

ESTTA Tracking number: **ESTTA281264**

Filing date: **04/30/2009**

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

Proceeding	91169226
Party	Plaintiff Arcadia Group Brands Ltd
Correspondence Address	Bret J. Danow Katten Muchin Rosenman LLP 575 Madison Avenue New York, NY 10022-2585 UNITED STATES bret.danow@kattenlaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Cathay Y. N. Smith
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Signature	/s/
Date	04/30/2009
Attachments	Arcadia's Motion for Leave to File Amended Pleading Instantly and Amended Pleading.pdf (31 pages)(1423097 bytes)

with goods that categorically encompasses clothing, footwear, and headgear is a breach of Studio Moderna's obligations under its contract with Arcadia and that registration of the mark depicted in the Application is likely to cause confusion, mistake, or deception in the minds of the purchasing public as to the source or origin of Studio Moderna's services.

2. On April 7, 2008, Arcadia filed a Petition to Cancel Studio Moderna's trademark registration for TOP SHOP TV (Registration No. 3,389,652) (the "Registration"), and amended its Petition to Cancel on May 6, 2008, on the grounds that Studio Moderna breached its obligations under its agreement with Arcadia, that Studio Moderna's Registration is an impediment to Arcadia's right to own a registration in the United States Patent and Trademark Office for its TOPSHOP name and mark in connection with its online and other retail services, notwithstanding Arcadia's prior use, and that Arcadia will be damaged in the event consumer confusion occurs.

3. On May 23, 2008, Studio Moderna filed a motion to strike certain paragraphs of Arcadia's Amended Petition to Cancel. The Board has yet to rule on Studio Moderna's motion to strike.

4. The Board consolidated the opposition proceeding and the cancellation proceeding on September 15, 2008. Since the consolidation, no new discovery has been propounded by either Arcadia or Studio Moderna. Furthermore, the discovery period in this consolidated proceeding is still open, and neither party has taken any depositions.

5. During the course of discovery in this consolidated proceeding, Arcadia recently discovered new information relating to Studio Moderna's nonuse of the TOP SHOP TV mark, its nonuse of the TOP SHOP TV mark on the broad categories of goods and services indicated in the Registration when it filed its Statement of Use, and its improper reliance on its foreign registration to apply for the TOP SHOP TV & Design mark for goods and services that exceed those registered under its foreign registration.

6. Specifically, despite repeated requests, Studio Moderna has failed to produce any evidence of its purported *bona fide* use in the ordinary course of trade of the TOP SHOP TV mark, depicted in the Registration, for “on-line retail services in the field of general consumer merchandise.” Studio Moderna’s website, located at www.topshoptv.com, purportedly offers a handful of items for sale. This website was “activated” a mere few days before the expiration of Studio Moderna’s fifth – and final – extension of time to file a Statement of Use to show use in commerce in support its Intent to Use application. Nevertheless, in response to discovery, Studio Moderna has failed to produce any evidence to show that its use of the TOP SHOP TV mark prior to filing its Statement of Use was a *bona fide* use in the ordinary course of trade, or that this use was anything other than a token use merely to reserve trademark rights. Furthermore, even if Studio Moderna could otherwise prove that its use was a valid use in commerce and not a token use, Studio Moderna was – and still is – only offering five items for sale on its website: the “Nicer Dicer” dicing kitchenware, the “Pancake Puffs” kitchen pan, the “Sonic Blade” kitchen knife, the “Germ Free 60” hand-cleaning solution, and the “Kosmodisk Classic” back remedy. The offering for sale of *five items* does not fit within the ambit of its Registration covering “on-line retail services in the field of *general consumer merchandise*.”

7. Pursuant to Federal Rule of Civil Procedure 15(a) and TBMP § 507.02, Arcadia now moves for leave to file the Amended Consolidated Notice of Opposition and Petition to Cancel attached hereto as Exhibit 1.

8. The amended pleading asserts additional grounds for opposition of the Application and cancellation of the registration on the bases that, among others, Studio Moderna did not use the mark TOP SHOP TV prior to filing its Statement of Use because any use of the mark prior was merely “token use” and not in fact a *bona fide* use in the ordinary course of trade, and Studio

Moderna failed to use the TOP SHOP TV mark to sell the wide range of "general merchandise" products as set forth in its Registration when it filed its Statement of Use.

9. In relevant part, Federal Rule of Civil Procedure 15(a) provides that leave to amend "shall be freely given when justice so requires." TBMP § 507.02 further states that "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties."

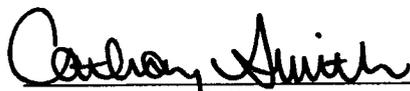
10. Arcadia brings this Motion in good faith and not for any improper purpose. Granting the Motion will cause no delay or prejudice to Studio Moderna, but rather will serve the ends of justice. Concurrently herewith, Arcadia files its Motion for Summary Judgment. *See Marmark Ltd. v. Nutrexpia S.A.*, 12 USPQ2d 1843 (TTAB 1989) (granting concurrently filed motion to amend pleading and motion for summary judgment on cause of action set forth in the amended pleading).

WHEREFORE, Arcadia Group Brands Ltd. respectfully requests that this Board grant its Amended Consolidated Notice of Opposition and Petition to Cancel, a copy of which is attached as Exhibit 1.

Respectfully submitted,

**Attorney for Opposer-Petitioner,
Arcadia Group Brands Ltd.**

Date: April 30, 2009



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Exhibit 1

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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

Arcadia Group Brands Ltd.,)	
)	
Opposer,)	Opposition No. 91-169,226
)	
v.)	
)	
Studio Moderna SA,)	
)	
Applicant.)	
)	
Arcadia Group Brands Ltd.,)	
)	
Petitioner,)	Cancellation No. 92-049,146
)	
v.)	
)	
Studio Moderna SA,)	
)	
Registrant.)	(as consolidated)
)	

**AMENDED CONSOLIDATED NOTICE OF OPPOSITION
AND PETITION TO CANCEL**

Opposer-Petitioner, Arcadia Group Brands Limited (“Arcadia”), a company organized and existing under the laws of England, having a place of business at Colegrave House, 70 Berners Street, London, W1T 3NL, United Kingdom, believes that it will be damaged by Studio Moderna SA’s (“Studio Moderna”) registration of U.S. Application Serial No. 78/239,078 (the “Application”), published in the U.S. Patent and Trademark Office (“USPTO”) on August 13, 2005, for the mark TOP SHOP TV & Design in Class 35, and that it is likely to be, or has been, damaged by Studio Moderna’s U.S. Registration No. 3,389,652 (the “Registration”), issued on February 26, 2008, for the mark TOP SHOP TV in connection with “on-line retail services in the field of general consumer merchandise.” Applicant-Registrant Studio Moderna has an address identified in the Registration and Application as Via Pretorio 22, Lugano, Switzerland 6900. For the reasons set forth below, Arcadia hereby opposes the Application and petitions to cancel the Registration, pursuant to 37 CFR §2.101(b) and 37 CFR §2.111(b).

As grounds therefor, Arcadia alleges as follows:

1. Arcadia is the owner and operator of the internationally renowned TOPSHOP chain of retail stores and the www.topshop.com website, where it sells a wide range of clothing and accessories bearing Arcadia’s famous TOPSHOP and TOP SHOP names and marks

(collectively, "TOPSHOP"). Arcadia, through its predecessors-in-interest, began using its mark in the United Kingdom no later than 1968, and began using the TOPSHOP names and marks in the United States no later than 1998, and continues to use such marks. On or about April 2, 2009, Arcadia opened its first stand-alone Topshop store in the United States. Through Arcadia's extensive sales, advertising and promotion activities, consumers worldwide, including in the United States, have long had familiarity with Arcadia's TOPSHOP names and marks and associate the TOPSHOP brand exclusively with Arcadia. In fact, in each of the last four years, international sales of clothing and accessories bearing Arcadia's TOPSHOP names and marks have totaled over seven hundred million dollars annually.

2. Arcadia advertises and promotes its products and services extensively through many forms of media, including, but not limited to, advertisements in internationally circulated publications, in printed and electronic catalogs, and on the internet at www.topshop.com. Arcadia's TOPSHOP brand has been featured in magazines and journals such as Lucky, US Weekly, InStyle, Vogue, People, the New York Times, and the Wall Street Journal, and is worn by celebrities such as Kate Bosworth, Nicole Richie, Cameron Diaz, Kelly Osbourne, Selma Blaire, Amanda Bynes, Juliette Lewis, Mariah Carey, Fergie, Lake Bell, Ashlee Simpson, Mary-Kate Olsen, Kate Moss, Keira Knightly, and Sienna Miller.

3. Arcadia 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 : 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 (collectively, the "TOPSHOP Family of Marks"). All of the foregoing TOPSHOP names and marks are valid and subsisting and in full force and effect in connection with clothing, accessories, retail store services and related goods and services.

4. Arcadia is also 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." A printout of this registration taken from the electronic search records of the USPTO is attached as Exhibit A1.

5. Arcadia is the owner of U.S. Registration No. 3,524,208 for the mark TOP SHOP, issued October 28, 2008, covering "jewelry, namely, necklaces, rings, earrings, bracelets, bangles and pendants" based upon the priority established by United Kingdom Registration No. 1,522,280. A printout of this registration taken from the electronic search records of the USPTO is attached as Exhibit A2.

6. Arcadia is the owner of U.S. Registration No. 3,524,207 for the mark TOP SHOP, issued October 28, 2008, covering "sunglasses and accessories for sunglasses, namely, neck cords which restrain sunglasses from movement on a wearer, and parts for the above goods" based upon the priority established by United Kingdom Registration No. 1,522,759, issued December

21, 1992. A printout of this registration taken from the electronic search records of the USPTO is attached as Exhibit A3.

7. Arcadia is the owner of U.S. Registration No. 3,552,730 for the mark TOPSHOP, issued December 30, 2008, covering “Hand bags; shoulder bags; leather canvas and mesh shopping bags; clutch bags; tote bags; trolley bags for travel with wheels attached; envelope bags of leather, namely, a bag having a closure flap for carrying personal articles; holdalls; purses; wallets; satchels; leather pouches; vanity cases sold empty; leather passport holders; and leather passport covers.” A printout of this registration taken from the electronic search records of the USPTO is attached as Exhibit A4.

8. Arcadia 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.” Arcadia is using and has used the mark TOP SHOP for online retail store services in the United States since 1998. Nevertheless, despite Arcadia’s earlier use of the TOPSHOP mark in the United States, Studio Moderna’s Registration has, to date, delayed Arcadia’s registration of its mark in the USPTO.

9. Beginning no later than 1998, via its websites www.topshop.co.uk and www.topshop.com, Arcadia has offered services in the United States which can be construed to be within those recited in the Registration and in Class 35 of the Application. Specifically, Arcadia has used – and is using – its TOPSHOP names and marks for the on-line retail sale of goods, which would facially qualify as a category of *general consumer merchandise*. A printout from the home page of Arcadia’s www.topshop.com website reflecting Arcadia’s current merchandise for sale is attached hereto as Exhibit B. (See <http://www.topshop.com/webapp/wcs/stores/servlet/TopCategoriesDisplay?storeId=12556&catalogId=19551> (last April 21, 2009)).^{1/}

10. According to the Statement of Use submitted in connection with the Registration, Studio Moderna did not commence use of the TOP SHOP TV mark in connection with the services identified in the Registration and in Class 35 of the Application until September 7, 2007, nearly ten years after Arcadia began offering online retail services under its TOPSHOP name and mark in the United States and well after Arcadia’s name became well-known among United States consumers.

11. On or about April 29, 2004, Studio Moderna and Arcadia entered into a coexistence agreement (the “Agreement”), which enumerates, among other things, the manner(s) in which the parties can use and register the TOPSHOP name and mark. The Agreement also is intended to avoid any likelihood of confusion between the parties’ respective marks and goods. A copy of the Agreement is attached as Exhibit C.

^{1/} The opening of Arcadia’s flagship TOPSHOP store in the United States has been featured in publications such as the *Wall Street Journal*, the *New York Times*, the *LA Times*, *Women’s Wear Daily*, and *Vogue*, beginning in 2004. Evidence of such has been produced to Studio Moderna in this consolidated proceeding.

12. Pursuant to the Agreement, Studio Moderna agreed, among other things, “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.” (Ex. C, ¶ 2.)

13. Studio Moderna’s use and registration of the TOP SHOP TV mark and/or TOP SHOP TV & Design in connection with “on-line retail services in the field of general consumer merchandise” in International Class 35 can be construed to include articles of clothing, footwear and headgear and therefore violate the spirit and the terms set forth in the Agreement and the understanding of the parties when they entered into such Agreement. Additionally, the documents produced by Studio Moderna in discovery reveal that Studio Moderna is marketing articles of clothing, footwear and other Class 25 goods under the TOP SHOP TV name and mark.

14. Moreover, because the phrase “general consumer merchandise” is so broad, Studio Moderna’s retail services would include the sale of merchandise so similar to Arcadia’s merchandise that it is likely to cause confusion, mistake, or deception in the minds of the purchasing public as to the source or origin of Studio Moderna’s services, especially in view of Arcadia’s long prior use of its TOPSHOP Family of Marks and well developed secondary meaning therein.

15. Notwithstanding the restrictions in the Agreement and Arcadia’s use and the fame of its TOPSHOP Family of Marks, on February 25, 2008, Studio Moderna filed applications for the marks TOP SHOP in International Classes 35, 38, and 41 (U.S. Application Serial No. 77/405,680), and TOP SHOP TV in International Classes 35, 38, and 41 (U.S. Application Serial No. 77/405,689). Such new applications demonstrate further progressive encroachment on Arcadia’s rights, as well as a bad faith intent to appropriate Arcadia’s goodwill, because Studio Moderna is aware – from the numerous documents produced by Arcadia during discovery – that Arcadia has been using the mark TOP SHOP for online retail services in the United States since 1998, and its flagship store in the United States is now open.

16. Arcadia will be damaged, and is likely to suffer damage and/or injury, if Studio Moderna is permitted to register the mark in the Application and/or continues to own the Registration because, among other things, (a) the Registration is an impediment to Arcadia’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 Arcadia’s prior use, (b) Studio Moderna’s use and/or registration of the TOP SHOP TV mark in connection with goods that categorically encompass clothing, footwear and headgear is a breach of Studio Moderna’s obligations under the Agreement, and (c) Arcadia will suffer damage and/or injury to its reputation by the confusion which will result in the marketplace.

Claims Specific To Studio Moderna’s Registration

17. Contrary to Studio Moderna’s Statement of Use, any use of Studio Moderna’s TOP SHOP TV mark prior to filing its Statement of Use was merely “token use” of the mark and not in fact a *bona fide* use in the ordinary course of trade, making the registration void *ab initio*. Accordingly, Studio Moderna’s Registration should be cancelled for nonuse.

18. Even if Studio Moderna's use could otherwise be construed a *bona fide* use in the ordinary course of trade for purposes of registration, Studio Moderna's description of services is overly broad and indefinite and, contrary to its Statement of Use, Studio Moderna has not used and is not using the TOP SHOP TV mark to sell the wide range of products as set forth in the Registration. In fact, as of the date Studio Moderna filed its Statement of Use, Studio Moderna's purported offerings were limited to five items: the "Nicer Dicer" dicing kitchenware, the "Pancake Puffs" kitchen pan, the "Sonic Blade" kitchen knife, the "Germ Free 60" hand-cleaning solution, and the "Kosmodisk Classic" back remedy. Accordingly, Studio Moderna's Registration should be cancelled because it should not be permitted to own a registration for on-line retail services of *all* categories of *general consumer merchandise*, including those that it does not sell and has never sold, and such conduct may rise to the level of fraud.

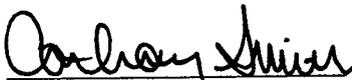
Claims Specific To Studio Moderna's Application

19. Studio Moderna's Application is based upon Section 44 of the Lanham Trademark Act of 1946. Accordingly, the description of goods in the Application cannot include goods that are not included in the description of goods in the Swiss registration upon which Studio Moderna's U.S. Application is based.

20. The goods and services covered in Studio Moderna's U.S. Application exceed the scope of goods covered in its Swiss Registration No. 514582 upon which its U.S. application is based. For instance, Studio Moderna's TOP SHOP TV & Design mark is not registered in Switzerland for "on-line retail services and electronic catalog services in the field of general consumer merchandise," which its U.S. Application seeks to cover. Studio Moderna, therefore, is not entitled to obtain the U.S. registration which it seeks on the basis of its Swiss registration.

WHEREFORE, Arcadia believes that it is likely to be damaged by U.S. Registration No. 3,389,652 and U.S. Application Serial No. 78/239,078, and Arcadia respectfully requests that the mark shown in such registration and application be cancelled and that this Amended Consolidated Notice of Opposition and Petition to Cancel be sustained.

Respectfully submitted,

By: 

Floyd A. Mandell
William J. Dorsey
Cathay Y. N. Smith
KATTEN MUCHIN ROSENMAN LLP
Attorneys for Arcadia
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

Dated: April 30, 2009

Exhibit A1

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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

This page was generated by the TARR system on 2009-04-30 12:13:08 ET

Serial Number: 78190311 Assignment Information Trademark Document Retrieval

Registration Number: 3237860

Mark (words only): TOPSHOP

Standard Character claim: No

Current Status: Registered.

Date of Status: 2007-05-01

Filing Date: 2002-12-02

Transformed into a National Application: No

Registration Date: 2007-05-01

Register: Principal

Law Office Assigned: LAW OFFICE 102

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: 2007-03-28

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

1. ARCADIA GROUP BRANDS LIMITED

Address:
ARCADIA GROUP BRANDS LIMITED
COLEGRAVE HOUSE, 70 BERNERS STREET
LONDON W1T 3NL
United Kingdom
Legal Entity Type: Company
State or Country Where Organized: United Kingdom

GOODS AND/OR SERVICES

International Class: 025
Class Status: Active
Women's clothing, namely skirts, dresses, pants, tops and jacket
Basis: 1(a)
First Use Date: 1964-12-31
First Use in Commerce Date: 1998-12-31

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.

2007-05-01 - Registered - Principal Register

2007-03-20 - Law Office Registration Review Completed

2007-03-15 - Assigned To LIE

2007-02-20 - Allowed for Registration - Principal Register (SOU accepted)

2007-02-02 - Statement of use processing complete

2007-02-02 - Extension 1 granted

2006-11-30 - Amendment to Use filed

2006-11-30 - Extension 1 filed

2006-11-30 - TEAS Extension Received

2006-11-30 - TEAS Statement of Use Received

2006-11-21 - Noa Mailed - SOU Required From Applicant

2006-10-04 - Opposition terminated for Proceeding

2006-10-04 - Opposition dismissed for Proceeding

2006-08-31 - Attorney Revoked And/Or Appointed

2006-08-31 - TEAS Revoke/Appoint Attorney Received

2006-08-30 - Assignment Of Ownership Not Updated Automatically

2005-11-08 - Opposition instituted for Proceeding

2005-07-08 - Extension Of Time To Oppose Received

2005-07-05 - Published for opposition

2005-06-15 - Notice of publication
2005-03-25 - Law Office Publication Review Completed
2005-03-14 - Assigned To LIE
2005-03-07 - Approved for Pub - Principal Register (Initial exam)
2005-03-04 - Amendment From Applicant Entered
2005-02-08 - Communication received from applicant
2005-02-08 - PAPER RECEIVED
2004-08-09 - Final refusal mailed
2004-08-06 - Previous allowance count withdrawn
2004-02-19 - Approved for Pub - Principal Register (Initial exam)
2003-12-24 - Communication received from applicant
2003-12-29 - PAPER RECEIVED
2003-06-24 - Non-final action mailed
2003-06-11 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Bret J. Danow

Correspondent

BRET J. DANOW
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, NY 10022-2585
Phone Number: 2129408800
Fax Number: 2129408671

Domestic Representative

Bret J. Danow
Phone Number: 212-940-8800
Fax Number: 212-940-8671

Exhibit A2

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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

This page was generated by the TARR system on 2009-04-30 12:12:30 ET

Serial Number: 78631857 Assignment Information Trademark Document Retrieval

Registration Number: 3524208

Mark

TOP SHOP

(words only): TOP SHOP

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2008-10-28

Filing Date: 2005-05-17

Transformed into a National Application: No

Registration Date: 2008-10-28

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: 2008-10-28

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

1. Arcadia Group Brands Limited

Address:

Arcadia Group Brands Limited
Colegrave House 70 Berners Street
London W1T 3NL
United Kingdom

Legal Entity Type: Company

State or Country Where Organized: United Kingdom

GOODS AND/OR SERVICES

International Class: 014

Class Status: Active

Jewelry, namely, necklaces, rings, earrings, bracelets, bangles and pendants

Basis: 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Registration Number: 1522280

Foreign Registration Date: 1992-12-21

Country: United Kingdom

Foreign Expiration Date: 1999-12-21

Foreign Renewal Number: 1522280

Foreign Renewal Date: 1999-11-19

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.

2008-10-28 - Registered - Principal Register

2008-08-12 - Published for opposition

2008-07-23 - Notice of publication

2008-07-09 - Law Office Publication Review Completed

2008-07-09 - Approved for Pub - Principal Register (Initial exam)

2008-07-09 - LIE Checked Susp - To Atty For Action

2008-07-09 - Assigned To LIE

2008-01-09 - Report Completed Suspension Check Case Still Suspended

2007-07-09 - Report Completed Suspension Check Case Still Suspended

2007-01-08 - Report Completed Suspension Check Case Still Suspended

2006-07-05 - Letter of suspension mailed

Latest Status Info

2006-07-03 - Suspension Letter Written
2006-07-01 - Teas/Email Correspondence Entered
2006-06-08 - Communication received from applicant
2006-06-08 - TEAS Response to Office Action Received
2005-12-20 - Non-final action mailed
2005-12-19 - Non-Final Action Written
2005-12-12 - Assigned To Examiner
2005-05-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Bret J. Danow

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BRET J. DANOW
KATTEN MUCHIN ROSENMAN LLP
575 MADISON AVENUE
NEW YORK, NY 10022-2585
Phone Number: (212) 940-8800
Fax Number: (212) 940-8671

Domestic Representative

Bret J. Danow
Phone Number: (212) 940-8800
Fax Number: (212) 940-8671

Exhibit A3

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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

This page was generated by the TARR system on 2009-04-30 12:12:58 ET

Serial Number: 78631856 Assignment Information Trademark Document Retrieval

Registration Number: 3524207

Mark

TOP SHOP

(words only): TOP SHOP

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2008-10-28

Filing Date: 2005-05-17

Transformed into a National Application: No

Registration Date: 2008-10-28

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: 2008-10-28

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

1. Arcadia Group Brands Limited

Address:

Arcadia Group Brands Limited
Colegrave House 70 Berners Street
London W1T 3NL
United Kingdom

Legal Entity Type: Company

State or Country Where Organized: United Kingdom

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

Sunglasses and accessories for sunglasses, namely, neck cords which restrain sunglasses from movement on a wearer, and parts for the above goods

Basis: 44(e)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Registration Number: 1522279

Foreign Registration Date: 1992-12-21

Country: United Kingdom

Foreign Expiration Date: 1999-12-21

Foreign Renewal Number: 1522279

Foreign Renewal Date: 1999-11-19

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.

2008-10-28 - Registered - Principal Register

2008-08-12 - Published for opposition

2008-07-23 - Notice of publication

2008-07-09 - Law Office Publication Review Completed

2008-07-09 - Approved for Pub - Principal Register (Initial exam)

2008-07-09 - LIE Checked Susp - To Atty For Action

2008-07-09 - Assigned To LIE

2008-01-09 - Report Completed Suspension Check Case Still Suspended

2007-07-09 - Report Completed Suspension Check Case Still Suspended

2007-01-08 - Report Completed Suspension Check Case Still Suspended

2006-07-05 - Letter of suspension mailed

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=78631856>

4/30/2009

2006-07-03 - Suspension Letter Written
2006-07-01 - Teas/Email Correspondence Entered
2006-06-08 - Communication received from applicant
2006-06-08 - TEAS Response to Office Action Received
2005-12-20 - Non-final action mailed
2005-12-19 - Non-Final Action Written
2005-12-12 - Assigned To Examiner
2005-05-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Bret J. Danow

Correspondent

BRET J. DANOW

KATTEN MUCHIN ROSENMAN LLP

575 MADISON AVENUE

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Phone Number: (212) 940-8800

Fax Number: (212) 940-8671

Domestic Representative

Bret J. Danow

Phone Number: (212) 940-8800

Fax Number: (212) 940-8671

Exhibit A4

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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

This page was generated by the TARR system on 2009-04-30 12:13:17 ET

Serial Number: 77301420 Assignment Information Trademark Document Retrieval

Registration Number: 3552730

Mark

TOPSHOP

(words only): TOPSHOP

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2008-12-30

Filing Date: 2007-10-11

Transformed into a National Application: No

Registration Date: 2008-12-30

Register: Principal

Law Office Assigned: LAW OFFICE 110

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: 2008-12-30

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

1. Arcadia Group Brands Limited

Address:

Arcadia Group Brands Limited
Colegrave House 70 Berners Street
London W1T3NL
United Kingdom

Legal Entity Type: Company

State or Country Where Organized: United Kingdom

GOODS AND/OR SERVICES

International Class: 018

Class Status: Active

Hand bags; shoulder bags; leather, canvas and mesh shopping bags; clutch bags; tote bags; trolley bags for travel with wheels attached; envelope bags of leather, namely, a bag having a closure flap for carrying personal articles; holdalls; purses; wallets; satchels; leather pouches; vanity cases sold empty; leather passport holders; and leather passport covers

Basis: 1(a)

First Use Date: 2006-11-30

First Use in Commerce Date: 2006-11-30

ADDITIONAL INFORMATION

Prior Registration Number(s):

3237860

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.

2008-12-30 - Registered - Principal Register

2008-10-14 - Published for opposition

2008-09-24 - Notice of publication

2008-09-05 - Law Office Publication Review Completed

2008-09-04 - Approved for Pub - Principal Register (Initial exam)

2008-09-03 - LIE Checked Susp - To Atty For Action

2008-09-03 - Assigned To LIE

2008-03-03 - Letter of suspension mailed

2008-03-03 - Suspension Letter Written

2008-01-17 - Teas/Email Correspondence Entered

2008-01-17 - Communication received from applicant

2008-01-17 - TEAS Response to Office Action Received

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=77301420>

4/30/2009

2007-12-18 - Non-final action mailed

2007-12-17 - Non-Final Action Written

2007-12-17 - Assigned To Examiner

2007-10-17 - Notice Of Pseudo Mark Mailed

2007-10-16 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Bret J. Danow

Correspondent

BRET J. DANOW

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575 MADISON AVENUE

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Exhibit B

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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THE BOUTIQUE
BRANDS AT TOPSHOP

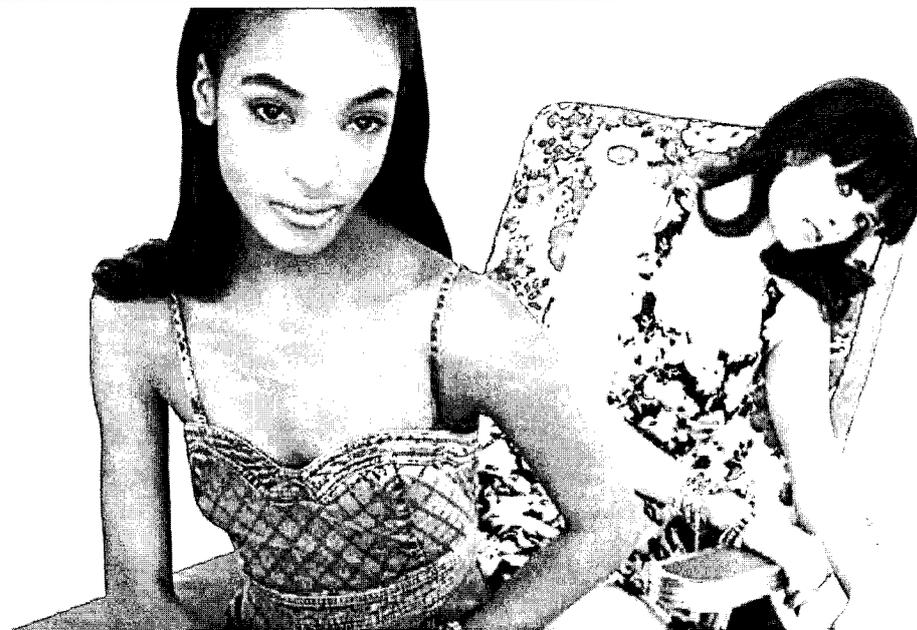
- DRESSES
- TOPS
- BASIC TOPS
- KNITWEAR
- JACKETS & COATS
- JEANS
- TROUSERS
- SHORTS
- SKIRTS
- LEGGINGS
- PLAYSUITS

SHOES

- ACCESSORIES
- BAGS & PURSES
- JEWELLERY
- TIGHTS & SOCKS
- LINGERIE & NIGHTWEAR
- SWIMWEAR

PETITE
TALL
MATERNITY & MINI

SNO
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- LOOKBOOK SS09
- THE TEE SHOP

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TARGETS
BREAST
CANCER



KATE MOSS
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Exhibit C

Arcadia Group Brands Ltd. v. Studio Moderna SA, Opposition No.
91169226, Cancellation No. 92049146 (as consolidated)

Opposer-Petitioner's Exhibit

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:

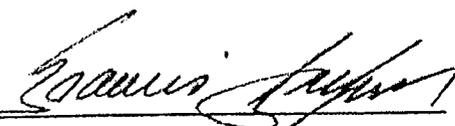
Studio Moderna, Finančne in intelektualne storitve, ter trgovina d.o.o., Cesta 9. avgusta 4, Zagorje, SI (hereinafter Studio Moderna) and

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

Whereas:

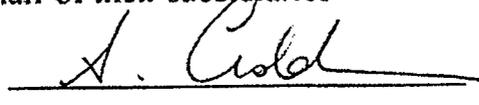
1. Studio Moderna undertakes not to use the mark TOP SHOP for designation of goods from class 25 of Nice classification (articles of clothing, footwear and headgear) in any country.
2. Arcadia Group undertakes not to use the mark TOP SHOP for designation of goods from class 10 of Nice classification (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: Budapest, 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

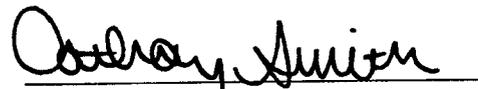
CERTIFICATE OF SERVICE

I hereby certify that I have caused true and correct copies of Arcadia Group Brands Ltd.'s Motion for Leave to file Amended Pleading *Instante*r and the Amended Consolidated Notice of Opposition and Petition to Cancel to be served upon:

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

Mr. Christopher C. Larkin
Seyfarth Shaw LLP
One Century Plaza, Suite 3300
2029 Century Park East
Los Angeles, California 90067-3063

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 30th day of April, 2009.


Cathay Y. N. Smith