

ESTTA Tracking number: **ESTTA947127**

Filing date: **01/11/2019**

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	Snap Inc.
Granted to Date of previous extension	01/13/2019
Address	63 Market Street Venice, CA 90291 UNITED STATES

Attorney information	JOSHUA J RICHMAN IPLA, LLP 650 CALIFORNIA STREET, 7TH FLOOR SAN FRANCISCO, CA 94108 UNITED STATES litigation@ipla.com, snapadversarial@ipla.com (858) 272-0220
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**Applicant Information**

Application No	87748310	Publication date	07/17/2018
Opposition Filing Date	01/11/2019	Opposition Period Ends	01/13/2019
Applicant	BADMOJI INC SUITE 14 4882 GRATIOT AVE SAGINAW, MI 48638 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Downloadable software for educational artistic expression consisting of user created avatars that are socially interactive with mature themes, namely, communications content software for use with third party software for electronically exchanging data, audio, video images and graphics via computer, mobile, wireless, telecommunications networks
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
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**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration	5409939	Application Date	04/01/2016
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No.			
Registration Date	02/27/2018	Foreign Priority Date	NONE
Word Mark	BITMOJI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2014/10/29 First Use In Commerce: 2014/10/29 Downloadable computer software application which allows users to create virtual images and comic strips consisting of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that can be posted, shared and transmitted via multi-media messaging (MMS), text messaging (SMS), email, online chatrooms, global computer networks, and other telecommunications networks; Computer software application for creating digital animation, namely, video games, television shows and movies with user created avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Video and electronic game software; user created video and electronic game software</p> <p>Class 041. First use: First Use: 2014/10/29 First Use In Commerce: 2014/10/29 Mobile media and entertainment services in the nature of non-animated content preparation, namely, creation and production of multimedia entertainment content in the form of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Entertainment services, namely, providing online non-downloadable graphics in the nature of digital comic strips via a website, namely, avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that end users can transmit and receive by means of the Internet or other computer or telecommunication networks, wireless communications networks, or by using computers, laptops, mobile equipment, and handheld digital electronic devices</p>		

Attachments	86983076#TMSN.png( bytes ) Snap v. Badmoji Inc. Notice of Opposition.pdf(2585732 bytes )
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Signature	/Joshua J. Richman/
Name	JOSHUA J RICHMAN
Date	01/11/2019

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

Snap Inc.,	)	
	)	
	)	
Opposer,	)	Mark: BADMOJI
	)	Serial No.: <a href="#">87748310</a>
v.	)	Filing Date: January 9, 2018
	)	Published: July 17, 2018
Badmoji Inc.,	)	
	)	
Applicant.	)	
	)	
	)	
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**NOTICE OF OPPOSITION**

Opposer Snap Inc., a Delaware corporation with an address of 63 Market Street, Venice, California 90291 (“**Snap**”), believes that it will be damaged by registration of BADMOJI (the “**Applicant’s Mark**”), as set forth in Application Serial No. [87748310](#) (the “**Application**”) owned by Badmoji Inc with an address of 4882 Gratiot Ave., Suite 14, Saginaw, Michigan, 48638 (the “**Applicant**”). Snap alleges as follows:

**SNAP’S BUSINESS**

1. Snap is the designer and distributor of the extremely popular SNAPCHAT camera and messaging application—available for both the iOS and Android operating system—that, among other things, allows users to edit and share photographs, videos, and messages called “Snaps” with others via mobile devices.

2. Since the SNAPCHAT application launched in 2011, the software application has become one of the most popular mobile applications in the world. As of September 2018, approximately 186 million people around the world were using the SNAPCHAT application every day. Snap’s many millions of registered users have shared billions of photo and video messages.

The SNAPCHAT software application has also been a top downloaded application in the Apple App store and Google Play Store for several years.

3. The SNAPCHAT application has won various awards, has been the subject of significant unsolicited media publicity, and is consistently used by many high-profile celebrities, athletes, musicians, politicians, and actors. Because of its widespread adoption, SNAPCHAT has achieved a high degree of consumer recognition and has become a strong and famous trademark among the general consuming public.

4. Over time, Snap has introduced new and innovative technology and features into its SNAPCHAT application. One such new feature is BITMOJI cartoon avatars. Snap acquired the BITMOJI avatar application and service from Bitstrips Inc. in a highly publicized acquisition in July 2016. BITMOJI is also a standalone software application that allows users to create personalized cartoon avatars of themselves that can be shared within SNAPCHAT, and also by text, email, and other electronic means. The BITMOJI cartoon avatars have become wildly popular, with millions of BITMOJI avatars being created and shared per day.

5. The BITMOJI application is routinely ranked by Apple as one of the top-ten free iOS applications. The BITMOJI application has been the most downloaded application in five major markets: United States, United Kingdom, France, Canada, and Australia. BITMOJI was the most downloaded iPhone software application worldwide in 2017.

6. Snap, and Bitstrips Inc. before it, has spent considerable time and effort developing the BITMOJI application and associated artwork. Reflecting that effort, Snap owns numerous copyrights in the BITMOJI avatar designs and artwork, as well as trademark registrations around the world for BITMOJI.

**SNAP’S TRADEMARK RIGHTS**

7. Snap is the owner of the following trademark registration on the USPTO Principal

Register (“**Snap’s Registration**”):

Trademark	Description of Goods/Services
BITMOJI  Registration No. 5409939  Registered: February 27, 2018	Class 9: Downloadable computer software application which allows users to create virtual images and comic strips consisting of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that can be posted, shared and transmitted via multi-media messaging (MMS), text messaging (SMS), email, online chatrooms, global computer networks, and other telecommunications networks; Computer software application for creating digital animation, namely, video games, television shows and movies with user created avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Video and electronic game software; user created video and electronic game software  Class 41: Mobile media and entertainment services in the nature of non-animated content preparation, namely, creation and production of multimedia entertainment content in the form of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Entertainment services, namely, providing online non-downloadable graphics in the nature of digital comic strips via a website, namely, avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that end users can transmit and receive by means of the Internet or other computer or telecommunication networks, wireless communications networks, or by using computers, laptops, mobile equipment, and handheld digital electronic devices

A copy of the Snap Registration is enclosed as **Exhibit A**, along with print-outs from the Trademark Office’s electronic database showing the current status and title of the registration.

8. Snap, either itself or through its predecessor in interest, has used the BITMOJI trademark since at least as early as October 29, 2014.

**APPLICANT AND ITS APPLICATION**

9. On January 9, 2018, Applicant filed its Application to register BADMOJI in connection with the following goods:

Class 09: Downloadable software for educational artistic expression consisting of user created avatars that are socially interactive with mature themes, namely, communications content software for use with third party software for electronically exchanging data, audio, video images and graphics via computer, mobile, wireless, telecommunications networks

The Application was filed based on Lanham Act Section 1(b). The Application published for opposition on July 17, 2018. Snap obtained a 60-day extension of time to oppose the Application, making the opposition deadline January 13, 2019 (tolling to January 14, 2019).

**COUNT 1**

**Likelihood of Confusion  
(15 U.S.C. § 1052(d) and 15 U.S.C. §1125(a))**

10. Snap realleges and incorporates by reference the preceding allegations of this Notice of Opposition.

11. Snap's trademark rights in and to BITMOJI are senior to any rights that Applicant may allege to have in its Application or Applicant's Mark because Snap's Registration for the BITMOJI mark was filed before the filing date of Applicant's Application.

12. Snap's trademark rights are senior to any rights that Applicant may allege to have in its Application or Applicant's Mark because, on information and belief, Applicant did not use Applicant's Mark in commerce for the goods and services claimed in the Application prior to the filing date or first use in commerce date of Snap's Registration, alleged herein.

13. Snap's trademark rights are senior to any rights that Applicant may allege to have in its Application or Applicant's Mark because Snap also owns common law trademark rights to the BITMOJI mark that predate the filing date of Applicant's Application.

14. Applicant's Mark is confusingly similar to the BITMOJI mark in sight, sound, appearance, and commercial impression. Indeed, Applicant's Mark incorporates the identical MOJI suffix with a leading three letter, one syllable prefix starting with "B". Only two letters separate the marks at issue.

15. The goods claimed in Applicant's Application are substantially similar to the goods claimed in Snap's Registration. Also, the goods claimed in Applicant's Application are substantially similar to the goods and services that Snap actually offered in United States commerce in connection with the BITMOJI mark prior to the filing date of Application.

16. Applicant had constructive knowledge and, on information and belief, had actual knowledge of Snap's trademark rights in and to the BITMOJI mark before it filed its Application.

17. Snap would be damaged by registration of Applicant's Mark because the mark so closely resembles the BITMOJI mark as to be likely to cause confusion, mistake, and deception. Persons familiar with the BITMOJI mark, and the goods and services offered under this mark, would be likely to believe erroneously that Applicant's goods are the goods of Snap or are authorized, endorsed, sponsored, or licensed by Snap. Thus, registration of Applicant's Mark on the Principal Register would be inconsistent with Snap's strong prior rights in the BITMOJI mark under Lanham Act § 2(d).

WHEREFORE, it is respectfully requested that this opposition be sustained and that the Application be denied registration based on likelihood of confusion with Snap's prior BITMOJI registration.

Dated: January 11, 2019

Respectfully submitted,

*/Joshua J. Richman/*

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San Francisco, CA 94108  
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# **Exhibit A**

# United States of America

United States Patent and Trademark Office

## BITMOJI

**Reg. No. 5,409,939**

**Registered Feb. 27, 2018**

**Int. Cl.: 9, 41**

**Service Mark**

**Trademark**

**Principal Register**

SNAP INC. (DELAWARE CORPORATION)  
63 Market Street  
Venice, CALIFORNIA 90291

CLASS 9: Downloadable computer software application which allows users to create virtual images and comic strips consisting of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that can be posted, shared and transmitted via multi-media messaging (MMS), text messaging (SMS), email, online chatrooms, global computer networks, and other telecommunications networks; Computer software application for creating digital animation, namely, video games, television shows and movies with user created avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Video and electronic game software; user created video and electronic game software

FIRST USE 10-29-2014; IN COMMERCE 10-29-2014

CLASS 41: Mobile media and entertainment services in the nature of non-animated content preparation, namely, creation and production of multimedia entertainment content in the form of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Entertainment services, namely, providing online non-downloadable graphics in the nature of digital comic strips via a website, namely, avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that end users can transmit and receive by means of the Internet or other computer or telecommunication networks, wireless communications networks, or by using computers, laptops, mobile equipment, and handheld digital electronic devices

FIRST USE 10-29-2014; IN COMMERCE 10-29-2014

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 86-983,076, FILED 04-01-2016



*Andrei Iancu*

Director of the United States  
Patent and Trademark Office

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Starting Oct. 4, 2018, bulk data customers should no longer obtain direct access to TSDR data through [tsdrsec.uspto.gov](http://tsdrsec.uspto.gov). There are two alternative ways to receive bulk data from TSDR.

**Trademark Status & Document Retrieval (TSDR)** ?

SEARCH MULTI-SEARCH ?

US Serial, Registration, or Reference No. 5409939 [Status](#) [Documents](#)

Status results found

STATUS	DOCUMENTS	MAINTENANCE	?
Download  Print Preview			
Generated on: This page was generated by TSDR on 2019-01-11 19:28:15 EST			
Mark: BITMOJI			
US Serial Number: 86983076	Application Filing Date: Apr. 01, 2016		
US Registration Number: 5409939	Registration Date: Feb. 27, 2018		
Filed as TEAS RF: Yes	Currently TEAS RF: Yes		
Register: Principal			
Mark Type: Trademark, Service Mark			
TM5 Common Status Descriptor:	LIVE/REGISTRATION/Issued and Active		
	The trademark application has been registered with the Office.		
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.			
Status Date: Feb. 27, 2018			
Publication Date: Mar. 28, 2017			
<b>▼ Mark Information</b> <span style="float: right;">▼ Expand All</span>			
Mark Literal Elements: BITMOJI			
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.			
Mark Drawing Type: 4 - STANDARD CHARACTER MARK			
<b>▼ Related Properties Information</b>			
International Registration Number: 1326620			
International Application(s): A0061947/1326620			

/Registration(s) Based on  
this Property:

Child Of: 86961890

#### ▼ Goods and Services

##### Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [ . ] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Downloadable computer software application which allows users to create virtual images and comic strips consisting of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that can be posted, shared and transmitted via multi-media messaging (MMS), text messaging (SMS), email, online chatrooms, global computer networks, and other telecommunications networks; Computer software application for creating digital animation, namely, video games, television shows and movies with user created avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Video and electronic game software; user created video and electronic game software

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Oct. 29, 2014

**Use in Commerce:** Oct. 29, 2014

**For:** Mobile media and entertainment services in the nature of non-animated content preparation, namely, creation and production of multimedia entertainment content in the form of avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things; Entertainment services, namely, providing online non-downloadable graphics in the nature of digital comic strips via a website, namely, avatars, graphic icons, symbols, images representing individuals, fanciful designs, comics, comic series, phrases, and graphical depictions of people, places and things that end users can transmit and receive by means of the Internet or other computer or telecommunication networks, wireless communications networks, or by using computers, laptops, mobile equipment, and handheld digital electronic devices

**International Class(es):** 041 - Primary Class

**U.S Class(es):** 100, 101, 107

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Oct. 29, 2014

**Use in Commerce:** Oct. 29, 2014

#### ▼ Basis Information (Case Level)

**Filed Use:** Yes

**Currently Use:** Yes

**Filed ITU:** Yes

**Currently ITU:** No

**Filed 44D:** No

**Currently 44E:** No

**Filed 44E:** No

**Currently 66A:** No

**Filed 66A:** No

**Currently No Basis:** No

**Filed No Basis:** No

#### ▼ Current Owner(s) Information

**Owner Name:** SNAP INC.

**Owner Address:** 63 MARKET STREET  
VENICE, CALIFORNIA UNITED STATES 90291

**Legal Entity Type:** CORPORATION

**State or Country Where  
Organized:** DELAWARE

#### ▼ Attorney/Correspondence Information

##### Attorney of Record

**Attorney Name:** John M. Kim

**Attorney Primary Email  
Address:** trademarks@ipla.com

**Attorney Email Authorized:** Yes

Correspondent

Correspondent JOHN M. KIM  
Name/Address: IPLA, LLP  
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SAN DIEGO, CALIFORNIA UNITED STATES 92121

Phone: 8582720220

Fax: 8582720221

Correspondent e-mail: [trademarks@ipla.com](mailto:trademarks@ipla.com)

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

▼ Prosecution History

Date	Description	Proceeding Number
Feb. 27, 2018	REGISTERED-PRINCIPAL REGISTER	
Jan. 26, 2018	NOTICE OF REINSTATEMENT MAILED	
Jan. 25, 2018	1(B) BASIS DELETED; PROCEED TO REGISTRATION	70565
Sep. 17, 2017	NOTICE OF ALLOWANCE CANCELLED	70565
Sep. 12, 2017	REINSTATEMENT GRANTED - REQUEST TO DELETE 1(B) FILED	70565
Dec. 26, 2017	ABANDONMENT NOTICE MAILED - NO USE STATEMENT FILED	
Dec. 25, 2017	ABANDONMENT - NO USE STATEMENT FILED	99999
Sep. 12, 2017	DIVISIONAL PROCESSING COMPLETE	
Aug. 28, 2017	DIVISIONAL REQUEST RECEIVED	
Sep. 12, 2017	CASE ASSIGNED TO INTENT TO USE PARALEGAL	70565
Aug. 28, 2017	TEAS REQUEST TO DIVIDE RECEIVED	
May 23, 2017	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Mar. 28, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Mar. 28, 2017	PUBLISHED FOR OPPOSITION	
Mar. 08, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Feb. 21, 2017	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Jan. 30, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 30, 2017	EXAMINER'S AMENDMENT ENTERED	88888
Jan. 30, 2017	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Jan. 30, 2017	EXAMINERS AMENDMENT E-MAILED	6328
Jan. 30, 2017	EXAMINERS AMENDMENT -WRITTEN	82421
Jan. 19, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Jan. 19, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Jan. 17, 2017	ASSIGNED TO LIE	70884
Dec. 16, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 05, 2016	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 18, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jul. 18, 2016	NON-FINAL ACTION E-MAILED	6325
Jul. 18, 2016	NON-FINAL ACTION WRITTEN	82421
Jul. 15, 2016	ASSIGNED TO EXAMINER	82421

Apr. 07, 2016	NOTICE OF PSEUDO MARK E-MAILED
Apr. 06, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM
Apr. 05, 2016	NEW APPLICATION ENTERED IN TRAM
<b>▼ TM Staff and Location Information</b>	
TM Staff Information - None	
File Location	
Current Location: PUBLICATION AND ISSUE SECTION	Date in Location: Feb. 27, 2018
<b>▼ Assignment Abstract Of Title Information - None recorded</b>	
<b>▼ Proceedings - None recorded</b>	

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