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

Proceeding	91186573
Party	Defendant CHW, LLC
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Attachments	ANSWER TO OPP 91186573.pdf ( 5 pages )(98400 bytes )

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

MIP METRO Group Intellectual Property GmbH & Co. KG	) ) ) )
Opposer,	)Opposition No:91186573
v.	)Serial No.: 77/227989
CHW, LLC	)Mark: IT'S FASHION METRO
Applicant	) ) ) ) )

**ANSWER TO NOTICE OF OPPOSITION**

Applicant, CHW, LLC ("CHW"), by and through its undersigned counsel, hereby answers the Notice of Opposition filed by MIP METRO Group Intellectual Property GmbH & Co. KG ("MIP METRO" or "Opposer") as to the mark IT'S FASHION METRO (stylized), Serial No. 77/227989, published for opposition on June 10, 2008, as follows:

1. The allegations contained in Paragraph 1 are admitted upon information and belief.
2. CHW admits that MIP METRO is the owner of U.S. Trademark Serial Number 78/581586 for the mark METRO and DESIGN and U.S. Trademark Serial Number 78/632210 for the mark METRO CASH & CARRY. The descriptions of services for these applications are in writing and speak for themselves. Except as expressly admitted, the allegations of Paragraph 2 are denied.

3. CHW admits that Opposer filed an application for METRO CASH & CARRY on May 18, 2005, and that CHW filed an application for IT'S FASHION METRO (stylized) on July 12, 2007. Except as expressly admitted, the allegations of Paragraph 3 are denied.
4. The allegations in Paragraph 4 are denied.
5. The allegations in Paragraph 5 are denied.
6. The allegations in Paragraph 6 are denied.
7. The allegations in Paragraph 7 are denied.
8. The allegations in Paragraph 8 are denied.
9. CHW admits that if its mark IT'S FASHION METRO (stylized) is granted registration, it will obtain a *prima facie* exclusive right to the use of the mark. Except as expressly admitted, the allegations of Paragraph 9 are denied.

#### **AFFIRMATIVE DEFENSES**

1. This Notice of Opposition fails to state a claim upon which relief can be granted.
2. There is no likelihood of confusion, mistake, or deception between Opposer's pleaded marks and Applicant's IT'S FASHION METRO (stylized) mark because the marks are facially dissimilar in appearance, sound, connotation, and commercial impression.

3. There is no likelihood of confusion, mistake, or deception between Opposer's pleaded marks and Applicant's IT'S FASHION METRO (stylized) mark because Applicant's IT'S FASHION METRO(stylized) mark is inherently distinctive.

4. There is no likelihood of confusion, mistake, or deception between Opposer's pleaded marks and Applicant's IT'S FASHION METRO (stylized) mark because the goods and services to be associated with Applicant's IT'S FASHION METRO (stylized) mark, on the one hand, and the goods and services to be associated with Opposer's pleaded marks, on the other hand, are substantially different, the consumers to whom they will be offered are substantially different, and the channels of trade in which they will be offered are substantially different.

5. There is no likelihood of confusion, mistake, or deception between Opposer's pleaded marks and Applicant's IT'S FASHION METRO (stylized) mark because Applicant's IT'S FASHION METRO (stylized) mark is part of a family of marks, all in the area of retail goods and services related to clothing and accessories, including IT'S FASHION METRO (stylized)(Serial No. 77227963); IT'S NEW. IT'S NOW. (Registration No. 3247571) and IT'S (Serial No. 77062130) and IT'S FASHION!, (Registration No. 1788619, all owned by The Cato Corporation and/or its subsidiary CHW.

6. There is no likelihood of confusion, mistake, or deception between Opposer's pleaded marks and Applicant's IT'S FASHION METRO (stylized) mark because there exists, both on the Principal Register and in common law usage throughout the United States, an extremely crowded field of marks consisting of or incorporating the word METRO in many classes of retail goods and services, including without limitation,

International Class 35. In light of the resulting inherent weakness of the term METRO, a heightened level of similarity between marks featuring that term and the goods and services associated with them is required to find a likelihood of confusion, mistake, or deception, and such heightened similarity does not exist between Opposer's pleaded marks and Applicant's IT'S FASHION METRO (stylized) mark.

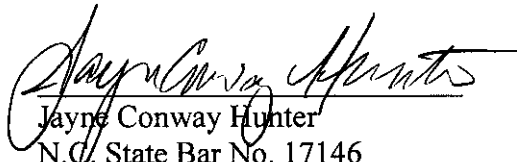
7. Opposer has no basis to oppose the registration of Applicant's IT'S FASHION METRO (stylized) mark, as Opposer filed its applications for the pleaded marks on the basis of intent to use. As the registrations for Opposer's pleaded marks have not issued and no evidence of use has been submitted and accepted at the U.S. Patent and Trademark Office, any rights of priority by way of constructive use claimed by Opposer have not vested and cannot be asserted against CHW.

8. Applicant denies that either Opposer or consumers of Opposer's goods and services have been, or will be, injured in any manner whatsoever by registration of Applicant's IT'S FASHION METRO (stylized) mark, denies that Opposer is entitled to any of the relief requested in the Notice of Opposition, and calls for strict proof of all of Opposer's allegations against it.

9. Applicant reserves the right to assert and rely on all other affirmative defenses that may be developed in the course of discovery.

WHEREFORE, Applicant CHW respectfully prays that the Notice of Opposition be dismissed with prejudice, that CHW's application to register the IT'S FASHION METRO (stylized) mark be allowed, and that, upon submission of satisfactory proof of use, registration of Applicant's IT'S FASHION METRO (stylized) mark be granted.

This the 3<sup>rd</sup> day of November, 2008.

  
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