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April 23, 2020

Opposition No. **91238805**

Snap Inc.[1]

v.

NfoSnap, Inc.

Before Zervas, Kuczma and Johnson,
Administrative Trademark Judges

By the Board:

On January 8, 2018, Snap Inc. ("Snap") filed a notice of opposition against NfoSnap, Inc.'s ("NfoSnap") Application Serial No. 87330965 for the mark NFOSNAP in standard characters for "computer software to allow controlled access for one or multiple users to scan an optical code with a portable computer or imaging device to access custom and interactive content" in International Class 9, pleading dilution and likelihood of confusion[2] with, *inter alia*, its standard character mark SNAPCHAT for "computer application software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and

[1] Snap Inc.'s change of correspondence address (filed September 13, 2019) has been noted and entered into the proceeding file.

[2] 1 TTABVUE.

text to others via the global computer network" in International Class 9.[3] NfoSnap denied the salient allegations of the notice of opposition in its answer, and counterclaimed to cancel the '712 registration alleging genericness.[4] Snap denied the salient allegations of the counterclaim in its answer.[5] Discovery closed on March 11, 2019,[6] and, as last reset, Snap's pretrial disclosures were due on July 24, 2019.[7]

This matter now comes up on Snap's motion (filed July 23, 2019)[8] and on NfoSnap's cross-motion (filed September 5, 2019)[9] for summary judgment on NfoSnap's counterclaim. The motions have been fully briefed.

Legal Standard and Burdens on Summary Judgment

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett,* 477 U.S. 317 (1986); *Opryland USA Inc. v. Great Am. Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co.,* 833 F.2d

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[3] Registration No. 4375712 ("the '712 registration") registered on the Principal Register on July 30, 2013, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Declaration under Section 8 of the Trademark Act, 15 U.S.C. § 1058, accepted on July 15, 2019.

[4] 5 TTABVUE.

[5] 7 TTABVUE.

[6] 14 TTABVUE 6.

[7] 18 TTABVUE 1; 19 TTABVUE.

[8] 20 TTABVUE (public copy) and 21 TTABVUE (confidential copy).

[9] 31 TTABVUE. Since the Board presumes that later filings are intended to supersede earlier versions of the same filing, NfoSnap's filings at 27 TTABVUE, 29 TTABVUE and 30 TTABVUE, have been given no consideration.

1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence on summary judgment is viewed in a light most favorable to the nonmoving party, and all reasonable inferences are drawn in the nonmovant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, *supra*. A factual dispute will be deemed genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The Board does not resolve disputes of material fact on summary judgment; rather, the Board only ascertains whether disputes of material fact exist. *See Univ. Book Store v. Univ. of Wisconsin Bd. of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994); *see also Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986) ("at the summary judgment stage the judge's function is not himself to weigh the evidence and determine the truth of the matter but to determine whether there is a genuine issue for trial.").

Where the party moving for summary judgment on a claim bears the burden of proof at trial on that claim, the moving party "must lay out the elements of its claim, citing the facts it believes satisfies those elements, and demonstrating why the record is so one-sided as to rule out the prospect of the nonmovant prevailing." 10A C. WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil § 2727.1 (4th ed. 2019); *see also Celotex*, 477 U.S. at 331 (Brennan, J., dissenting) ("If the moving party will bear the burden of persuasion at trial, that party must support its motion with credible evidence—using any of the materials specified in [Fed. R. Civ. P.] 56(c)—that would entitle it to a directed verdict if not controverted at trial.").

Where the party moving for summary judgment does not bear the burden of proof at trial, the party may discharge its initial burden of production by either submitting affirmative evidence that negates an essential element of the nonmoving party's claim or by demonstrating that the nonmoving party's evidence is insufficient to establish an essential element of the claim. *See id.* at 321-26.

If the movant successfully discharges its initial burden of production, the burden shifts to the nonmovant to demonstrate the existence of a genuine dispute for trial. *Id*. at 324. This requires more than a mere showing "of a scintilla of evidence in support of the [nonmovant's] position …; there must be evidence on which the jury could reasonably find for the [nonmovant]" and what may be considered reasonable for a jury "necessarily implicates the substantive evidentiary standard of proof that would apply at the trial on the merits." *Anderson*, 477 U.S. at 252. Since the standard of proof in Board inter partes proceedings on a claim of genericness is a preponderance of the evidence, *see Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015), the Board must, on summary judgment, "view the evidence presented through the prism of [this] substantive evidentiary burden" in determining if a genuine dispute exists. *Anderson*, 477 U.S. at 254. If the nonmovant's showing is insufficient to demonstrate that a genuine dispute exists on an essential element of the subject claim, the moving party is entitled to judgment as a matter of law. *See Celotex*, 477 U.S. at 322.

Legal Standard for Genericness

To prevail on a claim that a designation is generic, the claimant must identify the genus of goods or services at issue and demonstrate that the relevant public understands the designation primarily to refer to that genus of goods or services. *See H. Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) ("The critical issue … is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question."). The inquiry "into the public's understanding of a mark requires consideration of the mark as a whole. Even if each of the constituent words in a combination mark is generic, the combination is not generic unless the entire formulation does not add any meaning to the otherwise generic mark." *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005).

The Parties' Arguments on Snap's Motion

Turning first to Snap's motion, Snap argues that its registration is entitled to the presumption of validity under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), which "includes the presumption that the mark subject thereof is not merely descriptive of or generic in relation to the goods." *Editorial Am., S.A. v. Gruner + Jahr Ag & Co.*, 213 USPQ 498, 504 (TTAB 1982). Since "[a] party moving for summary judgment is entitled to the benefit of any relevant presumptions that support the motion," this presumption alone is sufficient to shift the burden of production to NfoSnap. *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 216 USPQ 579, 582 (9th Cir. 1982) ("By virtue of the presumption that the trademark 'Coke' is not generic,

Coca-Cola has met its burden of demonstrating that the genericness of the trademark 'Coke' does not raise a genuine issue of material fact.").

Nevertheless, Snap also argues that the evidence thus far adduced by NfoSnap is insufficient to establish an essential element of NfoSnap's claim of genericness, i.e., that the relevant public understands SNAPCHAT, as a whole, primarily to refer to the genus of goods at issue.

Snap first defines the relevant genus as the goods identified in the subject registration, i.e., "computer application software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and text to others via the global computer network," and we agree that the genus is as stated by Snap.[10] *See Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ("a proper genericness inquiry focuses on the description of [goods or] services set forth in the certificate of registration").

Snap then points out that the evidence NfoSnap has produced only addresses the genericness of the component terms "snap" and "chat" rather than the mark SNAPCHAT as a whole and that NfoSnap has otherwise failed to produce any

[10] NfoSnap defines the genus at issue not in terms of SNAPCHAT as a whole but rather in terms of the individual components "snap" and "chat." Specifically, NfoSnap identifies two separate genera based on wording from the identification of goods in the '712 registration, i.e., "photo" and "sending … videos, images, and text to others via the global computer network," and contends that "snap" is commonly understood as "photo" and that "chat" is commonly understood as "sending … videos, images, and text to others via the global computer network" to conclude that "[t]he whole term is generic and is understood by the relevant members of the public as referring to digital photos and informal conversations via short text exchanges in a specific application as instant messaging, or by using images, voice, video, or some combination of these." 31 TTABVUE 11 and 20. *Marvin Ginn* requires us to define only one genus.

evidence showing that the relevant public understands SNAPCHAT to primarily refer to the genus of goods at issue.[11]

NfoSnap does not dispute that its evidence pertains to demonstrating that the individual terms "snap" and "chat" are generic when used in reference to Snap's goods, but contends that "the same evidence shows that [SNAPCHAT] is generic" because the joining of the component generic terms results in a compound term that "does not create a different commercial impression from the parts [and] is nothing more than the sum of its parts and is not capable of identifying and distinguishing a single source and therefore the sum of the parts remains generic."[12]

Discussion

The relevant public's use or understanding of SNAPCHAT is critical to a determination of the mark's genericness and requires consideration of the mark as a whole. *See In re Steelbuilding.com,* 75 USPQ2d at 1421. Accordingly, in order to survive Snap's motion for summary judgment, NfoSnap may not simply rest on a showing that the constituent terms are generic or argument that such evidence is sufficient to raise a genuine dispute of material fact. *See Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986) (party opposing summary judgment "must do more than simply show that there is some metaphysical doubt as to the material facts."). Rather, NfoSnap must adduce evidence sufficient to raise a genuine dispute that the relevant public understands SNAPCHAT as a generic

[11] 20 TTABVUE 11-16.

[12] 31 TTABVUE 9 and 19.

designation for "computer application software for mobile phones, portable media players, and handheld computers, namely, software for sending digital photos, videos, images, and text to others via the global computer network."

In its briefing, NfoSnap appears to equate the relevant members of the public to the general public at large.[13] This is overbroad and inaccurate. The relevant public in a genericness inquiry are the "actual or potential purchasers of the goods or services." *Magic Wand,* 19 USPQ2d at 1553. Thus, based on the identification of goods in Snap's registration, which is unrestricted as to trade channels and end users, we presume, for purposes of summary judgment, that the relevant consumers of Snap's goods are individuals who use mobile devices to send media and text messages to others via a global computer network. *See In re Mecca Grade Growers, LLC*, 125 USPQ2d 1950, 1957 (TTAB 2018).

Most of the evidence NfoSnap has put forward seeks to establish the public's "common understanding" of each constituent term as a generic designation. This evidence, however, is insufficient to raise a genuine dispute as to whether the relevant public views SNAPCHAT as a generic designation for the genus of goods herein because, as we have noted *supra*, even if genericness is proved as to the constituent terms, the compound term will not be found generic "unless the entire formulation does not add any meaning to the otherwise generic mark." *In re*

[13] See 31 TTABVUE 6 ("Opposer's mark 'SNAPCHAT' is the combination of the generic terms 'snap' and 'chat' which are common terms recognized by the relevant public. These two terms are used excessively in the general public as generic terms. The proliferation and use of smart phones and mobile apps have greatly accelerated the use of digital photos and instant messaging, a type of online chat; thereby further causing the terms 'snap' and 'chat' to become a [sic] common and generic terms to the general public.").

Steelbuilding.com, 75 USPQ2d at 1421. To that end, NfoSnap submitted dictionary definitions of and references in online publications to SNAPCHAT as a whole. A representative sampling of that evidence is reproduced below:

Online publications:

How to Use Snapchat: Share Vanishing Photos with Snap Chat
(from https://www.lifewire.com):[14]

> Snapchat is a mobile messaging app for sharing pictures that disappear.

Snapchat: How the vanishing-photo app managed not to fade
(from https://phys.org):[15]

> Snapchat has managed to build something lasting out of photos that vanished almost instantly.
> The fast-growing social network for millennials has come a long way since its founder Evan Spiegel dropped out of Stanford University in 2012, three classes shy of graduation.

Snap: From disappearing photos to blockbuster IPO
(from https://www.usatoday.com):[16]

> Originally an app to share moments privately, Snapchat grew out of a Stanford University dorm room experiment that caught on big time with young mobile users.

Instagram Direct takes a page from Snapchat with disappearing photos and videos
(from https://www.androidpolice.com):[17]

> ... Instagram is adding some features you're probably familiar with from Snapchat—you can send images and videos that self-destruct after being viewed.

[14] 31 TTABVUE 344.

[15] *Id*. at 345.

[16] *Id*. at 346.

[17] *Id*. at 347.

How Reggie Brown invented Snapchat
(from https://techcrunch.com):[18]

> They quickly realized it would be much easier and more private for users, and thus more widely used, if they build a mobile app instead of a website; to this day, Snapchat still does not offer a web product.
> …
> With the benefit of hindsight, we can see that Facebook developed the conditions that allowed Snapchat to flourish.

The rise of Snapchat from a sexting app by Stanford frat bros to a $3 billion IPO
(from https://www.businessinsider.com):[19]

> Snapchat's beginning sounds a lot like Facebook's from "The Social Network."
> …
> At stake was the founding story of a social network to make photos disappear. Snapchat's founders ended up paying $157.5 million.
> …
> Snapchat wasn't Spiegel's first startup.
> …
> In Summer 2011, Snapchat was born—except it wasn't called Snapchat at first.
> …
> The now-duo changed the app's name to Snapchat in September 2011, its official birthday.

MUO article "What Is Snapchat and Is It Right for You?":[20]

> The popularity of Snapchat has skyrocketed since launch. And Snapchat is especially popular with younger generations.
> …
> So, what is Snapchat? How does Snapchat work? Is Snapchat right for you?
> …
> Snapchat is a multimedia app that can be used on smartphones running Android or iOS. It allows you to send pictures or videos, named "Snaps," to friends. These Snaps vanish after they've been viewed.

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[18] *Id*. at 350 and 353.

[19] *Id*. at 357-360.

[20] *Id*. at 419-420.

> The platform also offers a Chat function, similar to instant messaging services like WhatsApp. The main difference, however, is that, as with Snaps, Chats disappear once they've been viewed.

Online dictionary definitions

Cambridge Advanced Learner's Dictionary & Thesaurus:[21]

> Snapchat: the name of a social media service for sending pictures, messages, and videos that are only available to be seen for a limited amount of time.

SearchMobileComputing:[22]

> Snapchat is a mobile app that allows users to send and receive "self-destructing" photos and videos.

Techterms:[23]

> Snapchat is a mobile app and service for sharing photos, videos, and messages with other people. Once you view a message received via Snapchat, it is automatically deleted.

NfoSnap relies on this evidence to argue that "the combination of the generic term 'Snap' with the generic term 'Chat' … is nothing more than the sum of its parts and is not capable of identifying and distinguishing a single source and therefore the sum of the parts remains generic."[24] The problem with this argument is that this very same evidence of use of the compound term SNAPCHAT, including definitions thereof, uniformly refer to Snap and demonstrate that SNAPCHAT as a whole does indeed have a meaning beyond the generic meanings of the constituent terms.

Since the critical inquiry in determining genericness is the relevant public's understanding of the entirety of the designation against which the claim of

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[21] *Id*. at 369 and 411.

[22] *Id*. at 369.

[23] *Id*.

[24] *Id*. at 9.

genericness is raised, NfoSnap's evidence concerning the genericness of "snap" and "chat" as separate terms is insufficient to raise a genuine dispute as to the genericness of the combination SNAPCHAT in the face of NfoSnap's own evidence to the contrary. *See Princeton Vanguard*, 114 USPQ2d at 1832-33 ("even in circumstances where the Board finds it useful to consider the public's understanding of the individual words in a compound term as a first step in its analysis, the Board must then consider available record evidence of the public's understanding of whether joining those individual words into one lends additional meaning to the mark as a whole.").

Since NfoSnap has "fail[ed] to make a showing sufficient to establish the existence of an element essential to [its] case" for which it bears the burden of proof at trial, *see Celotex Corp.*, 477 U.S. at 322, Snap is entitled to judgment as a matter of law on NfoSnap's counterclaim.

Decision

Snap's motion for summary judgment on NfoSnap's counterclaim of genericness is **GRANTED** and the counterclaim is **DISMISSED with prejudice**.[25]

Proceedings are **RESUMED** on the following schedule:

Plaintiff's Pretrial Disclosures Due	**5/22/2020**
Plaintiff's 30-day Trial Period Ends	**7/6/2020**
Defendant's Pretrial Disclosures Due	**7/21/2020**

[25] In view of the decision herein, NfoSnap's cross-motion on its counterclaim is moot. The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Defendant's 30-day Trial Period Ends	**9/4/2020**
Plaintiff's Rebuttal Disclosures Due	**9/19/2020**
Plaintiff's 15-day Rebuttal Period Ends	**10/19/2020**
Plaintiff's Opening Brief Due	**12/18/2020**
Defendant's Brief Due	**1/17/2021**
Plaintiff's Reply Brief Due	**2/1/2021**
Request for Oral Hearing (optional) Due	**2/11/2021**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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