

ESTTA Tracking number: **ESTTA1227385**

Filing date: **08/08/2022**

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

Proceeding no.	91277331
Party	Defendant Uncommon Good Inc.
Correspondence address	ALYSON J. DILENA ST. ONGE STEWARD JOHNSTON & REENS LLC 986 BEDFORD STREET STAMFORD, CT 06905 UNITED STATES Primary email: tm-pto@ssjr.com Secondary email(s): aprovino@ssjr.com, litigation@ssjr.com, adilena@ssjr.com 2033246155
Submission	Answer and Counterclaim
Filer's name	Alyson J. DiLena
Filer's email	Litigation@ssjr.com, ACheverko@ssjr.com
Signature	/Alyson J. DiLena/
Date	08/08/2022
Attachments	Answer and Counter Claims.pdf(173209 bytes) Exhibit A Cover.pdf(58911 bytes) Moore Uncommon Goods.pdf(193280 bytes) Uncommon Goods - Fabriq.pdf(376181 bytes) Uncommon Goods Category on Amazon.pdf(1889537 bytes) uncommon goods studio.pdf(364432 bytes) Haven Uncommon Goods.pdf(111667 bytes) 4000 results Uncommon Goods Category on Amazon.pdf(149698 bytes)

Registration subject to the submission

Registration no.	2719619	Registration date	05/27/2003
Register	Principal		
Registrant	UNCOMMONGOODS, L.L.C. 140 58TH STREET, 5A BROOKLYN ARMY TERMINAL BROOKLYN, NY 11220 UNITED STATES		

Goods/services subject to the submission

Class 035. First Use: Jul 31, 1999 First Use In Commerce: Dec 23, 1999
All goods and services in the class are requested, namely: ON-LINE RETAIL STORE SERVICES FEATURING HOME FURNISHINGS, TEXTILES, CRAFTS, JEWELRY, FOOD, APPAREL AND APPAREL ACCESSORIES, FURNITURE, TOYS, AND TABLE TOPS

Grounds for cancellation

The mark is or has become generic	Trademark Act Section 14(3)
-----------------------------------	-----------------------------

Registration subject to the submission

Registration no.	2719620	Registration date	05/27/2003
Register	Principal		
Registrant	UNCOMMONGOODS, L.L.C. 140 58TH STREET, 5A BROOKLYN ARMY TERMINAL BROOKLYN, NY 11220 UNITED STATES		

Goods/services subject to the submission

Class 035. First Use: Dec 1999 First Use In Commerce: Dec 1999 All goods and services in the class are requested, namely: On-line retail store services featuring home furnishings, textiles, crafts, jewelry, food, apparel and apparel accessories, furniture, toys, and tablets

Grounds for cancellation

The mark is or has become generic	Trademark Act Section 14(3)
-----------------------------------	-----------------------------

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

UNCOMMONGOODS, LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91277331
	:	
UNCOMMON GOOD, INC.,	:	
	:	
Applicant.	:	

Application Serial No. 88/854,957
Mark: UNCOMMON GOOD

ANSWER AND COUNTERCLAIMS

Applicant, UNCOMMON GOOD, INC., (“Applicant”), denies that Opposer is entitled to any relief sought in its Notice of Opposition and responds below to the numbered grounds for opposition in this matter as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 and therefore denies the same.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 and therefore denies the same.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 and therefore denies the same.
4. Applicant admits that the USPTO’s TSDR systems indicates that Opposer is the current owner of record for U.S. Trademark Registration No. 2,719,619 covering “ON-LINE RETAIL STORE SERVICES FEATURING HOME FURNISHINGS, TEXTILES, CRAFTS,

JEWELRY, FOOD, APPAREL AND APPAREL ACCESSORIES, FURNITURE, TOYS, AND TABLE TOPS.”

5. Applicant admits that the USPTO’s TSDR system indicates that Opposer is the current owner of record for U.S. Trademark Registration No. 2,719,620 covering “On-line retail store services featuring home furnishings, textiles, crafts, jewelry, food, apparel and apparel accessories, furniture, toys, and tabletops.”

6. Applicant admits that the USPTO’s TSDR system indicates the allegation of paragraph 6.

7. Applicant admits that the USPTO’s TSDR system indicates that Opposer is the current owner of record for U.S. Trademark Registration No. 3,244,393 covering “online retail store services featuring gifts, home and home decor accessories, office and home office accessories, home and garden accessories, furniture, watches and jewelry, flatware, dinnerware, glassware, collectibles, and general merchandise.”

8. Applicant admits that the USPTO’s TSDR system indicates the allegation of paragraph 8.

9. Applicant admits that the USPTO’s TSDR system indicates the allegation of paragraph 9.

10. Applicant admits that the USPTO’s TSDR system indicates the allegation of paragraph 10.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 11 and therefore denies the same.

12. Applicant admits that the USPTO’s TSDR system indicates the allegation of paragraph 12.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 13 and therefore denies the same.

14. Denied.

15. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 15 and therefore denies the same.

16. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 16 and therefore denies the same.

17. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 17 and therefore denies the same.

18. Denied.

19. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 19 and therefore denies the same.

20. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 20 and therefore denies the same.

21. Denied.

22. Admitted.

23. Admitted.

24. Admitted.

25. Admitted.

26. Denied.

27. Denied.

28. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 28 and therefore denies the same.

29. Denied.

30. Denied.

31. Denied.

Applicant denies that Opposer is entitled to any relief sought in its Notice of Opposition.

AFFIRMATIVE DEFENSES

Applicant asserts the following Affirmative Defenses and reserves the right to assert additional Affirmative Defenses that are discovered during the course of this Opposition.

1. Opposer fails to state a claim upon which relief may be granted.
2. Opposer has not and will not be damaged by the registration of the trademark UNCOMMON GOOD by Applicant, and therefore lacks standing to oppose the application.
3. There is no likelihood of confusion, mistake, or deception between Opposer's alleged marks and Applicant's mark when considered in their entireties. Among other things, Applicant's mark is used on different goods and services from those listed in Opposer's registrations and applications and Applicant targets different consumers in different market spaces from Opposer.
4. Applicant's mark is distinctive in sound and appearance, meaning, connotation and commercial impression from ¹uncommon goods, ¹uncommon goods, UNCOMMON GIFTS, UNCOMMONGIFTS, THE UNCOMMON GREEN, UNCOMMON PERKS, UNCOMMON EXPERIENCES, and UNCOMMON GOODS BETTER TO GIVE and/or BETTER TO GIVE.
5. Opposer has failed to use and/or continuously use UNCOMMON GOODS for "a service which coordinates and assists in the charitable giving of others," and/or "charitable fundraising, organizing, promoting and running charitable and non-profit fundraising campaigns

for others; Organizing, promoting, and administering sweepstakes drawings as fundraisers on behalf of charitable and non-profit entities.”

6. Opposer has only added “charitable fundraising, organizing, promoting and running charitable and non-profit fundraising campaigns for others; organizing, promoting, and administering sweepstakes drawings as fundraisers on behalf of charitable and non-profit entities” to its pending applications in a bad faith attempt to preclude Applicant’s application from registering. Opposer’s claims are barred by the doctrine of unclean hands and/or fraud on the USPTO.

7. The term UNCOMMON is merely descriptive of Opposer’s goods and services that are unconventional, rare, or atypical.

8. The term GOODS is merely descriptive of Opposer’s goods and services and was disclaimed in registration nos. 2,716,619 and 2,716,620 and application nos. 88/873,836 and 88/873,864.

9. The UNCOMMON GOODS and UNCOMMONGOODS trademarks lack acquired distinctiveness or secondary meaning in relation to Opposer’s goods and services.

10. Opposer’s rights are narrow since UNCOMMON is used by numerous third parties in connection with clothing, consumer goods and online retail services.

11. Opposer’s claims are barred by estoppel.

12. Applicant reserves the right to rely on any and all further affirmative defenses that become available or arise during discovery in this matter, and reserves the rights to amend and supplement this Answer for the purposes of amending the above affirmative defenses and asserting other affirmative defenses.

WHEREFORE, Applicant denies that Opposer is entitled to any relief requested and further requests that the Board deny the Notice of Opposition and dismiss the opposition with prejudice.

COUNTER CLAIMS

Cancellation of Registration Nos. 2,719,619 and 2,719,620 For Becoming Generic

CC.A. 1 Registration No. 2,719,619 for UNCOMMON GOODS is generic and/or has become generic within the meaning of Trademark Act Section 14(3); 15 U.S.C. § 1064 states:

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such said prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

CC.A. 2. Petitioner submits that the phrase "UNCOMMON GOODS" is a generic phrase that is used by dozens of third parties as a descriptor for on-line retail store services featuring home furnishings, textiles, crafts, jewelry, food, apparel and apparel accessories, furniture, toys, and table tops as evidenced in Exhibit A attached. As exemplified by the websites and product listings of third parties, "UNCOMMON GOODS" is commonly used to describe "on-line retail

store services featuring home furnishings, textiles, crafts, jewelry, food, apparel and apparel accessories, furniture, toys, and table tops.”

CC.A. 3. Petitioner submits that in view of the above, the phrase “UNCOMMON GOODS” is generic for the goods and services in Registration No. 2,719,619.

CC.A. 4. Petitioner has been and continues to be damaged by U.S. Trademark Registration No. 2719619 as evidenced by the opposition proceedings under No. 91277331 brought by Registrant.

CC.B. 1 Registration No. 2,719,620 for UNCOMMONGOODS is generic and/or has become generic within the meaning of Trademark Act Section 14(3); 15 U.S.C. § 1064 states:

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such said prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

CC.B. 2. Petitioner submits that the phrase "UNCOMMONGOODS" is a generic phrase that is used by dozens of third parties as a descriptor for on-line retail store services featuring home furnishings, textiles, crafts, jewelry, food, apparel and apparel accessories, furniture, toys, and table tops as evidenced in Exhibit A attached. As exemplified by the websites and product

listings of third parties, “UNCOMMONGOODS” is commonly used to describe “on-line retail store services featuring home furnishings, textiles, crafts, jewelry, food, apparel and apparel accessories, furniture, toys, and table tops.”

CC.B. 3. Petitioner submits that in view of the above, the phrase “UNCOMMONGOODS” is generic for the goods and services in Registration No. 2,719,620.

CC.B. 4. Petitioner has been and continues to be damaged by U.S. Trademark Registration No. 2,719,620 as evidenced by the opposition under proceeding No. 91277331 brought by Registrant.

WHEREFORE, Petitioner prays that the Trademark Trial and Appeal Board grant the cancellation of U.S. Trademark Registration Nos. 2,719,619 and 2,719,620.

Respectfully submitted,



August 8, 2022

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Attorneys for Applicant

CERTIFICATE OF SERVICE

This is to certify that a true and complete copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** has been served on Counsel for the Opposer by email to:

Brett M. Tolpin
Mark R. Bagley
Tolpin & Partners, PC
30 N. LaSalle Street, Suite 1510
Chicago, IL 60602
Phone: 312-698-8971
Email: docket@tolpinlaw.com
Attorney for Opposer



August 8, 2022
Date

Alyson J. DiLena

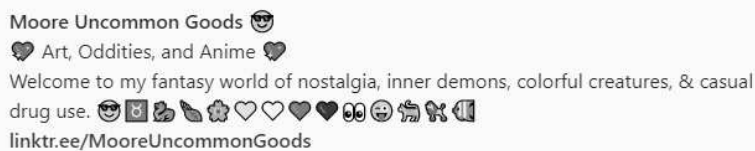
Exhibit A

Third party use of "UNCOMMON GOODS" that Compete with Opposer

- www.HavenUncommonGoods.Com;



- <https://www.ourfabriq.com/product-tag/uncommon-goods>;



- <https://ilovehandles.com/tagged/uncommon-goods/>;
- <https://www.sportique.com/blogs/the-logbook/top-10-uncommon-goods>;
- <http://www.justinablakeney.com/uncommon-goods>
- <https://www.amazon.com/uncommon-goods/s?k=uncommon+goods>
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- uncommongoodsstore.com
- www.uncommongoods.studio
- www.uncommongoodsinc.com

Moore Uncommon Goods 🧐

❤️ Art, Oddities, and Anime ❤️

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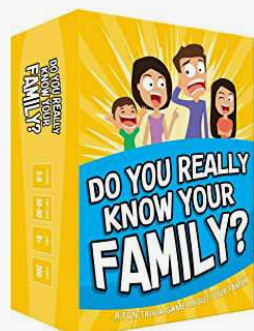
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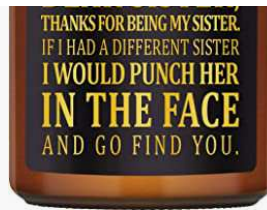
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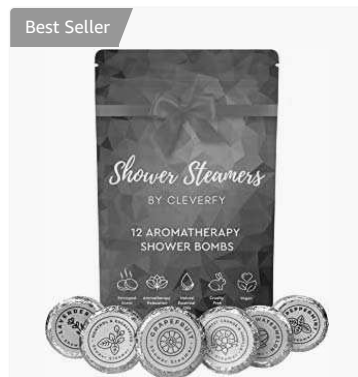
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