

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

Mailed:
March 29, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Dreamwell, Ltd.

v.

Kittrich Corporation

Opposition No. 91188186
to application Serial No. 77444304
filed on April 9, 2008

W. Andrew McNeil of Morris, Manning & Martin, LLP for
Dreamwell, Ltd.

Brian R. McGinley of SNR Denton US LLP for Kittrich
Corporation.

Before Seeherman, Grendel and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Kittrich Corporation has applied to register BEST REST,
in standard characters, for "sleep products, namely,
mattresses, spring mattresses, box springs and mattress
foundations; pillows and bolsters; mattress cushions,
mattress toppers" in Class 20 and "pillow cases, pillow
covers, pillow shams, bed blankets, bed canopies, bed
covers, bed linen, bed pads, bed sheets, bed skirts, bed

Opposition No. 91188186

spreads, blanket throws, comforters, duvets, duvet covers, mattress covers, mattress pads" in Class 24.¹ Dreamwell, Ltd. has filed an opposition on the grounds of likelihood of confusion (Section 2(d) of the Trademark Act), dilution (Sections 13(a) and 43(c)) and mere descriptiveness (Section 2(e)(1)). In particular, opposer has alleged that it is a wholly-owned subsidiary of Simmons Bedding Company, a maker of mattresses, box springs, and other bedding and related products; that opposer was formed in 2001 for the purpose of holding Simmons' intellectual property assets, and that opposer has licensed Simmons to use these trademarks; that opposer owns registrations for a number of BEAUTYREST trademarks, as well as the trademark GLAMOUREST,² and Simmons uses these marks pursuant to license; that applicant's mark BEST REST so resembles opposer's registered marks as to be likely, when used on or in connection with applicant's goods, to cause confusion or mistake or to deceive; that the mark BEAUTYREST has for many years prior to the filing date of applicant's application been a famous and distinctive mark, having been first adopted by Simmons in 1925 and used continuously since that time; that

¹ Application Serial No. 77444304, filed April 9, 2008, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) (intent-to-use).

² The specific registered marks in which opposer claims rights are set forth in the notice of opposition; we have listed those pleaded registrations that were made of record and that are current later in this opinion.

Opposition No. 91188186

applicant's mark will cause dilution of the quality of opposer's famous mark BEAUTYREST; and that applicant's mark, when used on or in connection with applicant's identified goods, is merely descriptive of them.

Applicant has denied the allegations of the notice of opposition in its answer, and has asserted affirmatively that no likelihood of confusion exists between applicant's mark and opposer's pleaded marks.

By operation of the rules, the record includes the pleadings and the file of the opposed application. Only opposer submitted evidence. It took the testimony deposition, with exhibits, of Matthew Anderson, vice president of business development for Simmons Bedding Company; applicant did not attend this deposition. Opposer also submitted three notices of reliance, consisting of printed publications showing advertisements for opposer's marks;³ the book A Classic Bedtime Story, a history of opposer's marks published by Simmons Co. in 1996; and status and title copies of opposer's fifteen pleaded registrations:⁴

³ Opposer submitted under this notice of reliance three exhibits. Exhibit A consists of what appears to be a four-page insert advertisement showing publication in 13 newspapers on October 10, 2004; Exhibit B appears to be a four-page insert advertisement published in four newspapers on February 18, 2007; and Exhibit C appears to be a four-page insert advertisement published in 13 newspapers on February 18, 2007.

⁴ One of opposer's pleaded registrations, No. 2716091, a copy of which it submitted under the notice of reliance, was cancelled, and we therefore have given it no consideration.

MARK	GOODS
<i>Beautyrest</i>	Mattresses, studio couches, lounges and box springs ⁵
<i>Beautyrest</i>	Mattresses and box springs ⁶
Beautyrest	mattresses ⁷
BEAUTYREST	Mattresses and box springs ⁸
BABY BEAUTYREST BACK CARE IV, "Baby" disclaimed and Section 2(f) as to "Back Care"	mattresses ⁹
BEAUTYREST POCKETED COIL, "Coil" disclaimed and Section 2(f) as to "Pocketed"	Mattresses and box springs ¹⁰
BEAUTYREST	Textile pillow protectors ¹¹

⁵ Registration No. 512535, issued July 19, 1949; Section 8 & 15 affidavits accepted and acknowledged; renewed three times.

⁶ Registration No. 1788183, issued August 17, 1993; Section 8 & 15 affidavits accepted and acknowledged; renewed.

⁷ Registration No. 207821, issued January 12, 1926; Section 8 & 15 affidavits accepted and acknowledged; renewed four times.

⁸ Registration No. 2791028, issued December 9, 2003; Section 8 & 15 affidavits accepted and acknowledged. At the time the Office prepared the status and title copies the Section 8 and 15 affidavits had not yet been considered; in accordance with Board policy, we have ascertained the current status of the registrations.

⁹ Registration No. 1324572, issued March 12, 1985; Section 8 & 15 affidavits accepted and acknowledged; renewed.

¹⁰ Registration No. 2146996, issued March 31, 1998; Section 8 affidavit accepted. We note that a renewal application was due to be filed by September 20, 2008, but no renewal indication was noted on the registration when the status and title copy issued on December 10, 2009. We have checked Office records but they do not reflect that the registration has been renewed, nor do they reflect that it has expired.

¹¹ Registration No. 2010820, issued October 22, 1996; Section 8 & 15 affidavits accepted and acknowledged; renewed.

<i>Beautyrest</i>	Pillows; Bed clothes and coverings, namely, mattress pads, dust ruffles, comforters and pillow cases ¹²
BEAUTYREST	Bed clothes and coverings, namely mattress pads, dust ruffles, comforters, and pillow cases ¹³
<i>Beautyrest</i>	chairs ¹⁴
BEAUTYREST BLACK	Mattresses and box springs ¹⁵
MY BABY'S BEAUTYREST	Mattresses and box springs ¹⁶
POCKET REST	Mattresses and box springs ¹⁷
GLAMOUREST	Mattresses and box springs ¹⁸
BEAUTYREST CONTINENTAL	Mattresses and box springs ¹⁹

Applicant did not introduce any testimony or other evidence, and only opposer filed a brief.

Preliminary Observations

¹² Registration No. 2585251, issued June 25, 2002; Section 8 & 15 affidavits accepted and acknowledged.

¹³ Registration No. 1904444, issued July 11, 1995; Section 8 & 15 affidavits accepted and acknowledged; renewed.

¹⁴ Registration No. 602721, issued March 1, 1955; Section 8 & 15 affidavits accepted and acknowledged; renewed three times.

¹⁵ Registration No. 3393270, issued March 4, 2008.

¹⁶ Registration No. 3464540, issued July 8, 2008.

¹⁷ Registration No. 2191136, issued September 22, 1998; Section 8 affidavit accepted; renewed.

¹⁸ Registration No. 865743, issued March 4, 1969; Section 8 & 15 affidavits accepted and acknowledged; renewed twice. This is a concurrent use registration for the United States except for the states of Florida and Georgia and certain counties in Alabama and South Carolina.

¹⁹ Registration No. 1404977, issued August 12, 1986; Section 8 affidavit accepted; renewed.

Relationship between opposer and Simmons Bedding Company

Mr. Anderson, opposer's sole witness, testified that he is the vice president of business development of Simmons Bedding Company. He did not provide any information as to the relationship between his company and opposer, Dreamwell, Ltd. Although opposer alleged in its notice of opposition a corporate relationship with Simmons Bedding Company, an allegation, of course, is not proof. We note that in its brief opposer mentions Dreamwell's activities, but either there is no citation to the record for supporting evidence, or the citation does not actually reference Dreamwell. See for example, the statement at page 23 of opposer's brief, that "third-party advertisements are prepared with, and subject to the control of, Simmons and/or Dreamwell," citing to the Anderson deposition at 26:6-11. There is no mention of Dreamwell in this portion of the testimony; in fact, there is no mention of Dreamwell anywhere in the testimony.

The situation in this case is akin to the circumstances presented in *Somerset Distilling Inc. v. Speymalt Whisky Distributors Ltd.*, 14 USPQ2d 1539 (TTAB 1989), in which the witness, Richard Chapman, an employee of Schenley Industries, testified on behalf of the opposer:

Applicant points out that Mr. Chapman's testimony fails to delineate the relationship between Schenley and opposer. We agree that the testimony elicited by opposer leaves a great deal to be desired in showing the connections between the

Opposition No. 91188186

various companies and trading divisions, both in the United States and abroad, that appear to be involved in using the "GORDON'S" mark. However, while opposer cannot rely on this testimony to demonstrate its ownership of the trademark "GORDON'S", it need not do so because it has submitted certified copies of its registrations, showing that the registrations are subsisting and that title resides in opposer.

Applicant also asserts that opposer cannot rely on Mr. Chapman's testimony to show use of the registered mark. We disagree. We think it evident from Mr. Chapman's testimony, during which the registrations owned by opposer were introduced, that the sales and promotion of "GORDON'S" trademarked products referred to the "GORDON'S" mark owned by opposer. Further, there is nothing in the record to indicate, nor has applicant claimed, that the use of "GORDON'S" by Schenley is an adverse use (nor can it make such a claim in the absence of a counterclaim for cancellation.) Thus, even though opposer cannot rely on Schenley's use in the sense of a licensee whose use inures to the benefit of the licensor, it can rely on Schenley's sales and promotion figures in the same manner that a manufacturer can use the product sales and promotion figures of an unrelated retail store which sells his product.

Because in the present case it is clear that the sales and advertising of BEAUTYREST products testified to by Mr. Anderson, as well as recognition of the BEAUTYREST marks, refer to the BEAUTYREST marks that are the subject of opposer's registrations, we will consider this testimony. However, testimony about Simmons Bedding Company's licensees, because there is no information as to how this company's licenses relate to opposer, is irrelevant and has not been considered.

Leading questions and unresponsive answers

Although applicant did not attend Mr. Anderson's testimony deposition and therefore raised no objections to any of the questions and responses, we note that some of opposer's attorney's questions were, to say the least, leading. See, for example:

Q.: So would you agree with me, then, that even if the Best Rest mark were applied to a product that was not in direct-or directly competing with a Beautyrest mark, it would be sold in the same, let's say, section of a retail store or the same store; and because the application is relating solely to bedding products, there would probably-correct me if I'm wrong, there would be probably a likelihood of confusion with those marks as well?

p. 45.

Similarly, many of the witness's responses were not, in fact, directly responsive to the questions asked, but were more in the nature of argument in favor of opposer's position:

Q.: Okay. There on page 52 [of exhibit 2, the book A Bedtime Story], down there in the bottom right corner, can you describe what is featured and described there?

A.: Yes. What's described here is a representation, an image of the original U.S. Patent Office grant on the trademark for Beautyrest. And this grant was registered January 12, 1926. And in 1925, Simmons introduced the Pocketed Coil mattress to the industry. This was a revolutionary step forward. This was a - it became immediately known as the premium mattress brand in the United States.

We had several leading luminaries of the time, and this would continue through today, endorsing the product, without any compensation, really, just

because of the strength of the design and the strength of the performance of the product. People such as Eleanor Roosevelt testified - or provided endorsement for the product, Arthur Ashe, you know, Thomas Edison. I mean, the list goes on and on.

But what this represents is, you know, the first time in the industry that a premium Pocketed Coil mattress was available, marketed on a nationwide basis. And this is really the core crux of the value proposition for Simmons.

pp. 8-9.

Needless to say, we have given each response the probative value which it deserves.

Hearsay

As previously stated, opposer has submitted, under a notice of reliance, a book, A Classic Bedtime Story: 125 Years of Innovation, that was published by the Simmons Co. in 1996. The notice indicates that the book is relevant "to show the history of the goods sold under the Opposer's BEAUTYREST Marks and that the public has been exposed to this history and may be aware of the information contained therein." We point out that the book cannot be used as proof of the statements made in the book; that would be hearsay. This same book was introduced as Exhibit 2 to the deposition of Mr. Anderson. While Mr. Anderson read excerpts from the book at his deposition, so that they are in the transcript, Mr. Anderson never testified as to the accuracy of the text that he read aloud, or as to the accuracy of any of the statements in the book. Therefore,

although we accept that the excerpts read by Mr. Anderson appear in the book and, to the extent that the book would be read by the public, would receive some public exposure, his reading the excerpts as part of his testimony does not serve to prove the truth of the statements made in the book, or that Mr. Anderson's reading the excerpts is the equivalent of his testifying to the underlying information that he read.

Family of marks

In its brief opposer has asserted that it has a "family of marks." See p. 13. However, opposer did not plead ownership of a family of marks in its notice of opposition. See *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511 (TTAB 2009), which indicates that if reliance on a family of marks is not pleaded it must be tried by consent of the parties, such that the pleadings may be deemed amended. As for whether this issue was tried, opposer's attorney did refer to a "family of marks" in some questions, e.g., "Can you tell us when the Beautyrest family of marks first were used?" p. 6. The witness's response to this question referenced for the most part only a single mark, BEAUTYREST, although at the end of his response Mr. Anderson mentioned some "sub-brands," only one of which is the subject of a pleaded registration:

Well, Beautyrest - the current design for Beautyrest was introduced in the United States in

1925, and I believe the trademark was granted at that same time. And I think we actually have materials to that, which we can review. But it's been in use now since 1925. It's a long-standing mark. It's well-known in the industry. It is our flagship brand, represents the vast majority of our sales. It also represents the vast majority of our licensing agreements for accessory, pillow, sheets, and other items. It is currently in use around the world with 18 different licensees in 200 different countries.

Beautyrest has been utilized as my company - as our flagship master brand. And under that, we have several sub-brands, including Beautyrest Classic, Beautyrest Studio, Beautyrest World Class, and Beautyrest Black, Beautyrest NXG. And there are others beyond that.

It is a core value proposition for our company. It is one of the things that would be valued very highly if you were doing a valuation of the Simmons Bedding Company.

pp.6-7.

At other points in the testimony, both opposer's counsel and the witness referred to a "Beautyrest family of products" rather than a "family of marks." And because applicant did not cross-examine Mr. Anderson or submit any evidence or a brief, we cannot say that applicant overtly consented to the trial of this issue.

However, we need not engage in an extensive discussion of whether or not the issue of a family of marks was actually tried by consent of the parties because opposer has not proven that it has a family of marks. In order to establish a family of marks, opposer must show a recognition among the purchasing public that the common characteristic

is indicative of a common origin of the goods. Simply using a series of similar marks does not of itself establish the existence of a family. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891. Opposer points to its sixteen pleaded registrations²⁰ as a basis for its claim that it established a family prior to applicant's constructive use of its mark, and also asserts, as the entirety of its argument that it has a family of marks:

BEAUTYREST is the master brand for a variety of sub-brands, such as BEAUTYREST World Class and BEAUTYREST Classic brands, among others. [Anderson Depo., 41:4-8.] However, BEAUTYREST is more than just a common element among the various trademarked sub-brands, because without it, the sub-brand designations would be meaningless. When a product features a BEAUTYREST trademark, the consumer knows that the particular product represents the same innovation, quality and value as other BEAUTYREST products.

Brief, p. 15.

The fact that opposer has used and registered several marks incorporating BEAUTYREST is not in itself sufficient to establish the existence of a family of marks. *Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d at 1514. Further, the evidence is insufficient to show that opposer has promoted BEAUTYREST as the "surname" of a family of marks. Opposer has submitted only three advertisements

²⁰ As noted supra, only fifteen of these registrations are current.

(albeit multiple copies of each advertisement showing that each has appeared in several newspapers). With the exception of BEAUTYREST per se, none of the marks that are the subject of opposer's pleaded registrations appears in these advertisements. And we note that the sub-brands that opposer mentions in its brief, BEAUTYREST World Class and BEAUTYREST Classic, are not among the marks that opposer has pleaded and submitted registrations for. Opposer cannot use a family of marks argument as a way to overcome its failure to plead in its notice of opposition likelihood of confusion based on common law marks. Accordingly, we have given opposer's claim of likelihood of confusion based on a family of marks no further consideration.²¹

Standing

In view of the registrations that opposer owns, and which have been made of record, opposer has shown that it has a direct commercial interest in this proceeding and therefore has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Descriptiveness

²¹ This ruling has no effect on our ultimate decision herein, in that opposer's argument is that BEST REST is confusingly similar to BEAUTYREST per se. Thus, contrary to the usual scenarios in which a plaintiff asserts a family of marks, opposer is not trying to claim rights in a surname portion of a family of marks where it does not use the surname alone, or that the applicant

We turn first to opposer's contention that applicant's mark BEST REST is merely descriptive of the identified goods in Class 20 (mattresses, spring mattresses, box springs and mattress foundations; pillows and bolsters; mattress cushions, mattress toppers) and in Class 24 (pillow cases, pillow covers, pillow shams, bed blankets, bed canopies, bed covers, bed linen, bed pads, bed sheets, bed skirts, bed spreads, blanket throws, comforters, duvets, duvet covers, mattress covers, mattress pads). Section 2(e)(1) of the Trademark Act prohibits the registration of a mark that is merely descriptive of the identified goods. However, a suggestive term is registrable. Whether a given mark is suggestive or merely descriptive depends on whether the mark immediately conveys knowledge of the ingredients, qualities or characteristics of the goods with which it is used, or whether imagination, thought or perception is required to reach a conclusion on the nature of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Opposer's argument as to why applicant's mark is merely descriptive is as follows:

The word "rest" immediately evokes the idea of sleep, a primary function of mattresses and bedding products. Nor does the addition of the laudatory term "best" save the mark from descriptiveness. Marks that are merely laudatory are regarded as being descriptive. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair*

has appropriated the surname portion of opposer's family of marks and is using it with other matter.

Opposition No. 91188186

Competition, § 11:17 (4th Ed. 2010). For example, AMERICA'S BEST POPCORN for popcorn was found to be [a] descriptive and merely self-laudatory epithet and not allowed to register. *In re Wileswood, Inc.*, 201 USPQ 400, 404 (TTAB 1978).

Brief, p. 28.

We are not persuaded by this argument. In fact, applicant's own characterization of how BEST REST "describes" mattresses and bedding products shows that the consumer must engage in some mental steps to go from understanding first that REST evokes the idea of sleep and second, that sleep is a function of mattresses and bedding products and third, that the mattresses and bedding products are used in connection with sleeping and/or they help one sleep or result in one being able to sleep. Further, while BEST has a laudatory significance, in this case it modifies the word REST, rather than describing the mattresses and bedding per se, in the manner of opposer's AMERICA'S BEST POPCORN example. Thus, while a consumer may understand from the mark BEST REST that, if one uses applicant's products one will sleep well, it requires a multi-stage reasoning process to do so, rather than an instantaneous understanding from the mark of an attribute of the products. See *Nautilus Group Inc. v. ICON Health and Fitness Inc.*, 372 F2d 1330, 71 USPQ2d 1173 (Fed. Cir. 2004) and cases cited therein.

The opposition on the ground of mere descriptiveness is dismissed.

Likelihood of confusion

The ground of likelihood of confusion has two elements: priority and likelihood of confusion. Because opposer has made its registrations of record, priority is not in issue with respect to the goods identified in those registrations. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As for the issue of likelihood of confusion, our determination is based on an analysis of all of 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). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

There are certain factors that clearly favor opposer and its claim of likelihood of confusion. The goods are, in part, legally identical. Opposer has made of record several registrations for the mark BEAUTYREST (in both typed drawing and stylized format) that include mattresses, box springs, comforters and pillow cases, items that are identical to some of the goods identified in each class of applicant's two class application. Because an opposition on the ground of likelihood of confusion must be sustained for

Opposition No. 91188186

each class for which there is likely to be confusion with respect to any of the goods in such class, see *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981), we need not further consider the similarity of opposer's goods and the remaining goods in applicant's application in order to conclude that this du Pont factor favors opposer.

Similarly, because the goods are legally identical, they are presumed to be sold in the same channels of trade and to the same classes of consumers which, in this case, includes the public at large.

We turn next to the du Pont factor of fame. Mr. Anderson testified that the mark BEAUTYREST was first introduced for mattresses in 1925, that the mark has been used since that time, and that certain innovations for mattresses have been introduced under the BEAUTYREST trademark, including the pocketed coil mattress in 1925, king and queen size mattresses in 1958, and no flip construction in 2000. Various celebrities have endorsed the mattress, including Henry Ford, H.G. Wells, Thomas Edison, Cole Porter and Arthur Ashe. Even Eleanor Roosevelt, when she was the First Lady, endorsed it. Opposer began advertising the mattress on television in the 1950s, and also advertises on radio, through the Internet, and does newspaper ads in conjunction with retail resellers.

Opposer's current annual advertising budget, at least for 2009, is approximately \$100 million.²²

As for sales, Mr. Anderson testified, in answer to the question of what "nationwide retailers feature the Beautyrest line of goods," that "major retailers that feature Beautyrest prominently in their advertising" include Macy's, Sleep Train and American Furniture Warehouse.

p. 30.²³ Annual sales for the last few years, excluding contract sales to companies in the health and hospitality industries (for example, hotels), are \$471 million in 2005, \$568 million in 2006, \$665 million in 2007, \$607 million in 2008 and \$505 million in 2009; these sales figures include those by international divisions as well as domestic sales.

We must say that some of the testimony and evidence submitted by opposer to show fame is problematic. For

²² Our information about opposer's advertising figures consists of the following exchange during Mr. Anderson's testimony: Q. "If you had to estimate, what would you say the expenditures on advertising today are?" A. "Annually, it's going to be in the range of \$100 million." p. 11. Mr. Anderson did not specify what years this estimate applies to; the date of Mr. Anderson's deposition was March 15, 2010, and we have therefore assumed that the estimate is for 2009. However, no documents showing annual advertising expenditures, or a breakdown as to the amounts spent on advertising in the various media, were submitted.

²³ As part of his answer to that same question, Mr. Anderson also stated that "What you'll typically find is that Simmons products will be utilized in any market by the leading retailers because, again, those leading retailers are looking to have products on their floor that consumers want to shop for that value that brand. Currently, Simmons has over 7,000 authorized retailers with 13,000 retail store door [sic] locations in the U.S." However, as we previously pointed out, Simmons is not the opposer, and there is no evidence about the relationship between Simmons and opposer, so we cannot assume that BEAUTYREST mattresses are sold in all of the 13,000 retail stores.

Opposition No. 91188186

example, although various celebrities have endorsed BEAUTYREST mattresses, opposer has not submitted any of these endorsements so that we could determine the context in which they were made, or the impact that the endorsements may have had. More importantly, it is not clear to us that people purchasing mattresses today would be aware of those endorsements, since they would have occurred quite some time ago. Most of the celebrities named by Mr. Anderson passed away many years ago (Thomas Edison died in 1931, H.G. Wells in 1946, Henry Ford in 1947, Cole Porter in 1964); even Arthur Ashe passed away in 1993. And of course Eleanor Roosevelt was First Lady from 1933 until 1945. Mr. Anderson did not identify any celebrities who have endorsed BEAUTYREST products currently or did so in the recent past.

As for opposer's advertising, again there are pictures of historical ads, as shown in the book A Bedtime Story. There are only three current advertisements that opposer made of record (albeit in multiple copies showing placement in many newspapers). They are all from a chain called Mattress Giant, and consist of four pages, such as would be seen in an insert in a Sunday newspaper. The BEAUTYREST mattresses are listed along with mattresses sold under other marks from other manufacturers, and the BEAUTYREST mark does not even appear on the first page of two of the ads. Although someone who wanted to buy a mattress would

certainly see the BEAUTYREST mark, the mark does not stand out to someone who merely is glancing at the pages in the paper. Opposer did not submit any examples of radio, internet or current television advertising.²⁴

As for sales, the figures provided by Mr. Anderson and listed above are for "international divisions" as well, test. p. 39, and therefore include sales outside the United States. However, opposer's exhibit 8, which shows a breakdown of sales for each U.S. state and territory, indicates that the bulk of the \$505 million of non-contract 2009 sales were made in the United States, and we therefore accept that the annual sales figures apply primarily to sales in the United States.

As the Federal Circuit has said, "[r]aw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading. ... Consequently, some context in which to place raw statistics is reasonable." Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002). Opposer's efforts to put its sales and advertising figures in context are surprisingly limited, particularly because Mr. Anderson

²⁴ The book A Bedtime Story contains photos of 1950s television ads and a "bowling ball" ad that the book states was started in 1995. Mr. Anderson read the excerpt from the book describing this ad campaign, but he did not testify as to the truth/accuracy of these statements.

testified that sales of BEAUTYREST products are broken down by states (exhibit 8) "so that we can show our--and measure our nationwide market share," and "that Beautyrest products and Simmons products are valued very highly across the entire United States. You'll find that we have a very high market share in almost every region of the country and every protectorate and every territory." p. 40. Although it appears from this testimony that opposer does measure its market share, opposer provided no testimony or exhibits about the specifics of market share. Instead, we have general statements from Mr. Anderson that "Beautyrest is, if not the leading brand, then one of the leading brands in the country," p. 10, included as part of a response that appears to be more in the nature of argument than fact, made in answer to counsel's request to identify a photograph of a trademark registration in the book A Bedtime Story.

We also acknowledge that this book, A Bedtime Story, has a great deal of information about the BEAUTYREST mark, including its history and the way in which BEAUTYREST products have been promoted. However, it is not clear to what extent this book has actually been viewed by the general public. It was privately published by Simmons Co. in 1996 as a history of the Simmons Bedding Company, including the BEAUTYREST brand, and distributed throughout the industry, including to many of the Simmons Bedding

Company's retailers and its sales and marketing and operations professionals. Mr. Anderson testified that "some" end-use consumers received copies of it, and that "you can find it in certain libraries," p. 7, but he provided no further details. We cannot conclude that there was been widespread distribution or viewing of the book by the public at large.

As is obvious from the preceding discussion, there are problems with much of the evidence submitted by opposer in terms of proving the fame of the BEAUTYREST mark. Much of the activities giving rise to renown for BEAUTYREST products occurred many decades ago, and do not show current fame of the mark. The actual advertisements that are of record are very limited, three newspaper ads, one from 2004, one from 2006, and one from 2007, and none of them prominently features the BEAUTYREST mark. The sales figures have not been placed in context, for example, by showing how the market share for BEAUTYREST mattresses compares with the market share of competitors, even though Simmons tracks such figures. Mr. Anderson's rather general statements about market share (which were not even responsive to the questions being asked) are not a substitute for documentary evidence.²⁵

²⁵ See, for example:
Q. So, Mr. Anderson, it sounds—is it fair to say that Beautyrest or Simmons has used a variety of creative

Despite the foregoing problems, when we view the totality of the evidence, and particularly the extraordinarily long time during which the BEAUTYREST mark has been used, coupled with the sales figures at the present time which on their face are so substantial that we can infer extensive consumer recognition of the mark, it is sufficient for us to find that the mark is famous. This du Pont factor favors opposer. However, while dilution fame is an either/or proposition--fame either does or does not exist--likelihood of confusion fame varies along a spectrum from very strong to very weak. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F3d

advertising means to—in association with Beautyrest throughout the years?

A. Without a doubt. We've used many different advertising campaigns and many different advertising vehicles to, again, drive our brand and our value proposition to the end-use consumer and establish that as one of the leading brands in the industry.

pp. 19-20.

Q. Thank you. Okay. On page 79 [of the book A Bedtime Story], it looks like we have an image from another magazine as well as some text there. Can you just describe to us what we're looking at here?

A. This is an image of a Woman's Day advertisement, and it's an image of several Beautyrest mattresses and with the text "A leading independent consumer publication torture-tested 32 mattresses [of] major manufacturers and rated them for durability, lasting firmness, and value. This one came out on top," with then the Beautyrest logo being shown.

Again, this goes back to driving to the end consumer the value proposition of a Beautyrest, which is better performance, better durability, and greater overall value. This is why consumers value Beautyrest so highly, and it's why the brand has such a strength--such a position of strength in the industry.

pp. 23-24. (Based on the text on the page on which the image appears, the "torture test" appears to reference a Consumer Reports test done in the 1980s.)

Opposition No. 91188186

1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In this case, because of the problems with opposer's evidence of fame we have detailed, we treat the fame of opposer's mark to be on the weak end of the spectrum.

Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). However, as the Board stated in *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1607 (TTAB 2010):

... this factor alone is not sufficient to establish likelihood of confusion. If that were the case, having a famous mark would entitle the owner to a right in gross, and that is against the principles of trademark law. See *University of Notre Dame du Lac v. J. C. Gourmet Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

The fame of the [plaintiff's] name is insufficient in and of itself to establish likelihood of confusion under §2(d). "Likely* * *to cause confusion" means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to the principles of trademark law and to concepts embodied in 15 USC § 1052(d).

Opposition No. 91188186

See also *Recot Inc. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("fame alone cannot overwhelm the other *du Pont* factors as a matter of law").

With this in mind, we turn to a consideration of the marks. We focus our discussion on opposer's mark BEAUTYREST, since this mark is closest to applicant's mark BEST REST, and it is this mark for which opposer has proved fame. As opposer has pointed out, both marks begin with the letter "B" and end with the word REST. However, the fact that they have in common the word REST is not a sufficient basis on which to find likelihood of confusion. Opposer itself views REST as being descriptive of mattresses and bedding ("the word 'rest' immediately evokes the idea of sleep, a primary function of mattresses and bedding products," brief, p. 28). Although we consider REST to be highly suggestive, rather than descriptive of the goods, it is well established that the mere presence of a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F2d 915, 189 USPQ 693, 694 (CCPA 1976); *Mead Johnson & Company v. Peter Eckes*, 195 USPQ 187 (TTAB 1977); *Cutter Laboratories, Inc. v. Air Products and Chemicals, Inc.*, 189 USPQ 108 (TTAB 1975).

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on

Opposition No. 91188186

a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Because the term REST is highly suggestive of the parties' goods, and because BEAUTY and BEST are the first words in the respective marks, they are the more prominent features. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d at 1692.

When the marks are compared in their entireties, and giving the appropriate weight to each of the words therein, we find that the marks differ in appearance, sound, connotation and commercial impression. Because of the differences between BEAUTY and BEST, differences that are emphasized by the fact that in the mark BEST REST, "BEST" is separated from REST, so it is clear that it is a different word, and because of the different lengths of BEAUTY and BEST, especially since BEAUTY appears as an even longer letter string in BEAUTYREST, the marks as a whole are different in appearance. The differences in pronunciation of BEAUTY and BEST also result in differences in the sound of the two marks, including the different number of syllables and different vowel sounds. Further, the fact that the two words in applicant's mark rhyme provides a further distinction, both because of the rhyme itself and because the rhyme emphasizes the word BEST. As for

connotation, opposer's mark calls to mind the phrase "beauty sleep," while applicant's mark suggests that its products will result in the best or most restful sleep that one has ever had. Although both marks obviously reference REST, the overall connotations are different. The commercial impressions of the mark, too, are different as a result of the differences in the initial words.

The du Pont factor of the similarity of the marks favors applicant.

Moreover, despite the du Pont factors that favor opposer, we consider that this factor of the dissimilarity of the marks outweighs the other factors. As the Court stated in *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991), in affirming the Board's decision for applicant on the basis that the dissimilarity of the marks outweighed all other factors, "We know of no reason why, in a particular case, a single duPont factor may not be dispositive." We point out that in deciding the motion for summary judgment, the Board reached its decision that confusion was not likely by essentially treating the factor of fame as though it favored the opposer.

In reaching this conclusion that the dissimilarity of the marks outweighs the factors favoring opposer's position, we have given opposer's mark the deference to which it is

entitled as a famous mark, and we are also mindful of the fact that the goods involved are identical. However, the fact situation in this case differs from other cases involving famous marks and where the goods were identical, in which likelihood of confusion was found. For example, in *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992), likelihood of confusion was found between PLAY-DOH and FUNDOUGH, both for modeling compound; however, the Court determined that the words PLAY and FUN, in the overall context of the marks, conveyed a very similar impression since they were both single syllable words associated closely in meaning because, in the context of a child's toy, the concepts of fun and play tend to merge. In *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984), likelihood of confusion was found between SPICE ISLANDS and SPICE VALLEY, both for teas, the Court stating that both marks conveyed confusingly similar commercial impressions. In the present case, for the reasons discussed, the marks are not confusingly similar. In effect, to reach the conclusion that confusion is likely because BEAUTYREST is a famous mark would essentially give opposer exclusive rights to the highly suggestive word REST, or to the word REST if a term beginning with the letter B were used with it. However, as the case law we quoted above

states, having a famous mark does not give the owner thereof a right in gross.

We have also taken into consideration the du Pont factor of the conditions of purchase--the only remaining factor that has been discussed and for which there is any evidence. The evidence shows that mattresses are relatively expensive items. The 2007 advertisement lists BEAUTYREST mattresses with prices ranging from a 50% off sale price of \$399 for a twin mattress to a \$3,399.99 sale price for a king set. Mr. Anderson also testified that customers shop for mattresses infrequently, once every eight to ten years for a master bedroom purchase. This testimony and evidence, as well as the fact that comfort and durability would be a concern in buying a mattress, indicates that mattresses are not impulse purchases, but would be made with some degree of care.

Mr. Anderson testified that "because consumers shop so infrequently, they're easily confused, and they're easily led astray, not only by competing or confusing brand names, but also by the retail sales associates." p. 10. This statement was part of a response that was more in the nature of argument than factual statements.²⁶ Because we regard

²⁶ These comments were made as part of his response to the question, "And can you describe what we're looking at here in the book as well?" The book was A Bedtime Story, and the first part of his answer was that it was "an image and text relating to a 1925 trademark patent for the name Beautyrest."

Opposition No. 91188186

this testimony as argument, and because it is at odds with general principles of trademark law that consumers exercise greater care with infrequent and expensive purchases, we accord this testimony limited probative value. Compare, *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ at 1282 ("Both products are relatively inexpensive, comestible goods subject to frequent replacement. Purchasers of such products have been held to a lesser standard of purchasing care"). At several points in his testimony Mr. Anderson repeated his concern about deceitful sales associates who are "there to guide or to direct the sale," and who could use applicant's mark "to confuse the sale of the product, and they could sell whatever was in their best interest to sell or whatever they wanted to drive through their business at that particular time." pp. 17-18. To the extent that sales associates are deceitful, any confusion is caused not by the trademark, but by the salesperson. Therefore, we find that the du Pont factor of the conditions of purchase favor applicant.

Accordingly, after considering opposer's arguments and the evidence of record, we find that, despite the identity of the goods and trade channels, and the fame to be accorded opposer's mark, the differences in the marks outweigh the factors favoring opposer, and that applicant's mark BEST REST for its identified goods is not likely to cause

confusion with opposer's registered BEAUTYREST marks. The opposition on the ground of likelihood of confusion is dismissed.

Dilution

Sections 13 and 43(c) of the Trademark Act provide for a cause of action for the dilution by blurring of famous marks.²⁷ A prerequisite for relief on the ground of dilution is that the plaintiff's mark must be famous, and, as indicated previously, there is a distinction between fame for likelihood of confusion purposes and fame for dilution. There is a higher and more rigorous standard for dilution fame. See *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d at 1694. We have already found that, based on opposer's evidence, the fame of its mark for likelihood of confusion purposes falls along the weak side of the spectrum. This evidence is certainly not sufficient to prove that the mark is famous for dilution purposes, and does not compare to the evidence introduced in *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003), in which NASDAQ was found to be a famous mark in terms of proving dilution. We have already detailed the problems with much of opposer's evidence of fame, and we need not do so again. In terms of dilution, "the transformation of a term into a truly famous mark"

²⁷ Opposer does not assert dilution by tarnishment.

means that "the mark must be a household name." *Thane International, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 64 USPQ2d 1564, 1575 (9th Cir. 2002), quoted in *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d at 1611. Opposer has fallen far short in proving that the fame of its mark has reached such a level.

In view of opposer's failure to prove that its mark is famous for purposes of proving dilution, we need not engage in an extended discussion of the remaining requirements to succeed on such a ground. However, opposer has characterized as the dispositive factors in its case in showing dilution by blurring "the similarity between the marks, the acquired distinctiveness of the BEAUTYREST Marks, and the exclusive use and recognition of the BEAUTYREST Marks."²⁸ Brief, p. 25. With regard to the first factor, the degree of similarity between applicant's mark and opposer's BEAUTYREST mark, we have already found, in determining that confusion is not likely, that the marks are dissimilar. For the same reasons, we find that the marks are not similar in the context of a dilution claim or, to

²⁸ Section 43(c)(2)(B) lists, as relevant factors, (i) The degree of similarity between the mark or trade name and the famous mark; (ii) The degree of inherent or acquired distinctiveness of the famous mark; (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (iv) The degree of recognition of the famous mark; (v) Whether the user of the mark or trade name intended to create an association with the famous mark; and (vi) Any actual association between the mark or trade name and the famous mark.

Opposition No. 91188186

put it more precisely, the degree of similarity is quite limited. As for the degree of distinctiveness, although opposer's mark is inherently distinctive, it is suggestive. Based on this record, opposer is engaging in substantially exclusive use of the mark, a factor that favors opposer. As for the degree of recognition of opposer's mark, the evidence on this point is quite limited. What opposer has submitted in this connection is, essentially, evidence of some recognition of the mark many decades ago. In terms of current recognition, opposer has shown what appear to be substantial sales, and although large sales can show some exposure of the mark to the public, they fall short in showing a high degree of recognition. There is no evidence of, for example, third-party mentions of the BEAUTYREST mark in articles, or brand awareness studies, or even, as we have previously said, market share. The remaining factors, whether applicant intended to create an association with BEAUTYREST and any actual association between applicant's mark and BEAUTYREST, are neutral.

When all these factors are considered, the degree of dissimilarity of the marks and the limited degree of recognition of opposer's mark outweigh the inherent distinctiveness of opposer's mark (especially because the mark is suggestive, rather than arbitrary) and opposer's exclusive use of its mark.

Opposition No. 91188186

Accordingly, we find that opposer has failed to prove that applicant's use of its mark is likely to cause dilution of opposer's mark, and dismiss the opposition on this ground.

Decision: The opposition is dismissed as to the three pleaded grounds of mere descriptiveness, likelihood of confusion and dilution.