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

Proceeding	91214657
Party	Plaintiff Top Shop/Top Man Limited
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

TOP SHOP/TOP MAN LIMITED,

Opposer,

v.

JILL CARD and RICHARD CARD,

Applicants.

Opposition No.: 91214657

OPPOSER’S RESPONSE IN OPPOSITION TO APPLICANT’S MOTION TO DISMISS

Opposer Top Shop/Top Man Limited (“Opposer”) submits this response in opposition to the Motion to Dismiss filed by Applicants Jill Card and Richard Card (“Applicants”) on April 4, 2014 (the “Motion”).

Applicants seek to dismiss Opposer’s Notice of Opposition based on purported pleading deficiencies that are unsubstantiated. As demonstrated below, Opposer’s likelihood of confusion and false suggestion of a connection claims not only meet this Board’s “simplified notice pleading” standard, but exceed it as Opposer has pled detailed facts that (when proven) would establish both claims.

I. APPLICABLE PLEADING STANDARDS

In determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 (2007). “Under the simplified notice pleading of the Federal Rules of Civil Procedure, the allegations of a complaint should be construed liberally so as to do substantial justice.” *Id.* (citations omitted). The pleading must be examined in its entirety to determine whether it contains any allegations which, if proven, would entitle plaintiff to the

relief sought. *Id.* Dismissal for insufficiency is appropriate only if it appears certain that opposer is entitled to no relief under any set of facts which could be proved in support of its claim. *Id.*

As shown below, the detailed allegations in the Notice of Opposition easily satisfy these pleading standards.

A. Opposer has Sufficiently Pled its Prior Use in Commerce for Purposes of Supporting its Likelihood of Confusion Claim (Count I)

As to Opposer's likelihood of confusion claim (under 15 U.S.C. § 1052(d)), Applicant argues that the claim should be dismissed solely because Opposer purportedly failed to allege that it "has sold goods or services under the claimed marks in interstate commerce prior to Applicant's priority date." (Mot., at 3). Applicant's argument exudes form over substance. *See, e.g., Fair Indigo*, 85 U.S.P.Q.2d at 1538 ("Applicant has confused the requirements for pleading priority . . . with the requirements for proving priority at trial or on summary judgment . . . , *the purpose of notice pleading is to obviate the need to allege particular "magic words."*) (emphasis added). In fact, the Notice of Opposition specifically alleges that "Opposer's rights in the TOPSHOP Marks arose prior to any alleged rights of Applicants in Applicants' Mark" (Opposition ¶ 6), and pleads the following facts that (if proven) would establish Opposer's use of the mark in commerce prior to Applicant's claimed priority date:

- Opposer is the owner of the famous TOPSHOP and TOP SHOP marks (the "TOPSHOP Marks") in connection with clothing, footwear, jewelry, sunglasses, accessories, luggage, bags, soaps and detergents, household furniture and textile goods, retail store and online retail store services, and other goods (Opposition ¶ 1);
- Opposer began using its TOPSHOP Marks in the United States no later than 1998, and continues to use such marks (Opposition ¶ 1);
- On or about April 2, 2009, the first stand-alone TOPSHOP store was opened in the United States and there are now TOPSHOP retail stores in New York, Los Angeles, Chicago and Las Vegas (Opposition ¶ 1); and
- Applicants filed the Application on December 7, 2012, claiming a first use date of August 24, 2009 (Opposition ¶ 5).

Each of the above allegations is incorporated by reference into Count I (Opposition ¶ 8), the likelihood of confusion claim.

Additionally, Opposer has identified specific trademark registrations it owns for the TOPSHOP Marks (Opposition ¶ 4), which are shown (along with the associated first use dates) on the Notice of Opposition's cover pages. *See, e.g.*, U.S. Registration No. 3807075 (identifying first use in commerce as August 2001); U.S. Registration No. 3552730 (identifying first use in commerce as November 30, 2006); U.S. Registration No. 3655345 (identifying first use in commerce as April 2, 2009); and U.S. Registration No. 3673939 (identifying first use in commerce as September 9, 2008).

Thus, Opposer has alleged facts that, if proven, would establish Opposer's use of its TOPSHOP Marks in commerce prior to Applicant's claimed date of first use. Applicant's Motion raises no other issue with the sufficiency of Opposer's likelihood of confusion claim and, therefore, Applicant's motion to dismiss Count I should be denied.

B. Opposer has Sufficiently Pled Facts that Would establish a False Suggestion of a Connection Claim

As to Opposer's false suggestion of a connection claim (under 15 U.S.C. § 1052(a)), Applicant argues that the claim should be dismissed because Opposer purportedly failed to allege that: (i) Applicant's mark is a close approximation of Opposer's previously used name or identity; (ii) Applicant's mark points uniquely and unmistakably to Opposer; and (iii) Opposer's name is sufficiently famous that a connection with Opposer would be presumed when Applicant's mark is used in connection with Applicant's services. (Mot. at 3-4). While Opposer acknowledges that Applicant has recited a portion of the test for evaluating whether a false suggestion of a connection claim has been *established*, there is no requirement that these specific words be parroted in the pleading in order to properly state a claim under Section 2(a). In fact,

the case Applicant cites for this test, *In re Peter S. Herrick, P.A.*, 91 U.S.P.Q.2d 1505, did not address whether a Section 2(a) claim had been properly pleaded, but whether it had been properly *established* by an examining attorney who refused to register a mark on the basis of Section 2(a). As such, Applicant is improperly holding Opposer to a burden of proof standard, rather than a burden of pleading standard. *See Fair Indigo*, 85 U.S.P.Q.2d at 1538 (“The purpose of a Rule 12(b)(6) motion is to challenge “the legal theory of the complaint, not the sufficiency of any evidence that might be adduced”).

The Notice of Opposition contains the following allegations supporting the false suggestion of a connection claim:

- Opposer is the owner of the famous TOPSHOP marks, which Opposer has used in the United States since 1998 (Opposition ¶ 1);
- Opposer’s TOPSHOP marks have been featured in magazines and journals such as Lucky, US Weekly, InStyle, Vogue, People, the New York Times, and the Wall Street Journal, and clothing under the TOPSHOP brand 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 (Opposition ¶ 2);
- Through Opposer’s extensive sales, advertising and promotion activities, and through the significant publicity the TOPSHOP brand receives *via* the national and international press and the media, consumers worldwide, including in the United States, have long had familiarity with Opposer’s TOPSHOP Marks and associate the TOPSHOP brand for clothing, clothing sales, and fashion exclusively with Opposer (Opposition ¶ 1);
- Applicants’ Mark wholly incorporates Opposer’s TOPSHOP Marks and the TOPSHOP Marks are a dominant component of Applicants’ Mark. Therefore, Applicants’ mark is similar in sound and appearance to Opposer’s TOPSHOP Marks and creates a similar commercial impression (Opposition ¶ 8);
- Opposer uses its mark in connection with clothing, accessories and retail store services (as well as other goods) (Opposition ¶ 1) and Applicant seeks to register its mark for “Retail store services featuring clothing and clothing accessories (Opposition ¶ 5); and
- Opposer’s rights in the TOPSHOP Marks arose prior to any alleged rights of Applicants in Applicants’ Mark (Opposition ¶ 6);

Each of the above allegations is incorporated by reference into Count II (Opposition ¶ 14), as support for the allegation that “Applicants’ Mark so resembles Opposer’s TOPSHOP Marks that when applied to Applicants’ Services, Applicants’ Mark is likely to falsely suggest a connection with Opposer” (Opposition ¶ 15).

As shown above, Opposer has pled facts demonstrating that (i) Applicant’s mark is a close approximation of Opposer’s previously used name or identity; (ii) Applicant’s mark points uniquely and unmistakably to Opposer; and (iii) Opposer’s name is sufficiently famous that a connection with Opposer would be presumed when Applicant’s mark is used in connection with Applicant’s services. Applicant’s Motion raises no other issue with the sufficiency of Opposer’s false suggestion of a connection claim and, therefore, Applicant’s motion to dismiss Count II should also be denied.

II. CONCLUSION

For the reasons stated above, Opposer respectfully requests that Applicant’s Motion to Dismiss be denied in its entirety.

Dated: December 18, 2014

Respectfully submitted,

/s/ Carolyn M. Passen
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CERTIFICATE OF SERVICE

I, Carolyn M. Passen, an attorney, hereby certify that on today's date I caused a copy of the foregoing OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS to be served upon Applicants' counsel of record via First Class Mail and e-mail, at the following address:

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Dated: December 18, 2014

/Carolyn M. Passen/