

ESTTA Tracking number: **ESTTA776153**

Filing date: **10/12/2016**

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

Proceeding	92064160
Party	Defendant Terrence R Wall Revocable Trust U/A/D 10/27/92
Correspondence Address	MELINDA S GIFTOS HUSCH BLACKWELL LLP PO BOX 1379 MADISON, WI 53701-1379 UNITED STATES ptomailbox@whdlaw.com, mindi.giftos@huschblackwell.com
Submission	Answer
Filer's Name	Melinda S. Giftos
Filer's e-mail	ptomailbox@whdlaw.com, mindi.giftos@huschblackwell.com
Signature	/Melinda S. Giftos/
Date	10/12/2016
Attachments	Answer - URBAN VILLAGE Petition to Cancel.pdf(108301 bytes)

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

In re the Matter of U.S. Reg. No. 3,150,251
For Mark: URBAN VILLAGE

URBAN VILLAGES, INC.,

Petitioner,

Cancellation No. 92064160

v.

TERRENCE R. WALL REVOCABLE TRUST
U/A/D 10/27/92,

Respondent.

ANSWER

Registrant, Terrence R. Wall Revocable Trust U/A/D 10/27/92 (the "Trust"), submits this Answer to the First Amended Petition for Cancellation filed by Urban Villages, Inc. ("Urban Villages").

1. Urban Villages is a successful real estate development and property management company out of Denver Colorado that focuses on long-term value generation through place-oriented design and detail-oriented operations that implement the highest standards for planning, design, development, and management.

RESPONSE: The Trust lacks sufficient information to form a belief as to the truth of the allegations contained therein, and therefore, denies the same.

2. On October 14, 2015, Urban Villages filed a federal trademark application for the mark URBAN VILLAGES for use with project management for planning design in Class 35, real estate management services in Class 36, real estate development in Class 37 and concierge services in Class 45 under Intent to Use Application Serial Number 86/788,139 (the "Urban Villages Mark").

RESPONSE: Denied in part. The Trust admits that Urban Villages filed U.S. Serial No. 86/788,139 for the URBAN VILLAGES trademark on October 14, 2015 on an intent-

to-use basis. However, application Serial No. 86/788,139 identifies numerous services that are not identified in paragraph 2. As such, the Trust denies the remaining allegations of paragraph 2 and states that application U.S. Serial No. 86/788, 139 speaks for itself.

3. On October 22, 2005, T. Wall Properties Management Group Corp. filed a federal trademark application for URBAN VILLAGE in Class 37 ("Respondent's Mark") for commercial real estate development services with a first use date of October 13, 2005. The application was rejected based on a 2(e)(1) descriptiveness refusal and was amended to the Supplemental Register in response on August 2, 2006. The application registered on September 26, 2006 (the "Registration").

RESPONSE: Denied in part. On October 13, 2005, T. Wall Property Management Group filed the original application for the URBAN VILLAGE federal trademark registration, U.S. Reg. No. 3150251 (the "URBAN VILLAGE Mark"), not T. Wall Properties Management Group Corp. On April 26, 2006, the U.S. Patent and Trademark Office examining attorney issued an office action refusing registration of the URBAN VILLAGE Mark on the grounds that it was merely descriptive of the applied-for services. In response, T. Wall Property Management Group amended its application for the URBAN VILLAGE Mark to the Supplemental Register on August 2, 2006. The U.S. Patent and Trademark Office issued Registration No. 3150251 for the URBAN VILLAGE Mark on September 26, 2006.

4. The Registration's ownership was transferred to the Trust on July 30, 2007.

RESPONSE: Denied to the extent paragraph 4 is vague and ambiguous. The Trust admits that T. Wall Properties Management Corp. assigned its rights in and to the URBAN VILLAGE Mark to the Trust on July 30, 2007. The Trust denies the remaining allegations of paragraph 4.

5. The Urban Villages Mark received a non-final office action on February 10, 2016 refusing the Urban Villages Mark under Section 2(d) based on a likelihood of confusion with the Registration owned by the Trust.

RESPONSE: Denied to the extent paragraph 5 is vague and ambiguous. The Trust admits that the U.S. Patent and Trademark Office issued an office action on February 10, 2016, refusing registration of U.S. Serial No. 86/788,139 in Classes 36 and 37 on the grounds that there is a likelihood of confusion with the URBAN VILLAGE Mark. The Trust denies the remaining allegations of paragraph 5.

6. The Respondent's Mark is no longer in use in commerce and has been abandoned.

RESPONSE: Denied.

7. The Urban Villages Mark stands the possibility of refusal of registration due to a potential likelihood of confusion with Respondent's abandoned Mark.

RESPONSE: Denied to the extent paragraph 7 is vague and ambiguous, and to the extent Urban Villages claims that the URBAN VILLAGE Mark has been abandoned. The Trust admits that the U.S. Patent and Trademark Office issued a partial refusal to register U.S. Serial No. 86/788,139 on the grounds that there is a likelihood of consumer confusion with the URBAN VILLAGE Mark, and that the U.S. Patent and Trademark Office file wrapper speaks for itself. The Trust denies the remaining allegations in paragraph 7.

8. Because Respondent's Mark is no longer in use and has been abandoned the Board should cancel the Registration pursuant to 15 U.S.C. § 1051.

RESPONSE: Denied

AFFIRMATIVE DEFENSES

1. Urban Villages' claims are barred because the Trust has continuously and exclusively used the URBAN VILLAGE Mark for more than ten years. During that

time, the URBAN VILLAGE Mark has acquired distinctiveness in the minds of consumers and has become a valuable asset of the Trust.

2. The Trust and/or its predecessor have openly used the URBAN VILLAGE Mark for over a decade and have given Urban Villages constructive notice of that use by filing its U.S. trademark application with the U.S. Patent and Trademark Office in 2005. Opposer's claims are therefore barred by the doctrines of laches, waiver, acquiescence and estoppel.
3. The Trust has priority of use of the URBAN VILLAGE Mark.

For all of the reasons set forth herein, Urban Villages' Petition to Cancel should be dismissed.

Dated: October 12, 2016.

s/ Melinda S. Giftos

Melinda S. Giftos

Wisconsin State Bar No. 1056609

Attorney for Registrant

HUSCH BLACKWELL LLP

P.O. Box 1379

Madison, Wisconsin 53701-1379

Telephone: 608-255-4440

Fax: 608-258-7138

Email: mindigiftos@huschblackwell.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a copy of the foregoing ANSWER was sent via first class, postage paid mail to Applicant's attorney, Jessie L. Pellant, Brownstein Hyatt Farber Schreck, LLP, 410 17th Street, Suite 2200, Denver, CO 80202, on October 11, 2016.

Dated: October 12, 2016.

s/ Melinda S. Giftos

Melinda S. Giftos

Wisconsin State Bar No. 1056609

Attorney for Registrant

HUSCH BLACKWELL LLP

P.O. Box 1379

Madison, Wisconsin 53701-1379

Telephone: 608-255-4440

Fax: 608-258-7138

Email: mindigiftos@huschblackwell.com