

ESTTA Tracking number: **ESTTA533688**

Filing date: **04/22/2013**

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

Notice of Opposition

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

Opposer Information

Name	Guard Master, Inc.
Granted to Date of previous extension	04/20/2013
Address	110 Bi-County Blvd STE 101 Farmingdale, NY 11735 UNITED STATES

Attorney information	Ludomir A. Budzyn Hoffmann & Baron, LLP 6900 Jerchio Turnpike Syosset, NY 11791 UNITED STATES LABdocket@hbiplaw.com Phone:973-331-1700
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Applicant Information

Application No	85722205	Publication date	02/19/2013
Opposition Filing Date	04/22/2013	Opposition Period Ends	04/20/2013
Applicant	Civilized Sleep Solutions, Inc. c/o The Law Office of Kevin M. Welch P.O. Box 494 Hermosa Beach, CA 90254 UNITED STATES		

Goods/Services Affected by Opposition

Class 020. All goods and services in the class are opposed, namely: Beds and bedding, namely, mattresses, mattress foundations, mattress cushions, mattress toppers, and pillows

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4313540	Application Date	01/27/2011
Registration Date	04/02/2013	Foreign Priority Date	NONE
Word Mark	PERFORMANCE MATTRESS PROTECTOR		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 024. First use: First Use: 2007/10/30 First Use In Commerce: 2007/10/30 mattress protectors

U.S. Registration No.	4301890	Application Date	01/27/2011
Registration Date	03/12/2013	Foreign Priority Date	NONE
Word Mark	PERFORMANCE MATTRESS PROTECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 2010/03/00 First Use In Commerce: 2010/03/00 Pillow protectors and mattress protectors		

U.S. Registration No.	4313541	Application Date	01/27/2011
Registration Date	04/02/2013	Foreign Priority Date	NONE
Word Mark	PERFORMANCE PILLOW		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 2010/01/16 First Use In Commerce: 2010/01/16 pillows		

U.S. Registration No.	4310501	Application Date	03/21/2012
Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	PERFORMANCE SLEEP SHOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2012/06/01 First Use In Commerce: 2012/06/01 Retail store and online retail store services featuring clothing, sleep accessories and bedding		

Related Proceedings	None
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Attachments	2079-70_Notice_of_Opposition.PDF (14 pages)(50852 bytes)
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Certificate of Service

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

Signature	/Ludomir A. Budzyn/
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Name	Ludomir A. Budzyn
Date	04/22/2013

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

In the Matter of Trademark Application Serial No. 85/722,205
Published: 19 February 2013

Guard Master Inc.)	
)	
Opposer,)	
)	
v.)	
)	Opposition No. <u>[Unassigned]</u>
Civilized Sleep Solutions, Inc.)	
)	
Applicant.)	

Commissioner for Trademarks
Box TTAB FEE
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITON

Guard Master Inc. (hereinafter “Opposer”) hereby files a Notice Of Opposition against Civilized Sleep Solutions, Inc. (hereinafter “Applicant”) regarding Applicant’s pending Application for trademark registration of the trademark PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP for “*mattresses, mattress foundations, mattress cushions, mattress toppers and pillows*” in International Class 20, with Serial No. 85/722,205 filed in the United States Patent and Trademark Office on 06 September 2012 (the “Application”). The Application was published in the Official Gazette on 19 February 2013. The time to file the

Notice of Opposition has been extended to 20 April 2013, which being a Saturday, makes this opposition timely filed on 22 April 2013 per 37 C.F.R. § 2.196.

Opposer believes it will be damaged by the registration of the mark of such Application and hereby opposes its federal registration. The grounds for the Opposition are as follows:

Parties

- 1) Opposer Guard Master Inc. is a corporation of New York with a principal place of business at Suite 101, 110 Bi-County Blvd., Farmingdale, New York 11735.
- 2) Upon information and belief, Applicant Civilized Sleep Solutions, Inc. is a California corporation with an address of 4707 E. 49th Street, Vernon, California 90058.
- 3) Upon information and belief, Civilized Sleep Solutions, Inc. is represented by counsel, namely Kevin M. Welch, Esq., The Law Office of Kevin M. Welch, P.O. Box 494, Hermosa Beach, CA 90254-0494.

Applicant's PERFORMANCE ENHANCED

MATTRESS SOCIETY OF SLEEP Application

- 4) Applicant seeks to register the trademark PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP for "mattresses, mattress foundations, mattress cushions, mattress toppers and pillows."
- 5) Applicant's Basis in filing the Application is Section 1(B), i.e., intent to use only.

- 6) Upon information and belief, as of the date of filing the Application, Applicant has made no use of its proposed trademark PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP in commerce.

COUNT I -- **Guard Master's PERFORMANCE MATTRESS**
PROTECTOR Trademark and Registration

- 7) Each of paragraphs 1-6 are incorporated under this heading as if set out in full.
- 8) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark, Opposer has engaged in the business of manufacturing and selling products including, among other things, mattress protectors, and has identified such products under the trademark PERFORMANCE MATTRESS PROTECTOR. Opposer's use of said mark to identify its product has been continuous and uninterrupted.
- 9) Opposer introduced bedding-related products under the trademark PERFORMANCE MATTRESS PROTECTOR in commerce at least as early as October 2007 and has used the PERFORMANCE MATTRESS PROTECTOR mark continuously since that time.
- 10) Opposer owns trademark rights in the PERFORMANCE MATTRESS PROTECTOR trademark for bedding-related products.
- 11) Opposer is the owner of United States Registration No. 4,313,540 ("the '540 Registration"), registered on the Principal Register on 02 April 2013 for the PERFORMANCE MATTRESS PROTECTOR trademark as used in connection with mattress protectors in International Class 24.

- 12) The '540 Registration is valid and in full force and effect. The Principal Register registration is *prima facie* evidence of the validity of the registration, of Opposer's ownership of the mark and of its exclusive right to use the mark in commerce. Moreover, the registration is constructive notice to Applicant and all others of Opposer's claim of ownership of the marks. Opposer uses the symbol ® in association with its marks.
- 13) Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing its trademark so that the public has come to associate and attribute usage of the PERFORMANCE MATTRESS PROTECTOR trademark with Opposer.
- 14) The goods identified in Applicant's application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 8) under the PERFORMANCE MATTRESS PROTECTOR mark, and to the goods listed in Opposer's '540 Registration, all of such goods being likely to travel through similar channels of trade.
- 15) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark in Applicant's application includes at its leading word the identical word PERFORMANCE as Opposer's PERFORMANCE MATTRESS PROTECTOR trademark.
- 16) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark for which Applicant seeks registration is confusingly similar to Opposer's PERFORMANCE MATTRESS PROTECTOR mark. Applicant's use of its applied-for mark on the goods recited in the Application will create a likelihood of confusion, mistake or deception among the trade and the purchasing public.

- 17) Opposer's PERFORMANCE MATTRESS PROTECTOR trademark has priority over Applicant's proposed PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark.
- 18) Opposer, as the owner of valid federal trademark registrations and as the prior user of such mark, will be damaged if registration of Applicant's mark is granted.

COUNT II -- **Guard Master's PERFORMANCE MATTRESS PROTECTION Trademark and Registration**

- 19) Each of paragraphs 1-6 are incorporated under this heading as if set out in full.
- 20) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark, Opposer has engaged in the business of manufacturing and selling products including, among other things, mattress protectors and pillow protectors, and has identified such products under the trademark PERFORMANCE MATTRESS PROTECTION. Opposer's use of said mark to identify its product has been continuous and uninterrupted.
- 21) Opposer introduced bedding-related products under the trademark PERFORMANCE MATTRESS PROTECTION in commerce at least as early as March 2010 and has used the PERFORMANCE MATTRESS PROTECTION mark continuously since that time.
- 22) Opposer owns trademark rights in the PERFORMANCE MATTRESS PROTECTION trademark for bedding-related products.

- 23) Opposer is the owner of United States Registration No. 4,301,890 (“the ‘890 Registration”) for the PERFORMANCE MATTRESS PROTECTION trademark as used in connection with pillow protectors and mattress protectors in International Class 24.
- 24) The ‘890 Registration is valid and in full force and effect. The Principal Register registration is *prima facie* evidence of the validity of the registrations, of Opposer's ownership of the mark and of its exclusive right to use the mark in commerce. Moreover, the registration is constructive notice to Applicant and all others of Opposer's claim of ownership of the marks. Opposer uses the symbol ® in association with its marks.
- 25) Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing its trademark so that the public has come to associate and attribute usage of the PERFORMANCE MATTRESS PROTECTION trademark with Opposer.
- 26) The goods identified in Applicant’s application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 20) under the PERFORMANCE MATTRESS PROTECTION mark, and to the goods listed in Opposer's ‘890 Registration, all of such goods being likely to travel through similar channels of trade.
- 27) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark in Applicant’s application includes at its leading word the identical word PERFORMANCE as Opposer’s PERFORMANCE MATTRESS PROTECTION trademark.
- 28) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark for which Applicant seeks registration is confusingly similar to Opposer’s PERFORMANCE MATTRESS PROTECTION mark. Applicant's use of its applied-for mark on the goods

recited in the Application will create a likelihood of confusion, mistake or deception among the trade and the purchasing public.

- 29) Opposer's PERFORMANCE MATTRESS PROTECTION trademark has priority over Applicant's proposed PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark.
- 30) Opposer, as the owner of valid federal trademark registrations and as the prior user of such mark, will be damaged if registration of Applicant's mark is granted.

COUNT III -- **Guard Master's PERFORMANCE PILLOW**

Trademark and Registration

- 31) Each of paragraphs 1-6 are incorporated under this heading as if set out in full.
- 32) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark, Opposer has engaged in the business of manufacturing and selling products including, among other things, pillows, and has identified such products under the trademark PERFORMANCE PILLOW. Opposer's use of said mark to identify its product has been continuous and uninterrupted.
- 33) Opposer introduced bedding-related products under the trademark PERFORMANCE PILLOW in commerce at least as early as January 2010 and has used the PERFORMANCE PILLOW mark continuously since that time.
- 34) Opposer owns trademark rights in the PERFORMANCE PILLOW trademark for bedding-related products.

- 35) Opposer is the owner of United States Registration No. 4,313,541 (“the ‘541 Registration”), registered on the Principal Register on 02 April 2013 for the PERFORMANCE PILLOW trademark as used in connection with pillows in International Class 20.
- 36) The ‘541 Registration is valid and in full force and effect. The Principal Register registration is *prima facie* evidence of the validity of the registration, of Opposer's ownership of the mark and of its exclusive right to use the mark in commerce. Moreover, the registration is constructive notice to Applicant and all others of Opposer's claim of ownership of the marks. Opposer uses the symbol ® in association with its marks.
- 37) Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing its trademark so that the public has come to associate and attribute usage of the PERFORMANCE PILLOW trademark with Opposer.
- 38) The goods identified in Applicant’s application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 32) under the PERFORMANCE PILLOW mark, and to the goods listed in Opposer's ‘541 registration, all of such goods being likely to travel through similar channels of trade.
- 39) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark in Applicant’s application includes at its leading word the identical word PERFORMANCE as Opposer’s PERFORMANCE PILLOW trademark.
- 40) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark for which Applicant seeks registration is confusingly similar to Opposer’s PERFORMANCE PILLOW mark. Applicant's use of its applied-for mark on the goods recited in the

Application will create a likelihood of confusion, mistake or deception among the trade and the purchasing public.

- 41) Opposer's PERFORMANCE PILLOW trademark has priority over Applicant's proposed PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark.
- 42) Opposer, as the owner of valid federal trademark registrations and as the prior user of such mark, will be damaged if registration of Applicant's mark is granted.

COUNT IV -- Guard Master's PERFORMANCE SLEEP SHOP

Trademark and Registration

- 43) Each of paragraphs 1-6 are incorporated under this heading as if set out in full.
- 44) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark, Opposer has engaged in the business of, among other things, retail and online sales services featuring clothing, sleep accessories and bedding, and has identified such products under the service mark PERFORMANCE SLEEP SHOP. Opposer's use of said mark to identify its services has been continuous and uninterrupted.
- 45) Opposer sold bedding-related products under the service mark PERFORMANCE SLEEP SHOP in commerce at least as early as June 2012 and has used the PERFORMANCE SLEEP SHOP mark continuously since that time.
- 46) Opposer owns rights in the PERFORMANCE SLEEP SHOP trademark for the sale of bedding-related products.

- 47) Opposer is the owner of United States Registration No. 4,310,501 (“the ‘501 Registration”), registered on the Principal Register on 26 March 2013 for the PERFORMANCE SLEEP SHOP service mark as used in connection with retail and online sales services featuring clothing, sleep accessories and bedding in International Class 35.
- 48) The ‘501 Registration is valid and in full force and effect. The Principal Register registration is *prima facie* evidence of the validity of the registration, of Opposer's ownership of the mark and of its exclusive right to use the mark in commerce. Moreover, the registration is constructive notice to Applicant and all others of Opposer's claim of ownership of the marks. Opposer uses the symbol ® in association with its marks.
- 49) Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing its trademark so that the public has come to associate and attribute usage of the PERFORMANCE SLEEP SHOP service mark with Opposer.
- 50) The goods identified in Applicant’s application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 44) under the PERFORMANCE SLEEP SHOP mark, and to the goods listed in Opposer's ‘501 Registration, all of such goods being likely to travel through similar channels of trade.
- 51) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark in Applicant’s application includes at its leading word the identical word PERFORMANCE as Opposer’s PERFORMANCE SLEEP SHOP trademark.
- 52) The PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP mark for which Applicant seeks registration is confusingly similar to Opposer’s PERFORMANCE

SLEEP SHOP mark. Applicant's use of its applied-for mark on the goods recited in the Application will create a likelihood of confusion, mistake or deception among the trade and the purchasing public.

- 53) Opposer's PERFORMANCE SLEEP SHOP trademark has priority over Applicant's proposed PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark.
- 54) Opposer, as the owner of valid federal trademark registrations and as the prior user of such mark, will be damaged if registration of Applicant's mark is granted.

Conclusion

- 55) Each of paragraphs 1-6, 8-18, 20-30, 32-42 and 44-54 are incorporated under this heading as if set out in full.
- 56) In contravention to 15 U.S.C. §1052(d), the registration and use of the PERFORMANCE ENHANCED MATTRESS SOCIETY OF SLEEP trademark sought to be registered by Applicant is likely to cause confusion, mistake, and deception in the minds of the public and to lead the public to believe that Applicant's products and/or services have their source in Opposer or that in some way Opposer is endorsing or sponsoring such products and/or services, or that Opposer is in some way associated with Applicant in manufacturing and selling the products or providing the services so identified.
- 57) The registration of Applicant's mark in connection with the goods specified in Applicant's application would be in direct conflict with the proper function of a

trademark; that is, as a designation of the sole and exclusive origin of goods or services, considering Opposer's prior use of and registration of its marks.

- 58) If Applicant succeeds in registering its mark, there will be statutory rights created thereby in violation of the earlier established rights of Opposer, all to the harm of Opposer's goodwill and with the resultant diminution of Opposer's rights in its mark, all to the irreparable damage and injury of Opposer and of the public.

WHEREFORE, Opposer files this Notice of Opposition and prays that the Application herein opposed be denied; that registration of the mark therein disclosed be refused, and for such other and further relief in the premises as may be deemed to be just and proper.

The filing fee of \$300.00 is presented herewith.

Please recognize as Opposer's attorneys the following: Applicant hereby appoints Daniel A. Scola, Jr., Salvatore J. Abbruzzese, Ludomir A. Budzyn, John S. Sopko, Andrea M. Wilkovich, Sandy S. Zaradic, Ph.D., David J. Torrente, Stephen J. Brown, Mark E. Baron, Palaiyur S. Kalyanaraman, Ph.D., and Michael I. Chakansky, each of them of HOFFMANN & BARON, LLP, 6 Campus Drive, Parsippany, NJ 07054-4406 and Ronald J. Baron, Charles R. Hoffmann, Irving N. Feit, Glenn T. Henneberger, Anthony E. Bennett, James F. Harrington, Steven T. Zuschlag, Roderick S. Turner, Susan A. Sipos, Kevin E. McDermott, Lauren T. Emr, Linda D. Chin, Alexander G. Vodovozov, Perry Y. Woo, Betsy Kingsbury Dowd, Mark E. Baron, and Judy R. Naamat each of them of HOFFMANN & BARON, LLP, 6900 Jericho

Turnpike, Syosset, NY 11791, its attorneys herein, with full power of substitution and revocation, to transact all business in the U.S. Patent and Trademark Office and in the courts in connection herewith.

Please direct all correspondence to:

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Respectfully submitted,
Guard Master, Inc

By: / Ludomir A. Budzyn /
Ludomir A. Budzyn
David J. Torrente

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Attorneys for Opposer
Guard Master, Inc.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing is being sent via Federal Express on 22 April 2013 in an envelope addressed to:

Kevin M. Welch, Esq.
The Law Office of Kevin M. Welch
PO Box 494
Hermosa Beach, CA 90254-0494

By: / Ludomir A. Budzyn /
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Attorney for Opposer
Guard Master, Inc.