



05-09-2002

U.S. Patent & TMO/c/TM Mail RptDt. #94

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, 2900 Crystal Drive, Arlington, VA 22202-3513.
<i>Lawrence H. Meier</i> 5/7/02
Lawrence H. Meier Date

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

Opposition No.: 124,556

Date: May 7, 2002

**APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND
COUNTERCLAIMS FOR CANCELLATION OF REGISTRATIONS**

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

- 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 Exhibits purporting to be certain registrations. Applicant further admits that "HSS Hire

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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) and 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).
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 trademark sense or in any use analogous to trademark use.

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

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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 to identify the 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 in this proceeding, then such registration should be cancelled, based on Applicant's use of HSS for such services prior to the foreign filing date identified above.

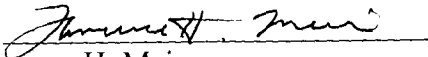
WHEREFORE, Applicant requests that the Notice of Opposition be dismissed in its entirety and that the counterclaims for cancellation identified above be granted in their entirety.

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Respectfully submitted,

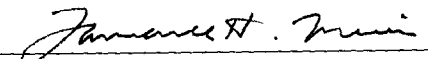
DOWNS RACHLIN MARTIN PLLC
Attorneys for Applicant

Date: May 7, 2002

By: 
Lawrence H. Meier

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS FOR CANCELLATION OF REGISTRATIONS**, has been sent via First Class Mail, postage-paid this 7th 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

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<i>Lawrence H. Meier</i>	5/7/02
Lawrence H. Meier	Date

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Opposition No. 124,556

TRADEMARK TRIAL AND
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**TRANSMITTAL FOR APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND
COUNTERCLAIM FOR CANCELLATION OF REGISTRATIONS**

1. Enclosed is Applicant's Answer to Notice of Opposition and Counterclaim For Cancellation of Registrations, in connection with the above-identified matter.
2. Check nos. 15571 and 15772, each in the amount of \$300 from Downs Rachlin Martin PLLC. Please charge any additional fees or credit any overpayment to Deposit Account No.04-1588. A copy of this sheet is enclosed.

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ae

Respectfully submitted,

DOWNS RACHLIN MARTIN PLLC
Attorneys for Applicant

Date: May 7, 2002

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

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