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

Proceeding	91191087
Party	Defendant Studio Moderna SA
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Date	08/26/2009
Attachments	Answer -- Opp No 91191087.pdf (6 pages)(140317 bytes)

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

In the Matter of Application No. 79/054,176
TOP SHOP (and design)
International Classes: 38 and 39
Published in the *Official Gazette*: March 17, 2009

Arcadia Group Brands Ltd.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91191087
)	
Studio Moderna SA,)	
)	
Applicant.)	
_____)	

Trademark Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1451
Alexandria, Virginia 22313-1451

**ANSWER BY APPLICANT
STUDIO MODERNA SA
TO NOTICE OF OPPOSITION**

Applicant Studio Moderna SA (“Studio Moderna” or “Applicant”) hereby answers the Notice of Opposition filed by Arcadia Group Brands Ltd. (“Arcadia” or “Opposer”) as follows, wherein numbered paragraphs correspond to like numbered paragraphs in the Notice of Opposition.

As to an initial unnumbered paragraph, Applicant acknowledges Opposer’s representation as to its address and incorporation but has insufficient information upon which to form a belief as to the truth of the representations and therefore denies the same. Applicant admits that it has an address in Lugano, Switzerland (currently Via Ferruccio Pelli 13, 6900 Lugano, Switzerland). Applicant

denies that Opposer has been, or is likely to be damaged by the registration of Application Serial No. 79/054,176 for Applicant's mark TOP SHOP (and design).

1. Applicant denies that the "Topshop" stores, web sites or products are "internationally renowned." Applicant denies that consumers in the United States and worldwide "have long had familiarity" with Opposer's "Topshop" marks. Applicant denies that consumers in the United States and worldwide associate "Topshop" with Opposer. Applicant denies that Opposer has used "Topshop" consistently in the United States since 1998. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 1 and therefore denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 and therefore denies the same.

3. Applicant denies that all of Opposer's Topshop names and marks are valid. Applicant denies that all of Opposer's Topshop names and marks cover retail store services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 3 and therefore denies the same.

4. Applicant admits that U.S. Registration No. 3,237,860 lists Arcadia Group Brands Limited as the Registrant of Topshop in International Class 25 and that the remaining recital of that document is as set forth therein.

5. Applicant admits that U.S. Registration No. 3,524,208 lists Arcadia Group Brands Limited as the Registrant of Top Shop in International Class 14 and that the remaining recital of that document is as set forth therein. Applicant denies that Opposer's mark registered as U.S. Registration No. 3,524,208 is entitled to priority based upon U.K. Reg. No. 1,522,280.

6. Applicant admits that U.S. Registration No. 3,524,207 lists Arcadia Group Brands Limited as the Registrant of Top Shop in International Class 9 and that the remaining recital of that document is as set forth therein. Applicant denies that Opposer's mark registered as U.S. Registration No. 3,524,207 is entitled to priority based upon U.K. Reg. No. 1,522,759.

7. Applicant admits that U.S. Registration No. 3,552,730 lists Arcadia Group Brands Limited as the Registrant of Topshop in International Class 18 and that the remaining recital of that document is as set forth therein.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 8 and therefore denies the same. As to footnote 1 on page 3 of the Notice of Opposition, Applicant denies that Arcadia had a Topshop store in the United States in 2004. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in footnote 1 and therefore denies the same.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 9 and therefore denies the same.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 10 and therefore denies the same.

11. Applicant admits that it filed Application Serial No. 79/054,176 on November 22, 2007 seeking registration of the mark TOP SHOP (and design) in Classes 16, 35, 38, 39, 41 and 42 via a request to extend protection under 15 U.S.C. 1141f(a) (Section 66(a)) ("176 Application"). Applicant admits that it filed a Request to Divide the '176 Application on August 8, 2008 to divide out Classes 35, 41 and 42 into a new child application, which became Application Serial No. 79/975,055. Applicant admits the recitation of services recited therein.

12. Applicant denies that Opposer owns a Topshop “family of marks.” Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 12 and therefore denies the same.

13. Applicant denies the allegations of paragraph 13.

14. Applicant denies the allegations of paragraph 14.

As to a final unnumbered paragraph, Applicant acknowledges Opposer’s request but denies that U.S. Application Serial No. 79/054,176 should be refused registration.

AFFIRMATIVE DEFENSES

14. Opposer’s requested relief should be denied based upon failure to state a claim.

15. Opposer’s requested relief should be denied as its claims are barred due to unclean hands.

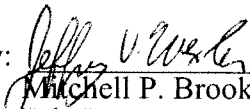
16. For the reasons stated in the Counterclaims filed by Opposer on July 27, 2009 in Opposition No. 91190681, Opposer may not base a claim of priority on U.S. Registration No. 3,237,860. Therefore, Opposer’s requested relief should be denied for lack of priority over Applicant’s pre-existing TOP SHOP and TOP SHOP TV registrations. (Pursuant to 37 C.F.R. §§ 2.106(b)(2)(i) and 2.114(b)(2)(i), Applicant is not filing duplicative Counterclaims for cancellation in response to this Opposition.)

WHEREFORE, having fully answered, Applicant Studio Moderna requests that the present Notice of Opposition be dismissed with prejudice; and that Studio Moderna be granted registration for the mark applied for.

Please address all correspondence to Mitchell P. Brook, Esq., c/o Luce, Forward, Hamilton & Scripps LLP, 11988 El Camino Real, Suite 200, San Diego, California 92130.

Dated: August 26, 2009

Respectfully submitted,

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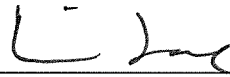
Attorneys for Applicant/Respondent and
Counterclaimant Studio Moderna SA

CERTIFICATE OF SERVICE

Arcadia Group Brands Ltd. v. Studio Moderna SA
U.S. Patent and Trademark Office
Opposition No. 91191087

I hereby certify that a true and correct copy of the foregoing **ANSWER BY APPLICANT STUDIO MODERNA SA TO NOTICE OF OPPOSITION** was served on counsel for Opposer by first class mail, postage prepaid, this 26th day of August 2009 addressed as follows:

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