

TTAB

Holly A. Birkett, D.V.M.
URBAN VET [Wa State
Registered mark #032451]
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March 21st, 2006

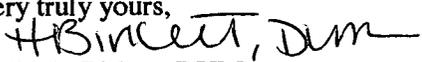
EXPRESS MAIL LABEL # EQ 369536539 US

Assistant Commissioner for Trademarks
PO BOX 1451
Alexandria, VA 22313-1451

RE: Urban Vet, PLLC v Urban Vet, Birkett, Holly A.
Opposition No. 91168524
ANSWER TO THE NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES
Applicant: Urban Vet, Birkett, Holly A.
Serial number: 78531745

Dear Sir or Madam:

Enclosed please find the Applicant's, Urban Vet, (Birkett, Holly A.), Answer to Notice of Opposition and Affirmative Defenses, to the Opposition No. 91168524. Should you have any questions, please do not hesitate to contact me.

Very truly yours,

Holly A. Birkett, DVM

03-21-2006

U.S. Patent & TMOfc/TM Mail Rcpt Dt.

1 5. Applicant is without sufficient knowledge or belief to admit or deny the allegations of Paragraph 5 of
2 the Notice of Opposition, and therefore denies same. To the extent Paragraph 5 contains the history of this
3 proceeding, such allegations require no answer.

4 6. Applicant is without sufficient knowledge or belief to admit or deny the allegations of Paragraph 6 of
5 the Notice of Opposition, and therefore denies same. To the extent Paragraph 6 contains the history of this
6 proceeding, such allegations require no answer.

7 7. Applicant is without sufficient knowledge or belief to admit or deny the allegations of Paragraph 7 of
8 the Notice of Opposition, and therefore denies same. To the extent Paragraph 7 contains the history of this
9 proceeding, such allegations require no answer.

10 8. Applicant denies the allegations of Paragraph 8 of the Notice of Opposition.

11 9. Applicant admits that Applicant's and Opposer's marks are confusingly similar and denies the
12 remaining allegations of Paragraph 9.

13 10. Applicant denies the allegations of Paragraph 10 of the Notice of Opposition.

14 11. Applicant denies the allegations of Paragraph 11 of the Notice of Opposition.

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16 **AFFIRMATIVE DEFENSES:**

17 In further answer to the Notice of Opposition, Applicant asserts that:

18 1. The Opposer's claims should be denied based on the doctrine of Unclean Hands.

19 2. The Opposer does not have the "exclusive rights" to use the mark. Opposer's use is junior to
20 Applicant's. Opposer was served a Cease and Desist letter on October 14, 2004, and a second letter on
21 January 25, 2005, which Opposer ignored. Applicant owns the rights to the mark "Urban Vet" under the
22 common law of the State of Washington with the Record of Registration stated as ("Exhibit A") file
23 #032451, in which the date of first use anywhere is stated as August 20, 2001, under classification
24 number 44 for professional veterinary services. As a result of the foregoing, Opposer cannot prevail on its
25 claim of priority.

26 3. Applicant has established rights as the first to apply for federal registration with the USPTO under Title
27 15.U.S.C 1051(b). In asserting these rights, Applicant's intent is to be protected as outlined in 15.U.S.C
28 1127(a) "Intent of Chapter".

1 4. Applicant's senior use of the mark "urbanvet" in intrastate common law commerce in the State of
2 Washington, as shown in said "Exhibit A", predates that of Opposer's allegations of use.

3 5. Opposer did not give consideration to the Applicant's rights to a "Notice of Allowance" as described
4 under section 13 (b) (2) [15 USC 1063 (b) (2)].

5 6. Opposer "adopted" the mark as admitted in the Notice of Opposition with full and undisputed
6 knowledge that the Applicant was already using the mark, without consent of Applicant, in common law
7 intrastate commerce, therefore creating an infringing intrastate trademark. Opposer should be denied
8 relief on the willful bad faith intent to rely on the good will established by the Applicant in the mark to
9 promote her own causes.

10 7. Opposer's claims should be denied. Opposer failed to file for its alleged rights with the United States
11 Patent and Trademark Office.

12 8. Opposer is estopped from asserting rights to the mark "urbanvet" as a result of Applicant's known prior
13 use of the same mark.

14 9. Opposer's claims are barred by laches, waiver and acquiescence.

15 10. Applicant reserves the right to raise additional defenses that may be necessary or may become
16 apparent.

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19 **RELIEF REQUESTED**

20 **WHEREFORE**, Applicant respectfully requests :

- 21 1. Judgment be entered in favor of Applicant and against Opposer;
 - 22 2. The Notice of Opposition be dismissed with prejudice;
 - 23 3. That a Notice of Allowance in application serial no. 78531745 issue forthwith;
 - 24 4. And that the Trademark Trial and Appeal Board grant further relief it deems appropriate or
25 necessary.
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Dated this 6th day of March, 2006.

Respectfully submitted,

H Birkett, DVM

Holly A. Birkett, D.V.M.
URBAN VET [Wa State Registered
mark #032451]
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drbirkett@mac.com

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Answer was mailed postage prepaid by first-class mail, to Everett E. Fruehling, Esq., 1420 Fifth Avenue, Suite 2800 , Seattle, Washington 98101-2347, attorney for Opposer, this 21st day of March, 2006.

H Birkett, DVM

Holly A. Birkett, Applicant.

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal service "Express Mail", in an envelope addressed to the BOX TTAB NO FEE, Commissioner for Trademarks, P.O. Box 1451 Alexandria, VA 22313-1451, this 21st day of March, 2006.

LABEL # EQ 369536539 US

H Birkett, DVM

Holly A. Birkett, D.V.M., Applicant.

EXHIBIT A

UNITED STATES OF AMERICA

The State of



Washington

Secretary of State

I, **Sam Reed**, Secretary of State of the State of Washington and custodian of its seal, hereby issue this

certificate that according to records on file in this office,

trademark:

URBAN VET

registered in the State of Washington to

HOLLY A. BIRKETT

names of partners: (if any) n/a,

state of incorporation: (if any) Wa and I further certify that such trademark

with file # 032451 was issued on August 2, 2004 and will expire on August 2, 2009.

I further certify that the classification number of the trademark is 44 and the

actual goods or services with which the trademark is used are

**VETERINARY BUSINESS, SERVICES INCLUDE PROFESSIONAL VETERINARY MEDICINE
AND SURGERY**

The date the trademark was first used anywhere is 08/20/2001 and the date the
trademark was first used in Washington is 08/20/2001.

Date: August 3, 2004



Given under my hand and the Seal of the State
of Washington at Olympia, the State Capital

A handwritten signature in cursive script that reads "Sam Reed".

Sam Reed, Secretary of State

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

Urban Vet PLLC,

No. 91168524

Opposer

v.

RESPONSE TO EVERETT E.
FRUEHLING'S DECLARATION
DATED FEBRUARY 24TH, 2006

Urban Vet, Birkett, Holly A.

Applicant.

I, Holly A. Birkett (Applicant), respond to Everett E. Fruehling's (Attorney for Opposer)

Declaration in response to my motion for extension of time to file an Answer, with the following:

1. Submitted is a certificate of service for the filed Motion for extension of time to file Answer of February 15th, 2006.
2. With respect to the Opposer's Certificate of Service, in Opposer's RESPONSE to Applicant's REQUEST FOR EXTENSION OF TIME TO FILE ANSWER, submitted to ESTTA on the 24th day of February 2006, Opposer's attorney/office sent Certificate of service to the incorrect address.

Dated March 21st, 2006

Holly A. Birkett, DVM

H Birkett, DVM

SERVICE
CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"
FOR THE APPLICANT'S MOTION OF FEBRUARY 15, 2006.

I hereby certify that the Defendant's Motion for Extension of Time submitted to TTAB/USPTO by ESTTA on February 15th, 2006 is being mailed by first-class mail, postage prepaid, to Everett E. Fruehling, Esq., 1420 Fifth Avenue, Suite 2800, Seattle, Washington 98101-2347, attorney for Opposer, this twenty-first day of March 2006.

Dated March 21st, 2006

H Birkett, DVM

Holly A. Birkett, DVM