

ESTTA Tracking number: **ESTTA324973**

Filing date: **01/04/2010**

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	LaCie S.A.
Granted to Date of previous extension	01/03/2010
Address	33 boulevard du General Martial Valin Paris, 75015 FRANCE

Attorney information	Jan Tamulewicz Katten Muchin Rosenman LLP 575 Madison Avenue New York, NY 10022-2585 UNITED STATES jan.tamulewicz@kattenlaw.com, michael.sarney@kattenlaw.com Phone:212-940-8673
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Applicant Information

Application No	77568369	Publication date	07/07/2009
Opposition Filing Date	01/04/2010	Opposition Period Ends	01/03/2010
Applicant	USE LABS LLC Agricultura 16-18, 2-9 EI Masnou, 08320 SPAIN		

Goods/Services Affected by Opposition

Class 042. First Use: 2008/08/25 First Use In Commerce: 2008/09/10 All goods and services in the class are opposed, namely: Providing on-line non-downloadable software for creating, editing, designing, developing, delivering, displaying and viewing video, audio, music, animation, images and graphics applications over the internet or other computer networks

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.	3540524	Application Date	08/17/2007
Registration Date	12/02/2008	Foreign Priority Date	03/29/2007

Word Mark	CALEIDO WUALA
Design Mark	CALEIDO WUALA
Description of Mark	NONE
Goods/Services	<p>Class 035. First use: Rental and management of advertising space in Internet publications; dissemination of advertising matter for third parties over the Internet; dissemination of commercial spots and personalized commercial announcements; operation of data banks, namely, collecting, organizing and systemizing data in computer databases; organization and management of data in distributed computer databases; electronic storage of data and documents; consultant on all the above-mentioned services</p> <p>Class 042. First use: Design and development of computer hardware and software; software design, maintenance, development and updating; information encryption and decryption and data; software programming for data protection for electronic data transmission via global computer networks, including on the Internet; consultant services in computers; consultant services in software; computer services, namely, the creation and provision of information indexes; provision and maintenance of data storage in a distributed system of computer storage of data; consultant on all the aforesaid; computer services, namely, allocation and administration of passwords</p>

Attachments	79047521#TMSN.jpeg (1 page)(bytes) wuaalaopposition.pdf (6 pages)(210168 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	/Jan Tamulewicz/
Name	Jan Tamulewicz
Date	01/04/2010

IN THE U.S. PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re: Application Serial No. 77568369

for the mark: WUUALA and Design

Applicant: USE LABS LLC

Published in the Official Gazette: July 7, 2009

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LACIE S.A.,	: Opposition No.
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Opposer,	:
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v.	:
	:
USE LABS LLC	:
	:
Applicant.	:
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NOTICE OF OPPOSITION

Attn: Box TTAB Fee
Commissioner for Trademarks
Trademark Trial and Appeal Board

2900 Crystal Drive
Arlington, Virginia 22202-3513

To the Commissioner for Trademarks:

In the matter of U.S. Trademark Application Serial No. 77542389 for the mark WUUALA and Design as applied to providing on-line non-downloadable software for creating, editing, designing, developing, delivering, displaying and viewing video, audio, music, animation, images and graphics applications over the internet or other computer networks in International Class 42, filed by USE LABS LLC (“Applicant”) and published for opposition in the July 7, 2009 issue of the United States Patent and Trademark Office Official Gazette, LACIE

S.A. believes that it will be damaged by the registration of this mark and hereby opposes the same.

Grounds for Opposition

As grounds for the opposition of this trademark, Opposer, by and through its attorneys, alleges as follows:

1. LACIE S.A. is a joint stock company organized and existing under the laws of France, having an office and place of business at 33 boulevard du Général Martial Valin F-75015, Paris, France (“Opposer”).

2. Opposer and its predecessor in interest, have, since at least as early as September 2007, continuously used WUALA and variations thereof in commerce as trademarks for design and development of computer hardware and software; software design, maintenance, development and updating; information encryption and decryption and data; software programming for data protection for electronic data transmission via global computer networks, including on the Internet; consultant services in computers; consultant services in software; computer services, namely, the creation and provision of information indexes; provision and maintenance of data storage in a distributed system of computer storage of data; consultant on all the aforesaid; computer services, namely, allocation and administration of passwords (Opposer’s Marks”). Opposer advertises and promotes its WUALA services extensively through many forms of media, including, but not limited to, advertisements in nationally and internationally circulated publications, in printed and electronic catalogs, at trade shows throughout the world, and on the internet at its www.wuala.com web site.

3. Opposer has expended considerable resources towards establishing and protecting its valuable WUALA Marks, and owns U.S. Trademark Registration No. 3540524 for its

CALEIDO WUALA Mark, registered December 2, 2008 and covering rental and management of advertising space in Internet publications; dissemination of advertising matter for third parties over the Internet; dissemination of commercial spots and personalized commercial announcements; operation of data banks, namely, collecting, organizing and systemizing data in computer databases; organization and management of data in distributed computer databases; electronic storage of data and documents; consultant on all the above-mentioned services in International Class 35 and design and development of computer hardware and software; software design, maintenance, development and updating; information encryption and decryption and data; software programming for data protection for electronic data transmission via global computer networks, including on the Internet; consultant services in computers; consultant services in software; computer services, namely, the creation and provision of information indexes; provision and maintenance of data storage in a distributed system of computer storage of data; consultant on all the aforesaid; computer services, namely, allocation and administration of passwords in International Class 42

4. Since its initial use of the WUALA Marks, Opposer has continuously used, advertised, promoted and offered Opposer's services under its WUALA Marks to the public, with the result that members of the relevant consuming public have come to know and recognize Opposer's Marks and associate them with Opposer and the services offered by Opposer. Opposer has established goodwill in connection with the advertising, marketing, promotion, rendering, distribution and sale of services under its WUALA Marks.

5. On September 8, 2008, long after Opposer began using its WUALA Marks, Applicant filed an intent-to-use trademark application seeking registration of the mark WUAALA and Design for providing on-line non-downloadable software for creating, editing,

designing, developing, delivering, displaying and viewing video, audio, music, animation, images and graphics applications over the internet or other computer networks.

6. Use and ownership by Applicant of the WUAALA and Design for providing on-line non-downloadable software for creating, editing, designing, developing, delivering, displaying and viewing video, audio, music, animation, images and graphics applications over the internet or other computer networks will be likely to cause confusion, mistake or deception in the minds of the purchasing public resulting in damage and detriment to Opposer and its reputation, in violation of Section 43 of the Trademark Act, 15 U.S.C. § 1125.

7. Upon information and belief, Opposer and Applicant are both engaged in the sale and promotion of their respective services through the same and/or overlapping channels of trade and to the same and/or highly related general classes of consumers.

8. Members of the relevant consuming public are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's services under Applicant's alleged WUAALA and Design mark and misled into believing that such services are rendered by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

9. Opposer will be irreparably harmed and damaged by the confusion which will result to the public if Applicant is permitted to register the WUAALA and Design for use in conjunction with providing on-line non-downloadable software for creating, editing, designing, developing, delivering, displaying and viewing video, audio, music, animation, images and graphics applications over the internet or other computer networks; and any inaccuracies, inconsistencies, misleading or prejudicial information, defamation, opinions or other flaws or

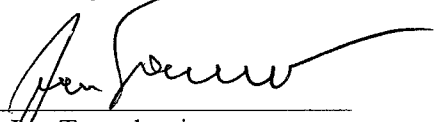
deficits in quality which might be found in Applicant's services would reflect adversely upon and injure the valuable reputation and goodwill of Opposer.

10. Further, if Applicant is granted the registration which is the subject of this Opposition, such registration would be prima facie evidence of Applicant's allegedly exclusive rights to use the mark WUALA and Design for these services, pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), which would further damage Opposer by giving color of exclusive statutory rights to Applicant in violation and derogation of the preexisting and superior rights of Opposer in its WUALA Marks.

WHEREFORE, Opposer respectfully requests that the mark shown in the U.S. Trademark Application Serial No. 77568369 be refused registration and that this Opposition be sustained.

Dated: January 4, 2010

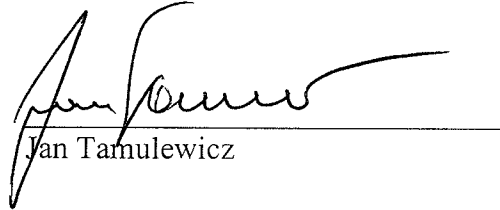
Respectfully submitted:

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CERTIFICATION OF SERVICE

I hereby certify that on this 4th day of January, 2010, I cause a true and correct copy of the foregoing Notice of Opposition to be served by United States first class mail, postage prepaid upon the following attorney of record:

Lawrence E. Abelman, Esq.
Abelman Frayne & Schwab
666 3rd Ave.
New York, New York 10017-4046



Jan Tamulewicz