

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

In the matter of trademark Registration No. 3,855,377
For the mark: URBAN HOMESTEAD
Date registered: October 5, 2010

In the matter of trademark Registration No. 3,633,366
For the mark: URBAN HOMESTEADING
Date registered: June 2, 2009

KELLY COYNE, ERIK KNUTZEN,)
PROCESS MEDIA, INC.)

 Petitioners)

 v.)

DERVAES INSTITUTE,)

 Registrant)

Cancellation No.: _____

PETITION TO CANCEL

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Petitioners, Kelly Coyne and Erik Knutzen, are authors of *The Urban Homestead: Your Guide to Self-sufficient Living in the Heart of the City* (hereinafter “The Urban Homestead book”), with address at 1327 McCollum Street, Los Angeles, CA, 90026 (“Petitioners Coyne and Knutzen”) and Petitioner Process Media, Inc. (“Petitioner Process Media”) is the publisher of The Urban Homestead book, with address at 1240 W. Sims Way, Suite 124, Port Townsend, WA, 98368 (hereinafter referred to collectively as “Petitioners”).

To the best of Petitioners’ knowledge, the name and address of the current owner of U.S. Registration No. 3,855,377 for URBAN HOMESTEAD and U.S. Registration No. 3,633,366 for URBAN HOMESTEADING (the “Registrations”) is the Dervaes Institute, 631 Cypress Avenue, Pasadena, CA, 91103 (“Registrant”).

Petitioners are currently and will continue to be damaged by the Registrations, and hereby petition to cancel the same.

The grounds for cancellation are as follows:

The Terms Urban Homestead and Urban Homesteading Are Descriptive of Registrant's Applied For Services and Generic

1. The word "urban" is defined as "of, relating to, characteristic of, or constituting a city." Attached as Exhibit A is a print out from the Merriam-Webster online dictionary.

2. The word "homestead" is defined as "the home and adjoining land occupied by a family." Attached as Exhibit B is a print out from the Merriam-Webster online dictionary.

3. "Urban homesteading" is commonly known as the practice of sustainable living techniques in urban areas, including growing food, raising livestock, producing simple food products, conserving energy, and generating energy from environmentally-friendly sources.

4. An "urban homestead" is commonly known as a suburban or city dwelling where the inhabitant incorporates the sustainable living techniques of urban homesteading.

5. Individuals who practice urban homesteading seek to become self-sustaining in food and energy production. To this end, many urban homesteaders supplement their income with income from the urban homestead itself, by writing or teaching about their lifestyle, selling produce, and/or selling other related products. Many urban homesteaders promote and communicate with each other about urban homesteading and their urban homesteads through web sites, blogs, publications, and educational workshops. In addition, urban homesteaders educate and promote urban homesteading among the general public as an environmentally-friendly and healthful alternative to typical urban consumption.

6. Petitioners Coyne and Knutzen have been living on an urban homestead in Los Angeles, California since 1998. They actively practice urban homesteading by raising chickens, growing and preserving fruits and vegetables, recycling water, and using solar energy.

7. Like other urban homesteaders, Petitioners Coyne and Knutzen seek to share their knowledge about urban homesteading and reduce their need for outside income. They have actively used the terms “urban homestead” and “urban homesteading” on their website, <http://www.rootsimple.com> (formerly at <http://www.homegrownevolution.com>) since 2006. In 2006, in furtherance of these goals, Petitioners Coyne and Knutzen began writing The Urban Homestead book, which Petitioner Process Media published in June 2008. The Urban Homestead book is an educational how-to guide that teaches other city-dwellers how to create their own urban homesteads.

Registrant and Its Generic and Descriptive Use of the Terms Urban Homestead And Urban Homesteading

8. Upon information and belief, Registrant, the Dervaes Institute, was founded and is operated by Jules Dervaes (“Dervaes”) to support and promote his family’s urban homestead in Pasadena, California.

9. Like many urban homesteaders, Registrant operates a website (currently located at <http://www.urbanhomestead.org>, formerly at <http://www.pathtofreedom.com>) that promotes urban homesteading, sells produce, and presents workshops that teach others about how to start an urban homestead.

10. Registrant’s uses of the terms “urban homestead” and “urban homesteading” are not unique or distinctive, but are rather consistent with other third party uses and common understanding of the terms dating back decades.

11. On Registrant’s website, Registrant provides the following definition for the term “urban homestead”:

“n. 1 a suburban or city home in which residents practice self-sufficiency through home food production and storage.

n. 2 the home and garden of a person or family engaging in sustainable small-scale agriculture and related activities designed to reduce environmental impact and increase self-sufficiency.

n. 3 a name describing the home of a person or family living by principals of low-impact, sustainable self-sufficiency through activities such as gardening for food production, cottage industry, extensive recycling, and generally simple living.”

Attached as Exhibit C is a copy of a printout from Registrant’s website.

12. On Registrant’s website, Registrant utilizes “urban homestead” as a generic term: *“My neighbors’ urban homestead is so productive, they’re able to live entirely on food they grow themselves.” See Exhibit C.*

13. On Registrant’s website, Registrant provides the following definition for the term “urban homesteading”:

“v. 1 the act of transforming a city or suburban home into a property that produces some or all of its residents own food and other subsistence needs.

v. 2 participation in home-based activities such as gardening, raising poultry or small livestock, producing simple products through cottage industry, minimizing consumer purchases, and generally seeking ways to increase self-sufficiency in a city or suburban environment.

v. 3 the creation of an urban homestead with the goal of reducing one’s environmental impact and returning to a home-based, family-centered, self-sufficient way of life.”

See Exhibit C.

14. On Registrant’s website, Registrant utilizes “urban homesteading” as a generic term: *“Their urban homesteading started with a small vegetable garden, but over time they become so self-sufficient that the family could sustain itself in the middle of the city without working any outside jobs.” See Exhibit C.*

Registrant’s Improper Acquisition Of Federal Trademark Registrations For Urban Homestead And Urban Homesteading

15. Despite Registrant’s knowledge of the widespread and common use of the term “urban homestead” by others, Registrant filed a trademark application on September 19, 2008 for the term “urban homestead,” Application Serial No. 77574809.

16. On April 29, 2009, the U.S. Patent & Trademark Office (“PTO”) issued a final office action denying registration of Application Serial No. 77574809 on multiple grounds, including “mere descriptiveness.”

17. On June 9, 2010, Registrant provided a Section 2(f) Declaration in connection with Application Serial No. 77574809 swearing that “[t]he mark has become distinctive of the goods/services through the applicant’s substantially exclusive and continuous use in commerce for at least five years immediately before the date of this statement.”

18. On October 5, 2010, Registrant was granted federal Registration No. 3,855,377 on the principal register for “urban homestead” in class 41 for:

“Educational services, namely, conducting informal programs in the fields of sustainable living, organic foods and gardening, homesteading, the environment, and conservation, using on-line activities and interactive exhibits; entertainment services, namely, providing a web site featuring photographs and audio and video recordings featuring instruction and current events reporting on sustainable living, organic foods and gardening, the environment, and conservation; on-line journals, namely, blogs featuring the subjects of sustainable living, organic foods and gardening, the environment, and conservation.”

19. Despite Registrant’s knowledge of the widespread and common use of the term “urban homesteading” by others, Registrant filed another trademark application on November 10, 2007 for the term “urban homesteading,” Application Serial No. 77326565.

20. On October 16, 2008, the PTO issued a final office action refusing to register the urban homesteading mark on the grounds of mere descriptiveness. The final office action explained that “‘urban homesteading’ typically refers to sustainable living practiced in a city environment” and that “the applicant is providing educational services centered on urban homesteading,” rendering its use of the term merely descriptive. The examiner attached Internet evidence including an article on urban homesteading authored by Petitioners Coyne and Knutzen.

21. On March 14, 2009, the PTO issued another office action confirming the descriptiveness refusal and suggesting amendment to the supplemental register.

22. On April 6, 2009, the Registrant amended its application Serial No. 77326565 to seek registration on the supplemental register.

23. On June 2, 2009, Registrant was granted federal Registration No. 3,633,366 on the supplemental register for “urban homesteading” in class 41 for:

“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.”

Petitioners And Other Urban Homesteaders Are Being And Will Continue To Be Damaged By The Registrations

24. Petitioners have long known Dervaes as a fellow urban homesteader. However, it was not until February 2011 that Petitioners learned that Dervaes was attempting to enforce trademark rights – or exclusive rights – to the terms “urban homestead” and “urban homesteading” by threatening other urban homesteaders who used the terms and preventing the display of other urban homesteaders’ online content.

25. In February 2011, the social networking website Facebook informed Petitioner Process Media that Facebook had received correspondence from Registrant demanding that Facebook take down portions of Process Media’s Facebook website because two web pages, one describing news articles concerning Petitioners Coyne and Knutzen and The Urban Homestead book and another displaying the cover of The Urban Homestead book, contained alleged unauthorized use of Registrant’s “urban homestead” trademark.

26. In response to Registrant’s threats, Facebook took down the relevant portions of Petitioner Process Media’s website.

27. To date, citing Registrant’s registration for URBAN HOMESTEAD, Facebook refuses to reinstate the affected portions of the Process Media Facebook website.

28. Due to widespread use of the terms “urban homestead” and “urban homesteading,” neither term is distinctive or capable of becoming distinctive of the services of

any one entity related to an urban homestead or urban homesteading, including Registrant, and no consumer recognition of either term as solely identifying Registrant has been achieved.

29. Registrant's use of the Registrations to demand the removal of online materials directly interferes with Petitioners' ability to promote The Urban Homestead book, and continue to discuss, promote, and educate others about urban homesteading.

30. Petitioners have since learned that Registrant has sent many similar threatening letters to other urban homesteaders and/or other online service providers concerning other urban homesteaders' online content.

31. Registrant's actions to enforce trademark rights in and to the terms "urban homestead" and "urban homesteading" prevent others from accurately describing and educating others about urban homesteading and creating an urban homestead.

32. Registrant's continued registration and enforcement of the Registrations will cause irreparable harm to Petitioners and will unjustly inhibit Petitioners' ability to educate others about and promote the benefits of urban homesteading and creating an urban homestead.

COUNT I
REGISTRANT'S URBAN HOMESTEAD REGISTRATION SHOULD BE
CANCELLED AS THE TERM "URBAN HOMESTEAD"
IS MERELY DESCRIPTIVE
15 U.S.C .§ 1052(e)

33. Petitioners incorporate all previous paragraphs by reference.

34. The term "urban homestead" refers to a suburban or city home in which inhabitants engage in such urban homesteading techniques as "sustainable living," "organic foods and gardening," "environmental consciousness," and "conservation."

35. "Urban homestead" is merely descriptive of the services recited in Registrant's URBAN HOMESTEAD Registration or descriptive of a significant feature of the services because the term "urban homestead" refers to the subject matter of Registrant's services.

36. The term "urban homestead" is necessary to accurately describe the subject matter of Petitioners' and other third parties' educational and promotional services.

37. Petitioners and other third parties have the right to use the term “urban homestead” in connection with describing the subject matter of their educational and promotional services.

38. The term “urban homestead” has not acquired distinctiveness with respect to the services recited in Registrant’s U.S. Registration 3,855,377

39. If Registrant is allowed to continue to maintain its registration for URBAN HOMESTEAD, Registrant would be able to continue to improperly obstruct Petitioners’ as well as other third parties’ descriptive use of the term.

40. Because the term “urban homestead” is merely descriptive of Registrant’s services, Registrant’s U.S. Registration 3,855,377 should be cancelled.

COUNT II
REGISTRANT’S URBAN HOMESTEAD REGISTRATION SHOULD BE
CANCELLED AS THE TERM “URBAN HOMESTEAD”
IS GENERIC
15 U.S.C .§ 1064(3)

41. Petitioners incorporate all previous paragraphs by reference

42. Registrant is not entitled to exclusive use of the term “urban homestead” in commerce for the services specified in U.S. Registration No. 3,855,377.

43. The general public would not understand or believe that educational services offered in connection with the term “urban homestead” refer to Registrant.

44. The term “urban homestead” is generic for a suburban or city dwelling where the inhabitant incorporates the sustainable living techniques of urban homesteading, and therefore generic with regard to the educational and promotional services concerning such dwellings.

45. The term “urban homestead” is necessary to accurately describe the subject matter of Petitioners’ and other third parties’ educational and promotional services.

46. Petitioners and other third parties have the right to use the term “urban homestead” in connection with educational and promotional services concerning such dwellings and lifestyle.

47. If Registrant is allowed to continue to maintain its registration for URBAN HOMESTEAD, Registrant would be able to continue to improperly obstruct Petitioners' as well as other third parties' descriptive use of the terms.

48. Because the term "urban homestead" is incapable of serving as an indicator of source, Registrant's U.S. Registration 3,855,377 should be cancelled.

COUNT III
REGISTRANT'S URBAN HOMESTEAD REGISTRATION SHOULD BE CANCELLED
BECAUSE IT WAS FRAUDULENTLY OBTAINED
15 U.S.C. § 1064(3)

49. Petitioners incorporate all previous paragraphs by reference.

50. During the prosecution of U.S. Registration No. 3,855,377, Registrant knowingly made false and material misrepresentations to the PTO with the intent to deceive the PTO into issuing a registration.

51. In Registrant's Section 2(f) Declaration, Registrant swore that Registrant had substantially exclusive and continuous use in commerce of URBAN HOMESTEAD for at least the five years before June 9, 2010. These statements are false and were made with the intent to deceive the PTO into issuing a registration.

52. Petitioners believe and therefore allege that Registrant knew at the time Registrant filed its Section 2(f) Declaration that the term "urban homestead" was in widespread use by others.

53. When Registrant filed its Section 2(f) Declaration, Registrant knew of Petitioners' use of the term in the title of The Urban Homestead book.

54. The PTO relied upon Registrant's statements when it determined that U.S. Registration No. 3,855,377 should issue. But for Registrant's statements, the PTO would not have issued Registration No. 3,855,377.

55. Registrant's actions in connection with the prosecution of U.S. Registration No. 3,855,377 constitute fraud such that U.S. Registration No. 3,855,377 is invalid and should be cancelled.

COUNT IV

REGISTRANT'S URBAN HOMESTEADING REGISTRATION SHOULD BE CANCELLED
BECAUSE THE TERM "URBAN HOMESTEADING" IS NOT CAPABLE OF
DISTINGUISHING REGISTRANT'S SERVICES
UNDER 15 U.S.C. § 1091(a)

56. Petitioners incorporate all previous paragraphs by reference.

57. Urban homesteading frequently encompasses activities "in the fields of sustainable living, organic foods and gardening, the environment, and conservation," and urban homesteading is often promoted through "providing a web site featuring photographic, audio and video featuring sustainable living, organic foods and gardening, the environment, and conservation" and through "on-line journals, namely, blogs featuring sustainable living, organic foods and gardening, the environment and conservation."

58. URBAN HOMESTEADING is and has been for decades used as a common term for the services described in U.S. Registration No. 3,633,366.

59. Because the term "urban homesteading" is incapable of distinguishing Registrant's services under 15 U.S.C § 1091(a), U.S. Registration No. 3,633,366 should be cancelled.

COUNT V

REGISTRANT'S URBAN HOMESTEADING MARK WAS NOT IN LAWFUL USE IN
COMMERCE UNDER 15 U.S.C. § 1091(a) PRIOR TO THE FILING DATE

60. Petitioners incorporate all previous paragraphs by reference.

61. Registrant did not engage in exclusive use in commerce of the term "urban homesteading" in reference to the services described in U.S. Registration No. 3,633,366.

62. Other urban homesteaders, including Petitioners, have engaged in widespread and continuous use in commerce of the term "urban homesteading" to educate and promote the benefits and techniques prior to Registrant's application date. Specifically, Petitioners have been using the term to promote The Urban Homestead book continuously since June 2008.

63. URBAN HOMESTEADING was not in lawful use by Registrant in commerce in connection with the services recited in U.S. Registration No. 3,633,366 prior to the application date as required by 15 U.S.C § 1091(a).


64. Because "urban homestead" was not in lawful use by Registrant in commerce in connection with the services, U.S. Registration No. 3,633,366 should be cancelled.

WHEREFORE, Petitioners respectively request that the Board grant Petitioners' Petition to Cancel and cancel U.S. Registration Nos. 3,855,377 and 3,633,366.

Please charge the requisite filing fee prescribed by 37 C.F.R. § 2.6(a)(17) to Deposit Account No. 501814 as well as any additional fees due in connection with this Opposition.

Please direct all correspondence relating to this matter to the attorneys for Petitioners at the address shown below.

Dated: April 4, 2011

By: 
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CERTIFICATE OF SERVICE

re: Kelly Coyne, Erik Knutzen, Process Media, Inc. v. Dervaes Institute

I hereby certify that a true and complete copy of the foregoing:

PETITION TO CANCEL

has been served on Registrant's counsel of record, Erik M. Pelton, by mailing said copy on April 4, 2011 via First Class Mail, postage prepaid, to:

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Reyna Motley