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

Proceeding	92064588
Party	Defendant Uncommon LLC
Correspondence Address	UNCOMMON LLC 1556 WEST CARROLL, SUITE 202 CHICAGO, IL 60607 UNITED STATES
Submission	Motion to Suspend for Civil Action
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Date	10/19/2016
Attachments	002009 W1049 - Motion to Suspend v2.pdf(120301 bytes) Ex A - Complaint.pdf(206629 bytes) Ex B - Spigen Answer Affirmative Defenses and Counterclaim.pdf(333634 bytes) Ex C - Spigen 1st Amended Answer and Counterclaim.pdf(85315 bytes) Ex D - Order.pdf(21375 bytes)

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

IN THE MATTER OF TRADEMARK REGISTRATION NO. 4,338,254
TRADEMARK: CAPSULE
REGISTERED: May 21, 2013

Spigen, Inc. and Spigen Korea Co., Ltd.)	
)	
Petitioners,)	
)	
v.)	Cancellation No.
)	92064588
Uncommon, LLC)	
)	
Registrant.)	
)	

**MOTION TO SUSPEND PROCEEDINGS PENDING
FINAL RESOLUTION OF PENDING FEDERAL COURT LITIGATION**

Registrant Uncommon, LLC (“Registrant”) respectfully submits this motion to suspend these proceedings pending resolution of Civil Action No. 1:15-cv-10897 currently pending in the United States District Court for the Northern District of Illinois (the “Civil Action”). The Civil Action was filed December 4, 2015. The motion should be granted because the Civil Action is potentially dispositive of the registrability and priority of use issues presently before the Board.

FACTS

This cancellation action purportedly commenced on October 11, 2016, when Petitioners Spigen, Inc. and Spigen Korea Co., Ltd. (collectively, “Petitioners”) filed their Petition for Cancellation of Registration No. 4,338,254. However, despite the certificate of service included in the Petition, Registrant has not been served with a copy of the Petition. Nevertheless, at the time Petitioners appear to have filed their cancellation petition, they had already received the complaint in the Civil Action charging Petitioner Spigen, Inc. with infringement of Registrant’s

trademark rights in the CAPSULE mark which is the subject of Registration No. 4,338,254. *See* Exhibit A, Complaint as filed on December 4, 2015 (without exhibits). In particular, Spigen, Inc. (a wholly owned subsidiary of Spigen Korea Co., Ltd., *see* Petition to Cancel at ¶3) was served with the complaint and thereafter informed its parent Spigen Korea Co., Ltd. Petitioners even admit the preexisting nature of the Civil Action in ¶13 and ¶20 of the Petition to Cancel.

On February 12, 2016, Petitioner Spigen, Inc. filed its initial Answer, Affirmative Defenses, and Counterclaims in the Civil Action, asserting *inter alia* that Registrant's trademark Registration No. 4,338,254 is merely descriptive and/or not distinctive. *See* Exhibit B, a copy of the filed answer without exhibits, at p.16, ¶39; p. 17, ¶51-52. Spigen, Inc.'s Affirmative Defenses also assert that Spigen, Inc. began using the CAPSULE mark prior to Registrant. *Id.* p.8 (Second Affirmative Defense). On March 25, 2016, Petitioner Spigen, Inc. filed its First Amended Answer and Counterclaims again alleging that Registration No. 4,338,254 is merely descriptive and/or not distinctive and that Petitioner Spigen is a prior user of the CAPSULE mark. *See* Exhibit C, p. 16, ¶39. Finally, the initial and First Amended Counterclaims each requests that the District Court declare that Registration No. 4,338,254 be cancelled and removed from the Principal Register. *See* Exhibit B at p. 12-16; Exhibit C at p.11-18. These allegations and requested relief encompass the entire grounds presented in and relief requested by Petitioners, in their Petition to Cancel.

ARGUMENT

This Board may suspend proceedings when it becomes aware of other relevant pending litigation. In particular, 37 C.F.R. § 2.117 provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action . . .

The initial and First Amended Answer, Affirmative Defenses and Counterclaims filed by Petitioner Spigen, Inc. seek to resolve issues of validity of U.S. Registration No. 4,338,254 inasmuch as Spigen, Inc. claims that U.S. Registration No. 4,338, 254 is either merely descriptive and/or lacks distinctiveness. Likewise, the initial and First Amended Answer, Affirmative Defenses and Counterclaims filed by Petitioner Spigen, Inc. seek to resolve the issues of priority of uses inasmuch as Spigen, Inc. asserts to be a prior user of the CAPSULE mark. Should Spigen, Inc. be successful in the Counterclaims filed in the Civil Action, the District Court has been asked to cancel U.S. Registration No. 4,338,254. Thus, the Civil Action not only bears on the present proceeding, but has the potential to dispose altogether of any need to continue this cancellation proceeding. Suspending this proceeding will conserve the resources of the Board and the parties by avoiding potentially unnecessary administrative litigation while a controlling civil action is pending.

Additionally, the parties have already exchanged a great deal of discovery in the Civil Action. Written discovery has been completed, depositions have been taken and the parties even held a settlement conference with the assigned Magistrate Judge. Discovery is scheduled to end in 8 days (October 26, 2016) with only a single continued Rule 30(b)(6) deposition of Petitioner Spigen, Inc.'s corporate representative to be completed in the meantime. In fact, Petitioner Spigen Inc. sought to extend fact discovery—due on October 26—during a hearing held on October 18, 2016. The Court denied such request in open court. (*See* Dkt. No. 91, attached hereto as Exhibit D).

While Petitioner Spigen Korea, Co., Ltd. is not a direct party to the Civil Action, its interests are represented in that action because it is in privity with Petitioner/Defendant Spigen, Inc. as Spigen, Inc.'s parent corporation. *See* Petition to Cancel at ¶3. Accordingly, Petitioner

Spigen Korea, Co., Ltd. has participated in discovery in the Civil Action. Additionally, the only domestic interests Spigen Korea, Co., Ltd. asserts in the Cancellation Petition are the interests of distribution by its wholly owned subsidiary Petitioner Spigen, Inc. (Defendant in the Civil Action). In fact, it is questionable whether Spigen Korea, Co., Ltd. even has standing to proceed as a petitioner in this proceeding. Notably, the Petition to Cancel only states that Spigen Korea, Co., Ltd. (a Republic of Korea corporation) manufactures the products distributed by Spigen in the United States. *See* Petition to Cancel, ¶4. It is Spigen, Inc. that allegedly uses any marks in the United States. *Id.* ¶5. There are no allegations that Spigen Korea, Co., Ltd. itself uses the trademarks at issue in the United States and the alleged damage to Petitioners stems from the Civil Action, to which Spigen Korea, Co., Ltd. is not a party. *Id.*, ¶¶13, 20.

CONCLUSION

For the foregoing reasons, Registrant respectfully requests that this Board enter an Order suspending this proceeding until the parties notify the Board of the final resolution of the pending Civil Action.

DATED: October 19, 2016

Respectfully submitted,

By: /Edward L. Bishop/

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CERTIFICATE OF SERVICE

This will certify that a true and accurate copy of the foregoing **MOTION TO SUSPEND PROCEEDINGS PENDING FINAL RESOLUTION OF PENDING FEDERAL COURT LITIGATION** has been served upon the following parties by electronic and first-class mail on October 19, 2016:

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/Edward L. Bishop/
Edward L. Bishop

EXHIBIT A

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

UNCOMMON, LLC,

Plaintiff,

v.

SPIGEN, INC.,

Defendant.

Case No.: _____

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff Uncommon, LLC (“Plaintiff” or “Uncommon”), by its attorneys, as and for its Complaint against Defendant Spigen, Inc. (“Defendant” or “Spigen”) alleges as follows:

NATURE OF THE CASE

1. This is a civil action for (1) trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114; (2) unfair competition in violation of the Lanham Act, 15 U.S.C. § 1125(a); and (3) unfair competition under Illinois common law. Uncommon brings this action to protect one of its most valuable assets, namely, the goodwill and consumer recognition associated with its trademarks; in particular, its CAPSULE trademark, which Uncommon has continuously used since 2009.

2. Uncommon owns a federal registration for its CAPSULE trademark. A true and correct copy of the federal trademark registration certificate (i.e., Reg. No. 4,338,354) for the CAPSULE trademark is attached hereto as Exhibit A (hereinafter the “CAPSULE trademark” or the “CAPSULE mark”).

PARTIES

3. Uncommon, LLC is a Delaware Limited Liability Company having its principal place of business at 2759 W. Lawrence Ave., Chicago, IL 60625.

4. On information and belief, Spigen, Inc. is a California Corporation having its principal place of business at 9975 Toledo Way, Suite 100, Irvine, CA 92618.

JURISDICTION AND VENUE

5. This Court has original subject matter jurisdiction over Plaintiff's Lanham Act claims, pursuant to 15 U.S.C. § 1121, 28 U.S.C. § 1331, and 28 U.S.C. § 1338(a). This Court has supplemental jurisdiction over Plaintiff's related state and common law claims under 28 U.S.C. § 1367.

6. This Court has personal jurisdiction over Defendant because Defendant is engaging in various activities within this State and this District, including offering for sale, selling, and distributing its accused products in this district. The consequences of Defendant's actions produce effects in and directly implicate this forum.

7. Venue is proper in this District under 28 U.S.C. § 1391(b)(2) because a substantial part of the events giving rise to this claim occurred within this District and because Defendant's acts of infringement are causing harm in this District.

FACTUAL BACKGROUND

Uncommon, LLC

8. Founded in 2009, Uncommon, LLC is a leading seller of protective cases for consumer electronic devices. In particular, Uncommon is well-known as a seller of smart phone and laptop protective cases featuring both ready-made and customizable graphical designs.

9. For example, customers can use Uncommon's website, www.getuncommon.com, to design their own smartphone, tablet, or laptop protective case using personal photographs or their own original artwork. Customers also have the option of purchasing pre-designed protective cases featuring, for example, artwork licensed from various artists.

10. Uncommon also markets and sells its protective cases through other channels, including directly through Apple, Inc. and in various retail locations run by Uncommon's licensees or distributors. Uncommon also markets and sells its protective cases on the internet at third party marketplaces such as Amazon.com and on the websites of Uncommon's licensees and distributors.

11. Through its marketing efforts, Uncommon has garnered a substantial following. Its protective cases have been featured in various media outlets and its cases have been personally used by many well-known celebrities.

12. Uncommon has also received favorable, unsolicited press coverage for its protective cases. Uncommon's protective cases have been featured, for example, on Elle Magazine's website ("Mother's Day Gift Guide 2013"), on Ebony Magazine's website ("The Best Gifts for Mama: Mother's Day Gift Guide 2013"), on Life & Style Weekly's website ("2013 Mother's Day Gift Guide"), on Teen Vogue's website ("35 Totally On-Trend Accessories"), in HOW Magazine's January 2013 issue, in Glamour Magazine's January 2013 issue, Essence Magazine's December 2012 issue, in Teen Vogue's December 2012 issue, and in Latitudes Magazine's November/December 2012 issue. *See* Exhibit B, printout of page from www.getuncommon.com listing press coverage.

13. Uncommon's products have also been featured in television media, including, for example, on WCIU Chicago's "You & Me This Morning" as part of a May 10, 2013 segment

about Mother's Day gifts and on a Fox 8 New Orleans' segment about Mother's Day Gifts in May 2013. *See* Exhibit B.

14. As part of its promotion and goodwill development, and in order to protect the source-identifying marks Uncommon has developed, Uncommon has applied for and received numerous active federal trademark registrations, including, but not limited to:

Mark	U.S. Reg. No.	Description of Goods/Services
"UN" 	4,002,977	IC 009: Carrying cases and bags designated for storage and transportation of consumer electronics, cellular phones, media players, laptop computers.
"WE PROVIDE THE CANVAS. YOU PROVIDE THE INSPIRATION."	3,917,885	IC 035: Retail and on-line retail store services featuring carrying cases or bags designed for storage and transportation of consumer electronics, cellular phones, media players, laptop computers, watches, musical instruments, toys, and sporting goods and accessories.
"DEFLECTOR"	4,090,969	IC 009: Carrying cases and bags designated for storage and transportation of consumer electronics, cellular phones, media players, laptop computers.
"CAPSULE"	4,338,254	IC 009: Cases specifically adapted for protection and storage of consumer electronics, namely, cellular phones and mobile media players
"FROSTED"	4,545,341	IC 009: Carrying cases and bags designed for protection, storage, and transportation of consumer electronics in the nature of cellular phones, media players, laptop computers
"GETUNCOMMON"	4,423,168	IC 009: Carrying cases and bags designed for storage and transportation of consumer electronics in the nature of cellular phones, media players and laptop computers
"PERMAFROST"	4,482,488	IC 009: Carrying cases and bags designed for storage, protection and transportation of consumer electronics in the nature of smart phones, cellular phones, media players and laptop computers.
"SAFETY"	4,569,306	IC 009: Cases for smart phones and tablet computers.

15. Through its significant marketing efforts, Uncommon also has attained common law rights in several unregistered marks.

The Capsule Mark

16. Among its many offerings, and long prior to the acts of Defendant complained of herein, Uncommon has promoted, marketed, and sold its protective cases in interstate commerce using the CAPSULE mark. The protective cases bearing the CAPSULE mark are currently available and actively being sold in configurations designed for the iPhone 5, iPhone 5s, iPhone 4, iPhone 4s, and the 4th Generation iPod Touch.

17. In an effort to promote its brand recognition and protect its valuable goodwill, Uncommon filed a trademark application for its CAPSULE mark on September 17, 2012, with a date of first use of December 16, 2009. The CAPSULE mark issued under Registration Number 4,338,254 on May 21, 2013 for “IC 009: Cases specifically adapted for protection and storage of consumer electronics, namely, cellular phones and mobile media players.” *See* Exhibit A.

18. Since 2009, Uncommon has continuously used its CAPSULE mark in interstate commerce in conjunction with the sale of its protective cases throughout the United States.

19. The protective cases utilizing the CAPSULE mark, like Uncommon’s other products, have received significant media attention. For example, the protective cases utilizing the CAPSULE mark were featured on Esquire.com’s list of “What to Get Her This Mother’s Day” in May of 2013. *See* Exhibit C.

20. Uncommon’s protective cases utilizing the CAPSULE mark were also featured on NBC’s Today Show as correspondent Sara Haines’ “favorite thing” on September 5, 2011. *See* Exhibit D.

21. The CAPSULE mark is distinctive.

22. As provided by 15 U.S.C. § 1115(a), Uncommon's federal registration of the CAPSULE mark serves as "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration."

Defendant's Infringing and Unfair Conduct

23. On information and belief, Defendant owns and operates a website at www.spigen.com, where it promotes and sells various protective cases for personal electronic devices.

24. Defendant is a direct competitor of Uncommon.

25. On information and belief, Defendant markets and sells its protective cases through various other retailers in the United States, both online and offline, including at Staples, Walmart, and Amazon stores or websites.

26. In particular, Defendant markets, promotes, offers for sale, and sells a "Capsule" protective case, which is available for several cellular phone models, including the iPhone 6, the iPhone 6s, the Samsung Galaxy S5, the Samsung Galaxy S6, and HTC One M9. *See* Exhibit E, printout of www.spigen.com search results for "Capsule".

27. Defendant's "Capsule" protective cases and Uncommon's protective cases utilizing the CAPSULE mark are marketed through the same channels and appear in close proximity when sold on the same websites.

28. For example, a search of "Capsule case" on Amazon.com yields results featuring both Uncommon's protective cases utilizing the CAPSULE mark and Defendant's "Capsule" protective cases. *See* Exhibit F, Amazon search printout. As shown in the attached search

printout, Uncommon's protective cases utilizing the CAPSULE mark are completely surrounded and pushed lower in the search results by Defendant's "Capsule" protective cases.

29. There is a strong likelihood that consumers will be confused into believing that Defendant's "Capsule" protective cases are Plaintiff's products or that they are authorized, endorsed, sponsored, or approved by Plaintiff.

30. Defendant's use of the word "Capsule" is an exact reproduction and copy of Plaintiff's CAPSULE mark.

31. On information and belief, Defendant has intentionally copied the CAPSULE mark in order to improperly and unfairly trade on the substantial goodwill that Plaintiff has achieved through its marketing efforts and years of customer satisfaction.

32. On information and belief, Defendant had actual knowledge of the existence of Uncommon's protective cases and use of the CAPSULE mark before Defendant first began using, offering to sell, selling its accused protective cases.

33. At no time has Uncommon authorized Defendant to use the CAPSULE mark.

34. Defendant filed an intent-to-use trademark application with the United States Patent and Trademark Office on November 25, 2014 for "AIR CAPSULE" in "IC 009: Cases for mobile phones; Cell phone cases; Clear protective covers specially adapted for personal electronic devices, namely, cell phones, personal digital assistants, tablet personal computers; Fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smartphones; Protective cases for smartphones; Protective covers and cases for cell phones, laptops and portable media players; Protective glasses." The application was assigned Serial No. 86,465,014 and is still pending registration.

35. Defendant filed a trademark application with the United States Patent and Trademark Office for “Capsule Solid” on October 5, 2015 for “CAPSULE SOLID” in “IC 009: Cases adapted for mobile phones; Cases for mobile phones; Cell phone backplates; Cell phone cases; Cell phone covers; Cell phone faceplates; Clear protective covers specially adapted for personal electronic devices, namely, cell phones, personal digital assistants, tablet personal computer; Fitted plastic films known as skins for covering and protecting electronic apparatus, namely, cell phones, tablet computers, mp3 players, smartphones; Protective cases for smartphones; Protective covers and cases for cell phones, laptops and portable media players; Protective covers for smartphones; Protective glasses.” The application lists a date of first use of February 2, 2015. The application was assigned Serial No. 86,778,356 and is still pending registration.

COUNT I
FEDERAL TRADEMARK INFRINGEMENT
(15 U.S.C. § 1114)

36. Plaintiff incorporates by reference Paragraphs 1 - 35 above as if restated herein in their entirety.

37. Defendants had actual and/or constructive knowledge of Uncommon’s rights in its federally registered CAPSULE mark at least as early as the date of its registration, May 21, 2013.

38. Defendant is using, in commerce, a reproduction or copy of Plaintiff’s registered CAPSULE mark.

39. Plaintiff has neither consented to nor authorized Defendant’s use of the CAPSULE mark.

40. Defendant's use of the CAPSULE mark is likely to cause confusion, mistake, or deception as to the source, sponsorship, or approval of Defendant's protective cases.

41. Defendant's unauthorized use of the CAPSULE mark constitutes a violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114(a).

42. The intentional nature of Defendant's unauthorized use of the CAPSULE mark renders this an exceptional case under 15 U.S.C. § 1117(a), justifying the imposition of treble damages and the award of Uncommon's fees and costs associated with bringing this action.

43. As a result of Defendant's above-outlined conduct, Uncommon has suffered and continues to suffer substantial damage and irreparable harm constituting an injury for which Uncommon has no adequate remedy at law. In particular, Uncommon will continue to suffer irreparable harm unless this Court enjoins Defendant's conduct. Specifically, such irreparable harm includes, but is not limited to, reputational harm amongst Uncommon's actual and potential customers, and erosion of market share.

COUNT II
UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN
(15 U.S.C. § 1125(a))

44. Plaintiff incorporates by reference Paragraphs 1 - 43 above as if restated here in their entirety.

45. Defendants had actual and/or constructive knowledge of Uncommon's rights in its federally registered CAPSULE mark at least as early as the date of its registration, May 21, 2013.

46. Plaintiff has neither consented to nor authorized Defendant's use of the CAPSULE mark.

47. Defendant's unauthorized use of the CAPSULE mark is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval by Uncommon of Defendant's protective cases.

48. Defendant's conduct constitutes a violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125(a)(1).

49. The intentional nature of Defendant's unauthorized use of the CAPSULE mark renders this an exceptional case under 15 U.S.C. § 1117(a), justifying the imposition of treble damages and the award of Uncommon's fees and costs associated with bringing this action.

50. As a result of Defendant's aforesaid conduct, Uncommon has suffered and continues to suffer substantial damage and irreparable harm constituting an injury for which Uncommon has no adequate remedy at law. In particular, Uncommon will continue to suffer irreparable harm unless this Court enjoins Defendant's conduct.

COUNT III
ILLINOIS COMMON LAW UNFAIR COMPETITION

51. Plaintiff incorporates by reference Paragraphs 1 - 50 above as if restated here in their entirety.

52. By marketing, advertising, and selling its "Capsule" protective cases, Defendant is acting with the purpose and intent to deceive consumers into believing that Defendant's protective case are made by Uncommon or are affiliated with or approved by Uncommon.

53. By marketing, advertising, and selling its "Capsule" protective case, Defendant intends to harm and is harming Plaintiff's business.

54. As a result of Defendant's unfairly competitive activities, Plaintiff has been damaged and will continue to be damaged unless Defendant is enjoined from using Plaintiff's CAPSULE mark.

55. Plaintiff is also entitled to recover money damages to compensate for Defendant's unfair conduct.

COUNT IV
CANCELLATION OF "AIR CAPSULE", SERIAL NO. 86/465,014
(15 U.S.C. § 1119)

56. Plaintiff incorporates by reference Paragraphs 1 - 55 above as if restated here in their entirety.

57. Defendant's pending registration for "AIR CAPSULE", Serial No. 86,465,014, consists of a mark which so resembles Plaintiff's CAPSULE mark as to likely, when used on or in connection with Defendant's goods or services, cause confusion, mistake, or deception.

58. Plaintiff has priority of rights for use of the term CAPSULE.

59. The continued existence and/or future existence of Defendant's registration for the term "AIR CAPSULE" is damaging or will damage Plaintiff.

60. Defendant's registration of the term "AIR CAPSULE" has caused, and continues to cause, irreparable injury and will continue to do so unless this Court orders cancellation of that application.

COUNT V
CANCELLATION OF "CAPSULE SOLID", SERIAL NO. 86/778,356
(15 U.S.C. § 1119)

61. Plaintiff incorporates by reference Paragraphs 1 - 60 above as if restated here in their entirety.

62. Defendant's pending registration for "CAPSULE SOLID", Serial No. 86,778,356, consists of a mark which so resembles Plaintiff's CAPSULE mark, as to likely, when used on or in connection with Defendant's goods or services, cause confusion, mistake, or deception.

63. Plaintiff has priority of rights for use of the term CAPSULE.

64. The continued existence and/or future existence of Defendant's registration for the term "CAPSULE SOLID" is damaging or will damage Plaintiff.

65. Defendant's registration of the term "CAPSULE SOLID" has caused, and continues to cause, irreparable injury and will continue to do so unless this Court orders cancellation of that application.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Uncommon, LLC respectfully seeks the following relief against Defendant Spigen, Inc.:

- A. Judgment that Defendant's conduct violates Plaintiff's federal trademark rights, in violation of 15 U.S.C. § 1114.
- B. Judgment that Defendant's conduct constitutes federal unfair competition in violation of 15 U.S.C. § 1125(a).
- C. Judgment that Defendant's conduct constitutes unfair competition under Illinois common law.
- D. Damages in an amount to be proven at trial, in the form of disgorgement of Defendant's profits, actual damages suffered by Plaintiff, and compensation for corrective advertising.
- E. Treble damages as a result of the willful nature of Defendant's conduct, in accordance with 15 U.S.C. § 1117.
- F. Plaintiff's attorneys' fees incurred in bringing this action, in accordance with 15 U.S.C. § 1117.
- G. A preliminary, mandatory, and permanent injunction enjoining, restraining and ordering Defendant, and its officers, agents, servants, attorneys, and other persons who are in active concert or participation with it:
 - 1. To cease using, selling, offering for sale, holding for sale, advertising, or promoting any goods or services under or in connection with any trade name, trademark, service mark, or Internet domain name that is comprised in whole or in part of the term "Capsule" or any other term confusingly similar to the term "Capsule."

2. To deliver and destroy all inventory, literature, advertisements, and other materials displaying the CAPSULE mark.

H. Pre-judgment and post-judgment interest.

I. A certified order to the United States Patent and Trademark Office to cancel the registration pursuant to 15 U.S.C. § 1119, of “AIR CAPSULE” Serial No. 86,465,014.

J. A certified order to the United States Patent and Trademark Office to cancel, pursuant to 15 U.S.C. § 1119, the registration of “CAPSULE SOLID”, Serial No. 86,778,356.

K. Any and all other relief as this Court may deem just and proper.

JURY DEMAND

Plaintiff demands a trial by jury as to all issues so triable.

DATED: December 4, 2015

Respectfully submitted by,

/s/ Edward L. Bishop
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EXHIBIT B

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

UNCOMMON, LLC,)	
)	
Plaintiff,)	Case No. 15-cv-10897
v.)	
)	Hon. John R. Blakey
SPIGEN, INC.,)	
)	JURY TRIAL DEMANDED
Defendant.)	
_____)	
)	
UNCOMMON, LLC,)	
)	
Counter-Plaintiff,)	
v.)	
)	
SPIGEN, INC.,)	
)	
Counter-Defendant.)	

ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM

Defendant SPIGEN, INC. (“Defendant” or “Spigen”), by and through its attorneys, and for its Answer, Affirmative Defenses and Counterclaim against Plaintiff UNCOMMON, LLC (hereinafter “Plaintiff” or “Uncommon”) alleges as follows:

ANSWER

NATURE OF THE CASE

1. Spigen admits that this action purports to be a civil action brought under 15 U.S.C. §1114 and §1125 and Illinois common law. Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the remaining allegations of this paragraph.

2. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

PARTIES

3. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

4. Spigen admits this paragraph.

JURISDICTION AND VENUE

5. Spigen admits that this Court has original subject jurisdiction over Uncommon's claim arising under Federal law. Spigen admits that this court has supplemental jurisdiction over all other claims that are so related as to claims in the action within such original jurisdiction that they form part of the same controversy under Article III of the United States Constitution. Except as expressly admitted, Spigen denies all allegations of this paragraph.

6. Spigen denies the allegations of this paragraph.

7. Spigen denies the allegations of this paragraph.

FACTUAL BACKGROUND

Uncommon, LLC

8. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

9. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

10. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

11. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

12. Spigen lacks sufficient information or knowledge either to admit or deny the

allegations in this paragraph, and on that basis denies the allegations of this paragraph.

13. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

14. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

15. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

The Purported Capsule Mark

16. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

17. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

18. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

19. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

20. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

21. Spigen denies the allegations of this paragraph.

22. This paragraph contains a legal conclusion which Spigen is not required to admit or deny. As far as an answer is required, Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

Defendant's Alleged Infringing and Unfair Conduct

23. Spigen admits that it owns and operates the website at www.spigen.com, and that it promotes and sells protective cases for electronic devices. Except as expressly admitted, Spigen denies the allegations of this paragraph.

24. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

25. Spigen admits that its protective case products are sold by authorized online resellers including Staples, Walmart, and Amazon websites. Spigen admits that it markets its protective cases. Except as expressly admitted, Spigen denies the allegations of this paragraph.

26. Spigen admits that it has offered for sale and sold protective cases for cellular phones that contains the term "Capsule." Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the allegations of this paragraph not expressly admitted to.

27. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

28. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

29. Spigen denies the allegations of this paragraph.

30. Spigen denies the allegations of this paragraph.

31. Spigen denies the allegations of this paragraph.

32. Spigen denies the allegations of this paragraph.

33. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

34. Spigen admits that it has filed a trademark application for the mark “Air Capsule” with the USPTO in IC 009 on November 25, 2014 which is still pending (Ser. No. 86465014). Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the allegations of this paragraph not expressly admitted to.

35. Spigen admits that it has filed a trademark application for the mark “Capsule Solid” with the USPTO in IC 009 on October 5, 2015 which is still pending (Ser. No. 86778356). Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the allegations of this paragraph not expressly admitted to.

COUNT I
Federal Trademark Infringement
(15 U.S.C. § 1114)

36. Spigen incorporates by reference its responses to paragraphs 1-35 as if restated herein in their entirety.

37. Spigen denies the allegations of this paragraph.

38. Spigen denies the allegations of this paragraph.

39. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

40. Spigen denies the allegations of this paragraph.

41. Spigen denies the allegations of this paragraph.

42. Spigen denies the allegations of this paragraph.

43. Spigen denies the allegations of this paragraph.

COUNT II
Unfair Competition and Alleged False Designation of Origin

(15 U.S.C. § 1125(A))

44. Spigen incorporates by reference its responses to paragraphs 1-43 as if restated herein in their entirety.

45. Spigen denies the allegations of this paragraph.

46. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

47. Spigen denies the allegations of this paragraph.

48. Spigen denies the allegations of this paragraph.

49. Spigen denies the allegations of this paragraph.

50. Spigen denies the allegations of this paragraph.

COUNT III
Illinois Common Law Unfair Competition

51. Spigen incorporates by reference its responses to paragraphs 1-50 as if restated herein in their entirety.

52. Spigen denies the allegations of this paragraph.

53. Spigen denies the allegations of this paragraph.

54. Spigen denies the allegations of this paragraph.

55. Spigen denies the allegations of this paragraph.

COUNT IV
Cancellation of “Air Capsule”, Serial No. 86,465,014
(15 U.S.C. § 1119)

56. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen incorporates by reference its responses to paragraphs 1-55 as if restated herein in their entirety.

Count

57. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

58. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

59. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

60. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

COUNT V
Cancellation of “Capsule Solid”, Serial No. 86,778,356

61. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen incorporates by reference its responses to paragraphs 1-60 as if restated herein in their entirety.

62. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

63. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

64. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

65. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

WHEREFORE, Defendant SPIGEN, INC. prays that this Honorable Court:

- A. Enter an Order Denying the relief requested by Plaintiff;
- B. Deny Plaintiff the award of attorneys’ fees and costs; and
- C. Award Defendant their attorneys’ fees and costs and any further relief as this Court deems just.

DEFENDANT’S AFFIRMATIVE DEFENSES

NOW COMES the Defendant, SPIGEN, INC. and pursuant to Federal Rule of Civil Procedure 8(c), submit their Affirmative Defenses to UNCOMMON, LLC Complaint as follows:

**FIRST AFFIRMATIVE DEFENSE
FAILURE TO STATE A CLAIM**

1. The Complaint fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE
CONTINUOUS PRIOR USE**

2. The claims made in the Complaint and relief sought therein are barred, in whole or in part, on the basis that Spigen had continuous prior use of the “CAPSULE” mark without knowledge of Defendants’ use of the alleged trade dress at issue.

**THIRD AFFIRMATIVE DEFENSE
CONTINUOUS PRIOR USE BEFORE REGISTRATION**

3. The claims made in the Complaint and relief sought therein are barred, in whole

or in part, on the basis that Spigen had continuous prior use of the “CAPSULE” mark before Plaintiffs applied for registration of the alleged trade dress at issue.

**FOURTH AFFIRMATIVE DEFENSE
WAIVER, ACQUIESCENCE, ESTOPPEL**

4. Each of the purported claims in the Complaint are barred by the doctrines of waiver, acquiescence, and estoppel.

**FIFTH AFFIRMATIVE DEFENSE
LACHES**

5. Plaintiff’s rights in the “CAPSULE” mark are unenforceable, in whole or in part, against Spigen under the doctrine of laches.

**SIXTH AFFIRMATIVE DEFENSE
ABANDONMENT**

6. The claims made in the Complaint are barred, in whole or in part, by abandonment of the “CAPSULE” mark.

**SEVENTH AFFIRMATIVE DEFENSE
FAILURE TO MITIGATE**

7. The claims made in the Complaint are barred, in whole or in part, because of Plaintiffs’ failure to mitigate damages, if such damages exist.

**EIGHTH AFFIRMATIVE DEFENSE
ACTS OF PLAINTIFF**

8. On information and belief, the damages, if any, that were allegedly sustained by Plaintiffs as a result of the acts complained of in the Complaint were caused in whole or in part or were contributed to by reason of the acts, omissions, negligence, and/or intentional misconduct of Plaintiffs, its agents, predecessors, and/or related entities.

**NINTH AFFIRMATIVE DEFENSE
NO EQUITABLE RELIEF**

9. As a result of Plaintiffs' actions, Plaintiffs are not entitled to equitable relief, including but not limited to Plaintiffs' request for injunctive relief as it has an adequate remedy at law.

**TENTH AFFIRMATIVE DEFENSE
NO WILLFUL INFRINGEMENT**

10. There was no willful infringement by Spigen. As a result, Plaintiffs' claims for enhanced damages and an award of attorneys' fees and costs have no basis in fact or law and should be denied.

**ELEVENTH AFFIRMATIVE DEFENSE
THIRD PARTY USE**

11. The claims made in the Complaint are barred, in whole or in part, by reason of other parties' use of the "CAPSULE" mark.

**TWELFTH AFFIRMATIVE DEFENSE
ACTIONS OF OTHERS**

12. The claims made in the Complaint are barred, in whole or in part, because Spigen is not liable for the acts of other over whom it has no control.

**THIRTEENTH AFFIRMATIVE DEFENSE
LACK OF CAUSATION**

13. Plaintiff's claims against Spigen are barred because Plaintiff's damages, if any, were not caused by Spigen.

**FOURTEENTH AFFIRMATIVE DEFENSE
LACK OF DAMAGES**

14. Without admitting the Complaint states a claim, there has been no damage in any amount, manner or at all by reason of any act alleged against Spigen in the Complaint, and the relief prayed for in the Complaint therefore cannot be granted.

FIFTEENTH AFFIRMATIVE DEFENSE

ALL REMAINING DEFENSES

15. Spigen adopts and incorporates herein all affirmative defenses available pursuant to the Federal Rules of Civil Procedure 8 (or any applicable statute or regulation), to the extent the facts known at this time would make any of the said defenses available or facts developed in the future would make the same available. No affirmative defense is waived.

WHEREFORE Defendant, SPIGEN, INC. prays for an Order Denying the relief Plaintiff UNCOMMON, LLC seeks in its Complaint, and for whatever other relief this Court deems just.

DEFENDANT'S COUNTERCLAIM

NOW COMES Defendant/Counter-Plaintiff SPIGEN, INC. (hereinafter, "Spigen" or "Counter-Plaintiff") by and through its attorneys and for its Counterclaim against Plaintiff/Counter-Defendant UNCOMMON, LLC (hereinafter, "Uncommon" or "Counter-Defendant") states as follows:

PARTIES

1. Spigen is a California Corporation with its principal place of business located at 9975 Toledo Way #100, Irvine, CA 92618.

2. Upon information and belief, Counter-Defendant Uncommon, LLC is a Delaware Limited Liability Company having its principal place of business at 2759 W. Lawrence Ave., Chicago, IL 60625.

JURISDICTION AND VENUE

3. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. §1121 and 28 U.S.C. §§ 1331 and 1338(a). This Court has supplemental jurisdiction under 28 U.S.C. §1367 over the state law claims.

4. Upon information and belief, venue is proper in this District pursuant to 28 U.S.C.

§§ 1391(b), (c), and (d), and 1400(b) because Counter-Defendant has transacted business in this District and/or initiated this proceeding in this District.

5. Upon information and belief, personal jurisdiction exists generally over Counter-Defendant because Counter-Defendant has sufficient minimum contacts with the forum because of business conducted within this State and District. Personal jurisdiction also exists specifically over each Counter-Defendant because each, directly or through affiliates, subsidiaries or intermediaries, transacts business in this District including making, using, offering to sell, selling and/or having sold infringing products within this State and District, which infringe the alleged trade dress at issue. Additionally, each Counter-Defendant consented to personal jurisdiction in this forum by initiated this proceeding herein

COUNT I

Cancellation of the “CAPSULE” Mark (U.S. Registration No. 4,338,254) Based on Fraud in the Procurement of the Registration

6. Spigen restates and incorporates by reference its allegations in Paragraphs 1-5 of the Counterclaims.

7. Vatra, Inc. (hereinafter, “Vatra”) applied for registration of the mark “CAPSULE” (U.S. Registration No. 3,472,044) in connection with IC 009, including cases for mobile phones and cases for telephones, on December 27, 2007.

8. Vatra’s “CAPSULE” mark (U.S. Registration No. 3,472,044) was published for opposition on May 6, 2008 and registered on the principal register on July 22, 2008.

9. On information and belief, Vatra began using the mark “CAPSULE” as early as September 1, 2007.

10. SwitchEasy Limited (“SwitchEasy”) applied for registration of the mark “CAPSULE” (Ser. No. 77533218) in connection with IC 009 protective cases and carrying cases

for portable digital media player devices on July 29, 2008 with a first date of use at least as early as December 1, 2005.

11. Upon information and belief, SwitchEasy has used and continues to use the trademark “CAPSULE” since at least December 1, 2005 in connection with IC 009 protective cases.

12. On September 17, 2012, Counter-Defendant filed a trademark application for the “CAPSULE” mark in connection with IC 009, including cellular phone cases, with a date of first use of December 16, 2009. The registration number for this application was (U.S. 4,338,524).

13. Spigen began using the mark “CAPSULE” prior to Counter-Defendant’s application of the mark “CAPSULE” and continued to use the mark “CAPSULE”.

14. Upon information and belief, Counter-Defendant attested to the United States Patent and Trademark Office (hereinafter, “USPTO”) in its trademark registration application that its “CAPSULE” mark that it did not have knowledge of the existence of Vatra’s prior registration and use of the mark “CAPSULE” (U.S. Registration No. 3,472,044) and/or senior user of SwitchEasy.

15. Upon information and belief, Counter-Defendant’s assertions that it did not have knowledge of Vatra prior registration and use of the mark “CAPSULE” (U.S. Registration No. 3,472,044) and/or senior user of SwitchEasy were false.

16. Upon information and belief, Counter-Defendant’s assertions that it had no knowledge of Spigen’s, Vatra’s and/or SwitchEasy’s prior use of the mark “CAPSULE” were false.

17. Upon information and belief, Counter-Defendant knew that these assertions were false, but made these statements in order to induce the U.S. Patent and Trademark office to issue

the registration for its mark “CAPSULE” (U.S. Registration No. 4,338,524).

18. In reliance upon and due to the foregoing false statements made by Counter-Defendant in connection with the mark “CAPSULE” (U.S. Registration No. 4,338,524), the USPTO issued the registration for the mark “CAPSULE (U.S. Registration No. 4,338,524) to Counter-Defendant.

19. Had the existence of Vatra’s prior registration and use been disclosed to the USPTO, the USPTO would not have issued the registration for the mark “CAPSULE (U.S. Registration No. 4,338,524) to Counter-Defendant.

20. Had the existence of senior user of SwitchEasy been disclosed to the USPTO, the USPTO would not have issued the registration for the mark “CAPSULE (U.S. Registration No. 4,338,524) to Counter-Defendant.

21. Counter-Defendant’s misrepresentation in its Application for the mark “CAPSULE” was material to the USPTO in deciding to grant U.S. Registration No. 4,338,524.

22. Thus, the Court should exercise its authority and order the USPTO to cancel the “CAPSULE” Mark (U.S. Registration No. 4,338,524)

COUNT II

Cancellation of the “CAPSULE” Mark (U.S. Registration No. 4,338,524) Based on Prior Registration by Vatra and/or Senior User of SwitchEasy

23. Spigen restates and incorporates by reference its allegations in Paragraphs 1-22 of the Counterclaims.

24. Vatra, Inc. (hereinafter, “Vatra”) applied for registration of the mark “CAPSULE” (U.S. Registration No. 3,472,044) in connection with IC 009, including cases for mobile phones and cases for telephones, on December 27, 2007.

25. Vatra’s “CAPSULE” mark (U.S. Registration No. 3,472,044) was published for

opposition on May 6, 2008 and registered on the principal register on July 22, 2008.

26. On information and belief, Vatra began using the mark “CAPSULE” as early as September 1, 2007.

27. SwitchEasy Limited (“SwitchEasy”) applied for registration of the mark “CAPSULE” (Ser. No. 77533218) in connection with IC 009 protective cases and carrying cases for portable digital media player devices on July 29, 2008 with a first date of use at least as early as December 1, 2005.

28. Upon information and belief, SwitchEasy has used and continues to use the trademark “CAPSULE” since at least December 1, 2005 in connection with IC 009 protective cases.

29. On September 17, 2012, Counter-Defendant filed a trademark application for the “CAPSULE” mark, with a date of first use of December 16, 2009. The registration number for this application was 4,338,524.

30. There is a likelihood of confusion between Counter-Defendant’s use of the mark “CAPSULE” and Vatra’s use of the mark “CAPSULE” because the marks are identical and the goods are identical.

31. Counter-Defendant’s mark “CAPSULE” is identical to Vatra’s prior registration of the mark “CAPSULE”.

32. Vatra’s use of the mark “CAPSULE” is for mobile phone and electronic device cases, the same type of products Counter-Defendant is using for the mark “CAPSULE.”

33. There is a likelihood of confusion between Counter-Defendant’s use of the mark “CAPSULE” and SwitchEasy’s use of the mark “CAPSULE” because the marks are identical and the goods are identical.

34. SwitchEasy is a senior user to Counter-Defendant in using the mark “CAPSULE” in connection with IC 009 protective cases.

35. Thus, the Court should exercise its authority and order the USPTO to cancel the “CAPSULE” Mark (U.S. Registration No. 4,338,524).

COUNT III

Cancellation of the “CAPSULE” Mark (U.S. Registration No. 4,338,524) Based on the Mark Being Merely Descriptive with no Secondary Meaning

36. Spigen restates and incorporates by reference its allegations in Paragraphs 1-35 of the Counterclaims.

37. The term “CAPSULE” when used in connection with Plaintiff’s or Spigen’s products, or other protective case products for electronic devices, is incapable of functioning as a trademark pursuant to 15 U.S.C. §1052(e)(1).

38. The term “CAPSULE” when used in connection with cases specifically adapted for protection and storage of consumer electronics, namely, cellular phones and mobile media players, is incapable of functioning as a trademark pursuant to 15 U.S.C. §1052(e)(1).

39. The term “CAPSULE” is merely descriptive and is not inherently distinctive because it does not inherently identify a particular source, but instead is merely a description of Plaintiff’s products and has not acquired distinctiveness through secondary meaning.

40. Since the term “CAPSULE” is merely descriptive with no secondary meaning, it is invalid.

41. The Court has the authority to cancel a mark for any reason that it is invalid.

42. Thus, the Court should exercise its authority and order the USPTO to cancel the “CAPSULE” Mark (U.S. Registration No. 4,338,524)

COUNT IV

Declaratory Judgment of Non-Infringement of the “CAPSULE” Mark (U.S. Registration

No. 4,338,524) and No Unfair Competition or False Designation of Origin

43. Spigen restates and incorporates by reference its allegations in paragraphs 1-42 of the Counterclaims.

44. An actual case and controversy exists between parties as to whether the “CAPSULE” Mark has been infringed by Spigen.

45. There is no likelihood of confusion, mistake or deception as to the origin, sponsorship, or approval by Counter-Defendant as to Spigen’s use of the term “CAPSULE” in connection with its protective cases.

46. Spigen has not violated Counter-Defendants’ rights in the mark “CAPSULE”, including any trademark rights, or committed unfair competition.

47. Spigen seeks a judicial declaration finding that they have not infringed and does not infringe on the “CAPSULE” mark under the Lanham Act or Illinois Common Law.

48. Spigen further seeks a judicial declaration that is has not committed unfair competition.

COUNT V

Declaratory Judgment of Lack of Protectable or Enforceable Trademark

49. Spigen restates and incorporates by reference its allegations in paragraphs 1-48 of the First Amended Complaint.

50. An actual case and controversy exists as to whether the “CAPSULE” mark is protectable or enforceable.

51. The “CAPSULE” mark at is generic or at least merely descriptive.

52. The “CAPSULE” mark is not distinctive and has not acquired a secondary meaning.

53. Spigen seeks a judicial declaration finding that Counter-Defendant did not acquire

any protectable right for the “CAPSULE” mark.

54. Counter-Defendant obtained the trademark registration for the mark “CAPSULE” by fraud or inequitable conduct and thus, the trademark registration is not enforceable.

COUNT VI
Declaratory Judgment Granting Concurrent Use Right to Spigen

55. Spigen restates and incorporates by reference its allegations in paragraphs 1-54 of the First Amended Complaint.

56. Spigen began using the mark “CAPSULE” prior to Counter-Defendant’s application of the mark “CAPSULE.”

57. Upon information and belief, Spigen began using the mark “CAPSULE” in certain geographical region prior to Counter-Defendant’ use of the mark “CAPSULE” in that geographical region.

58. Spigen seeks a judicial declaration finding that they have a trademark right for the mark “CAPSULE” in such geographical region.

COUNT VII
Damages under 15 U.S.C. § 1120

59. Spigen restates and incorporates by reference its allegations in paragraphs 1-58 of the First Amended Complaint.

60. Upon information and belief, Counter-Defendant obtained the trademark registration for the mark “CAPSULE” by fraud or inequitable conduct, including but not limited to false or fraudulent declaration, and thus, the trademark registration is invalid or unenforceable.

61. Spigen has been injured by Uncommon’s acts to enforce its invalid or unenforceable right to the mark “CAPSULE” and seeks damages under 15 U.S.C. § 1120.

PRAYER FOR RELIEF

WHEREFORE, Defendant/Counter-Plaintiff SPIGEN, INC., respectfully requests that the judgment be entered in its favor and against Plaintiff/Counter-Defendant UNCOMMON, LLC as follows:

1. A judgment in Spigen's favor and denying all relief Uncommon requested in its Complaint and dismissing Uncommon's Complaint with Prejudice;
2. A judgment in favor of Spigen on all of its Counterclaims;
3. A declaration cancelling Uncommon's registration for the mark "CAPSULE";
4. A declaration that Spigen has not infringed, any of trademark right, if any, of Uncommon;
5. A declaration that the Alleged Trade Dress at Issue is not protectable because it is not distinctive, has not acquired secondary meaning, and/or because the design of the Trade Dress at Issue is functional;
6. A judgment denying any preliminary or permanent injunction requested by Uncommon;
7. A declaration that Uncommon's trademark registration for the mark "CAPSULE" is not enforceable;
8. A declaration granting Spigen a concurrent use right for the mark "CAPSULE";
9. That the Court enter judgment declaring that this is an exceptional case justifying an award of attorneys' fees to Spigen and against Uncommon in the defense of this action and that the Court grant Spigen's reasonable attorneys' fees incurred in the prosecution of the counterclaims in this action based on the foregoing legal grounds;
10. That Uncommon be ordered to pay all costs associated with this action;
11. Damages to and in favor of Spigen under 15 U.S.C. § 1120; and

12. That the Court award Spigen such other further relief as the Court may deem just and proper.

Respectfully submitted,

SPIGEN, INC.

By: /s/ Heedong Chae
One of Defendant/Counter-Plaintiff's attorneys

Heedong Chae
East West Law Group PC
3600 Wilshire Blvd., Suite 702
Los Angeles, CA 90010
Email: hdchae@ewpat.com
Tel: 213-387-3630

EXHIBIT C

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

UNCOMMON, LLC,)	
)	
v.)	Case No. 15-cv-10897
)	Hon. John R. Blakey
SPIGEN, INC.,)	
)	JURY TRIAL DEMANDED
Defendant.)	
_____)	
)	
UNCOMMON, LLC,)	
)	
v.)	
)	
SPIGEN, INC.,)	
)	
Counter-Defendant.)	

FIRST AMENDED ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM

Defendant SPIGEN, INC. (“Defendant” or “Spigen”), by and through its attorneys, and for its First Amended Answer, Affirmative Defenses and Counterclaim against Plaintiff UNCOMMON, LLC (hereinafter “Plaintiff” or “Uncommon”) alleges as follows:

FIRST AMENDED ANSWER

NATURE OF THE CASE

1. Spigen admits that this action purports to be a civil action brought under 15 U.S.C. §1114 and §1125 and Illinois common law. Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the remaining allegations of this paragraph.

2. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

PARTIES

3. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

4. Spigen admits this paragraph.

JURISDICTION AND VENUE

5. Spigen admits that this Court has original subject jurisdiction over Uncommon's claim arising under Federal law. Spigen admits that this court has supplemental jurisdiction over all other claims that are so related as to claims in the action within such original jurisdiction that they form part of the same controversy under Article III of the United States Constitution. Except as expressly admitted, Spigen denies all allegations of this paragraph.

6. Spigen denies the allegations of this paragraph.

7. Spigen denies the allegations of this paragraph.

FACTUAL BACKGROUND

Uncommon, LLC

8. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

9. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

10. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

11. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

12. Spigen lacks sufficient information or knowledge either to admit or deny the

allegations in this paragraph, and on that basis denies the allegations of this paragraph.

13. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

14. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

15. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

The Purported Capsule Mark

16. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

17. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

18. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

19. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

20. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

21. Spigen denies the allegations of this paragraph.

22. This paragraph contains a legal conclusion which Spigen is not required to admit or deny. As far as an answer is required, Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

Defendant's Alleged Infringing and Unfair Conduct

23. Spigen admits that it owns and operates the website at www.spigen.com, and that it promotes and sells protective cases for electronic devices. Except as expressly admitted, Spigen denies the allegations of this paragraph.

24. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

25. Spigen admits that its protective case products are sold by authorized online resellers including Staples, Walmart, and Amazon websites. Spigen admits that it markets its protective cases. Except as expressly admitted, Spigen denies the allegations of this paragraph.

26. Spigen admits that it has offered for sale and sold protective cases for cellular phones that contains the term "Capsule." Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the allegations of this paragraph not expressly admitted to.

27. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

28. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

29. Spigen denies the allegations of this paragraph.

30. Spigen denies the allegations of this paragraph.

31. Spigen denies the allegations of this paragraph.

32. Spigen denies the allegations of this paragraph.

33. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

34. Spigen admits that it has filed a trademark application for the mark “Air Capsule” with the USPTO in IC 009 on November 25, 2014 which is still pending (Ser. No. 86465014). Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the allegations of this paragraph not expressly admitted to.

35. Spigen admits that it has filed a trademark application for the mark “Capsule Solid” with the USPTO in IC 009 on October 5, 2015 which is still pending (Ser. No. 86778356). Spigen lacks sufficient information or knowledge either to admit or deny the remaining allegations in this paragraph, and on that basis denies the allegations of this paragraph not expressly admitted to.

COUNT I
Federal Trademark Infringement
(15 U.S.C. § 1114)

36. Spigen incorporates by reference its responses to paragraphs 1-35 as if restated herein in their entirety.

37. Spigen denies the allegations of this paragraph.

38. Spigen denies the allegations of this paragraph.

39. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

40. Spigen denies the allegations of this paragraph.

41. Spigen denies the allegations of this paragraph.

42. Spigen denies the allegations of this paragraph.

43. Spigen denies the allegations of this paragraph.

COUNT II
Unfair Competition and Alleged False Designation of Origin

(15 U.S.C. § 1125(A))

44. Spigen incorporates by reference its responses to paragraphs 1-43 as if restated herein in their entirety.

45. Spigen denies the allegations of this paragraph.

46. Spigen lacks sufficient information or knowledge either to admit or deny the allegations in this paragraph, and on that basis denies the allegations of this paragraph.

47. Spigen denies the allegations of this paragraph.

48. Spigen denies the allegations of this paragraph.

49. Spigen denies the allegations of this paragraph.

50. Spigen denies the allegations of this paragraph.

COUNT III
Illinois Common Law Unfair Competition

51. Spigen incorporates by reference its responses to paragraphs 1-50 as if restated herein in their entirety.

52. Spigen denies the allegations of this paragraph.

53. Spigen denies the allegations of this paragraph.

54. Spigen denies the allegations of this paragraph.

55. Spigen denies the allegations of this paragraph.

COUNT IV
Cancellation of “Air Capsule”, Serial No. 86,465,014
(15 U.S.C. § 1119)

56. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen incorporates by reference its responses to paragraphs 1-55 as if restated herein in their entirety.

Count

57. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

58. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

59. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

60. Count IV for Cancellation of “Air Capsule”, Serial No. 86,465,014 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

COUNT V
Cancellation of “Capsule Solid”, Serial No. 86,778,356

61. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen incorporates by reference its responses to paragraphs 1-60 as if restated herein in their entirety.

62. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

63. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

64. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

65. Count V for Cancellation of “Capsule Solid”, Serial No. 86,778,356 was dismissed by Plaintiff [Dkt. 23]. As such, no answer is required. As far as an answer is required, Spigen denies the allegations of this paragraph.

WHEREFORE, Defendant SPIGEN, INC. prays that this Honorable Court:

- A. Enter an Order Denying the relief requested by Plaintiff;
- B. Deny Plaintiff the award of attorneys’ fees and costs; and
- C. Award Defendant their attorneys’ fees and costs and any further relief as this Court deems just.

DEFENDANT’S AFFIRMATIVE DEFENSES

NOW COMES the Defendant, SPIGEN, INC. and pursuant to Federal Rule of Civil Procedure 8(c), submit their Affirmative Defenses to UNCOMMON, LLC Complaint as follows:

**FIRST AFFIRMATIVE DEFENSE
CONTINUOUS PRIOR USE**

1. The claims made in the Complaint and relief sought therein are barred, in whole or in part, on the basis that Spigen had continuous prior use of the “CAPSULE” mark without knowledge of Defendants’ use of the alleged trade dress at issue.

**SECOND AFFIRMATIVE DEFENSE
CONTINUOUS PRIOR USE BEFORE REGISTRATION**

2. The claims made in the Complaint and relief sought therein are barred, in whole or in part, on the basis that Spigen had continuous prior use of the “CAPSULE” mark before Plaintiffs applied for registration of the alleged trade dress at issue.

**THIRD AFFIRMATIVE DEFENSE
WAIVER, ACQUIESCENCE, ESTOPPEL**

3. Each of the purported claims in the Complaint are barred by the doctrines of waiver, acquiescence, and estoppel.

**FORTH AFFIRMATIVE DEFENSE
LACHES**

4. Plaintiff's rights in the "CAPSULE" mark are unenforceable, in whole or in part, against Spigen under the doctrine of laches.

**FIFTH AFFIRMATIVE DEFENSE
ABANDONMENT**

5. The claims made in the Complaint are barred, in whole or in part, by abandonment of the "CAPSULE" mark.

**SIXTH AFFIRMATIVE DEFENSE
FAILURE TO MITIGATE**

6. The claims made in the Complaint are barred, in whole or in part, because of Plaintiffs' failure to mitigate damages, if such damages exist.

**SEVENTH AFFIRMATIVE DEFENSE
ACTS OF PLAINTIFF**

7. On information and belief, the damages, if any, that were allegedly sustained by Plaintiffs as a result of the acts complained of in the Complaint were caused in whole or in part or were contributed to by reason of the acts, omissions, negligence, and/or intentional misconduct of Plaintiffs, its agents, predecessors, and/or related entities.

**EIGHTH AFFIRMATIVE DEFENSE
THIRD PARTY USE**

8. The claims made in the Complaint are barred, in whole or in part, by reason of other parties' use of the "CAPSULE" mark.

**NINTH AFFIRMATIVE DEFENSE
ACTIONS OF OTHERS**

9. The claims made in the Complaint are barred, in whole or in part, because Spigen is not liable for the acts of other over whom it has no control.

**TENTH AFFIRMATIVE DEFENSE
ALL REMAINING DEFENSES**

10. Spigen adopts and incorporates herein all affirmative defenses available pursuant to the Federal Rules of Civil Procedure 8 (or any applicable statute or regulation), to the extent the facts known at this time would make any of the said defenses available or facts developed in the future would make the same available. No affirmative defense is waived.

WHEREFORE Defendant, SPIGEN, INC. prays for an Order Denying the relief Plaintiff UNCOMMON, LLC seeks in its Complaint, and for whatever other relief this Court deems just.

DEFENDANT'S FIRST AMENDED COUNTERCLAIM

NOW COMES Defendant/Counter-Plaintiff SPIGEN, INC. (hereinafter, "Spigen" or "Counter-Plaintiff") by and through its attorneys and for its Counterclaim against Plaintiff/Counter-Defendant UNCOMMON, LLC (hereinafter, "Uncommon" or "Counter-Defendant") states as follows:

PARTIES

1. Spigen is a California Corporation with its principal place of business located at 9975 Toledo Way #100, Irvine, CA 92618.

2. Upon information and belief, Counter-Defendant Uncommon, LLC is a Delaware Limited Liability Company having its principal place of business at 2759 W. Lawrence Ave., Chicago, IL 60625.

JURISDICTION AND VENUE

3. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. §1121 and 28 U.S.C. §§ 1331 and 1338(a). This Court has supplemental jurisdiction under 28 U.S.C. §1367 over the state law claims.

4. Upon information and belief, venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b), (c), and (d), and 1400(b) because Counter-Defendant has transacted business in this District and/or initiated this proceeding in this District.

5. Upon information and belief, personal jurisdiction exists generally over Counter-Defendant because Counter-Defendant has sufficient minimum contacts with the forum because of business conducted within this State and District. Personal jurisdiction also exists specifically over each Counter-Defendant because each, directly or through affiliates, subsidiaries or intermediaries, transacts business in this District including making, using, offering to sell, selling and/or having sold infringing products within this State and District, which infringe the alleged trade dress at issue. Additionally, each Counter-Defendant consented to personal jurisdiction in this forum by initiated this proceeding herein

COUNT I

Cancellation of the “CAPSULE” Mark (U.S. Registration No. 4,338,254) Based on Fraud in the Procurement of the Registration

6. Spigen restates and incorporates by reference its allegations in Paragraphs 1-5 of the Counterclaims.

7. Vatra, Inc. (hereinafter, “Vatra”) applied for registration of the mark “CAPSULE” (U.S. Registration No. 3,472,044) in connection with IC 009, including cases for mobile phones and cases for telephones, on December 27, 2007.

8. Vatra’s “CAPSULE” mark (U.S. Registration No. 3,472,044) was published for opposition on May 6, 2008 and registered on the principal register on July 22, 2008.

9. Based upon its trademark registration application, Vatra began using the mark “CAPSULE” as early as September 1, 2007.

10. SwitchEasy Limited (“SwitchEasy”) applied for registration of the mark “CAPSULE” (Ser. No. 77533218) in connection with IC 009 protective cases and carrying cases for portable digital media player devices on July 29, 2008 with a first date of use at least as early as December 1, 2005.

11. Upon information and belief, SwitchEasy has used and continues to use the trademark “CAPSULE” since at least December 1, 2005 in connection with IC 009 protective cases.

12. On September 17, 2012, Counter-Defendant filed a trademark application for the “CAPSULE” mark in connection with IC 009, including cellular phone cases, with a date of first use of December 16, 2009 (Serial No. 85730481). The registration number for this application was (U.S. 4,338,524).

13. Spigen began using the term “CAPSULE” prior to Counter-Defendant’s application of the mark “CAPSULE” and continued to use the term “CAPSULE”.

14. Counter-Defendant submitted to the United States Patent and Trademark Office (hereinafter, “USPTO”) a signed declaration that “[t]he undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that ... he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely,

when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true” (hereinafter, the “Declaration”).

15. By the Declaration, Counter-Defendant attested to the USPTO in its trademark registration application that its “CAPSULE” mark that it did not have knowledge of the existence of Vatra’s prior registration and use of the mark “CAPSULE” (U.S. Registration No. 3,472,044) and/or senior user of SwitchEasy.

16. Upon information and belief, Counter-Defendant’s assertions that it did not have knowledge of Vatra prior registration and use of the mark “CAPSULE” (U.S. Registration No. 3,472,044) and/or senior user of SwitchEasy were false.

17. Upon information and belief, Counter-Defendant’s assertions that it had no knowledge of Spigen’s, Vatra’s and/or SwitchEasy’s prior use of the mark “CAPSULE” were false.

18. The facts constituting Counter-Defendant’s misrepresentation to the USPTO is unavailable to Spigen.

19. Spigen’s suspicions of Counter-Defendant’s misrepresentations to the USPTO is based upon the following: (a) Counter-Defendant’s litigation counsel, Nicholas S. Lee was also the attorney who filed the trademark application for “CAPSULE” on its behalf; (b) Vatra and SwitchEasy’s registration of the mark “CAPSULE” is public record and is easily accessible; (c) an experienced trademark attorney, such as Mr. Lee, would have done a search of the trademarks prior to filing a trademark application; (d) in 2012, when Counter-Defendant submitted its application for its mark “CAPSULE”, a search of the trademark registry in by an experienced

trademark attorney would have revealed Vatra and SwitchEasy's prior registration and use of the mark "CAPSULE"; and (e) upon finding other users of the mark "CAPSULE", a trademark attorney would have notified the applicant of existence of other users and done additional investigation before submitting a declaration such as the Declaration.

20. Upon information and belief, Counter-Defendant knew that the assertions in the Declaration were false, but made the statements in order to induce the USPTO to issue the registration for its mark "CAPSULE" (U.S. Registration No. 4,338,524).

21. In reliance upon and due to the foregoing false statements made by Counter-Defendant in connection with the mark "CAPSULE" (Serial No. 85730481), the USPTO issued the registration for the mark "CAPSULE (U.S. Registration No. 4,338,524) to Counter-Defendant.

22. Had the existence of Vatra's prior registration and use been disclosed to the USPTO, the USPTO would not have issued the registration for the mark "CAPSULE (U.S. Registration No. 4,338,524) to Counter-Defendant.

23. Had the existence of senior user of SwitchEasy been disclosed to the USPTO, the USPTO would not have issued the registration for the mark "CAPSULE" (U.S. Registration No. 4,338,524) to Counter-Defendant.

24. Counter-Defendant's misrepresentation in its Application for the mark "CAPSULE" was material to the USPTO in deciding to grant U.S. Registration No. 4,338,524.

25. Thus, the Court should exercise its authority and order the USPTO to cancel the "CAPSULE" Mark (U.S. Registration No. 4,338,524)

COUNT II

Cancellation of the "CAPSULE" Mark (U.S. Registration No. 4,338,524) Based on Prior Registration by Vatra and/or Senior User of SwitchEasy and/or Senior User of Spigen

26. Spigen restates and incorporates by reference its allegations in Paragraphs 1-25 of the Counterclaims.

27. Vatra, Inc. (hereinafter, "Vatra") applied for registration of the mark "CAPSULE" (U.S. Registration No. 3,472,044) in connection with IC 009, including cases for mobile phones and cases for telephones, on December 27, 2007.

28. Vatra's "CAPSULE" mark (U.S. Registration No. 3,472,044) was published for opposition on May 6, 2008 and registered on the principal register on July 22, 2008.

29. On information and belief, Vatra began using the mark "CAPSULE" as early as September 1, 2007.

30. SwitchEasy Limited ("SwitchEasy") applied for registration of the mark "CAPSULE" (Ser. No. 77533218) in connection with IC 009 protective cases and carrying cases for portable digital media player devices on July 29, 2008 with a first date of use at least as early as December 1, 2005.

31. Upon information and belief, SwitchEasy has used and continues to use the trademark "CAPSULE" since at least December 1, 2005 in connection with IC 009 protective cases.

32. On September 17, 2012, Counter-Defendant filed a trademark application for the "CAPSULE" mark, with a date of first use of December 16, 2009. The registration number for this application was 4,338,524.

33. There is a likelihood of confusion between Counter-Defendant's use of the mark "CAPSULE" and Vatra's use of the mark "CAPSULE" because the marks are identical and the goods are identical.

34. Counter-Defendant's mark "CAPSULE" is identical to Vatra's prior registration

of the mark “CAPSULE”.

35. Vatra’s use of the mark “CAPSULE” is for mobile phone and electronic device cases, the same type of products Counter-Defendant is using for the mark “CAPSULE.”

36. There is a likelihood of confusion between Counter-Defendant’s use of the mark “CAPSULE” and SwitchEasy’s use of the mark “CAPSULE” because the marks are identical and the goods are identical.

37. SwitchEasy is a senior user to Counter-Defendant in using the mark “CAPSULE” in connection with IC 009 protective cases.

38. Assuming Spigen’s use of the term “CAPSULE” constitutes a use of a trademark, Spigen began using the mark “CAPSULE” prior to Counter-Defendant’s application of the mark “CAPSULE” and continued to use the mark “CAPSULE”.

39. Upon information and belief, Spigen is a senior user to Counter-Defendant in using the mark “CAPSULE” in connection with IC 009 protective cases.

40. Spigen will be damaged if the Court does not exercise its authority and order the USPTO to cancel the “CAPSULE” mark.

41. Thus, the Court should exercise its authority and order the USPTO to cancel the “CAPSULE” Mark (U.S. Registration No. 4,338,524).

COUNT III

Cancellation of the “CAPSULE” Mark (U.S. Registration No. 4,338,524) Based upon the Genericness of the Mark under 15 U.S.C. 1064(3)

42. Spigen restates and incorporates by reference its allegations in Paragraphs 1-41 of the Counterclaims.

43. The term “CAPSULE” when used in connection with Plaintiff’s or Spigen’s products, or other protective case products for electronic devices, is incapable of functioning as a

trademark pursuant to 15 U.S.C. §1052(e)(1).

44. The term “CAPSULE” when used in connection with cases specifically adapted for protection and storage of consumer electronics, namely, cellular phones and mobile media players, is incapable of functioning as a trademark pursuant to 15 U.S.C. §1052(e)(1).

45. The term “CAPSULE” is a generic term for protective cases, such as cases specifically adapted for protection and storage of consumer electronics, namely, cellular phones and mobile media players.

46. There are numerous companies that use the term “CAPSULE” in this manner.

47. The term “CAPSULE” does not indicate that the product comes from a single source.

48. Thus, the Court should exercise its authority and order the USPTO to cancel the “CAPSULE” Mark (U.S. Registration No. 4,338,524)

COUNT IV

Cancellation of the “CAPSULE” Mark (U.S. Registration No. 4,338,524) Based on the Mark Being Merely Descriptive with no Secondary Meaning

49. Spigen restates and incorporates by reference its allegations in Paragraphs 1-48 of the Counterclaims.

50. The term “CAPSULE” when used in connection with Plaintiff’s or Spigen’s products, or other protective case products for electronic devices, is incapable of functioning as a trademark pursuant to 15 U.S.C. §1052(e)(1).

51. The term “CAPSULE” when used in connection with cases specifically adapted for protection and storage of consumer electronics, namely, cellular phones and mobile media players, is incapable of functioning as a trademark pursuant to 15 U.S.C. §1052(e)(1).

52. The term “CAPSULE” is merely descriptive and is not inherently distinctive because it does not inherently identify a particular source, but instead is merely a description of Plaintiff’s products and has not acquired distinctiveness through secondary meaning.

53. Since the term “CAPSULE” is merely descriptive with no secondary meaning, it is invalid.

54. The Court has the authority to cancel a mark for any reason that it is invalid.

55. Thus, the Court should exercise its authority and order the USPTO to cancel the “CAPSULE” Mark (U.S. Registration No. 4,338,524)

COUNT V

Declaratory Judgment Granting Concurrent Use Right to Spigen

56. Spigen restates and incorporates by reference its allegations in paragraphs 1-55 of the First Amended Complaint.

57. Spigen began using the mark “CAPSULE” prior to Counter-Defendant’s application of the mark “CAPSULE.”

58. Upon information and belief, Spigen began using the mark “CAPSULE” in certain geographical region prior to Counter-Defendant’ use of the mark “CAPSULE” in that geographical region.

59. Spigen seeks a judicial declaration finding that they have a trademark right for the mark “CAPSULE” in such geographical region.

COUNT VI

Damages under 15 U.S.C. § 1120

60. Spigen restates and incorporates by reference its allegations in paragraphs 1-59 of the First Amended Complaint.

61. Upon information and belief, Counter-Defendant obtained the trademark

registration for the mark “CAPSULE” by fraud or inequitable conduct, including but not limited to false or fraudulent declaration, and thus, the trademark registration is invalid or unenforceable.

62. Spigen has been injured by Uncommon’s acts to enforce its invalid or unenforceable right to the mark “CAPSULE” and seeks damages under 15 U.S.C. § 1120.

PRAYER FOR RELIEF

WHEREFORE, Defendant/Counter-Plaintiff SPIGEN, INC., respectfully requests that the judgment be entered in its favor and against Plaintiff/Counter-Defendant UNCOMMON, LLC as follows:

1. A judgment in Spigen’s favor and denying all relief Uncommon requested in its Complaint and dismissing Uncommon’s Complaint with Prejudice;
2. A judgment in favor of Spigen on all of its Counterclaims;
3. A declaration cancelling Uncommon’s registration for the mark “CAPSULE”;
4. A declaration that Spigen has not infringed, any of trademark right, if any, of Uncommon;
5. A declaration that Uncommon’s mark “CAPSULE” is not protectable because it is not distinctive, has not acquired secondary meaning, and/or because it has become generic;
6. A judgment denying any preliminary or permanent injunction requested by Uncommon;
7. A declaration that Uncommon’s trademark registration for the mark “CAPSULE” is not enforceable;
8. A declaration granting Spigen a concurrent use right for the mark “CAPSULE”;
9. That the Court enter judgment declaring that this is an exceptional case justifying an

award of attorneys' fees to Spigen and against Uncommon in the defense of this action and that the Court grant Spigen's reasonable attorneys' fees incurred in the prosecution of the counterclaims in this action based on the foregoing legal grounds;

10. That Uncommon be ordered to pay all costs associated with this action;
11. Damages to and in favor of Spigen under 15 U.S.C. § 1120; and
12. That the Court award Spigen such other further relief as the Court may deem just and proper.

Respectfully submitted,

SPIGEN, INC.

By: /s/ Heedong Chae
One of Defendant/Counter-Plaintiff's attorneys

Heedong Chae
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Tel: 213-387-3630

EXHIBIT D

**UNITED STATES DISTRICT COURT
FOR THE Northern District of Illinois – CM/ECF LIVE, Ver 6.1.1
Eastern Division**

Uncommon, LLC

Plaintiff,

v.

Case No.: 1:15-cv-10897

Honorable John Robert Blakey

Spigen, Inc.

Defendant.

NOTIFICATION OF DOCKET ENTRY

This docket entry was made by the Clerk on Tuesday, October 18, 2016:

MINUTE entry before the Honorable John Robert Blakey: Motion hearing held on 10/18/2016. Oral motion to extend fact discovery deadline is denied. Defendant's motion to stay [88][90] is briefed as follows: response shall be filed on or before 11/1/2016. Status hearing previously set for 10/26/2016 is reset for 11/3/2016 at 9:00 a.m. in Courtroom 1725. Defendant's motion to file second amended answer and counterclaims [81] is entered and continued to 11/3/2016. Mailed notice(gel,)

ATTENTION: This notice is being sent pursuant to Rule 77(d) of the Federal Rules of Civil Procedure or Rule 49(c) of the Federal Rules of Criminal Procedure. It was generated by CM/ECF, the automated docketing system used to maintain the civil and criminal dockets of this District. If a minute order or other document is enclosed, please refer to it for additional information.

For scheduled events, motion practices, recent opinions and other information, visit our web site at www.ilnd.uscourts.gov.