

ESTTA Tracking number: **ESTTA1274632**

Filing date: **03/27/2023**

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

Proceeding no.	92081595
Party	Defendant Honest History Co.
Correspondence address	HONEST HISTORY CO 1620 CENTINELA AVE 301B INGLEWOOD, CA 90302 UNITED STATES Primary email: tmclient@frameworklaw.com No phone number provided
Submission	Answer
Filer's name	Christopher M. Wheeler
Filer's email	chris@cmwheelerlaw.com, Grant@frameworklaw.com
Signature	/CMW/
Date	03/27/2023
Attachments	Cancellation No. 92081595 Answer (FINAL).pdf(102773 bytes)

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

IN THE MATTER OF:

U.S. REGISTRATION NO.: 6,008,523
MARK: HONEST HISTORY

U.S. REGISTRATION NO.: 6,504,087
MARK: HONEST HISTORY

U.S. REGISTRATION NO.: 6,504,088
MARK: HONEST HISTORY

<hr/>)	
MERCURY ONE, INC.,)	
)	
	Petitioner,)	
)	
vs.)	Cancellation No. 92081595
)	
HONEST HISTORY CO.,)	
)	
	Respondent.)	
<hr/>)	

ANSWER TO PETITION FOR CANCELLATION

Respondent HONEST HISTORY CO., by its counsel, responds as follows to the “Petition for Cancellation” filed herein.

1. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 1 of the Petition for Cancellation, and therefore denies the same.

2. Respondent denies each and every allegation contained in paragraph 2 of the Petition for Cancellation except Respondent admits it is the owner of U.S. Reg. Nos. 6008523, 6504087, and 6504088 (the “Honest History Registrations”).

3. Paragraph 3 of the Petition for Cancellation consists of a statement to which no admission or denial is required.

4. Paragraph 4 of the Petition for Cancellation is a statement of law to which no admission or denial is required. To the extent a response is required, denied.

5. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 5 of the Petition for Cancellation, and therefore denies the same.

6. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of the first sentence of paragraph 6 of the Petition for Cancellation, and therefore denies the same. As to the second sentence, denied.

7. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 7 of the Petition for Cancellation, and therefore denies the same.

8. Respondent admits the terms “honest” and “history” are defined in dictionaries, otherwise Respondent denies each and every allegation contained in paragraph 8 of the Petition for Cancellation.

9. Respondent denies each and every allegation contained in paragraph 9 of the Petition for Cancellation.

10. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 10 of the Petition for Cancellation, and therefore denies the same.

11. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 11 of the Petition for Cancellation, and therefore denies the same.

12. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 12 of the Petition for Cancellation, and therefore denies the same except Respondent admits it filed a Complaint with the WIPO Arbitration and Mediation Center on September 15, 2021.

13. The WIPO Complaint in connection with the allegations of paragraph 13 of the Petition for Cancellation speaks for itself. To the extent a response is required, denied.

14. The WIPO Domain Name Decision in connection with the allegations of paragraph 14 of the Petition for Cancellation speaks for itself. To the extent a response is required, denied.

15. Paragraph 15 of the Petition for Cancellation mischaracterizes the actions of Respondent; therefore, the allegations are denied except Respondent admits it continued to demand Petitioner take action with respect to its use of Honest History as a source identifier for its yet-to-be-launched self-purported “website archive.”

16. Paragraph 16 of the Petition for Cancellation mischaracterizes the demands of Respondent; therefore, the allegations are denied.

17. Respondent denies each and every allegation contained in paragraph 17 of the Petition for Cancellation.

18. Respondent denies each and every allegation contained in paragraph 18 of the Petition for Cancellation.

19. Respondent denies each and every allegation contained in paragraph 19 of the Petition for Cancellation.

20. Respondent denies each and every allegation contained in paragraph 20 of the Petition for Cancellation.

21. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 21 of the Petition for Cancellation, and therefore denies the same.

22. The PTO records in connection with the allegations of paragraph 22 of the Petition for Cancellation speak for themselves. To the extent a response is required, denied.

23. The PTO records in connection with the allegations of paragraph 23 of the Petition for Cancellation speak for themselves. To the extent a response is required, denied.

24. The PTO records in connection with the allegations of paragraph 24 of the Petition for Cancellation speak for themselves. To the extent a response is required, denied.

25. Respondent admits the allegation contained in paragraph 25 of the Petition for Cancellation.

26. Respondent admits the allegation contained in paragraph 26 of the Petition for Cancellation.

27. Respondent denies each and every allegation contained in paragraph 27 of the Petition for Cancellation.

28. Respondent denies each and every allegation contained in paragraph 28 of the Petition for Cancellation.

29. Respondent denies each and every allegation contained in paragraph 29 of the Petition for Cancellation.

30. Paragraph 30 of the Petition for Cancellation mischaracterizes Registration No. 6,504,088 (*'088 Registration*); therefore, the allegations are denied except Respondent admits on September 28, 2021, the PTO granted Respondent's '088 Registration for the word mark HONEST HISTORY in Class 16 for the following goods and services:

Educational publications, namely, printed workbooks, textbooks, activity books, teacher guides, manuals, posters, and

educational booklets in the fields of history and education for children

Respondent further admits it made no claim to an exclusive right to use the term “history” apart from the mark, and the ‘088 registration has not yet become incontestable.

31. Paragraph 31 of the Petition for Cancellation mischaracterizes Registration No. 6,504,087 (*‘087 Registration*); therefore, the allegations are denied except Respondent admits on September 28, 2021, the PTO granted Respondent’s ‘087 Registration for the word mark HONEST HISTORY in Class 41 for the following goods and services:

Educational services, namely, providing non-downloadable videos, courses of instruction, blogs, and audio recordings, in the fields of history and education for children; Providing courses of instruction in the field of history and education for children; Educational services, namely, developing curriculum for educators; Educational services, namely, developing curriculum for others in the field of history; Educational services, namely, developing curriculum for teachers

Respondent further admits it made no claim to an exclusive right to use the term “history” apart from the mark, and the ‘087 registration has not yet become incontestable.

32. Paragraph 32 of the Petition for Cancellation mischaracterizes Registration No. 6,008,523 (*‘523 Registration*); therefore, the allegations are denied except Respondent admits on March 10, 2020, the PTO granted Respondent’s ‘523 Registration for the word mark HONEST HISTORY in Class 16 for the following goods and services:

Educational magazines for children in the field of history.

Respondent further admits it made no claim to an exclusive right to use the term “history” apart from the mark, and the ‘523 registration has not yet become incontestable.

33. The PTO records in connection with the allegations of paragraph 33 of the Petition for Cancellation speak for themselves. To the extent a response is required, denied.

34. Paragraph 34 of the Petition for Cancellation mischaracterizes Respondent’s response to the Office Action dated August 14, 2018 therefore, the allegations are denied

except Respondent admits that each of the Honest History Registrations disclaim any exclusive right to use the term “history” apart from the mark as shown therein.

35. Respondent denies each and every allegation contained in paragraph 35 of the Petition for Cancellation.

36. Respondent denies each and every allegation contained in paragraph 36 of the Petition for Cancellation.

37. The PTO records in connection with the allegations of paragraph 37 of the Petition for Cancellation speak for themselves. To the extent a response is required, denied.

38. Respondent denies each and every allegation contained in paragraph 38 of the Petition for Cancellation.

39. Respondent denies each and every allegation contained in paragraph 39 of the Petition for Cancellation.

40. The PTO records in connection with the allegations of paragraph 40 of the Petition for Cancellation speak for themselves. To the extent a response is required, denied.

41. Respondent denies each and every allegation contained in paragraph 41 of the Petition for Cancellation.

42. Paragraph 42 of the Petition for Cancellation is a statement to which no admission or denial is required. To the extent a response is required, denied.

43. Paragraph 43 of the Petition for Cancellation mischaracterizes Applicant’s Complaint filed with the WIPO Arbitration and Mediation Center which speaks for itself. To the extent a response is required, denied.

44. Paragraph 44 of the Petition for Cancellation mischaracterizes Applicant’s Complaint filed with the WIPO Arbitration and Mediation Center which speaks for itself. To the extent a response is required, denied.

45. Respondent denies each and every allegation contained in paragraph 45 of the Petition for Cancellation.

46. Respondent denies each and every allegation contained in paragraph 46 of the Petition for Cancellation.

47. Respondent denies each and every allegation contained in paragraph 47 of the Petition for Cancellation.

48. Respondent admits the allegation contained in paragraph 48 of the Petition for Cancellation.

49. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 49 of the Petition for Cancellation, and therefore denies the same.

50. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 50 of the Petition for Cancellation, and therefore denies the same.

51. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 51 of the Petition for Cancellation, and therefore denies the same.

52. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 52 of the Petition for Cancellation, and therefore denies the same.

53. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 53 of the Petition for Cancellation, and therefore denies the same.

54. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 54 of the Petition for Cancellation, and therefore denies the same.

55. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 55 of the Petition for Cancellation, and therefore denies the same.

56. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 56 of the Petition for Cancellation, and therefore denies the same.

57. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 57 of the Petition for Cancellation, and therefore denies the same.

58. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 58 of the Petition for Cancellation, and therefore denies the same.

59. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 59 of the Petition for Cancellation, and therefore denies the same.

60. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 60 of the Petition for Cancellation, and therefore denies the same.

61. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 61 of the Petition for Cancellation, and therefore denies the same.

62. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 62 of the Petition for Cancellation, and therefore denies the same.

63. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 63 of the Petition for Cancellation, and therefore denies the same.

64. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 64 of the Petition for Cancellation, and therefore denies the same.

65. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 65 of the Petition for Cancellation, and therefore denies the same.

66. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 66 of the Petition for Cancellation, and therefore denies the same.

67. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 67 of the Petition for Cancellation, and therefore denies the same.

68. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 68 of the Petition for Cancellation, and therefore denies the same.

69. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 69 of the Petition for Cancellation, and therefore denies the same.

70. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 70 of the Petition for Cancellation, and therefore denies the same.

71. Paragraph 71 of the Petition for Cancellation contains a misstatement of law inasmuch as it implies Respondent has a duty to prevent third party uses of the words “honest history” in a generic, descriptive, and/or informational manner therefore, the allegations are denied.

72. Respondent denies the allegations contained in Paragraph 72 of the Petition for Cancellation except Respondent admits the Exhibits 13-1 to 13-22 do not use the words “honest history” as a source identifier in a trademark sense.

73. Respondent denies each and every allegation contained in paragraph 73 of the Petition for Cancellation.

74. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 74 of the Petition for Cancellation, and therefore denies the same.

75. Respondent denies the allegations of paragraph 75 of the Petition for Cancellation.

76. Respondent denies the allegations of paragraph 76 of the Petition for Cancellation.

77. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 77 of the Petition for Cancellation, and therefore denies the same.

78. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 78 of the Petition for Cancellation, and therefore denies the same.

79. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 79 of the Petition for Cancellation, and therefore denies the same.

80. Respondent denies the allegations of paragraph 80 of the Petition for Cancellation.

81. Respondent lacks sufficient knowledge and information to form a belief as to the allegations of paragraph 81 of the Petition for Cancellation, and therefore denies the same.

82. Respondent denies each and every allegation contained in paragraph 82 of the Petition for Cancellation.

83. Respondent denies each and every allegation contained in paragraph 83 of the Petition for Cancellation.

84. Respondent denies each and every allegation contained in paragraph 84 of the Petition for Cancellation.

85. Respondent admits the allegation contained in paragraph 85 of the Petition for Cancellation.

86. Respondent admits the allegation of paragraph 86 the Petition for Cancellation, and therefore denies the same.

87. Respondent admits the allegation contained in paragraph 87 of the Petition for Cancellation.

88. Respondent denies each and every allegation contained in paragraph 88 of the Petition for Cancellation.

89. Respondent denies each and every allegation contained in paragraph 89 of the Petition for Cancellation.

90. Respondent denies each and every allegation contained in paragraph 90 of the Petition for Cancellation.

91. Respondent denies each and every allegation contained in paragraph 91 of the Petition for Cancellation; furthermore, Respondent's '523 Reg. priority date of April 19, 2018, pre-dates Exhibit 13-6's purported publication date of December 23, 2019.

92. Respondent denies each and every allegation contained in paragraph 92 of the Petition for Cancellation.

93. Respondent denies each and every allegation contained in paragraph 93 of the Petition for Cancellation.

94. Respondent denies each and every allegation contained in paragraph 94 of the Petition for Cancellation.

95. Respondent denies each and every allegation contained in paragraph 95 of the Petition for Cancellation.

Answer to First Cause of Action
Cancellation Based on Descriptiveness
Without Secondary Meaning Established

96. Respondent incorporates by reference the responses in paragraphs 1 through 95 as though fully set forth.

97. Respondent denies each and every allegation contained in paragraph 97 of the Petition for Cancellation.

98. Respondent admits the allegations contained in paragraph 98 of the Petition for Cancellation.

99. Respondent denies each and every allegation contained in paragraph 99 of the Petition for Cancellation.

100. Paragraph 100 of the Petition for Cancellation contains a mischaracterization of law inasmuch as it omits that acquired distinctiveness may be presumed when a mark is, at least, suggestive. Therefore, the allegations are denied.

101. Paragraph 101 of the Petition for Cancellation are statements that contain no allegations. To the extent a response is required, denied.

102. Paragraph 102 of the Petition for Cancellation consists of a statement to which no admission or denial is required. To the extent a response is required, denied.

103. Paragraph 103 of the Petition for Cancellation consists of a statement to which no admission or denial is required. To the extent a response is required, denied.

104. Respondent denies each and every allegation contained in paragraph 104 of the Petition for Cancellation.

105. Respondent denies each and every allegation contained in paragraph 105 of the Petition for Cancellation.

106. Respondent denies each and every allegation contained in paragraph 106 of the Petition for Cancellation.

107. Respondent denies each and every allegation contained in paragraph 107 of the Petition for Cancellation.

Answer to Second Cause of Action
Cancellation Based on Genericness

108. Respondent incorporates by reference the responses in paragraphs 1 through 107 as though fully set forth.

109. Respondent denies each and every allegation contained in paragraph 109 of the Petition for Cancellation.

110. Respondent admits the allegation contained in paragraph 110 of the Petition for Cancellation.

111. Respondent denies each and every allegation contained in paragraph 111 of the Petition for Cancellation.

112. Respondent denies each and every allegation contained in paragraph 112 of the Petition for Cancellation.

113. Respondent denies each and every allegation contained in paragraph 113 of the Petition for Cancellation.

114. Respondent denies each and every allegation contained in paragraph 114 of the Petition for Cancellation.

115. Respondent denies each and every allegation contained in paragraph 115 of the Petition for Cancellation.

116. Respondent denies each and every allegation contained in paragraph 116 of the Petition for Cancellation.

Answer to Third Cause of Action
Cancellation Based on Failure to Function as a Trademark

117. Respondent incorporates by reference the responses in paragraphs 1 through 116 as though fully set forth.

118. Respondent denies each and every allegation contained in paragraph 118 of the Petition for Cancellation.

119. Paragraph 119 of the Petition for Cancellation consists of a statement to which no admission or denial is required. To the extent a response is required, denied.

120. Paragraph 120 of the Petition for Cancellation consists of a statement to which no admission or denial is required. To the extent a response is required, denied.

121. Respondent denies each and every allegation contained in paragraph 121 of the Petition for Cancellation.

122. Respondent denies each and every allegation contained in paragraph 122 of the Petition for Cancellation.

123. Respondent denies each and every allegation contained in paragraph 123 of the Petition for Cancellation.

124. Respondent denies each and every allegation contained in paragraph 124 of the Petition for Cancellation.

125. Respondent denies each and every allegation contained in paragraph 125 of the Petition for Cancellation.

126. Respondent denies each and every allegation contained in paragraph 126 of the Petition for Cancellation.

127. Respondent denies each and every allegation contained in paragraph 127 of the Petition for Cancellation.

128. Respondent denies each and every allegation contained in paragraph 128 of the Petition for Cancellation.

129. Respondent denies each and every allegation contained in paragraph 129 of the Petition for Cancellation.

Answer to Fourth Cause of Action
Cancellation Based on Abandonment

130. Respondent incorporates by reference the responses in paragraphs 1 through 129 as though fully set forth.

131. Respondent denies each and every allegation contained in paragraph 131 of the Petition for Cancellation.

132. Paragraph 132 of the Petition for Cancellation consists of a statement to which no admission or denial is required. To the extent a response is required, denied.

133. Paragraph 133 of the Petition for Cancellation consists of a statement to which no admission or denial is required. To the extent a response is required, denied.

134. Respondent denies each and every allegation contained in paragraph 134 of the Petition for Cancellation.

135. Respondent denies each and every allegation contained in paragraph 135 of the Petition for Cancellation.

136. Respondent denies each and every allegation contained in paragraph 136 of the Petition for Cancellation.

137. Respondent denies each and every allegation contained in paragraph 137 of the Petition for Cancellation.

138. Respondent denies each and every allegation contained in paragraph 138 of the Petition for Cancellation.

139. Respondent denies each and every allegation contained in paragraph 139 of the Petition for Cancellation.

140. Respondent denies each and every allegation contained in paragraph 140 of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

Respondent reserves the right to rely on affirmative defenses as may be supported by facts to be determined through full and complete discovery and to amend its Answer to assert such affirmative defenses.

WHEREFORE, Respondent prays that this Petition for Cancellation be dismissed and that judgment be entered in favor of Respondent.

Respectfully submitted,

Dated: March 27, 2023

By: /CMW/

Christopher M. Wheeler
ATTORNEY AT LAW
5419 Hollywood Boulevard, Suite C436
Los Angeles, CA 90027
Tel: 323-580-6200
Fax: 323-544-6205 (fax)
Chris@CMWheelerLaw.com

Grant F. Atkinson
FRAMEWORK LAW GROUP PC
PO Box 143
Wrightwood, CA 92397
Tel: 847-987-7361
Grant@frameworklaw.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Answer to Petition for Cancellation** has been served on D. Scott Hemingway, Esq., by forwarding said copy on March 27, 2023, via email to:

D. Scott Hemingway, Esq.
HEMINGWAY & HANSEN, LLP
1700 Pacific Avenue, Suite 1820
Dallas, TX 75201
Tel: 214-292-8301
Fax: 214-292-8999 (fax)
shemingway@hh-iplaw.com
ehartman@hh-iplaw.com
admin@hh-iplaw.com

Dated: March 27, 2023

/CMW/

Christopher M. Wheeler