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

Proceeding	92054201
Party	Plaintiff Dan Foam ApS
Correspondence Address	AMY SULLIVAN CAHILL STITES HARBISON PLLC 400 WEST MARKET STREET , SUITE 1800 LOUISVILLE, KY 40202 3352 UNITED STATES acahill@stites.com
Submission	Opposition/Response to Motion
Filer's Name	Amy S. Cahill
Filer's e-mail	acahill@stites.com
Signature	/Amy S. Cahill/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

DAN FOAM APS	)	
	)	
Petitioner,	)	
	)	Cancellation No. 92054201
v.	)	
	)	
SLEEP INNOVATIONS, INC.,	)	
	)	
Registrant.	)	

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**PETITIONER’S RESPONSE TO REGISTRANT’S  
CROSS-MOTION FOR SUMMARY JUDGMENT**

Petitioner Dan Foam APS, by counsel, submits this response to Registrant’s cross-motion for summary judgment. The parties agree that no genuine issues of material fact remain in the case and that the matter is ripe for decision on dispositive motion.

***Petitioner’s Actual Confusion Evidence Is Overwhelming Evidence of Likely  
Confusion in Support of Summary Judgment for Petitioner***

Faced with unfavorable evidence, Registrant asks the Board to exclude significant actual confusion evidence in this case as a “sanction” for Petitioner’s service of a subpoena six business days after its issuance.<sup>1</sup> Registrant has waived any right to object to this oversight and certainly was not prejudiced by the *de minimus* delay.

Registrant was provided a copy of the subpoena directed to Overstock.com and all of the documents produced by Overstock.com on February 14, 2012 – over eight months ago. Registrant did not object to the discovery of Overstock.com documents upon their receipt, nor at any time during the discovery period in the form of a motion to exclude, motion to quash the

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<sup>1</sup> Petitioner served its Subpoena on Overstock.com on February 2, 2012. It provided a copy of the subpoena to counsel for Registrant in February 14, 2012, six business days later.

subpoena, or a motion for sanctions. After two extensions of time, the discovery period in this matter closed on June 10, 2012. Registrant waived its right to object to the service date of the subpoena by failing to raise any objection during discovery. *See* TBMP § 523.04 (a party cannot object to evidence that is failed to identify through a motion to compel discovery) and TBMP § 527.01(e)(procedure for motion to quash subpoena).

Registrant had ample opportunity to take a deposition of a representative of Overstock.com during the discovery period – specifically during the intervening four month period between disclosure of the Overstock.com documents and the close of discovery. It chose not to. Registrant claims that it did not know that Petitioner would rely on the Overstock.com documents in support of its arguments, but Petitioner *specifically identified the evidence produced by Overstock as evidence in support of Petitioner’s claims of actual confusion in its Answers to Registrant’s First Set of Interrogatories* served on Registrant on March 9, 2012. *See* Exhibit A to Petitioner’s Motion for Summary Judgment.

Registrant also argues that Petitioner obtained a “secret” affidavit from a representative of Overstock.com attesting to the authenticity of the business records it produced. However, this declaration was used for the purpose of establishing authenticity and admissibility of documents, not as evidence itself. There are a number of methods through which a party may rely on documents produced in discovery in connection with a summary judgment motion. TBMP § 525.05(a)(1)(Documents that are admissible include affidavits and declarations). The acceptability of a declaration is addressed clearly in TBMP § 525.05(b).<sup>2</sup> There is no

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<sup>2</sup> “Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant. However, an adverse party may have an opportunity for direct examination of the affiant, if a Fed. R. Civ. P. 56(d) motion to take the discovery deposition of the affiant is made and granted.” TBMP § 528.05(b).

requirement that a declaration in support of a summary judgment motion be produced in discovery. The requirements for reliance on documents in support of summary judgment are different from the requirements for authenticating documents in support of a party's trial brief. Registrant itself has provided sworn declarations in support of its Response to Petitioner's Motion for Summary Judgment, which declarations were not produced in discovery.

The evidence Petitioner subpoenaed from Overstock.com and produced to Registrant during discovery speaks for itself and is overwhelming proof that consumers who encounter Registrant's mark are likely to believe, and in fact do believe, that those products emanate from or are associated with Petitioner. To the extent Registrant challenges the reliability of the evidence, it was Registrant that chose not to take the deposition of representatives of Overstock.com in an effort to impeach this evidence (perhaps for fear that the evidence developed through such a deposition would be more harmful than helpful) and thus Registrant has waived any objection to its consideration by the Board.

***Third-Party Registered Marks Cited by Registrant Support Petitioner's Position***

Registrant identifies a number of registered marks that include *either* a reclining figure design *or* the word formative "PEDIC." *Registrant does not identify a single mark that includes both a reclining figure element and the word formative "PEDIC."*

Petitioner is not claiming the exclusive right to use or register either the reclining figure design or the word "PEDIC" in this proceeding. Rather, it is claiming the exclusive right to register both of these elements together as part of its trademark taken as a whole. Examples of third-party marks that include only one element of Petitioner's mark are not helpful to a determination of likely confusion. *Recot, Inc. v. Becton*, 54 USPQ2d 1894 (Fed. Cir. 2000); *China Healthways Institute, Inc. v. Wang*, 83 USPQ2d 1123 (Fed. Cir. 2007) ("The marks must

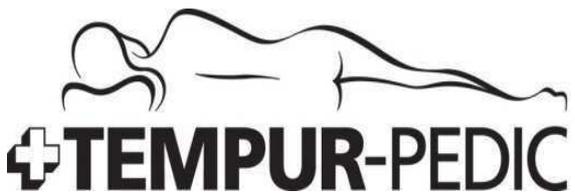
be compared in their entirety, at least when the overall commercial impression is reasonably based on the entirety of the marks.”). In fact, the lack of evidence showing even one registered mark sharing both elements not only undercuts Registrant’s contentions but also adds support to Petitioner’s claim that its mark is strong. *See Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007).

***Survey Evidence is Not Required in Board Proceedings and is Unnecessary Here***

Registrant makes much of the fact that Petitioner has not conducted a consumer survey to support its claims of likely confusion. However, a survey is never required and rarely provided in the context of an *inter partes* proceeding before the Board. As the Board noted in *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993), 27 USPQ2d at 1435-36, the absence of survey evidence does not permit a negative inference:

We appreciate the significant financial cost of surveys. Moreover, we obviously recognize the limited jurisdictional nature of Board proceedings, wherein only rights to federal registrability, not use, are determined. With these two thoughts foremost in our minds, we are not inclined to draw any negative inferences from a party's failure to offer survey evidence in a proceeding before the Board.

*Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007). Notably absent from Registrant’s cross-motion is a representation of the parties’ marks and goods, the comparison of which does not require a survey or expert.

PETITIONER	REGISTRANT
	
Seating and couching mats in the nature of a	Mattress toppers, pillows, mattresses in

pillow or seat liner, pillows, cushions, mattresses, top mattresses, bolsters and chair pads in International Class 20.	International Class 20.
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***Registrant’s Use of Petitioner’s Trademark as a “Key Word” is Relevant***

Sleep Innovations admitted during discovery that it regularly bids on TEMPUR-PEDIC as a key word to generate sponsored advertisements through Google’s AdWords program. While this practice itself has not been held to be unlawful, it certainly is evidence in support of a number of factors relevant to a finding of likely confusion. First, Registrant’s decision to bid on the TEMPUR-PEDIC mark as a key word to generate advertisements for its competing products proves that Sleep Innovations’ consumers and potential consumers are the same as, or overlap with, the consumers and potential consumers of Petitioner’s products. Second, Registrant’s decision to use Petitioner’s trademark in this fashion demonstrates’ Registrant’s awareness of Petitioner’s famous mark, and/or Registrant’s appreciation of the strength of that mark among consumers. Third, Registrant’s actions demonstrates that the parties enjoy overlapping trade channels for their products, namely commercial sales through the Internet that originate with Google’s search engine. In short, the result of this practice is that consumers who are looking to purchase goods on the Internet and enter “TEMPUR-PEDIC” into the Google search box may well be presented with an advertisement for Petitioner’s goods and link to a site to purchase them, alongside a “hit” for Petitioner’s own web site also selling goods online.

***The Commercial Impression Created by the Parties’ Marks is Always Relevant to a Determination of Likely Confusion***

Petitioner points out in its summary judgment motion that both Petitioner and Registrant use similar descriptions in marketing their products to consumers, namely, that the parties’ respective products are “made exclusively in the U.S.A.”, are constructed using multiple layers

of foam comprised of “open cell technology,” and come with a 20-year limited warranty. These facts (which are not disputed by Registrant) show not only how highly similar the parties’ respective products are (beyond merely being directly competing memory foam mattress and pillow products), but also show how consumers who encounter the marks in the marketplace will perceive the parties’ respective goods and marks.

***The Parties Enjoy Overlapping Trade Channels***

The evidence developed in this proceeding shows that both parties sell significant quantities of product directly to consumers via the Internet. This fact should not be minimized, particularly because the manner in which the parties’ marks are displayed online is significant to the commercial impression created by each.

The case Registrant cites in its cross-motion in an effort to minimize the importance of the Internet as a shared trade channel involves completely disparate goods that were not currently sold on the Internet and therefore is of little value here. The Opposer in *Parfums de Coeur, Ltd. v. Lazarus* sold body fragrances, while applicant sought to register an arguably similar mark in connection with an animated television series. The Board in finding no likely confusion between the marks noted that the fact that “Applicant’s television series *might be promoted* through the Internet” was insufficient to support a finding of likely confusion writing:

We also note opposer's point that it promotes and sells its products through the Internet, and that applicant's television series might be promoted through the Internet, such as through a website for a cable channel on which the television series would appear.

83 USPQ2d 1012, 1022. In contrast, Petitioner and Registrant actually do sell significant quantities of merchandise through the Internet, as documented in Petitioner’s Motion for Summary Judgment. This taken together with Registrant’s use of Petitioner’s mark in its online

marketing efforts as described above leave little doubt that the parties' consumers are traveling the same channels in search of and for acquisition of their goods.

Accordingly, Petitioner respectfully requests that Petitioner's Motion for Summary Judgment be granted, that Registrant's Cross-Motion for Summary Judgment be denied, and that Registrant's Registration No. 3,916,902 be cancelled.

Respectfully submitted,

s/Amy Sullivan Cahill  
Amy Sullivan Cahill  
[acahill@stites.com](mailto:acahill@stites.com)  
STITES & HARBISON PLLC  
400 West Market Street, Suite 1800  
Louisville, KY 40202-3352  
Telephone: 502-587-3400  
Facsimile: 402-587-6392

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing was served on counsel for Registrant, this 17th day of October, 2012, by sending same via First Class Mail, postage prepaid, to:

Irene Hurtado  
Robert W. Smith  
MCCARTER & ENGLISH LLP  
Four Gateway Center  
100 Mulberry Street  
Newark, New Jersey 07102

s/Amy Sullivan Cahill

DI65:42033:902105:1:LOUISVILLE