

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE TTAB**

Hearing:  
August 4, 2009

Mailed:  
February 4, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Tempur-Pedic International Inc., et al.  
v.  
Denver Mattress Co., LLC  
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Opposition No. 91169165 to application Serial No. 78405837  
filed on April 21, 2004  
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Ariana G. Voight and Erica G. Jeung of Michael Best & Friedrich LLP for Tempur-Pedic International Inc., Tempur-Pedic Management, Inc. and Dan Foam ApS.

David E. Sipiora and Ryan D. Phillips of Townsend and Townsend and Crew LLP for Denver Mattress Co., LLP.

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Before Bucher<sup>1</sup>, Cataldo and Taylor, Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Denver Mattress Co., LLC has filed an application to register on the Principal Register the mark SWEDISH LUXURY, in typed format, for "mattresses, parts and components for mattresses, namely, foundations and box springs; furniture" in International Class 20 and "retail furniture and mattress

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<sup>1</sup> Judge Bucher has been substituted for Judge Drost, now retired from Federal service, on this panel.

store services" in International Class 35.<sup>2</sup> During examination, applicant disclaimed the word "SWEDISH" upon request of the examining attorney.

Registration has been opposed by Tempur-Pedic International Inc., Tempur-Pedic Management, Inc. and Dan Foam ApS ("collectively Tempur-Pedic or opposers") on the grounds of priority and likelihood of confusion and that the applied-for mark is geographically deceptively misdescriptive of the identified goods.<sup>3</sup> As regards the ground of priority and likelihood of confusion, opposers specifically allege, in significant part, that long prior to the April 21, 2004 filing date of applicant's involved application, opposers adopted and used in commerce the

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<sup>2</sup> Serial No. 78405837, filed on April 21, 2004 with an allegation of a bona fide intention to use the recited goods in commerce.

<sup>3</sup> Opposers, in their notice of opposition, also alleged claims of dilution and that the applied-for mark is geographically deceptive. However, opposers did not pursue these claims in their briefs and, accordingly, we consider them to have been withdrawn. In addition, to the extent opposers argue that they have common law rights in the mark SWEDISH (alone), the arguments have not been considered because such ownership rights were not pleaded. That is, we do not consider opposers' allegation that "[d]ue to the fact that the products marketed under the SWEDISH SLEEP SYSTEM name were the first products of their kind to be refined in Sweden for use in commercial applications by Opposer's and their affiliates, and because they have been exclusively marketed and sold under the SWEDISH SLEEP SYSTEM and SWEDISH trademarks, the term "Swedish" has become synonymous with the SWEDISH SLEEP SYSTEM trademark and with products originating with Opposers" (Not. of op. ¶ 4) to be a claim of common law ownership of the term. We consider the allegation merely as illuminative of opposers' likelihood of confusion claim and, in particular, of their claim that the term SWEDISH dominates their pleaded mark. We add, incidentally, that opposers did not assert ownership of any other "SWEDISH trademarks" or identify any "related products" in the opposition.

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SWEDISH SLEEP SYSTEM trademark, Registration No. 2452364<sup>4</sup>, in connection with the manufacturing, marketing, sale and distribution of mattresses, cushions and pillows made of elastic viscous foam; that since at least as early as 1992, opposers have made substantially continuous use of SWEDISH SLEEP SYSTEM in the marketing and selling of mattresses, cushions, pillows and pads made of elastic viscous foam in the United States; and that opposers' have sold elastic viscous foam products throughout the United States under the SWEDISH SLEEP SYSTEM mark and trade name and opposers' have built up valuable goodwill in the SWEDISH SLEEP SYSTEM trademark. (Not. of op. ¶¶ 1-2, and 7) Opposers further allege that the SWEDISH SLEEP SYSTEM registration is valid and subsisting and constitutes notice to applicant of opposers' claim of ownership of the mark shown therein. (Not. of op. ¶ 3) Opposers also allege that they have expended tremendous time, effort, and money in advertising and promoting the products under the SWEDISH SLEEP SYSTEM mark and name and, as a result, the distinctive SWEDISH SLEEP SYSTEM mark is famous and identifies opposers as the source of high-quality mattresses, cushions, pillows and

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<sup>4</sup> Registration No. 2452364 issued May 22, 2001 on the Principal Register pursuant to Section 2(f) of the Trademark Act. Section 8 affidavit accepted; Section 15 affidavit acknowledged. We point out that the registration covers "mattresses, cushions and pillows made of elastic viscous foam" and includes a disclaimer of "SLEEP SYSTEM."

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pads and related products, and that their mark achieved fame long prior to the filing date of applicant's mark. (Not. of op. ¶¶ 5 and 9) Last, opposers allege that use<sup>5</sup> and/or registration of applicant's applied-for mark, SWEDISH LUXURY, on its goods and services will be likely to cause confusion, to cause mistake, and to deceive as to the source of applicant's goods and services and to induce purchasers to believe that the goods and services of applicant emanate from opposers, are endorsed or licensed by opposers, or are in some way connected with opposers, to the injury and damage to opposers. (Not. of op. ¶¶ 12 and 14)

As to their claim that applicant's SWEDISH LUXURY mark is primarily geographically deceptively misdescriptive, opposers particularly allege that applicant's goods do not come from Sweden or have any connection with Sweden; that the primary significance of the SWEDISH LUXURY mark is the generally known geographic location of SWEDEN; that the consuming public is likely to believe that the place identified by applicant's SWEDISH LUXURY mark, i.e., SWEDEN, indicates the origin of the goods and services bearing the mark; and that the misrepresentation of SWEDISH origin of the goods and services bearing the SWEDISH LUXURY mark is a

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<sup>5</sup> We point out that the Board's jurisdiction is limited to determining right to registration. Accordingly, the issue of applicant's right to use the SWEDISH LUXURY mark is not before us.

material factor in a consumer's decision to purchase applicant's goods and services.<sup>6</sup> (Not. of op. ¶¶ 16-19).

Applicant, in its answer, has denied the essential allegations of the notice of opposition.

**EVIDENTIARY MATTERS**

***Motion to Strike***

On December 17, 2008, the Board issued an order partially deferring opposers' motion to strike portions of applicant's notice of reliance<sup>7</sup> and objections to portions of the testimony declaration, and corresponding exhibits, of Robert Rensink ("Rensink test."). We now consider that portion of the motion to strike which was renewed in opposers' brief. Opposers have interposed several objections to portions of the Resink testimony declaration and accompanying exhibits, which we discuss in turn. First, opposers have objected to Paragraphs 12-14 and exhibit C, consisting of statements and documents related to applicant's use of the term SWEDISH POCKET COILS, and paragraphs 15-16 and 18-23 and exhibits D, G, H and I consisting of statements and documents related to

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<sup>6</sup> Opposers did not maintain the claim that the SWEDISH LUXURY mark is primarily geographically deceptively misdescriptive of the identified services in their brief. We accordingly consider it withdrawn as to the services.

<sup>7</sup> We note that opposers' motion to strike insofar as it pertained to applicant's notice of reliance was granted as to Exhibit B, denied as to Exhibit G, and found moot as to Exhibits I, J, and N inasmuch as they were withdrawn from consideration by applicant.

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applicant's use of the term SWEDISH INDIVIDUALLY WRAPPED COILS, arguing that such evidence is irrelevant because those terms are not at issue in this proceeding. Opposers particularly object to the references in paragraphs 12 and 15, and corresponding exhibit F, arguing that geographically descriptive uses of the terms SWEDISH POCKET COILS and SWEDISH INDIVIDUALLY WRAPPED COILS are not relevant to this proceeding. In response to the objection, applicant argues that its use of SWEDISH POCKET COILS and SWEDISH INDIVIDUALLY WRAPPED COILS for mattresses are examples of similar marks used on similar goods and, thus, highly relevant to this proceeding. Because applicant's uses of those terms are examples of third-party use of similar marks on similar goods, the objection is overruled. However, we have considered the testimony and exhibits only insofar as they pertain to such third-party use.

Opposers also object on the ground of relevancy to paragraph 17 of the declaration to the extent that it consists of various statements that pertain to the geographic origin of any products sold under the SWEDISH INDIVIDUALLY WRAPPED COILS mark, as well as to corresponding exhibit J. Inasmuch as the geographic origin of products sold under that mark is not at issue herein, the objection is sustained and such statements and evidence have not been considered.

Opposers further object to portions of Paragraph 17 insofar as it consists of statements regarding possible settlement discussions. Fed. R. Evid. 408 expressly states that statements made in settlement negotiations are inadmissible. Accordingly, the objection is sustained and such statements have not been considered in this decision.

Opposers have interposed objections to various claims in paragraphs 26-28 insofar as they relate to the validity of its pleaded registration, and corresponding Exhibits K, L, and M. These statements consist of assertions that opposers use the pleaded mark in a descriptive manner. An attack on the validity of a pleaded registration will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.<sup>8</sup> See Trademark Rule 2.114(b)(2)(ii). Insofar as the statements question the validity of opposers' pleaded mark, they are inappropriate. Opposers' objection is accordingly sustained and such statements and corresponding evidence have not been considered.

As to the remaining objections, i.e., to paragraphs 24 through 25, as well as exhibit J, consisting of statements

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<sup>8</sup> Considering opposers' pleaded registration is over five years old, a challenge to the registration on the ground that the mark is descriptive would not even be available to applicant. See Section 14(3) of the Trademark Act.

We also point out that because an attack on opposers' pleaded registration is not appropriate in this case, we have not considered any such arguments made by applicant in its brief.

and documents regarding third-party use of marks including the term "Swedish," and paragraphs 26 through 29 consisting of statements which opposers characterize as further alleged use of the term "Swedish" by third parties, based on hearsay, lack of support and opinion testimony of a lay witness, we find it unnecessary, except as otherwise noted, to address them specifically. The objections relate principally to the probative value to be accorded the statements and evidence in question, and we have accorded the relevant testimony the appropriate probative weight.

***Evidentiary Objections***

Opposers also raised evidentiary objections for the first time in its brief as to the scope of applicant's cross-examination of opposers' witness, Daniel Setlak, arguing that applicant's two cross-examinations not only covered subjects not included in his testimony declaration, but also went further to question Mr. Setlak as to facts irrelevant to the issues in this proceeding. These facts, opposers assert, include the current geographic connection between each piece of opposers' mattresses, foundations, and textile coverings, where on opposers' goods the SWEDISH SLEEP SYSTEM mark is used, as well as another of applicant's marks not at issue in this proceeding. Applicant, on the other hand, contends the cross-examination testimony is

relevant and within the scope of the direct testimony of Mr. Setlak.

First, with regard to the questions concerning the geographic connection between opposers' goods and Sweden, we note that Mr. Setlak's declaration includes a reference, albeit brief, to Sweden as the place of development of the foam from which opposers goods are made, and several of the exhibits to the Setlak declaration discuss, in detail, the Swedish origins of opposers' products. As such, we do not find applicant's questions regarding the geographic connection between opposers' goods and Sweden outside the scope of the Setlak declaration. We point out, however, that while those questions are not outside of the scope of the declaration, they are not particularly probative of the issue at bar, namely, the registrability of applicant's applied-for mark, SWEDISH LUXURY. As regards the questions concerning the placement of opposer's pleaded SWEDISH SLEEP SYSTEM mark on opposers' goods, we agree with applicant that how consumers encounter the SWEDISH SLEEP SYSTEM mark on or in connection with opposers' products may have a bearing on the strength of the mark. Accordingly, we do not find that line of questioning irrelevant.

Opposers' objections as to the scope and relevancy of portions of the Setlak cross-examination testimony are therefore overruled. We add, however, that none of the

testimony that opposers sought to exclude is outcome determinative and, in addition, it has been accorded whatever probative value it merits.

Applicant has raised a single evidentiary objection to Exhibit Q of the Rensink cross-examination deposition, identified therein as a "two-page [hand-written] document on Mission Palms letterhead" and made of record by opposers during cross-examination. Applicant contends that Exhibit Q is not self-authenticating and was not part of any notice of reliance served by opposers. Applicant argues that during cross-examination, Mr. Rensink stated that he had no knowledge of Exhibit Q, nor the fact surrounding the document. Applicant therefore maintains that Exhibit Q is not properly of record and should be stricken from the record.

In response, opposers essentially argue that Mr. Rensink had sufficient general knowledge of an event where Exhibit Q was purportedly drafted and, accordingly, the document is properly of record.<sup>9</sup>

Materials that do not fall within 37 C.F.R. § 2.122(e), that is, materials that are not self-authenticating in nature and thus not admissible by notice of reliance, may be introduced into evidence through the testimony of a person

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<sup>9</sup> We note that the specifics of opposers' response are confidential.

who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials. See TBMP § 704.08 (2d ed. rev. 2004).

Although the transcript of the cross-examination testimony of Mr. Rensink is designated in its entirety as "highly confidential," our review of the transcript reveals that Mr. Rensink did not, and could not, "clearly or properly" authenticate the document. As such, Exhibit Q was not properly introduced into evidence. Accordingly, applicant's objection is sustained and Exhibit Q to the Rensink cross-examination will not be further considered.

#### THE RECORD

In light of the foregoing, the record consists of the pleadings and the file of application Serial No. 78405837. In addition, during their assigned testimony period, opposers submitted the testimony declaration<sup>10</sup> of Daniel Setlak, Vice President of Marketing and Direct Sales for Tempur-Pedic North America, Inc., with exhibits A-T<sup>11</sup>; first cross-examination testimony deposition of Daniel Setlak (taken April 3, 2008); second cross-examination testimony

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<sup>10</sup> We note in this regard that on February 29, 2008, the parties submitted a written stipulation allowing them to submit direct testimony in affidavit or declaration form.

<sup>11</sup> In the redacted Testimony Declaration of Daniel Setlak, opposers include references to Exhibits A through T, while in the non-redacted version, Exhibit H was omitted such that Exhibits I through S do not match those in the redacted version. To prevent confusion, we will refer in this decision to the lettering of the exhibits from the redacted version of the Setlak declaration.

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deposition of Daniel Setlak (taken June 5, 2008) with Exhibits B, L, M, N and Q; opposers' first notice of reliance on (a) a status and title copy of its pleaded Registration No. 2452364 (Exhibit 1); (b) newspaper and magazine articles purportedly to show unsolicited media attention given to opposers' products sold under the SWEDISH SLEEP SYSTEM mark (Exhibits 2-13<sup>12</sup>); and (c) applicant's responses to certain of its discovery requests (Exhibits 14-17); and opposers' second notice of reliance on newspaper and magazine articles to (1) rebut applicant's testimony that foam is regularly called "Swedish memory foam," because they purportedly show numerous third parties, including those in the bedding industry, writing about generic types of foam without using the term "Swedish," and only use the term "Swedish" in connection with opposers' goods (Exhibits 1-25); (2) rebut applicant's testimony because they purportedly show that third parties, including those in the bedding industry, do not refer to foam used in bedding as "Swedish memory foam" (Exhibits 26-28); and (3) rebut applicant's testimony that the public does not associate Sweden with bedding products and memory foam, because they purportedly show that there is, in fact, an association between bedding products and Sweden (Exhibits 20-39).

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<sup>12</sup> Opposers notice of reliance references Exhibits 1-16. However, the reference is obviously a typographical error inasmuch as Exhibits 14-16 consists of applicant's discovery responses.

During its assigned testimony period, applicant submitted the testimony declaration (which is of record except as indicated above) of Robert Rensink, its Vice President and General Manager of Manufacturing, with Exhibits A-H and J; the cross-examination testimony deposition of Robert Rensink with exhibits A, B, E, G, H, I, N, O and P; and a notice of reliance on (1) a copy of its involved application Serial No. 78405837 taken from the TARR data base of the United States Patent and Trademark Office as well as documents from the file history of that application<sup>13</sup> (Exhibits A and C); documents from the file history of pleaded Registration No. 2452364 (Exhibit D); opposers' responses to certain of its discovery requests (Exhibits E-H); and Temper-Pedic advertisements purportedly relevant to "many" issues in this proceeding, including, but not limited to, the descriptive use of Opposers' mark (Exhibits K-M).<sup>14</sup>

#### **THE PARTIES**

##### ***Opposers***

Opposers develop, manufacture, market, and sell a variety of visco-elastic foam mattresses, pillows, pads and

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<sup>13</sup> As indicated above, the record includes the file of involved application Serial No. 78405837. Accordingly, its submission was unnecessary.

<sup>14</sup> We reiterate that in the absence of a counterclaim, an attack on the validity of a pleaded registration will not be heard. Accordingly, the articles are of record for whatever other appropriate probative value they may have.

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cushions. (Setlak dec. ¶ 2) In 1992, opposers first began offering visco-elastic mattresses and pillows under the SWEDISH SLEEP SYSTEM mark. (Setlak dec. ¶ 3-4, exh. A) Opposers chose the SWEDISH SLEEP SYSTEM mark because its goods are made from proprietary foam developed in Sweden. (Setlak dec. ¶ 3) Opposers have expanded their offerings under the SWEDISH SLEEP SYSTEM mark, which at the time of the filing of the Setlak declaration, included nine different mattress models and eight pillows which sell at price points ranging from \$699 to over \$5000 for mattresses and \$40 to \$100 for pillows. (Setlak dec. ¶¶ 2) Since first offerings of SWEDISH SLEEP SYSTEM branded goods in 1992 through chiropractic offices, opposers have expanded their trade channels. Opposers currently offer goods under the SWEDISH SLEEP SYSTEM trademark in approximately 6,350 retail locations across the United States, on their website at [www.tempurpedic.com](http://www.tempurpedic.com), at trade shows and through chiropractors, medical retailers, hospitals, and other medical equipment manufacturers. (Setlak dec. §§ 5-7, and 19). Opposers have spent substantial sums<sup>15</sup> to promote their SWEDISH SLEEP SYSTEM mark. (Setlak dec § 5) Opposers feature the SWEDISH SLEEP SYSTEM mark in media advertising, which includes, television, print, and radio advertisements,

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<sup>15</sup> The exact advertising expenditures were designated as confidential in the declaration, but appear in the redacted version of opposers' brief.

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point-of-sale displays, and sales incentives, among other methods. (Setlak dec. §§ 15-16) Opposers publish and distribute newsletters and holiday catalogs to its consumers, in which they highlight the SWEDISH SLEEP SYSTEM goods and awards received for such products. (Setlak dec. § 16, exh. L-P) Current advertisements bears symbols indicating awards and recognition from, e.g., NASA, Consumer's Digest and the Arthritis Foundation. (*Id.*, exh. L) Opposers benefit from publicity and recognition received from unsolicited media coverage including from print publications such as The New York Times, The New York Sun Times, The Orange County Register, Telegraph Herald, Daytona Beach New Journal, Tampa Tribune, The Chicago Tribune, The Philadelphia Inquirer, and the Sarasota Herald-Tribune. (Opposer's first not. of rel., exhs. 2-13) Since 2003, opposers have sold over 1.8 million mattresses under the SWEDISH SLEEP SYSTEM trademark domestically for total domestic net sales of just over \$2.1 billion. (Setlak dec. §§ 13-14) Opposers demand proper use of its SWEDISH SLEEP SYSTEM mark from its retail partners and provide all with strict guidelines regarding use of its trademarks, including the SWEDISH SLEEP SYSTEM mark. (Setlak dec. § 20, exh. Q) In addition, opposers enforce their rights in the SWEDISH SLEEP SYSTEM mark. (Setlak dec. §§ 21-22, exhs. S-T).

**Applicant**

Applicant is in the mattress and bedding industry, with approximately 90 stores located in Alabama, Arkansas, Arizona, Colorado, Idaho, Illinois, Indiana, Iowa, Kansas, Kentucky, Michigan, Missouri, Montana, Nebraska, New Mexico, North Carolina, Ohio, Oklahoma, Oregon, Pennsylvania, South Dakota, Tennessee, Texas, Utah, Washington, Wisconsin, and Wyoming. (Rensink dec. ¶ 2) Applicant sells and targets sales to all members of the sleeping public. (Rensink dec. ¶¶ 2-3) Applicant markets and sells its products, which include several types of mattresses, pillows, and mattress pads, via its retail stores and the Internet. (Rensink dec. ¶ 3) Applicant chose the name SWEDISH LUXURY because of its view that "SWEDISH" denotes high quality and reliability in the marketplace. (*Id.*)

**DISCUSSION**

***Opposers' Standing and Priority of Use***

Because opposers have properly made pleaded Registration No. 2452364 of record, we find that opposers have established their standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Moreover, because opposers' Registration No. 2452364 is of record, Section 2(d) priority

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is not an issue in this case as to the mark therein and goods covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). We further note that applicant does not contest that opposers have made prior use of the mark in the pleaded registration.

***Likelihood of Confusion***

Turning now to our discussion of the issue of likelihood confusion, our determination thereof is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

***Fame***

We begin our likelihood of confusion analysis with the *du Pont* factor which requires us to consider evidence of the fame of opposers' mark and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir.

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2000); and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456, and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

*Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305.

In determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309; *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the products, etc.). *Bose Corp. v. Audio Products, Inc.*, 63 USPQ2d at 1309.

The evidence supporting the fame of opposers' SWEDISH SLEEP SYSTEM mark includes its use in connection with mattresses, pillows and other bedding-related products for over fifteen years, the over \$2.1 billion in domestic net sales of bedding products since 2003 under the SWEDISH SLEEP SYSTEM mark, a vigorous enforcement policy, diversity in

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advertising modes and significant advertising expenditures since 1992, as well as general renown as evidenced by newspaper and magazine articles and testimony regarding industry awards. We note, however, that nearly every reference to the SWEDISH SLEEP SYSTEM product in the sampling advertising provided by opposers also includes the TEMPUR-PEDIC mark - although not necessarily in tandem with the SWEDISH SLEEP SYSTEM mark.<sup>16</sup> In addition, virtually all of the newspaper and magazine articles reference the TEMPUR-PEDIC mark. Thus, the extent of the public recognition and renown of the SWEDISH SLEEP SYSTEM mark separate and apart from the TEMPUR-PEDIC mark is not clear. *Cf.* Bose Corp. v. QSC Audio Products Inc., 63 USPQ2d at 1308 ("we think those who claim fame for product marks that are used in tandem with a famous house mark can properly be put to the tests to assure their entitlement to the benefits of fame for product marks").

"In view of the extreme deference that is accorded to a famous mark in term of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, we think that it is the duty of a plaintiff asserting that its mark is famous to clearly prove it." Blue Man Productions Inc. v. Tarmann, *supra* at 1819. While opposers have demonstrated that their

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<sup>16</sup> Setlak dec. §§ 16, exhs. L, M and N.

mark has achieved at least a high degree of recognition, the evidence is not sufficient to support a finding that the mark is famous and thus entitled to the extensive breadth of protection accorded a truly famous mark.

Nonetheless, based on the record, we find opposers' SWEDISH SLEEP SYSTEM mark distinctive and strong and entitled to a broad scope of protection. In coming to this determination, we have considered all of the evidence relevant thereto, including applicant's evidence, more fully discussed *infra*, of third-party uses of various "SWEDISH" formative marks.

***Similarity of the Goods and Services/Trade Channels/Purchasers***

We next consider the *du Pont* factors which pertain to the similarity or dissimilarity of the goods and services, channels of trade and classes of purchasers. It is well settled that likelihood of confusion is determined on the basis of the goods and services as identified in the application and in the pleaded registration. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Where the goods and services in the application and/or pleaded registration are broadly identified as to their nature and type, such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, it is presumed that in scope the identification of the goods and

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services encompasses not only all the goods and services of the nature and type described therein, but that the identified goods and services are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof. In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

As for the goods, applicant's goods are identified as "mattresses, parts and components for mattresses, namely foundations and box springs; furniture" and opposers' goods are identified as "mattresses, cushions and pillows made of elastic viscous foam." We find the parties' goods are legally identical, in part, as to mattresses, inasmuch as applicant's mattresses are so broadly identified as to encompass those made of elastic viscous foam. Likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application, even if the common goods constitute only a small percentage of the goods intended for sale. See Tuxedo Monopoly, Inc. v. General Mills Fun Group, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). We further find that the remaining goods, save the "furniture" identified in applicant's application, are closely related and complementary bedding products and that applicant's "furniture" is complementary to opposers' identified bedding products to the extent that applicant's

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furniture, as identified without limitation, must be presumed to include bedroom furniture; all being goods that would be purchased by the same customer seeking to outfit a bedroom.

In addition, we find applicant's services and opposers' goods closely related and/or complementary: the items sold through applicant's identified "retail furniture and mattress store services" are presumed to include opposers' more narrowly identified mattresses made of elastic viscous foam. The record further supports a finding that, at one time, the mattresses sold at applicant's mattress stores included opposers' mattresses of elastic viscous foam.<sup>17</sup> Also, applicant's application includes mattresses, thus reinforcing the relatedness of the goods and services, and that consumers are accustomed to seeing a single mark used for both the identified goods and services. We also point out that goods and the services involving the sales of such goods have frequently been held to be commercially related. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988) (finding furniture refinishing services and office furniture related); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003) (finding applicant's clothing items related to opposer's retail and mail order services in the field of clothing); and *Steelcase Inc. v.*

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<sup>17</sup> Rensink dec. ¶ 29.

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Steelcare Inc., 219 USPQ 433 (TTAB 1983) (finding applicant's furniture refinishing services related to opposer's office furniture); J. Thomas McCarthy, Trademarks and Unfair Competition §24:25 (2009) ("[w]here the services consists of retail sales services, likelihood of confusion is found when another mark is used on goods which are commonly sought through a retail outlet.").

Here, the identical and related and/or complementary nature of applicant's goods and services and opposers' goods is sufficient to demonstrate the relatedness of the goods and services. Indeed, applicant does not argue otherwise.

Applicant nonetheless contends that applicant and opposers use different channels of trade to distribute their goods and services and that their respective goods will not appear side-by-side to the consumer. Applicant particularly contends that it is the only source of its products, selling its SWEDISH LUXURY mattresses at its own retail stores and via its website, [www.denvermattress.com](http://www.denvermattress.com), while opposers sell their products through various retailers nationwide, through their website, and through one company-owned store.

This argument is unavailing. As noted above, because applicant's identification of goods and services contains no limitations or restrictions as to types of purchasers or channels of trade, we must presume that the legally identical goods will be offered in the same channels of

trade and will be purchased by the same classes of purchasers, while the related and/or complementary goods will be sold or offered in the channels of trade that would be normal for such goods, including third-party retail stores featuring mattresses, and to all normal purchasers, including ordinary consumers seeking bedding. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981). In addition, and as discussed above, we must also presume that opposers' bedding products could be sold in applicant's stores. Therefore, at a minimum, we presume that applicant's and opposers' channels of trade and purchasers overlap.

Accordingly, the *du Pont* factors of relatedness of the goods and services, channels of trade and classes of purchasers favor opposer.

***Conditions of Sale***

With respect to the conditions under which the parties' goods would be purchased, applicant contends the mattresses sold by both it and opposers are expensive<sup>18</sup> and that purchases of that magnitude are not the subject of "impulse" buying. In the absence of such limitations to the identification of goods and services in applicant's application and the identification of goods in the pleaded registration, we must presume that applicant's and opposers'

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<sup>18</sup> We note that the price ranges for both applicant's and opposers' mattresses are marked as confidential.

mattresses are available in a range of prices, including lesser expensive models that would be attractive to budget conscious ordinary consumers looking to purchase bedding. Nonetheless, we recognize that a mattress is not the type of article frequently purchased by a given individual, and thus purchasers of applicant's mattresses and opposers' bedding products may exercise a heightened degree of care or thought in choosing such goods. On yet the other hand, even careful purchasers of goods can be confused as to source under circumstances where substantially similar marks are used on identical and substantially related goods and on closely related and/or complementary goods and services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible.").

Thus, this *du Pont* factor, at best, slightly favors opposer.

***The Marks***

We now turn to a consideration of the marks, keeping in mind that when marks would appear on even some identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines.

*Century 21 Real Estate Corp. v. Century Life of America*, 970

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F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). That is, the purchaser's fallibility of memory over a period of time must be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurant Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991); *aff'd unpub'd* (Fed. Cir., June 5, 1992).

With these principles in mind, we consider the marks. Applicant's mark is SWEDISH LUXURY while opposers' mark is SWEDISH SLEEP SYSTEM. The marks are similar inasmuch as they both begin with the same word SWEDISH, which is a

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factor that supports a conclusion that confusion is likely here. *Palm Bay Imports*, 73 USPQ2d at 1692 ("To be sure, CLICQUOT is an important term in the mark, but VEUVE nevertheless remains a 'prominent feature' as the first word in the mark and the first word to appear on the label. Not only is VEUVE prominent in the commercial impression created by VCP's marks, it also constitutes 'the dominant feature' in the commercial impression created by Palm Bay's mark"). See also *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1985, 1987 (TTAB 1988) ("there are also similarities between them in that both start with the term 'KID' a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

The other words in opposers' mark are the words "sleep system," which opposers have disclaimed. "Regarding descriptive terms, this court has noted that 'the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846, quoting, *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). The Federal Circuit has noted that a disclaimed term ... may be given little weight, but it may not be ignored." *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006). In

this case, we find that "sleep system" is particularly entitled to little weight inasmuch as both parties' goods are products used for sleep, and applicant's retail services feature such products. Thus, the words "sleep system" are not source signifying and therefor not a dominant element; it is the word SWEDISH that is the dominant portion of opposers' mark.

The additional word in applicant's mark, "luxury," defined, in part, as: "1. great comfort: expensive high-quality surroundings, and the great comfort they provide,"<sup>19</sup> while different from any other term in applicant's mark, is not so distinctive in relation to applicant's goods that its presence in applicant's mark results in dissimilar marks. The term is laudatory and suggestive in relation to the goods and services identified in applicant's application and, accordingly, would not be viewed as inherently strong. We find this so even though applicant also has included a disclaimer of the word SWEDISH. Such a disclaimer does not remove the word or, contrary to applicant's position, reduce its significance in applicant's mark, especially given its prominence as the first word in applicant's mark coupled

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<sup>19</sup> Encarta<sup>®</sup> World Dictionary [North American Edition] (2009) retrieved at <http://encarta.msn.com>. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Foot Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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with the laudatory nature of the only other word in applicant's mark. We thus find that applicant's mark and opposers' mark are substantially similar in appearance, sound, connotation and commercial impression due to the shared term "SWEDISH." Moreover, customers familiar with opposers' SWEDISH SLEEP SYSTEM mark for elastic viscous foam mattresses, cushions and pillows are likely to assume that applicant's SWEDISH LUXURY mark for the same or closely related and/or complementary goods and services is a variant thereof, identifying a new product line or the store where such new products may be purchased.

Applicant maintains that the connotation and commercial impression of the two marks differ drastically. According to applicant, opposers' mark, SWEDISH SLEEP SYSTEM, invokes an image of a collection of products to form a system related to sleep while its mark suggests comfort and/or high quality. We find this unsupported argument unpersuasive. Applicant has adopted as the connotation of "Swedish" in its mark "high quality and reliability in the marketplace."

(Br. p. 12). Given the identity and close relatedness of the identified goods and services, the word "Swedish" in opposers' mark is just as likely to be perceived as "high quality," resulting in marks with similar connotations.

Applicant also has made of record evidence in the form of web pages from eleven different third-party websites

where the term "Swedish" is used in connection with a variety of goods. The examples (emphasis supplied) include:

**>>Swedish Steel Springs**

At the heart of the DUX 12:12 [mattress] are Swedish steel springs - nearly 3 times as many as an ordinary bed.  
(Duxiana - [www.duxiana.com](http://www.duxiana.com))

The **Swedish Neck Pillow** is very comfortable for both back and side sleepers.

...

**Swedish Medical Products** offers a **Deluxe Memory Foam Pillow** in the contour size only.

(Swedish Medical Products - <http://www.swedishpillows.com>)

**Swedish Memory Foam**

**Therapeutic Pillow w/ Swedish Memory Foam**

(Hudson Consumer Products - [www.hudsonconsumerproducts.com](http://www.hudsonconsumerproducts.com))

...Sissel has a variety of products that may alleviate [back] and prevent [ ] neck and back discomfort, such as the Swedish Neck Pillows and Temp-Control Pillows.

(Sissel-Online.com - [http://www.sissel-online.com/product/neck\\_pillows.php](http://www.sissel-online.com/product/neck_pillows.php))

Swedish Folding Cot and Deluxe Swedish Folding Cot  
(LL Bean - [www.llbean.com](http://www.llbean.com))

**Swedish Day Bed**

Gustavian day bed, Sweden ca. 1790, in excellent condition.

(Cupboards & Roses Antiques - [www.cupboardsandroses.com](http://www.cupboardsandroses.com))

The Aurora mattress is one of our best mattresses, designed to mimic the high-end Swedish mattresses,

...

(Dax Stores - [www.daxstores.com](http://www.daxstores.com))

High-Quality Swedish Woodwork

Coffee Tables•Custom Furniture•Bed Frames

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(Swedish Woodwork & Design, LLC -  
www.swedishwoodworkanddesign.com)<sup>20</sup>

Applicant's witness, Robert Rensink, states in his declaration that he contacted the first six companies listed below and based on the telephone conversations, it was apparent that all of the described goods were available for consumer purchase.

Applicant has also made of record evidence of its use, which it claims was without objection by opposers, of three additional marks which include the term "Swedish." They are SWEDISH MEMORY FOAM, SWEDISH POCKET COILS and SWEDISH INDIVIDUALLY WRAPPED COILS.<sup>21</sup>

Last, applicant points to numerous cease-and-desist letters, placed into evidence by opposers, written to various companies seeking to stop the third-parties from using the term "Swedish" in the sale of their goods. Applicant contends that letters show "rampant" third-party use of the term "Swedish" in the bedding industry, and

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<sup>20</sup> The last three examples from [www.swedishheirlooms.com](http://www.swedishheirlooms.com) (featuring "Swedish antique furniture, chandeliers, mirrors, silver and porcelain"); [wwwswedishbabyquilts.com](http://wwwswedishbabyquilts.com) (featuring "Swedish baby quilts"); and [www.gustavian.com](http://www.gustavian.com) (featuring "Swedish sofas) show use of the term in connection with goods that are not as closely related as the goods and services at issue here. As such, they are of little probative value.

<sup>21</sup> The parties apparently have treated applicant's "third-party" marks as confidential due the evidentiary dispute resolved earlier in this decision. In light of that decision allowing argument and evidence of these marks in connection with applicant's assertion of third-party use on similar marks, we find that they are improperly treated as confidential. We have therefore referenced them in this decision.

apparently because opposers, except in twenty-one instances, did not provide evidence of compliance, that opposers have not been successful in curbing this third-party use.

Applicant thus argues that the "*duPont* factor, third-party use, weighs heavily for a finding of no likelihood of confusion given that the only similarity between the marks, the word 'Swedish,' is widely used in the marketplace on similar goods." (Br. p. 23)

Apart from the previously resolved evidentiary objections, opposers argue that the Internet evidence is entitled to very little weight because it does not show actual third-party use of "Swedish" as a trademark in connection with mattresses or bedding products. Opposers further argue with respect to the testimony of applicant's witness that he did not personally visit any of the alleged third parties' places of business.

Concerning applicant's use of other "Swedish" marks, opposers contend that applicant's minor uses of these marks were not sufficient to attract opposers' attention, and given the limited exposure and duration of applicant's "alleged" use of "Swedish" as a trademark, little weight should be given to applicant's assertion that its prior uses of the term should limit opposers' rights in any way. Opposers also point out that applicant's witness testified

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that applicant is no longer using the SWEDISH MEMORY FOAM mark.

Last, with respect to opposers' enforcement efforts, opposers maintain that their enforcement actions, via cease and desist letters against third-party users of "Swedish" in marks that were confusingly similar to their SWEDISH SLEEP SYSTEM mark, were successful and that there is no evidence in the record that such third-party uses continued.

First, as regards applicant's "third-party" marks, applicant, itself, acknowledges that it no longer uses the SWEDISH MEMORY FOAM mark and, accordingly, it has no probative value. In addition, although we cannot disclose specific sales and advertising figures for the bedding products sold and marketed under the SWEDISH POCKET COILS and SWEDISH INDIVIDUALLY WRAPPED COILS marks, we do not find them sufficient to evidence widespread use of these marks such that the consuming public is familiar with them. Nor is there any other evidence of record regarding the extent of public exposure to these marks.

Next, the fact that opposers have vigorously pursued third-party uses of "Swedish" formative marks does not evidence "rampant" third-party use, especially since, as opposers notes, there is no evidence of current use of these marks.

Last, although the Internet evidence, introduced through the testimony of Mr. Rensink, is evidence of third-party use of the term "Swedish," the probative value of that evidence is limited because applicant has presented no evidence concerning the extent to which these third-party designations are used in commerce or the public's familiarity with them. See *Sports Authority Michigan, Inc. v. PC Authority Inc*, 63 USPQ2d 1782 (TTAB 2001). For example, it is not known how frequently the websites are viewed or how broad the consumer base is for these bedding products. While the Board has, in likelihood of confusion cases, given weight to evidence of widespread and significant use by third parties of marks containing elements in common with the involved marks to demonstrate that confusion is not likely to occur,<sup>22</sup> the record simply does not establish that "Swedish" has been diluted in the field of bedding products. See *Broadway Chicken Inc.*, 38 USPQ2d 1559 (TTAB 1996) (Broadway weak for restaurant services based on evidence that hundreds of restaurants and eating establishments use that word.)

We thus find that applicant's evidence does not establish that there is widespread use of similar marks for bedding products such that opposers' mark is weak, or

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<sup>22</sup> See e.g., *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1462 (TTAB 1987).

otherwise justify the registration of another confusingly similar mark.

As noted previously, the dominant, albeit disclaimed, portion of applicant's mark is identical to the dominant portion of opposers' mark. While we have not overlooked the additional matter in each mark, we nonetheless conclude that the marks, when considered in their entireties, are substantially similar due to their shared term SWEDISH.

***The Nature and Extent of Any Actual Confusion***

Applicant contends that for almost two years opposers' goods and applicant's goods were sold in applicant's stores with no evidence of actual confusion<sup>23</sup> and that for almost four years, there has been no evidence of actual confusion between its goods and services and opposers' goods. Thus, applicant argues, this *du Pont* factor weighs heavily against a finding of likelihood of confusion. Although applicant's advertising expenditures are marked "confidential" and therefore cannot be disclosed, they are minimal. The absence, therefore, of actual confusion between the parties' goods, despite being sold in the same stores for almost two years, is not surprising and not legally significant. See *Time Warner Entertainment v. Jones*, 65 USPQ2d 1650, 1663; and *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768

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<sup>23</sup> We are unclear why applicant redacted this argument. Like opposers, we do not find it confidential and have discussed it in this decision.

(TTAB 1992). Moreover, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990).

Therefore, this *du Pont* factor is neutral.

***Applicant's Intent***

Opposers contend that in 2005, they notified applicant of opposers' rights in the SWEDISH SLEEP SYSTEM mark; that from May 2004 to January 2007, applicant was an authorized dealer of opposers and, as part of the distributorship, applicant received a copy of opposers' trademark usage guidelines that clearly show the mark SWEDISH SLEEP SYSTEM with the ® symbol and constitutes notice of opposers' trademark rights in the SWEDISH SLEEP SYSTEM mark. Further, opposers' assert that their Retail Partner Obligations and Advertising Policy (Obligations and Advertising Policy)<sup>24</sup> put applicant on notice of opposers' asserted rights in the term "Swedish," at least as early as 2005, and well within the period during which applicant was prosecuting the application for the SWEDISH LUXURY mark and prior to applicant's first use of the mark. That applicant continued its plans to adopt and use the SWEDISH LUXURY mark even after notice of opposers' rights in the SWEDISH SLEEP SYSTEM

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<sup>24</sup> The particulars of opposers' Obligations and Advertising Policy are confidential.

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mark, opposers contend, weighs in favor of a finding of likelihood of confusion. Opposers also contend that applicant intended to trade off the goodwill associated with opposers as well as opposers' mark.

Applicant, by contrast, contends that the facts do not support opposers' accusation of bad faith. According to applicant, opposers' do not possess trademark rights in the term "Swedish," and that excerpts of the language from opposers' Obligations and Advertising Policy "simply illustrate [opposers'] misguided attempt to possess what it does not own: trademark rights in the geographically descriptive term "Swedish."

There is insufficient evidence of record to show or from we which we can infer that applicant adopted its SWEDISH LUXURY mark in bad faith. Mere knowledge of the existence of opposers' mark does not, in and of itself, constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ 1307 (Fed. Cir 1989). *Ava Enterprises, Inc. V. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006). Opposers must show that applicant intentionally sought to trade on opposers' good will.

Even so, it is settled that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril. W.R.

Grace & Co. v. Herbert J. Meyer Industries, Inc. 190 USPQ  
308 (TTAB 1976).

### Conclusion

We have carefully considered all of the evidence pertaining to priority of use and the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion. After balancing the relevant factors, we conclude that opposers have established priority of use and that consumers familiar with their mattresses, cushions and pillows made of elastic viscous foam sold under the SWEDISH SLEEP SYSTEM mark would be likely to believe, upon encountering applicant's SWEDISH LUXURY mark for mattresses, parts and components for mattresses, namely, foundations and box springs; furniture and retail furniture and mattress store services, that the parties' goods and services originate with or are associated with or sponsored by the same entity. We do so principally because the goods and services are identical or closely related and the marks are similar in appearance, sound, connotation and commercial impression.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of opposers as the prior user.

*See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992).

**GEOGRAPHIC DECEPTIVE MISDESCRIPTIVENESS**

In the case of *In re California Innovations, Inc.* 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003), the Court set forth the elements of a Section 2(e)(3) geographically deceptively misdescriptive claim as follows:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark (i.e., that a goods/place association exists), when in fact the goods do not come from that place; and
- (3) the misrepresentation would be a material factor in the consumer's decision to purchase the goods.

Opposers contend that the primary significance of the mark SWEDISH LUXURY is the geographic term SWEDISH, and the term LUXURY is secondary and highly suggestive and does not detract from the primary geographic significance of the mark as a whole, and that applicant readily admits that its goods do not come from Sweden. Opposers argue that "because the evidence of record establishes that Sweden is noted for its high quality and high reliability furniture products, including bedding products, and because Applicant's goods do not originate in Sweden, the goods/place association between SWEDISH LUXURY and Applicant's memory foam products would be

material to a consumer's decision to purchase the goods."

(Br. p. 39)

Applicant, on the other hand, contends that opposers have failed to meet the test under *California Innovations* because "there is no evidence that the consuming public is likely to associate the specific goods in question - mattresses - with Sweden, and there is no evidence to show whether or not the mattresses are made in Sweden will be material to a consumer's decision." (Br. p. 27) (emphasis supplied) Applicant also contends that opposers mischaracterize the law with respect to the final factor, whether a misrepresentation is material.

With regard to the first prong of the test, applicant does not dispute that the primary significance of the mark SWEDISH LUXURY is a generally known location. The evidence confirms that Sweden is a generally known geographic location. The American Heritage Dictionary of the English Language, Fourth Edition defines "Swedish" as "of or relating to Sweden, the Swedes, or their culture or language."<sup>25</sup> In addition, we find that the primary significance of the mark SWEDISH LUXURY is geographic. The word LUXURY does not detract from the primary geographic significance of the mark. See, e.g., *In re Wada*, 194 F.3d

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<sup>25</sup> Retrieved at <http://www.bartlby.com>. (Applicant's not. of rel., Exh. D.).

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1297, 52 USPQ 1539 (Fed. Cir. 1999) (The mark NEW YORK WAYS GALLERY projects a primarily geographic significance and the addition of WAYS GALLERY to NEW YORK does not detract from the primary significance of the mark); In re Boyd Gaming Corp., 57 USPQ2d 1944 (TTAB 2000) (The primary significance of the marks ROYAL HAVANA RESORT & CASINO and HAVANA RESORT AND CASINO is geographic and the additional wording in the marks does not detract from the geographic meaning).

(2) The consuming public is likely to believe the place identified by the mark indicates the origin of the goods and services bearing the mark when in fact the goods do not come from that place

As regards the second prong, it involves two issues. The first issue is whether there is a goods/place association; the second issue is whether or not the goods come from the place named. As regards the second issue, applicant admits that its goods do not come from Sweden. (Rensink cross-examination test. p. 17)

The first issue requires proof that the public is likely to believe that applicant's goods, in particular its mattresses, originate in Sweden. Under this issue, we consider "whether the public would reasonably identify or associate the goods sold under the mark with the geographic location contained in the mark." In re Save Venice New York Inc., 259 F.3d 1346, 59 USPQ2d 1778, 1783 (Fed. Cir. 2001). We do not find the evidence sufficient to prove that consumers associate Sweden with mattresses.

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In support of their contention that consumers are likely to associate the goods at issue - in particular mattresses - with Sweden, opposers point to the file history of their pleaded registration<sup>26</sup> and note that the examining attorney made of record excerpts from a search of the LEXIS/NEXIS data base in which the term "SWEDISH" or "SWEDEN" appeared within ten words of "mattress" or "mattresses." The search generated 86 excerpts of which 17 were made of record. We find this evidence stale; being more than ten years old. In addition, of the 17 excerpts of record, one occurrence of the term "Swedish" was not related to mattresses (excerpt 12 of 86); eight referred to opposers' goods (excerpts 14, 22, 40, 43, 49, 54, 55, and 62 of 86); five referred to mattresses manufactured by the Swedish company Dux (excerpts 18, 23, 26 71 and 76 of 86) and, of final two, one excerpt was from the Vancouver Sun, a paper circulated outside of the United States (excerpt 58 of 86). Opposers also point to search results from a search of the terms "Swedish" or "Sweden" within ten words of "pillow." That search generated 108 excerpts, eleven of which are of record. Again, this evidence suffers from staleness. Of the eleven, five refer to opposers' goods (excerpts 7, 8, 11, 12 and 48 of 108). Moreover, given the

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<sup>26</sup> (Rensink dec., exh. C) We note that opposers' incorrectly referenced Exhibit A in their brief.

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brevity of the excerpts, i.e., a few words or sentences on either side of the search term, we cannot say that the references are to distinct products such that we could infer widespread exposure of a type that would demonstrate a consumer association between bedding products and the country of Sweden. For these reasons, we find the excerpts have little probative value.

Opposers also made of record eleven newspaper articles which they claim demonstrate a consumer association between Sweden and mattresses.<sup>27</sup> These articles suffer from the same shortcomings as the excerpts from LEXIS/NEXIS. Notably, of the eleven articles, almost half are over ten years old and, collectively, they refer to the same three Swedish manufacturers, i.e., Duxiana (Exhibits 29 and 37 and 39), Hastens (Exhibits 30, 31, 32, 33 and 34), Dux/Simmons or Dux (Exhibits 32, 34, 35, 36 and 38), of extremely high-end mattresses. These references to three Swedish mattress manufacturers, who it appears only deal in very expensive bedding, simply do not persuade us that there is consumer association of mattresses with Sweden.

Last, we find that the testimony of applicant's witness does not support opposers' contention that there is a goods/place association between mattresses and Sweden.<sup>28</sup>

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<sup>27</sup> (Opposers' second not. of rel., exhs. 29-39)

<sup>28</sup> Opposers point to, for example, applicant's witness' declaration wherein he stated that "Denver Mattress chose the

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The perception of a single witness is simply not sufficient to demonstrate a goods/place association between mattresses and Sweden. Moreover, we find more credible applicant's witnesses' testimony as to his first-hand knowledge, i.e., his general perception of products produced in Sweden based on his travels to Sweden and visits to different manufacturing companies. (Rensink cross-examination test. p. 15). There simply is no foundation for his statement that "the general perception in the U.S. [is] that products produced from Sweden have a high value and high quality and reliability in the marketplace." (*Id.*)

In view of the forgoing, opposers have not demonstrated that the consuming public is likely to believe that Sweden indicates the origin of applicant's mattresses.

Accordingly, opposers cannot prevail on their geographically deceptively misdescriptive claim and we need not consider the third prong, i.e., whether the mark's misrepresentation is a material factor in the consumer's decision to purchase the goods.

**Decision:** The opposition is sustained as to opposers' priority and likelihood of confusion claim and dismissed as to their geographically deceptively misdescriptive claim.

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name SWEDISH LUXURY because of our view that 'Swedish' denotes high quality and reliability in the marketplace." (Rensink Dec. ¶ 4).