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

Proceeding no.	91271308
Party	Defendant WhizSolve Pte. Ltd.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Attachments	2022-01-26-WHIZSOLVE-Answer Amended Aff. Def. and Amended Counterclaims to Amended Notice of Opposition.pdf(135581 bytes )

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

SNAP, INC.

Opposer,

v.

WHIZSOLVE PTE. LTD.,

Applicant.

Opposition No. 91271308

Serial No.: 88880340

Mark: SNAPSOLVE

Classes: 9, 16, 41, 42

Published: April 27, 2021

**ANSWER, AMENDED AFFIRMATIVE DEFENSES, AND AMENDED  
COUNTERCLAIMS TO AMENDED NOTICE OF OPPOSITION**

Applicant WhizSolve Pte. Ltd. (“Applicant” or “WhizSolve”), owner of Application Serial No. 88880340 (“the subject Application”), as for its Answer, Amended Affirmative Defenses, and Amended Counterclaims states as follows:

1. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 1 of the Notice of Opposition, and therefore denies same.
2. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 2 of the Notice of Opposition, and therefore denies same.
3. Applicant admits that Registrant has pleaded Registration Nos. 4111564, 4375712, 5633315, and 6420265 as a basis for this Opposition, and that the allegations in Paragraph 3 of the Notice of Opposition appear to identify the statements made in the registrations of the filing and registration dates, the identifications of goods and/or services, and claimed first use in United States commerce dates. Applicant denies the remaining allegations in Paragraph 3.

4. Applicant states that the documents attached as Exhibit 1 speak for themselves. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 4 of the Notice of Opposition, and therefore denies same.

5. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 5 of the Notice of Opposition, and therefore denies same.

6. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 6 of the Notice of Opposition, and therefore denies same.

7. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 7 of the Notice of Opposition, and therefore denies same.

8. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 8 of the Notice of Opposition, and therefore denies same.

9. Denied.

10. Applicant admits that it filed the subject Application with the USPTO on April 21, 2020 to register the SNAPSOLVE mark on the Principal Register for the goods and services identified in the application, and admits that Registrant appears to list out the identification of goods and services contained in the application in Paragraph 10 of the Notice of Opposition. Applicant denies the remaining allegations in Paragraph 10.

11. Applicant denies that the subject Application was filed originally on a Section 1(b) basis, and states that the subject Application was also filed on a Section 44(d) basis, based on foreign Indian Registration No. 4481327 with a priority date of March 23, 2020. Applicant lacks sufficient knowledge and information to admit or deny the remaining allegations in Paragraph 11 of the Notice of Opposition, and therefore denies same.

12. Denied.

13. Denied.

14. Applicant lacks sufficient knowledge and information to admit or deny the allegations in Paragraph 14 of the Notice of Opposition, and therefore denies same.

15. Denied.

16. Denied.

17. Denied.

18. The allegations as pleaded in Paragraph 18 of the Notice of Opposition to not require a response. To the extent any answer is required, Applicant lacks sufficient knowledge and information to admit or deny the allegations, and therefore denies same.

#### **AMENDED AFFIRMATIVE DEFENSES**

1. Opposer's claims are barred by estoppel.

#### **AMENDED COUNTERCLAIMS**

#### **HISTORY OF REGISTRATION NO. 4111564**

1. Opposer Snap, Inc. ("Opposer" or "Snap") relies as a ground for opposition on Registration No. 4111564 (the "'564 Registration") covering "on-line social networking services, in Class 45." The application that issued to registration under the '564 Registration was filed by a third party, Snap Interactive, Inc. ("Snap Interactive"), for the mark SNAP INTERACTIVE based on Section 1(a) use in commerce.

2. On or about October 25, 2016, Snap Interactive filed suit against Snap in the United States District Court for the Southern District of New York, alleging that Opposer's change of its corporate name from Snapchat, Inc. to Snap, Inc. constituted infringement of Snap Interactive's registered trademarks, including, *inter alia*, the '564 Registration, which under Snap Interactive's use, became an incontestable trademark (the "Snap Interactive Lawsuit"). The

Snap Interactive Lawsuit was voluntarily dismissed on December 23, 2016. On or about December 21, 2016, as part of the settlement in the Snap Interactive Lawsuit, Snap Interactive assigned the ‘564 Registration for SNAP INTERACTIVE to Snap and the Trademark Assignment Agreement was recorded with the USPTO on February 17, 2017.

3. At the time of the assignment, Snap did not use SNAP INTERACTIVE or SNAP as a trademark for any goods or services.

4. On June 8, 2017, Opposer filed with the USPTO a Section 7(e) Request to amend the mark from SNAP INTERACTIVE to SNAP.

5. On September 5, 2017, the USPTO issued an updated Registration Certificate for the ‘564 Registration.

#### **HISTORY OF REGISTRATION NO. 6420265**

6. On November 6, 2017, Opposer filed an application to register as a trademark SNAP for a wide array of Class 42 services which included, in relevant part:

Hosting digital content on the internet; providing online web facilities for managing and sharing online photographs, videos, text, music and digital content; providing photographic images, videos, music, audio, music, text, graphics, and other information from searchable indexes and databases, by means of the internet and communication networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; 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, editing, modifying, posting, displaying, linking, sharing, transmission or otherwise providing photographs, videos, music and electronic media or information over the internet and communication networks; providing temporary use of on-line non-downloadable software applications for photo and video sharing; providing temporary use of on-line non-downloadable authentication software for controlling access to and communications with computers and computer networks,

based on Section 1(b) intent to use.

7. The application that issued to registration under Registration No. 6420265 (“the ‘265 Registration’”) was a child application of abandoned Serial No. 87673644, and proceeded to registration based on a claim of Section 1(a) use in commerce.

8. Snap did not use the mark SNAP at the time it filed its Statement of Use on August 9, 2021, nor did Snap use the mark SNAP as of the alleged first use date of July 17, 2017.

9. Applicant is being damaged by the continued registration of Opposer’s ‘564 Registration and ‘265 Registration, both for the SNAP mark, as these registrations are being used as the basis to oppose the subject Application and prevent the SNAPSOLVE mark from being registered, despite the fact that Opposer does not use SNAP as a trademark.

**COUNTERCLAIM I  
CANCELLATION OF REG. NO. 4111564 FOR NON-USE ABANDONMENT**

10. Applicant repeats and realleges the allegations in the foregoing Counterclaim Paragraphs as if fully set forth herein.

11. Opposer has not used the mark SNAP for the Class 45 services in the ‘564 Registration.

12. Opposer has not used the mark SNAP for the Class 45 services in the ‘564 Registration during the three-year period preceding the date of this cancellation counterclaim, and has no intention to use and/or resume use for such services.

13. As a result of its non-use of the SNAP trademark in connection with the services identified in ‘564 Registration, and with no intention to begin and/or resume use, Opposer has abandoned said SNAP trademark within the meaning of 15 U.S.C. § 1127, Section 45 of the Lanham Act.

**COUNTERCLAIM II**  
**CANCELLATION OF REG. NO. 4111564 FOR FRAUD ON THE USPTO**

14. Applicant repeats and realleges the allegations in the foregoing Counterclaim Paragraphs as if fully set forth herein.

15. At the time of the filing of the Request to Amend the SNAP INTERACTIVE registration, Snap did not, and does not use SNAP as a trademark or service mark for the services covered by the '564 Registration. Applicant searched online and did not identify any use of SNAP in connection with on-line social networking services.

16. In its renewal of the '564 Registration, Snap made verified statements under penalty of perjury that it used SNAP as a trademark on the covered services.

17. When it filed its application for renewal of the '564 Registration, Snap was fully aware that it did not make use of the mark shown on the services alleged in the '564 Registration, and consequently, the statements made were false and material to the USPTO's issuance of the renewal of registration.

18. In reliance on Snap's false statement of continued use of the mark covered by the '564 Registration, the USPTO issued a renewal of the '564 Registration.

19. By its conduct, Opposer has committed a fraud upon the USPTO.

20. But for Opposer's fraudulent conduct, the USPTO would not have renewed the '564 Registration.

21. Registration No. 411154 should be cancelled under Section 14 of the Trademark Act, 15 U.S.C. § 1064, because it was maintained by fraud on the USPTO.

**COUNTERCLAIM III  
CANCELLATION OF REG. NO. 6420265 AS VOID AB INITIO**

22. Applicant repeats and realleges the allegations in the foregoing Counterclaim Paragraphs as if fully set forth herein.

23. Opposer has never used, and does not use, the mark SNAP for the Class 42 services in the '265 Registration.

24. As a result of Opposer's lack of use of the SNAP trademark in connection with the services identified in '265 Registration, Opposer's '265 Registration should be cancelled because the underlying application is void ab initio under 15 U.S.C. § 1051(a), Section 1(a) of the Trademark Act.

**COUNTERCLAIM IV  
CANCELLATION OF REG. NO. 6420265 FOR FRAUD ON THE USPTO**

25. Applicant repeats and realleges the allegations in the foregoing Counterclaim Paragraphs as if fully set forth herein.

26. Opposer submitted a Statement of Use for the '265 Registration on August 18, 2020, attesting under penalty of perjury, that the SNAP mark had been first used anywhere and first used in commerce on July 17, 2017 with the following Class 42 services:

Hosting digital content on the internet; providing online web facilities for managing and sharing online photographs, videos, text, music and digital content; providing photographic images, videos, music, audio, music, text, graphics, and other information from searchable indexes and databases, by means of the internet and communication networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; 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, editing, modifying, posting, displaying, linking, sharing, transmission or otherwise providing photographs, videos, music and electronic media or information over the internet and communication networks; providing temporary use of on-line non-downloadable software applications for photo and video sharing;

providing temporary use of on-line non-downloadable authentication software for controlling access to and communications with computers and computer networks.

27. The Statement of Use declared under penalty of perjury that the representations made in the filing were true.

28. At the time Opposer sought to obtain the '265 Registration, Opposer had knowledge that it did not use, nor had it ever used, the SNAP mark in connection with the Class 42 services covered by the '265 Registration.

29. In reliance on Opposer's verified statements, which falsely stated that Opposer used the mark SNAP on the services covered by the '265 Registration, the USPTO accepted the Statement of Use approving the application for registration. The Certificate of Registration issued for the '265 Registration on July 13, 2021.

30. Opposer has not used the SNAP mark in commerce in connection with the Class 42 services identified in the '265 Registration.

31. Opposer intended to mislead the USPTO into accepting the Statement of Use and approving the SNAP mark for registration in Class 42.

32. By its conduct, Opposer has committed a fraud upon the USPTO.

33. But for Opposer's fraudulent conduct, the USPTO would not have issued the '265 Registration.

34. Registration No. 6420265 should be cancelled under Section 14 of the Trademark Act, 15 U.S.C. § 1064, because it was obtained by fraud on the USPTO.

**WHEREFORE**, Applicant respectfully requests that the Notice of Opposition be dismissed in its entirety, that Registrant's Registration Nos. 4111564 and 6420265 be cancelled, and that the subject Application proceed to registration.

Dated: January 26, 2022

Respectfully submitted,

**BAKER & HOSTETLER LLP**

*/Jacqueline M. Lesser/*

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*Counsel for Applicant WhizSolve Pte. Ltd.*

**CERTIFICATE OF SERVICE**

I, Lisa Bollinger Gehman, hereby certify that on January 26, 2022, a true and correct copy of the foregoing ANSWER, AMENDED AFFIRMATIVE DEFENSES, AND AMENDED COUNTERCLAIMS TO AMENDED NOTICE OF OPPOSITION has been served via e-mail upon counsel for the Opposer:

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*Counsel for Opposer Snap, Inc.*

*/s/ Lisa Bollinger Gehman*  
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Lisa Bollinger Gehman