ESTTA Tracking number: **ESTTA298485**
Filing date: **07/31/2009**

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

Proceeding	91190746
Party	Defendant City Image LLC
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Date	07/31/2009
Attachments	City Image LLC Answer to Notice of Opposition vJuly 31, 2009 (00064082).PDF (7 pages)(474584 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeal Board

In the matter of Application Serial. No. 77-610,916

TM: CITY IMAGE

CITI TRENDS, INC.,
Opposer,

v. Opposition No. 91190746

CITY IMAGE LLC,
Applicant

ANSWER TO NOTICE OF OPPOSITION

Comes now the applicant, City Image LLC ("Applicant"), and submits its Answer to the Notice of Opposition filed by Citi Trends, Inc. ("Opposer") against Applicant's application for registration of the mark CITY IMAGE, Serial No. 77-610,916, filed November 10, 2008, and published in the Official Gazette on June 2, 2009, by numbered paragraphs as follows:

1. Applicant denies the allegations set forth in Paragraph 1 of Opposer's Notice of Opposition and avers that Applicant was the first to use the mark CITY IMAGE anywhere, and in commerce which Congress may regulate, in connection with retail store services featuring clothing, hats and footwear.

2. The allegations of Paragraph 2 of Opposer's Notice of Opposition are admitted.

3. The allegations of Paragraph 3 of Opposer's Notice of Opposition are admitted.

4. The allegations of Paragraph 4 of Opposer's Notice of Opposition are denied, and the Applicant further avers that the word CITI is different and readily distinguishable from the word CITY, as to meaning and appearance, and in some instances also as to sound. Applicant further avers that it is preposterous that any registrant, let alone Opposer, can claim the entire field of urban fashion or streetwear, merely by using a word with a sound potentially similar to the sound for the word "city" in any such mark.

5. The allegations of Paragraph 5 of Opposer's Notice of Opposition are denied, and Applicant further avers that Opposer's referenced Registrations at Paragraph 3 of Opposer's Notice of Opposition (hereinafter referred to as "Opposer's Registrations") demonstrate that multiple various references for various goods or services that incorporate the word CITI do not give rise to colorable rights to the word CITY, carte blanche. Further, Applicant avers that none of Opposer's Registrations in any way features the word IMAGE or any similar-sounding word, so as to cause confusion with Applicant's mark CITY IMAGE. Moreover, the Applicant's mark is distinct for its use of the word IMAGE following the word CITY, together with the graphic logo as used in Applicant's mark.

Applicant denies that Opposer is entitled to any of the relief sought in the Notice of Opposition or to any relief whatsoever. Each and every allegation contained in the Notice of Opposition which has not heretofore been specifically admitted or denied is generally denied.

AFFIRMATIVE DEFENSES

1. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

2. Opposer is barred from asserting the claims as set forth in the Notice of Opposition by the doctrines of waiver and/or estoppel. Namely, the marks CITY BIG with Registration Number 3561781, Serial Number 77143086 and CITY SPORTS with Registration Number 3305412, Serial Number 77031413, among other marks of third parties designating retail apparel sales in goods or services and prominently featuring the word "city" have been registered during the course of Opposer's process of registering Opposer's Registrations, without causing confusion.

3. The Opposer's Registrations all use the acronym or fanciful term CITI, which is not commonly used in the English language except in extremely limited circumstances, such as its being a component of the famous mark for financial services, CITIGROUP. In contrast, Applicant's mark CITY IMAGE features the word "city", an actual word in common usage whose primary definition in the English language by Merriam-Webster is, "an inhabited place of greater size, population, or importance than a town or village."

4. Applicant did not intend for Applicant's mark to cause confusion with Opposer's mark, and at best only idiosyncratic and isolated incidents of actual confusion would ever exist.

5. The respective products of Opposer and Applicant are priced substantially differently and are marketed through different channels. The Applicant uses the mark CITY IMAGE as it markets and sells goods that are new to the apparel market, whereas

the Opposer uses CITI TRENDS and its other marks that feature the term CITI as it markets and sells goods that have been substantially discounted due to lack of prior sale and have been previously sitting unsold in the market for potentially considerable duration. Applicant's primary channel of trade is in retail services for apparel that constitute cutting-edge urban fashions from major manufacturers and brands. Opposer's channels of trade are similar to those of other large discount chains, receiving apparel inventory already past its prime and only then made available for sale to retail consumers by Opposer. While Applicant is a seller of first resort, Opposer is a seller of last resort.

6. Under the sound, sight, and meaning trilogy, the sight and sound of the two marks is not similar. The syllabic sounds of CITY in modern English usage are consistently and solely "si" followed by "tee". The acronym or fanciful term CITI has no standard pronunciation in the English language. CITI could be pronounced "chi-tai", "ki-tai", "chi-tee", "ki-tee", "si-tee", or "see-eye-tee-eye", among other potential and foreseeable pronunciations and mispronunciations. Even to the extent the syllabic sounds of CITI and CITY are similar, the sounds of these names do not exist in a vacuum, because the overall design of the Applicant's mark with graphic and logo is quite dissimilar from any of Opposer's Registrations.

7. In the alternative, Opposer is barred from asserting the claims as set forth in the Notice of Opposition by the doctrine of unclean hands. The word CITY (in singular "city" and plural "cities", and other terms with similar sounds to the word "city", have previously been claimed by third-party registrants for the sale of apparel in goods or services. To use Opposer's own assertion that CITY is similar to CITI, then Opposer has likely infringed others' rights in using CITI as a component of Opposer's marks.

8. In the alternative, Opposer lacks standing to bring this opposition because the Opposer is not the owner of the Opposer's asserted trademark(s), specifically to the extent of the use of a term CITI where such term may sound like the word CITY and appear in Opposer's Registrations. The word "city" is generic and merely descriptive in referencing things that relate to or arise in the urban environment. The intended meaning of word "city" as a component of Applicant's mark CITY IMAGE, as well as in a host of third party marks that feature the word CITY or similar-sounding terms, is the same as the primary meaning of the word "city" in the English language. Opposer should not be permitted to prevail in any claim to the English language word for "city" in selling city-related goods or services, because the word "city" is generic or merely descriptive of such services or goods.

WHEREFORE, having fully answered, Applicant denies that Opposer could or would be damaged by the allowance of the present application for trademark registration and prays that the Notice of Opposition be dismissed and a certificate of registration granted to Applicant in due course.

Respectfully submitted,

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By: _____

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the preceding Answer to Notice of Opposition is being electronically filed with the United States Patent Office through its ESTTA electronic filing system on this 31st day of July, 2009.

_____
Peter J. Kraybill

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition has been served on Opposer's attorney by mailing a copy thereof via First Class Mail, postage prepaid, on this 31st day of July, 2009 addressed as follows:

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