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

Proceeding	92054201
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**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.)	

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REGISTRANT'S TRIAL BRIEF

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PRELIMINARY STATEMENT

Petitioner Dan Foam ApS (“Petitioner”) seeks to cancel Registrant Innocor, Inc. f/k/a Sleep Innovations, Inc.’s (“Registrant”) registration for its BODIPEDIC & Design mark in Class 20, alleging that this mark is confusingly similar to Petitioner’s TEMPUR-PEDIC & Design mark. Registrant, however, owns an incontestable federal registration for the word mark BODIPEDIC in connection with goods in Class 20, which Petitioner has not challenged. Registrant’s prior existing registration for a substantially similar mark covers the same or substantially identical goods as those covered by Registrant’s BODIPEDIC & Design mark.

In addition, PEDIC-formative marks abound on the Principal Register in Class 20, as do marks that include a reclining figure, and many of such marks are in use in commerce. Petitioner does not have an exclusive right to use either of these elements. Petitioner’s rights in its mark are therefore weak, and its mark is only entitled to a narrow scope of protection. Registrant’s Mark should be permitted to coexist.

Such weakness of Petitioner’s mark, together with the differences in the parties’ marks, warrants entry of judgment in Registrant’s favor. Indeed, the parties’ marks have distinct and distinguishable commercial impressions based upon the inclusion of dominant terms that are wholly dissimilar and design elements that are not confusingly similar. Based upon the admissible evidence before this Board, judgment should be entered in favor of Registrant.

DESCRIPTION OF THE RECORD

By operation of Trademark Rule 2.122, 37 CFR § 2.122, the Record includes the pleadings in this proceeding, the file history for Registrant’s Mark, and Petitioner’s pleaded registrations.

In addition to these materials and the materials identified in Petitioner's Brief at pages 2-3 (subject to certain evidentiary objections discussed below), the record includes the following additional evidence offered by Registrant during its testimony period:

- Testimony Deposition of Lisa Thorstenson, taken on July 23, 2014, with exhibits, filed with Notice of Filing of Certified Deposition Transcript on August 19, 2014 ("Thorstenson Testimony Dep.");
- First Notice of Reliance, filed on August 14, 2014, ("First NOR") attaching:
 - Exhibit A Joint Motion for Approval of Stipulation, dated and filed November 18, 2013
 - Exhibit B Order Approving Stipulation, dated January 8, 2014
 - Exhibit C Title and Status Copy of U.S. Reg. No. 3,916,902, BODIPEDIC (& Design) mark
 - Exhibit D Title and Status Copy of U.S. Reg. No. 3,137,309, BODIPEDIC word mark
 - Exhibit E Registration file for U.S. Reg. No. 3,137,309, BODIPEDIC word mark
 - Exhibit F Third party registrations for PEDIC formative marks, printed from U.S.P.T.O. TSDR database
 - Exhibit G Third party registrations for reclining figure marks, printed from U.S.P.T.O. TSDR database
 - Exhibit H Documents produced by the parties during discovery and authenticated pursuant to the Stipulation.
 - Exhibit I Documents produced by the parties during discovery and authenticated pursuant to the Stipulation.
- Second Notice of Reliance Attaching Confidential Materials Filed Under Seal, filed on August 14, 2014, ("Second NOR") attaching:
 - Exhibit J Discovery Deposition of Lisa Thorstenson, with Exhibits 1-42
 - Exhibit K Discovery Deposition of Dan Setlak, with Exhibits 1-32

Exhibit L Discovery Deposition of Sharon Miller, with Exhibits 1-15

Exhibit M Discovery Deposition of Michael Loomis, with Exhibits 1-16

STATEMENT OF FACTS

A. Undisputed Facts

1. The Parties' Respective Marks and Goods

Registrant owns U.S. Registration No. 3,916,902 for the BODIPEDIC and Design mark ("Registrant's Mark"), depicted below, in connection with mattress toppers, pillows and mattress, in Class 20 ("Registrant's Goods"). Petition for Cancellation (the "Petition"), ¶ 5, Docket Entry No. 1; Answer to Petition to Cancel ("Answer"), ¶ 5, Docket Entry No. 4; see First NOR, Ex. C.



The registration for Registrant's Mark issued on February 8, 2011, without objection from Petitioner. See Prosecution file for Registrant's Mark. Similarly, Petitioner's TEMPUR-PEDIC and Design mark, which is the subject of U.S. Registration No. 3,900,919 ("Petitioner's Mark"), was not cited as an obstacle by the Patent and Trademark Office. Id.

On July 1, 2011, Petitioner filed the Petition seeking cancellation of Registrant's Mark based upon Petitioner's claim that Petitioner has priority and that Registrant's Mark is confusingly similar to Petitioner's Mark. See Petition, ¶¶ 10-11, Docket Entry No. 1. Petitioner's Mark registered on January 4, 2011.

Registrant also owns U.S. Registration No. 3,137,309 for the word mark BODIPEDIC, in connection with mattress toppers, pillows, chair and chair cushions, in Class 20. First NOR, Ex.

D. The BODIPEDIC word mark has been registered since August 29, 2006, based on use in

commerce since at least as early as February 2003, and is now incontestable. Id. Petitioner has not challenged the registration for the BODIPEDIC word mark. See First NOR, Ex. E.

Registrant manufactures and sells memory foam mattresses, pillows and mattress toppers in connection with the Registrant's Mark. See Second NOR, Ex. J at 32:5-12. Products offered under Registrant's Mark are presently sold only via the Internet. Id. at 56:13-25; 67:2-19. For a brief period, Registrant offered a mattress in Costco club stores. Id. at 67:20-5. Registrant's Goods offered under the BODIPEDIC brand do not bear Registrant's Mark on packaging or labels affixed to the products. Id. at 35:5-37:7. As such, when Registrant's Goods are offered via the Internet, Registrant's Mark only appears on the webpage advertising Registrant's Goods. When Registrant offered its mattress under Registrant's Mark in Costco, Registrant's Mark only appeared on a point-of-sale display. Id. at 116:24 -117:24.

Petitioner manufactures and sells memory foam mattresses, pillows, and other products under its TEMPUR-PEDIC and Design Mark. Second NOR, Ex. K at 19:3-16 and 62:23-25.

2. The Overstock.com Compilation and the Testimony of Jane Martin

During the discovery period, Petitioner served a subpoena dated February 2, 2012 upon Overstock.com, Inc. seeking production of documents (the "Subpoena"). On February 10, 2012, Overstock.com produced a single document in response to the Subpoena, a compilation of communications between Overstock.com employees or Overstock's third party customer service representatives and purported consumers (the "Compilation"). The Compilation includes a purported communication between an individual named Jane Martin and an Overstock.com representative. Testimony Deposition of Victoria Neeshan submitted by Petitioner ("Neeshan Testimony Dep."), Exhibit 8 thereto, (see entry number 5035089, pages 52-53)¹. Despite not

¹ Petitioner filed the transcript of Ms. Neeshan's testimony deposition and all of its other testimony depositions under seal. As a result, it is unclear whether Petitioner filed with the Board the complete transcripts of any of its

identifying Ms. Martin in its Initial Disclosures or its original Pretrial Disclosures, Petitioner sought leave, fourteen days before the close of Petitioner's testimony period, to amend its Pretrial Disclosures to identify Ms. Martin as a witness and the Board granted that request. On May 1, 2014, Petitioner took Ms. Martin's testimony deposition. See Testimony Deposition of Jane Martin submitted by Petitioner ("Martin Testimony Dep."), Docket Entry No. 65.

3. Similarity of the Marks

Contrary to Petitioner's assertions, the marks are not confusingly similar. Registrant's Mark includes the term BODIPEDIC, which is the subject of an incontestable federal registration. First NOR, Exs. C and D. Petitioner's Mark includes the term TEMPUR-PEDIC. Id., Ex. C. While both marks share the term PEDIC, numerous third parties own registrations for trademarks that include the term PEDIC and cover mattresses, pillows, mattress toppers, and related goods in Class 20, and there is evidence that many of these marks are in use in commerce. Id., Ex. F; Thorstenson Testimony Dep., 6:5-8:17 and Exhibits 43-45 thereto. The dominant portion of both parties' spoken marks — BODI and TEMPUR — are distinguishable in sound, appearance and meaning. See First NOR, Ex. C and Second NOR, Ex. K at Exhibit 9 thereto.²

The only other common element the marks share is the depiction of a reclining figure. See id., First NOR, Ex. C and Second NOR, Ex. K at Exhibit 9 thereto. There are numerous federally registered marks that include a reclining figure and cover goods in Class 20, which are also in use in commerce. See First NOR, Ex. G; Thorstenson Testimony Dep., 6:5-8:17 and

testimony depositions, with all exhibits, as required by 37 C.F.R. §2.125(h). As argued below, to the extent that Petitioner failed to file with the Board the complete transcripts of its testimony depositions of Ms. Neeshan, Mohican Lane, and Jane Martin, with all exhibits, Registrant objects and requests that such incomplete testimony depositions be disregarded.

² As argued below, Petitioner has failed to make its TEMPUR-PEDIC registration of record in this proceeding. See 37 C.F.R. § 2.122(d).

Exhibits 43-45 thereto.

The designs included in the parties' respective marks are not confusingly similar. See First NOR, Ex. C and Second NOR, Ex. K at Exhibit 9 thereto; and Second NOR, Ex. K at 167:22-172:22. Petitioner's Mark includes a prominent cross or plus sign design element, followed by the word mark TEMPUR-PEDIC. Second NOR, Ex. K at 168:23-169:2. The figure of a reclining female extends across the entirety of the word TEMPUR-PEDIC. Second NOR, Ex. K at Exhibit 9 thereto; Second NOR, Ex. K at 168:7-10 and 168:18-22. On the spectrum of realism to abstraction, the female figure included in Petitioner's Mark is more realistic than it is abstract. See Second NOR, Ex. K at Exhibit 9 thereto. The design portion of Petitioner's Mark consists of seven lines or strokes. See id. The female figure in Petitioner's Mark is laying on her left side, depicted from head to foot and parallel to the word portion of Petitioner's Mark. Id. She is unclothed, with her head pointed to the left and directly over the letters TE in the TEMPUR-PEDIC word mark. Second NOR, Ex. K at Exhibit 9 thereto; Second NOR, Ex. K at 168:15-17 and 169:17-20. She has long hair draped over the contour pillow on which her head rests. Second NOR, Ex. K at Exhibit 9 thereto; Second NOR, Ex. K at 167:25- 168:6. The female's spine and buttocks are unmistakably represented. Second NOR, Ex. K at Exhibit 9 thereto. In addition, the female's two legs are plainly illustrated, with the top right leg crossed in front of the bottom left leg, and the left, bottom foot plainly visible. Second NOR, Ex. K at Exhibit 9 thereto; Second NOR, Ex. K at 168:11-14.

Registrant's Mark, in stark contrast, is highly abstract on the spectrum of realism to abstraction, consisting of only three lines or strokes. First NOR, Ex. C. The strokes merely suggest an ideational anthropomorphic figure and, unlike Petitioner's Mark, begin in the middle of the word portion of the mark, with the hip of the figure slicing into the letter I of "BODI", and

extending upward to the right at an angle across the letters PED, with the figure's head resting over the letter D of "PED". First NOR, Ex. C and Second NOR, Ex. K at 171:15-23. In contrast with Petitioner's Mark, the figure is not parallel to the word portion of Registrant's Mark, and its head points to the right, not the left. First NOR, Ex. C and Second NOR, Ex. K at 170:22-171:1. Further, there is no pillow depicted in Registrant's Mark. First NOR, Ex. C and Second NOR, Ex. K at 169:25-170:2.

The figure included in Registrant's Mark is abstract to the point that it is gender neutral, and it is inconclusive as to whether the figure is clothed. First NOR, Ex. C. Apart from strokes that suggest the outline of a partial head, partial chin and torso, there are no other anatomical elements depicted. First NOR, Ex. C. In contrast to Petitioner's Mark, the figure in Registrant's Mark does not include hair, a spine, buttocks, full legs or any feet. First NOR, Ex. C and Second NOR, Ex. K at 170:20-21. Instead, the figure in Petitioner's Mark depicts a human torso from shoulder to the bottom of the hip, with the figure's head turned slightly to its left side and tilted downward, such that the line of the chin is revealed. See First NOR, Ex. C.

4. Likelihood of Confusion and Actual Confusion

Despite its burden, the record presented by Petitioner is devoid of any evidence of likely confusion between the parties' marks. Notably, Petitioner did not retain an expert or conduct any likelihood of confusion survey in this matter. Second NOR, Ex. K at 45:24-46:6. Petitioner submits the Compilation produced by Overstock.com as purported evidence of actual consumer confusion between Petitioner's Mark and Registrant's Mark. See Neeshan Testimony Dep., Exhibit 8 thereto, Docket Entry No. 68. However, the Compilation consists of undated entries of conversations between Overstock.com representatives with individuals who are unnamed or incompletely identified. Not one entry within the Compilation refers to Petitioner's

Mark asserted herein or Registrant's Mark that is challenged in this proceeding. See id. The source of consumer confusion is unclear from any of the communications reflecting alleged actual confusion. See id. The only references made by customers in the communications reflected in the Compilation are to the parties' respective word marks — BODIPEDIC and TEMPUR-PEDIC. See id. There are no references to designs of any kind. See id. As noted by the Board in its decision on the parties' cross motions for summary judgment, the Compilation "is of little probative value in the absence of testimony from the customers themselves as to whether they were confused and, if so, what caused their confusion. See Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc., 2 U.S.P.Q.2d 1682, 1690-1 (TTAB 1987) (testimony regarding alleged incidents of third-party confusion is of little probative value in the absence of testimony from the third parties themselves)." See Board's May 13, 2013 Decision and Order, Docket Entry No. 42.

During its testimony period, Petitioner took the testimony of Ms. Martin, one of the individuals whose communications with Overstock.com appeared in the Compilation, but that testimony is not probative of likelihood of confusion. Contrary to Petitioner's mischaracterizations, the testimony of Ms. Martin does not evidence actual consumer confusion between Petitioner's Mark and Registrant's Mark at issue in this proceeding. Martin Testimony Dep., 19:12-20:8 and 36:22-37:2. Ms. Martin testified that she did not remember seeing any "mark with a design element" and only remembers seeing the "Tempur-Pedic word mark." Id., 19:12-20. Indeed, Ms. Martin testified that she did not see the BODIPEDIC design mark on Overstock.com's webpage when she purchased the products at issue. Id., 19:21-20:5 and 36:22-37:2. Ms. Martin's testimony clearly establishes that she was not confused by Registrant's Mark as she testified unequivocally that she has never even seen Registrant's Mark. To the extent that

Ms. Martin was confused based upon the BODIPEDIC word mark, Petitioner has not challenged the registration for that mark and that registration is now incontestable.

STATEMENT OF THE ISSUES

Has Petitioner proven entitlement to cancellation of Registrant's Mark, despite: (1) Registrant's ownership of an incontestable prior existing registration for a substantially similar mark that covers the same or substantially identical goods; (2) the number of PEDIC-formative marks and reclining figure marks on the Principal Register in Class 20 and in use in commerce in connection with mattresses, pillows and mattress toppers; and (3) the differences between the parties marks?

ARGUMENT

I. Evidentiary Objections

Petitioner has failed to make its registration for Petitioner's Mark of record in accordance with 37 C.F.R. § 2.122(d)(1) or (2). Petitioner did not include a current title and status copy of its registration with its Petition, nor did it include a current title and status copy of its registration identified and introduced during a testimony deposition or attached to a notice of reliance. See 37 C.F.R. § 2.122(d)(1) and (2); see also Petition, Docket Entry No. 1 and Petitioner's NOR. In addition, Registrant did not admit ownership or validity of the registration for Petitioner's Mark in its Answer to the Petition or otherwise. See Answer, Docket Entry No. 4. As such, Petitioner has not established ownership or status of the registration for Petitioner's Mark and Petitioner is not entitled to any of the statutory evidentiary presumptions afforded to a registration that has been properly made of record. See Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), §704.03(b)(1)(A), n. 22. Petitioner cannot therefore rely upon its registration as prima facie evidence of a number of issues, including ownership of the mark, validity of the

registration, exclusive right to use the mark in connection with the goods identified in the registration, or continuous use of the mark. See id.

Petitioner also improperly submitted the Declaration of Sarah Hajjar (the “Hajjar Declaration”) as Exhibit 7(s) to Petitioner’s Notice of Reliance. The parties did not stipulate to admissibility of declarations in lieu of testimony. See 37 C.F.R. § 2.123(b) (“By written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses.”); see also Tri-Star Marketing LLC v. Nino Franco Spumanti SrL., 84 U.S.P.Q.2d 1912, 1914 (TTAB 2007) (absent stipulation by the parties, declaration cannot be submitted in lieu of testimony). To the extent that Petitioner contends that the Hajjar Declaration is admissible pursuant to the parties’ stipulation concerning admissibility of discovery depositions and documents produced in discovery, the Hajjar Declaration was never produced by Petitioner in discovery. Indeed, Petitioner relied upon the Hajjar Declaration and served it on Registrant for the first time in connection with Petitioner’s Motion for Summary Judgment, filed after the close of discovery. Moreover, the parties did not stipulate to admissibility of affidavits or declarations in lieu of trial testimony. As such, the Hajjar Declaration is not admissible and should not be considered as part of the record.

Registrant further objects to Petitioner’s testimony deposition to the extent that Petitioner has not filed with the Board complete copies of the transcripts of each of its testimony depositions and all exhibits marked at such depositions in accordance with 37 C.F.R. §2.125(h). Petitioner filed each of the transcripts of its testimony depositions under seal. As such, Registrant is uncertain as to whether Petitioner filed the complete transcripts and all exhibits of those testimony depositions with the Board. Registrant further objects to the extent that, in its Notice of Reliance, Petitioner failed to submit complete copies of the discovery depositions

taken in the action, which the parties stipulated could be used in lieu of testimony depositions. Registrant submits that, to the extent Petitioner has submitted incomplete deposition transcripts, such testimony should be disregarded for failure to comply with 37 C.F.R. §2.125(h).

II. **Judgment Should Be Entered In Favor of Registrant Based upon Registrant's Morehouse Defense**

Judgment should be entered in Registrant's favor based upon its Morehouse defense. Petitioner "cannot be 'damaged' within the meaning of Lanham Act § 13 by registration" of Registrant's Mark in connection with Registrant's Goods because Registrant "owns an existing registration for the same or substantially identical mark for the same or substantially identical goods." Gould v. General Mktg. Capital, 2013 TTAB LEXIS 157, 30-31 (TTAB Mar. 26, 2013); see also Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881 (C.C.P.A. 1969). Here, Registrant's Mark, BODIPEDIC (and design), is substantially identical to the BODIPEDIC word mark. See Cont'l Specialties Corp. v. Cont'l Connector Corp., 1976 TTAB LEXIS 91, at *7-8 (TTAB Oct. 30, 1976) (holding word mark "'CONTINENTAL' per se creates the same psychological impression and makes the same commercial impact as do 'CONTINENTAL' displayed against a background of interlocking letter 'c's' . . . or a background of interlocking circles Hence, 'CONTINENTAL' per se is substantially identical to applicant's registered marks."). In addition, Registrant's Mark covers "mattress toppers, pillows and mattresses," in Class 20, and the Word Mark covers "mattress toppers, pillows, chair and chair cushions," in Class 20. Given the substantially identical nature of the marks and the goods covered by these registrations owned by Registrant, Petitioner cannot claim to be damaged by Registrant's Mark and judgment should be entered in Registrant's favor.

Petitioner mistakenly relies upon Citadel Fed. Credit Union v. KCG IP Holdings LLC, 2013 TTAB LEXIS 380 (TTAB July 10, 2013), to support its argument that Registrant's Mark is

not substantially similar to Registrant's BODIPEDIC word mark. Applicant asserted the Morehouse defense to the opposition of its application for the CITADEL word mark, relying upon its prior registration for the CITADEL and design mark. See id.; see also U.S. Registration Nos. 2,812,459 and 3,213,943. The design element included in the prior registration, which consists of a large "crenellated design element" that resembles the wall of a fort or castle, preceded the term CITADEL. See U.S. Registration No. 2,812,459. In Citadel, the Board rejected applicant's Morehouse defense, holding that the crenellated design element in the prior registered mark was "not merely a background design." In so holding, the Board was distinguishing the facts of Citadel from the facts of Continental Specialties Corp. v. Continental Connector Corp., 1976 TTAB LEXIS 91, 7-8 (TTAB 1976).

The facts here are analogous to the facts of Continental Specialties Corp. and are distinguishable from the facts of Citadel. In Continental Specialties Corp., the Board upheld applicant's Morehouse defense and dismissed the opposition, finding that the word mark CONTINENTAL "per se creates the same psychological impression and makes the same commercial impact as do 'CONTINENTAL' displayed against a background of interlocking letter 'c's' as in Registration No. 1,019,311 or a background of interlocking circles as in Registration No. 1,020,434," and concluding that the marks owned by the Applicant were substantially identical. Continental Specialties Corp., 976 TTAB LEXIS 91, at * 7-8. Like the design mark at issue in Continental Specialties Corp., the design element of Registrant's Mark is "merely a background design." Citadel, 2013 TTAB LEXIS 380, at *9. The reclining figure design in Registrant's Mark is small and does not precede the word BODIPEDIC, like the crenellated design included in the CITADEL (and design) mark at issue in Citadel. As such, the Board should hold that the Registrant's Mark is substantially identical to and "per se creates the

same psychological impression and makes the same commercial impact” as Registrant’s BODIPEDIC word mark. Continental Specialties Corp., 976 TTAB LEXIS 91, at * 7-8.

III. There Is No Likelihood Of Confusion

Registrant, not Petitioner, is entitled to judgment on the issue of likelihood of confusion. Indeed, 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, as evidenced by third parties’ wide use of the term PEDIC and a reclining figure design for similar goods, and therefore entitled to only a very limited scope of protection, (3) the record is devoid of evidence of a likelihood of confusion between the parties’ marks, much less any probative evidence of actual confusion, 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) (setting forth factors that evidence likelihood of confusion); see also Bose Corp. v. QSC Audio Prods., 293 F.3d 1367, 1370 (Fed. Cir. 2002) (stating that a likelihood of confusion analysis may involve analysis of only certain DuPont factors, as determined by the evidence in the particular case).

A. Petitioner Has Not Proven Fame Of Petitioner’s Mark.

Petitioner’s Mark, the only mark that Petitioner has pleaded in the Petition, has only been registered since January 4, 2011. The Petition does not include a dilution claim or any allegation that Petitioner’s Mark is famous. See Petition, Docket Entry No. 1. In addition, Petitioner has not proven fame of the mark at issue. Petitioner has not established that the admissible evidence of record³ cited by Petitioner to support its claim that Petitioner’s Mark is famous relates specifically to the design mark at issue in this proceeding, as opposed to Petitioner’s TEMPUR-

³ The Hajjar Declaration is not admissible for the reasons discussed above.

PEDIC word mark or other trademarks. As such, there is no basis to support a finding that Petitioner's Mark is famous.

B. Registrant's Mark Is Not Likely To Be Confused With Petitioner's Mark Because The Overall Commercial Impressions Of The Marks Are Different

Confusion between Registrant's Mark and Petitioner's Mark is not likely because the overall commercial impressions of Registrant's Mark and Petitioner's Mark are vastly different. While trademarks "must be considered as a whole in determining likelihood of confusion," Franklin Mint Corp. v. Master Mfg. Co., 667 F.2d 1005, 1007 (C.C.P.A. 1981), "individual features of the two marks may be analyzed in order to determine whether they are confusingly similar." Dow Corning Corp. v. Applied Power Indus., Inc., 167 U.S.P.Q. 730 (N.D. Ill. 1970). Here, the first terms of Registrant's Mark and Petitioner's Mark are wholly distinct, which create overall marks that are different in appearance, sound, meaning, and commercial impression. See In re E.I. DuPont DeNemours & Co., 476 F.2d at 1361. Additionally, there are many distinctions between the designs in Registrant's Mark and Petitioner's Mark, which further distinguish the marks in appearance and commercial impression. Given these fundamental differences, confusion between these marks is highly unlikely.

1. Registrant's Mark And Petitioner's Mark Have Distinct Commercial Impressions Because 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 portions 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 (TTAB 2002); see also Castle & Cook, Inc. v. Robzens', Inc., 189 U.S.P.Q. 555 (TTAB 1976) (where applicant's and opposer's marks each were composite marks consisting of a word portion and a bee design, finding word portions — terms QUEEN BEE and BUMBLE BEE — were most

significant portions of marks in analyzing likelihood of confusion). This is true for Registrant's Mark and Petitioner's Mark. 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) (stating that it is well settled that dominant part of a mark may be given more weight in determining commercial impression created by mark and assessing similarity of marks). The terms BODIPEDIC and TEMPUR-PEDIC are visually and aurally differentiated and have distinct commercial impressions, which precludes 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 Astra Pharm. Prods. Inc. v. Beckman Instruments Inc., 220 U.S.P.Q. 609, 611 (D. Mass. 1983) aff'd 718 F.2d 1201 (1st Cir. 1983); see also In re Sweet Victory Inc., 228 U.S.P.Q. 959, 961 (TTAB 1986) (finding marks GLACE CONTINENTAL and GLACE LITE were not likely to be confused even though both marks were used in connection with sherbet, because “the overall differences in the marks are sufficient so that while source confusion may be possible, it is not likely.”) 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. See New England Fish Co. v. The Hervin Co., 179 U.S.P.Q. 743 (TTAB 1973) (stating that “each case requires consideration of the effect of the entire mark including any term in addition to that which closely

resembles the opposing mark,” and finding no likelihood of confusion between BLUE MOUNTAIN KITTY O’S mark and KITTY mark). Like the “GLACE” marks in In re Sweet Victory, and the “KITTY” marks in New England Fish Co., although Registrant’s Mark and Petitioner’s Mark share the term PEDIC, they are, as a whole, phonetically dissimilar and visually distinct.

Here, the first terms of the marks — BODI and TEMPUR — and thus the marks as a whole, are quite distinct in sound, appearance, and meaning. In fact, BODI and TEMPUR share none of the same letters and are of different lengths. The term BODI suggests something relating to the human form, while, the term TEMPUR vaguely suggests something relating to temperature. As such, the parties’ marks are not likely to be confused. See Sure-Fit Prods. Co. v. Saltzson Drapery Co., 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958) (affirming Patent Office decision that marks RITE-FIT and SURE-FIT, both used in connection with slip covers, were not likely to be confused, and stating that “[t]he fact of the matter is that ‘Rite’ and ‘Sure’ do not look alike or sound alike, factors which we feel . . . militate against” a finding of confusion).

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 Pickle-Rite Co., Inc. v. Chicago Pickle Co., 171 F. Supp. 671, 675 (N.D. Ill. 1959) (stating, “[c]ommon experience teaches that an individual will more readily remember the first part of a name than some other part,” and finding that defendant’s use of name POL-PAK on pickle bottles infringed plaintiff’s trademark POLKA used to designate varieties of pickles); Coca-Cola Co. v. Carlisle Bottling Works, 43 F.2d 101, 114 (E.D. Ky. 1929) (noting the “general rule” that “where the front part of the two trademarks involved differ in appearance, sound, and meaning, there is no infringement even though there may be similarity amounting to identity in the last

parts”). Because the first term in Registrant’s Mark is BODI, which is not included in or similar to any portion of Petitioner’s Mark, the impressions created in the minds of consumers are different, and confusion between Registrant’s Mark and Petitioner’s Mark is not likely, especially given the weakness of Petitioner’s Mark, as discussed below.

2. The Differences In The Design Elements Of Registrant’s Mark And Petitioner’s Mark Create Distinct Overall Commercial Impressions

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

As discussed above, 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. Hurtado Decl., Ex. C. 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. Hurtado Decl., Ex. A. The design is stylized and highly abstract, with no anatomical features depicted, in stark contrast to Petitioner’s Mark. See id. The figure depicted in 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. See id. Petitioner indeed admitted to many of these distinctions between the parties’

marks.⁴

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 highly 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 (TTAB 1984) (finding no likelihood of confusion because the ambiguity of the bird design — “a modern version of the head of a bird almost to the point of abstractness” — in Cardinal Industries Inc.'s mark “makes it unlikely . . . that it would cause confusion with [Cardinal IG Co.'s] mark, which is clearly and solidly a bird's head and recognizable as that of a cardinal.”)

C. Registrant's Mark Is Not Likely To Be Confused With Petitioner's Mark Because The Term PEDIC And The Reclining Figure Design Are Weak, And Thus Petitioner's Mark Is Entitled To Only A Narrow Scope Of Protection

In the section of its brief entitled “Petitioner's Mark . . . is Strong and Famous,” Petitioner discusses only the claimed fame of its Mark. Petitioner ignores “[t]he number and nature of similar marks in use on similar goods.” See In re E.I. DuPont DeNemours & Co., 476 F.2d at 1361. Indeed, an analysis of this important DuPont factor reveals that 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.

⁴ Petitioner admitted that while the design in Petitioner's Mark depicts the full figure of a naked, long-haired woman reclining on a contour pillow, oriented with her head at the beginning of the Mark, the design in Registrant's Mark is different in many ways. Second NOR, Ex. K at 167:22-172:25. Specifically, Petitioner admitted that the design in Registrant's Mark depicts only part of the body, that the figure is oriented with its head at the end of the Mark, and that the figure is not lying on a pillow. Id. at 169:21-172:11. Petitioner also admitted that no anatomical features were depicted in Registrant's Mark indicating the figure is a female or that the figure is naked. Id. Petitioner further admitted that its Mark contains a “plus sign” figure, which is absent from Registrant's Mark. Id. at 168:23-169:16.

The PTO has registered numerous marks over the years that include the term PEDIC in connection with goods in Class 20 and related classes, examples of which are below. Thus, the term PEDIC is a weak mark entitled to only a narrow scope of protection. See id. Indeed, there are at least 99 federally registered marks that include the term PEDIC in connection with mattresses, mattress toppers, pillows, bedding, box springs and/or beds in International Class 20 and related classes. See First NOR, Ex. F. For example:

- DENVERPEDIC, Reg. No. 3,280,502, registered for “mattresses, mattress foundations, beds and pillows,” in Class 20;
- OSTERPEDIC, Reg. No. 599,965, registered for “mattresses,” in Class 20;
- POSTUREPEDIC, Reg. No. 619,058, registered for “mattresses and box springs,” in Class 20;
- NATUREPEDIC, Reg. No. 3,045,755, registered for “mattresses, box springs and pillows,” in Class 20;
- COMFOR-PEDIC, Reg. No. 3,189,821, registered for “mattress, mattress toppers, pillows; industrial foam for use as mattresses,” in Class 20;
- THER-A-PEDIC, Reg. No. 949,332, registered for “bedding, namely, mattresses and boxsprings,” among other things, in Class 20; and
- BOB-O-PEDIC, Reg. No. 3,355,727, registered for “mattresses and mattress foundations,” in Class 20.

See id. As demonstrated by these extensive references and Registrant’s own incontestable registration for the mark BODIPEDIC, PEDIC is a relatively common term when used in connection with goods in Class 20.

Furthermore, the PTO has registered numerous marks over the years that include a reclining figure design in connection with goods in Class 20 and related classes. Similar to the term PEDIC, Petitioner’s reclining figure design falls into the category of weak marks entitled to only a narrow scope of protection. See Palm Bay Imports, Inc., 396 F.3d at 1373. In fact, there are at least 15 federally registered marks that include the design of a reclining

figure plus a word in connection with mattresses, pillows, mattress toppers, foam sleep wedges, mattress pads, bedding, sleep sofas and/or back support cushions in International Class 20 and related classes. See First NOR, Ex. G. As demonstrated by these references, the design of a reclining figure — frequently shown, as in Petitioner’s Mark, directly above the literal portion of the mark — is a relatively common design when used in connection with goods in Class 20.

Registrant has submitted evidence that many of these registered PEDIC and reclining figure marks are presently in use in commerce. See Thorstenson Testimony Dep., 6:5-8:17, Exhibits 43-45 thereto. Thus, the evidence establishes that the consuming public is exposed to third-party use of similar marks on similar goods, and this evidence is relevant to show that Petitioner’s Mark “is relatively weak and entitled to only a narrow scope of protection.” Palm Bay Imports, Inc., 396 F.3d at 1373. When a mark, such as Petitioner’s Mark, exists in a crowded field, the public is presumed to be able to distinguish it from other marks which have only slight differences. See id. at 1374; King Candy Co. v. Eunice King’s Kitchen Inc., 496 F.2d 1400, 1401, 182 U.S.P.Q. 108, 109-10 (C.C.P.A. 1974) (“the expressions ‘weak’ and ‘entitled to limited protection’ are but other ways of saying . . . that confusion is unlikely because the marks are of such nonarbitrary nature or so widely used that the public easily distinguishes slight differences in the marks under consideration as well as differences in the goods . . . even though the goods of the parties may be considered ‘related’”). As the CCPA held in Sure Fit Prods. Co. v. Salzson Drapery Co., “[w]here a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.” 117 U.S.P.Q. 295, 297 (C.C.P.A. 1958); see also General Mills Inc. v. Kellogg Co., 3 U.S.P.Q.2d 1442, 1445 (8th Cir. 1987) (“[d]etermining that a mark is weak

means that consumer confusion has been found unlikely because the mark's components are so widely used that the public can easily distinguish slight differences in the marks, even if the goods are related"). Here, because Petitioner's Mark includes a common term — PEDIC — and the common design of a reclining figure, both widely used in connection with mattresses, mattress toppers and pillows, ordinary consumers are able to distinguish the parties' marks based on slight differences.

The case Standard Brands Inc. v. Peters is particularly instructive here. 191 U.S.P.Q. 168 (TTAB 1975). In Standard Brands Inc., the applicant for the mark CORN-ROYAL for butter and margarine introduced several third party registrations for marks that included the term ROYAL to support its argument that the term ROYAL was weak in the field of food. See id. The applicant asserted that the CORN-ROYAL mark was registrable despite the opposer's prior use of and registrations for the mark ROYAL covering various food products, including shortening. See id. After examining the third party registrations, the Board found that the PTO had treated the term ROYAL as a "weak" mark that "could not be exclusively appropriated in the food field" and stated that the scope of protection afforded to weak marks "have been so limited as to permit the use and/or registration of the same mark for different goods or of a composite mark comprising this term plus other matter, whether such matter be equally suggestive or even descriptive, for the same or similar goods." Id. at 172. The Board concluded that the CORN-ROYAL mark was registrable for butter and margarine despite the prior use and registration of the mark ROYAL for shortening and other food products. See id.

Like the term ROYAL as used in connection with food products, the term PEDIC and the reclining figure design are clearly weak marks in connection with goods in Class 20.

Accordingly, the scope of protection afforded to marks that include the term PEDIC plus another term in Class 20 is very narrow. The same is true for marks that include the design of a reclining figure in combination with a word mark in Class 20. Thus, confusion between Registrant's Mark, which begins with the wholly distinct term BODI and has a distinct design, and Petitioner's Mark, is not likely.

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

The Compilation produced by Overstock.com 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 (TTAB 1987) (finding evidence of checks erroneously mailed to wrong party where both parties used same mark as business name and evidence of misdirected phone call to be of "virtually no probative value" where "circumstances surrounding misdirected checks [were] unexplained and unclear" and identity of caller who made misdirected call was unknown and circumstances surrounding misdirected call were "unexplained"); see also Duluth News-Tribune v. Mesabi Publ'g Co., 84 F.3d 1093, 1098 (8th Cir. 1996) (noting purported evidence of "actual confusion" on summary judgment motion consisting of "vague evidence of misdirected phone calls and mails is hearsay of a particularly unreliable nature given the lack of an opportunity for cross-examination of the call or sender regarding the reason for the 'confusion.'").

Here, the Compilation 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. Neeshan Testimony Dep., Ex. 8. 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. Because the communications in the Compilation do not reference

Petitioner's Mark or Registrant's Mark that is the subject of this proceeding, the Compilation does not evidence actual confusion between the parties' marks. The reason for the consumers' concern is entirely unclear from the Compilation. As such, that evidence is of virtually no probative value. See Hi-Country Foods, 4 U.S.P.Q.2d at 1172.

As discussed above, the testimony of Ms. Martin also fails to establish a likelihood of confusion, and most certainly is not an incident of actual confusion between Registrant's Mark and Petitioner's Mark. Ms. Martin had no recollection of seeing any design mark, and only remembers seeing the "Tempur-Pedic word mark." Martin Testimony Dep., 19:12-20. Ms. Martin testified that she has no recollection of ever seeing Registrant's Mark when she purchased products from Overstock.com Id., 19:21-20:5. Given that this proceeding relates to Registrant's design mark, not its BODIPEDIC word mark, Ms. Martin's testimony does nothing to support a finding that confusion between Registrant's Mark and Petitioner's Mark is likely.

Based upon the foregoing, neither the Compilation, nor Ms. Martin's testimony, is probative and reliable evidence of actual confusion or likelihood of confusion between Registrant's Mark and Petitioner's Mark. Given the lack of evidence of actual confusion, this factor weighs in favor of Registrant, not Petitioner.

E. Consumers Carefully Consider Purchases Of The Parties' Goods And Therefore Are Unlikely To Confuse The Source Of The Products

Because of "[t]he conditions under which . . . sales are made" for Registrant's and Petitioner's products, confusion between the products is not likely. See In re E.I. DuPont DeNemours & Co., 476 F.2d at 1361. Petitioner failed to address this important DuPont factor.

Purchasing a mattress is a decision to which consumers give much consideration, not one that they make on impulse. A mattress is a relatively expensive item that is purchased infrequently, see Dreamwell, Ltd. v. Kittrich Corp., 2011 TTAB LEXIS 123 (TTAB Mar. 29,

2011), and it is an important purchase because it impacts the quality of the purchaser's sleep and therefore the purchaser's health and wellness. As a result, consumers typically give significant consideration to the brands and features of different mattresses before purchasing one, and therefore would be unlikely to confuse them. See id. (finding that because mattresses are relatively expensive, customers shop infrequently for them, and comfort and durability are concerns in purchasing a mattress, "mattresses are not impulse purchases, but would be made with some degree of care," which suggests no likelihood of confusion).

The "price level of the goods or services is an important factor in determining the amount of care the reasonably prudent buyer will use. If the goods or services are relatively expensive, more care is taken and buyers are less likely to be confused as to source or affiliation." 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:95 at 23-245 (4th ed. 2012).

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 (TTAB 1983); Oreck Corp. v. U.S. Floor Sys., Inc., 803 F.2d 166 (5th Cir. 1986); TMEP § 1207.01(d)(vii) (circumstances suggesting care in purchasing may tend to minimize likelihood of confusion). Registrant's Goods range in price from [REDACTED], while Petitioner's Goods range in price from [REDACTED]. Second NOR, Ex. J at 66:1-21; Ex. K 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.

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

Petitioner's claim that the parties share channels of trade because "a significant channel for advertising and sales of both Petitioner's and Registrant's products is the Internet" is

unfounded. Pet. Brief at 6. “[T]he 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 (TTAB 2007).

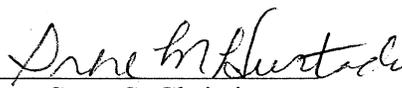
On the issue of Internet sales, Petitioner failed to allege anything more than this general fact, and did not point to a single website through which both Petitioner and Registrant sold or advertised their products. Id. (holding that the TTAB needs something more than the fact that both parties sell or promote their products through the Internet — such as, if the parties’ goods were promoted or offered through the same website — to demonstrate shared channels of trade or likelihood of confusion). In addition, the record is devoid of any evidence suggesting that the parties’ goods are sold on the same websites. Petitioner’s argument that the channels of trade overlap in part because the products of both parties are sold via the Internet should be disregarded by the Board.

CONCLUSION

In view of the foregoing, judgment should be entered in favor of Registrant, and the Cancellation should be dismissed with prejudice.

Dated: December 23, 2014

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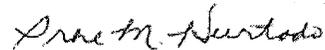
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Registrant's Trial Brief was served on counsel for Petitioner by first class mail on the 23rd day of December, 2014, as follows:

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