

Office Action Response

HAUS

Ser. No. 88/789,894

132149.0021

In the Office Action issued May 3, 2020, the Examining Attorney refused registration of Applicant's mark HAUS ("Applicant's Mark") in class 36 under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1), based on an allegation that the mark is merely descriptive for the services in that class. The Examiner also issued a translation requirement. Applicant responds to each of the requirements below

TRANSLATION

Applicant submits the following translation statement: **The English translation of "HAUS" in the mark is "house."**

ARGUMENTS TRAVERSING SECTION 2(E)(1) REFUSAL

Examiner asserts that HAUS is merely descriptive of Applicant's educational materials (print, downloadable, and online) on the basis that "haus" translates to "house" in English and that the term "house" conveys information about a feature of Applicant's services.

The refusal fails to take into account the distinctiveness provided by the alternative spelling used in the mark. The mark HAUS does not simply and only convey the translation "house," as if the word were merely "house" in English. Applicant has not applied to register the word "house" in English, Applicant has applied for a different spelling that provides sufficient distinctiveness for consumers to identify and latch onto the concept of a single, particular source of services. Regardless of the translation of "haus" from German, consumers will not see the mark as a German equivalent and assume this is a German brand offering the services—there is no German connection in this case, and no reason for consumers to infer a German association of any kind with the mark or the services. Rather, consumers will see the distinctive spelling of HAUS as a modern and intentional spelling variation which effectively differentiates the term from the plain English word "house."

A term is only merely descriptive if it immediately conveys knowledge of a significant quality, characteristic, function, feature or purpose of the services it recites. *See, e.g., In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). Determining the descriptiveness of a mark is done in relation to an applicant's recited services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re Chamber of Commerce of the U.S.*, 102 USPQ2d at 1219, citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). Here, the spelling HAUS does more than immediately and only convey the notion of "house," and by extension, "housing."

First, the fact that a chain of mental steps must be taken, to follow from the spelling HAUS to “house” to “housing” in itself demonstrates that the mark is at least suggestive. “A suggestive mark requires imagination, thought and perception to reach a conclusion as to the nature of the goods, while a merely descriptive mark forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods.” *In Re Fat Boys Water Sports LLC*, 118 U.S.P.Q.2d 1511 (TTAB 2016) (precedential) (citing *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014)). If a consumer must follow a multi-stage reasoning process to determine attributes of the service, then the term is suggestive, not descriptive. 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:67 (5th ed.) (citing *In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496, 1978 WL 21243 (TTAB 1978) (TENNIS IN THE ROUND held not descriptive of a special kind of tennis facility)). Here, consumers must pronounce the sound of the mark or understand a translation of the mark, then take a further mental step to apply the term house in relation to the services, in order to understand the suggestion of “housing.” The multi-stage reasoning process demonstrates that the mark is not merely descriptive, but is instead suggestive.

Further, considering the mark overall in the context of the services, consumers will not readily translate the mark and make a German language connection. The doctrine of foreign equivalents is generally limited to “situations in which an American consumer is likely to ‘stop and translate’ the foreign words into their English equivalent.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1696 (Fed. Cir. 2005). Here, there is nothing about the services or the context that implies any German language or German cultural connection, which would encourage translation. Applicant is not a German company, its services are not Germany-connected or directed to housing that has anything to do with German style, culture, or history, nor are the services aimed at German-speaking consumers. This makes for an entirely different context than, for example, a tortilla chip brand using a Spanish term for a mark, which would be likely to be translated in the context of such goods.

In contrast, here, HAUS is used for financial services which have no connection to any concept of German culture or language. Thus, the mark is likely to be seen as an intentional misspelling of “house” which was chosen to impart a modern and distinctive style in keeping with the current trend of single-word marks that are misspelled for distinctive effect, e.g., LYFT, TUMBLR, REDDIT, WAZE, and others. Like these other misspelled marks, consumers will perceive HAUS as an intentional spelling which allows the mark to be distinguished from others in the marketplace, and from the ordinary English term “house.”

Thus, viewed in context, the commercial impression of the term HAUS for the recited services is likely to be seen as a distinctive brand which points consumers to a single source of goods and services. *DuoProSS Meditech Corp. v. Inviro Medical Devices, Ltd.*, 695 F.3d 1247, 1252, 103 USPQ2d 1753 (Fed. Cir. 2012) (“When determining whether a mark is merely descriptive, the Board must consider the commercial impression of a mark as a whole... Because a mark must be considered as a whole, the Board may not ‘dissect’ the mark into isolated elements.”) Seeing the mark as merely the equivalent of “house” is out of sync with the commercial context here, and is an inappropriate dissection of the mark into one possible translation which is unlikely to even be applied in this context. Further, as noted above, the translated term must still undergo a process of mental reasoning to connect the services to the concept of housing.

In sum, the mark HAUS is suggestive rather than merely descriptive because a multi-stage thought process is required to connect the term as written, which is not the English term “house” to the services, and because the mark is more likely to be seen as a modern, distinctive misspelling than a German equivalent. Seeing HAUS for the recited services, consumers will understand and identify a particular source of services as distinct from other companies using “house” in their marks.

Any doubt as to the distinctiveness of a mark must be resolved in favor of the applicant. *See, e.g., In re Conductive Systems, Inc.*, 220 U.S.P.Q. 84, 86 (TTAB 1986) (doubts under § 2(e) about the merely descriptive nature of a term are resolved in favor of the applicant); *see also In re The Gracious Lady Serv., Inc.*, 175 USPQ 380, 382 (TTAB 1972) (“It is recognized that there is a large gray area in determining the descriptiveness of a mark, and where reasonable men may differ, it has been the practice to resolve such doubt in an applicant’s behalf and publish the mark for opposition purposes.”); *In re Entenmann’s Inc.*, 15 USPQ.2d 1750, 1751 n.2 (TTAB 1990) (“[I]n ex parte cases involving a refusal to register on the basis of mere descriptiveness, it is the practice of this Board to resolve doubts in the favor of the applicant and pass the mark to publication.”)

With the above responses, Applicant believes that the application is now in condition for publication, and Applicant respectfully requests forwarding of the application for the purposes of publication.