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

Proceeding	91253078
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

INSTAGRAM, LLC, Opposer, vs. INSTASIZE, INC., Applicant.	Opposition No. 91253078 **OPPOSER INSTAGRAM, LLC'S REPLY IN SUPPORT OF MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS, OR IN THE ALTERNATIVE, MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES**

Opposer Instagram, LLC ("Instagram") submits this reply in support of its motion for partial judgment on the pleadings as to Applicant Instasize, Inc.'s ("Instasize") affirmative defenses, or alternatively, for an order striking Instasize's affirmative defenses.

I. Introduction

Instasize misconstrues the purpose of trademark law by asserting that Instagram is "attempting to appropriate and remove [the prefix "insta"] from the English language, sans existence as part of Opposer's trademark." Opp. at 1. To the contrary, Instagram's opposition merely recognizes the likelihood of consumer confusion that would be caused by Instasize's registration of a mark similar to INSTAGRAM for "[d]ownloadable mobile applications for photo editing," a product category that directly describes the Instagram app for which Instagram owns multiple registrations evidencing its prior rights. Instasize cannot escape this obvious conflict by asserting vague and irrelevant affirmative defenses that will only add to litigation expenses for both sides. While Instagram appreciates Instasize's willingness to voluntarily

withdraw several of its defenses, the remaining defenses are equally insufficient and Instasize's argument provides no basis to save them.

II. The Board Should Enter Partial Judgment on the Pleadings and/or Strike Applicant's Affirmative Defenses.

As set forth in the authorities cited in Instagram's Motion, this Board should strike affirmative defenses that are nothing more than boilerplate allegations, unsupported by any facts. Instasize's affirmative defenses each contain a single conclusory sentence, with no factual support whatsoever. For this reason alone, Instasize's affirmative defenses should be stricken.

Instasize quotes *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ 2d 1221, 1223 (TTAB 1995) and argues that "the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but will provide fuller notice of the basis for a claim or defense." Opp. at 3. As an initial matter, the opinion in *Order of Sons of Italy in America* simply does not include the quoted language, nor does it stand for the proposition put forth by Instasize. In fact, in that case, there was no mention of a "prejudice" requirement, and the Board *granted* a motion to strike two of the applicant's three affirmative defenses on the ground that they were legally insufficient and redundant. The only affirmative defense that was not stricken in that case was one that the Board considered "an amplification of applicant's denial of opposer's claims" because it gave opposer "more complete notice of applicant's position" by indicating the type of evidence the applicant may seek to introduce at trial. *Id.* at *3.

Here, however, Instasize's one-sentence, conclusory allegations in support of its purported affirmative defenses do not provide "more complete notice" of Instasize's position or the evidence Instasize may rely on. Rather, Instasize's bare-bones list of allegations simply identifies general legal doctrines and does nothing to put Instagram on notice of the factual bases

for its affirmative defenses. In addition, even if a showing of "prejudice" were required, it would be satisfied in this case. Unless Instasize's irrelevant and insufficient "affirmative defenses" are stricken, Instagram will need to expend additional time and resources addressing the "merits" of these unsupported allegations in discovery and at summary judgment or trial – a burden that Instagram should not have to bear. *See Villa v. Ally Fin., Inc.,* 2014 WL 800450, at *4 (M.D.N.C. Feb. 28, 2014) ("Irrelevant affirmative defenses prejudice plaintiffs where they result in increased time and expense of trial, including the possibility of extensive and burdensome discovery."). Accordingly, Instasize's argument should be rejected, and its affirmative defenses should be stricken.

A. First and Second Affirmative Defenses – Laches and Acquiescence

Instasize acknowledges the general rule that the defenses of laches and acquiescence are not applicable in opposition proceedings. In arguing that this situation presents an exception to the general rule, Instasize cites a non-precedential decision stating that laches can be considered based on "an opposer's failure to object to an applicant's earlier ***registration*** of the same or substantially same mark for the same or substantially similar goods [or services]." *Volkswagen Ag*, No. 2004, 2008 WL 4354190, at *6 (Sept. 10, 2008) (emphasis added).

Here, Instasize has never even filed an application for the INSTASIZE mark in the U.S.[1] prior to the instant application, let alone obtained a prior ***registration*** required to possibly trigger

[1] Instasize filed a trademark application for INSTASIZE in Brazil on November 11, 2015, Instagram timely filed an opposition on February 1, 2016, and the Brazilian Trademark Office ruled in Instagram's favor and denied Instasize's application on May 8, 2018.

the exception on which Instasize seeks to rely. So Instasize's argument cannot apply, and its laches defense should be stricken/dismissed.

Instasize argues that its application was filed five years ago and that this somehow forms a basis to assert a laches or acquiescence defense. But it is well settled that in a TTAB opposition proceeding, the relevant time period for purposes of laches and acquiescence "start[s] to run from the time the mark is published for opposition, not from the time of knowledge of use." *Lodestar Anstalt*, 91216163, 2017 WL 513974, at *3 (TTAB Feb. 2, 2017) (citing *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572 (Fed. Cir. 1991)) (striking affirmative defenses of laches and acquiescence where opposition was timely filed and applicant provided no factual bases to support defenses). Three days after the INSTASIZE application was published for opposition, Instagram opposed. Instagram filed its opposition at the first opportunity and thus cannot be accused of undue delay as a matter of law. Instasize's laches and acquiescence defenses should therefore be dismissed/stricken.

B. Seventh Affirmative Defense – Bad Faith and Unclean Hands

Failure to provide notice of the factual basis for an affirmative defense is a sufficient ground to strike the defense. *See* TBMP §§ 506, 311.02(b). Instasize's seventh affirmative defense simply reads, "Opposer's claims are barred by the doctrine of bad faith and unclean hands." Thus, the purported defense does nothing more than state a legal conclusion, has no factual support, and should be stricken for this reason alone. *See, e.g., Lodestar Anstalt*, 2017 WL 513974, at *3-*5 (striking both opposer's and applicant's "bald pleadings" of unclean hands that merely "list[ed] the[] defense[] by name" and "provided no further facts upon which [it] might plausibly be based"); *Arabica Funding, Inc., & Caribou Coffee Co., Inc.*, No. 91202224,

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