposer’s fraud claim. Opposer’s amendments state particular facts, which, if proven, demonstrate that Applicant knowingly made false and material misrepresentations with the intention of procuring a registration to which it is not entitled. In particular, the Amended Complaint properly alleges that: (1) in prosecuting the application for registration of “INSTA”, Applicant knowingly made false misrepresentations of fact, which were material to the prosecution of the Application. For instance, the Application was filed with full knowledge that

¹ Applicant alleges that Opposer has opposed registration of the “word version of the INSTA mark.” There is no “word version” of the INSTA mark. The INSTA mark is a composite logo, in which the word INSTA appears in very small lettering and as a very minor component of the mark.

Applicant did not possess exclusive rights in the alleged mark “INSTA” and that the alleged mark “INSTA” had not been used as a mark, 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; (2) the false representations of fact made by Applicant were made with the intention of inducing the Examining Attorney to the Application for publication and obtaining registration of the alleged mark INSTA; (3) the Examining Attorney relied on the Applicant’s misrepresentations as to descriptiveness, distinctiveness and use to pass the Application for publication; and (4) 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. The specific allegations in the Amended Complaint demonstrate that Applicant had fraudulent intent when filing the Application, intending to procure a registration to which it is not entitled. Applicant’s amendments assert particular factual allegations, which, if proven, demonstrate that Applicant knowingly made false and material misrepresentations with the intention of procuring a registration to which it is not entitled

Accordingly, this Response to the Motion addresses Applicant’s argument that Count II of the Opposition, based on Applicant’s non-use of the applied-for mark INSTA, fails to state a claim because it is defective on its face. Applicant’s Motion should be denied because the Notice of Opposition satisfies the pleading requirements of the Federal Rules of Civil Procedure, and Count II satisfactorily states a claim on which relief may be granted, as explained more fully below.

I. FACTUAL BACKGROUND

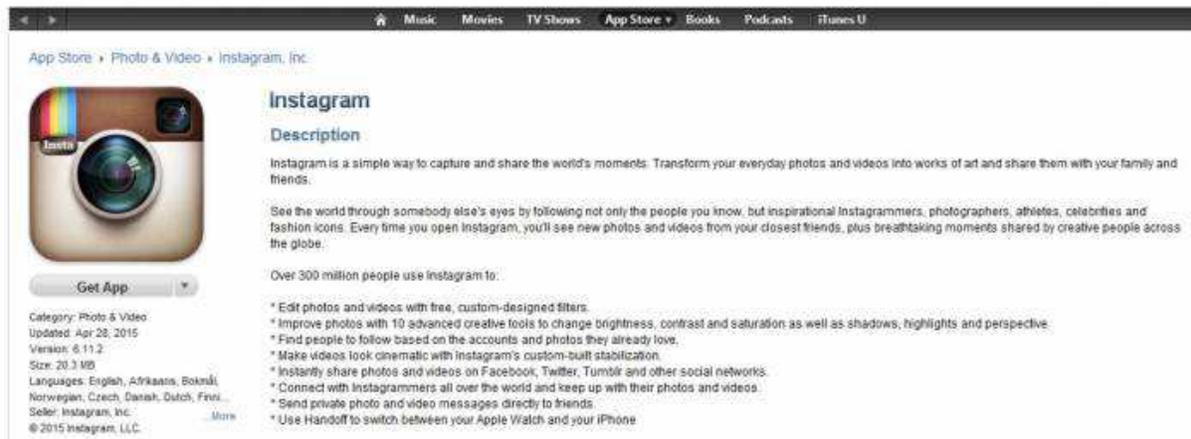
Opposer does not dispute that Applicant owns the composite mark shown below (hereinafter “the camera logo”):



The camera logo is registered (U.S. Registration No. 4,531,884) for a variety of goods and services in Classes 9, 38, 41, 42, and 45.

Applicant filed U.S. Application Serial No. 86/638,028, on May 21, 2015, seeking registration of the alleged standard character 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 (hereinafter “the Application”). Applicant falsely claimed in the Application that it had first used the alleged mark INSTA in connection with the goods listed in the Application on September 20, 2011.

However, Applicant does not currently and has never used the term “INSTA” as a mark. In fact, the specimen submitted by Applicant with the Application shows use of the alleged mark INSTA as a very minor feature of an overall camera logo:



Had Applicant actually used the alleged mark INSTA separate and apart from the camera logo, Applicant would have filed a specimen showing use of that alleged mark. It did not. To date, Applicant has not actually used the alleged mark INSTA for the goods listed in the Application separate and apart from the camera logo. Instead, the alleged mark INSTA is included within the camera logo as a very minor component of the logo that does not create a separate commercial impression as a mark itself. The specimen of use submitted in connection with the Application cannot support registration of the alleged mark INSTA under 15 U.S.C. §1051(a), because the specimen shows a mark that is materially different from the alleged mark.

II. ARGUMENT

The purpose of a Rule 12(b)(6) motion is to challenge “the legal theory of the complaint, not the sufficiency of any evidence that might be adduced” and “to eliminate actions that are fatally flawed in their legal premises and destined to fail . . .” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). A motion to dismiss

for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a notice of opposition. Applicant's motion should be granted only if it appears certain that the Opposer cannot be entitled to relief under any set of facts that Opposer could prove in support of its claim. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1218 (TTAB 1990). Opposer can withstand the motion to dismiss if it simply alleges such facts that if proven, would establish that it is entitled to the relief sought. *See Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1874 (TTAB 2011). Put simply, to survive a motion to dismiss, Opposer's Notice of Opposition need only "state a claim to relief that is plausible on its face." *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012). Count II states a claim that is plausible on its face.

A. Opposer has Alleged Sufficient Facts to Support Count II of the Notice of Opposition

FRCP 12(b)(6) must be construed in tandem with FRCP 8(a), which requires that a pleading stating a claim for relief must contain (among other things): "a short and plain statement of the claim showing that the pleader is entitled to relief." FRCP 8(a)(2)." The pleading requirements are merely intended to give the defendant fair notice of the claims and their grounds. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). In other words, "[t]he factual allegations must be enough to raise a right to relief above the speculative level on the assumption that all the allegations in the complaint are true (even if doubtful in fact)." *Id.* (citations omitted).

Under federal notice pleading, the allegations of a complaint should be construed liberally without requiring technical forms of pleading. *Megastar, Inc. v. Harris Corp.*, 2000 TTAB LEXIS 804, *4 (TTAB 2000) (citing Fed. R. Civ. P. 1, 8(a), 8(e)(1) and 8(f)). The Notice of Opposition was sufficient to put Applicant on notice of the fact that Opposer believes the

alleged mark INSTA is not entitled to registration as a result of Applicant's non-use of the mark separate and apart from the camera logo, which is the purpose of the pleading requirements. *Twombly*, 550 U.S. at 555 (2007) (citing *Conley v. Gibson*, 355 U.S. 41 (1957)). Applicant's Motion itself demonstrates that Applicant has received "notice" of the claims and the grounds. Applicant has no trouble identifying Opposer's claim of non-use and dedicates much of its brief attempting to incorrectly argue that Opposer's claim of non-use fails because use of the alleged mark INSTA as part of the camera logo constitutes use of INSTA as a separate mark. Motion, p. 6. Though Applicant misconstrues the law, its argument demonstrates that Applicant has received "notice" of Opposer's claim of non-use. Accordingly, Opposer respectfully request that the Court deny Applicant's Motion based on FRCP 12(b)(6).

B. The Factual Allegations Alleged In Count II Demonstrate That Applicant Has Not Used The Alleged Mark INSTA In Commerce.

Twombly does not impose a probability requirement at the pleadings stage. *Twombly*, 550 U.S. at 555. If it did, though, Applicant would successfully demonstrate a likelihood of success on its claim. Applicant argues that Opposer has conceded that Applicant *has* used the alleged mark INSTA, which precludes the refusal of the mark on non-use grounds. Applicant misconstrues the allegations in Count II of the Notice of Opposition. Opposer alleges that 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. Notice of Opp., ¶¶14-15. Applicant argues that this statement is a concession that Applicant *has* used INSTA, since there is no requirement that a word element be used separate and apart from a design element in order to be "used." Motion, p. 5. Applicant wholly ignores Opposer's allegation that "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 as a separate mark. Notice of Opp., ¶¶14-15.

A design and a word mark cannot be capable of separate trademark significance if the design and the word mark are so intertwined that they create a single commercial impression. *See* McCarthy § 7:27. Applicant does not dispute that there is no requirement that a mark be used alone and by itself in order to be considered “used” in commerce; Applicant disputes that the alleged mark INSTA does not create a commercial impression separate and distinct from the camera logo to be considered “used” in commerce. Section 1051(a) specifically requires that the applied-for trademark be “used in commerce” in order to be registrable on the basis of use. While a mark does not have to be displayed in any particular size or degree of prominence, it must be used in a way that makes a commercial impression separate and apart from the other elements of the material upon which it is used, such that the designation will be recognized by prospective purchasers as a source identifier. *In re C.R. Anthony Co.*, 3 USPQ2d 1894 (TTAB 1987). Moreover, the proposed mark must not blend so well with other matter on [the] specimens that it is difficult or impossible to discern what the mark is. *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982). In this case, Applicant’s alleged INSTA mark blends with the camera logo such that the camera logo, as a whole, creates a solitary commercial impression and the small lettering within the logo does not create a commercial impression separate and apart from the mark as a whole.

Applicant relies on *General Foods Corp. v. Ito Yokado Co., Ltd.*, 219 USPQ 822 (TTAB 1983) to support its erroneous argument that the component INSTA need not be used as separate and apart from the camera logo to be registrable on the basis of use. This case, however, is inapposite; it does not address the issue at hand. This case speaks to whether trademark owners

are obliged to use a registered mark in commerce *alone* to avoid abandonment of a mark, not whether use of a tiny word *within* a composite logo constitutes use of a mark under 15 U.S.C. § 1051(a). The case does mention the fact that when opposer filed its application for registration of the bird design alone, it submitted specimens showing the bird design used in combination with the words BIRDS EYE, and the Examining Attorney was “persuaded that the design mark made a separate commercial impression and that the design could be registered on its own on the basis of that separate commercial impression.” *General Foods*, 219 USPQ at 825. However, the case goes on to state that the “question of the correctness of the decision which resulted in issuance of the separate registration of the design” is not before the Board. *Id.* Had that question been before the Board, the Board would have likely found that the specimen did not support the registration, as is the case here.

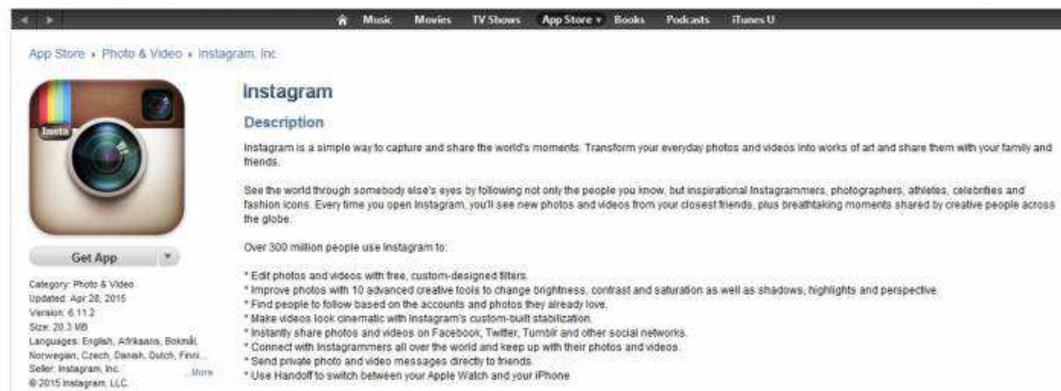
The TMEP states that, for applications filed under § 1 of the Trademark Act, the drawing must match the specimen. TMEP § 807.12(a). The mark in the drawing must be a substantially exact representation of the mark shown on the specimen. *Id.* Here, the application for registration of INSTA in standard character form, which is based under § 1 of the Trademark Act, is supported by evidence of use a materially different design mark. The application for registration of INSTA in standard character form could not be supported by a specimen of use, which shows a materially different mark consisting primarily of a representation of a camera with the formative INSTA in very small letters directly beneath the view-finder of the camera:



Therefore, the claim of use of the alleged mark INSTA in commerce must fail. The application for registration of INSTA should not have been allowed publication based on use, because the specimen showed an entirely different mark from the mark in the drawing. The drawing depicts the following:

INSTA

The specimen depicts an “entirely different mark from the mark in the drawing,” in direct opposition to the requirements of TMEP § 807.12(a):



Section 1051(a) specifically requires that the applied-for trademark be “used in commerce”. Applicant misses the mark. Opposer does not argue that two marks cannot be used in combination and both marks be separately registered and separately protected. Instead, Opposer argues that Applicant’s use of small component INSTA in connection with the camera logo does not create a separate and distinct commercial impression apart from the camera logo as a whole such that the mark INSTA has been used in commerce as a source identifier. Because Applicant does not currently and has never used the term “INSTA” as a mark, separate and apart from the composite camera logo, as shown in U.S. Registration No. 4,531,884, and because the specimen of use filed in connection with the Application does not show use of the alleged mark INSTA as identified in the drawing, Applicant’s mark has not been used in commerce in accordance with the requirements of 15 U.S.C. § 1051(a). Therefore, Opposer’s claim for non-use states a claim upon which relief can be granted and should stand.

III. CONCLUSION

For the foregoing reasons, Applicant’s Motion to Dismiss Opposer’s Notice of Opposition should 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 16th day of February, 2016, by sending it via First Class Mail, postage prepaid, to:

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