UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: March 22, 2017

Cancellation No. 92053837

Kelly Coyne, Erik Knutzen, and Process Media, Inc.

v.

Dervaes Institute

Before Zervas, Wellington, and Masiello,
Administrative Trademark Judges.

By the Board:

On April 4, 2011, Petitioners filed a petition to cancel Respondent's registrations (1) on the Supplemental Register for the wording URBAN HOMESTEADING,[1] and (2) on the Principal Register for the wording URBAN HOMESTEAD,[2] both for nearly identical "[e]ducational services,"

[1] Registration No. 3633366, issued June 2, 2009, Section 8 affidavit accepted. The complete recitation of services of this registration is as follows: "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." This registration was cancelled on January 5, 2017, in accordance with a court determination, as discussed later in this order.[Because this surprised me; and I spent time looking at the record before I realized you were discussing it later.]

[2] Registration No. 3855377, issued on October 5, 2010, Section 8 affidavit accepted. The registration includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). The complete recitation of services of this registration

"entertainment services," and "on-line journals" in International Class 41. In the petition to cancel, Petitioners contend that the terms URBAN HOMESTEAD and URBAN HOMESTEADING are merely descriptive and generic and are used as such by Respondent on its website. Accordingly, Petitioners seek cancellation of Respondent's registrations on the grounds that: (1) the term URBAN HOMESTEAD is merely descriptive and has not acquired distinctiveness; (2) the mark URBAN HOMESTEAD is generic; (3) Respondent committed fraud in obtaining its registration on the Principal Register for the URBAN HOMESTEAD mark in the declaration under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), during *ex parte* prosecution of the application for Registration No. 3855377; (4) the URBAN HOMESTEADING mark is incapable of distinguishing Respondent's services because it "is and has been for decades used as a common term for the [identified] services" in Registration No. 3633366; and (5) the URBAN HOMESTEADING mark was not in lawful use in commerce prior to the filing date of the application for Registration No. 3633366. 1 TTABVUE. Respondent, in its answer, denied the salient allegations of the petition to cancel and set

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is as follows: ""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".

forth additional arguments concerning its intended defense herein.[3] 5 TTABVUE.

Relevant procedural history

Because of the lengthy history of this proceeding, much of which bears on the resolution of the pending motions, we first provide a history of the proceeding and related Cancellation No. 92053896. On July 21, 2014, Petitioners filed a motion for summary judgment on the ground that the terms URBAN HOMESTEAD and URBAN HOMESTEADING are generic for the services recited in each of Respondent's involved registrations.[4] 81-85 TTABVUE. After full briefing of that motion, the Board, in a December 23, 2014 order (97 TTABVUE), noted that Respondent, in its response to the motion for summary judgment, referred to its having "successfully defend[ed]"

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[3] In a June 9, 2011 order, this proceeding was consolidated with Cancellation No. 92053896, styled *Denver Urban Homesteading, LLC v. Dervaes Inst.,* wherein Denver Urban Homesteading, LLC ("Denver") sought cancellation of Registration No. 3633366 on the Supplemental Register. 9 TTABVUE.

On October 6 and 9, 2012, respectively, Denver and Petitioners filed separate motions for summary judgment in these consolidated proceedings. Cancellation No. 92053896, 10 TTABVUE; 31-38 and 44 TTABVUE. In a February 19, 2013 order (52 TTABVUE), the Board declined to consider the separate motions for summary judgment, but indicated that Denver and Petitioners could file a single renewed motion for summary judgment. On March 13, 2013, Denver filed a request for reconsideration of the February 19, 2013 order (54 TTABVUE), which was denied in an August 12, 2013 order (61 TTABVUE).

In a March 31, 2014 order (77 TTABVUE), the Board denied Denver's request (filed January 6, 2014, 72 TTABVUE) for an immediate hearing on the merits in Cancellation No. 92053896 under Trademark Act Section 24, 15 U.S.C. § 1092, divided the consolidated proceedings, suspended Cancellation No. 92053896 pending dispostion of this proceeding, and resumed the above-captioned proceeding.

[4] Petitioners filed the renewed motion for summary judgment between the due date for its pretrial disclosures and the date on which its testimony period was to commence under the operative schedule at the time of such filing.

a civil action, namely, Case No. 1:13-cv-00917-REB-KMT, styled *Denver Urban Homesteading, LLC v. Dervaes Inst.,* in the United States District Court for the District of Colorado ("the Colorado case") (92 TTABVUE 7), deferred consideration of the renewed motion for summary judgment, and requested copies of the pleadings and any decisions regarding the alleged genericness of the involved marks in that case. On January 20, 2015, Respondent filed such copies. 98 TTABVUE.

In the complaint in the Colorado case (98 TTABVUE 14-36), filed April 10, 2013, Denver alleged, among other things, that: (1) because the mark URBAN HOMESTEADING is generic and "not capable of distinguishing" Respondent's services, Respondent's Registration No. 3633366 on the Supplemental Register for that mark should be cancelled; (2) Respondent's Registration No. 3633366 was obtained through fraud and therefore should be cancelled; (3) the URBAN HOMSTEADING mark was never in lawful use in commerce; (4) Respondent is liable to Denver for damages for injuries resulting from Respondent's fraud; and (5) because Respondent has no exclusive right to use the term URBAN HOMESTEADING, Denver is not infringing on Respondent's trademark rights. The record indicates that, in a March 28, 2014 decision, the Colorado case was dismissed, in relevant part, for lack of personal jurisdiction over the defendants. 98 TTABVUE 13, 205-214.

In an April 9, 2015 order (100 TTABVUE), the Board, having been made aware that, on December 1, 2014, Denver commenced Case No. 2:2014-cv-

09216, styled *Denver Urban Homesteading, LLC v. Dervaes Inst.*, in the United States District Court for the Central District of California ("the California case"), again deferred consideration of the renewed motion for summary judgment, and requested copies of the pleadings in the California case. On May 7, 2015 (101 TTABVUE 10-30), Respondent filed the requested copies. In the California case, Denver pleaded essentially the same claims as in the Colorado case. In response to Respondent's filing (102 TTABVUE), Petitioners requested that the Board decline to suspend this proceeding and instead rule on its pending motion for summary judgment.

On July 15, 2015, the district court in the California case issued an order to show cause why that case should not be suspended pending final determination of Cancellation Nos. 92053837 and 92053896. On July 20, 2015, Respondent filed, among other things, a copy of (1) the district court's order to show cause (103 TTABVUE). The district court discharged the order to show cause in a September 18, 2015 decision. After Denver, on October 2, 2015, filed a motion for summary judgment in the California case on the grounds of genericness and fraud, the Board in an October 19, 2015 order, suspended proceedings herein pending a decision on the motion for summary judgment in the California case (104 TTABVUE).

On November 25, 2015, Respondent filed a copy of a November 5, 2015 decision in the California case wherein the District Court granted partial summary judgment on the ground that the term URBAN HOMESTEADING

is generic for the recited services, but denied the motion for summary judgment "in all other respects" (105 TTABVUE 6-12). On December 7, 2015, Respondent filed copies of, among other things, the following documents from the California case: (1) a December 3, 2015 order in which the California case was dismissed with prejudice (107 TTABVUE 5), (2) the parties' stipulation (filed December 2, 2015 in the California case) for voluntary dismissal (107 TTABVUE 14), and (3) a stipulation (filed December 2, 2015 in the California case) for dismissal with prejudice and mutual general release.

On December 31, 2015, Respondent filed a motion for dismissal of the above-captioned proceeding in view of the dismissal with prejudice of the California case. In response thereto, Petitioners ask that the District Court's entry of summary judgment on the claim that the term URBAN HOMESTEADING is generic be given preclusive effect.

In related Cancellation No. 92053896, Denver, on March 3, 2016, filed a motion for entry of judgment on its genericness claim based on the November 5, 2015 order granting summary judgment on the genericness claim in the California case. In a July 28, 2016 order, the Board granted that motion, determining that the District Court's entry of summary judgment on the claim that the term URBAN HOMESTEADING is generic "survived, and was not superseded, by" the dismissal of the California case.[5] Cancellation No.

[5] The Board noted that, on February 1, 2016, the District Court issued a Form AO 120 "Report on the Filing or Determination of an Action Regarding a Patent or Trademark," by which it notified the USPTO that by "[o]rder dated November 5, 2015 (Dkt. No. 77) cancelling trademark 'urban homesteading'" the court had ordered the

92053896, 34 TTABVUE 10. Registration No. 3633366 was cancelled on January 5, 2017.

Respondent's motion to dismiss denied

Regarding Respondent's motion to dismiss based on the dismissal of the California case after the entry of partial summary judgment on the genericness claim with regard to the mark URBAN HOMESTEADING and Respondent's Registration No. 3633366 therefor, that case was limited to the mark URBAN HOMESTEADING and Registration No. 3633366. Respondent's involved Registration No. 3855377 for the mark URBAN HOMESTEAD was not at issue in either the California case or Cancellation No. 92053896. Further, in view of the Board's July 28, 2016 decision in Cancellation No. 92053896, the Board finds that dismissal of the above-captioned proceeding based on the dismissal of the California case is unwarranted.[6] Accordingly, Respondent's motion to dismiss is denied.

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cancellation of Respondent's Registration No. 3633366. Based thereon, the Board concluded that "the actions and statements of the district court following dismissal of the action clearly indicate that its determination on summary judgment survived dismissal. Indeed, by issuing the Form AO 120, the district court acted to effectuate the cancellation of the registration." Cancellation No. 92053896, 34 TTABVUE 8. The Board further noted that "the [United States] Court of Appeals for the Ninth Circuit has stated that 'district courts have been reversed for refusing to order the cancellation of registrations for claimed marks found to be incapable of serving as valid marks.'" *Id.* at 9 n.8, quoting *Gracie v. Gracie*, 217 F.3d 1060, 1065 (9th Cir. 2000).

[6] Time to appeal that decision to the United States Court of Appeals for the Federal Circuit or to commence a civil action in a United States district court expired with no appeal having been filed and no civil action having been commenced. *See* Trademark Act Section 21, 15 U.S.C. § 1071; Trademark Rule 2.145.

Preclusive effect of the California case

The entry of judgment in Cancellation No. 92053896 and the subsequent cancellation of Registration No. 3633366 does not dictate that judgment automatically be entered in this case. Under the Board's general practice, Petitioners would be allowed to decide whether they wish to go forward and obtain a judgment herein with regard to their claims against Registration No, 3633366 or have the claims dismissed as moot. However, Petitioners, in response to Respondent's motion to dismiss, asked that the District Court's determination that the term URBAN HOMESTEADING is generic for the services recited in Registration No. 3633366 be given preclusive effect. *See B&B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S.Ct 1293, 113 USPQ2d 2045, 2053 (2015) ("When a district court, as part of its judgment, decides an issue that overlaps with part of the TTAB's analysis, the TTAB gives preclusive effect to the court's judgment."). Therefore, we presume that Petitioners do not wish to have the genericness claim against the mark URBAN HOMESTEAD and the accompanying registration for that mark dismissed as moot and will determine whether application of the doctrines of claim preclusion (also known as *res judicata*) or issue preclusion (also known as collateral estoppel) are warranted herein with regard to the genericness claim against that mark and Registration No. 3633366 for that mark.[7]

[7] Respondent's involved Registration No. 3855377 for the mark URBAN HOMESTEAD was not at issue in the California case. Accordingly, the California case has no preclusive effect with regard to that registration.

The doctrine of claim preclusion protects against relitigation of a previously adjudicated claim between the same parties or their privies. Under that doctrine, "a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action." *Parklane Hosiery Company, Inc. v. Shore.*, 439 U.S. 322, 326 n.5 (1979). Neither Petitioners nor any of their privies were parties to the California case. Accordingly, the doctrine of claim preclusion is inapplicable in this case.

Turning to whether the doctrine of issue preclusion (also known as collateral estoppel) is applicable with regard to the genericness of the mark URBAN HOMESTEADING in connection with the identified services in involved Registration No. 3633366 based on the California case, such doctrine can bar relitigation of the same issue in a second action. *See Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005). The doctrine of issue preclusion is applicable where: (1) there is an identity of an issue in a prior proceeding, (2) the identical issue was actually litigated, (3) the determination of the issue was necessary to the judgment in the prior proceeding, and (4) the party defending against preclusion had a full and fair opportunity to litigate the issue in the prior proceeding. *See Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1859 (Fed. Cir. 2000).

There is an identity of issue between the California case and the above-captioned proceeding. That is, both cases involve the issue of whether the term URBAN HOMESTEADING is generic for the services recited in involved

Registration No. 3633366. That genericness issue was actually litigated in the briefing of, and decision on, the motion for summary judgment, and the District Court's decision on that issue was "adequately deliberated and firm." *Dana v. E.S. Originals, Inc.*, 342 F.3d 1320, 68 USPQ2d 1138, 1140 (Fed. Cir. 2003). The determination of the issue of genericness was necessary to the November 5, 2015 decision in which the District Court granted summary judgment on the genericness claim. Respondent had a full and fair opportunity to litigate the issue of genericness in opposing the motion for summary judgment in the California case. The court set forth its findings of fact and conclusions of law in fully reasoned opinions. Those orders were not preliminary in nature, but made clear that they fully and finally resolved the matters addressed. The court in the California case clearly considered the issue of genericness to be conclusively decided and complete, with the remaining claims left open. *See id.* Based thereon, we find that the doctrine of issue preclusion applies with regard to the genericness claim against the term URBAN HOMESTEADING for the identified services in Registration No. 3633366. Because the remaining claims in the California case were later dismissed by stipulation of the parties without having been actually litigated, the doctrine of issue preclusion is inapplicable thereto. Petitioners' request that the District Court's decision in the California case on the motion for summary judgment on the genericness claim is therefore granted, and we hereby enter judgment on Petitioners' genericness claim with

regard to the term URBAN HOMESTEADING as used in connection with the services recited in Registration No. 3633366.

In view of such entry, we decline to consider the remaining claims regarding Registration No. 3633366. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013); TBMP § 102.01. We will consider Petitioners' summary judgment motion with regard only to the alleged genericness of the mark URBAN HOMESTEAD as used in connection with the services recited in Registration No. 3855377.

Motion for summary judgment

The Board notes initially that all of the excerpts of the discovery depositions of Jules Dervaes, Justin Dervaes, Anais Dervaes, and Jordanne Dervaes submitted by Petitioners were filed under seal and have been designated as confidential.[8] Because the records of Board proceedings are intended to be public, parties must limit their designation of information as confidential to that information which is genuinely confidential, such as customer names and sales and advertising figures.[9] *See* Trademark Rule 2.27(d). The Board must

[8] Respondent included as exhibits to the declaration of Jules Dervaes six DVDs of online and television media coverage of Respondent's activities, some in foreign languages. The Board accepts exhibits on DVD when recorded sound and video files cannot be adequately transcribed and submitted as exhibits through ESTTA or regular mail. *See Hunter Indus., Inc. v. Toro Co.,* 110 USPQ2d 1651, 1654 n.5 (TTAB 2014). However, Board proceedings are conducted in English. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011). Accordingly, we have not considered media coverage that is not in English and is not accompanied by an English translation. *See id.*

[9] Excessive designation of information as confidential complicates the record, and the information at issue is frequently improperly designated as confidential. *See General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB

discuss the record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decision. Therefore, in rendering this decision, we will not be bound by Petitioners' designations and, in this opinion, we will treat only testimony and evidence that is clearly of a private nature or commercially sensitive as confidential. *See Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1460-61 (TTAB 2014).

On July 29, 2014, Petitioners filed a supplement to the motion for summary judgment, wherein they submitted additional evidence from the *New York Times* that was published after the filing of the motion. Because that supplement is in contravention of Trademark Rule 2.127(a), which limits a movant to a brief and a reply brief in support of a motion, it has received no further consideration.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute as to any material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4

2011), judgment set aside on other grounds, 110 USPQ2d 1679 (TTAB 2014) (non-precedential).

USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Sys. Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

To prevail in this proceeding, Petitioners must establish not only a valid ground for denying the registration sought, but must also establish that there is no genuine issue of material fact as to their standing. *See, e.g., Lipton Indus.,*

Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). As evidence in support of their standing, Petitioners submitted an advertisement for Coyne's and Knutzen's book *The Urban Homestead*, which indicates that it was published by Process Media (84 TTABVUE 538); a February 14, 2011 e-mail from Jules Dervaes of Respondent to "Process Media/The Urban Homestead," wherein he instructs Petitioners not to use the term "urban homestead" except in reference to Respondent's products or services (84 TTABVUE 540-41); and Adam Parfrey of Process Media's February 16, 2011 e-mail response thereto (84 TTABVUE 539).[10] In addition, Petitioners have submitted a series of news articles concerning the parties' dispute (84 TTABVUE 178-292 and 296-342). Based on Petitioners' evidence of Coyne's and Knutzen's authorship, and Process Media's publication, of *The Urban Homestead* and the e-mail exchange between Parfrey and Jules Dervaes, the Board finds that all Petitioners have met their initial burden of establishing that there is no genuine dispute as to any material fact regarding their standing to maintain this proceeding. That is, Petitioners have met their initial burden of establishing that each of them has a real interest, i.e., a direct and personal stake, in the outcome of this proceeding and that each of them has a reasonable basis for its belief that it would be damaged by the continued registration of the mark URBAN HOMESTEAD. *See Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Lipton*

[10] Petitioners assert that these documents were produced in discovery. *See* Trademark Rule 2.127(e)(2).

Indus., Inc., 213 USPQ at 189; *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760-61 (TTAB 2013). Respondent, in its brief in response, does not argue that Petitioners lack standing to maintain this proceeding. Based on the foregoing, we find that there is no genuine dispute that Petitioners have standing to maintain this proceeding.

Regarding the alleged genericness of the term "urban homestead," a generic term "is the common descriptive name of a class of goods or services." *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Generic terms are incapable of being source indicators and are therefore unregistrable on both the Principal Register under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and the Supplemental Register.[11] *See Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830 (Fed. Cir. 2015); *In re Reed Elsevier Props. Inc.*, 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007) (LAWYERS.COM found generic and unregistrable on the Supplemental Register); *H. Marvin Ginn Corp.,* 228 USPQ at 530. A determination of genericness with regard to a multi-word term is based on the challenged term as a whole and not upon the individual words in that term. *See Princeton Vanguard, LLC,* 114 USPQ2d at 1830-31.

[11] By contrast, a term that is merely descriptive, but not generic, that has become distinctive of an applicant's goods and/or services is registrable on the Principal Register under Trademark Act Section 2(f).

"The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question." *H. Marvin Ginn*, 228 USPQ at 530. The public's perception is the primary consideration in determining whether a term is generic. *Loglan Inst. Inc. v. Logical Language Group Inc.*, 902 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992); *Magic Wand Inc. v. RDB Inc.,* 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991). Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. *Loglan Inst. Inc.,* 22 USPQ2d at 1533.

There are two steps in so determining: (1) What is the genus of goods or services at issue?; and (2) Is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services? *See H. Marvin Ginn Corp.,* 228 USPQ at 531-32. The Board has often held that a term that names the "central focus" or "key aspect" of services is generic for the services themselves, and the Board's principal reviewing Court has approved this approach. *E.g., In re Cordua Rests., Inc.*, 823 F.3d 594, 118 USPQ2d 1632, 1637-38 (Fed. Cir. 2016) (affirming the Board's finding that CHURRASCOS is generic for restaurants for which churrasco steaks are a key characteristic or feature); *In re Hotels.com LP*, 573 F.3d 1300, 91 USPQ2d 1532, 1533-34 (Fed. Cir. 2009) (approving Board's finding that the word "hotels" identifies the "central focus" of online lodging

information and reservation services, rendering the mark HOTELS.COM generic). A term is incapable of appropriation as a trademark where it is generic for the subject matter of the services at issue rather than the services themselves (e.g., education, training, research, etc.). *See In re Indus. Relations Counselors, Inc.*, 224 USPQ 309, 310 (TTAB 1984) (INDUSTRIAL RELATIONS COUNSELORS, INC. incapable of functioning as a mark for conducting seminars and research in the field of industrial relations); *In re Harcourt Brace Jovanich, Inc.,* 222 USPQ 820 (TTAB 1984) (LAW AND BUSINESS held incapable as a mark for educational seminars on that subject although not an apt name for the service of presenting seminars or training courses); *In re Seats, Inc.*, 221 UPSQ 1207 (TTAB 1984) (SEATS for ticket reservation and issuance services held incapable although a common name for the subject matter of the services rather than the services themselves). When a registered term is generic for one or more of the goods or services identified in a particular class, that class may be cancelled in its entirety. *See In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988). The issue of whether a term is generic is determined based on facts as they exist at the time registrability is being considered. *Cf. Target Brands Inc. v. Hughes,* 85 USPQ2d 1676, 1681 (TTAB 2007) (distinctiveness determined at the time issue is under consideration).

With regard to the first step of our inquiry, the genus of services at issue is determined by Respondent's chosen recitation of services in the involved

registration, i.e., "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." *See Magic Wand Inc.,* 19 USPQ2d at 1552. For purposes of this motion, we will focus on websites providing information on sustainable living, organic foods and gardening. The relevant public consists of members of the general public who are actual or potential purchasers of those services. *See Magic Wand Inc.,* 19 USPQ2d at 1553.

Petitioners rely on generic use of the term "urban homestead" by Respondent and persons associated with Respondent on various websites, including:

> (1) An excerpt from Respondent's website urbanhomestead.org, accessed March 16, 2011, where the following definition of the term "urban homestead" is set forth:[12]
>
> > 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.

[12] This excerpt was removed from Respondent's website in 2011. 85 TTABVUE 162.

> n. 3 A name describing the home of a person or family living by principals [sic] of low-impact sustainable self-sufficiency through activities such as gardening for food production, cottage industry, extensive recycling, and generally simple living.
> **USAGE IN A SENTENCE** 'My neighbors' **urban homestead** is so productive, they're able to live entirely on food they grow themselves.'

85 TTABVUE 169 (emphasis added). The definition was submitted as an exhibit to the discovery deposition of Jordanne Dervaes, who wrote the definition.

(2) An excerpt from julesdervaes.com, accessed March 12, 2012, which features a transcript of an interview of Jules Dervaes by Yvonne Maffei. In that interview, Maffei asked Dervaes to "describe ... what exactly is an **urban homestead**" (emphasis added). Dervaes responded:

> A suburban or city home on a fraction of an acre where an individual or family lives by principles of low-impact, sustainable self-sufficiency through activities such as gardening for food production and preservation, cottage industry, extensive recycling, and generally simple living-including conservation measures and an old-fashioned DIY self-reliance.

82 TTABVUE 106.

(3) A June 15, 2009 entry from julesdervaes.com, accessed September 27, 2011, entitled "10 Elements of Urban Homesteading." That entry includes the following (emphasis in original, except for bold underlined text, which is added):

> While these 10 factors make up the 'ideal' **urban homestead**, it should be understood that individual circumstances vary greatly and that many of these factors take years to implement fully. Therefore, any **urban homestead** SHOULD be a work in progress.
> **1. Grow your own FOOD on your city lot.**
> *More than 50% of diet, organically, on an urban lot (approx. less than half an acre") with visually appealing landscaping. *Depends on square footage of house, location, and climate zone.*
> **2. Use alternative ENERGY sources.**
> *E.g., solar, wind, in conjunction with energy efficiency and conservation measures to reduce usage.*

> **3. Use alternative FUELS & TRANSPORTATION.**
> *E.g., bio-fuels and/or alternative methods of transportation (bicycle, walk, public).*
> **4. Keep farm ANIMALS for manure and food.**
> *Practice animal husbandry.*
> **5. Practice WASTE REDUCTION.**
> *Use it up, wear it out, make it do, do without, compost it, re-purpose it.*
> **6. Reclaim GREYWATER and collect RAINWATER.**
> *Practice water conservation and recovery.*
> **7. Live SIMPLY.**
> *...in the manner of past eras. Develop back-to-basics homemaking skills, including food preservation and preparation.*
> **8. Do the work YOURSELF.**
> *Learn to do home and vehicle maintenance, repairs and basic construction.*
> **9. Work at HOME.**
> *Earn a living from the land or hand work done at home. Develop a homebased economy.*
> **10. Be a good NEIGHBOR.**
> *Be conscious and considerate of your surroundings — ask yourself "Would I want to live next to me?" Offer a helping hand for free. Urban homesteading is a community-based way of life, not a business.*

82 TTABVUE 180.

(4) An excerpt from the Facebook page of Jordanne Dervaes, accessed September 22, 2011, in which she urges that people use the term "**urban homestead**" "with pride" and encourages the use of that term "in the public domain." 85 TTABVUE 173 (emphasis added).

(5) An excerpt from the August 15, 2008 entry of the PATH TO FREEDOM blog, accessed June 9, 2011, wherein Anais Dervaes states as follows (emphasis added):

> Starting in the mid 1980's, the Dervaes family has through hard work and effort transformed our ordinary city lot into a viable **urban homestead**. Where [we] not only grow over 90% of our produce, but have citified farm animal[s], brew our own fuel and incorporate many alternative energy, waste and

> water reclamation practices, and appropriate technologies.
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> 82 TTABVUE 70.
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> (6) An excerpt from julesdervaes.com, accessed September 27, 2011, which provides "[t]opic [e]xamples" of presentations and workshops given by Jules Dervaes, and states as follows (emphasis added): "Since 1983, Jules Dervaes and his family have been living a protest against corporate control of the food supply by working and living of their **urban homestead**. They now grow over 6,000 pounds of produce annually on a one fifth acre residential lot in Pasadena, CA (1/10 acre garden)." 82 TTABVUE 95.
>
> (7) An excerpt from julesdervaes.com, accessed June 6, 2011, which reprints an April 14, 2010 (unspecified city) *Daily News* feature on the Dervaes family, which includes the following statement: "Jules refers to the place as an **urban homestead** and the project as the Path to Freedom." (emphasis added)
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> (8) An excerpt from the website urbanhomesteading.com, accessed March 12, 2012, which includes the following passage in the profile of Anais Dervaes (emphasis added): "She loves traipsing around the **urban homestead** in aprons and barefeet and taking pictures of all the homestead happenings!" 82 TTABVUE 102.
>
> (9) Excerpts of the PATH TO FREEDOM blog from the website urbanhomestead.org/journal, which include the phrase "THE ORIGINAL MODERN **URBAN HOMESTEAD**" in the heading thereof. 81 TTABVUE 783-865, 1038-43; 82 TTABVUE 2-7 (emphasis added).

A party's own generic use of a term is strong evidence of genericness. *See Turtle Wax Inc. v. Blue Coral Inc.*, 2 USPQ2d 1534, 1536 (TTAB 1987).

Petitioners' evidence regarding the relevant public's understanding of the term URBAN HOMESTEAD in connection with the services at issue also includes the following:

> (1) An excerpt from *The Integral Urban House: Self-Reliant Living in the City* by Helga Olkowski, Tom Javits, and the Farallones Institute staff (1979), which refers to "an **urban homestead** chicken-fish-garden [manure removal] system" used in connection with egg-laying hens in a "small chicken house the size of a one-car garage." 81 TTABVUE 712 (emphasis added).
>
> (2) A November/December 1976 article from the archives of *Mother Earth News* (online at www.motherearthnews.com), accessed May 24, 2011, entitled "The Integral Urban House," which refers to the Farallones Institute's Project of converting "a Victorian mansion into an **urban homestead**" where residents "grow their own fruits and vegetables, raise chickens, rabbits, and fish, recycle 90% of their wastes, solar heat their hot water, and conduct a variety of alternative technology experiments ... all on a 1/8-acre city lot!"[13] 84 TTABVUE 388-93 (emphasis added).
>
> (3) A March/April 1985 article from the archives of *Mother Earth News*, accessed May 18, 2011, entitled "Urban Homesteading in Florida," which features a "tiny **urban homestead**" near Tampa Bay. 84 TTABVUE 385-87.[14]

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[13] Petitioners submitted a declaration of Nikkole Gadsden, a paralegal for Petitioners' attorney, through which Petitioners make of record the results of a June 2, 2014 search of the Westlaw ALLNEWS database that Ms. Gadsden conducted for the terms "urban homestead" and "urban homesteading" spanning the time period from 1973 to the present. 81 TTABVUE 29-687. Such search resulted in 2,658 hits for those terms. Ms. Gadsden avers that, of those hits, 43 mention activities of Respondent or Dervaes family members in connection with those terms, 2,615 do not mention either Respondent or Dervaes family members. Ms. Gadsden further avers that, of those 2,615 hits, 740 discuss sustainable living activities practiced or promoted by others, 1,755 discuss affordable housing programs that may or may not involve sustainable living, and the remaining 120 "occurred in a different or unclear context." Petitioners also submitted a declaration of Christopher J. Kox, a librarian and researcher at the University of California at Berkeley, who conducted searches of the printed *Readers' Guide to Periodical Literature* and various databases for the term "urban homesteading" and submitted copies of his search reports. 82 TTABVUE 35-55. Because the search results provide little or no context of the use of the terms at issue on the webpages linked to the search reports, they are of little value in assessing the consumer public perception of the term "urban homestead" in connection with the recited services. *See In re Bayer AG*, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007).

[14] The article includes the following:

> Nowadays, here on our tiny **urban homestead** only a block from Tampa Bay, we come just about as close to self-reliance as is possible in a city. The two original gardens have been joined by an herb plot, grapevines, two wildly productive fig trees, and three varieties of Florida apple trees (which are actually imports from Israel). We have a

(4) A May/June 1985 article from the archives of *Mother Earth News*, accessed June 21, 2012, entitled "How to Live Well on Two City Acres," which describes living in an "**urban homestead**" at an "80-year-old house" where "down in the basement and out in the backyard, ... much of the food needed by several families is grown through cooperative effort."[15] 84 TTABVUE 394-97 (emphasis added).

(5) An excerpt from the website urban-homesteading.com, accessed September 19, 2011, which includes the subheadings "Cooking and Eating on the **Urban Homestead**" and "Raising Your Own Animals." 84 TTABVUE 49-51 (emphasis added).

(6) an excerpt from the website urban-homestead.net, accessed September 16, 2011, entitled "**Urban Homestead**: Farming in the Backyard." 84 TTABVUE 68-69 (emphasis added).

(7) An excerpt from the website ehow.com, accessed June 20, 2012, which includes the headlines "Homesteading Opportunities" and "Start an **Urban Homestead**." The text refers to the Dervaes family as an example of transforming a city house on a city lot into a "working, urban microfarm[] that can create a sustainable living environment for the people who live there." 84 TTABVUE 73-76 (emphasis added).

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small banana grove in the side yard ... and maverick papayas pop up from time to time all over the property.

(emphasis added)

[15] The article includes the following:

Two acres that extend behind the house sport vegetable gardens, a pond, grapevines and blackberry bushes, a huge compost pile, dwarf fruit trees, and a woodlot. 'We, the families in the houses on either side of us, and another family who lives down the street bought this land cooperatively,' Mrs. Bender says as she points to the gardens from the back porch swing. 'Then we all bought our houses, along with small plots for our own backyards, back from the cooperative, so that each family actually owns its own property. The rest of the land, though, is still owned cooperatively.'

Aside from four large gardens (each is spacious enough to feed a family of four), the main focal point in the neatly kept acreage is the pond. 'that's where I raise African tilapia,' Mrs. Bender, who is director of environmental research at Morehouse College, explains.

(8) An excerpt from the website everyday-simple-living.com, accessed June 20, 2012, which under the headline "Urban Homesteading" refers to "[r]aising animals on an **urban homestead**." 84 TTABVUE 93-95 (emphasis added). The text of the article states as follows:

> Raising animals on an **urban homestead** is definitely more than some people want to take on. But for those who are willing to give it a go - its rewards are many. Fresh eggs from your own chickens! Fresh milk from your own goats! Fresh honey from your own bees! Good stuff.

(9) An article from portlandtribune.com, created on June 11, 2014 and accessed July 16, 2014, entitled "Find ideas for building your **urban homestead**." The article refers to the Oregon City Farmers Market's Householding Fair, where readers are advised that "[i]f you're looking for ideas for creating an **urban homestead** on your city lot, check out booths with information on chickens, beekeeping, goats, preserving food, composting, growing food, worm bins, green cleaners, recycling, repurposing and disaster-preparedness." 84 TTABVUE 109-112 (emphasis added).

(10) An excerpt from holisticlivingschool.org, accessed August 23, 2011, wherein the Florida School of Holistic Living offers a series of workshops, classes, and hikes known as the 2009 **Urban Homestead** Series, including "Organic Gardening 101," "Worm Composting 101," and "Introduction to Canning: Preserving Food," which are intended "to provide a guidebook for urban living in a sustainable way." This excerpt indicates that such series is guided by Coyne and Knutzen's book *The Urban Homestead*. 84 TTABVUE 142-45 (emphasis added).

(11) An excerpt from ledameredith.net, accessed April 14, 2011, entitled "Leda's **Urban Homestead**," which offers "Classes & Events with Leda," including "Easy to Grow Vegetables," "Growing Food in the Shade," and "Urban Foraging." 84 TTABVUE 149-53 (emphasis added).

(12) An excerpt from continue.utah.edu, accessed August 23, 2011, wherein The University of Utah Continuing Education offers "**Urban Homestead** Classes with Lifelong Learning," through which customers may "[g]et hands-on training in a wide

> range of backyard gardening and city farming skills, from raising chickens and bee keeping to garden design and selling your own produce." (84 TTABVUE 154-55).

Petitioners' evidence indicates, *prima facie*, that there is no genuine dispute that the general public understands the term "urban homestead" as referring to the recited "sustainable living, organic foods and gardening," in city environments; and that third parties make generic use of that term on websites that provide information on "sustainable living, organic foods and gardening," in city environments. That evidence persuasively shows use of the term "urban homestead" as an apt identifier of the activities in question by persons other than the parties to this proceeding and persons who received correspondence from Respondent in which Respondent asserted its trademark rights in that term. As such, the evidence shows that the relevant public understands that term as identifying the subject matter of Respondent's websites. Although Jordanne Dervaes contends in her discovery deposition that her aforementioned posted definition of the term "urban homesteading" was merely something that people who accessed Respondent's website "could have fun reading" (85 TTABVUE 162), the example of usage of that term provided as part of that definition is entirely consistent with third-party use of the term. Based on the evidence of record as a whole (*see W. Florida Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994)), we find that Petitioners have met their initial burden of establishing that there is no

genuine dispute as to any material fact that the term "urban homestead" is a generic term for Respondent's websites.

The burden now shifts to Respondent to demonstrate the existence of any genuine dispute of material fact that must be resolved at trial. We note initially that although Respondent, through the declaration of Jules Dervaes, has included a list of print and online publications and other media coverage in which Respondent has been featured (94 TTABVUE 61-91), merely listing a publication or other media coverage is insufficient to make that publication or media coverage of record.[16] *See Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1219 (TTAB 2011).

In its brief in response, Respondent correctly notes that a registration for a mark on the Principal Register is entitled to a *prima facie* presumption of validity. *See* Trademark Act Section 7(b), 15 U.S.C. § 1057(b). However, a registration for a mark that has become generic for the relevant goods and/or services can be cancelled. *See* Trademark Act Section 14(3), 15 U.S.C. § 1064(3).

Respondent asserts that the term "urban homestead" is not generic because it survived "arduous and demanding" process of trademark examination. 92 TTABVUE 12-13. However, determinations made by examining attorneys are

[16] Respondent submitted evidence that its publication "Elements Of The Urban Homestead" was registered for copyright with the Library of Congress on June 22, 2009 (94 TTABVUE 52). However, "[t]he title of a single creative work is, of necessity, descriptive of the work and does not function as a trademark." *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142 (TTAB 2011).

not binding on the Board and have no preclusive or precedential value. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Even if, as alleged, Respondent conducted its due diligence and applied to register the marks in good faith, so applying does not preclude a finding of genericness. *Cf. Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012) (good faith adoption of a mark does not preclude a finding of likelihood of confusion because it is expected that applicants are acting in good faith). Even if Respondent were the first, or even the sole, user of a generic term or phrase, that does not entitle Respondent to register such a term or phrase as a mark. *See In re Nat'l Shooting Sports Found., Inc.*, 219 USPQ 1019 (TTAB 1983). A term may become generic after it is registered. *See* Trademark Act Section 14(3), 15 U.S.C. § 1064(3).

While Jules Dervaes states in correspondence to third-party users of "urban homestead" and in his declaration that other terms such as "modern homesteading," "urban sustainability projects" (84 TTABVUE 540), "urban farming," "urban gardening," and "urban agriculture" (94 TTABVUE 8) are available to identify their activities, it is well settled that there can be more than one generic term for particular services. *Roselux Chemical Co., Inc. v. Parsons Ammonia Co., Inc.*, 299 F.2d 855, 132 USPQ 627, 632 (CCPA 1962).

Through the declaration of Jules Dervaes, Respondent introduced evidence that the term "urban homestead" is also used to refer to "housing rehabilitation/renewal" in city buildings. 94 TTABVUE 5, 22-51. However, the

fact that a term may have other meanings in different contexts is not controlling on the issue of descriptiveness and, by extension, genericness.[17] *See In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979).

Respondent's lengthy argument that the term "urban homestead" is somehow suggestive is incorrect.[18] The involved registration includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Because the registration is based on acquired distinctiveness under Section 2(f), the statute accepts the registered mark's lack of inherent distinctiveness as an established fact. *See Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

The DVDs that Respondent submitted as exhibits to the declaration of Jules Dervaes reinforce the public perception of "urban homestead" as a generic term for "sustainable living, organic foods and gardening, [and] homesteading" in city environments. In the DVD excerpt of the August 18, 2009 Sundance Channel program *Big Ideas for a Small Planet*, Jules Dervaes refers to himself as the "founder of an urban homestead." In an April 20, 2008 excerpt from nytimes.com, Jules Dervaes states that "this is where I live, my home, and

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[17] A generic term is the "ultimate in descriptiveness." *H. Marvin Ginn Corp.*, 228 USPQ at 530.

[18] Even if we assume, as Respondent argues, that the word "homestead" is most closely associated with the Homestead Act of 1862, and that such word is defined under the California Code of Civil Procedure, any determination regarding the genericness of the phrase "urban homestead" is based on the perception of the the phrase as a whole, and not only its component parts, by the relevant public. *See Princeton Vanguard, LLC,* 114 USPQ2d at 1830-31.

we've turned it into an urban homestead." In the excerpt from a May 7, 2010 Food Network program, *Private Chefs of Beverly Hills*, one of the participants states in reference to Respondent, that "we have some clients who run what's called an urban homestead, which means they grow their own produce and raise their own animals." In the identification bar across the bottom of the screen on a June 15, 2008 CNN feature on the Dervaes family, each member of the family is identified as an "URBAN HOMESTEADER." Likewise, in the July 22, 2004 Los Angeles Times article that was submitted as an exhibit to the declaration of Jules Dervaes, the author states that "Dervaes, like many of the most committed greenies, has given up his job to devote himself to running an urban homestead." 94 TTABVUE 55.

Respondent asserts that entry of summary judgment is inappropriate here because Petitioners did not support their motion for summary judgment with a survey. However, "a survey is neither required nor expected in a Board proceeding. Most Board cases involve only indirect evidence of consumer perception." *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1832 n.25 (TTAB 2015). Based on the foregoing, we find that Respondent has failed to rebut Petitioners' *prima facie* showing that there is no genuine dispute of material fact as to the genericness of the term "urban homestead" for Respondent's identified services.

Because the evidence of record makes clear that there is no genuine dispute that the public perceives the term "urban homestead" as the generic name of

the subject matter of respondent's services, we find that there is no genuine dispute as to any material fact that such wording is generic for the services at issue. In view thereof, Petitioners' motion for summary judgment on their genericness claim is granted. Because we have entered judgment on the genericness claim against both registrations involved in this proceeding, we decline to reach Petitioners' remaining claims herein.

The petition to cancel is hereby sustained, and judgment is hereby entered against Respondent on the ground that the involved marks URBAN HOMESTEADING and URBAN HOMESTEAD are generic for the services recited in the registrations therefor. As noted *supra*, Registration No. 3633366 has already been cancelled. Registration No. 3855377 will be cancelled in due course.