

ESTTA Tracking number: **ESTTA741259**

Filing date: **04/20/2016**

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	Trans Union LLC
Granted to Date of previous extension	04/20/2016
Address	555 W. Adams St Chicago, IL 60661 UNITED STATES
Attorney information	F WILLIAM MCLAUGHLIN WOOD PHILLIPS 500 W MADISON SUITE 1130 CHICAGO, IL 60565 UNITED STATES docketing@woodphillips.com,fwmclaughlin@woodphillips.com Phone:312-876-1800

Applicant Information

Application No	86480424	Publication date	12/22/2015
Opposition Filing Date	04/20/2016	Opposition Period Ends	04/20/2016
Applicant	Telefónica Digital Espana, S.L.U. Calle Gran Vía-a 28 Madrid, SPAIN		


Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Advertising and marketing services offered to third parties via cell phone services; conducting market surveys; analysis of advertising response and market research
Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Telecommunications, namely, telephone communications and cellular telephone communications; transmission, delivery and reception of sound, data and images; transmission of data and of information by electronic means; provision of telecommunications connections to electronic communications networks, for transmission or reception of audio, video or multimedia content; network services, namely, electronic transmission of messages and data via computer terminals; delivery of messages by electronic transmission
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Design and development of hardware and software in the field of telecommunications

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4833826	Application Date	09/22/2014
Registration Date	10/13/2015	Foreign Priority Date	NONE
Word Mark	TU		
Design Mark			
Description of Mark	The mark consists of the letters "TU" surrounded by a partial circle.		
Goods/Services	<p>Class 035. First use: First Use: 2015/01/05 First Use In Commerce: 2015/01/05 business management and consulting; business and consumer information services in the field of management of information and data of others; providing marketing demographics and preparing mailing lists; providing business information in the field of computers; computerized management of business and marketing demographic information and data for others; research services, namely, providing business and market research, and market analysis services; commercial information and directory agencies; preparing business reports; demographic consultation; providing an on-line computer database on the subject of marketing demographics and mailing lists, which features information concerning computerized print and data selection, arrangement, presentation, and distribution of that information; providing an on-line interactive computer database in the fields of marketing demographics and mailing lists; and providing an on-line computer database in the field of marketing demographics and mailing lists, business consulting services, business marketing and management consulting services, computerized database management and direct mail marketing services; providing business and consumer information services in the fields of consumer credit, insurance, pre-employment screening, credit fraud detection and prevention; database management consulting services in the fields of consumer credit, insurance and lending, and insurance risk</p> <p>Class 036. First use: First Use: 2015/01/05 First Use In Commerce: 2015/01/05 providing credit and credit risk information via reports, printouts, printed labels, electronic lists, CD-ROMs, magnetic tape and computer disks, and via com-</p>		

	<p>puter-to-computer transmission of data and email; consulting and information services concerning consumer credit information; computerized management of financial and consumer credit information and data for others; financial and credit information provided by electronic means; credit inquiry and consultation; financial analysis and consultation; providing information in the fields of consumer credit reporting, real estate appraisal, real property data compiled from public records, credit fraud victim financial assistance, consumer credit, insurance, lending and insurance risk management via reports, printouts, printed labels, electronic lists, e-mail, CD-ROMs, magnetic tape and computer disks; consulting and information services concerning financial data and statistics for use by lenders, financial institutions and insurance companies; credit and financial information reporting services provided by computer and on-line means; lending and insurance risk management; computer services, namely, providing a computer database featuring computerized print and data selection, arrangement, presentation and distribution in the fields of commercial and consumer credit reporting, real estate appraisal, real property data compiled from public records, consumer credit, insurance and lending, and insurance risk management; providing an interactive computer database in the field of commercial and consumer credit reporting, real estate appraisal, real property data compiled from public records, consumer and commercial credit, insurance and lending, and insurance risk management; consulting services in the fields of lending and financial information management, financial information processing, credit and lending risks, consumer credit, insurance and lending, and insurance risk management; real estate and mortgage services, namely, providing mortgage loan processing assistance</p> <p>Class 042. First use: First Use: 2015/01/05 First Use In Commerce: 2015/01/05 consulting in the field of computers; computer services, namely, providing temporary use of related non-downloadable software tools for use in designing and customizing the selection, arrangement, presentation, printing and distribution of data, in the fields of consumer credit reporting, real estate appraisal, real property, consumer credit, insurance, lending, and insurance risk management; computer consulting services in the field of lending and insurance risk management; providing information in the field of information technology; computer consulting and information technology consulting, including using information technology to establish and maintain online commerce; real estate services, namely, home inspection services</p> <p>Class 045. First use: First Use: 2015/01/05 First Use In Commerce: 2015/01/05 providing credit fraud detection and prevention information and pre-employment screening information, via reports, printouts, printed labels, electronic lists, email, CD-ROMs, magnetic tape and computer disks, and via computer-to-computer transmission of data and email; providing interactive online computer databases in the fields of credit fraud detection and prevention and pre-employment screening; regulatory compliance consulting in the field of flood insurance; property title searching</p>
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U.S. Application No.	86401670	Application Date	09/22/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TU		

Design Mark	
Description of Mark	The mark consists of the letters "TU" surrounded by a partial circle.
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 computer software for use in business applications, namely, for use in information management, information processing, information and database management, for compiling marketing demographics, for making mailing lists, for verifying consumer credit, for insurance risk management, for lending and insurance risk management, and for database management and the management of the data and information of others, and printed material, namely, documentation and instruction manuals, all sold as a unit therewith; computer software to perform computerized print and data selection, arrangement and presentation, in the fields of consumer credit reporting and real estate appraisals, and for use in connection with real property data compiled from public records, marketing demographics, and mailing lists

Attachments	86977225#TMSN.png(bytes) 86401670#TMSN.png(bytes) 86480424_Notice.pdf(108732 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	/F. William McLaughlin/
Name	F WILLIAM MCLAUGHLIN
Date	04/20/2016

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

Trans Union LLC

Serial No. 86/480,424

Opposer,

v.

Telefónica Digital Espana, S.L.U.

Mark: TU GO and Design

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

Trans Union LLC ("Opposer") opposes the referenced application of Telefónica Digital Espana, S.L.U. ("Applicant") for the trademark TU GO and Design ("Applicant's Mark").

Opposer believes that it will be damaged by registration of the mark shown in Application No. 86/480,424 and hereby opposes the same.

The grounds of opposition are as follows:

1. Opposer is a Delaware Limited Liability Company having an address at 555 West Adams Street, Chicago, Illinois 60661.
2. On information and belief, Applicant is a company of Spain with an address Calle Gran Via 28 Madrid Spain.
3. Opposer is the owner of U.S. Registration No. 4,833,826 for the mark TU and Design ("Opposer's Mark") covering services in Classes 35, 36, 42, and 45, as identified in said registration.

4. Opposer is the owner of U.S. Application No. 86/401,670 for the mark TU and Design for goods in International Class 9.

5. Both of Opposer's registration and application identified in Paragraphs 3 and 4, above, are based on an application filed September 22, 2014.

6. On information and belief, Applicant filed Application No. 86/480,424 on or about December 15, 2014, based on an intent to use the mark in Classes 35, 38, and 42. Applicant's filing date is subsequent to Opposer's filing date.

7. Applicant has opposed Opposer's TU and Design mark in other jurisdictions based on alleged likelihood of confusion between the marks. As such, Applicant has stated that there is a likelihood of confusion between Applicant's Mark sought to be registered herein and Opposer's Mark.

8. As admitted by Applicant, Applicant's TU GO mark so resembles Opposer's TU and Design mark as to be likely, when applied to the services recited in Applicant's application, to cause confusion or mistake or to deceive purchasers, resulting in injury to Opposer.

For the reasons set forth above, Opposer believes that it will be damaged if a registration for the TU GO and Design mark of Application No. 86/480,424 is granted to Applicant.

WHEREFORE, Opposer requests that Application No. 86/480,424 be rejected and the Opposition sustained.

Respectfully submitted,

TRANS UNION LLC, Opposer

By:



F. William McLaughlin
Its Attorney

Date: April 20, 2016

WOOD, PHILLIPS, KATZ,
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CERTIFICATE OF SERVICE

I hereby certify that on April 20, 2016, a copy of the foregoing was sent by
U.S. Mail to the following correspondent of record:

Mark Tidman
Baker & Hostetler
1050 Connecticut Avenue NW, Suite 1100
Washington, D.C. 20036

/F. William McLaughlin/