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January 26, 2012

BY EMAIL & FIRST-CLASS MAIL

David L. Bea, Esq.
David L. Bea & Associates
30 W. Monroe St.
Suite 800
Chicago, IL 60603

Re: Your 18 January 2012 Letter to NY Passive House

Dear Mr. Bea:

My office serves as trademark counsel for New York Passive House (“NYPH”) and been asked to review and comment on the above-referenced letter.

As you no doubt know, the records of the United States Patent & Trademark Office (USPTO) indicate that there are no federally registered trademarks on file for “CPHC”, “CPHD”, or “Certified Passive House Consultant”. It appears that on January 12, 2012, two weeks ago, PHIUS applied to register CPHC, and is now in the beginning stages of the application process subject to a lengthy review and determination by the USPTO whether the mark does qualify, which it may not. As for CPHD and Certified Passive House Consultant, apparently no registrations have yet been attempted in the United States.

As you no doubt also know, the German Patent & Trademark Office database indicates that Passivhaus Institut Darmstadt, originator of the planning and design of passive housing construction, has trademarked “Passive House Institute”, “Certified Passive House Designer”, and six other related marks in Germany. CPHC, CPHD, and Certified Passive House Consultant have not been trademarked in Germany at all. It appears however that organizations certified by Passivhaus Institut Darmstadt have been delivering passive house services similar to PHIUS’s in the United States making use of similar acronyms and names for an extended period on a continuous basis.

In light of the above information, and what appears to be conceded in your letter, therefore, PHIUS has no federal trademark rights in any of the above marks; nor is it relying on any of the German trademarks registered by Passivhaus Institut for any of the claims stated in your letter.

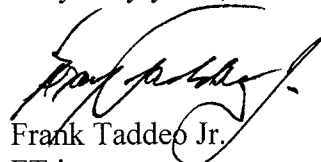
As for your assertion of common law rights: first, PHIUS needs to establish that any such rights are exclusive to it, which contention may very well be challenged by those other organizations certified by Passivhaus Institut in the United States. Second, inasmuch as PHIUS conducts business operations in Illinois, under normal common law rules of trademark, it would be limited to protection of such rights only in the State of Illinois, not in New York or elsewhere. And thirdly, and most importantly, PHIUS would need to show that NYPH engages in the same or similar business, and that NYPH is causing confusion in the marketplace detrimental to PHIUS.

From what I understand, NYPH is an association of professionals that promotes and distributes information on the passive house concept primarily in the New York, New Jersey, and Connecticut area. Unlike PHIUS and those companies certified by Passivhaus in the U.S., NYPH provides no training or other services or certifications. Even if PHIUS were successful in establishing common law rights applicable to the New York metropolitan area, PHIUS would be unable to show that NYPH engages in competition with PHIUS, much less "unfair" competition. NYPH solicits for no other passive house business, nor is it an agent or partner with of any such business. In fact, it serves as a center for information about passive house training by PHIUS and other companies in the field, nothing more.

Finally, I am advised that NYPH has had no access to, nor made use of, PHIUS email lists at any time. If your office has any such evidence to the contrary, please forward it to my attention for immediate action. If in the future any such lists should come NYPH's way, my client will promptly notify PHIUS and proceed to destroy them.

If you have any questions or comments, please feel free to contact my office. Otherwise the demands in your letter are respectfully rejected. Please be advised that should PHIUS seek to litigate this matter notwithstanding this rejection and reasons for it, any such litigation will be defended vigorously with an application for Rule 11 sanctions for frivolous conduct.

Very truly yours,



Frank Taddeo Jr.

FT:jt