

ESTTA Tracking number: **ESTTA649363**

Filing date: **01/12/2015**

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	Bedgear LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	110 Bi-County Blvd, Suite 101 Farmingdale, NY 11735 UNITED STATES		

Attorney information	Leo G. Lenna Sorell, Lenna & Schmidt, LLP 99 Smithtown Bypass 2nd Floor Hauppauge, NY 11788 UNITED STATES rglanz@slsllp.com Phone:6316569818		
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Applicant Information

Application No	86428855	Publication date	12/23/2014
Opposition Filing Date	01/12/2015	Opposition Period Ends	01/22/2015
Applicant	Zinus Inc. 1951A Fairway Drive San Leandro, CA 94577 UNITED STATES		

Goods/Services Affected by Opposition

Class 020. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Mattress foundations; Mattresses 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	<p>PERFORMANCE MATTRESS PROTECTOR</p>		
Description of Mark	NONE		
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	<p>PERFORMANCE MATTRESS PROTECTION</p>		
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.	4583028	Application Date	07/25/2013
Registration Date	08/12/2014	Foreign Priority Date	NONE
Word Mark	BEDGEAR PERFORMANCE BEDDING		
Design Mark			
Description of	The mark consists of Intertwining swirls with the term "bedgear" positioned to		

Mark	the right and the term "performance bedding" positioned below the term "bedgear".
Goods/Services	Class 020. First use: First Use: 2013/02/15 First Use In Commerce: 2013/02/15 pillows and mattresses

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	<p style="text-align: center;">PERFORMANCE PILLOW</p>		
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	<p style="text-align: center;">PERFORMANCE SLEEP SHOP</p>		
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		

U.S. Registration No.	4586997	Application Date	05/24/2013
Registration Date	08/19/2014	Foreign Priority Date	NONE

Word Mark	PERFORMANCE TOPPER
Design Mark	PERFORMANCE TOPPER
Description of Mark	NONE
Goods/Services	Class 020. First use: First Use: 2012/01/28 First Use In Commerce: 2012/01/28 featherbed; mattress topper

U.S. Registration No.	4555046	Application Date	09/27/2013
Registration Date	06/24/2014	Foreign Priority Date	NONE

Word Mark	PERFORMANCE PILLOW PROTECTOR
Design Mark	PERFORMANCE PILLOW PROTECTOR
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 2012/02/14 First Use In Commerce: 2012/02/14 pillow protectors

U.S. Registration No.	4615949	Application Date	06/07/2013
Registration Date	10/07/2014	Foreign Priority Date	NONE
Word Mark	PERFORMANCE BASE LAYER		

Design Mark	<h1>Performance Base Layer</h1>
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 2012/01/16 First Use In Commerce: 2012/01/16 mattress protectors and pillow protectors

U.S. Registration No.	4592983	Application Date	02/26/2014
Registration Date	08/26/2014	Foreign Priority Date	NONE
Word Mark	PERFORMANCE WOOL		
Design Mark	<h1>PERFORMANCE WOOL</h1>		
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 2014/02/10 First Use In Commerce: 2014/02/10 Mattress toppers made in whole or significant part of wool Class 024. First use: First Use: 2014/02/10 First Use In Commerce: 2014/02/10 Bed sheets, bed blankets, duvets, comforters, mattress protectors, mattress covers, pillow protectors, pillow covers, crib mattress protectors, crib mattress covers and crib sheets, all of the foregoing made in whole or significant part of-wool		

Attachments	85227720#TMSN.png(bytes) 85227718#TMSN.png(bytes) 86019513#TMSN.png(bytes) 85227727#TMSN.png(bytes) 85575357#TMSN.png(bytes) 85941834#TMSN.png(bytes) 86076464#TMSN.png(bytes) 85953745#TMSN.png(bytes) 86204607#TMSN.png(bytes) Notice of Opposition PERFORMANCE PLUS.pdf(97770 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 First Class Mail on this date.

Signature	/Leo G. Lenna/
Name	Leo G. Lenna
Date	01/12/2015

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

In the Matter of Trademark Application Serial No. 86/428,855

Bedgear LLC.,

Opposer

v.

Opposition No. not assigned

Zinus Inc,

Applicant

NOTICE OF OPPOSITON

Bedgear LLC. (hereinafter "Opposer") hereby files a Notice of Opposition against Zinus Inc. (hereinafter "Applicant") regarding Applicant's pending Application for trademark registration of the trademark PERFORMANCE PLUS for "*Mattress foundations; Mattresses and pillows*" in International Class 20, with Serial No. 86/428,855 filed in the United States Patent and Trademark Office on October 20, 2014 (the "Application"). The Application was published in the Official Gazette on December 23, 2014. The time to file the Notice of Opposition expires January 23, 2015.

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 Bedgear LLC 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, Zinus Inc. is a California corporation with an address of 1951A Fairway Drive San Leandro California 94577.
- 3) Upon information and belief, Zinus Inc., is represented by in-counsel, at the address of 1951A Fairway Drive San Leandro California 94577.

Applicant's PERFORMANCE PLUS Application

- 4) Applicant seeks to register the trademark PERFORMANCE PLUS for "*Mattress foundations; Mattresses 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 PLUS in commerce.

COUNT I Likelihood of Confusion (15 U.S.C. § 1052(d))

- 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 PLUS 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 April 2, 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 PLUS trademark in Applicant's application includes the identical word PERFORMANCE as Opposer's PERFORMANCE MATTRESS PROTECTOR trademark.
- 16) The PERFORMANCE PLUS 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 PLUS 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
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 19) Each of paragraphs 1-18 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 PLUS 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") registered on the Principal Register on March 12, 2013 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 PLUS trademark in Applicant's application includes the

identical word PERFORMANCE as Opposer's PERFORMANCE MATTRESS PROTECTION trademark.

- 28) The PERFORMANCE PLUS 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 PLUS 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
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 31) Each of paragraphs 1-30 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 PLUS 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 April 2, 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 PLUS trademark in Applicant's application includes the identical word PERFORMANCE as Opposer's PERFORMANCE PILLOW trademark.
- 40) The PERFORMANCE PLUS 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 PLUS 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
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 43) Each of paragraphs 1-42 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 PLUS 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 March 26, 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 PLUS trademark in Applicant's application includes the identical words PERFORMANCE SLEEP as Opposer's PERFORMANCE SLEEP SHOP trademark.
- 52) The PERFORMANCE PLUS 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 PLUS 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.

COUNT V
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 55) Each of paragraphs 1-54 are incorporated under this heading as if set out in full.
- 56) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE PLUS 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 BEDGEAR PERFORMANCE BEDDING. Opposer's use of said mark to identify its services has been continuous and uninterrupted.

- 57) Opposer sold bedding-related products under the service mark BEDGEAR PERFORMANCE BEDDING in commerce at least as early as February 15, 2013 and has used the BEDGEAR PERFORMANCE BEDDING mark continuously since that time.
- 58) Opposer owns rights in the BEDGEAR PERFORMANCE BEDDING trademark for the sale of bedding-related products.
- 59) Opposer is the owner of United States Registration No. 4,583,028 ("the '028 Registration"), registered on the Principal Register on August 12, 2014 for the BEDGEAR PERFORMANCE BEDDING mark as used in connection with pillows and mattresses in International Class 20.
- 60) The '028 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.
- 61) 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 BEDGEAR PERFORMANCE BEDDING service mark with Opposer.

- 62) The goods identified in Applicant's application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 56) under the BEDGEAR PERFORMANCE BEDDING mark, and to the goods listed in Opposer's '028 Registration, all of such goods being likely to travel through similar channels of trade.
- 63) The PERFORMANCE PLUS trademark in Applicant's application includes the identical words PERFORMANCE as Opposer's BEDGEAR PERFORMANCE BEDDING trademark.
- 64) The PERFORMANCE PLUS mark for which Applicant seeks registration is confusingly similar to Opposer's BEDGEAR PERFORMANCE BEDDING 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.
- 65) Opposer's BEDGEAR PERFORMANCE BEDDING trademark has priority over Applicant's proposed PERFORMANCE PLUS trademark.
- 66) 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 VI
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 67) Each of paragraphs 1-66 are incorporated under this heading as if set out in full.
- 68) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE PLUS 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 TOPPER.

Opposer's use of said mark to identify its services has been continuous and uninterrupted.

- 69) Opposer sold bedding-related products under the service mark PERFORMANCE TOPPER in commerce at least as early as January 28, 2012 and has used the PERFORMANCE TOPPER mark continuously since that time.
- 70) Opposer owns rights in the PERFORMANCE TOPPER trademark for the sale of bedding-related products.
- 71) Opposer is the owner of United States Registration No. 4,586,997 ("the '997 Registration"), registered on the Principal Register on August 19, 2014 for the PERFORMANCE TOPPER mark as used in connection with featherbed and mattress topper in International Class 20.
- 72) The '997 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.
- 73) 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 TOPPER service mark with Opposer.
- 74) The goods identified in Applicant's application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 68) under PERFORMANCE TOPPER mark, and to the goods listed in Opposer's '997 registration, all of such goods being likely to travel through similar channels of trade.

- 75) The PERFORMANCE PLUS trademark in Applicant's application includes the identical words PERFORMANCE as Opposer's PERFORMANCE TOPPER trademark.
- 76) The PERFORMANCE PLUS mark for which Applicant seeks registration is confusingly similar to Opposer's PERFORMANCE TOPPER 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.
- 77) Opposer's PERFORMANCE TOPPER trademark has priority over Applicant's proposed PERFORMANCE PLUS trademark.
- 78) 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 VII
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 79) Each of paragraphs 1-78 are incorporated under this heading as if set out in full.
- 80) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE PLUS 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 PILLOW PROTECTOR. Opposer's use of said mark to identify its services has been continuous and uninterrupted.
- 81) Opposer sold bedding-related products under the service mark PERFORMANCE PILLOW PROTECTOR in commerce at least as early as February 14, 2012 and has used the PERFORMANCE PILLOW PROTECTOR mark continuously since that time.

- 82) Opposer owns rights in the PERFORMANCE PILLOW PROTECTOR trademark for the sale of bedding-related products.
- 83) Opposer is the owner of United States Registration No. 4,555,046 ("the '046 Registration"), registered on the Principal Register on June 24, 2014 for the PERFORMANCE PILLOW PROTECTOR mark as used in connection with pillow protectors in International Class 24.
- 84) The '046 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.
- 85) 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 PROTECTOR mark with Opposer.
- 86) The goods identified in Applicant's application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 80) under PERFORMANCE PILLOW PROTECTOR mark, and to the goods listed in Opposer's '046 registration, all of such goods being likely to travel through similar channels of trade.
- 87) The PERFORMANCE PLUS trademark in Applicant's application includes the identical words PERFORMANCE as Opposer's PERFORMANCE PILLOW PROTECTOR trademark.
- 88) The PERFORMANCE PLUS mark for which Applicant seeks registration is confusingly similar to Opposer's PERFORMANCE PILLOW 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.

- 89) Opposer's PERFORMANCE PILLOW PROTECTOR trademark has priority over Applicant's proposed PERFORMANCE PLUS trademark.
- 90) 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 VIII
Likelihood of Confusion
(15 U.S.C. § 1052(d))

- 91) Each of paragraphs 1-90 are incorporated under this heading as if set out in full.
- 92) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE PLUS 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 BASE LAYER. Opposer's use of said mark to identify its services has been continuous and uninterrupted.
- 93) Opposer sold bedding-related products under the service mark PERFORMANCE BASE LAYER in commerce at least as early as January 16, 2012 and has used the PERFORMANCE BASE LAYER mark continuously since that time.
- 94) Opposer owns rights in the PERFORMANCE BASE LAYER trademark for the sale of bedding-related products.
- 95) Opposer is the owner of United States Registration No. 4,615,949 ("the '949 Registration"), registered on the Principal Register on October 7, 2014 for the

PERFORMANCE BASE LAYER mark as used in connection with mattress protectors and pillow protectors in International Class 24.

- 96) The '949 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.
- 97) 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 BASE LAYER mark with Opposer.
- 98) The goods identified in Applicant's application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 92) under PERFORMANCE BASE LAYER mark, and to the goods listed in Opposer's '949 registration, all of such goods being likely to travel through similar channels of trade.
- 99) The PERFORMANCE PLUS trademark in Applicant's application includes the identical words PERFORMANCE as Opposer's PERFORMANCE BASE LAYER trademark.
- 100) The PERFORMANCE PLUS mark for which Applicant seeks registration is confusingly similar to Opposer's PERFORMANCE BASE LAYER 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.
- 101) Opposer's PERFORMANCE BASE LAYER trademark has priority over Applicant's proposed PERFORMANCE PLUS trademark.

102) 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 VIII
Likelihood of Confusion
(15 U.S.C. § 1052(d))

103) Each of paragraphs 1-102 are incorporated under this heading as if set out in full.

104) From a date prior to Applicant's filing date of the Application by Applicant for the PERFORMANCE PLUS 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 WOOL. Opposer's use of said mark to identify its services has been continuous and uninterrupted.

105) Opposer sold bedding-related products under the service mark PERFORMANCE WOOL in commerce at least as early as February 10, 2014 and has used the PERFORMANCE WOOL mark continuously since that time.

106) Opposer owns rights in the PERFORMANCE WOOL trademark for the sale of bedding-related products.

107) Opposer is the owner of United States Registration No. 4,592,983 ("the '983 Registration"), registered on the Principal Register on August 26, 2014 for the PERFORMANCE WOOL mark as used in connection with mattress toppers made in whole or significant part of wool in International Class 20 and bed sheets, bed blankets, duvets, comforters, mattress protectors, mattress covers, pillow protectors, pillow covers, crib mattress protectors, crib mattress covers and crib sheets, all of the foregoing made in whole or significant part of wool in International Class 20.

- 108) The '983 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.
- 109) 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 WOOL mark with Opposer.
- 110) The goods identified in Applicant's application are closely related to the goods marketed by Opposer (mentioned hereinabove in paragraph 104) under PERFORMANCE WOOL mark, and to the goods listed in Opposer's '983 registration, all of such goods being likely to travel through similar channels of trade.
- 111) The PERFORMANCE PLUS trademark in Applicant's application includes the identical words PERFORMANCE as Opposer's PERFORMANCE WOOL trademark.
- 112) The PERFORMANCE PLUS mark for which Applicant seeks registration is confusingly similar to Opposer's PERFORMANCE WOOL 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.
- 113) Opposer's PERFORMANCE WOOL trademark has priority over Applicant's proposed PERFORMANCE PLUS trademark.
- 114) 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 V
Likelihood of Dilution
(15 U.S.C. § 1125(c))

- 115) Each of paragraphs 1-54 are incorporated under this heading as if set out in full.
- 116) Opposer is a leading manufacturer and distributor of products in the bedding industry.
- 117) Opposer’s family of PERFORMANCE-formative marks (collectively “PERFORMANCE MARKS”) are the subject of the following United States Trademark registrations and applications, among others:

<u>MARK</u>	<u>REG./SERIAL NO.</u>	<u>REG./APP. DATE</u>	<u>GOODS</u>	<u>Date of First Use</u>
PERFORMANCE MATTRESS PROTECTOR	4,313,540	April 2, 2013	Mattress protectors	Oct. 30, 2007
PERFORMANCE MATTRESS PROTECTION	4,301,890	March 12, 2013	Pillow protectors and mattress protectors	March, 2010
BEDGEAR PERFORMANCE BEDDING	4,583,028	August 12, 2014	pillows and mattresses	Feb. 15, 2013
PERFORMANCE PILLOW	4,313,541	April 2, 2013	Pillows	Jan. 16, 2010
PERFORMANCE SLEEP SHOP	4,310,501	March 26, 2013	Retail and online sales services featuring clothing, sleep accessories and bedding.	June 1, 2012
PERFORMANCE TOPPER	4,586,997	August 19, 2014	Featherbed; mattress topper	Jan. 28, 2012
PERFORMANCE PILLOW PROTECTOR	4,555,046	June 24, 2014	Pillow protectors	Feb. 14, 2012
PERFORMANCE MATTRESS	85/836,148	January 30, 2013	Mattresses	ITU

PERFORMANCE BASE LAYER	4,615,949	Oct. 07, 2014	Mattress protectors and pillow protectors	Jan. 16, 2012
PERFORMANCE WOOL	4,592,983	August 26, 2014	Mattress toppers made in whole or significant part of wool. Bed sheets, bed blankets, duvets, comforters, mattress protectors, mattress covers, pillow protectors, pillow covers, crib mattress protectors, crib mattress covers and crib sheets, all of the foregoing made in whole or significant part of wool.	Feb. 10, 2014
PERFORMANCE BLANKET	86/451,637	Nov. 12, 2014	blankets and comforters	Nov. 01, 2014

- 118) Opposer has sold millions of dollars worth of its bedding and bedding related products and other goods under the PERFORMANCE MARKS and has spent millions of dollars in advertising and promoting goods under these marks.
- 119) As a result of Opposer's extensive marketing and promotion, coupled with the overwhelming commercial success of its bedding and bedding products and other goods offered under the PERFORMANCE MARKS, Opposer's PERFORMANCE MARKS have become famous.

120) Applicant's alleged mark PERFORMANCE PLUS incorporates Opposer's PERFORMANCE portion of the PERFORMANCE MARKS and is likely to cause dilution of Opposer's famous PERFORMANCE MARKS.

Conclusion

121) Each of paragraphs 1-60 are incorporated under this heading as if set out in full.

122) In contravention to 15 U.S.C. §1052(d), the registration and use of the PERFORMANCE PLUS 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.

123) 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.

124) 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.

125) Applicant's proposed registration and use of the mark PERFORMANCE PLUS, in connection with the goods set forth in the Application, is likely to cause dilution of Opposer's famous PERFORMANCE MARKS under section 43(c) of the Lanham

Act, 15 U.S.C. § 1125(c).

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 Leo G. Lenna, Peter B. Sorell, William D. Schmidt, Reine H. Glanz, Erik B. Zarkowsky, Kara M. McDermott and Michael Tsimaras of Sorell, Lenna & Schmidt 99 Smithtown Bypass, 2nd Floor, Hauppauge, New York, 11788, 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:

Dated: January 12, 2015

Respectfully submitted,

Bedgear, LLC

By: /Leo G. Lenna/

Leo G. Lenna, Esq.

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Attorney for Opposer

CERTIFICATE OF SERVICE

The undersigned does hereby certify that on January 12, 2015 a copy of the NOTICE OF OPPOSITION was served on Counsel for the Applicant on the date set forth below, by Prepaid First Class United States Mail to the following address:

ZINUS INC.
1951A FAIRWAY DR
SAN LEANDRO, CALIFORNIA 94577-5643

/Leo G. Lenna/
Leo G. Lenna