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

Proceeding	92062096
Party	Plaintiff Houzz Inc.
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Submission	Motion to Suspend for Civil Action
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Signature	/John Paul Oleksiuk/
Date	08/28/2015
Attachments	motion to suspend 120816232_1.pdf(248476 bytes)

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

In the matter of U.S. Trademark Registration No. 4,668,337
For the Trademark IN HOUZ
Registered on the Principal Register January 6, 2015

HOUZZ INC.)	
)	
Petitioner,)	
)	
v.)	
)	Cancellation No. 92062096
ODL, INCORPORATED)	
)	
)	
Registrant.)	
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**MOTION FOR SUSPENSION PENDING OUTCOME OF A CIVIL ACTION
UNDER 37 C.F.R §2.117(a)**

Pursuant to C.F.R. § 2.117(a), Petitioner Houzz Inc. (“Petitioner”) files this motion to suspend all proceedings in this matter, pending the outcome of a civil action pending in federal court between the parties which may have a bearing on the instant Board case.

On August 24, 2015, after filing the Petition for Cancellation in the instant Board case, Petitioner filed suit against Registrant ODL, Incorporated for Federal Trademark Infringement Under 15 U.S.C. § 1114, Unfair Competition and False Designation of Origin Under 15 U.S.C. § 1125, Federal Trademark Dilution Under 15 U.S.C. § 1125, and Unfair Competition Under Cal. Bus. & Prof. Code § 17200 in the U.S. District Court for the Northern District of California, captioned *Houzz Inc. v. ODL, Incorporated, et al.*, Civil Action No. 5:15-cv-03847-HRL (the “Civil Action”). On August 27, 2015, Petitioner filed an Amended Complaint in the Civil Action. Attached hereto as Exhibit A is a true and correct copy of the Amended Complaint

(exhibits and attachments thereto omitted). The Civil Action involves the same parties and some common issues that may have a bearing on the instant Board proceedings.

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action. *See* 37 C.F.R. § 2.117(a); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125 (TTAB 1974), *petition denied*, 181 USPQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971).

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court. To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court. *See, e.g., Goya Foods Inc. v. Tropicana Prods Inc.*, 846 F.2d 848, 6 USPQ2d 1950, 1954 (2d Cir. 1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 USPQ2d 1208 (D.Minn. 1986).

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Here, the pending Civil Action involves some issues in common with these proceedings which may bear on this case. Petitioner therefore respectfully requests that these Board proceedings be suspended pursuant to C.F.R. §2.117(a) until resolution of the Civil Action.

COOLEY LLP

Dated: August 28, 2015

By: /John Paul Oleksiuk/
Janet L. Cullum, Esq.
Anne H. Peck, Esq.
John Paul Oleksiuk, Esq.
Chantal Z. Hwang, Esq.
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **MOTION FOR SUSPENSION PENDING OUTCOME OF A CIVIL ACTION UNDER 37 C.F.R §2.117(a)** has been served on ODL, Incorporated by mailing said copy of August 28, 2015, via First Class Mail, postage prepaid to:

ODL, Incorporated
215 East Roosevelt Avenue
Zeeland, Michigan 49464

Date: August 28, 2015

/John Paul Oleksiuk/
John Paul Oleksiuk

Exhibit A

120816232 v1

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6 Attorneys for Plaintiff
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8 UNITED STATES DISTRICT COURT
 9 NORTHERN DISTRICT OF CALIFORNIA
 10 SAN JOSE DIVISION

13 HOUZZ INC., a Delaware corporation,
 14 Plaintiff,
 15 v.
 16 ODL, INCORPORATED, a Michigan
 corporation,
 17 INHOUZ, LLC, a Michigan limited liability
 company,
 18 Defendants.

Case No. 5:15-cv-03847-HRL

AMENDED COMPLAINT FOR:

**(1) FEDERAL TRADEMARK
 INFRINGEMENT UNDER 15 U.S.C.
 § 1114;**

**(2) UNFAIR COMPETITION AND
 FALSE DESIGNATION OF ORIGIN
 UNDER 15 U.S.C. § 1125;**

**(3) FEDERAL TRADEMARK
 DILUTION UNDER 15 U.S.C. § 1125;
 and**

**(4) UNFAIR COMPETITION UNDER
 CAL. BUS. & PROF. CODE § 17200,
 ET SEQ.**

DEMAND FOR JURY TRIAL

21 Plaintiff Houzz Inc. (“Plaintiff” or “Houzz”) complains and alleges against ODL,
 22 Incorporated (“ODL”) and InHouz, LLC (“InHouz”) (collectively, “Defendants”) as follows:
 23

THE PARTIES

1
2 1. Plaintiff Houzz, Inc. is a corporation organized under the laws of the State of
3 Delaware with its principal place of business at 310 University Avenue, Palo Alto, California
4 94301.

5 2. Defendant ODL, Incorporated is a corporation organized under the laws of the
6 State of Michigan with its principal place of business at 215 East Roosevelt Avenue, Zeeland,
7 Michigan 49464.

8 3. Defendant InHouz, LLC is a limited liability company organized under the laws of
9 the State of Michigan with its principal place of business at 215 East Roosevelt Avenue, Zeeland,
10 Michigan 49464.

11 4. Upon information and belief, Defendant InHouz, LLC is a wholly-owned
12 subsidiary of Defendant ODL, Incorporated.

JURISDICTION AND VENUE

13
14 5. This action arises under the federal trademark statute (the “Lanham Act”), 15
15 U.S.C. §1051, *et seq.*

16 6. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. §
17 1119 and 1121, and 28 U.S.C. §§ 1331, 1338, and 1367.

18 7. Plaintiff is informed and believes, and based thereon alleges, that this Court has
19 personal jurisdiction over Defendants because (i) Defendants conduct business within the State of
20 California and this judicial district; (ii) Defendants have caused products to be advertised,
21 promoted, and sold under the IN HOUZ trademark in the State of California and this judicial
22 district; (iii) the causes of action asserted in this Amended Complaint arise out of Defendants’
23 contacts with the State of California and this judicial district; and (iv) Defendants have caused
24 tortious injury to Plaintiff in the State of California and this judicial district.

25 8. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) and (c)
26 because (i) Defendants conduct business within the State of California and this judicial district;
27 (ii) Defendants have caused products to be advertised, promoted, and sold under the IN HOUZ
28 trademark in the State of California and this judicial district; (iii) the causes of action asserted in

1 this Amended Complaint arise out of Defendants’ contacts with the State of California and this
2 judicial district; and (iv) Defendants have caused tortious injury to Plaintiff in the State of
3 California and this judicial district.

4 **INTRADISTRICT ASSIGNMENT**

5 9. This is an Intellectual Property Action to be assigned on a district wide basis
6 pursuant to Civil L.R. 3-2(c).

7 **FACTUAL BACKGROUND**

8 **PLATINFF’S BUSINESS AND THE HOZZ TRADEMARK**

9 10. Houzz is on online platform and application offering a wide variety of information
10 about home design and remodeling to a broad community of users across the United States and
11 internationally.

12 11. Houzz began as a local, small project in the Bay Area founded by a husband and
13 wife who had experienced difficulty in identifying the resources and information they desired in
14 connection with remodeling their home.

15 12. Over the years, Houzz has transformed the home remodeling and design industry
16 by bringing together a community of homeowners, designers, architects and others in the industry
17 to share, exchange and discuss remodeling and design and has become the leading – and largest –
18 platform for home remodeling and design.

19 13. With more than 35 million unique monthly users and 800,000 active home
20 professionals, Houzz offers the largest home community online.

21 14. Houzz’ website, which is located at <www.houzz.com> (the “HOZZ Website”),
22 and Houzz’ mobile application now feature over 7 million professional photos of home interiors
23 and exteriors.

24 15. Since 2008, Houzz has continuously used the inherently distinctive trademark
25 HOZZ for a website featuring information in the fields of home renovation, home interior
26 design, interior decorating and remodeling.

27
28

1 16. At Houzz, the focus today is the same as it was from day one: to create the best
2 experience for home design by using technology to remove the barriers between homeowners and
3 good design, and between home design and remodeling professionals and homeowners.

4 17. The HOUZZ Website and Houzz' mobile application provide a platform for users
5 to create electronic scrapbooks and share photos of home design and decorating ideas, including
6 DIY ("do it yourself") home projects.

7 18. The HOUZZ Website and Houzz' mobile application provide a platform for home
8 design and remodeling professionals to share and promote their services by featuring their
9 portfolios of past work and facilitating connections with consumers for those services.

10 19. The HOUZZ Website and Houzz' mobile application provide a platform to enable
11 homeowners to readily locate and connect with providers of products including building
12 materials, furnishing and decorative items featured in images displayed on the HOUZZ Website
13 and on the Houzz mobile application.

14 20. Houzz has devoted substantial time, effort, and resources to the development and
15 extensive promotion of the HOUZZ mark and the products and services offered thereunder. As a
16 result of Houzz' efforts and the quality of the products and services offered under the HOUZZ
17 mark, the public has come to recognize and rely upon the HOUZZ trademark as an indication of
18 quality and the HOUZZ mark enjoys substantial goodwill in the marketplace and is a valuable
19 asset of Houzz.

20 21. Over the years, the HOUZZ mark has enjoyed widespread media coverage,
21 including coverage by *The Today Show*, *CNBC*, *Bloomberg Businessweek*, *Fox Business*, *Fast*
22 *Company*, *Les Echos*, *Pando Daily*, *Time*, *Forbes*, *Mashable*, *Bloomberg TV*, *Internet Trends*
23 *2014*, *TechCrunch*, *Vanity Fair*, *CNN*, *The Huffington Post*, *The Wall Street Journal*, *The*
24 *Washington Post*, *Digital Journal*, *The San Francisco Chronicle*, *The New York Times*,
25 *Fortune.com*, *The Dallas Morning News*, *The Cleveland Plain Dealer*, *Landscape Management*
26 *Magazine*, *The Valley Girl Show*, *AllThingsD*, *PCMag.com*, *Barron's*, *MacObserver*, *TheStreet*,
27 *Remodeling Magazine*, *The Sacramento Bee*, *Architectural Digest*, *The National Post*, *Macworld*,
28 *Search Engine Watch*, *The Los Angeles Times*, *Forbes*, *Las Vegas Review-Journal*, *Chicago*

1 *Tribune, InStyle, AppStorm, Parenting, The Kim Komando Show, The Mercury News, La Stampa,*
2 *AppCraver, The Associated Press, and The Oregonian.*

3 22. As a result of Houzz' widespread use of the HOUZZ mark in the United States,
4 extensive advertising and promotion of the products and services sold in connection with the
5 HOUZZ mark, widespread media coverage of Houzz' products and services, the high degree of
6 customer recognition of the HOUZZ mark, the strong and loyal base of customers that Houzz
7 enjoys for its services, and the distinctiveness of the HOUZZ mark, among other factors, the
8 HOUZZ mark is famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C.
9 §1125(c).

10 23. On April 10, 2012, the United States Patent & Trademark Office ("PTO") issued
11 U.S. Trademark Registration No. 4,124,845 for the mark HOUZZ in connection with
12 "[p]romoting home design and decorating products of others by providing hypertext links to the
13 web sites of others; promoting home design, decorating, and remodeling services of others by
14 providing contact information and hypertext links to service provider's websites," "[p]roviding a
15 website that features information in the field of home renovation and remodeling," and
16 "[p]roviding a website featuring information in the field of interior design and architecture for use
17 by interior designers and architects; [p]roviding a website featuring information in the field of
18 home interior design and interior decorating; [p]roviding an website that features temporary use
19 of non-downloadable software allowing website users to upload, post, share and display online
20 photos of interior design and decorating ideas and which also allows users to post questions and
21 comments in the field of interior design, decorating and remodeling; providing a website
22 featuring temporary use of non-downloadable software for use in creating online, electronic
23 scrapbooks of design and decorating ideas."

24 24. The application filing date and priority date for U.S. Trademark Registration No.
25 4,124,845 is July 8, 2011.

26 25. The date that the HOUZZ mark was first used for each class of services in U.S.
27 Trademark Registration No. 4,124,845 was at least as early as August 2008.

28

1 26. On February 18, 2014, the PTO issued U.S. Trademark Registration No. 4,485,255
2 for the mark HOUZZ and Design (in stylized form) in connection with “[p]roviding online
3 directories and listings featuring vendor contact information in the field of interior decorating,
4 furnishings, and remodeling; providing hypertext links to websites of others featuring the sale of
5 furnishings,” “[p]roviding a website that features information in the field of home renovation and
6 remodeling; providing hypertext links to websites of others featuring home remodeling
7 information,” and “[p]roviding a website featuring information in the field of interior decorating
8 and architecture; [p]roviding a website that features temporary use of non-downloadable software
9 allowing website users to upload, post, share and display online photos of interior decorating
10 ideas and that also allows users to post questions and comments in the field of interior decorating
11 and remodeling; providing a website featuring temporary use of non-downloadable software for
12 use in creating online, electronic scrapbooks of decorating ideas; providing hypertext links to
13 websites of others featuring interior decorating information.”

14 27. The application filing date and priority date for U.S. Trademark Registration No.
15 4,485,255 is July 23, 2013.

16 28. The date that the HOUZZ and Design mark was first used for each class of
17 services in U.S. Trademark Registration No. 4,485,255 was at least as early as December 2009.

18 29. U.S. Trademark Registration Nos. 4,124,845 and 4,485,255 are referred to
19 collectively herein as the “HOUZZ Registrations.” True and correct copies of the registration
20 certificates for the HOUZZ Registrations, along with a PTO report on the current status of the
21 HOUZZ Registrations, are attached as Exhibit A, and incorporated by reference as though fully
22 set forth herein. Houzz is also the owner of several other pending U.S. trademark applications for
23 the mark HOUZZ, as well as foreign trademark applications and registrations.

24 30. The HOUZZ Registrations are in full force and effect on the PTO’s Principal
25 Register.

26 **DEFENDANTS’ USE OF THE IN HOUZ TRADEMARK**

27 31. Notwithstanding Houzz’ diligent efforts to monitor and prevent unauthorized uses
28 of its HOUZZ trademark, Defendants have engaged in reoccurring and willful infringement and

1 dilution of the HOUZZ trademark in connection with an IN HOUZ branded website featuring
2 information in the fields of home renovation, home interior design, interior decorating and
3 remodeling, DIY home projects, and the sale of related goods, including but not limited to
4 infringement and dilution arising from deliberate and willful copying from Houzz.

5 32. On August 7, 2013, ODL applied to register the mark IN HOUZ with the United
6 States Patent and Trademark Office, and the registration issued as U.S. Trademark Registration
7 No. 4,668,337 (“ODL’s Registration”) on January 6, 2015, covering “[p]roviding a website to
8 promote the sale and purchase of decorative [sic] door glass, retractable screens, doorglass
9 blinds, door glass, indoor storage and communication system, and tubular solar lighting,” and
10 “[p]roviding information on installation services available by region in the fields of decorative
11 door glass, retractable screens, door glass blinds, door glass, indoor storage and communication
12 systems, and tubular solar lighting.” ODL’s Registration contains a claimed date of first use of
13 March 31, 2014 for the IN HOUZ mark for the services identified in the registration. A true and
14 correct copy of ODL’s Registration is attached hereto as Exhibit B.

15 33. ODL’s Registration has not become incontestable.

16 34. ODL’s Registration is vulnerable to cancellation on the basis of Houzz’ priority
17 and likelihood of confusion between the IN HOUZ mark and the HOUZZ mark.

18 35. ODL’s Registration is also vulnerable to cancellation on the basis that the IN
19 HOUZ mark dilutes the distinctive quality of the famous HOUZZ mark.

20 36. On August 24, 2015, Houzz filed a Petition for Cancellation of the IN HOUZ
21 Registration, and the Petition for Cancellation is currently pending.

22 37. Upon information and belief, on or about March 20, 2012, an agent of Defendants
23 created a user profile on the HOUZZ Website, using a username and name corresponding with
24 the name of an ODL employee, and using an email address ending in “inhouz.com”.

25 38. Upon detecting this account and the unauthorized use of the IN HOUZ mark, on or
26 about March 23, 2015, Houzz suspended this account.

27 39. Shortly after learning of Defendants’ infringing activities, on or about March 27,
28 2015, Houzz sent a letter to Defendants, demanding that they cease all use of the IN HOUZ mark

1 in connection with their identical or closely related offerings in the category of home design and
2 remodeling as those offered under the HOUZZ mark, as shown at inhouz.com.

3 40. By letter dated April 2, 2015, ODL refused to comply with Houzz' demands, and
4 Defendants continued engaging in their infringing activity.

5 41. Upon information and belief, on or about May 26, 2015, Defendants resumed
6 accessing the HOUZZ Website under a new account, using a username and email that appeared to
7 be associated with the same employee of ODL whose account was suspended by Houzz on March
8 23, 2015.

9 42. Upon detecting this account on or about August 12, 2015, Houzz suspended this
10 account as well.

11 43. Through their accounts on the HOUZZ Website, Defendants have offered for sale
12 products under the IN HOUZ mark. Attached hereto as Exhibit C is a true and correct copy of a
13 cached version of a page on the HOUZZ Website as of July 19, 2015 reflecting the listing of a
14 product under the IN HOUZ mark.

15 44. Defendants have used the confusingly similar and dilutive IN HOUZ mark in
16 connection with dozens of blog articles that are deliberate and willful imitations of the style used
17 by Houzz covering the same subjects as Houzz. For example:

HOUZZ ARTICLES	IN HOUZ ARTICLES
AVAILABLE AT HOUZZ.COM	AVAILABLE AT INHOUZ.COM
17 Ways to Increase Your Home's Curb Appeal (first published March 20, 2013)	12 Ways to Add Curb Appeal to Your Home (first published August 6, 2015)
How to Spruce Up Your Patio for Summertime Fun (first published May 23, 2015)	Sprucing Up Your Outdoor Entertaining Space for Spring (first published August 3, 2015)
12 Cheap and Chic Fall Centerpieces (first published September 26, 2012)	12 Creative Centerpieces for Any Occasion (first published August 13, 2015)

HOUZZ ARTICLES AVAILABLE AT HOUZZ.COM	IN HOUZ ARTICLES AVAILABLE AT INHOUZ.COM
Keys to a Stylish Entry (first published April 2, 2011)	Transformation Tuesday: A Stylish Entryway (first published April 28, 2015)
8 Amazing Home Exterior Transformations (first published May 29, 2013)	5 Ways to Transform an “Ugly” Home Exterior (first published March 9, 2015)
Find the Right Glass Door for Your Patio (first published August 1, 2013)	Finding Your Front Door Glass Design Style (first published July 9, 2015)
Your Door: Shades of Privacy and Light (first published January 17, 2012)	Transformation Tuesday: Natural Light and Privacy (first published April 21, 2015)
The Joy of Spring: Bring the Outside Inside (March 20, 2011)	5 Tips on How to Bring the Outdoors Inside (first published January 22, 2015)
13 Upgrades to Make Over Your Outdoor Grill Area (first published June 25, 2015)	8 Patio Upgrades for Under \$200 Each (first published August 5, 2015)
10 Fun Decorating Projects for Spring (first published March 19, 2014)	10 Ways to Spruce Up Your Home Décor for Spring (first published May 6, 2015)

True and correct copies of excerpts from each of the respective houzz.com and inhouz.com articles listed above are attached hereto as Exhibit D.

45. On social media, Defendants have also shared links to Houzz’ content in a manner that puts the IN HOUZ mark and HOUZZ mark in close proximity.

1 46. For example, Defendants posted a link to a Houzz article on Twitter, under the
2 InHouz username, with multiple references to Houzz, as shown in the following screenshot:



1 47. Defendants posted the same article on Facebook as well, under the InHouz
2 username, as shown in the following screenshot:



48. Defendants are also promoting the IN HOUZ brand elsewhere to consumers located within this District, as well as promoting and selling other goods under the IN HOUZ brand through retailers and dealers located within this District.

49. Attached hereto as Exhibit E is a true and correct copy of a page from ODL's website located at <www.odl.com> on August 14, 2015, identifying 121 physical locations within 100 miles of zip code 94101 where ODL products can be purchased, and identifying online retailer InHouz.com as a location where customers located in zip code 94101 may purchase ODL products within this District.

50. Defendants' IN HOUZ branded website featuring products and information in the fields of home renovation, home interior design, interior decorating and remodeling competes directly with Houzz' offering of the same services under the HOUZZ brand.

51. Defendants' products and services offered under the IN HOUZ brand are offered through the same marketing and trade channels and to the same target customers as Houzz',

1 including through e-commerce websites and, until Houzz suspended Defendants' accounts, in
2 some cases through the HOUZZ Website itself.

3 52. Houzz began using the HOUZZ mark in the United States prior to Defendants'
4 adoption and use of the IN HOUZ mark in the United States. The priority dates for the HOUZZ
5 Registrations are also prior to Defendants' first use of the IN HOUZ mark and application to
6 register the IN HOUZ mark in the United States.

7 53. The HOUZZ marks acquired wide recognition in the general consuming public,
8 and became famous, prior to Defendants' use of the IN HOUZ mark.

9 54. The IN HOUZ mark is highly similar in sight, sound, and appearance to the
10 HOUZZ mark.

11 55. The particular stylization of IN HOUZ used by Defendants, with the terms IN and
12 HOUZ separated by a design element, exacerbates the similarity in appearance to the HOUZZ
13 mark, as shown in the following stylization:



16

17 56. Defendants' use of the term IN HOUZ described herein is likely to cause
18 confusion in the marketplace and infringes Houzz' valuable rights in the HOUZZ mark.

19 57. Defendants' use of the term IN HOUZ described herein creates a false suggestion
20 of an affiliation or connection between Defendants and Houzz.

21 58. The term IN HOUZ incorporates a distinctive part of the HOUZZ mark, i.e.,
22 "HOUZ," and thus Defendants' use of the IN HOUZ mark impairs the distinctiveness of the
23 HOUZZ mark and weakens the connection in consumers' minds between the HOUZZ mark and
24 Houzz' services.

25 59. Houzz is not affiliated with Defendants. Houzz has not consented to, sponsored,
26 endorsed, or approved of Defendants' use of the term IN HOUZ in connection with the
27 production, marketing, or sale of any products or services.

28

1 intention of causing confusion, mistake, and deception, making this an exceptional case entitling
2 Plaintiff to recover treble damages, reasonable attorneys' fees, and costs pursuant to 15 U.S.C. §
3 1117, as well as prejudgment interest.

4 **SECOND CAUSE OF ACTION**

5 **FEDERAL UNFAIR COMPETITION AND FALSE DESIGNATION OF ORIGIN**

6 **UNDER 15 U.S.C. § 1125**

7 68. Plaintiff realleges and incorporates herein by this reference paragraphs 1 through
8 67 of this Amended Complaint as if fully set forth here.

9 69. Defendants have used in commerce and without Plaintiff's authorization or
10 consent the term IN HOUZ, which is confusingly similar to Plaintiff's registered and common
11 law HOUZZ mark.

12 70. Defendants' actions as described herein are likely to cause confusion and
13 deception among the consuming public and is likely to lead the consuming public to believe that
14 Plaintiff has authorized, approved, or somehow sponsored Defendants' use of the term IN HOUZ.

15 71. Defendants' actions constitute unfair competition and false designation of origin in
16 violation of 15 U.S.C. § 1125(a).

17 72. Plaintiff has been, and will continue to be, damaged and irreparably harmed by the
18 actions of Defendants, which will continue unless Defendants are enjoined by this Court.
19 Plaintiff has no adequate remedy at law in that the amount of damage to Plaintiff's business and
20 reputation and the diminution of the goodwill of the HOUZZ trademark are difficult to ascertain
21 with specificity. Plaintiff is therefore entitled to injunctive relief pursuant to 15 U.S.C. § 1116.

22 73. Plaintiff is entitled to recover damages in an amount to be determined at trial and
23 profits made by Defendants on the sales of any products and services through use of the IN
24 HOUZ mark. Furthermore, Plaintiff is informed and believes, and on that basis alleges, that the
25 actions of Defendants were undertaken willfully and with the intention of causing confusion,
26 mistake, deception, making this an exceptional case entitling Plaintiff to recover treble damages,
27 reasonable attorneys' fees, and costs pursuant to 15 U.S.C. § 1117, as well as prejudgment
28 interest.

THIRD CAUSE OF ACTION

FEDERAL TRADEMARK DILUTION UNDER 15 U.S.C. § 1125

1
2
3 74. Plaintiff realleges and incorporates herein by this reference paragraphs 1 through
4 73 of this Amended Complaint as if fully set forth here.

5 75. As a result of the considerable publicity afforded the HOUZZ mark, and the strong
6 and loyal base of customers that Houzz enjoys for its services, the HOUZZ mark has a high
7 degree of consumer recognition, it is widely recognized by the general consuming public of the
8 United States as a designation of Houzz' services, and it is famous.

9 76. The HOUZZ mark became famous before Defendants adopted or applied to
10 register the IN HOUZ mark.

11 77. Defendants' IN HOUZ mark incorporates a distinctive part of the HOUZZ mark,
12 i.e., "houz," and thus their use is likely to cause an association between IN HOUZ and HOUZZ
13 that impairs the distinctiveness of the HOUZZ mark and weakens the connection in consumers'
14 minds between the HOUZZ mark and Houzz' services. Defendants' use of the IN HOUZ mark is
15 likely to cause dilution by blurring based on a number of relevant considerations, including:

- 16 (a) The high degree of similarity between the IN HOUZ mark and the famous
17 HOUZZ mark;
18 (b) The inherently distinctive nature of the HOUZZ mark;
19 (c) Houzz' substantially exclusive use of the HOUZZ mark;
20 (d) The wide recognition of the HOUZZ mark by the general consuming public; and
21 (e) On information and belief, Defendants intended to create an association with the
22 HOUZZ marks.

23 78. Plaintiff has been, and will continue to be, damaged and irreparably harmed by the
24 actions of Defendants, which will continue unless Defendants are enjoined by this Court.
25 Plaintiff has no adequate remedy at law in that the amount of damage to Plaintiff's business and
26 reputation and the diminution of the goodwill of the HOUZZ trademark are difficult to ascertain
27 with specificity. Plaintiff is therefore entitled to injunctive relief pursuant to 15 U.S.C. § 1116.
28

1 all other persons acting in concert with it be preliminarily and permanently enjoined from (i)
2 using the IN HOUZ mark, or any other mark confusingly similar to Plaintiff's HOUZZ
3 trademark, in connection with the marketing, promotion, advertising, sale, or distribution of any
4 products and services and (ii) from any acts of infringement of Plaintiff's HOUZZ trademark.

5 B. That Defendants file, within ten (10) days from entry of an injunction, a
6 declaration with this Court signed under penalty of perjury certifying the manner in which
7 Defendants have complied with the terms of the injunction;

8 C. That Defendants are adjudged to have violated 15 U.S.C. § 1114 by infringing
9 Plaintiff's HOUZZ trademark;

10 D. That Defendants are adjudged to have violated 15 U.S.C. § 1125(a) for unfairly
11 competing against Plaintiff by using a false designation of origin for Defendants' infringing
12 products and services;

13 E. That Defendants are adjudged to have violated 15 U.S.C. § 1125(c) for dilution by
14 blurring of Plaintiff's HOUZZ trademark;

15 F. That Defendants are adjudged to unlawfully and unfairly compete against Plaintiff
16 under the laws of the State of California, Cal. Bus. & Prof. Code § 17200, *et seq.*;

17 G. That the Court decree and order the cancellation of ODL's U.S. Trademark
18 Registration No. 4,668,337 for the mark IN HOUZ, on the basis of priority and likelihood of
19 confusion, and certify said decree and order to the Director of the United States Patent and
20 Trademark Office under 15 U.S.C. § 1119;

21 H. That Plaintiff be awarded Defendants' profits derived by reason of said acts, or as
22 determined by said accounting;

23 I. That Plaintiff be awarded three times Defendants' profits and three times of all
24 Plaintiff's damages, suffered as a result of Defendants' willful, intentional, and deliberate acts in
25 violation of the Lanham Act, as well as Plaintiff's costs, attorneys' fees, and expenses in this suit
26 under 15 U.S.C. § 1117;

27 J. That Plaintiff be awarded damages in an amount sufficient to compensate it for the
28 damage caused by Defendants' unfair competition under Cal. Bus. & Prof. Code § 17200, *et seq.*;

1 K. That Plaintiff be awarded three times Defendants' profits and three times
2 Plaintiff's damages suffered as a result of the willful, intentional, and deliberate acts in violation
3 of Cal. Bus. & Prof. Code §§ 14247 and 14250;

4 L. That Plaintiff be granted prejudgment and post judgment interest;

5 M. That Plaintiff be granted costs associated with the prosecution of this action; and

6 N. That Plaintiff be granted such further relief as the Court may deem just and
7 equitable.

8 **DEMAND FOR JURY TRIAL**

9 Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiff hereby demands a
10 trial by jury of all issues triable of right by a jury.

11 Dated: August 27, 2015

COOLEY LLP
JANET L. CULLUM (104336)
ANNE H. PECK (124790)
JOHN PAUL OLEKSIUK (283396)
CHANTAL Z. HWANG (275236)

15 /s/ Janet L. Cullum
16 Janet L. Cullum (104336)
17 Attorneys for Plaintiff
Houzz Inc.

18 120734782 v1

Milana, Mercedes

From: ECF-CAND@cand.uscourts.gov
Sent: Thursday, August 27, 2015 11:04 AM
To: efilings@cand.uscourts.gov
Subject: Activity in Case 5:15-cv-03847-HRL Houzz Inc. v. ODL, Incorporated et al Amended Complaint

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U.S. District Court

California Northern District

Notice of Electronic Filing

The following transaction was entered by Cullum, Janet on 8/27/2015 at 11:04 AM and filed on 8/27/2015

Case Name: Houzz Inc. v. ODL, Incorporated et al

Case Number: [5:15-cv-03847-HRL](#)

Filer: Houzz Inc.

Document Number: [6](#)

Docket Text:

AMENDED COMPLAINT against All Defendants. Filed by Houzz Inc.. (Attachments: # (1) Exhibit A, # (2) Exhibit B, # (3) Exhibit C, # (4) Exhibit D (1 of 3), # (5) Exhibit D (2 of 3), # (6) Exhibit D (3 of 3), # (7) Exhibit E)(Cullum, Janet) (Filed on 8/27/2015)

5:15-cv-03847-HRL Notice has been electronically mailed to:

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5:15-cv-03847-HRL Please see [Local Rule 5-5](#); Notice has NOT been electronically mailed to:

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Document description:Main Document

Original filename:C:\Users\SULKHANM\Desktop\Amended Complaint.pdf

Electronic document Stamp:

[STAMP CANDStamp_ID=977336130 [Date=8/27/2015] [FileNumber=11938651-0]

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Document description:Exhibit A

Original filename:C:\Users\SULKHANM\Desktop\Exh. A.pdf

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Document description:Exhibit B

Original filename:C:\Users\SULKHANM\Desktop\Exh. B.pdf

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Document description:Exhibit C

Original filename:C:\Users\SULKHANM\Desktop\Exh. C.pdf

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Document description:Exhibit D (1 of 3)

Original filename:C:\Users\SULKHANM\Desktop\Exh. D (1 of 3)C.pdf

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Document description:Exhibit D (2 of 3)

Original filename:C:\Users\SULKHANM\Desktop\Exh. D (2 of 3)C.pdf

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Document description:Exhibit D (3 of 3)

Original filename:C:\Users\SULKHANM\Desktop\Exh. D (3 of 3)C.pdf

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