ESTTA Tracking number: **ESTTA503996**
Filing date: **11/06/2012**

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

Proceeding	92054201
Party	Defendant Sleep Innovations, Inc.
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Date	11/06/2012
Attachments	Registrant's Reply Brief in Further Support of Cross-Motion for Summary Judgment.pdf (11 pages)(476961 bytes)

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

In the Matter of Registration No. 3,916,902
For the Mark: BODIPEDIC (& Design)
Registration Date: February 8, 2011

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

REGISTRANT'S REPLY BRIEF IN FURTHER SUPPORT OF REGISTRANT'S CROSS-MOTION FOR SUMMARY JUDGMENT

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PRELIMINARY STATEMENT

Registrant Sleep Innovations, Inc. ("Registrant") submits this reply brief in further support of Registrant's Cross-Motion[1] for Summary Judgment (the "Cross-Motion"). Registrant incorporates by reference herein all arguments made and legal authority cited in its Moving Brief. As argued in Registrant's Moving Brief, there are no genuine issues of material fact. When the law is applied to the undisputed facts, entry of summary judgment in favor of Registrant, not Petitioner, is warranted.

ARGUMENT

I. The Log Should Be Excluded As A Sanction For Petitioner's Violation Of Rule 45

The notice requirement of Rule 45 is plain, as is Petitioner's violation of that requirement. Petitioner incredibly argues that its twelve day delay in serving notice of the Subpoena (incorrectly characterized by Petitioner as spanning 6 business days), only after it received responsive documents, constituted a "*de minimus* [sic] delay." Petitioner's Response to Registrant's Cross-Motion For Summary Judgment ("Pet. Response") at 1. This argument is inconsistent with Rule 45, the Advisory Committee Notes to the Amendment to Rule 45, and the cases and authorities interpreting the notice requirements of the rule.

The law is clear that evidence obtained by a subpoena without notice can be excluded. See 9-45 Moore's at § 45.21[3][a]. The timeline, detailed in Registrant's Brief, speaks for itself and unquestionably evidences willful deception on the part of Petitioner. See Smith Decl., Exs. F, G, H, and I. Petitioner's willful conduct is directly related to the Log, which Petitioner seeks to rely upon in support of its Motion.

[1] Terms previously defined in Registrant's Brief in Opposition to Petitioner's Motion for Summary Judgment and in Support of Registrant's Cross-Motion for Summary Judgment ("Registrant's Brief") are used herein without further explanation.

Petitioner's contention that Registrant has "waived" its right to object to the Log is erroneous. The TBMP makes clear that the Board will not "make prospective or hypothetical evidentiary rulings." Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 527.01(f) Third Edition, Revision 1 (June 2012) ("[T]he Board will deny a motion to prospectively exclude evidence that might be introduced at trial."). The TBMP specifies that "[r]ather than requesting a discovery sanction prospectively, the better practice is to file a motion to strike or otherwise object to such evidence after it is introduced." Id. Registrant did just that, waiting until Petitioner sought to introduce the Log to seek its exclusion.

Petitioner's contention that Registrant should have filed a motion to quash is likewise flawed and ignores the plain language of Rule 45, which details the circumstances in which a motion to quash must be made and those in which such a motion can be made. Notably, failure of the serving party to provide the required notice under Rule 45 is not a mandatory or permissive basis for a motion to quash. See Fed. R. Civ. P 45(c)(3)(A) and (B). In addition, Registrant lacked standing to file a motion to quash the nonparty subpoena. See Smith v. Midland Brake, Inc., 162 F.R.D. 683, 685 (D. Kan. 1995). Moreover, Registrant received notice of the Subpoena at the same time it received Overstock.com's production of responsive documents, making a motion to quash impractical and procedurally untimely.

II. The Record Is Devoid Of Probative Evidence Of Actual Confusion

As discussed above and in Registrant's Brief, Petitioner should be precluded from relying upon the Log based upon Petitioner's violation of Rule 45. In any event, however, the Log is inadmissible hearsay that should be disregarded based upon Petitioner's failure to adduce testimony or a declaration sufficient to establish that the Log constitutes a business record under F.R.E. 803(6). See, e.g., Craddock-Terry Shoe Corp. v. Adorence Co, Inc., 1982 TTAB LEXIS

137, at *6-7 (T.T.A.B. Apr. 9, 1982). Indeed, in its opposition, Petitioner has failed to come forward with any argument as to why the Log is an admissible business record. Petitioner's contention that Registrant has waived its right to object to the relevance of the Log or on grounds that it is otherwise inadmissible because Registrant did not depose Overstock.com is preposterous as objections on grounds of relevance and admissibility are always preserved for trial. See 7-30 Moore's Federal Practice - Civil § 30.43.

Petitioner's general contention that Registrant waived its right to object to the Log because Registrant did not depose Overstock.com is unsupported by a shred of legal authority. Indeed, as the proponent of the evidence, Petitioner — not Registrant — had the burden to depose Overstock.com or otherwise establish the relevance and admissibility of the Log. Petitioner's failure to do so suggests a fear on Petitioner's part that the testimony would likely be more harmful than helpful with regard to its purported evidence of actual confusion.

Even if the Board chooses to consider the Log, the Log has virtually no probative value because the alleged incidents of "actual confusion" are "unexplained and unclear." Hi-Country Foods Corp. v. Hi Country Beef Jerky, 4 U.S.P.Q.2d 1169, 1172 (T.T.A.B. 1987); see also Duluth News-Tribune v. Mesabi Publ'g Co., 84 F.3d 1093, 1098 (8th Cir. 1996). Here, the Log contains no reference to Petitioner's Mark or Registrant's Mark. Not a single caller references the design element of either party's mark as causing confusion on the consumer's part. Pet. Brief, Ex. S. The communications only reference the word marks TEMPUR-PEDIC and/or BODIPEDIC. See id. As noted above, Registrant's BODIPEDIC word mark is not challenged in this proceeding and is the subject of an incontestable registration.

The communications in the Log do not reference either Petitioner's Mark or Registrant's Mark that is the subject of this proceeding, and thus the Log cannot possibly be evidence of

actual confusion between the parties' marks. It is simply impossible to discern from the Log the reason for the consumers' inquiries. Not surprisingly, Petitioner has failed to identify anywhere in the Log that refers to the marks at issue, or to explain exactly how it evidences actual confusion between the parties' marks. As such, the Log is of virtually no probative value. See Hi-Country Foods, 4 U.S.P.Q.2d at 1172.

The Log is also not probative evidence of actual confusion because the Log is undated and there is no evidence by way of testimony or affidavit to determine the period over which the communications in the Log occurred. See Pet. Brief, Ex. S. Here, even if the "confusion" reflected in the Log could be attributed to Registrant's Mark, it is impossible to tell whether those instances occurred in the month prior to production of the Log in response to the Subpoena, or in the three years since adoption of Registrant's Mark in April 2009. This is also undisputed. Given the lack of evidence of actual confusion, this factor weighs in favor of Registrant, not Petitioner.

III. There Is No Likelihood Of Confusion

There is no likelihood of confusion between Registrant's Mark and Petitioner's Mark because: (1) the overall commercial impressions of the marks are very different, (2) Petitioner's Mark is weak and therefore entitled to only a very limited scope of protection, (3) there is a lack of any evidence of a likelihood of confusion between the parties' marks, much less any probative evidence of actual confusion, as discussed above, and (4) buyers carefully consider purchases of the parties' products, which are relatively expensive. See In re E.I. DuPont DeNemours & Co., 476 F.2d 1357 (C.C.P.A. 1973); see also Bose Corp. v. QSC Audio Prods., 293 F.3d 1367, 1370 (Fed. Cir. 2002).

A. The Overall Commercial Impressions Of The Marks Are Different

Confusion between Registrant's Mark and Petitioner's Mark is not likely because when the marks are considered in their entireties, the overall commercial impressions of the parties' respective marks are vastly different.

1. The First Terms Of The Marks Are Visually And Aurally Distinct

Although marks are considered in their entireties, "when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods." In re TSI Brands, 67 U.S.P.Q.2d 1657 (T.T.A.B. 2002). As such, the dominant word portions of the parties' marks — the terms BODIPEDIC and TEMPUR-PEDIC — should be given the most weight in determining the marks' commercial impressions and assessing the similarity of the marks. See In re Chatam Int'l Inc., 380 F.3d 1340, 71 U.S.P.Q.2d 1944, 1946 (Fed. Cir. 2004). The terms BODIPEDIC and TEMPUR-PEDIC are visually and aurally distinct and have distinct commercial impressions, precluding a finding of likelihood of confusion. Further, Registrant owns an incontestable registration for the BODIPEDIC word mark, which has been used in commerce since February 2003. Thus, Registrant has already developed rights in that mark, which has coexisted with Petitioner's TEMPUR-PEDIC marks for almost ten years.

The fact that the marks share one term — PEDIC — is not dispositive, as similarity is based on the total effect of the marks, rather than a comparison of any individual features. See In re Sweet Victory Inc., 228 U.S.P.Q. 959, 961 (T.T.A.B. 1986). Here, the Board should consider the effect of all terms and elements included in the mark, including terms other than the term PEDIC that is in Petitioner's Mark and including the design elements, discussed in detail in

Registrant's Brief and below. See New England Fish Co. v. The Hervin Co., 179 U.S.P.Q. 743 (T.T.A.B. 1973).

The first terms of the marks — BODI and TEMPUR — and thus the marks as a whole, are quite distinct in sound, appearance, and meaning. Furthermore, the fact that the *first* terms of the marks are different is significant because the first portions of marks are likely to be most prominent in the eyes of the consumer. See Pikle-Rite Co., Inc. v. Chicago Pickle Co., 171 F. Supp. 671, 675 (N.D. Ill. 1959).

2. The Differences In The Respective Design Elements Of The Parties' Marks Create Distinct Overall Commercial Impressions And Petitioner's Mark Is Weak

The many distinctions — which Petitioner ignores — between the designs in Registrant's Mark and Petitioner's Mark, as detailed in Registrant's Brief, result in marks that have different overall commercial impressions. As a result, there is no likelihood of confusion.

As detailed in Registrant's Brief, the reclining figure design in Petitioner's Mark depicts the full figure, from head to toe, of a naked woman, reclining on a contour pillow. Smith Decl., Ex. C[2]. The woman has long hair, and her anatomical features (*e.g.*, buttocks, vertical indentation at the spine) are depicted. See id. The woman is oriented with her head at the beginning of the Mark, and her body is parallel to and stretches the length of the words TEMPUR-PEDIC. See id. Petitioner's Mark also includes a prominent cross or plus sign design that precedes the word TEMPUR-PEDIC. See id.

In contrast, the design in Registrant's Mark suggests only a partial human figure that is gender neutral. Smith Decl., Ex. A. The design is stylized and abstract, with no anatomical features depicted, in stark contrast to Petitioner's Mark. See id. The figure depicted in

[2] Contrary to Petitioner's assertions, Registrant included depictions of both parties' marks as exhibits to the Smith Declaration at Exhibits A and C.

Registrant's Mark does not have hair, is not reclining on a pillow, and is oriented with its head at the end of the mark, with its body at a partial angle and stretching over only the letters "IPED". See id. In contrast to Petitioner's Mark, Registrant's Mark contains no cross or plus sign figure, and the figures are quite different as discussed at length in Registrant's Brief. See id. Petitioner indeed admitted to many of these distinctions between the parties' marks. See id., Ex. L at 167:22-172:25.

These distinctions, as well as the ambiguity of the Registrant's design (*e.g.*, whether the abstract depiction is male or female, naked or clothed), make it unlikely that this design would cause confusion with Petitioner's Mark. See Cardinal Indus., Inc. v. Cardinal IG Co., 223 U.S.P.Q. 732, 735-36 (T.T.A.B. 1984).

In addition, Petitioner's Mark is weak because both the term that is common in the marks — PEDIC — and the reclining figure design, are weak due to widespread third party use in connection with goods in Class 20. See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). As such, Petitioner's Mark is entitled to only a narrow scope of protection. See id.

B. Consumers Carefully Consider Purchases Of The Parties' Goods

Petitioner does not dispute that purchasing a mattress is a decision to which consumers give much consideration, not one that they make on impulse as mattresses are relatively expensive items that are purchased infrequently. See Dreamwell, Ltd. v. Kittrich Corp., 2011 TTAB LEXIS 123 (T.T.A.B. Mar. 29, 2011). Mattresses impact a consumer's sleep and therefore affect a consumer's health and well-being, making the purchase of a mattress one in which consumers typically give significant consideration to the brands and features of different

mattresses before purchasing one, making consumer confusion unlikely. See id.

Where expensive goods or services are purchased by discriminating buyers after careful consideration and a long buying cycle, the likelihood that purchasers will be confused is nil. See In re Software Design, Inc., 220 U.S.P.Q. 662, 663 (T.T.A.B. 1983); TMEP § 1207.01(d)(vii). Registrant's Goods range in price from $29.99 to $699, while Petitioner's Goods range in price from $49 to over $7,000. Smith Decl., Exs. K at 66:1-21; Ex. L at 112:8-116:23. Confusion is not likely here because the goods at issue are relatively expensive and are purchased only after careful consideration.

D. The Petitioner's Argument That Trade Channels Overlap Because Both Parties Sell On The Internet Should Be Ignored

Contrary to Petitioner's assertions, "the mere fact that goods . . . may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade. The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet." Parfums de Coeur, Ltd. v. Lazarus, 83 U.S.P.Q.2d 1012 (T.T.A.B. 2007).

On the issue of Internet sales, Petitioner failed to allege anything more than the general fact that both parties offer their products on the Internet. Petitioner did not point to a single website through which both Petitioner and Registrant sold or advertised their products. Id. Petitioner's products are not sold on Overstock.com, which is the primary channel of trade for Registrant's products. Petitioner's argument that the channels of trade overlap in part because the products of both parties are sold on the Internet should be disregarded by the Board. As the Board is well aware, everything from socks to sailboats can be purchased on the Internet. The mere fact that both parties' goods are sold on the Internet does not demonstrate an overlap in trade channels.

IV. Petitioner's Remaining Arguments Lack Merit

Petitioner continues to make much of the fact that for a period of time Registrant bid on the word TEMPUR-PEDIC as a keyword through Google's sponsored advertising program, Pet. Brief at 8-9, arguing that this evidences Registrant's awareness of Petitioner's "famous mark, and/or Registrant's appreciation of the strength of that mark among consumers." Pet. Response at 5. That is plainly wrong: it is not possible to bid on a design element for Google's sponsored advertising program. Thus, evidence concerning Registrant's efforts to bid on the **word** TEMPUR-PEDIC has no relevance to consumer recognition of Petitioner's Mark that is the subject of this proceeding.

Under the heading "The Commercial Impression Created by the Parties' Marks is Always Relevant to a Determination of Likely Confusion," Petitioner identifies a number of statements that both parties make about their goods, such as "made exclusively in the U.S.A.," and references to "open cell technology" and a "20-year limited warranty." Registrant does not contest that the parties' goods are similar, and thus, the fact that both parties use similar descriptive phrases in advertising them is not surprising. Contrary to Petitioner's assertion, however, these commonalities have nothing to do with the commercial impression of the marks as perceived by consumers. See 5-5 Anne Gilson LaLonde, Gilson on Trademarks § 5.03 (Matthew Bender 2012) (explaining commercial impression of allegedly infringing mark is determined by examining the trademark itself in its entirety, including all of its component parts, not its dissected parts).

CONCLUSION

In view of the foregoing, Registrant's Cross-Motion for Summary Judgment should be granted, and the Cancellation should be dismissed with prejudice.

Dated: November 6, 2012

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CERTIFICATE OF FILING AND SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing reply brief in further support of Registrant's Cross-Motion for Summary Judgment was electronically filed with the Trademark Trial and Appeal Board, and served on counsel for Petitioner by regular mail on the 6th day of November, 2012, as follows:

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