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Filing date: **05/06/2008**

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

Proceeding	92049146
Party	Plaintiff Arcadia Group Brands Limited
Correspondence Address	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
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/s/
Date	05/06/2008
Attachments	Amended Petition to Cancel.PDF (15 pages)(1308669 bytes)

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

Arcadia Group Brands Limited,)	
)	
Petitioner,)	Cancellation No. 92049146
)	
v.)	Mark: TOP SHOP TV
)	
Studio Moderna SA,)	Reg. No.: 3,389,652
)	
Registrant.)	

AMENDED PETITION TO CANCEL

Petitioner, Arcadia Group Brands Limited, 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 is likely to be, and has been, damaged by 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" to Registrant, Studio Moderna SA, with an address identified in the Registration as Via Pretorio 22, Lugano, Switzerland 6900. Accordingly, for the reasons set forth below, Petitioner hereby petitions to cancel the Registration, pursuant to 37 CFR §2.111(b).

As grounds therefor, Petitioner alleges as follows:

1. Petitioner 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 Petitioner's famous TOPSHOP and TOP SHOP names and marks (collectively, "TOPSHOP"). Petitioner, through its predecessors-in-interest, began using its mark in the United Kingdom in 1964, and has used the TOPSHOP names and marks in the United States commencing in 1998, and continues to use such marks. Through Petitioner's extensive sales, advertising and promotion, consumers worldwide, including in the United States, have long had familiarity with Petitioner's TOPSHOP names and marks and associate the TOPSHOP brand exclusively with Petitioner. In fact, in the last four years, international sales of clothing and accessories bearing Petitioner's TOPSHOP names and marks have totaled over seven hundred million dollars annually.

2. Petitioner 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. 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. 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.

3. Petitioner 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 A.

4. 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 is using and has used the mark TOP SHOP for online retail store services in the United States since 1998. Nevertheless, 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").

5. Petitioner and Registrant are also parties to an opposition proceeding, Opposition No. 91169226 (the "Related Opposition"), in the Trademark Trial and Appeal Board concerning Registrant's application for registration of the mark TOP SHOP TV and Design (U.S. Application Serial No. 78/239,078). In that proceeding, which involves the same or similar questions of law and/or fact as presented by the instant Amended Petition to Cancel, Petitioner opposes registration of the mark TOP SHOP TV and Design in International Class 35.

6. Beginning at least as early as 1998, via its websites www.topshop.co.uk and www.topshop.com, Petitioner has offered services in the United States which can be construed to be within those recited in the Registration, a broad description of "on-line retail services in the field of general consumer merchandise." A printout from the home page of Petitioner's www.topshop.com website is attached hereto as Exhibit B. (See <http://www.topshop.com/webapp/wcs/stores/servlet/TopCategoriesDisplay?storeId=12556&catalogId=19551> (last visited May 6, 2008)).^{1/}

7. 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 until September 7, 2007, nearly ten years after Petitioner began offering online retail services under its TOPSHOP name and mark in the United States and well after Petitioner's name became well-known among United States consumers.

^{1/} 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*. Evidence of such has been produced to Registrant in the Related Opposition. The store's opening in New York City is scheduled for Fall 2008.

8. On or about April 29, 2004, Registrant and Petitioner 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.

9. Pursuant to the Agreement, Registrant 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.)

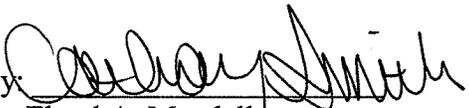
10. Registrant's use and registration of the TOP SHOP TV mark in connection with "on-line retail services in the field of general consumer merchandise" in International Class 35 can be construed to include articles of clothing, footwear and headgear, and therefore violate the spirit and the terms set forth in the Agreement, and the understanding of the parties when they entered into such Agreement. Additionally, the documents produced by Registrant in the Related Opposition reveal that Registrant is marketing articles of clothing, footwear and other Class 25 goods under the TOP SHOP name and mark.

11. Additionally, notwithstanding the restrictions in the Agreement and Petitioner's use and the fame of its TOPSHOP Family of Marks, on February 25, 2008, Registrant 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 Petitioner's rights, as well as bad faith intent to appropriate Petitioner's goodwill, because Registrant is aware – from the numerous documents produced by Petitioner in the Related Opposition – that Petitioner 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 scheduled to open in Fall 2008.

12. Petitioner will be damaged, and is likely to suffer damage and/or injury, if Registrant continues to own the Registration because, among other things, (a) 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, and (b) Registrant'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 Registrant's obligations under the Agreement, and, if there is a likelihood of confusion, damage to Petitioner will result.

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

Respectfully submitted,

By: 

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: May 6, 2008

Exhibit A

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

This page was generated by the TARR system on 2008-05-06 15:53:18 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 - Notice of allowance - mailed

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

Latest Status Info

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

KATTEN MUCHIN ROSENMAN LLP

575 MADISON AVENUE

, NY 10022-2585

Phone Number: 2129408800

Fax Number: 2129408671

Domestic Representative

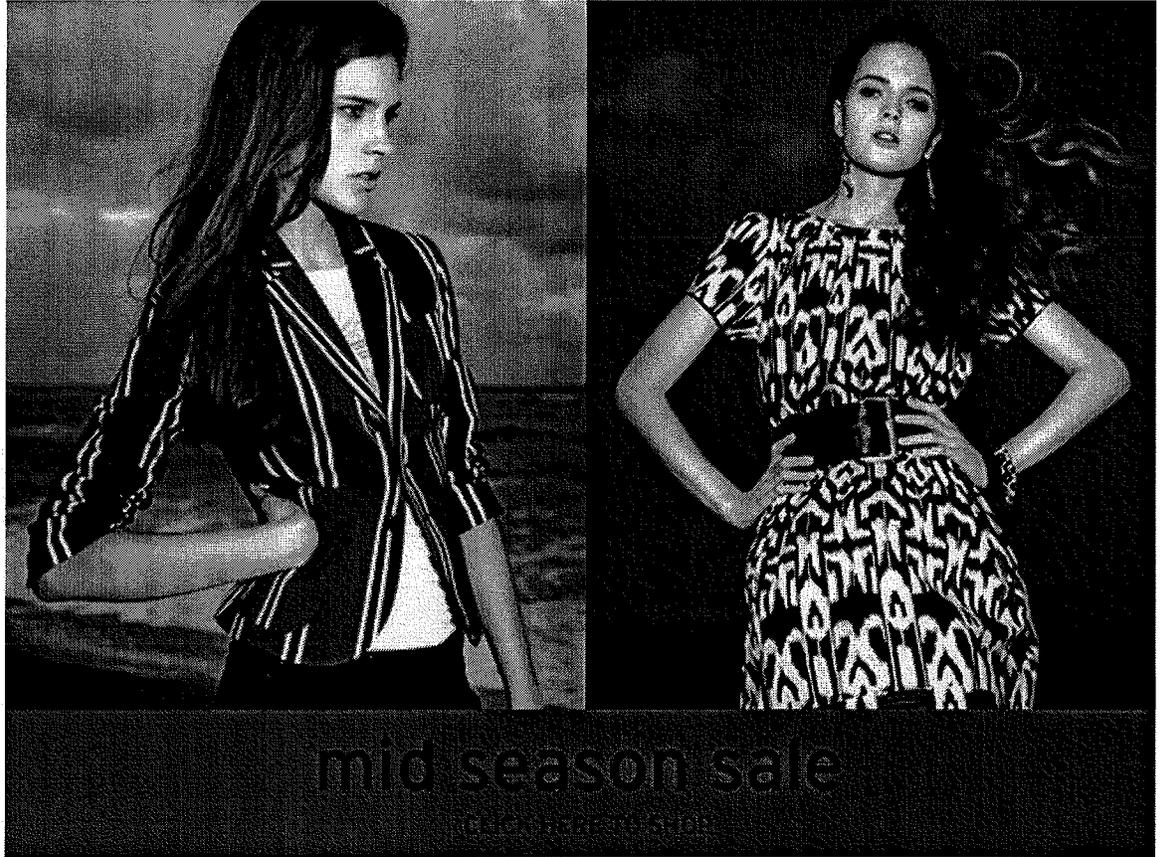
Bret J. Danow

Phone Number: 212-940-8800

Fax Number: 212-940-8671

Exhibit B

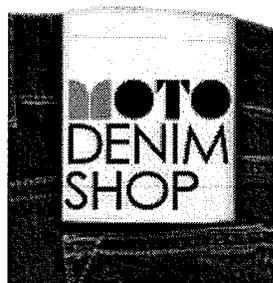
TOPSHOP



features



MINI STORES



STYLE BLOG

RSS

5:57am - 2nd May 2008

PAYPAL ON TOPSHOP.COM



The **safest, easiest way to shop online** is now available on TOPSHOP.COM! **Paypal** helps to **protect your credit card information** through a secure, fraud-prevention system, meaning your financial information is never shared.

If you've already signed-up to **Paypal**, then simply continue shopping with us as you'd normally do, only select the 'Paypal' button when you check-out. If not, but you'd like to find out more about shopping with Paypal and the service they offer, simply follow the link below.

<https://www.paypal.com/uk/>

Happy *safer* shopping...
Love TOPSHOP.COM and Paypal

For a full list of our **Price and Payment** options please click here.

5:55am - 2nd May 2008

CALLING ALL OUR LONDON SHOPPERS!!



Have we got a treat for you this Bank Holiday weekend...the exclusive **TOPSHOP.COM Archive** collection now has a limited range for sale in **Topshop, Oxford Circus**. Looking to the roots of the **British High Street** for inspiration, Archive brings you **sourced vintage pieces** from the 40's through to the 80's including influential labels like **Comme des Garcons, Radley and Louis Feraud**.

Make sure you get down to the **Topshop Boutique** fast as it will only be available for a limited time.

On your marks...

Go to the blog archive page

SEARCH

SHOPPING BAG 0 item(s) In your Bag: £0.00

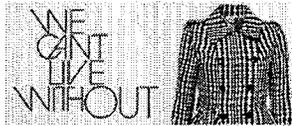
- SALE
- KATE MOSS
- NEW IN
- DRESSES
- TOPS
- SHOES
- KNITWEAR
- WAISTCOATS
- JACKETS AND COATS
- JEANS
- PLAYSUITS
- TROUSERS AND SHORTS
- LEGGINGS
- SKIRTS
- THE BOUTIQUE
- BRANDS AT TOPSHOP
- ACCESSORIES
- JEWELLERY
- SWIMWEAR
- LINGERIE AND NIGHTWEAR
- HOBIERY
- PETITE
- TALL
- MATERNITY
- MINI - BABY CLOTHES
- FAIRTRADE
- LAST CHANCE TO BUY



COLLECTIONS

- GLOBAL COLOUR CLASH
- MODERN ROMANCE
- maggie
- TRiD
- HOTSHOP
- THE BOUTIQUE

STYLING FEATURES



STYLE BLOG

RSS

5:57am - 2nd May 2008
PAYPAL ON TOPSHOP.COM

PayPal

The safest, easiest way to shop online is now available on TOPSHOP.COM! PayPal helps to protect your credit card information through a secure, fraud-prevention system, meaning your financial information is never shared.

If you've already signed-up to PayPal, then simply continue shopping with us as you'd normally do, only select the 'Paypal' button when you check-out. If not, but you'd like to find out more about shopping with PayPal and the service they offer, simply follow the link below.

<https://www.paypal.com/uk/>

Happy safer shopping...
Love TOPSHOP.COM and PayPal

For a full list of our **Price and Payment** options please click here.

5:55am - 2nd May 2008
CALLING ALL OUR LONDON SHOPPERS!!

ARCHIVE

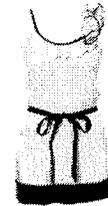
Have we got a treat for you this Bank Holiday weekend... the exclusive TOPSHOP.COM Archive collection now has a limited range for sale in Topshop, Oxford Circus. Looking to the roots of the British High Street for inspiration, Archive brings you sourced vintage pieces from the 40's through to the 80's including influential labels like Comme des Garçons, Radley and Louis Ferrand.

Make sure you get down to the Topshop Boutique Fast as it will only be available for a limited time.

On your marks...

DAILY FIX

RSS



Style NOTES

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Be first to find out about our new looks and the latest Topshop news...it only takes 2 mins to sign up!

WE NOW SHIP TO:



NEW!

SPEND OVER £100 AND RECEIVE FREE P&P (MAINLAND UK ONLY)

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MINI STORES



VIDEO/



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STUDENTS 10% OFF ALL YEAR



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TOPSHOP AFTER SERVICE



Style advisors and more

Exhibit C

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:

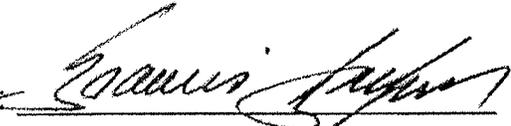
Studio Moderna, Finančne in intelektualne storitve, ter trgovina d.o.o., Cesta 9. avgusta 4, Zagorje, SI (hereinafter Studio Moderna) and

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

Whereas:

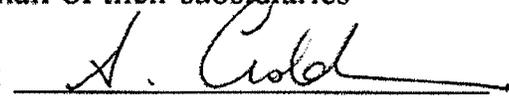
1. Studio Moderna undertakes not to use the mark TOP SHOP for designation of goods from class 25 of Nice classification (articles of clothing, footwear and headgear) in any country.
2. Arcadia Group undertakes not to use the mark TOP SHOP for designation of goods from class 10 of Nice classification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

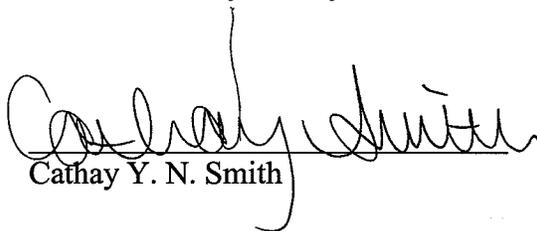
Place and Date: LONDON 16/6/04

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the Amended Petition to Cancel regarding U.S. 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 6th day of May, 2008.


Cathay Y. N. Smith