

ESTTA Tracking number: **ESTTA466311**

Filing date: **04/10/2012**

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	Western Union Holdings, Inc.
Granted to Date of previous extension	04/11/2012
Address	12500 E. Belford Ave. Englewood, CO 80112 UNITED STATES
Attorney information	E. A. Langworthy / C. J. Galus Sutherland Asbill & Brennan LLP 1275 Pennsylvania Ave., NW Washington, DC 20004-2415 UNITED STATES eteas@sutherland.com Phone:202-383-0100

**Applicant Information**

Application No	79094410	Publication date	12/13/2011
Opposition Filing Date	04/10/2012	Opposition Period Ends	04/11/2012
International Registration No.	1069304	International Registration Date	02/15/2011
Applicant	WOOGROUP Soci�t� Anonyme 58 Avenue de Wagram F-75017 Paris FRANCE		

**Goods/Services Affected by Opposition**

Class 036. All goods and services in the class are opposed, namely: Financial and monetary affairs, namely, money transfer
---

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3284554	Application Date	11/01/2006
Registration Date	08/28/2007	Foreign Priority Date	NONE

Word Mark	WU
Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2006/08/28 First Use In Commerce: 2006/08/28 financial services, namely, banking services, money transfer services, electronic funds transfer services, bill payment services, money order services, credit card services, prepaid card services in the nature of adding airtime to prepaid or pay-as-you-go services that reload cash on pre-paid/secured debit cards, and that recharge minutes to pre-paid long distance calling cards; gift check services in the nature of issuing personalized gift checks akin to money orders; automatic teller machine services, debit and stored value card services and direct deposit of funds into customer bank accounts; automated clearing house deposit services

Attachments	77034296#TMSN.jpeg ( 1 page )( bytes ) WOOGROUP - Notice of Opposition Ser No 79094410.pdf ( 11 pages )(32474 bytes ) WOOGROUP Exhibit A DOC.pdf ( 6 pages )(281161 bytes )
-------------	---

### Certificate of Service

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

Signature	/Christina J. Galus/
Name	Christina J. Galus
Date	04/10/2012

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

WESTERN UNION HOLDINGS, INC.,

Opposer,

v.

WOOGROUP Société Anonyme,

Applicant.

**E-FILING**

Opposition No.: \_\_\_\_\_

App. No.: 79094410

Mark: WOONEO

Published: December 13, 2011

**NOTICE OF OPPOSITION**

Western Union Holdings, Inc., a corporation organized and existing under the laws of the state of Georgia, having its office and principal place of business at 12500 E. Belford Avenue, Englewood, CO 80112 (hereinafter, collectively with its predecessors-in-interest and related companies, “Opposer”), believes that it will be damaged by registration of the mark WOONEO subject of Application Serial No. 79094410 in the name of WOOGROUP Société Anonyme (“Applicant”) for all services recited in the application, namely, “financial and monetary affairs, namely, money transfer” in International Class 36. As grounds for opposition, Opposer hereby alleges:

1. By the application opposed herein, Applicant is a French “societe anonyme” or joint stock company having a principal place of business at 58 Avenue de Wagram, F-75017 Paris, France.

2. By the application opposed herein, Applicant is seeking to register the alleged mark WOONEO in association with “financial and monetary affairs, namely, money transfer” in International Class 36.

3. Upon information and belief, Applicant has sought to register in the United States a family of WOO-formative marks for the services mentioned above and other related financial services. Opposer was successful in canceling Applicant's federal registration for WOOPAY (Reg. No. 3936821) for "financial affairs and monetary affairs, namely, money transfer" and opposing its application for federal registration of WOO (Serial No. 79080064 - Opposition No. 91201992) for "financial affairs and monetary affairs, namely, money transfer." Applicant's application for registration of WOOGROUP (Serial No. 79098664) for "financial services, namely, banking services, money transfer services, electronic funds transfer services, bill payment services, money order services, credit card services, prepaid card services, gift check services, automatic teller machine services, debit and stored value card services and direct deposit of funds into customer bank accounts; automated clearing house deposit services and on-line auction payment and settlement services" was abandoned due to Applicant's failure to respond to an Office Action issued on August 22, 2011.

4. Opposer obtained extensions of time to oppose Application No. 79094410 through and including April 11, 2012.

5. Opposer is the owner of the trade name and mark WU (the "WU Mark"), used by itself and/or as a formative with other letters or wording, for example WUPOS, WUGIFTCARD, WU&YOU, and WU PREPAID (collectively the "WU Marks"). Since at least as early as 1865, Opposer has used the WU Mark to identify its business, goods and services in the United States and worldwide. Opposer also owns domain name registrations for numerous WU-formative domains, including wugiftcard.com, wuprepaid.com, wugift.com, wugoldcard.com, wusourcing.com, wupanama.com, wu-sim.com, wugocash.com, wumallmobile.com, wuyeseffect.com, wub.fr, wubank.co.uk, wubank.de, wubank.es, wubank.fr, wubank.no,

wubank.pl, wuclub.de, wuclub.eu, wuclub.fr, and wuclub500.com (collectively the “WU Domains”), and uses these domains to promote its business, goods, and services.

6. Opposer’s WU Marks and WU Domains all share the term “WU” and have been extensively used and promoted by Opposer in such a manner that the consuming public associates “WU” with Opposer. The purchasing public recognizes that each of Opposer’s WU Marks and the shared characteristics of the WU Marks are indicative of the common origin of the goods and services promoted by Opposer through use of its WU Marks.

7. Opposer obtained federal registration of its WU Mark on August 28, 2007 under U.S. Registration No. 3284554. Such registration is valid and subsisting and is *conclusive* evidence of Opposer’s exclusive right to use Opposer’s WU Mark in connection with “financial services, namely, banking services, money transfer services, electronic funds transfer services, bill payment services, money order services, credit card services, prepaid card services in the nature of adding airtime to prepaid or pay-as-you-go services that reload cash on pre-paid/secured debit cards, and that recharge minutes to pre-paid long distance calling cards; gift check services in the nature of issuing personalized gift checks akin to money orders; automatic teller machine services, debit and stored value card services and direct deposit of funds into customer bank accounts; automated clearing house deposit services,” and to prevent registration of confusingly similar marks. Pursuant to 37 CFR § 2.122(d), a current printout of information from the electronic database records of the United States Patent and Trademark Office showing the current status and title of the registration is attached hereto as Exhibit A.

8. When Opposer first began trading on the New York Stock Exchange in 1865, it used the WU Mark as its ticker symbol, and it has continuously used the WU Mark as its stock ticker symbol since 1865 except in such period of time during which Opposer had no publicly-

traded stock.

9. When Opposer was spun off from First Data Corporation in 2006 and thus once again became a public company, Opposer inaugurated the re-launch of its WU ticker symbol in a ceremony at the New York Stock Exchange on October 4, 2006. Opposer has continuously used the WU Mark as its stock ticker symbol since that date, and such symbol has become the name by which Opposer's investors, customers and the financial press know and refer to Opposer in the United States and worldwide.

10. Since Opposer became a public company in 2006, Opposer has routinely used the WU Mark on press releases it has issued.

11. Prior to the priority date of Applicant's application opposed herein, Opposer used its WU Mark in connection with the promotion and sale of a wide variety of goods and services, including services identical to Applicant's money transfer services. Opposer has expended considerable time, effort, and money in creating goodwill, public acceptance and recognition for its goods and services. By reason of this long, extensive, and exclusive use of its marks, Opposer enjoyed, and today enjoys, valuable goodwill in its famous WU Mark, which became famous years, if not decades, prior to the priority date of the WOONEO application and prior to Applicant's first use of its mark, if any there may be in the United States.

12. By virtue of its extensive advertising, promotion and sales through use of the WU Mark, Opposer's WU Mark has become well known to the public as an indication of source for a variety of financial goods and services including, for example, money orders and a variety of payment instruments and services such as money transfer, bill payment, prepaid payment, stored value card, gift card, direct deposit, and ATM services such that the WU Mark is likely to call to mind financial and payment-related services when encountered by consumers.

13. Throughout Opposer's extensive advertising and marketing of the WU goods and services to customers or potential customers, Opposer, as well as Opposer's employees and agents, pronounce the WU Mark phonetically as "WOO."

14. Based on Opposer's knowledge and belief, Opposer is the only entity in the United States that uses and has federally registered the mark "WU" for money transfer services.

15. Opposer has extensively and exclusively used its WU Mark in connection with its business, goods, and services for nearly one-hundred forty-five (145) years prior to the priority date of the application opposed herein, and in addition to its aforementioned federal registration, Opposer shall rely upon its common law rights in and to its WU Mark.

16. Through Opposer's extensive and exclusive use of the WU Mark, the WU Mark has acquired fame in the United States and worldwide as the source of Opposer's goods and services.

17. There is no issue of priority. Opposer has priority by virtue of its long-standing and extensive use of its WU Mark and by virtue of its ownership of the federal registration identified above in Paragraph 7.

18. The first syllable of Applicant's mark, namely, "WOO," is the only distinctive portion of Applicant's WOONEO mark because "NEO," a prefix meaning "new," merely describes (or misdescribes) Applicant's financial and payment-related services by indicating that they are allegedly novel. Thus, "WOO" is the dominant portion of Applicant's mark.

19. Although in a likelihood of confusion analysis, a mark should be considered as a whole, one portion of the mark may be accorded more weight than another. The term "NEO" in Applicant's mark is weak because it is merely descriptive (or misdescriptive) of the financial and monetary services identified in the application. As a result, the dominant term "WOO" should

be given more weight in the likelihood of confusion analysis.

20. Applicant's mark is highly similar to Opposer's WU Mark in appearance because both marks begin with the letter "W" and consist of a single word.

21. Applicant's mark is highly similar to Opposer's WU mark in sound because the first and dominant portion of the WOONEO mark is pronounced identically to the WU Mark.

22. Opposer's employees and agents pronounce the WU Mark as "WOO" in marketing and advertising WU goods and services to customers or potential customers. Opposer's employees and agents also pronounce the WU Marks similarly in such marketing and advertising, namely, e.g. as "WOOPOS" or "WOO&YOU" or "WOO GIFTCARD" or "WOO PREPAID." As a result of Opposer's marketing efforts (as well as, on information and belief, the natural tendency to pronounce WU as it reads phonetically, "WOO"), consumers are likely to pronounce Opposer's WU Mark as "WOO.

23. The identity of pronunciation between the initial and dominant portion of Applicant's WOONEO mark and Opposer's WU Mark merits significant weight in a likelihood of confusion analysis because customers often request money transfer services orally, either on the telephone or at a money transfer location.

24. Applicant's mark is similar to Opposer's WU Mark in meaning because the WU Mark and the dominant portion of the WOONEO mark will be perceived by consumers to have little inherent meaning in the context of their associated financial and payment-related goods and services and the merely descriptive (or misdescriptive) portion of Applicant's mark, "NEO," merely brings to mind allegedly novel services without adding any distinctive meaning.

25. As a result of its similarity to Opposer's WU Mark in appearance, pronunciation, and meaning, Applicant's WOONEO mark is highly similar in commercial impression to

Opposer's WU Mark.

26. On information and belief, Applicant has attempted to copy Opposer's brand strategy of creating WU-formative marks to identify various financial goods and services by creating a family of WOO-formative marks, such as the ones identified in Paragraph 3 above, for identical services as those for which Opposer has registered its WU Mark.

27. The similarity between Applicant's WOONEO mark and Opposer's WU Mark will give rise to an association between the marks in the minds of consumers that is likely to impair the distinctiveness of Opposer's famous WU Mark.

28. On information and belief, the services recited in the application at issue herein are identical to the services promoted and sold by Opposer through use of Opposer's WU Marks and WU Domains.

29. On information and belief, Applicant has consciously attempted to replicate Opposer's scope of WU registered services for Applicant's WOO-formative marks.

30. On information and belief, the services recited in the application at issue herein and Opposer's services promoted and sold through use of Opposer's WU Marks travel in the same channels of trade and are marketed to similar purchasers. On information and belief, Applicant offers its services through the Internet, over the phone, and in person at money transfer locations.

31. The WU Marks are inherently distinctive and merit a broad scope of protection. Upon information and belief, Opposer owns the only federal registration for WU for money transfer services and has vigorously enforced its broad rights.

32. Consumers recognize Opposer's distinctive WU Marks as uniquely identifying Opposer as the owner of the marks, even when encountering the marks apart from Opposer's

goods or services.

33. Due to the similarity in services, trade channels, and groups of potential customers targeted by both Applicant and Opposer, it is likely that Applicant's use of its WOONEO mark will come to the attention of potential purchasers of Opposer's WU services.

34. The similarity between Applicant's WOONEO mark and Opposer's WU Mark will harm Opposer's long-standing reputation as a provider of high-quality money transfer services.

35. Upon information and belief, Applicant's use and registration of the mark opposed herein is intended to create and imply an affiliation and/or association of Applicant and its services with Opposer, Opposer's services, and/or Opposer's WU Marks.

36. Concurrent use or registration of its mark by Applicant will result in irreparable damage to Opposer as consumers would be likely to consider the services offered under Applicant's WOONEO mark as emanating from Opposer, and purchase such services, resulting in a loss of sales to Opposer.

37. Concurrent registration of Applicant's WOONEO mark in association with the applied-for services would result in irreparable damage to Opposer as consumers would be likely to believe, mistakenly, that Applicant's WOONEO mark is affiliated with or endorsed by or approved by Opposer.

38. Furthermore, concurrent registration of Applicant's WOONEO mark would infringe on Opposer's long-time, exclusive rights in its WU Mark, its rights in the trade name and stock ticker symbol "WU," and its rights in its WU Marks and WU Domains for various financial services, including money transfer, because Applicant's WOONEO mark is likely to confuse or mislead consumers as to whether Applicant's WOONEO mark and the applied-for

services are affiliated with, are approved or endorsed by, or emanate from Opposer.

39. If Applicant is permitted to obtain a registration for the WOONEO mark opposed herein, and thereby the prima facie exclusive right to use in commerce the WOONEO mark on services identical to services provided by Opposer, confusion within the meaning of Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) is likely to result to the detriment of Opposer, and in violation of Opposer's common law and registered rights in its WU Mark.

40. Registration of Applicant's WOONEO mark is likely to cause dilution of the distinctive quality of Opposer's WU Mark and will blur the distinctiveness of Opposer's famous WU Mark.

41. Registration of the WOONEO mark by Applicant is likely to dilute and impair Opposer's rights and otherwise lessen the capability of Opposer's famous WU Mark to identify and distinguish Opposer's services. Such contemporaneous use and registration is likely to result in a lack of designation and indication of origin, and a loss of distinctiveness and exclusivity of Opposer's famous WU Mark in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c)).

42. Registration of Applicant's WOONEO mark is likely to dilute Opposer's WU Mark by tarnishment in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c)) as the similarity of the WOONEO mark to the WU Mark is likely to harm the reputation of Opposer's WU Mark by damaging the positive associations evoked by Opposer's WU Mark in the minds of purchasers, which have resulted from Opposer's offering of high quality services in association with its WU Mark.

**Prayer for Relief**

WHEREFORE, Opposer requests that Application Serial No. 79094410 be rejected, that

no registration be issued in connection with this application, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

WESTERN UNION HOLDINGS, INC.

Date: April 10, 2012

By: /Christina Galus/  
Elisabeth A. Langworthy  
Valerie S. Sanders  
Christina J. Galus  
SUTHERLAND ASBILL & BRENNAN LLP  
1275 Pennsylvania Avenue, NW  
Washington, DC 20004  
202.383.0100 (telephone)  
202.637.3593 (facsimile)  
[eteas@sutherland.com](mailto:eteas@sutherland.com) (email)

## **CERTIFICATE OF SERVICE**

I hereby certify on this 10<sup>th</sup> day of April 2012, a true and correct copy of the foregoing Notice of Opposition was served on the following via Federal Express:

WOOGROUP S.A.  
58 Avenue De Wagram F-75017  
Paris, France

Benjamin Ashurov, Esq.  
Raj Abhyanker P.C  
1580 W El Camino Real Suite 8  
Mountain View, CA 94040

*Correspondent of Record*

/Christina Galus/

# EXHIBIT A

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

**United States Patent and Trademark Office**

Reg. No. 3,284,554

Registered Aug. 28, 2007

**SERVICE MARK  
PRINCIPAL REGISTER**

**WU**

WESTERN UNION HOLDINGS, INC. (GEORGIA CORPORATION)  
12500 E BELFORD AVE #M12K3  
ENGLEWOOD, CO 80112

FOR: FINANCIAL SERVICES, NAMELY, BANKING SERVICES, MONEY TRANSFER SERVICES, ELECTRONIC FUNDS TRANSFER SERVICES, BILL PAYMENT SERVICES, MONEY ORDER SERVICES, CREDIT CARD SERVICES, PREPAID CARD SERVICES IN THE NATURE OF ADDING AIRTIME TO PREPAID OR PAY-AS-YOU-GO SERVICES THAT RELOAD CASH ON PRE-PAID/SECURED DEBIT CARDS, AND THAT RECHARGE MINUTES TO PRE-PAID LONG DISTANCE CALLING CARDS; GIFT CHECK SERVICES IN THE NATURE OF ISSUING PERSONALIZED GIFT CHECKS AKIN

TO MONEY ORDERS; AUTOMATIC TELLER MACHINE SERVICES, DEBIT AND STORED VALUE CARD SERVICES AND DIRECT DEPOSIT OF FUNDS INTO CUSTOMER BANK ACCOUNTS; AUTOMATED CLEARING HOUSE DEPOSIT SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 8-28-2006; IN COMMERCE 8-28-2006.

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

SER. NO. 77-034,296, FILED 11-1-2006.

PAUL F. GAST, EXAMINING ATTORNEY



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



**Assignments on the Web > Trademark Query**

**No assignment has been recorded at the USPTO**

**For Serial Number: 77034296**

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.2  
Web interface last modified: July 25, 2011 v.2.2

[HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-27 08:22:05 ET

Serial Number: 77034296 Assignment Information Trademark Document Retrieval

Registration Number: 3284554

Mark

WU

(words only): WU

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2007-08-28

Filing Date: 2006-11-01

Transformed into a National Application: No

Registration Date: 2007-08-28

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-08-28

---

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Western Union Holdings, Inc.

Address:

Western Union Holdings, Inc.

12500 E Belford Ave #M12K3  
Englewood, CO 80112  
United States  
**Legal Entity Type:** Corporation  
**State or Country of Incorporation:** Georgia

---

**GOODS AND/OR SERVICES**

---

**International Class:** 036

**Class Status:** Active

financial services, namely, banking services, money transfer services, electronic funds transfer services, bill payment services, money order services, credit card services, prepaid card services in the nature of adding airtime to prepaid or pay-as-you-go services that reload cash on pre-paid/secured debit cards, and that recharge minutes to pre-paid long distance calling cards; gift check services in the nature of issuing personalized gift checks akin to money orders; automatic teller machine services, debit and stored value card services and direct deposit of funds into customer bank accounts; automated clearing house deposit services

**Basis:** 1(a)

**First Use Date:** 2006-08-28

**First Use in Commerce Date:** 2006-08-28

---

**ADDITIONAL INFORMATION**

---

(NOT AVAILABLE)

---

**MADRID PROTOCOL INFORMATION**

---

(NOT AVAILABLE)

---

**PROSECUTION HISTORY**

---

**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2007-08-28 - Registered - Principal Register

2007-06-12 - Published for opposition

2007-05-23 - Notice of publication

2007-04-10 - Law Office Publication Review Completed

2007-04-10 - Assigned To LIE

2007-03-18 - Approved for Pub - Principal Register (Initial exam)

2007-03-18 - Examiner's Amendment Entered

2007-03-18 - EXAMINERS AMENDMENT E-MAILED  
2007-03-18 - Examiners Amendment -Written  
2007-03-15 - Priority Action E-Mailed  
2007-03-15 - Priority Action Written  
2007-03-12 - Assigned To Examiner  
2006-11-07 - Notice Of Pseudo Mark Mailed  
2006-11-06 - New Application Entered In Tram

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Elisabeth A. Langworthy, Esq.

**Correspondent**

ELISABETH A. LANGWORTHY, ESQ.  
SUTHERLAND ASBILL & BRENNAN LLP  
1275 PENNSYLVANIA AVE NW  
WASHINGTON, DC 20004-2404  
Phone Number: 202-383-0100  
Fax Number: 202-637-3593

---