

ESTTA Tracking number: **ESTTA580732**

Filing date: **01/08/2014**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Passive House Institute U.S., Inc.
Granted to Date of previous extension	01/08/2014
Address	110 S Race St. Suite 202 Urbana, IL 61801 UNITED STATES
Attorney information	JOHN BOSTJANCICH SMART & BOSTJANCICH 30 W MONROE ST , STE 800 CHICAGO, IL 60603 UNITED STATES bostjancich@hotmail.com, pattismart@hotmail.com Phone:312-857-2424

Applicant Information

Application No	85583360	Publication date	09/10/2013
Opposition Filing Date	01/08/2014	Opposition Period Ends	01/08/2014
Applicant	Dr. Wolfgang Feist Carsonweg 82 64289 Darmstadt, DEX DEX		

Goods/Services Affected by Opposition

<p>Class A. First Use: 1991/00/00 First Use In Commerce: 2006/04/18 All goods and services in the class are opposed, namely: Energy efficient building structures and components therefor in the nature of walls, wall connections and wall systems;insulation and insulation systems; balcony systems and associated connections; faÅšades and associated connections; flueand chimney systems; roofing and roofing systems; flooring, foundations and associated systems; doors; windows including glazing, associated framing, shading and connections; HVAC and ERV units as well as other heat recovery systems; ventilation systems; heat pumps; heating, cooling and dehumidification systems; compact units relating to ventilation with heat recovery, space heating, hot water preparation, space cooling and dehumidification; devices enabling the recovery of renewable energies; and energy storage devices</p>
<p>Class B. First Use: 1991/00/00 First Use In Commerce: 2006/04/18 All goods and services in the class are opposed, namely: Consulting, training, design, supervision, and construction of energy efficientbuilding structures</p>

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
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Genericness	Trademark Act section 23
Other	Lack of use in commerce, Trademark Act section 1

Attachments	NoticeOfOpposition.pdf(33053 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John Bostjancich/
Name	JOHN BOSTJANCICH
Date	01/08/2014

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

In the Matter of Application SN 85583360: CERTIFIED PASSIVE HOUSE
Published in the *Official Gazette* dated September 10, 2013

PASSIVE HOUSE INSTITUTE U.S.,)	
INC.)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
DR. WOLFGANG FEIST,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Passive House Institute U.S., Inc. (also known as “PHIUS”), an Illinois not-for-profit corporation located and doing business at 110 S Race St. Suite 202, Urbana, IL 61801, believes it will be damaged by registration of the mark shown in Application Serial No. 85583360 and hereby opposes same.

As grounds for the opposition, it is alleged:

1. Opposer is and has been involved in research relating to energy standards for passive houses, materials and components used in the construction of passive houses, and the design and construction of passive houses in North America.
2. Opposer is and has been engaged in the certification of consultants, builders and energy raters involved in the design, construction and certification of passive houses, the certification of building components for use in construction of passive houses, and the certification of passive house plans, specifications and energy modeling.

3. Opposer currently certifies passive houses at the design and energy modeling stage and, in connection therewith, also requires third party job-site quality assurance inspections to help assure that a building is constructed as designed.

4. Opposer's PHIUS+ certified passive houses are recognized by the U.S. Department of Energy and are qualified for tax credits.

5. Passive houses are buildings which are designed to achieve an extremely low level of energy consumption through use of construction techniques and products which include high insulation values throughout the building envelope, a high degree of air-tightness, high performance windows, thermal bridge-free construction, and advanced heat-transfer ventilation systems.

6. The term "passive" in the phrase "passive house" refers to the fact that energy used to heat or cool the house is primarily gained through passive measures (insulation, heat recovery, passive use of solar energy and internal heat sources) rather than active sources such as furnaces, boilers and air conditioners.

7. Applicant's Passive House Institute has written that: "Passive house is not a brand name, but a construction concept that can be applied by anyone and that has stood the test of time."

8. The passive house concept was researched, developed and documented by scientists and building science innovators in the United States and Canada in the 1970s and 1980s.

9. In the 1990s, with funding from the German government, applicant adapted for Germany the work of the early American and Canadian pioneers of the passive house concept, and he promoted the passive house concept there. Applicant has stated that 20,000 to 30,000 passive houses have been built in central Europe.

10. Prior to 2011, applicant and opposer or opposer's Executive Director cooperated in a relationship to spread knowledge of the passive house concept in North America, but said relationship

terminated in 2011. Upon information and belief, applicant has been aware of the use and understanding of “passive house” as a generic term in the United States, both during his prior relationship with opposer and opposer’s Executive Director and after the termination of said relationship.

11. Applicant has no proprietary or exclusive right in or to any energy standard to which passive houses perform.

12. Applicant has applied to register CERTIFIED PASSIVE HOUSE for a certification mark for energy efficient building structures and components therefor in the nature of walls, wall connections and wall systems; insulation and insulation systems; balcony systems and associated connections; façades and associated connections; flue and chimney systems; roofing and roofing systems; flooring, foundations and associated systems; doors; windows including glazing, associated framing, shading and connections; HVAC and ERV units as well as other heat recovery systems; ventilation systems; heat pumps; heating, cooling and dehumidification systems; compact units relating to ventilation with heat recovery, space heating, hot water preparation, space cooling and dehumidification; devices enabling the recovery of renewable energies; and energy storage devices, and for consulting, training, design, supervision, and construction of energy efficient building structures, with the term CERTIFIED disclaimed and with a Section 2(f) claim that applicant acquired rights in the phrase PASSIVE HOUSE through substantial and exclusive use.

13. The terminology “passive house” or “certified passive house” is common descriptive or generic terminology with respect to buildings which achieve extremely low levels of energy consumption by means of certain design and construction techniques, or components thereof, their plans, their designers, builders or raters, or the certification of any of the aforesaid, and said terminology cannot function as a mark.

14. The terminology “passive house” or “certified passive house” is so highly descriptive of buildings that achieve extremely low levels of energy consumption by means of certain design and construction techniques, or components thereof, their plans, their designers, builders or raters, or the certification of any of the aforesaid, that said terminology is incapable of functioning as a mark.

15. The terminology “passive house” is descriptive, as acknowledged by applicant, and, contrary to applicant’s allegation, is without acquired distinctiveness.

16. Upon information and belief, there has been no use of CERTIFIED PASSIVE HOUSE as a certification mark by any party authorized by applicant.

17. Registration of CERTIFIED PASSIVE HOUSE by applicant, with the term CERTIFIED disclaimed and a Section 2(f) claim of distinctiveness with respect to the phrase PASSIVE HOUSE for the services listed in the application opposed herein, would be damaging to those involved in research, testing, construction and certification of passive houses in North America, including opposer and its network of certified consultants, builders and raters, in that it would allow applicant to claim exclusive rights in terminology commonly used to refer to such low-energy consumption houses or the certification of same.

WHEREFORE, registration by applicant of the aforesaid mark for the aforesaid certification services would be damaging to opposer.

Opposer has submitted the requisite filing fee in the amount of \$ 600.00. Please charge any additional fees to Account No. 19-2552.

Please address all correspondence to John Bostjancich, Smart & Bostjancich, 30 West Monroe Street, Suite 800, Chicago, Illinois 60603; (312) 857-2424.

Respectfully submitted,

SMART & BOSTJANCICH

By: / John Bostjancich /
Patricia S. Smart
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(312) 857-2424

Attorneys for Opposer

CERTIFICATE OF SERVICE

I, John Bostjancich, an attorney for opposer, hereby certify that on this 8th day of January, 2014, a copy of the foregoing Notice Of Opposition is being served upon Jason L. White, Esq., Michael D. Adams, Esq., Mayer Brown LLP, PO Box 2828, Chicago, IL 60690-2828, by first class mail, postage prepaid.

By: / John Bostjancich /