

ESTTA Tracking number: **ESTTA1235190**

Filing date: **09/12/2022**

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

Proceeding no.	91277331
Party	Plaintiff UncommonGoods, LLC
Correspondence address	BRETT M. TOLPIN TOLPIN & PARTNERS PC 30 N. LASALLE STREET, SUITE 1510 CHICAGO, IL 60602 UNITED STATES Primary email: docket@tolpinlaw.com 312.698.8971
Submission	Motion to Strike
Filer's name	Brett M. Tolpin
Filer's email	docket@tolpinlaw.com
Signature	/bmt/
Date	09/12/2022
Attachments	2022-09-12 Motion to strike.pdf(164926 bytes)

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

In the matter of: U.S. Ser. No. 88/854,957 – UNCOMMON GOOD

UNCOMMON GOODS, LLC,)	
)	
Opposer,)	Opposition No. 91277331
)	
v.)	
)	
UNCOMMON GOOD, INC.,)	
)	
Applicant.)	
)	

OPPOSER’S MOTION TO STRIKE AND SUPPORTING MEMORANDUM OF LAW

Opposer Uncommon Goods, LLC (“Opposer”) moves to strike certain of Applicant Uncommon Good, Inc.’s (“Applicant”) purported answer paragraphs and affirmative defenses from the pleading Applicant filed on August 8, 2022. As described more fully below, certain of Applicant’s answer paragraphs do not fairly admit or deny the substance of Opposer’s corresponding allegations, and certain of Applicant’s purported affirmative defenses are insufficient, redundant, or lacking in the necessarily factual particularity. Opposer therefore respectfully requests that the Board strike the identified eight paragraphs of Applicant’s purported answer and the identified five of Applicant’s purported affirmative defenses.

I. LEGAL STANDARDS

In general, the Board may strike from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. TBMP 506.01; Fed. R. Civ. P. 12 (f). The Board evaluates motions to strike in the context of the principle that the primary purpose of pleadings is to give fair notice of the claims or defenses asserted. TBMP 506.01. While motions

to strike are not favored, the Board has granted and will grant such motions in appropriate circumstances, such as where a purported affirmative defense fails to plead sufficient facts, amounts to a redundant denial, or is contrary to applicable rules or case law. *Id.*

II. ARGUMENT

A. **Eight of the Numbered Paragraphs in Applicant’s Purported Answer Should Be Stricken for Failure to Respond to the Substance of the Corresponding Allegations.**

For each factual allegation in a Notice of Opposition, an answering applicant has essentially three options: The applicant must either admit the allegation, deny the allegation (TBMP 311.02(a); Fed R. Civ. P. 8(b)(1)(B)), or state that it lacks knowledge or information sufficient to form a belief about the truth of the allegation. TBMP 311.02(a); Fed R. Civ. P. 8(b)(5). At the same time, the applicant’s choice of how to respond must also be shaped by the overarching principle that “a denial of an allegation should fairly meet the substance of the allegation denied.” TBMP 311.02(a); *see* Fed R. Civ. P. 8(b)(2).

A significant number of the present Applicant’s responses to the numbered paragraphs of the Notice of Opposition amount to none of the three options of an admission, denial, or statement of lack of knowledge or information. As such, those responses fail to fairly meet the substance of the corresponding allegations. All of the problematic responses suffer from the same basic flaw, which can be seen in the response to Notice of Opposition paragraph 4. That paragraph alleges:

Opposer is the owner of U.S. Trademark Registration No. 2,719,619 for the mark UNCOMMON GOODS in International Class 35 for “On-line retail store services featuring home furnishings, textiles, crafts, jewelry, food, apparel accessories, furniture, toys, and table tops.”

Notice of Opposition ¶ 4. Applicant responded to this allegation by stating:

Applicant admits that the USPTO's TSDR system indicates that Opposer is the current owner of record for U.S. Trademark Registration No. 2,719,619 covering "ON-LINE RETAIL STORE SERVICES FEATURING HOME FURNISHINGS, TEXTILES, CRAFTS, JEWELRY, FOOD, APPAREL AND APPAREL ACCESSORIES, FURNITURE, TOYS, AND TABLE TOPS."

Opposer's August 8, 2022 Answer ¶ 4. Although facially styled as an admission, the substance of the response is only that the "USPTO's TSDR system indicates" certain things. This type of response effectively sidesteps the substance of the allegation rather than fairly meeting it. The allegation is not about what the "USPTO's TSDR system" says, but rather what the underlying substantive facts are. Moreover, Opposer cannot tell from this response whether Applicant is admitting for the purpose of this proceeding the accuracy and truthfulness of the USPTO records, or will challenge that accuracy during the proceeding. Because the response does not properly respond to its corresponding allegation, it offers an immaterial statement rather than an answer, and therefore should be stricken.

Applicant's purported answers to each of Notice of Opposition paragraphs 5, 6, 7, 8, 9, 10, and 12 suffer from the exact same problem. Each of those responses admits that the "USPTO's TSDR system indicates" certain things, rather than admitting, denying, or claiming lack of knowledge of the underlying alleged facts. These responses are improper and immaterial, and they fail to provide a solid foundation on which to define the scope of discovery in the opposition proceeding. Each of these purported answer paragraphs should be stricken as well.

B. Applicant's Sixth Affirmative Defense Must Be Stricken for Failure to Plead Fraud With Particularity.

Applicant's Sixth Affirmative Defense is legally insufficient because it attempts to allege fraud on the Trademark Office without the required level of particularity. "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *In re Bose Corp.*, 580 F.3d 1240,

1243 (Fed. Cir. 2009). In order to plead fraud or mistake before the Board, “a party must state with particularity the circumstances constituting fraud or mistake.” Fed. R. Civ. P. 9(b); 37 C.F.R. § 2.106(b)(2). The Federal Circuit has interpreted the particularity requirement of Rule 9(b) to require “identification of the specific who, what, when, where and how of the material misrepresentation or omission committed before the PTO.” *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1212, 1327 (Fed. Cir. 2009). See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 1010 (CCPA 1981) (in pleadings before the Trademark Trial and Appeal Board, “Rule 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud”). These requirements apply equally to a claim of unclean hands if that claim is based on factual allegations of a fraudulent nature, as “[a] claim that ‘sounds in fraud’ – in other words, one that is premised on a course of fraudulent conduct – can implicate Rule 9(b)’s heightened pleading requirements.” *Borsellino v. Goldman Sachs Group, Inc.*, 477 F.3d 502 (7th Cir. 2007).

Applicant’s Sixth Affirmative Defense does not come close to meeting the requirement that it identify the “specific who, what, when, where and how” of the supposed fraud on the Trademark Office. It alleges only that Opposer added certain services “to its pending applications in a bad faith attempt to preclude Applicant’s application from registering.” Opposer’s August 8, 2022 Affirmative Defenses ¶ 6. Applicant does not even allege that Opposer’s act of adding those services to unspecified pending applications involved any false representations, much less what the specific false representations were, who made them, when they were made, or what made them false. The allegation contains only the vaguest implication that something wrong or fraudulent occurred, rather than any specific statement of the nature and circumstances of the supposed false and material representations. As such, Applicant’s Sixth

Affirmative Defense fails to plead with the particularity required by Rule 9(b), and must be stricken in its entirety.

C. Applicant's First Affirmative Defense Must Be Stricken Because Failure to State a Claim is Not a Proper Affirmative Defense.

Applicant's First Affirmative Defense consists of a bare recital that "Opposer fails to state a claim upon which relief may be granted." Opposer's August 8, 2022 Affirmative Defenses ¶ 1. This is not a legally sufficient defense, as "[a]n assertion that a pleading fails to state a claim upon which relief can be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading rather than a statement of a defense to a properly pleaded claim." *Great Adirondack Steak & Seafood Café, Inc. v. Adirondack Pub & Brewery, Inc.*, 2015 TTAB LEXIS 321, *9 (TTAB, Mar. 30, 2015) (citing *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 U.S.P.Q.2d 1733, 1738 n.7 (TTAB 2001)). As such, Applicant's First Affirmative Defense is legally insufficient and must be stricken.

D. Applicant's Eleventh Affirmative Defense Must Be Stricken Because It Is Nothing More Than A Bald Recital of Estoppel.

Applicant's Eleventh Affirmative Defense consists of a bare recital that "Opposer's claims are barred by estoppel." Opposer's August 8, 2022 Affirmative Defenses ¶ 11. This bald and conclusory allegation is not a legally sufficient defense because it gives absolutely no indication of the factual basis for the defense. "The elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense." TBMP § 311.02(b). *See also IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Because Appellant's Eleventh Affirmative Defense fails to give Opposer fair notice of the factual basis for the supposed estoppel, it is

insufficient and must be stricken.

E. Applicant's Second and Seventh Affirmative Defenses Must Be Stricken Because They Merely Restate Certain of Applicant's Denials.

A purported affirmative defense which merely restates and adds nothing to a denial which an applicant has already made to an opposer's allegations is redundant and should be stricken. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). On the other hand, an affirmative defense which amplifies an applicant's denials of an opposer's allegations, meaning that it gives the opposer more complete notice of the applicant's position, will generally not be stricken as redundant. *Id.* Both of the present Applicant's Second and Seventh Affirmative Defenses fall into the redundant category and must be stricken.

Applicant's Second Affirmative Defense states in its entirety that "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." Opposer's August 8, 2022 Affirmative Defenses ¶ 2. This is a simple restatement of Opposer's denial of Applicant's paragraph 29, which alleges such damage in that "Registration of Applicant's mark as shown in the application would interfere with Opposer's enjoyment of its rights in its UNCOMMON GOODS, UNCOMMONGOODS, UNCOMMON GIFTS, UNCOMMONGIFTS, AND UNCOMMON marks." Notice of Opposition ¶ 29. The Second Affirmative Defense offers no reasons for the alleged lack of damage, and no information which amplifies or explains that lack. As such, it is merely redundant and must be stricken.

Applicant's Seventh Affirmative Defense states that "The term UNCOMMON is merely descriptive of Opposer's goods and services that are unconventional, rare, or atypical." Opposer's August 8, 2022 Affirmative Defenses ¶ 7. Previously, Applicant had denied

Applicant's paragraph 18, which alleges that "The common or unifying term "uncommon" in Opposer's family of marks is distinctive of Opposer's services." Notice of Opposition ¶ 18. Applicant's assertion that "uncommon" is merely descriptive of Opposer's services is functionally the same thing as denying that "uncommon" is distinctive of those services, because "distinctive" and "merely descriptive" are opposite and mutually exclusive conclusions in a trademark analysis. *See Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 505-506 (9th Cir. 2011) ("... a descriptive mark that lacks secondary meaning is not distinctive and is not entitled to trademark protection.") As a result, Applicant's assertion that "uncommon" is merely descriptive of Opposer's services does not amplify or offer any new information about its denial that "uncommon" is distinctive of the same services, and the Seventh Affirmative Defense must be stricken.

Conclusion

The Board should strike from Applicant’s August 8, 2022 pleading answer paragraphs 4, 5, 6, 7, 8, 9, 10, and 12. The Board should also strike from the same pleading Applicant’s purported First, Second, Sixth, Seventh, and Eleventh affirmative defenses.

Respectfully submitted,



Dated: September 12, 2022

By _____
Brett M. Tolpin
Mark R. Bagley
Tolpin & Partners, PC
30 N. LaSalle Street, Suite 1510
Chicago, IL 60602
Telephone: (312) 698-8971
Fax: (312) 803-9602
E-mail: docket@tolpinlaw.com

Attorneys for Uncommon Goods, LLC

CERTIFICATE OF SERVICE

I hereby certify that a copy of this Opposer’s Motion to Strike and Supporting Memorandum of Law is being served by e-mail on September 12, 2022 to Stephen McNamara, St. Onge Steward Johnston & Reens LLC, 986 Bedford Street, Stamford, CT 06905 at smcnamara@ssjr.com and litigation@ssjr.com.



Brett M. Tolpin
Tolpin & Partners, PC.
30 N. LaSalle Street, Suite 1510
Chicago, Illinois 60602