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05-30-2002  
U.S. Patent & TMO/TM Mail Rcpt Dt. #76

TRADEMARK

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

In the Matter of: Application Serial No. 75/682,226

Published in the *Official Gazette* on July 11, 2000

HSS HIRE SERVICE GROUP PLC,	)
	)
Opposer,	)
	)
v.	)
	)
THE HOME SERVICE STORE, INC.	)
	)
Applicant.	)

**CERTIFICATE OF MAILING (37 C.F.R. 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Trademarks, Box TTAB - NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513.

<i>Lawrence H. Meier</i>	<i>5/20/02</i>
Lawrence H. Meier	Date

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Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Opposition No. 124,556

02 JUN 7 AM 8:23  
TRADEMARK TRIAL AND  
APPEAL BOARD

**TRANSMITTAL FOR APPLICANT'S AMENDED ANSWER TO NOTICE OF  
OPPOSITION AND AMENDED COUNTERCLAIMS FOR CANCELLATION OF  
REGISTRATIONS, SUBMITTED PURSUANT TO SECTIONS 2.106(b)(iii) and 2.115 OF  
THE U.S. TRADEMARK LAW RULES OF PRACTICE, AND RULE 15(a) OF THE  
FEDERAL RULES OF CIVIL PROCEDURE**

1. Enclosed is Applicant's Amended Answer to Notice of Opposition and Amended Counterclaims For Cancellation of Registrations, in connection with the above-identified matter.
2. Please charge any fees to Deposit Account No.04-1588. A copy of this sheet is enclosed.

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Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC  
Attorneys for Applicant

Date: May 28, 2002

By: *Lawrence H. Meier*  
Lawrence H. Meier

BTV/216552.1

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<i>Lawrence H. Meier</i>	<u>5/29/02</u>
Lawrence H. Meier	Date

Box TTAB  
Assistant Commissioner for Trademarks  
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Opposition No.: 124,556

Date: May 28, 2002

**APPLICANT'S AMENDED ANSWER TO NOTICE OF OPPOSITION AND  
AMENDED COUNTERCLAIMS FOR CANCELLATION OF REGISTRATIONS,  
SUBMITTED PURSUANT TO SECTIONS 2.106(b)(iii) and 2.115 OF THE U.S.  
TRADEMARK LAW RULES OF PRACTICE, AND RULE 15(a) OF THE FEDERAL  
RULES OF CIVIL PROCEDURE**

The Home Service Store, Inc. ("Applicant"), hereby answers the Notice of Opposition filed by HSS Hire Service Group PLC ("Opposer") as follows:

1. In response to the allegations in Paragraphs 1 and 2, Applicant admits that certain documents identified as Exhibits A and B were annexed to the Notice of Opposition, said

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- Exhibits purporting to be certain registrations. Applicant further admits that “HSS Hire Service Group PLC” is identified on portions of such Exhibits. Applicant lacks knowledge or information sufficient to form a belief as the truth of the remaining allegations of Paragraphs 1 and 2, and accordingly denies the same.
2. In response to the allegations in Paragraphs 3 and 4, Applicant denies such allegations.
  3. In response to the allegations in Paragraph 5, Applicant admits that it seeks to register the Pending Mark (as defined in the Notice of Opposition) in International Classes 35, 36 and 42, but asserts that the application for the Pending Mark speaks for itself, and denies that use of the Pending Mark is related solely to homeowners and contractors in the building and construction industry.
  4. In response to the allegations in Paragraph 6, Applicant denies such allegations.
  5. In response to the allegations in Paragraphs 7 and 8, Applicant denies such allegations, though Applicant admits that it does seek to register the Pending Mark, and that the application for such mark speaks for itself.
  6. In response to the allegations in Paragraph 9, Applicant denies such allegations.
  7. In addition, and as an affirmative defense, Applicant alleges that the Notice of Opposition is defective because, among other things, it does not specify which of the classes of services contained in the Pending Mark allegedly cause the likelihood of confusion asserted by Opposer. In addition, and on information and belief, Opposer did not submit the correct fee to oppose all three classes of services contained in the Pending Mark to the Trademark Trial and Appeal Board.

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8. In addition, and as an affirmative defense, Applicant alleges that as a result of its continuous and substantial usage of the Pending Mark since adoption, the Pending Mark is a valuable asset of Applicant and carries considerable goodwill and consumer acceptance of its services provided under the Pending Mark. Such goodwill and widespread usage has made the mark distinctive to the Applicant.
9. In addition, and as an affirmative defense, Applicant alleges that there is no likelihood of confusion, mistake or deception because, among other things, the Pending Mark, on the one hand, and the Registered Marks or Unregistered Mark (as defined in the Notice of Opposition), on the other, are not confusingly similar, in light of significant differences in the marks themselves (e.g., the sight, sound and meaning of at least the Pending Mark and Registered Marks), because the services identified by the marks are unrelated (e.g., Applicant does not use the Pending Mark to identify any services that are the same as or similar to those the Opposer allegedly uses the Registered and Unregistered Marks to identify), and because the Pending Mark is not promoted or used in the same distribution channels as the Registered Marks or Unregistered Mark.
10. In addition, and as an affirmative defense, Applicant alleges that Opposer has not used the Unregistered Mark, by itself and without association with either of the Registered Marks, in either a service mark sense or in any use analogous to service mark use.
11. In addition, and as an affirmative defense, Applicant alleges that the Notice of Opposition must be dismissed because it was not served in a timely manner. In particular, Applicant

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alleges that the Notice of Opposition was required to have been served by November 12, 2001, but was not served until November 13, 2001.

Applicant hereby counterclaims to cancel Opposer's pleaded Registration No. 2,072,559. As grounds in support of the counterclaim, Applicant alleges as follows:

1. On information and belief, Opposer has made no use of the mark HSS HIRE SHOP in the United States, in connection with any goods or services for at least three consecutive years preceding the filing of this counterclaim for cancellation and Opposer has no intent to resume such use.
2. As a result of Opposer's failure to use the HSS HIRE SHOP mark with intent not to resume such use, the HSS HIRE SHOP mark that is the subject of Registration No. 2,072,559 has become abandoned for purposes of Section 45 of the Trademark Act.

Applicant hereby counterclaims to cancel Opposer's pleaded Registration No. 2,368,208. As grounds in support of the counterclaim, Applicant alleges as follows:

1. Applicant's predecessor in interest, Home Service Solutions, LLC, began use of HSS in a trade name fashion, in corporate fashion(s), in uses analogous to service mark use, and/or to identify services referenced in the application for the Pending Mark, prior to October 19, 1998, the alleged priority date for the mark HSS RENTAL STORES (based on an alleged foreign filing date).
2. Applicant does not assert that there is any likelihood of confusion, mistake or deception between its uses of HSS and the services identified in the registration for HSS RENTAL STORES; however, should the Trademark Trial and Appeal Board determine otherwise

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in this proceeding, then such registration should be cancelled, based on Applicant's use of HSS as noted in Paragraph 1 prior to the foreign filing date identified above.

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed in its entirety and that the counterclaims for cancellation identified above be granted in their entirety.

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC  
Attorneys for Applicant

Date: May 28, 2002

By: Lawrence H. Meier  
Lawrence H. Meier  
[lmeier@drm.com](mailto:lmeier@drm.com)

#### CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing **APPLICANT'S AMENDED ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS FOR CANCELLATION OF REGISTRATIONS**, has been sent via First Class Mail, postage-paid this 28th day of May, 2002, to Elizabeth A. Gonzalez, Esq., Holme Roberts & Owen LLP, 1700 Lincoln Street, Suite 41009, Denver, CO 80203, Attorneys for Opposer.

Lawrence H. Meier  
Lawrence H. Meier

BTV/216553.1

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