

ESTTA Tracking number: **ESTTA619984**

Filing date: **08/06/2014**

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 | Telegram Messenger LLP |
| Granted to Date of previous extension | 08/06/2014 |
| Address | Suite 2 23-24 Great James Street London, WC1N 3ES UNITED KINGDOM |
| Party who filed Extension of time to oppose | Telegram Mesenger LLP |
| Relationship to party who filed Extension of time to oppose | Same entity, however "Telegram Messenger LLP" was misspelled in extension filing. |

| | |
|----------------------|---|
| Attorney information | James W. Dabney Fried, Frank, Harris, Shriver & Jacobson LLP 1 New York Plaza New York, NY 10004 UNITED STATES dabnejam@friedfrank.com, teas@friedfrank.com Phone:212-859-8000 |
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Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86116716 | Publication date | 04/08/2014 |
| Opposition Filing Date | 08/06/2014 | Opposition Period Ends | 08/06/2014 |
| Applicant | Telegram LLC 1521 Concord Pike Ste 303 Wilmington, DE 19803 UNITED STATES | | |

Goods/Services Affected by Opposition

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|--|
| <p>Class 009. First Use: 2013/08/14 First Use In Commerce: 2013/08/14 All goods and services in the class are opposed, namely: Downloadable mobile applications for messaging and securely communicating with peers, enabling transmission of images, audio-visual and video content, and other multi-media; Downloadable software for instant messaging, file sharing, communications, electronically exchanging data, audio, video images and graphics via computer, mobile, wireless, telecommunications networks and downloadable computersoftware for processing images, graphics, audio, video, and text</p> |
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Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | NO OWNERSHIP IN APPLICANT |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|------------------------------------|---|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | TELEGRAM | | |
| Goods/Services | Downloadable mobile applications for messaging and securely communicating with peers, enabling transmission of images, audio-visual and video content, and other multi-media; Downloadable software for instant messaging, file sharing, communications, electronically exchanging data, audio, video images and graphics via computer, mobile, wireless, telecommunications networks and downloadable computer software for processing images, graphics, audio, video, and text. | | |

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|---------------------|---|
| Related Proceedings | Pavel Durov, Telegram Messenger LLP, and Dogged Labs Limited v. Ilya Sherbovich, Ilya Perekopsky, David Axel Neff Yuri Kachuro, Victoria Lazareva, United Capital Partners, Digital Fortress LLC, Telegram LLC, Pictograph LLC, and John Does 1-3, No. 14 Civ. 3063 (LGS) |
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|-------------|---|
| Attachments | Durov-Notice of Opposition.pdf(190907 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-----------------|
| Signature | /JWD/ |
| Name | James W. Dabney |
| Date | 08/06/2014 |

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

NOTICE OF OPPOSITION

In the matter of Application Serial No.
86116716 Published in the Official Gazette
on April 8, 2014 at page TM 686.

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|-------------------------|---|----------------|
| PAVEL DUROV and | : | |
| TELEGRAM MESSENGER LLP, | : | |
| | : | |
| | : | |
| Opposers, | : | |
| | : | |
| v. | : | Opp. No. _____ |
| | : | |
| TELEGRAM LLC, | : | |
| | : | |
| | : | |
| Applicant. | : | |
| | : | |

Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

SIR:

PAVEL DUROV, an individual who is a citizen of the Russian Federation, and TELEGRAM MESSENGER LLP, a limited liability partnership organized and existing under the laws of England and Wales, having its principal place of business located at Suite 2, 23-24 Great James Street, London, United Kingdom, WCN1 3ES, believe that they would be damaged by registration of the mark shown in the above-identified application (the "Proposed Mark"), and hereby oppose same.

As grounds of opposition, Pavel Durov and Telegram Messenger LLP allege:

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office on August 6, 2014.

| | | |
|-------------------------|--------------------|---------------------|
| <u>Hadi Nilforoshan</u> | <u>[Signature]</u> | <u>8/6/2014</u> |
| (Name) | (Signature) | (Date of Signature) |

COUNT 1—NO OWNERSHIP IN APPLICANT

1. Pavel Durov is the founder and owner of TELEGRAM, a cloud-based heavily encrypted electronic messaging service with over 35 million users that allows users to send text messages, pictures, and videos on smartphones and other electronic devices in a secure manner. A description of the TELEGRAM service appears at the web site associated with the domain name www.telegram.org.

2. Telegram Messenger LLP is owned by Pavel Durov and is the current repository of all trademark rights and goodwill appurtenant to the TELEGRAM messaging service that Pavel Durov founded and owns. Telegram Messenger LLP is the owner of European Community Trade Mark Application Serial No. 012800587.

3. Prior to November 12, 2013, Pavel Durov provisioned and financed the distribution and operation of TELEGRAM messaging service in the United States through trusted individuals including Ilya Perekopsky (“Perekopsky”) and David Axel Neff (“Neff”).

4. Prior to November 12, 2013, Pavel Durov instructed Perekopsky and Neff to form the Applicant, Telegram LLC (“Applicant”), and to file the application for registration which is the subject of this Notice of Opposition (the “Application”).

5. At a time currently unknown to Opposers, but prior to April 2, 2014, Neff purported to sell the Applicant to a British Virgin Islands entity that is owned and controlled by third parties located in the Russian Federation, without the knowledge or authorization of Opposers.

6. On April 30, 2014, Opposers commenced a civil action against Applicant and the entities and individuals involved in the illegal sale of Applicant, entitled *Pavel Durov, Telegram Messenger LLP, and Dogged Labs Limited v. Ilya Sherbovich, Ilya Perekopsky, David*

Axel Neff, Yuri Kachuro, Victoria Lazareva, United Capital Partners, Digital Fortress LLC, Telegram LLC, Pictograph LLC, and John Does 1-3, No. 14 Civ. 3063 (LGS), in the United States District Court for the Southern District of New York (the “New York Action”).

7. Applicant is not the owner of the Proposed Mark and has no right to seek registration of the Proposed Mark.

8. Applicant has no right to use the Proposed Mark and accordingly lacks any bona fide intention to use the Proposed Mark.

9. Registration of the Proposed Mark to Applicant would damage Opposers, in that such registration would give false color to a claim of right in Applicant to exclusive rights in the TELEGRAM mark and conflict with Opposers’ exclusive rights to use TELEGRAM to identify the origin of electronic messaging services provided by Opposers.

COUNT 2—LIKELIHOOD OF CONFUSION

10. Paragraphs 1 through 9, above, are realleged and incorporated by reference as if set forth in full.

11. Pavel Durov adopted and used TELEGRAM as a service mark in United States commerce prior to November 12, 2013.

12. Telegram Messenger LLP holds the goodwill associated with Pavel Durov’s use of TELEGRAM in association with electronic messaging services.

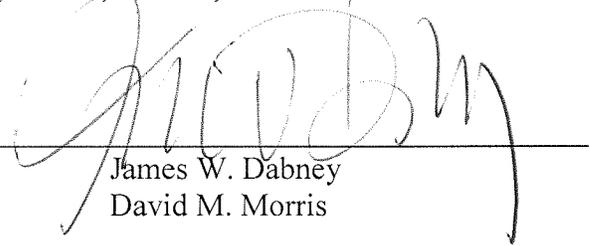
13. The Proposed Mark so resembles Opposers’ mark TELEGRAM as to be likely, when used on or in connection with the goods or services identified in the Application, to cause confusion, to cause mistake, or to deceive, including by causing persons familiar with Opposers’ services to believe, falsely, that Applicant or its services are sponsored, authorized, endorsed, affiliated with, or otherwise approved by Opposers.

14. Registration of the Proposed Mark to Applicant would damage Opposers, in that such registration would give false color to a claim of right in Applicant to exclusive rights in the TELEGRAM mark and conflict with Opposers' exclusive rights to use TELEGRAM to identify the origin of electronic messaging services provided by Opposers.

WHEREFORE, Opposers pray that this opposition be sustained, and that registration of the Proposed Mark to Applicant be refused. Please recognize as attorneys for Opposers in this proceeding, James W. Dabney and David M. Morris (members of the Bar of the State of New York), and the law firm of Fried, Frank, Harris, Shriver, & Jacobson LLP, One New York Plaza, New York, New York 10004.

FRIED, FRANK, HARRIS, SHRIVER & JACOBSON LLP

By



James W. Dabney
David M. Morris

Date: August 6, 2014

One New York Plaza
New York, New York 10004
(212) 859-8000

Attorneys for Opposers Pavel Durov &
Telegram Messenger LLP

CERTIFICATE OF SERVICE

I hereby certify under penalty of perjury pursuant to 28 U.S.C. §1746 that on August 6, 2014, I caused to be served on the following, by First Class Mail, postage prepaid, a true and correct copy of the foregoing Notice of Opposition:

Telegram LLC
1521 Concord Pike, Suite 303
Wilmington, Delaware 19803

Dated: New York, New York
August 6, 2014



Hadi Nilforoshan