

ESTTA Tracking number: **ESTTA295363**

Filing date: **07/15/2009**

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	Arcadia Group Brands Limited
Granted to Date of previous extension	07/15/2009
Address	Colegrave House70 Berners Street London, W1T 3NL UNITED KINGDOM
Attorney information	Floyd A. Mandell Katten Muchin Rosenman LLP 525 W. Monroe Street Chicago, IL 60661 UNITED STATES floyd.mandell@kattenlaw.com, william.dorsey@kattenlaw.com, cathay.smith@kattenlaw.com

Applicant Information

Application No	79054176	Publication date	03/17/2009
Opposition Filing Date	07/15/2009	Opposition Period Ends	07/15/2009
International Registration No.	0742982	International Registration Date	07/28/2000
Applicant	Studio Moderna SA Via Pretorio 22 Lugano, CH6900 SWITZERLAND		

Goods/Services Affected by Opposition

Class 038. All goods and services in the class are opposed, namely: Transmission of messages by electronic means, in particular by radio, television and computer networks
Class 039. All goods and services in the class are opposed, namely: Delivery of goods

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration	3237860	Application Date	12/02/2002
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No.			
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. Registration No.	3524208	Application Date	05/17/2005
Registration Date	10/28/2008	Foreign Priority Date	NONE
Word Mark	TOP SHOP		
Design Mark	<h1>TOP SHOP</h1>		
Description of Mark	NONE		
Goods/Services	Class 014. First use: Jewelry, namely, necklaces, rings, earrings, bracelets, bangles and pendants		

U.S. Registration No.	3524207	Application Date	05/17/2005
Registration Date	10/28/2008	Foreign Priority Date	NONE
Word Mark	TOP SHOP		
Design Mark	<h1>TOP SHOP</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: Sunglasses and accessories for sunglasses, namely, neck cords which restrain		

	sunglasses from movement on a wearer, and parts for the above goods
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U.S. Registration No.	3552730	Application Date	10/11/2007
Registration Date	12/30/2008	Foreign Priority Date	NONE
Word Mark	TOPSHOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2006/11/30 First Use In Commerce: 2006/11/30 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		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	TOPSHOP		
Goods/Services	Packaging and delivery of goods; transmission of electronic messages.		

Related Proceedings	Consolidated Opposition No. 91169226 and Cancellation No. 92049146; Opposition No. 91190681; and Opposition No. 91190739.
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Attachments	78631857#TMSN.jpeg (1 page)(bytes) 78631856#TMSN.jpeg (1 page)(bytes) 77301420#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (5 pages)(246965 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	/s/
Name	Cathay Y. N. Smith
Date	07/15/2009

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

Arcadia Group Brands Limited,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Mark: TOP SHOP & Design
)	
Studio Moderna SA,)	Serial No.: 79/054,176
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer, 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”) request for extension of protection of U.S. Application Serial No. 79/054,176 (the “Application”), published in the U.S. Patent and Trademark Office (“USPTO”) on March 17, 2009, for the mark TOP SHOP & Design in Classes 38 and 39. Applicant Studio Moderna has an address identified in the Application as Via Pretorio 22, 6900 Lugano, Switzerland. For the reasons set forth below, Arcadia hereby opposes the Application pursuant to 37 CFR §2.101(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 advertises and 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, and through the significant publicity it receives *via* the national and international press and the media, 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 trademark registrations for them in, among others, the following countries: Australia, Austria, Bahrain, Belgium, Brunei Darussalam, Bulgaria, China, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Gibraltar, Greece, Guernsey, Hong Kong, Hungary, Iceland, Indonesia, Ireland, Israel, Italy, Japan, Jersey, Jordan, Latvia, Lebanon, Lithuania, Luxembourg, Malta, Monaco, Morocco, Netherlands, New Zealand, Peru, Philippines, Poland, Portugal, Qatar, Republic of Korea, Romania, Russian Federation, San Marino, Saudi Arabia, Serbia, Singapore, Slovakia, Slovenia, South Africa, Spain, Sweden, Switzerland, Taiwan, Thailand, Tunisia, Turkey, Ukraine, 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."

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, issued December 21, 1992.

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.

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."

8. Beginning no later than 1998, *via* its websites www.topshop.co.uk and www.topshop.com, Arcadia has offered retail services selling clothing, accessories, and other goods in the United States under its TOPSHOP name and mark.^{1/}

9. Consumers in the U.S. have the option of shopping for and purchasing goods at Arcadia's TOPSHOP store, over the telephone, or from Arcadia's websites. When a customer purchases goods from Arcadia over the phone or through its website, the goods are packaged at Arcadia's warehouse, and then delivered to the customer in packages marked with Arcadia's TOPSHOP mark to the customer's shipping address.

10. Arcadia further communicates with consumers by electronic means, such as transmission of e-mails, to update consumers on the latest news on TOPSHOP's collections, events and promotions, to confirm orders/shipments of goods, and to reply to customer inquiries. All communications are sent from "TOPSHOP" and display Arcadia's TOPSHOP mark.

11. Applicant filed its 66(a) request to extend protection on TOP SHOP & Design in the United States on November 22, 2007 for "[d]elivery of goods" in International Class 39, and "[t]ransmission of messages by electronic means, in particular by radio, television and computer networks" in International Class 38.

12. Arcadia began using TOPSHOP and its TOPSHOP Family of Marks in the United States almost ten years prior to Applicant's filing date of its extension of protection in the United States. Arcadia also began packaging and delivering packages labeled with Arcadia's TOPSHOP mark in the United States and transmitting e-mail messages to consumers in the United States well before Studio Moderna's date of filing its extension of protection in the United States. *See* 37 CFR § 7.27.

13. Applicant's TOP SHOP & Design mark in the Application will cause dilution of the distinctive quality of Arcadia's TOPSHOP Family of Marks, in violation of § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), with consequent damage to Arcadia and the public.

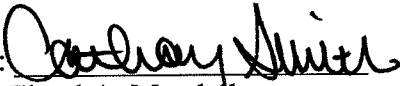
14. Applicant's services offered under the TOP SHOP & Design mark would be so closely related to the services offered by Arcadia under its TOPSHOP Family of Marks as to be likely to cause confusion, mistake, or deception in the minds of the purchasing public as to the source of origin of Applicant's services, in view of Arcadia's long prior use of its TOPSHOP Family of Marks and well developed secondary meaning therein, in violation of §2(d) of the Lanham Act, 15 U.S.C. §1052(d), with consequent damage to Arcadia and the public.

^{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.

WHEREFORE, Arcadia respectfully requests that the request to extend protection in the United States of the mark shown in U.S. Trademark Application Serial No. 79/054,176 be refused registration and that this Opposition be sustained.

Dated: July 15, 2009

Respectfully submitted,

By: 

Floyd A. Mandell

William J. Dorsey

Cathay Y. N. Smith

KATTEN MUCHIN ROSENMAN LLP

Attorneys for Arcadia

525 West Monroe Street

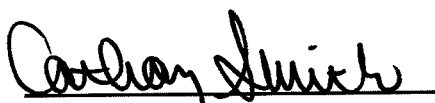
Chicago, Illinois 60661

(312) 902-5200

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and complete copy of the Notice of Opposition regarding Serial No. 79/054,176 to be served upon Applicant's attorney of record, Mr. Mitchell P. Brook, by mailing said copy on July 15, 2009, *via* First Class Mail, postage prepaid to:

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


Cathay Y. N. Smith