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

Proceeding	92053896
Party	Defendant Dervaes Institute
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Submission	Answer
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Date	05/13/2011
Attachments	92053896 URBAN HOMESTEADING Denver - Answer - FINAL.pdf ( 10 pages ) (42036 bytes )

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

Denver Urban Homesteading, LLC  
Petitioner,

v.

Dervaes Institute,  
Respondent.

Cancellation No. 92053896

Registration No. 3633366

Mark:

**URBAN HOMESTEADING**

**ANSWER TO PETITION TO CANCEL**

The following is the Answer of Dervaes Institute (hereinafter “Registrant”) to the Petition to Cancel filed on April 11, 2011 and assigned Cancellation No. 92053896. Registrant hereby responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Petition to Cancel, as follows:

1. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 and therefore denies same.
2. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 2 and therefore denies same.
3. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 3 and therefore denies same.
4. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 4 and therefore denies same.
5. Denied.

6. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 6 and therefore denies same.

7. Denied as Petitioner's use of "urban homesteading" in lowercase lettering; admitted as to the remaining allegations in Paragraph 7.

8. Denied.

9. Admitted regarding Registrant's URBAN HOMESTEADING® trademark application Serial No. 77326565.

10. Admitted regarding Registrant's URBAN HOMESTEADING® trademark Registration No. Serial No. 3633366.

11. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 11 and therefore denies same.

12. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 12 and therefore denies same.

13. Admitted that Registrant sent a letter to James Bertini dated February 15, 2011 and that Registrant requested that improper use of URBAN HOMESTEADING® cease.

Registrant lacks information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in Paragraph 13 and therefore denies same.

14. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 14 and therefore denies same.

15. Admitted.

16. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 16 and therefore denies same.

17. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 17 and therefore denies same.

18. Denied.

19. Denied as Petitioner's use of "urban homesteading" in lowercase lettering; admitted as to the remaining allegations in Paragraph 19.

20. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 20 and therefore denies same.

21. Registrant admits that Exhibit D consists of part of a complaint it submitted to Google.

22. The statements in Paragraph 22 appear to be speculation or opinion, and not statements of fact, and therefore are not appropriate for admission or denial. As a result, Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 22 and therefore denies same.

23. The statements in Paragraph 25 appear to be speculation or opinion, and not statements of fact, and therefore are not appropriate for admission or denial. As a result, Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 23 and therefore denies same.

24. The statements in Paragraph 24 appear to be speculation or opinion, and not statements of fact, and therefore are not appropriate for admission or denial. As a result, Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 24 and therefore denies same.

25. The statements in Paragraph 25 appear to be speculation or opinion, and not statements of fact, and therefore are not appropriate for admission or denial. As a result,

Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 25 and therefore denies same.

26. Registrant admits that Exhibit E consists of a letter sent by counsel on behalf of Registrant.

27. Denied. The text of the letter in Exhibit D speaks for itself.

28. The statements in Paragraph 28 appear to be speculation or opinion, and not statements of fact, and therefore are not appropriate for admission or denial. As a result, Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 28 and therefore denies same.

29. The statements in Paragraph 29 appear to be speculation or opinion, and not statements of fact, and therefore are not appropriate for admission or denial. As a result, Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 29 and therefore denies same.

30. Denied.

31. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 31 and therefore denies same.

32. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 32 and therefore denies same.

33. Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 33 and therefore denies same.

34. Denied.

35. Denied.

36. Denied.

37. The USPTO records speak for themselves.

38. Because the statements in Paragraph 38 are not specific as to the time and as to other details including the types of use referenced, Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 31 and therefore denies same.

39. Admitted that Registrant's allegation of use for Application Serial No. 77326565, filed on February 2, 2009, alleges first use in commerce date of March 6, 2002; denied as to any other allegations in Paragraph 39.

40. Paragraph 40 does not call for an admission or denial as the statute referenced speaks for itself.

41. Denied.

42. Denied. The USPTO records speak for themselves.

43. Denied.

44. Denied.

45. Registrant lacks information sufficient to form a belief as to the truth or falsity of the vague allegations contained in Paragraph 45 and therefore denies same.

46. Registrant lacks information sufficient to form a belief as to the truth or falsity of the vague allegations contained in Paragraph 46 and therefore denies same.

47. Admitted.

48. Denied. Dervaes Institute and its predecessors have used the URBAN HOMESTEADING® mark since at least 2002.

49. Denied.

50. Denied.

51. Denied.
52. Denied.
53. Paragraph 53 is not a statement of fact and does not require an admission or denial.
54. Denied.
55. Denied.
56. Denied.
57. Paragraph 57 is not a statement of fact and does not require an admission or denial.
58. Denied.

#### **Registrant's Statements**

In addition, Registrant sets forth the following statements in support of its defenses:

59. The Dervaes family has been practicing sustainable living and educating others about its practices and benefits for more than 25 years. Their work has been documented and shared online at [www.urbanhomestead.org](http://www.urbanhomestead.org) and other websites since 2001, receiving national and international media attention. Additionally, the Dervaes family produced an award-winning short documentary film about its work, called *Homegrown Revolution* which has been featured at film festivals around the world and on *Oprah's* 2009 Earth Day television special.

60. Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

61. Where the mark is a phrase, it is generic only if the composite mark as a whole is found to be generic. *In re American Fertility Society*, 188 F. 3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine because where the mark is a phrase evidence that each separate term is generic is not sufficient). *See also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for telephone shop-at-home retail services in the field of mattresses because it “bears closer conceptual resemblance to a phrase than a compound word” and there is no evidence of record that the mark as a whole is generic); *and In re Active Ankle Systems Inc.*, 83 USPQ2d 1532 (TTAB 2007) (DORSAL NIGHT SPLINT found generic for orthopedic splints for the foot and ankle based on record that included third-party use of the entire phrase).

62. “[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration.” *Magic Wand Inc. v. RDB Inc.*, 940 F. d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

63. The test for genericness “is to be applied to a mark... as a whole, for the whole may be greater than the sum of its parts.” *In re American Fertility*, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999).

64. If the relevant term is merely descriptive, but not generic, the mark may be registered on the Principal Register with a proper showing of acquired distinctiveness under §2(f), or on the Supplemental Register, if appropriate. *See Express Mortgage Brokers Inc. v. Simpson Mortgage Inc.*, 31 USPQ2d 1371 (E.D. Mich. 1994).

65. The URBAN HOMESTEADING mark in Registrant’s Registration No. 3633366 is not generic with regard to the relevant services, namely, “Educational services, namely,



conducting informal programs in the fields of sustainable living, organic foods and gardening, the environment, and conservation, using on-line activities and interactive exhibits; entertainment services, namely, providing a web site featuring photographic, audio and video featuring sustainable living, organic foods and gardening, the environment, and conservation; on-line journals, namely, blogs featuring sustainable living, organic foods and gardening, the environment and conservation.”

66. Registrant has used the mark in Registration No. 3633366 in commerce since at least 2002 in connection with “Educational services, namely, conducting informal programs in the fields of sustainable living, organic foods and gardening, the environment, and conservation, using on-line activities and interactive exhibits; entertainment services, namely, providing a web site featuring photographic, audio and video featuring sustainable living, organic foods and gardening, the environment, and conservation; on-line journals, namely, blogs featuring sustainable living, organic foods and gardening, the environment and conservation.”

Applicant hereby appoints Erik M. Pelton, a member of the Bars of the State of New Jersey and the District of Columbia, and Mark L. Donahey, a member of the Bar of the Commonwealth of Virginia, at the firm of:

Erik M. Pelton & Associates, PLLC  
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to act as attorneys in the matter of the cancellation identified above, to prosecute said cancellation, to transact all business in the Patent and Trademark Office connected with the

cancellation, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

WHEREFORE, Registrant requests dismissal of the Petition to Cancel and such other and further relief as may be just and proper.

Dated this 13th day of May, 2011.



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Attorney for Respondent

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of ANSWER TO PETITION TO CANCEL has been served on the following by delivering said copy on May 13, 2011, via First Class Mail, to counsel for Petitioner at the following address:

JAMES BERTINI  
415 KALAMATH STREET  
DENVER, CO 80204



By: \_\_\_\_\_

Erik M. Pelton, Esq.