

ESTTA Tracking number: **ESTTA649356**

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

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 | Rebuttal Brief |
| Filer's Name | Amy S. Cahill |
| Filer's e-mail | acahill@stites.com |
| Signature | /Amy S. Cahill/ |
| Date | 01/12/2015 |
| Attachments | Petitioner's Reply Brief.pdf(118408 bytes) |

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Armco Inc. v. Armco Burglar Alarm Co., 693 F.2d 1155, 217 USPQ 145 n. 10 (5th Cir. 1982)2
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International Kennel Club of Chi, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 6 USPQ2d 1977 (7th Cir. 1988).....2

Trademark Rules

TBMP § 704.03(b)(1)(A)3
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Code of Federal Regulations

37 C.F.R. § 2.120(j)(3)(i)4

Rules

Fed. R. Evid. 803(3)2

I. THE ACTUAL CONFUSION EVIDENCE CARRIES GREAT WEIGHT

Respondent objects to the recorded customer service exchanges that include a reference to Petitioner's Mark made of record by Petitioner in support of its case. A real-time, recorded log of communications with consumers and potential consumers is among the best evidence of actual confusion in the marketplace that could exist. Petitioner went to great lengths insure the reliability and weight of this evidence. In short, Petitioner secured evidence showing that:

- The consumer communications took place at the point of sale
- The consumer communications were recorded live, in real time
- The consumer communications were recorded word-for-word and were not edited (except to obscure consumer credit card information)
- The communications were assigned a date and time stamp, are maintained perpetually, and are never deleted
- The communications were created and kept in the ordinary course of business¹

Respondent went the additional step of researching and locating one of the customers whose conversation was included in the customer service log and taking her deposition. Ms. Jane Martin testified that she believed that Overstock was selling TEMPUR-PEDIC products and that she believed she was purchasing a TEMPUR-PEDIC product. Ms. Martin continues to believe that Overstock.com was advertising TEMPUR-PEDIC brand products, as that was her perception. Overstock.com does not sell TEMPUR-PEDIC products. A completed purchase of a junior user's products made as the result of actual confusion is the most directly damaging type of actual confusion, as the trademark owner's market is directly impacted.

Sworn testimony from a consumer establishing actual confusion is admissible under the state of mind exception to the rule against hearsay. Fed. R. Evid. 803(3). This is because the

¹ Neeshan Testimony Dep., p. 13, and Exhibit 2 to Neeshan Dep., TTABVue Docket Entry No. 68.

statement is not offered for its truth, but rather for the fact that the declarant *believed* the businesses were the same. *See Armco Inc. v. Armco Burglar Alarm Co.*, 693 F.2d 1155, 217 USPQ 145, 149 n. 10 (5th Cir. 1982). Jane Martin’s testimony is admissible evidence of actual confusion and lends additional weight to the recorded customer service exchanges.

Petitioner also made of record facts that show the way in which consumers encounter Respondent’s products and Respondent’s mark in commerce – namely through a web site portal that displays Respondent’s word and design mark in conjunction with the products. It would be silly to expect to consumers to refer to the products on the phone or by email by using the word and design mark.

Finally, Respondent raises an issue already decided by the Board, namely whether Petitioner properly identified Jane Martin as a witness. The Board granted Petitioner’s request to include Ms. Martin as a witness, and Petitioner secured the evidentiary deposition of Jane Martin within the trial period.

Petitioner has made a strong record of actual confusion evidence in support of its position that Respondent’s registered mark is likely to cause confusion with Petitioner’s Mark. Such actual confusion is entitled to substantial weight and in fact is considered the “best evidence” of actual confusion. *Amstar Corp. v. Domino’s Pizza, Inc.*, 615 F.2d 252, 205 USPQ2d 969, 978-79 (5th Cir. 1908)(actual confusion evidence is the “best evidence” that confusion is likely); *International Kennel Club of Chi, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 6 USPQ2d 1977 (7th Cir. 1988)(actual confusion evidence entitled to “substantial weight”).

II. PETITIONER AND RESPONDENT’S SALES CHANNELS OVERLAP

Although the Ninth Circuit Court of Appeals has held that *some use* of the Internet for *marketing* of the parties’ goods does not “alone and as a matter of law” constitute overlapping marketing channels for purposes of likely confusion, this holding does not end the discussion.

Rather, the correct inquiry is:

whether both parties use the Web as a substantial marketing and advertising channel, whether the parties' marks are utilized in conjunction with Web-based products, and whether the parties' marketing channels overlap in any other way.

Entrepreneur Media v. Smith, 279 F.3d 1135, 1151, 61 USPQ2d 1705, 1717 (9th Cir. 2002). In this case, both parties use the Internet not merely to provide information about their products, but both use the Internet as a primary channel for sales of products directly to consumers.

III. PETITIONER'S TRIAL RECORD IS PROPER AND COMPLETE

Petitioner need not make its registration for Petitioner's Mark of record in the proceeding. Petitioner's registration was properly introduced in the deposition of Dan Setlak.² Pursuant to TBMP § 704.03(b)(1)(A), a federal registration owned by a party may be made of record through the introduction of a copy of the registration as an exhibit to testimony. Moreover, Petitioner's registration may be deemed by the Board to be of record since throughout the proceeding Respondent has treated Petitioner's registration as being of record, including but not limited to in the summary judgment briefing. *See id.* To the extent this is not acceptable to the Board, Petitioner attaches as Exhibit A a current printout from TSDR showing the current status and title of the Petitioner's registration.

Petitioner properly filed and served complete copies of its evidentiary deposition transcripts in accordance with TBMP §§ 703.01(k),(l). Confidential materials were filed using TTABVue's confidential portal in accordance with Trademark Trial and Appeal Board rules. On June 5, 2014, Petitioner filed a complete copy of the transcript of the testimony deposition of

² Setlak Dep., p. 50, and Exhibit 9.

Jane Martin and all attached exhibits, and on July 29, 2014, Petitioner filed a complete copy of the transcript of the testimony deposition of Victoria Neeshan and all attached exhibits.³

It is not improper for Petitioner to designate portions of deposition transcripts in its Notice of Reliance. Petitioner properly relied upon in its trial brief only on those portions of the depositions identified in the Notice of Reliance. In accordance with TBMP § 704.09 and 37 C.F.R. § 2.120(j)(3)(i), Petitioner identified and filed the portions of the deposition transcripts it intended to include as evidence in support of its trial brief through its Notice of Reliance.⁴

IV. THE *MOREHOUSE* DEFENSE HAS NO APPLICATION TO THIS PROCEEDING

Respondent tries to argue around the Board's most recent holding on the availability of the *Morehouse* defense by suggesting that the design element in Respondent's mark is "merely a background design." The reclining figure design is a significant portion of Respondent's Mark and takes it far out of the realm of "same or substantially identical" to Respondent's registered word mark.

The mark of the Challenged Registration and the mark of Respondent's prior registration are not essentially the same. The prior registration is in standard character form, while the applied-for mark has a stylization element and a reclining figure design element that the registration of BODIPEDIC does not have.

V. CONCLUSION

In view of the facts disclosed by the record, Petitioner has proved by a preponderance of the evidence that Respondent's BODIPEDIC & Reclining Figure Design mark that is the subject of Registration No. 3,916,902 is likely to cause confusion with Petitioner's TEMPUR-PEDIC &

³ TTABVue Docket Entry Nos. 65 and 68.

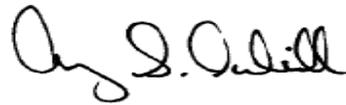
⁴ TTABVue Docket Entry No. 62.

Reclining Figure Design mark. Therefore Petitioner respectfully requests that Petitioner's
Petition for Cancellation be granted and Registration No. 3,916,902 be cancelled.

Respectfully submitted,

Date: January 12, 2015

STITES & HARBISON PLLC
Attorneys for Petitioner

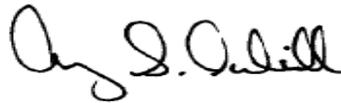
A handwritten signature in black ink, appearing to read "Amy S. Cahill". The signature is fluid and cursive, with the first name "Amy" being the most prominent.

Amy S. Cahill
400 W. Market Street
Suite 1800
Louisville, KY 40202
Telephone: (502) 681-0597
Facsimile: (502) 779-9805
Email: acahill@stites.com

CERTIFICATE OF SERVICE

I, Amy S. Cahill, an attorney, state that I served a true and correct copy of Petitioner's Reply Brief on the Petition for Cancellation by depositing said copy in a properly addressed envelope, first class postage prepaid, and depositing same in the United States mail on this 12th day of January, 2015 on:

Irene Hurtado
Scott S. Christie
MCCARTER & ENGLISH, LLP
Four Gateway Center, 100 Mulberry Street
Newark, NJ 07102



Amy S. Cahill

EXHIBIT A

Generated on: This page was generated by TSDR on 2015-01-12 12:57:31 EST

Mark: TEMPUR-PEDIC



US Serial Number: 77180017

Application Filing Date: May 14, 2007

US Registration Number: 3900919

Registration Date: Jan. 04, 2011

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jan. 04, 2011

Publication Date: Apr. 15, 2008

Notice of Allowance Date: Oct. 14, 2008

Mark Information

Mark Literal Elements: TEMPUR-PEDIC

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of a female figure on a pillow reclining on top of a cross and the words "TEMPUR-PEDIC". The portion of the mark comprised of a cross design is not displayed in the color red or a colorable imitation thereof; and is not used and will not be used in the color red or a colorable imitation thereof.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 02.03.02 - Women depicted as shadows or silhouettes of women; Silhouettes of women
02.09.03 - Reclining, humans; Sleeping, humans; Humans, including men, women and children, depicted reclining or sleeping
09.01.07 - Bedding, bedspreads; Blankets; Bolsters (cushions); Comforters, bed; Cushions; Mattress pads; Pillows; Quilts, bed; Sleeping bags; Bed quilts; Bed pillows; Bed comforters; Bags, sleeping; Afghan; Bedding, pillows, comforters, blankets
24.13.02 - Cross, Greek (equal sides); Greek cross (equal sized lines)

Related Properties Information

Claimed Ownership of US Registrations: 1853088, 1926469, 2495299 and others

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Seating and couching mats in the nature of a pillow or seat liner, pillows, cushions, mattresses, top mattresses, bolsters and chair pads for medical uses

International Class(es): 010 - Primary Class

U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: May 31, 2007

Use in Commerce: May 31, 2007

For: Seating and couching mats in the nature of a pillow or seat liner, pillows, cushions, mattresses, top mattresses, bolsters and chair pads

International Class(es): 020 - Primary Class

U.S Class(es): 002, 013, 022, 025, 032, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: May 31, 2007

Use in Commerce: May 31, 2007

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Dan-Foam ApS

Owner Address: Holmelund 43
Aarup DK-5560
DENMARK

Legal Entity Type: CORPORATION

State or Country Where Organized: DENMARK

Attorney/Correspondence Information

Attorney of Record - None

Correspondent

Correspondent Name/Address: TRACY COOKE
TEMPUR-PEDIC INTERNATIONAL INC
1713 JAGGIE FOX WAY
LEXINGTON, KENTUCKY 40511-2512
UNITED STATES

Phone: 859-514-4615

Fax: 859-514-5615

Correspondent e-mail: legal@tempurpedic.com

Correspondent e-mail No Authorized:

Domestic Representative - Not Found

Prosecution History

| Date | Description | Proceeding Number |
|---------------|---|-------------------|
| Jan. 04, 2011 | REGISTERED-PRINCIPAL REGISTER | |
| Dec. 02, 2010 | NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED | |
| Dec. 01, 2010 | LAW OFFICE REGISTRATION REVIEW COMPLETED | 68658 |
| Dec. 01, 2010 | ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED | |
| Nov. 12, 2010 | STATEMENT OF USE PROCESSING COMPLETE | 69302 |
| Nov. 08, 2010 | USE AMENDMENT FILED | 69302 |
| Nov. 08, 2010 | TEAS STATEMENT OF USE RECEIVED | |
| Oct. 19, 2010 | NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED | |
| Oct. 18, 2010 | EXTENSION 4 GRANTED | 69302 |
| Oct. 14, 2010 | EXTENSION 4 FILED | 69302 |
| Oct. 14, 2010 | TEAS EXTENSION RECEIVED | |
| Apr. 20, 2010 | NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED | |
| Apr. 19, 2010 | EXTENSION 3 GRANTED | 69302 |
| Apr. 14, 2010 | EXTENSION 3 FILED | 69302 |
| Apr. 14, 2010 | TEAS EXTENSION RECEIVED | |
| Oct. 14, 2009 | EXTENSION 2 GRANTED | 98765 |
| Oct. 14, 2009 | EXTENSION 2 FILED | 98765 |
| Oct. 14, 2009 | TEAS EXTENSION RECEIVED | |
| Jul. 15, 2009 | ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY | |
| May 04, 2009 | EXTENSION 1 GRANTED | 69302 |
| Apr. 14, 2009 | EXTENSION 1 FILED | 69302 |
| May 04, 2009 | CASE ASSIGNED TO INTENT TO USE PARALEGAL | 69302 |
| Apr. 15, 2009 | EXTENSION RECEIVED WITH TEAS PETITION | |
| Apr. 15, 2009 | PETITION TO REVIVE-GRANTED | 88889 |
| Apr. 15, 2009 | TEAS PETITION TO REVIVE RECEIVED | |
| Oct. 14, 2008 | NOA MAILED - SOU REQUIRED FROM APPLICANT | |
| Aug. 29, 2008 | EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED | |
| Jul. 10, 2008 | CHANGES/CORRECTIONS AFTER PUB APPROVAL ENTERED | 67832 |
| Jul. 07, 2008 | ASSIGNED TO PETITION STAFF | 67832 |

| | | |
|---------------|---|-------|
| Jun. 17, 2008 | FAX RECEIVED | |
| May 12, 2008 | EXTENSION OF TIME TO OPPOSE RECEIVED | |
| Apr. 15, 2008 | PUBLISHED FOR OPPOSITION | |
| Mar. 26, 2008 | NOTICE OF PUBLICATION | |
| Mar. 07, 2008 | LAW OFFICE PUBLICATION REVIEW COMPLETED | 68658 |
| Mar. 07, 2008 | ASSIGNED TO LIE | 68658 |
| Feb. 13, 2008 | APPROVED FOR PUB - PRINCIPAL REGISTER | |
| Feb. 12, 2008 | TEAS/EMAIL CORRESPONDENCE ENTERED | 88889 |
| Feb. 12, 2008 | CORRESPONDENCE RECEIVED IN LAW OFFICE | 88889 |
| Feb. 12, 2008 | TEAS RESPONSE TO OFFICE ACTION RECEIVED | |
| Aug. 27, 2007 | NOTIFICATION OF NON-FINAL ACTION E-MAILED | 6325 |
| Aug. 27, 2007 | NON-FINAL ACTION E-MAILED | 6325 |
| Aug. 27, 2007 | NON-FINAL ACTION WRITTEN | 81877 |
| Aug. 13, 2007 | ASSIGNED TO EXAMINER | 81877 |
| May 18, 2007 | NOTICE OF DESIGN SEARCH CODE MAILED | |
| May 17, 2007 | NEW APPLICATION ENTERED IN TRAM | |

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 01, 2010

Assignment Abstract Of Title Information

Summary

Total Assignments: 1

Registrant: Dan-Foam ApS

Assignment 1 of 1

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS

Reel/Frame: [4017/0620](#)

Pages: 8

Date Recorded: Jul. 07, 2009

Supporting Documents: [assignment-tm-4017-0620.pdf](#)

Assignor

Name: [DAN-FOAM APS](#)

Execution Date: Jun. 18, 2009

Legal Entity Type: PRIVATE LIMITED LIABILITY COMPANY

State or Country Where Organized: DENMARK

Assignee

Name: [NORDEA BANK DANMARK A/S, AS FOREIGN COLLATERAL AGENT](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: DENMARK

Address: CHRISTIANSBRO, STRANDGADE 3
P.O. BOX 850
COPENHAGEN C, DENMARK DK-0900

Correspondent

Correspondent Name: MOORE & VAN ALLEN PLLC

Correspondent Address: 430 DAVIS DRIVE
SUITE 500
MORRISVILLE, NC 27560

Domestic Representative

Domestic Representative Name: JOHN E. SLAUGHTER/MOORE & VAN ALLEN PLLC

Domestic Representative Address: 430 DAVIS DRIVE
SUITE 500
MORRISVILLE, NC 27560

Proceedings

Summary

Number of Proceedings: 6

Type of Proceeding: OppositionProceeding Number: [91210620](#)

Filing Date: May 08, 2013

Status: Terminated

Status Date: Oct 22, 2013

Interlocutory Attorney: ANDREW P BAXLEY

Defendant

Name: Jiangsu Wellcare Household Articles Co., Ltd.

Correspondent Address: XIANG WEILIN
CONVENTION PLAZA
3011, 30/F, OFFICE TOWER , 1 HARBOUR ROAD
HONG KONG HONG KONGCorrespondent e-mail: tmefiling@gmail.com**Associated marks**

| Mark | Application Status | Serial Number | Registration Number |
|------|---|--------------------------|---------------------|
| OK | Abandoned - After Inter-Partes Decision | 85792572 | |

Plaintiff(s)

Name: Dan Foam ApS

Correspondent Address: AMY SULLIVAN CAHILL
STITES & HARBISON PLLC
400 WEST MARKET STREET, SUITE 1800
LOUISVILLE KY , 40202-3352
UNITED STATESCorrespondent e-mail: acahill@stites.com**Associated marks**

| Mark | Application Status | Serial Number | Registration Number |
|--------------|--------------------|--------------------------|-------------------------|
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |
| TEMPUR-PEDIC | Registered | 85384316 | 4231040 |

Prosecution History

| Entry Number | History Text | Date | Due Date |
|--------------|--|--------------|--------------|
| 1 | FILED AND FEE | May 08, 2013 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | May 15, 2013 | Jun 24, 2013 |
| 3 | PENDING, INSTITUTED | May 15, 2013 | |
| 4 | P MOT FOR DEFAULT JUDGMENT | Jul 08, 2013 | |
| 5 | BD DECISION: SUSTAINED | Sep 25, 2013 | |
| 6 | TERMINATED | Sep 25, 2013 | |
| 7 | UNDELIVERABLE MAIL | Sep 26, 2013 | |

Type of Proceeding: OppositionProceeding Number: [91209082](#)

Filing Date: Jan 30, 2013

Status: Terminated

Status Date: Mar 13, 2013

Interlocutory Attorney: BENJAMIN U OKEKE

Defendant

Name: Restonic Corporation

Correspondent Address: ROBERT V JAMBOR
LEYDIG VOIT & MAYER LTD
2 PRUDENTIAL PLAZA SUITE 4900
CHICAGO IL , 60601
UNITED STATESCorrespondent e-mail: trademarks@leydig.com**Associated marks**

| Mark | Application Status | Serial Number | Registration Number |
|----------|---|--------------------------|---------------------|
| TEMPAGEL | Abandoned - After Inter-Partes Decision | 85456908 | |

Plaintiff(s)

Name: Dan Foam ApS

Correspondent Address: AMY SULLIVAN CAHILL

STITES & HARBISON PLLC
 400 WEST MARKET STREET, SUITE 1800
 LOUISVILLE KY , 40202-3352
 UNITED STATES

Correspondent e-mail: acahill@stites.com

| Associated marks | | | |
|-----------------------------------|--|--------------------------|-------------------------|
| Mark | Application Status | Serial Number | Registration Number |
| TEMPUR | Renewed | 74322007 | 1926469 |
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |
| TEMPUR-PEDIC | Renewed | 74247231 | 1853088 |
| THE ADVANTAGEBED BY TEMPUR-PEDIC | Registered | 77531300 | 3700051 |
| THE ALLURABED BY TEMPUR-PEDIC | Section 8 and 15 - Accepted and Acknowledged | 77043778 | 3509218 |
| THE BELLAFINA BED BY TEMPUR-PEDIC | Registered | 77531310 | 3700052 |
| THE CELEBRITYBED BY TEMPUR-PEDIC | Registered | 77209300 | 3456803 |
| THE CLASSICBED BY TEMPUR-PEDIC | Section 8 and 15 - Accepted and Acknowledged | 78723618 | 3446640 |
| THE GRANDBED BY TEMPUR-PEDIC | Registered | 77538967 | 3567704 |
| THE RHAPSODYBED BY TEMPUR-PEDIC | Section 8 and 15 - Accepted and Acknowledged | 78598877 | 3319861 |
| TEMPUR-CLOUD | Registered | 77824488 | 3945266 |
| THE DELUXEBED BY TEMPUR-PEDIC | Registered | 78723624 | 3921145 |
| TEMPUR-HD | Registered | 78776313 | 3451045 |

| Prosecution History | | | |
|---------------------|--|--------------|--------------|
| Entry Number | History Text | Date | Due Date |
| 1 | FILED AND FEE | Jan 30, 2013 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jan 30, 2013 | Mar 11, 2013 |
| 3 | PENDING, INSTITUTED | Jan 30, 2013 | |
| 4 | W/DRAW OF APPLICATION W/ CONSENT | Mar 11, 2013 | |
| 5 | BD DECISION: DISMISSED W/O PREJ | Mar 13, 2013 | |
| 6 | TERMINATED | Mar 13, 2013 | |

Type of Proceeding: Opposition

Proceeding Number: [91200853](#)

Filing Date: Jul 21, 2011

Status: Terminated

Status Date: Oct 25, 2011

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Nantong Healthcare Foam Series Co., Ltd.

Correspondent Address: JIANGSU NEW&HIGH TRADEMARK AGENCY
 3/F 72 SHANXI ROAD
 NANJING JIANGSU , 210009
 CHINA

| Associated marks | | | |
|------------------|---|--------------------------|---------------------|
| Mark | Application Status | Serial Number | Registration Number |
| MLILY | Abandoned - After Inter-Partes Decision | 79087830 | |

Plaintiff(s)

Name: DanFoam ApS

Correspondent Address: AMY SULLIVAN
 STITES & HARBISON PLLC
 400 WEST MARKET STREET, SUITE 1800
 LOUISVILLE KY , 40202-3352
 UNITED STATES

Correspondent e-mail: acahill@stites.com

| Associated marks | | | |
|------------------|--------------------|---------------|---------------------|
| Mark | Application Status | Serial Number | Registration Number |

TEMPUR-PEDIC

Registered

[77180017](#)

[3900919](#)

| Prosecution History | | | |
|---------------------|--|--------------|--------------|
| Entry Number | History Text | Date | Due Date |
| 1 | FILED AND FEE | Jul 21, 2011 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jul 25, 2011 | Sep 03, 2011 |
| 3 | PENDING, INSTITUTED | Jul 25, 2011 | |
| 4 | P'S MOTION FOR DEFAULT JUDGEMENT | Sep 08, 2011 | |
| 5 | BOARD'S DECISION: SUSTAINED | Oct 25, 2011 | |
| 6 | TERMINATED | Oct 25, 2011 | |

Type of Proceeding: Cancellation

Proceeding Number: [92054201](#)

Filing Date: Jul 01, 2011

Status: Pending

Status Date: Jul 01, 2011

Interlocutory Attorney: CHERYL S GOODMAN

Defendant

Name: Sleep Innovations, Inc.

Correspondent Address: IRENE M HURTADO
MCCARTER & ENGLISH LLP
FOUR GATEWAY CENTER, 100 MULBERRY STREET
NEWARK NJ , 07102
UNITED STATES

Correspondent e-mail: schristie@mccarter.com , ihurtado@mccarter.com , dpopovic@mccarter.com

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|-----------|----------------------|--------------------------|-------------------------|
| BODIPEDIC | Cancellation Pending | 85070859 | 3916902 |

Plaintiff(s)

Name: Dan Foam ApS

Correspondent Address: AMY SULLIVAN CAHILL
STITES HARBISON PLLC
400 WEST MARKET STREET , SUITE 1800
LOUISVILLE KY , 40202 3352
UNITED STATES

Correspondent e-mail: acahill@stites.com

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|--------------|--------------------|--------------------------|-------------------------|
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |

TEMPUR-PEDIC

Registered

[77180017](#)

[3900919](#)

| Prosecution History | | | |
|---------------------|--|--------------|--------------|
| Entry Number | History Text | Date | Due Date |
| 1 | FILED AND FEE | Jul 01, 2011 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jul 06, 2011 | Aug 15, 2011 |
| 3 | PENDING, INSTITUTED | Jul 06, 2011 | |
| 4 | ANSWER | Aug 11, 2011 | |
| 5 | CHANGE OF CORRESPONDENCE ADDRESS | Jan 31, 2012 | |
| 6 | STIPULATED PROTECTIVE ORDER | Jan 31, 2012 | |
| 7 | STIP PROTECTIVE ORDER NOTED AND APPROVED | Feb 10, 2012 | |
| 8 | D'S MOTION FOR AN EXTENSION OF TIME | Feb 10, 2012 | |
| 9 | EXTENSION OF TIME GRANTED | Mar 13, 2012 | |
| 10 | STIPULATION FOR AN EXTENSION OF TIME | Apr 27, 2012 | |
| 11 | EXTENSION OF TIME GRANTED | Apr 27, 2012 | |
| 12 | P MOT FOR SUMMARY JUDGMENT | Aug 02, 2012 | |
| 13 | P MOT FOR SUMMARY JUDGMENT | Aug 02, 2012 | |
| 14 | P MOT FOR SUMMARY JUDGMENT | Aug 02, 2012 | |
| 15 | P'S MOTION FOR SUMMARY JUDGMENT | Aug 07, 2012 | |

| | | |
|----|---|--------------|
| 16 | PET'S MOTION FOR SJ EXH | Aug 07, 2012 |
| 17 | SUSPENDED PENDING DISP OF OUTSTNDNG MOT | Aug 22, 2012 |
| 18 | NOTICE OF PET RE-FILING OF NON-CONF MOT SJ | Aug 23, 2012 |
| 19 | P'S MOTION FOR SUMMARY JUDGMENT | Aug 23, 2012 |
| 20 | P'S MOTION FOR SUMMARY JUDGMENT | Aug 23, 2012 |
| 21 | P'S MOTION FOR SUMMARY JUDGMENT | Aug 23, 2012 |
| 22 | D'S MOTION FOR AN EXTENSION OF TIME | Aug 31, 2012 |
| 23 | EXTENSION OF TIME GRANTED | Sep 11, 2012 |
| 24 | RESPONDENT'S CROSS-MOTION FOR SJ | Sep 17, 2012 |
| 25 | RESP'S BRIEF IN OPP TO PET'S MOT FOR SJ | Sep 17, 2012 |
| 26 | DECLARATION OF R W SMITH IN OPP TO PET'S SJ | Sep 17, 2012 |
| 27 | RESP'S RESPONSE TO SJ - EXH A | Sep 17, 2012 |
| 28 | RESP'S RESPONSE TO SJ EXHT B PART 1 | Sep 17, 2012 |
| 29 | RESP'S RESPONSE TO SJ EXH B PART 2 | Sep 17, 2012 |
| 30 | RESP'S RESPONSE TO SJ EXH C | Sep 17, 2012 |
| 31 | RESP'S RESPONSE TO SJ EXH D PART 1 | Sep 17, 2012 |
| 32 | RESP'S RESPONSE TO SJ EXH D PART 2 | Sep 17, 2012 |
| 33 | RESP'S RESPONSE TO SJ EXH D PART 3 | Sep 17, 2012 |
| 34 | RESP'S RESPONSE TO SJ EXH E | Sep 17, 2012 |
| 35 | RESP'S RESPONSE TO SJ EXHBTS J K L | Sep 17, 2012 |
| 36 | DECL OF IRENE M. HURTADO | Sep 19, 2012 |
| 37 | DECLARATION OF ROBERT W SMITH IN OP TO PET MOT FOR SJ | Sep 17, 2012 |
| 38 | P'S REPLY IN SUPPORT OF MOTION | Oct 05, 2012 |
| 39 | P'S REPLY IN SUPPORT OF MOTION | Oct 08, 2012 |
| 40 | P'S OPPOSITION/RESPONSE TO MOTION | Oct 17, 2012 |
| 41 | D'S REPLY IN SUPPORT OF MOTION | Nov 06, 2012 |
| 42 | P MOT FOR SUMMARY JGT DENIED | May 13, 2013 |
| 43 | MOT TO AMEND ANS OR COUNTERCLAIM/AMENDED ANS OR COUNTERCLAIM | May 31, 2013 |
| 44 | PET'S MOTION TO RESUME PROC | Jun 12, 2013 |
| 45 | P OPP/RESP TO MOTION | Jun 14, 2013 |
| 46 | D REPLY IN SUPPORT OF MOTION | Jul 03, 2013 |
| 47 | SUSP PEND DISP OF OUTSTNDNG MOT | Jul 13, 2013 |
| 48 | TRIAL DATES SET | Sep 10, 2013 |
| 49 | STIPULATION | Nov 18, 2013 |
| 50 | P MOT FOR EXT W/ CONSENT | Dec 16, 2013 |
| 51 | P MOT TO SUPPLEMENT PRETRIAL DISLOSURES AND TO TAKE TESTIMONY DEPOSITION BY TELEPHONE | Jan 03, 2014 |
| 52 | D ENTRY OF APPEARANCE | Jan 08, 2014 |
| 53 | SUSP PEND DISP OF OUTSTNDNG MOT | Jan 08, 2014 |
| 54 | PROTECTIVE AGREEMENT | Jan 09, 2014 |
| 55 | CONF DEC OF IRENE M HURTADO | Jan 08, 2014 |
| 56 | D CROSS MOT TO QUASH MOT FOR PROTECTIVE ORDER | Jan 08, 2014 |
| 57 | CHANGE OF CORRESP ADDRESS | Jan 08, 2014 |
| 58 | P REPLY IN SUPPORT OF MOTION | Jan 13, 2014 |
| 59 | D REPLY IN SUPPORT OF MOTION | Jan 17, 2014 |
| 60 | PROCEEDINGS RESUMED | Apr 16, 2014 |
| 61 | Confidential Testimony For Plaintiff | Apr 28, 2014 |
| 62 | Confidential Plaintiff's Notice of Reliance | May 01, 2014 |
| 63 | CONFIDENTIAL P EXHIBIT 12 TO ITS NOTICE OF RELIANCE | May 06, 2014 |

| | | |
|----|---|--------------|
| 64 | STIP FOR EXT | May 13, 2014 |
| 65 | CONFIDENTIAL P TESTIMONY | Jun 05, 2014 |
| 66 | TRIAL DATES RESET | Jun 10, 2014 |
| 67 | STIP FOR EXT | Jul 25, 2014 |
| 68 | CONFIDENTIAL P TESTIMONY | Jul 29, 2014 |
| 69 | REDACTED D NOTICE OF RELIANCE & EXHS A-I | Aug 14, 2014 |
| 70 | REDACTED D SECOND NOTICE OF RELIANCE | Aug 14, 2014 |
| 71 | CONFIDENTIAL D SECOND NOTICE OF RELIANCE & EXHS J-M | Aug 14, 2014 |
| 72 | D TESTIMONY (THORSTENSON) & DEPO EXHS 43-47 | Aug 19, 2014 |
| 73 | EXTENSION OF TIME GRANTED | Sep 24, 2014 |
| 74 | CONFIDENTIAL P FINAL BRIEF | Nov 25, 2014 |
| 75 | REDACTED P FINAL BRIEF | Nov 25, 2014 |
| 76 | D FINAL BRIEF: TM RULE 2.128 | Dec 23, 2014 |
| 77 | Confidential Brief on Merits for Defendant | Dec 23, 2014 |

Type of Proceeding: Opposition

Proceeding Number: [91184797](#) **Filing Date:** Jun 24, 2008
Status: Terminated **Status Date:** Aug 04, 2008
Interlocutory Attorney: CHERYL S GOODMAN

Defendant

Name: Tao Trading Corp
Correspondent Address: Piya Wangiwatsin
TAO Trading Corp.
1420 W Hoard Street, Apt. 201
Chicago IL , 60626-1433
UNITED STATES
Correspondent e-mail: peter@taotrading.com

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|------------|---|--------------------------|---------------------|
| BODYCHOICE | Abandoned - After Inter-Partes Decision | 77334213 | |

Plaintiff(s)

Name: Dan-Foam ApS, Tempur World, LLC, Tempur-Pedic International Inc.
Correspondent Address: Tracy cooke
Tempur-Pedic International Inc.
1713 Jaggie Fox Way
Lexington KY , 40511
UNITED STATES
Correspondent e-mail: legal@tempurpedic.com

Associated marks

| Mark | Application Status | Serial Number | Registration Number |
|--------------|-----------------------|--------------------------|-------------------------|
| TEMPUR | Cancelled - Section 8 | 75588182 | 2495299 |
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |

Prosecution History

| Entry Number | History Text | Date | Due Date |
|--------------|--|--------------|--------------|
| 1 | FILED AND FEE | Jun 24, 2008 | |
| 2 | NOTICE AND TRIAL DATES SENT; ANSWER DUE: | Jun 24, 2008 | Aug 03, 2008 |
| 3 | PENDING, INSTITUTED | Jun 24, 2008 | |
| 4 | WITHDRAWAL OF APPLICATION | Jul 31, 2008 | |
| 5 | BOARD'S DECISION: SUSTAINED | Aug 04, 2008 | |
| 6 | TERMINATED | Aug 04, 2008 | |

Type of Proceeding: Extension of Time

Proceeding Number: [77180017](#) **Filing Date:** May 12, 2008
Status: Terminated **Status Date:** Aug 29, 2008
Interlocutory Attorney:

Defendant**Name:** Dan-Foam ApS**Correspondent Address:** TRACY COOKE
TEMPUR-PEDIC INTERNATIONAL INC
1713 JAGGIE FOX WAY
LEXINGTON KY , 40511-2512
UNITED STATES**Associated marks**

| Mark | Application Status | Serial Number | Registration Number |
|--------------|--------------------|--------------------------|-------------------------|
| TEMPUR-PEDIC | Registered | 77180017 | 3900919 |

Potential Opposer(s)**Name:** Johnson & Johnson**Correspondent Address:** Norm D. St. Landau
Drinker Biddle & Reath LLP
1500 K Street, N.W., Suite 1100
Washington DC , 20009
UNITED STATES**Correspondent e-mail:** jaye.yung@dbr.com , norm.st.landau@dbr.com , andrea.engel@dbr.com**Prosecution History**

| Entry Number | History Text | Date | Due Date |
|--------------|-------------------------------------|--------------|----------|
| 1 | INCOMING - EXT TIME TO OPPOSE FILED | May 12, 2008 | |
| 2 | EXTENSION OF TIME GRANTED | May 12, 2008 | |