

ESTTA Tracking number: **ESTTA238514**

Filing date: **09/23/2008**

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	MIP Metro Group Intellectual Property GmbH & Co. KG
Granted to Date of previous extension	10/08/2008
Address	Metro-Strasse 1 Duesseldorf, 40235 GERMANY
Attorney information	Mark H. Tidman Baker & Hostetler LLP 1050 Connecticut Avenue, NW Washington, DC 20036-5304 UNITED STATES mtidman@bakerlaw.com, trademarks@bakerlaw.com, blebenberg@bakerlaw.com Phone:202-861-1500

Applicant Information

Application No	77227989	Publication date	06/10/2008
Opposition Filing Date	09/23/2008	Opposition Period Ends	10/08/2008
Applicant	CHW, LLC 8100 DENMARK AVENUE CHARLOTTE, NC 28234 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: sunglasses
Class 014. All goods and services in the class are opposed, namely: watches and jewelry
Class 018. All goods and services in the class are opposed, namely: handbags and wallets
Class 025. All goods and services in the class are opposed, namely: clothing for men, women, teens, girls and boys, namely, shorts, skirts, pants, gauchos, capri pants, jeans, sweatshirts, sweatpants, hooded sweatshirts, jackets, blazers, coats, t-shirts, shirts, blouses, knit tops, halter tops, crop tops, tunics, sweaters, tube tops, dresses, gloves, mittens, earmuffs, hats, caps, shoes, boots, belts, scarves, socks, hosiery, tights, undergarments, belts, lingerie and pajamas
Class 035. All goods and services in the class are opposed, namely: retail clothing store services and online retail store services featuring clothing and accessories

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	78581586	Application Date	03/07/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	METRO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: retail store services, wholesale stores and wholesale distributorships, all featuring food and general merchandise		

U.S. Application No.	78632210	Application Date	05/18/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	METRO CASH&CARRY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: Retail store services, wholesale stores and distributorships, all featuring food and general merchandise		

Related Proceedings	Opposition also filed against Ser. No. 77227963
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Attachments	78581586#TMSN.jpeg (1 page)(bytes) 78632210#TMSN.jpeg (1 page)(bytes) IT'S FASHION METRO Opposition.pdf (14 pages)(459357 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	/Mark H. Tidman/
Name	Mark H. Tidman
Date	09/23/2008

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

MIP METRO Group Intellectual Property
GmbH & Co. KG

Opposer,

v.

Opposition No.:
Serial No.: 77/227,989
Mark: IT'S FASHION METRO

CHW, LLC

Applicant.

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria , VA 22313-1451

Dear Sir or Madam:

MIP METRO Group Intellectual Property GmbH & Co. KG ("Opposer"), a German GmbH & Co. KG with its principal place of business at Metro-Strasse 1, 40235 Duesseldorf, Germany, believes that it will be damaged by the registration of the mark IT'S FASHION METRO as shown in Trademark Application Serial No. 77/277,989, filed on July 12, 2007, in International Classes 9, 14, 18, 24 and 35, published for opposition in the Official Gazette of June 10, 2008, Vol. 1331, No. 1, at Page TM93.

1. Opposer, MIP METRO Intellectual Property GmbH & Co. KG, is a GmbH & Co. KG duly organized and existing under the laws of the Germany, having its corporate address and a principal place of business at Metro-Strasse 1, 40235 Duesseldorf, Germany.

2. Opposer is the owner of U.S. Trademark Serial No. 78/581,586 for the mark METRO & Design and U.S. Trademark Serial No. 78/632,210 for METRO CASH & CARRY (hereinafter "Opposer's Marks"), both of which covers services highly similar to those listed in the subject application and related to the goods. In particular, Opposer's application covers "retail store services, wholesale stores and wholesale distributorships, all featuring food and general merchandise" in Class 35. Said applications are the exclusive properties of Opposer and is in all respect valid and subsisting, a printout of which from the USPTO TARR website is attached hereto collectively as Exhibit A.

3. Opposer filed its trademark applications on May 7, 2005 and May 18, 2005 respectively, long prior to July 12, 2007, Applicant's filing date.

4. Opposer's Marks METRO & Design and METRO CASH & CARRY are arbitrary as applied to Opposer's services. Opposer's Marks are thus highly distinctive and serve as a strong indicator of origin.

5. There is no issue of priority since Opposer's filing date precedes Applicant's filing date.

6. Applicant's IT'S FASHION METRO (Stylized) mark and Opposer's Marks are highly similar visually and aurally.

7. The goods and services for which Applicant seeks registration of the IT'S FASHION METRO (Stylized) mark are highly similar to the services for which Opposer has filed its application. The services to be marketed by Opposer are offered to the same consumers, and are thus in competition with the goods and services to be marketed and sold by Applicant.

8. Applicant's mark is confusingly and deceptively similar to Opposer's Marks and is likely to cause confusion and mistake in the minds of the purchasing public and to deceive the purchasing public as to the source or origin of Applicant's services. Persons familiar with Opposer's Marks would be likely to believe that Applicant's goods and services originate with or are sponsored by Opposer. Any such confusion in the trade could seriously injure Opposer to the extent that any objection or fault found with Applicant's

services marketed under its mark would necessarily reflect upon the reputation which Opposer will establish for its services to be offered under its trademark.

9. If Applicant were granted registration for the subject mark, it would hereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration and use would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Opposer, believes and avers that it is being and will continue to be damaged by registration of the mark with respect to International Classes 9, 14, 18, 25, and 35 as aforesaid, and prays that said Application Serial No. 77/227,989 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed Mark H. Tidman, John H. Weber and Kelu Lu, members of the law firm of BAKER & HOSTETLER LLP to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

Mark H. Tidman
BAKER & HOSTETLER LLP
Washington Square, Suite 1100
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036-5304
Telephone: (202) 861-1500
Fax: (202) 861-1783

The Commissioner is hereby authorized to charge the filing fee of \$1500.00 against this application concerning International Classes 9, 14, 18, 25 and 35 for this opposition and any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-2036.

Respectfully submitted,

MIP METRO Intellectual Property GmbH & Co. KG

Date: _____

By:  _____

Mark H. Tidman

John H. Weber

Kelu Lu

Baker & Hostetler LLP

Washington Square, Suite 1100

1050 Connecticut Avenue, N.W.

Washington, D.C. 20036-5304

(202) 861-1500 (Telephone)

(202) 861-1783 (Facsimile)

email: trademarks@bakerlaw.com

Attorneys for Opposer

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 2008-09-23 15:01:09 ET

Serial Number: 78581586 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark



(words only): METRO

Standard Character claim: No

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2008-04-24

Filing Date: 2005-03-07

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
DOMBROW COLLEEN M

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-09-19

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

1. MIP Metro Group Intellectual Property GmbH & Co. KG

Address:

MIP Metro Group Intellectual Property GmbH & Co. KG
Metro-Strasse 1
40235 Duesseldorf
Fed Rep Germany
Legal Entity Type: GmbH & Co. KG
State or Country Where Organized: Fed Rep Germany

GOODS AND/OR SERVICES

International Class: 035

Class Status: Active

retail store services, wholesale stores and wholesale distributorships, all featuring food and general merchandise

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Color(s) Claimed: The color(s) yellow and blue is/are claimed as a feature of the mark.

Description of Mark and Any Color Part(s): The mark consists of the word METRO appearing in yellow on blue background.

Design Search Code(s):

26.11.01 - Rectangles as carriers or rectangles as single or multiple line borders

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.

2008-05-07 - Attorney Revoked And/Or Appointed

2008-05-07 - TEAS Revoke/Appoint Attorney Received

2008-04-24 - Opposition instituted for Proceeding

2008-04-21 - Opposition instituted for Proceeding

2008-04-11 - Ex parte appeal terminated

2007-11-20 - Extension Of Time To Oppose Received

2007-10-23 - Published for opposition

2007-10-03 - Notice of publication

2007-09-19 - Law Office Publication Review Completed

2007-09-19 - Assigned To LIE

2007-08-14 - Approved for Pub - Principal Register (Initial exam)

2007-02-12 - LETTER OF SUSPENSION E-MAILED

2007-02-12 - Suspension Letter Written

2007-02-08 - TEAS Response to Office Action Received

2007-02-08 - Ex parte appeal - Instituted

2007-02-08 - Jurisdiction Restored To Examining Attorney

2007-02-08 - EXPARTE APPEAL RECEIVED AT TTAB

2006-08-11 - Final refusal e-mailed

2006-08-11 - Final Refusal Written

2006-08-09 - Teas/Email Correspondence Entered

2006-08-07 - Communication received from applicant

2006-08-07 - TEAS Response to Office Action Received

2006-05-08 - TEAS Change Of Correspondence Received

2006-02-06 - NON-FINAL ACTION E-MAILED

2006-02-06 - Non-Final Action Written

2006-01-11 - Teas/Email Correspondence Entered

2005-12-23 - Communication received from applicant

2005-12-23 - TEAS Response to Office Action Received

2005-07-01 - Non-final action e-mailed

2005-07-01 - Non-Final Action Written

2005-05-16 - Assigned To Examiner

2005-05-15 - Assigned To Examiner

2005-03-14 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mark H. Tidman

Correspondent

Mark Tidman

Baker & Hostetler LLP

Washington Square 1050 Connecticut Aven

ue N.W. Suite 1100

Washington, DC 20036

Phone Number: 202.861.1500

Fax Number: 202.861.1783

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

This page was generated by the TARR system on 2008-09-23 15:01:25 ET

Serial Number: 78632210 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

METRO CASH&CARRY

(words only): METRO CASH&CARRY

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2008-04-22

Filing Date: 2005-05-18

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 107

Attorney Assigned:
ALTREE NICHOLAS

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-09-18

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MIP METRO Group Intellectual Property GmbH & Co. KG
Metro-Strasse 1
40235 Duesseldorf
Fed Rep Germany
Legal Entity Type: GmbH & Co. KG
State or Country Where Organized: Fed Rep Germany

GOODS AND/OR SERVICES

International Class: 035
Class Status: Active
Retail store services, wholesale stores and distributorships, all featuring food and general merchandise
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Disclaimer: "CASH & CARRY"

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.

- 2008-05-07 - Attorney Revoked And/Or Appointed
- 2008-05-07 - TEAS Revoke/Appoint Attorney Received
- 2008-04-22 - Opposition instituted for Proceeding
- 2008-04-21 - Opposition instituted for Proceeding
- 2007-11-20 - Extension Of Time To Oppose Received
- 2007-10-23 - Published for opposition
- 2007-10-03 - Notice of publication
- 2007-09-18 - Law Office Publication Review Completed
- 2007-09-17 - Assigned To LIE

2007-08-13 - Ex parte appeal terminated

2007-08-08 - Approved for Pub - Principal Register (Initial exam)

2007-02-08 - LETTER OF SUSPENSION E-MAILED

2007-02-08 - Suspension Letter Written

2007-01-18 - TEAS Response to Office Action Received

2007-01-18 - Ex parte appeal - Instituted

2007-01-18 - Jurisdiction Restored To Examining Attorney

2007-01-18 - EXPARTE APPEAL RECEIVED AT TTAB

2006-07-18 - Final refusal e-mailed

2006-07-18 - Final Refusal Written

2006-06-23 - Teas/Email Correspondence Entered

2006-06-13 - Communication received from applicant

2006-06-13 - TEAS Response to Office Action Received

2006-05-08 - TEAS Change Of Correspondence Received

2005-12-13 - Non-final action e-mailed

2005-12-13 - Non-Final Action Written

2005-12-13 - Assigned To Examiner

2005-05-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Mark H. Tidman

Correspondent

MARK TIDMAN

BAKER & HOSTETLER

1050 CONNECTICUT AVENUE, N.W.SUITE 1100

WASHINGTON, DC 20036

Phone Number: 202.861.1500

Fax Number: 202.861.1783

Domestic Representative

Katrin Zuehlke

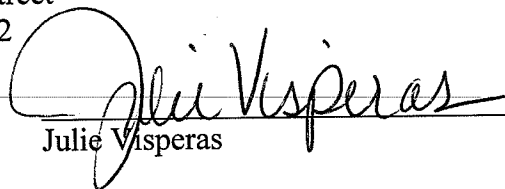
Phone Number: 212 839 7366

Fax Number: 212 839 5599

CERTIFICATE OF SERVICE

I hereby certify that on the 23rd day of September 2008, a true copy of the Notice of Opposition was served on counsel for Applicant via U.S. first-class mail, postage prepaid to:

Jayne C. Hunter
McGuire Woods
BOX 26
201 North Tyson Street
Charlotte NC 28202


Julie Visperas