

ESTTA Tracking number: **ESTTA842191**

Filing date: **08/28/2017**

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	Instagram, LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	1601 Willow Road Menlo Park, CA 94025 UNITED STATES		

Attorney information	Annie L. Albertson Kilpatrick Townsend & Stockton LLP 9720 Wilshire Blvd., Penthouse Suite Beverly Hills, CA 90212 UNITED STATES Email: aalbertson@kilpatricktownsend.com, lmcfarland@kilpatricktownsend.com, colivier@kilpatricktownsend.com, tmadmin@kilpatricktownsend.com
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Applicant Information

Application No	87388311	Publication date	08/01/2017
Opposition Filing Date	08/28/2017	Opposition Period Ends	08/31/2017
Applicants	Spencer, Terry D 515 Crocker St. Los Angeles, CA 90013 UNITED STATES Torres, Pete 6362 Hollywood Blvd Los Angeles, CA 90013 UNITED STATES		

Goods/Services Affected by Opposition

Class 039. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Shipping and delivery services, namely, pickup, transportation, and delivery of packages and letters by various modes of transportation
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Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4146057	Application Date	09/19/2011
Registration Date	05/22/2012	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Downloadable computer software for modifying the appearance and enabling transmission of photographs		

U.S. Registration No.	4756754	Application Date	10/24/2013
Registration Date	06/16/2015	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2013/08/00 First Use In Commerce: 2013/11/01 Marketing, advertising and promotion services; dissemination of advertising for others via computer and communication networks; marketing and advertising consultation services; promoting the goods and services of others via computer and communication networks; market research services; provision of market research information Class 038. First use: First Use: 2013/08/00 First Use In Commerce: 2013/11/01 Telecommunication services, namely, transmission of advertisements and media advertising communications via computer and communication networks		


U.S. Registration No.	4795634	Application Date	03/04/2013
Registration Date	08/18/2015	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		

Design Mark	
Description of Mark	The mark consists of the word "INSTAGRAM" written in script writing.
Goods/Services	<p>Class 009. First use: First Use: 2013/05/13 First Use In Commerce: 2013/05/13 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 for use as an application programming interface (API); computer software in the nature of an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; 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</p> <p>Class 038. First use: First Use: 2013/05/13 First Use In Commerce: 2013/05/13 Telecommunications services, namely, electronic transmission of data, messages, graphics, images and information; peer-to-peer photo sharing services, namely, electronic transmission of digital photofiles among internet users; providing access to computer, electronic and online databases; providing online forums for communication, namely, transmission on topics of general interest; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, and images; telecommunications services, namely, electronic transmission of photos and videos</p> <p>Class 041. First use: First Use: 2013/05/13 First Use In Commerce: 2013/05/13 Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content; publishing services, namely, publishing of electronic publications for others</p> <p>Class 042. First use: First Use: 2013/05/13 First Use In Commerce: 2013/05/13 Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site featuring technology that allows users to manage their online photograph and social networking accounts; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, providing a web site featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; providing information from searchable indexes and databases of information; providing search engines for obtaining data via communications networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer services, namely, hosting online web facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or</p>

	<p>otherwise providing electronic media or information over communication networks; providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple web sites; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple web sites; providing information on topics of general interest from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or user-specified information, personal profiles, audio, video, photographic images, text, graphics and data</p> <p>Class 045. First use: First Use: 2013/05/13 First Use In Commerce: 2013/05/13 Internet based social introduction, networking and dating services; providing online computer databases in the fields of social networking, social introduction and dating</p>
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U.S. Registration No.	4822600	Application Date	06/20/2013
Registration Date	09/29/2015	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Downloadable computer software for modifying the appearance and enabling transmission of images, audio-visual and video content; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software for use as an application programming interface (API); computer software in the nature of an application programming interface (API) which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; 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</p>		

U.S. Registration No.	4827509	Application Date	06/20/2013
Registration Date	10/06/2015	Foreign Priority Date	NONE

Word Mark	INSTAGRAM
Design Mark	
Description of Mark	NONE
Goods/Services	Class 045. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Internet based Social introduction, networking and dating services; providing information in the form of databases featuring information in the fields of social networking, social introduction and dating


U.S. Registration No.	4856047	Application Date	06/20/2013
Registration Date	11/17/2015	Foreign Priority Date	NONE

Word Mark	INSTAGRAM
Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Providing use of online temporary non-downloadable software for enabling transmission of images and audiovisual and video content; hosting on-line web facilities as websites and mobile sites for others for managing and sharing on-line content; providing information from searchable indexes and databases of information;providing search engines for obtaining data via communications networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks;providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple websites;providing temporary use of non-downloadable software applications for so-

	cial networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or specified information in the nature of personal profiles, audio, video, photographic images, text, graphics and data
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U.S. Registration No.	4863595	Application Date	06/20/2013
Registration Date	12/01/2015	Foreign Priority Date	NONE

Word Mark	INSTAGRAM
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 038. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Telecommunications services, namely, electronic transmission of data, messages, graphics, images, videos and information; peer-to-peer photo and video sharing services, namely, electronic transmission of digital photos, video and audio-visual files among internet users; providing access to computer, electronic and online databases; providing online forums for communication, namely, transmission on topics of general interest; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, videos, and images
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U.S. Registration No.	4863594	Application Date	06/20/2013
Registration Date	12/01/2015	Foreign Priority Date	NONE

Word Mark	INSTAGRAM
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content; publishing of electronic publications for others		
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U.S. Registration No.	5019151	Application Date	08/14/2015
Registration Date	08/09/2016	Foreign Priority Date	NONE

Word Mark	INSTAGRAM		
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Design Mark			
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Description of Mark	The mark consists of the word "INSTAGRAM" written in script writing.		
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Goods/Services	Class 035. First use: First Use: 2013/08/00 First Use In Commerce: 2013/11/01 Marketing, advertising and promotion services; Dissemination of advertising for others via computer and communication networks; Promoting the goods and services of others via computer and communication networks; Marketing and advertising consultation services; Market research services; Provision of market research information; Providing online advertising services for others; Providing online advertising on computer networks		
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U.S. Registration No.	5088532	Application Date	08/14/2015
Registration Date	11/22/2016	Foreign Priority Date	NONE

Word Mark	INSTAGRAM		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 025. First use: First Use: 2013/12/00 First Use In Commerce: 2013/12/00 Clothing for men and women, namely, shirts, t-shirts, jackets, tops and sweat shirts		
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U.S. Registration No.	5181545	Application Date	09/09/2016
Registration Date	04/11/2017	Foreign Priority	NONE

		Date	
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2014/11/00 First Use In Commerce: 2014/11/00 Pens Class 018. First use: First Use: 2014/10/00 First Use In Commerce: 2014/10/00 Tote bags Class 021. First use: First Use: 2014/10/00 First Use In Commerce: 2014/10/00 Water bottles sold empty		

U.S. Application No.	86725507	Application Date	08/14/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing for children, namely, shirts, t-shirts, jackets, tops, sweat shirts, headwear, hats, caps; Clothing for men and women, namely, headwear, hats and caps		

Attachments	85426267#TMSN.png(bytes) 86100072#TMSN.png(bytes) 85866573#TMSN.png(bytes) 85965174#TMSN.png(bytes) 85965171#TMSN.png(bytes) 85983853#TMSN.png(bytes)
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Signature	/Annie L. Albertson/
Name	Annie L. Albertson
Date	08/28/2017

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

In re Application No. 87/388,311
Filed: March 28, 2017
Published: August 1, 2017 in the *Official Gazette*
For: **SMOKESTAGRAM**

INSTAGRAM, LLC,

Opposer,

vs.

PETE TORRES and TERRY D. SPENCER,

Applicants.

Opposition No. _____

NOTICE OF OPPOSITION

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, Virginia 22313-1451

Dear Sir or Madam:

Instagram, LLC (“Opposer” or “Instagram”) believes it will be damaged by the registration of the mark SMOKESTAGRAM (“SMOKESTAGRAM”) covered by Application Serial No. 87/388,311, filed on March 28, 2017, by Pete Torres and Terry D. Spencer (“Applicants”), and hereby opposes such registration.

1. Instagram is a Delaware limited liability company with its headquarters and principal place of business at 1601 Willow Road, Menlo Park, California 94025. Applicants are, upon information and belief, two individuals located at 6362 Hollywood Blvd., Los Angeles, California 90013, and 515 Crocker Street, Los Angeles, California 90013, respectively. This Notice of Opposition has been timely filed. As grounds of opposition, Instagram alleges as follows.

2. As published in the Official Gazette dated August 1, 2017, Applicants seek to register the SMOKESTAGRAM mark that is the subject of Application Serial No. 87/388,311, in International Class 39 for “*Shipping and delivery services, namely, pickup, transportation, and delivery of packages and letters by various modes of transportation.*”

3. Since the launch of its photo sharing and social networking service and software application in October 2010, Instagram has continuously used the trademark INSTAGRAM in interstate commerce in the United States in connection with its goods and services. Reflecting its trademark rights, Instagram owns U.S. registrations and applications for its INSTAGRAM mark, including the following:

<u>Trademark</u>	<u>Reg. or App. No.</u>	<u>Reg. or App. Date</u>	<u>First Use Date</u>
INSTAGRAM	4146057	5/22/2012	10/6/2010
INSTAGRAM	4756754	6/16/2015	11/1/2013
INSTAGRAM (stylized)	4795634	8/18/2015	5/13/2013
INSTAGRAM	4822600	9/29/2015	10/6/2010
INSTAGRAM	4827509	10/6/2015	10/6/2010
INSTAGRAM	4856047	11/17/2015	10/6/2010
INSTAGRAM	4863595	12/1/2015	10/6/2010
INSTAGRAM	4863594	12/1/2015	10/6/2010
INSTAGRAM (stylized)	5019151	8/9/2016	11/01/2013
INSTAGRAM	5088532	8/14/2015	12/00/2013
INSTAGRAM	5181545	9/9/2016	10/00/2014, 11/00/2014
INSTAGRAM	86725507	8/14/2015	N/A

These registrations and applications cover a variety of goods and services including, but not limited to, the following:

- Marketing, advertising and promotional services;

- 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;
- Telecommunications services, namely electronic transmission of data, messages, graphics, images and information;
- Computer services, namely providing an interactive website featuring technology that allows users to manage their online photograph and social networking accounts;
- Providing use of online software for enabling transmission of images and audiovisual and video content;
- Providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; and,
- Social introduction, networking and dating services.

Instagram's registrations and applications for its INSTAGRAM trademark are incorporated herein by reference.

4. All of Instagram's marks that feature the term INSTAGRAM are referred to herein as the "INSTAGRAM Marks."

5. The INSTAGRAM Marks are highly distinctive with regard to all of Instagram's goods and services in connection with which the marks are used.

6. Instagram's INSTAGRAM Marks have priority over Applicants' application, which is an intent-to-use based application.

7. Applicants' SMOKESTAGRAM mark creates a similar commercial impression as the INSTAGRAM Marks.

8. Applicants' services claimed in their application are related to the goods and services offered by Instagram in connection with its INSTAGRAM Marks.

9. Applicants' mark is deceptively similar to the INSTAGRAM Marks so as to cause confusion, or to cause mistake or to deceive the public as to the origin of Applicants' services offered under the mark. Specifically, registration of Applicants' mark will lead the public to conclude, incorrectly, that Applicants are or have been affiliated or connected with Instagram, and/or that Applicants' services provided under the mark are or have been, authorized, sponsored, endorsed, or licensed by Instagram. Issuance of any registration to Applicants for the proposed mark will result in damage to Instagram and the public. Therefore, registration of Applicants' mark is prohibited by 15 U.S.C. §1052(d).

10. Moreover, through Instagram's widespread use of the INSTAGRAM Marks, extensive and continuous media coverage, the high degree of consumer recognition of the INSTAGRAM Marks, Instagram's enormous and loyal user base, its multiple trademark registrations and pending applications, and other factors, the INSTAGRAM Marks are strong, enjoy widespread recognition among consumers, and have become famous within the meaning of Section 43(a) of the United States Trademark Act, 15 U.S.C. § 1125(c).

11. Applicants' mark has caused or is likely to cause dilution of the distinctive quality of the INSTAGRAM Marks and/or harm the reputation of the INSTAGRAM Marks in violation of 15 U.S.C. § 1125(c), to the harm and damage of Instagram and the public.

12. The INSTAGRAM Marks were famous before Applicants filed the application at issue and before Applicants began their use of the SMOKESTAGRAM mark.

13. Therefore, registration of Applicants' mark should be refused under 15 U.S.C. §§ 1052 and 1063(a).

14. Registration of Applicants' mark would constitute *prima facie* evidence of the validity of such registration, Applicants' ownership of the mark, and Applicants' exclusive right to

use the mark pursuant to the provisions of 15 U.S.C. § 1057(b). Such registration would be a source of damage and injury to Instagram and the public, and would be contrary to the principles of registration set out in 15 U.S.C. §§ 1051 *et seq.*

WHEREFORE, Instagram prays that this Opposition be sustained, and that registration to Applicants for the mark covered by Application Serial No. 87/388,311, be refused.

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Please direct all notices, pleadings and process regarding this matter to the below.

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

Dated: August 28, 2017

By: 

Larry W. McFarland

Annie L. Albertson

Attorneys for Opposer Instagram, LLC

Kilpatrick Townsend & Stockton LLP

9720 Wilshire Boulevard, PH Suite

Beverly Hills, CA 90212

Telephone: (310) 248-3830

Facsimile: (310) 860-0363

CERTIFICATE OF SERVICE

I hereby certify that on August 28, 2017, I served the foregoing **NOTICE OF OPPOSITION** on the parties in said action via email to Terry D. Spencer and Pete Torres at: webmaster@22block.net, webmaster@smokestagram.net, smoke@smokestagram.net, as well as via First Class Mail to:

Terry D. Spencer
515 Crocker Street
Los Angeles, CA 90013

Pete Torres
6362 Hollywood Blvd.
Los Angeles, CA 90013

Dated: August 28, 2017

By: /s/ Angelina Caviles
Angelina Caviles

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