

ESTTA Tracking number: **ESTTA203223**

Filing date: **04/07/2008**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Arcadia Group Brands Limited		
Entity	Company	Citizenship	England
Address	Colegrave House, 70 Berners Street London, W1T 3NL UNITED KINGDOM		

Attorney information	Floyd Mandell Katten Muchin Rosenman LLP 525 West Monroe Street Chicago, IL 60661 UNITED STATES floyd.mandell@kattenlaw.com, william.dorsey@kattenlaw.com, cathay.smith@kattenlaw.com, deborah.wing@kattenlaw.com Phone:312-902-5200
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Registration Subject to Cancellation

Registration No	3389652	Registration date	02/26/2008
Registrant	Studio Moderna SA Via Pretorio 22 Lugano, 6900 SWITZERLAND		

Goods/Services Subject to Cancellation

Class 035. First Use: 2007/09/07 First Use In Commerce: 2007/09/07 All goods and services in the class are cancelled, namely: on-line retail services in the field of general consumer merchandise

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Improper Filing of Statement of Use; Breach of Parties' Coexistence Agreement

Related Proceedings	Opposition No. 91169226
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3237860	Application Date	12/02/2002
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Registration Date	05/01/2007	Foreign Priority Date	NONE
Word Mark	TOPSHOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1964/12/31 First Use In Commerce: 1998/12/31 Women's clothing, namely skirts, dresses, pants, tops and jacket		

U.S. Application No.	78631860	Application Date	05/17/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TOP SHOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: Retail store services and online retail store services featuring clothing, footwear, hair accessories, bags, millinery, jewelry, imitation jewelry, watches, eyewear and sporting clothing		

Attachments	78631860#TMSN.jpeg (1 page)(bytes) PETITIONTOCANCELTOPSHOPIV.PDF (17 pages)(1031589 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	/fam/
Name	Floyd Mandell
Date	04/07/2008

Petitioner's TOPSHOP names and marks and associate the TOPSHOP brand exclusively with Petitioner, including its subsidiaries and affiliates, in connection with fashion clothing, accessories, and related products.

3. Petitioner has expended considerable resources towards establishing and protecting its valuable TOPSHOP names and marks worldwide and owns international trademark registrations for them in, among others, the following countries (collectively, the "TOPSHOP Family of Marks"): Algeria, Australia, Bahrain, Benelux, China, Croatia, Cyprus, Czech Republic, Denmark, Estonia, European Union, Finland, France, Germany, Gibraltar, Greece, Guernsey, Hong Kong, Hungary, Iceland, Indonesia, Ireland, Israel, Italy, Japan, Jordan, Lebanon, Malta, Morocco, New Zealand, Peru, Philippines, Poland, Portugal, Russia, Singapore, Slovenia, South Africa, South Korea, Spain, Switzerland, Taiwan, Turkey, United Arab Emirates, United Kingdom, United States and Yemen.

4. Petitioner is the owner of U.S. Registration No. 3,237,860 for the mark TOPSHOP, issued May 1, 2007, covering "women's clothing, namely skirts dresses, pants, tops and jacket" and reciting a date of first use of at least as early as December 31, 1964.

5. All of the foregoing TOPSHOP names and marks are valid and subsisting and in full force and effect, and all cover the TOPSHOP Family of Marks in connection with clothing, accessories, retail store services and related goods and services.

6. Petitioner is the owner of U.S. Application Serial No. 78/631,860 for the mark TOP SHOP covering "retail store services and online retail store services featuring clothing, footwear, hair accessories, bags, millinery, jewelry, imitation jewelry, watches, eyewear and sporting clothing" ("Petitioner's Application"), which application is based on the priority established by United Kingdom Trademark Registration No. 2,017,957, issued April 19, 1995. Despite Petitioner's earlier use of the TOPSHOP mark in the United States, the Registration has, to date, prevented Petitioner's registration of its mark in the United States Patent and Trademark Office ("USPTO") since, on September 11, 2006, the USPTO suspended Petitioner's Application based, in part, on the disposition of the application underlying the Registration ("Registrant's Application").

7. Petitioner and Registrant are also involved in an opposition proceeding concerning a related mark, Opposition No. 91169226. In Opposition No. 91169226, Petitioner herein, as Opposer, opposes registration of the mark TOP SHOP TV and Design in International Class 35 (Serial No. 78/239,078). Opposition No. 91169,226 involves the same or similar questions of law and/or fact as in the instant Petition to Cancel.

II. Petitioner's use of the mark TOPSHOP in the United States pre-dates Registrant's use of the TOP SHOP TV mark by several years.

8. Since at least as early as 1964, Petitioner has operated its TOPSHOP business, and used its TOPSHOP trade name, service mark and trademark, in connection with promoting, advertising and selling a broad range of apparel and accessories and its retail store services and online store services featuring apparel and accessories. Petitioner has used its TOPSHOP names and marks in connection with retail store services and the sale of apparel and accessories since at

least 1964 in the United Kingdom and in connection with online sales of apparel and accessories since at least 1998 in the United States.

9. Petitioner has offered online retail services (the identical services to those recited in the Registration) in the United States since at least 1998 via its websites www.topshop.co.uk and www.topshop.com. Petitioner has sold its TOPSHOP branded merchandise through retail outlets in the United States since September 2005. A printout from the home page of Petitioner's www.topshop.com website is attached hereto. See <http://www.topshop.com/webapp/wcs/stores/servlet/TopCategoriesDisplay?storeId=12556&catalogId=19551> (last visited April 7, 2008) (attached hereto as Exhibit A).^{2/}

10. According to the Statement of Use submitted in connection with the Registration, Registrant did not commence use of the TOP SHOP TV mark in connection with the services identified in the Registration (namely, "online retail services in the field of general consumer merchandise") until September 7, 2007, nearly ten years after Petitioner began offering online retail services under its TOPSHOP name and mark and well after Petitioner's name became well-known among United States consumers.

11. Petitioner will be damaged and is likely to suffer damage and/or injury if Registrant continues to own the Registration because, among other things, the Registration is an impediment to Petitioner's right to own a registration in the USPTO for its TOPSHOP name and mark in connection with its online and other retail services, notwithstanding Petitioner's prior use.

III. The Registration constitutes a breach of the parties' coexistence agreement.

12. Registrant and Petitioner previously entered into a coexistence agreement to memorialize certain limitations on each of Registrant's and Petitioner's use of the TOPSHOP name and mark to avoid a likelihood of confusion. Specifically, Registrant and Petitioner are parties to an agreement dated April 29, 2004 (a copy of which is attached hereto as Exhibit B) pursuant to which, among other things, Registrant agreed not to use the mark TOP SHOP in connection with articles of clothing, footwear and headgear (the "Agreement"). The relevant provision of the Agreement provides, as follows: "Studio Moderna undertakes not to use the TOP SHOP mark for designation of goods from Class 25 of Nice classification (articles of clothing, footwear and headgear) in any country."

13. Despite their obligations under the Agreement, on April 17, 2003, long after the adoption and use by Petitioner of the TOPSHOP Family of Marks and after the TOPSHOP Family of Marks became well known in the United States, Registrant filed Registrant's Application covering "on-line retail services in the field of *general consumer merchandise*" in International Class 35 (emphasis added).

^{2/} Petitioner's plan for the opening of its flagship TOPSHOP store in the United States has been well-publicized for at least two years in publications such as the *Wall Street Journal*, the *New York Times*, the *LA Times*, *Women's Wear Daily*, and *Vogue*. The store's opening in New York City is scheduled for Fall 2008.

14. The phrase “general consumer merchandise” as set forth in the Class 35 recitation of services in the Registration may be construed to include and cover articles of clothing, footwear and headgear and therefore violates the terms set forth the Agreement. Registrant’s services must expressly exclude articles of clothing, footwear and headgear to satisfy Registrant’s obligations under the Agreement since Registrant’s offering of such products of the type offered by Petitioner for retail services, and in the same channels of trade and in a manner similar to the manner in which Petitioner offers its goods, is likely to confuse consumers as to the origin of such products.

15. Petitioner will be damaged and is likely to suffer damage and/or injury if Registrant continues to own the Registration because, among other things, Registrant’s use and/or registration of the TOP SHOP TV mark in connection with goods that could be deemed to include clothing, footwear and headgear is a breach of Registrant’s obligations under the Agreement, and, if there is a likelihood of confusion, damage to Petitioner will result.

16. Additionally, notwithstanding the parties’ coexistence agreement and Petitioner’s use and the fame of its TOPSHOP Family of Marks, on March 13, 2008, Registrant also filed applications for the marks TOP SHOP in International Classes 35, 38, and 41 (Serial No. 77/405,680), and TOP SHOP TV in International Classes 35, 38, and 41 (Serial No. 77/405,689) (copies of which are attached hereto as Exhibit C). Such new applications demonstrate further progressive encroachment on Petitioner’s rights, as well as bad faith intent to appropriate Petitioner’s goodwill.

IV. Improper Filing of Statement of Use

17. Upon information and belief, Registrant was not using the TOP SHOP TV mark in commerce, as required by statute, as of the filing of the Statement of Use in Registrant’s Application.

18. Upon information and belief, Registrant was not consistently or continuously offering the services identified in the Registration as of the filing of the Statement of Use in Registrant’s Application.

19. Upon information and belief, the specimen of use filed in Registrant’s Application did not conform to statutory requirements and, further, did not evidence good faith, continuous, and continuing use of the TOP SHOP TV mark. Upon information and belief, such specimens of use were contrived and put in place solely for the purpose of avoiding abandonment of Registrant’s Application.

WHEREFORE, Petitioner believes that it is likely to be damaged by the continued registration of Registration No. 3,389,652, and Petitioner respectfully requests that the mark shown in U.S. Trademark Registration No. 3,389,652 be cancelled and that this Petition to Cancel be sustained.

Respectfully submitted,

By: /FAM/_____

Floyd A. Mandell

William J. Dorsey

Cathay Y. N. Smith

KATTEN MUCHIN ROSENMAN LLP

Attorneys for Petitioner

525 West Monroe Street

Chicago, Illinois 60661

(312) 902-5200

Dated: April 7, 2008

Exhibit A

TOPSHOP



features

STYLE BLOG

CHAIN REACTION

2 WAYS TO WEAR...

RSS

6:00am - 4th Apr 2008
RAY BANS AT TOPSHOP

The occasional flashes of sunshine have made us start seriously thinking about splashing out on a **new pair of sunnies**, so lucky for us that TOPSHOP.COM are now stocking the **American Classic - Ray Bans!**

From the style-sets favourite **wayfarers** (we LOVE the red), to the timeless **aviator** and the **Jackie O...**let's face it they all look good, just don't wear them on the bus!

SHOP RAY BANS

THE SHORT STORY

6:55am - 3rd Apr 2008
SAY 'YES YES' TO OPERATOR PLEASE!

WIN OPERATOR PLEASE

Exhibit B

AGREEMENT

Concerning the use of trademark TOP SHOP (including word mark or any kind of a device mark including the words TOP SHOP, hereinafter »the mark TOP SHOP«) made on 29th of April 2004, between:

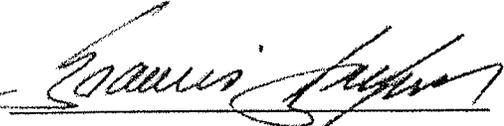
Studio Moderna, Finančne in intelektualne storitve, ter trgovina d.o.o., Cesta 9. avgusta 4, Zagorje, SI (hereinafter Studio Moderna) and

Arcadia Group Brands Limited, Colegrave House, 70 Berners Street, London W1P 3AE, GB also on behalf of their subsidiaries, (hereinafter Arcadia Group).

Whereas:

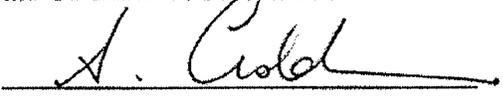
1. Studio Moderna undertakes not to use the mark TOP SHOP for designation of goods from class 25 of Nice classification (articles of clothing, footwear and headgear) in any country.
2. Arcadia Group undertakes not to use the mark TOP SHOP for designation of goods from class 10 of Nice classification (surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials) in any country, except the United Kingdom and Republic of Ireland.
3. Arcadia Group undertakes not to oppose registration of International trademark registration No. 742982 in Greece and in Estonia, and not to file appeal against the Turkish Trade mark registry's decision pertaining International trademark registration No. 742982 in Turkey.
4. Both parties agree, in case of any future conflict regarding the use or registration of »the mark TOP SHOP« in any country, to inform each other about the situation in order to try settling the conflict in an amicable way, before commencing any administrative and legal procedures in that regard.

On behalf of
Studio Moderna d.o.o.
Zagorje, SI

Signed by: 

Place and Date: Bled, 30/04/04

On behalf of
Arcadia Group Brands Limited,
London, GB
also on behalf of their subsidiaries

Signed by: 

Place and Date: LONDON 16/6/04

Exhibit C

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

This page was generated by the TARR system on 2008-04-07 16:54:39 ET

Serial Number: 77405680 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

TOP SHOP

(words only): TOP SHOP

Standard Character claim: Yes

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2008-03-06

Filing Date: 2008-02-25

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

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: 042 -New Application Processing

Date In Location: 2008-03-06

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

1. Studio Moderna SA

Address:

Studio Moderna SA
Via Pretorio 22
6900 Lugano
Switzerland

Legal Entity Type: Corporation**State or Country of Incorporation:** Switzerland

GOODS AND/OR SERVICES

International Class: 035**Class Status:** Active

Retail stores; kiosks in retail stores of others; providing home shopping services in the field of general consumer merchandise by means of television; order taking, processing and fulfillment services; advertising, marketing and promotional services, namely preparing and placing advertisements for others in print, radio, television, and catalogs and via a global communications network; direct response retail services by means of infomercials in the field of general consumer merchandise; production and distribution of infomercials; promoting the sale of goods and services of others by operating an on-line retail website providing products for purchase, and links to the sites of others; import, export and distributorship services featuring general consumer merchandise; mail order catalog services featuring general consumer merchandise; arranging and conducting sales and marketing conferences; mail order services, mail order catalog services, on-line retail services and electronic catalog services in the field of general consumer merchandise

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 038**Class Status:** Active

Broadcasting services

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 041**Class Status:** Active

Production and distribution of radio and television programs via television, radio, satellite, telephone, wireless and cellular phone, digital phone, and a global communications network

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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.

2008-02-29 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mitchell P. Brook

Correspondent

MITCHELL P. BROOK

LUCE, FORWARD, HAMILTON & SCRIPPS

11988 EL CAMINO REAL STE 200

SAN DIEGO, CA 92130-3334

Phone Number: 858 720 6300

Fax Number: 858 720 6306

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

This page was generated by the TARR system on 2008-04-07 16:55:23 ET

Serial Number: 77405689 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

TOP SHOP TV

(words only): TOP SHOP TV

Standard Character claim: Yes

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2008-03-06

Filing Date: 2008-02-25

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

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: 042 -New Application Processing

Date In Location: 2008-03-06

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

1. Studio Moderna SA

Address:

Studio Moderna SA
Via Pretorio 22
6900 Lugano
Switzerland

Legal Entity Type: Corporation**State or Country of Incorporation:** Switzerland

GOODS AND/OR SERVICES

International Class: 035**Class Status:** Active

Retail stores; kiosks in retail stores of others; providing home shopping services in the field of general consumer merchandise by means of television; order taking, processing and fulfillment services; advertising, marketing and promotional services, namely preparing and placing advertisements for others in print, radio, television, and catalogs; direct response retail services by means of infomercials in the field of general consumer merchandise; production and distribution of infomercials; import, export and distributorship services featuring general consumer merchandise; mail order catalog services featuring general consumer merchandise; arranging and conducting sales and marketing conferences; mail order services, mail order catalog services

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 038**Class Status:** Active

Broadcasting services

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 041**Class Status:** Active

Production and distribution of radio and television programs via television, radio, satellite, telephone, wireless and cellular phone, digital phone, and a global communications network

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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.

2008-02-29 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mitchell P. Brook

Correspondent

MITCHELL P. BROOK
LUCE, FORWARD, HAMILTON & SCRIPPS
11988 EL CAMINO REAL STE 200
SAN DIEGO, CA 92130-3334
Phone Number: 858 720 6300
Fax Number: 858 720 6306

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the Petition to Cancel regarding U.S. Trademark Registration No. 3,389,652 to be served upon:

Mitchell P. Brook, Esq.
Luce, Forward, Hamilton & Scripps LLP
11988 El Camino Real, Suite 200
San Diego, California 92130

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 7th day of April, 2008.


Deborah A. Wing