

THIS OPINION
IS NOT A
PRECEDENT OF THE TTAB

Hearing: June 23, 2015

Mailed: November 13, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Dan Foam ApS
v.
Innocor, Inc.

—
Cancellation No. 92054201
—

Amy S. Cahill of Stites & Harbison PLLC for Dan Foam ApS.

Scott S. Christie and Irene M. Hurtado of McCarter & English, LLP for Innocor, Inc.

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Before Zervas, Mermelstein and Wolfson, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Innocor, Inc. (“Respondent”) owns a registration for the mark depicted below:



for “Mattress toppers, pillows, [and] mattresses” in International Class 20 (the “BODIPEDIC and design” mark).¹

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¹ Reg. No. 3916902, issued February 8, 2011, based on an application filed June 24, 2010, and alleging April 2, 2008, as the date of first use anywhere and date of first use in commerce. The registration includes the following description of the mark: “The mark

Dan Foam ApS (“Petitioner”) filed a petition to cancel Respondent’s registration on the ground of likelihood of confusion with its registered and previously used mark:



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” in International Class 10 and “seating and couching mats in the nature of a pillow or seat liner, pillows, cushions, mattresses, top mattresses, bolsters and chair pads” in International Class 20 (the “TEMPUR-PEDIC and design” mark).² Respondent, in its answer, denies the salient allegations of the petition to cancel and pleads, as an affirmative defense, that Petitioner cannot be damaged by registration of the BODIPEDIC and design mark because Respondent owns Registration No. 3137309 for the standard character mark BODIPEDIC for “mattress toppers, pillows, chairs

consists of the word ‘BODIPEDIC’ with a stylized silhouette of a person which is above the letters ‘IPED’.” Color is not claimed as a feature of the mark. The registration claims ownership of Reg. No. 3137309 for the standard character mark BODIPEDIC for “mattress toppers, pillows, chairs and chair cushions” in International Class 20; issued August 29, 2006; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

² Reg. No. 3900919, issued January 4, 2011, based on an intent-to-use based application filed May 14, 2007, and alleging (by way of a statement of use filed November 8, 2010), May 31, 2007, as the date of use anywhere and date of first in commerce. The registration includes the following description of the mark and additional information: “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 is not claimed as a feature of the mark.” The registration claims ownership of Reg. No. 1853088 for the typed mark TEMPUR-PEDIC for “mattresses, cushions and furniture pads made of elastic viscous foam”; issued September 6, 1994; renewed.

and chair cushions.” *See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).³

The Record

The record includes the pleadings and the file for Respondent’s BODIPEDIC and design mark, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). The record also includes documents and discovery depositions that have been submitted pursuant to the parties’ November 18, 2013 Stipulation, wherein the parties agreed to admit certain discovery depositions into evidence and to consider as authentic the documents produced by the parties during the discovery period.

A. Petitioner’s Testimony and Evidence

Petitioner introduced the following testimony, with attached exhibits:

1. Testimony deposition of Mohican Laine, Senior Director of Business Intelligence at Overstock.com (61 TTABVUE) (filed under seal);
2. Testimony deposition of Victoria Neeshan, Associate Director of Technology Operations at Overtsock.com (68 TTABVUE) (filed under seal); and
3. Testimony deposition of Jane Martin, in her individual capacity (filed under seal at 65 TTABVUE; public version at 89 TTABVUE).

Petitioner also filed a Notice of Reliance⁴ on:

1. Respondent’s Responses to Petitioner’s First Requests for Admissions;
2. Respondent’s Responses to Petitioner’s Second Requests for Admissions;
3. Respondent’s verified answers to Petitioner’s interrogatories;

³ Respondent pleaded several other affirmative defenses that have been waived, as they were not pursued at trial or referenced in Respondent’s brief. *See Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 (TTAB 2007) (where applicant did not argue the affirmative defense of equitable estoppel in her brief, the affirmative defense was given no consideration); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer deemed to have waived the claim).

⁴ Petitioner filed a confidential version of its Notice of Reliance at 62 TTABVUE and a redacted, public version at 89 TTABVUE. Petitioner did not file a public version of any testimony deposition except for that of Jane Martin.

4. Documents verified through Respondent's responses to Petitioner's requests for admissions;
5. Printed publications available to the general public;
6. Portions of the following discovery depositions, pursuant to the parties' Stipulation, with exhibits:
 - a. Dave Hochwalt;⁵
 - b. Daniel Robert Setlak, Petitioner's Vice President of Marketing;
 - c. Lisa Thorstenson, Respondent's Executive Vice President of Channel Marketing;
 - d. Michael Loomis, Respondent's Executive Vice President of Business and Product Development; and
 - e. Sharon Miller, Respondent's Director of Marketing and Communications.
7. Documents produced during the discovery period:⁶
 - (a) Declaration of Sarah Hajjar, Petitioner's Director, Interactive Marketing, and attached Exhibit A;
 - (b) Media in the nature of a CD-ROM obtained and produced through discovery; and
 - (c) Internet materials.

B. Respondent's Testimony and Evidence

Respondent introduced the testimony deposition of Lisa Thorstenson, Respondent's Executive Vice President of Channel Marketing, with attached exhibits (72 TTABVUE).

Respondent also filed Notices of Reliance (at 69, 70 and 71 TTABVUE) on:

1. Joint Motion for Approval of Stipulation dated November 18, 2013;
2. Order approving the parties' Stipulation;
3. Title and status copies of Reg. Nos. 3916902 and 3137309;
4. The registration file for Reg. No. 3137309;
5. Copies of third-party registrations purporting to show that Petitioner's mark is weak;
6. Documents produced during the discovery period, pursuant to the parties' Stipulation, purporting to show use of Respondent's mark;

⁵ In the pages it filed, Petitioner did not identify Mr. Hochwalt by title or position.

⁶ These documents have been introduced pursuant to the parties' Stipulation. *See* Trademark Rule 2.120(j)(3)(i), 37 C.F.R. § 2.120(j)(3)(i); TBMP § 704.11 ("Documents obtained through disclosure or under Fed. R. Civ. P. 34 may be made of record by stipulation of the parties."). The Stipulation is at 49 TTABVUE.

7. Printed publications purporting to show third-party use of similar marks; and
8. Complete copies of the following discovery depositions, including exhibits:
 - a. Thorstenson deposition;
 - b. Setlak deposition;
 - c. Miller deposition; and
 - d. Loomis deposition.⁷

Evidentiary Objections

Respondent makes several evidentiary objections in its trial brief. Specifically, Respondent objects to the introduction of the declaration of Sarah Hajjar and the accompanying exhibit; argues that Petitioner has not made its pleaded registration of record; and objects to Petitioner's trial record to the extent Petitioner has not submitted entire transcripts of testimony depositions filed under seal, and to Petitioner's submission of only portions of the discovery depositions that Petitioner selected to introduce.

We first address Respondent's objection to the Hajjar declaration, which we hereby sustain. A witness declaration may be submitted in the form of an affidavit (or declaration) only upon written agreement of the parties. Trademark Rule

⁷ The materials (listed 1-7 above) are at 69 TTABVUE and have not been filed under seal. The Notice of Reliance on the discovery depositions (No. 8 above) was not filed under seal but the depositions themselves were filed under seal at 71 TTABVUE. Respondent has not filed public versions of the depositions.

It is clear from a reading of the record that both parties have over-designated submitted materials as confidential. Petitioner refiled public versions of some materials but Respondent did not refile any public copies. Because Board proceedings are designed to be publicly available, the improper designation of materials as confidential thwarts that intention and makes it more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed. *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010). The Board is not obligated to treat as confidential materials that have been improperly designated as such. *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1656 (TTAB 2014) (party who relies on the testimony of a witness at trial cannot shield the identity of the witness from being made public).

2.123(b), 37 C.F.R. § 2.123(b). Here, the parties agreed, in their written Stipulation, to allow discovery depositions to be submitted as evidence in the proceeding, but the Hajjar declaration is not a discovery deposition. It is a declaration prepared and submitted in support of Petitioner's motion for summary judgment. Accordingly, we have not considered the Hajjar declaration or the exhibit attached to the declaration.

We next consider Respondent's objection to the introduction of Petitioner's pleaded registration. A plaintiff may make its pleaded registration of record by attaching to the petition to cancel (1) an original or photocopy of its pleaded registration prepared by the USPTO (showing the current status and current title to the registration), or (2) a current printout of information from the electronic database records of the USPTO showing current title to and status of the registration. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1). A plaintiff may also make its registration of record (3) by "appropriate identification and introduction during the taking of testimony" or (4) by attaching to a Notice of Reliance filed during the plaintiff's testimony period (a) an original or photocopy of the registration prepared and issued by the USPTO (showing both the current status of and current title to the registration), or (b) a current printout of information from the electronic database records of the USPTO, showing both the current title to and status of the registration. Trademark Rule 2.122(d)(2), 37 C.F.R. § 2.122(d)(2); *Research in Motion Ltd. v. NBOR Corporation*, 92 USPQ2d 1926, 1928

(TTAB 2009) (recognizing option to prove a pleaded registration by relying on USPTO electronic records attached to Notice of Reliance).

Respondent did not admit in its answer that Petitioner owns the registration. Petitioner did not introduce its registration by way of trial testimony or attach any relevant document to its petition to cancel or to a Notice of Reliance.⁸ The copy of Petitioner's registration that was attached to Petitioner's reply brief is untimely and has not been considered. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008) ("Evidence submitted outside of the trial periods — including that attached to briefs — is untimely, and will not be considered."). Petitioner argues, however, that its pleaded registration was properly introduced during the discovery deposition of Petitioner's Vice President of Marketing, Daniel Robert Setlak, as Exhibit 9 thereto.

A copy of Petitioner's original registration certificate was introduced into evidence as Exhibit 9 during Mr. Setlak's discovery deposition.⁹ Mr. Setlak

⁸ We have not considered the statement made by Dave Hochwalt that "Dan-Foam ApS is the owner of the Tempur-Pedic trademark" that is contained in the pages from his deposition submitted by Petitioner under its Notice of Reliance as establishing ownership or status of the registration. 89 TTABVUE 194. The statement is not specifically directed to the mark identified in the pleaded registration. Although a copy of the pleaded registration was included as an exhibit to the pages from his deposition that were filed under seal (but not with the public version), Mr. Hochwalt was not asked about the exhibit (either in the pages that were filed under seal at 62 TTABVUE or with the public version at 89 TTABVUE). Moreover, Petitioner — in any of the pages it did file — failed to identify Mr. Hochwalt by title or position, or include any signature page verifying the statements made during his deposition. These deficiencies have reduced the probative value of the information to zero.

⁹ 71 TTABVUE. Exhibit 9 and Mr. Setlak's deposition testimony directed to Exhibit 9 (Setlak Dep., p. 50) were filed under seal. However, we have considered the parties to have waived any objection to making public this information by their discussion of Respondent's evidentiary objection to its introduction.

identified the document as “the U.S. Patent and Trademark Office registration for the Tempur-Pedic trademark,” but he did not identify Petitioner as the current owner of the registration, or indicate its current status. Mr. Setlak’s testimony is insufficient to make the registration of record. *See, e.g., West Point-Pepperell, Inc. v. Borlan Industries Inc.*, 191 USPQ 53, 54 (TTAB 1976) (witness not qualified as a person having knowledge of the current status or ownership of the registrations; copies introduced during testimony incompetent to make registrations of record); *cf. Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (opposer may introduce registrations through witness testifying that registrations are still subsisting and are owned by opposer). Even were we to consider the statement, and the further discussion of Petitioner’s first use of the mark, as sufficient to indicate Petitioner’s ownership of the registration, the witness did not confirm that the registration remains active. *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985) (no probative value where testimony established opposer’s ownership of registration, but not current status). Further, Petitioner’s original registration certificate is not itself sufficient to make the registration of record. The certificate was issued to Petitioner more than three years prior to its submission as an exhibit and is thus not competent evidence of the *current* status of and title to the registration. A document relied upon to show the status and title to Petitioner’s registration must be reasonably contemporaneous with its filing. *See, e.g., Hard Rock Cafe Int’l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (status and

title copies prepared three years prior are not adequate to show current status and title); *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1043 (TTAB 2014) (plain paper copy accepted as being of record “because the date that registration was issued (March 29, 2011) is reasonably contemporaneous with the date the notice of opposition was filed (July 20, 2011).”).

Petitioner further argues that its pleaded registration has been brought into evidence by Respondent’s “implied consent.” The doctrine of “implied consent” is applicable when a determination of whether an issue, which is unpleaded and would otherwise not be adjudicated, has nonetheless been tried by the parties and should therefore be considered properly pleaded. Fed. R. Civ. P. 15. There is no question that Petitioner pleaded its registration, thus, here, we are dealing with a matter of proof, not whether an otherwise unpleaded issue has been tried by consent of the parties. The doctrine of “implied consent” is inapplicable. On the other hand, Petitioner’s pleaded registration may be brought into evidence if Respondent has treated the registration as admitted in its brief. *Local Trademarks Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156, 1157 n.5 (TTAB 1990) (applicant conceded ownership and validity of pleaded registration in its trial brief); *Jockey International, Inc. v. Frantti*, 196 USPQ 705, 706 n.5 (TTAB 1977) (“Although status copies showing title in opposer were never filed by opposer, ... applicant’s brief treats the registrations as being in the record and so shall we”). *See also Angelica Corp. v. Collins & Aikman Corp.*, 192 USPQ 387, 390 n. 1 (TTAB 1976) (“[S]ince applicant did not deny in its brief the current existence of the registrations

or opposer's ownership thereof, we consider them for what they are worth."); TBMP § 704.03(b)(1)(A) (a registration owned by any party may be deemed to be of record if the adverse party treats the registration as being of record in its brief).

Respondent argues in its brief that Petitioner has failed to make its pleaded registration of record.¹⁰ However, Respondent's brief also acknowledges that Petitioner's mark "registered on January 4, 2011,"¹¹ and (erroneously¹²) identifies Petitioner's pleaded registration as in the record, stating that "[b]y operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the Record includes the pleadings in this proceeding, the file history for Registrant's Mark, and Petitioner's pleaded registration[]."¹³ Respondent also states in its brief, as an argument against a finding of likelihood of confusion, that the 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 [to registration of Respondent's mark]."¹⁴ Against the weight of Respondent's clear objection to admitting Petitioner's registration into the record, these three statements are best read as incongruities or as merely admitting that the registration issued on the date

¹⁰ Respondent's Brief, p. 9, 76 TTABVUE 16.

¹¹ *Id.*, at 10.

¹² Although Respondent's registration is automatically part of the record pursuant to Trademark Rule 2.122(b)(1), the same is not true of Petitioner's pleaded registration. That rule covers only the application or registration *against which* the proceeding has been filed, *i.e.*, the defendant's application or registration. *Compare* Trademark Rule 2.122(b)(1) *with* Trademark Rule 2.122(d) (means for introducing the registration of an opposer or petitioner).

¹³ 76 TTABVUE 8.

¹⁴ *Id.*

indicated, and not as demonstrating that Respondent has stipulated to entry of Petitioner's registration in the record. *See Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (admission that registrations issued to opposer "on the dates indicated" insufficient to establish validity of registrations); *cf. Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 n.6 (TTAB 1984) (where plaintiff failed to properly introduce its pleaded registrations, but applicant assumed they were in the record and made no objection, Board treated the registrations' "currency and their ownership by opposer as having been stipulated"). Here, Respondent has clearly objected to admissibility and has not conceded the registration's currency or its ownership by Petitioner. Nor has Petitioner made a status and title copy of its pleaded registration of record by any of the means available to it under the Trademark Rules. Accordingly, we find the registration is not of record in this proceeding.

As to whether the trial transcripts are complete, our review of the testimony deposition transcripts that have been filed herein raises no issue as to whether the record is complete. We therefore accept them as filed. As for the fact that Petitioner submitted only portions of several discovery depositions under its Notice of Reliance, such practice is specifically contemplated by Trademark Rule 2.120(j), 37 C.F.R. § 2.120(j). Moreover, the deposition transcripts for Messrs. Setlak, Loomis, and Miller and for Ms. Thorstenson were made part of the record in their entireties by Respondent. Regardless of which party files it, when evidence has been made of

record “it may be used by any party to the proceeding for any relevant purpose.” *See Dynamark Corp. v. Weed Eaters, Inc.*, 207 USPQ 1026, 1028 n.2 (TTAB 1980).

Standing

Standing “requires only that the party seeking cancellation believe that it is likely to be damaged by the registration.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Petitioner has shown that it is using the pleaded TEMPUR-PEDIC and design mark in connection with, *inter alia*, mattresses, mattress toppers, and pillows and that it has a good faith claim of likelihood of confusion that is not lacking in merit. Accordingly, the record reflects that Petitioner has a direct commercial interest and standing to petition for cancellation of Respondent’s BODIPEDIC and design mark. *Id.*; *see also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Priority

In *inter partes* proceedings before the Board where the plaintiff asserting a Section 2(d) claim has not introduced its own registration, the Section 2(d) priority test is whether plaintiff’s unregistered mark or trade name was “previously used” as of the earliest date on which the defendant can rely for priority purposes. *See, e.g., West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994) (“A party claiming prior use of a registered mark may petition to cancel the registration on the basis of such prior use pursuant to section 14 of the Lanham Act.”). Respondent may rely on the filing date of its registration, June 24,

2010, for priority purposes. *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“It is well settled that in the absence of any evidence of earlier use, the earliest date upon which respondent may rely is the filing date of its underlying application.”); *see also Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995). Respondent has presented evidence and testimony attesting to an earlier first use date. In answer to requests for admission¹⁵ and in its answers to interrogatories,¹⁶ Respondent indicated April 2008 as its date of first use. In her testimony, Lisa Thorstenson stated that she believed Respondent’s date of first use to be April 2009.¹⁷ Either way, Petitioner testified that it first used its mark in connection with mattresses, pillows and mattress toppers in May of 2007.¹⁸ Accordingly, Petitioner has demonstrated that its use is prior to the earliest date upon which Respondent can rely. Thus, Petitioner has established priority with respect to its pleaded mark and mattresses, pillows and mattress toppers.¹⁹

Likelihood of Confusion

We now turn to a consideration of the issue of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Our determination under Trademark Act § 2(d) is based on an analysis of the probative facts in evidence that

¹⁵ 89 TTABVUE 15.

¹⁶ *Id.* at 28.

¹⁷ 89 TTABVUE 298.

¹⁸ Setlak Dep., 71 TTABVUE 358 (confidential); 89 TTABVUE 218 (public); Exhibit 10 (confidential report of yearly sales figures).

¹⁹ The parties each sell an item designed to overlay on top of a mattress for additional comfort; Respondent describes the item as a “mattress topper” and Petitioner as a “top mattress.”

are relevant to the factors bearing on a likelihood of confusion. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imp., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *see also In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999). Petitioner must establish that there is a likelihood of confusion by a preponderance of the evidence.

Fame of Petitioner’s Mark

We start with the fifth *du Pont* factor, “fame of the prior mark.” Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Because “[d]irect evidence of fame, for example, from widespread consumer polls, rarely appears in contests over likelihood of confusion,” fame for likelihood of confusion purposes “may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark and by the

length of time those indicia of commercial awareness have been evident.” *Bose Corp.*, 63 USPQ2d at 1305. Relevant factors also include market share, brand awareness, licensing activities, and variety of goods bearing the mark. *Recot*, 214 F.3d at 1326. Because of the wide latitude of legal protection accorded a famous mark, the party asserting fame must clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Petitioner’s claim that its mark is famous is largely based on its sales and advertising figures, which have been submitted as confidential and hence are not disclosed in this opinion. We find that Petitioner’s sales and advertising figures for products bearing the pleaded TEMPUR-PEDIC and design mark are impressive. Petitioner originally adopted an earlier version of the mark (containing the words TEMPUR-PEDIC forming a base for a reclining figure on a pillow design) in the early 1990s and first used the mark in its current format in 2007.²⁰ Mr. Setlak testified that Petitioner uses the mark across all of its product lines.²¹ Petitioner sells its products nationwide through major department stores such as Macy’s, Bloomingdale’s and JCPenny’s, at mall-based stores such as Brookstone, and through mattress stores, furniture stores, wholesale clubs and specialty back stores.²² Petitioner also sells direct-to-consumer via phone sales, and via the

²⁰ Setlak Dep., 89 TTAVUE 218-19 (identifying the common elements that appear in the original version and the 2007 revised version).

²¹ *Id.*, 89 TTABVUE 198.

²² *Id.*, 89 TTABVUE 203-4.

Internet.²³ A confidential list of retailers selling Petitioner's goods numbered over 2,200.²⁴ Petitioner advertises in "hundreds of [magazine] titles,"²⁵ such as *Better Homes and Gardens*, *The New Yorker*, *Traditional Home*, *Popular Science*, *Popular Mechanics*, and *Discovery* as well as in the newspaper *USA Today*.²⁶ Petitioner also has placed "several million dollars of Internet advertising every year,"²⁷ and has spent "tens of millions of dollars" on television advertising.²⁸ Many of Petitioner's retailers conduct their own advertising campaigns for Petitioner's goods, using Petitioner's mark,²⁹ and Petitioner has received unsolicited media attention that recognizes "TEMPUR-PEDIC" as a major mattress brand.³⁰ Likewise, Respondent's use of Petitioner's word mark in two instances reinforces a finding that Petitioner's

²³ *Id.*, 89 TTABVUE 202.

²⁴ *Id.*, Exhibit 11.

²⁵ *Id.*, 89 TTABVUE 210.

²⁶ *Id.*, Exhibit 7.

²⁷ *Id.*, 89 TTABVUE 212.

²⁸ *Id.*, 89 TTABVUE 214.

²⁹ *Id.*, 89 TTABVUE 215.

³⁰ For example, a 2012 Consumer Reports survey, "*Unemployed Americans More Likely To Suffer From Sleep Problems Than Those With Jobs*," cites TEMPUR-PEDIC memory foam mattresses as one of the best brands for improving sleep. 89 TTABVUE 54. An article in the July 2, 2012 online edition of *Tire Business* entitled "*Eco tires advance, but many buyers not shopping for them*" shows the reach of the TEMPUR-PEDIC brand even in unrelated fields. In explaining how an "eco tire" sidewall takes back its shape after hitting an obstruction in the road, the speaker being interviewed likens the product to a "Tempur-Pedic mattress with memory foam." 89 TTABVUE 66.

mark is well-known. The first involves keyword advertising³¹ and the second involves a pressure mapping test.³²

Based on the evidence, we find that Petitioner's mark is famous. When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a "long shadow which competitors must avoid." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (citing *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992); *Nina Ricci S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074, 12 USPQ2d 1901, 1904 (Fed.Cir.1989) ("There is no excuse for even approaching the well-known trademark of a competitor." (internal quotations omitted)). Although fame alone cannot overwhelm the other *du Pont* factors as a matter of law, see *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed.Cir.1983), fame deserves its full measure of weight in assessing likelihood of confusion. This factor heavily favors Petitioner.

The Goods

We next address the respective goods of Petitioner for which Petitioner has priority (mattresses, pillows and mattress toppers) and Respondent's mattress toppers, pillows, and mattresses, to determine whether they are sufficiently related to give rise to potential confusion. The record shows that both parties sell

³¹ Thorstenson Dep., 71 TTABVUE 80. This information was filed under seal; therefore we do not include the details here.

³² Loomis Dep., 71 TTABVUE 1156, Exhibits 6, 8. This information was also filed under seal; therefore we do not include the details here.

mattresses and pillows constructed from foam material, the properties of which have been touted in each party's advertising.³³ These goods are identical. The parties' "mattress toppers" and "top mattresses" are at least legally identical; when asked to identify what products Petitioner offers, Mr. Setlak testified that Petitioner sells, *inter alia*, a "pillow overlay mattress topper."³⁴ Accordingly, the second *du Pont* factor strongly favors a finding of likelihood of confusion.

Trade Channels and Classes of Purchasers

Respondent contends that the parties' trade channels are not the same because it only sells via the Internet through a third-party online retailer, Overstock.com.³⁵ However, Petitioner currently sells its goods over the Internet via a website maintained or owned by Petitioner,³⁶ and many of the third-party retailers who sell Petitioner's mattresses and pillows have their own e-commerce presence.³⁷ Respondent's goods are also advertised via a popular Internet-based retailer³⁸ by third party resellers. In the past, both parties sold mattresses through the same well-known, membership-only, warehouse club store.³⁹ Thus, the trade

³³ See, on behalf of Respondent, Respondent's answers to Petitioner's request for admissions Nos. 44 and 45; 89 TTABVUE 21. Petitioner's statements regarding the construction of its products were filed under seal. See Setlak Dep., 71 TTABVUE 360 and Loomis Dep., 71 TTABVUE 1143. Michael Loomis is Respondent's Executive Vice President of Business and Product Development. 89 TTABVUE 397.

³⁴ 89 TTABVUE 207.

³⁵ Respondent's Brief, 76 TTABVUE 11. See also Loomis Dep., 89 TTABVUE 397.

³⁶ Setlak Dep., 89 TTABVUE 202.

³⁷ Setlak Dep., 89 TTABVUE 203.

³⁸ Loomis Dep., 71 TTABVUE 1152 (the name of the online retailer is not included here because the entire deposition was marked confidential).

³⁹ Loomis Dep., 71 TTABVUE 1149 (confidential); Setlak Dep., 89 TTABVUE 206.

channels are similar and at one time directly overlapped. Regarding the classes of consumers, both parties target ordinary purchasers within the same consumer demographics as to age, income, and gender.⁴⁰

The *du Pont* factors relating to the similarity or dissimilarity of established, likely-to-continue trade channels and classes of purchasers favor Petitioner.

Care and Sophistication of the Purchasers

The fourth *du Pont* factor includes a consideration of the conditions under which sales are made, that is, whether purchasers are careful and sophisticated or whether sales are made on impulse. Respondent argues that the goods are expensive, and of a type that would be purchased only after careful consideration of their health and wellness benefits. We agree that the relevant purchasing class includes discerning consumers, but the realm of potential purchasers also includes average consumers using ordinary care, since mattresses and pillows are common, necessary household items. Both parties' pillows sell for similar prices⁴¹ and with respect to these items, consumers would exercise ordinary levels of care in their purchasing decisions. As for mattresses, while Petitioner's mattresses cost well into the thousands of dollars and Respondent's mattresses are sold at significantly lower

⁴⁰ Specific information regarding these demographics has been filed under seal. Setlak Dep., 71 TTABVUE 81, 84, 86 (confidential); Thorstenson Dep., 71 TTABVUE 92 (confidential).

⁴¹ Thorstenson Dep., 71 TTABVUE 73 (confidential) and Setlak Dep., 71 TTABVUE 413, 417 (confidential). As this information is marked confidential, we have discussed the information in only general terms.

price points,⁴² some of Petitioner's mattresses at the lower end of Petitioner's product line have sold for approximately the same price as Respondent's mattresses. Moreover, even sophisticated consumers are not necessarily knowledgeable in the field of trademarks, and as such, are not immune from trademark confusion. *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

We find that this factor is neutral.

Third-party Use of Similar Marks

Evidence of third-party use bears on the strength or weakness of a plaintiff's mark. *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) ("The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection."). *See also Palm Bay*, 73 USPQ2d at 1693 ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.").

Respondent has submitted Internet evidence showing that close to 50 companies sell mattresses, pillows and related goods under marks that incorporate the term "-pedic."⁴³ Printouts of these third-party websites were attached to

⁴² Thorstenson Dep., 71 TTABVUE 73 (confidential) and Setlak Dep., 71 TTABVUE 413, 417 (confidential). As this information is marked confidential, we have discussed the information in only general terms.

⁴³ Respondent's first Notice of Reliance, 69 TTABVUE, Exhibit F and Thorstenson Test. Dep., 72 TTABVUE.

Cancellation No. 92054201

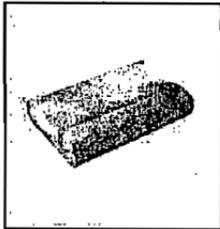
Respondent's Notice of Reliance, demonstrating use of the following "-pedic" marks:⁴⁴



504



531



Pillo-Pedic®

544



546



552

Simmons Maxipedic Tarpon Cushion Firm Mattress^{Pro®}

554

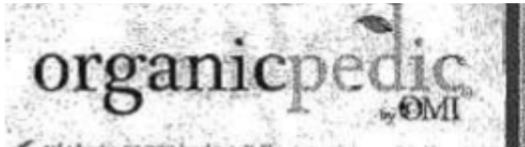
⁴⁴ 69 TTABVue 503-697, Exhibit I. The numbers following the display of each mark indicates the page from which the information was taken.

Perfect Density Memory-Pedic Memory Foam Mattresses

557



561 (mattresses, pillows and pillowcases)



563



567

Sealy Posturepedic Twin Pack PrimaLoft Support Pillows

571

The Amazing Benefits of Owning a Primopedic

4.8 out of 5 stars (10 customer reviews)

576

Sertapedic University Park Firm Mattress Product Code SR3104

579

SnoozerPedic DreamWeaver Memory Foam Body Pillow

by Zenk Designs, Inc

★★★★☆ (4 customer reviews)

581

Englander Viscopedic 5121 Memory Foam Mattresses, Queen, Chamois/Beige by Englander

585

Dream On Me Ultrapedic, Convoluted Crib and Toddler Bed Mattress
by Dream On Me

586

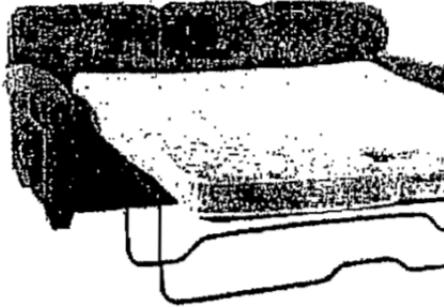
ViscoPedic Memory Foam Sleeping Pillows

589



Therapedic MemoryTouch Neck Pillow

592 (and mattresses)



Jennipedic Deluxe Queen Innerspring

596

NimblepedicTM Memory Foam Mattress

605

(and

pillows and mattress overlays)



the healthy mattressSM

611



613

Somnapedic Memory Foam Mattress by PostureCraft

614

Super Pedic Memory Foam King Mattress

615

Symbol Pedic Belair Mattress Set 617

TRI-PEDIC Memory Foam Mattress 620


VISCO-PEDIC
Visco Elastic Memory Foam 624

Vita Pedic Collection "Aphrodite Plush" (Medium) 627

ComforPedic Loft Air Cool™ 629

Bob-O-Pedic 6 630

Crown-O-Pedic Baron Mattress by Eclipse 632

Dream-O-Pedic® 633


GUSTO-PEDIC 635

Health-o-pedic' 636

Dreamstar
King O Pedic 638

RESTOPEDIC
Restopedic Mattresses

639

Spring-O-Pedic (SOP)

646

Stress-O-Pedic™ - America's Finest Made Beds!

652

Agility® – Therapedic International

656

QUEEN RV Mattress. AERO-PEDIC Memory Foam Queen Mattress. 60"x79"

by Paramount Bedding

658

SEARS-O-PEDIC ®/MD Cotton Mattress Pad

676

(and

mattresses)



680



682

Sleep Solutions Enviro - Pedic Double Mattress

684



686

**Faraday Queen Sleeper
with Sleep-O-Pedic
Mattress**

690



692

**Posturecraft Visco Somna-Pedic
Mattress: TPQK-VSPM**

693

Flex-o-Pedic adjustable beds

694

The evidence of extensive third-party use strongly suggests that many competitors in the mattress business use the “-pedic” suffix to imply that their products are “orthopedic,”⁴⁵ that is, beneficial in preventing and correcting aches and pains associated with bones, joints and muscles such that sleeping on the branded mattresses may avoid or alleviate bodily pain. Respondent has also

⁴⁵ Orthopedics is defined as “the branch of medicine that deals with the prevention and correction of injuries or disorders of the skeletal system and associated muscles, joints, and ligaments.” *The American Heritage Stedman's Medical Dictionary* (Houghton Mifflin Co. 2002).

submitted copies of over sixty third-party, use-based registrations in connection with bedding products such as mattresses and pillows incorporating the term “-pedic.”⁴⁶ The third-party registrations are clearly consistent with a finding that the “-pedic” element of the registered and used marks are weak. “[E]xtensive evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation*).

While we accept that the “-pedic” suffix in Petitioner’s mark is weak, we are not persuaded by the evidence of third-party use and registration of “reclining figure” design marks that Petitioner’s specific figure design is also so weak that purchasers will tend to discount it and look to other features when considering the overall commercial impact of Petitioner’s mark. The evidence shows that there are thirteen “reclining figure” design marks in use for mattresses and related goods and

⁴⁶ Examples submitted with Respondent’s first Notice of Reliance (69 TTABVUE) include:

PILLO-PEDIC (69 TTABVUE 99); CRADLEPEDIC (69 TTABVUE 102); ENVIROPEDIC (69 TTABVUE 106); LATEXPEDIC (69 TTABVUE 109); MAXIPEDIC (69 TTABVUE 111); MEMORYPEDIC (69 TTABVUE 114); NATUREPEDIC (69 TTABVUE 123); OSTERPEDIC (69 TTABVUE 128); VERLOPEDIC (69 TTABVUE 131); POSTUREPEDIC (69 TTABVUE 134); PRIMOPEDIC (69 TTABVUE 143); SACROPEDIC (69 TTABVUE 145); and SERTAPEDIC (69 TTABVUE 147); AMERICAN PEDIC (69 TTABVUE 179) COMFOR-PEDIC (69 TTABVUE 184); CONTOUR PEDIC (69 TTABVUE 188); ECONO-PEDIC (69 TTABVUE 191); FLOW-PEDIC (69 TTABVUE 193); GEL-PEDIC (69 TTABVUE 195); JENN-PEDIC (69 TTABVUE 201); LUMBAR PEDIC (69 TTABVUE 204); NIMBLE-PEDIC (69 TTABVUE 206); RX PEDIC (69 TTABVUE 208); SENSOR PEDIC (69 TTABVUE 210); SIR PEDIC (69 TTABVUE 213); SUPER PEDIC (69 TTABVUE 215); SYMBOL PEDIC (69 TTABVUE 219); ULTRA-PEDIC (69 TTABVUE 221); VISCO PEDIC (69 TTABVUE 244); and VITA PEDIC (69 TTABVUE 247).

eleven such use-based third-party registrations. The designs shown to be in use are:⁴⁷



The marks in the eleven registrations are:⁴⁸

⁴⁷ Thorstenson testimony, 72 TTABVUE 18-218. Numbers following the depictions of the marks indicate the page at which the web page is found. There is one additional mark, belonging to Respondent (for the mark COMFORT WAVE and design) that was identified by Ms. Thorstenson in her confidential testimony and filed under seal. 71 TTABVUE 129, Exhibit 26. As the mark was used in promotional material, Respondent's designation of it as confidential is improper and we will not be bound thereby.

⁴⁸ These registrations were filed with Respondent's first Notice of Reliance. The numbers following each mark indicate the page of 69 TTABVUE at which the registration may be found.



The wide use of these similar marks by others in the field show that reclining figures in general are suggestive of bedding products, but they are too disparate in their visual renditions to show that Petitioner's specific reclining figure design is weak. None is drawn with the measure of detail with which Petitioner's mark is drawn, but are more abstract line drawings, or cartoonish renderings. Further, only three of these marks include both the term "pedic" and any type of design, and of these, only two are formatted like Petitioner's mark, that is, with a recognizable reclining human figure drawn so as to appear to be laying on its side on top of a mattress. Those marks are depicted below.



In summary, the evidence shows that “-pedic” as a suffix is weak for bedding products but reclining figure designs are suggestive only, and that Petitioner’s mark as a whole is inherently somewhat weak. This factor slightly favors Respondent.

The Marks

We next consider the marks in their entirety as to appearance, sound, connotation and commercial impression, to determine the similarity or dissimilarity between them. The “touchstone of this factor is consideration of the marks in total.” *Jack Wolfskin*, 116 USPQ2d at 1134. *See also Juice Generation*, 115 USPQ2d at 1676 (explaining that “the message of a whole phrase may well not be adequately captured by a dissection and recombination”); *In re Viterra*, 101 USPQ2d at 1362 (“[M]arks must be viewed ‘in their entirety,’ and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design.”). The marks ‘must be considered ... in light of the fallibility of memory ...,” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014), and the proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013).

Where, as here, the goods are in-part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a

recognizable disparity between the goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Both Respondent's and Petitioner's marks are combinations of design and word elements.



When a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *See In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). Here, the word element of each mark is four syllables long, ending in “-pedic.” We have already noted that the suffix is weak, but it lends a similar visual and aural characteristic to each mark, and is emphasized (by bold style lettering) in Respondent's mark, enhancing the likelihood that consumers will recollect it. The cadence of each mark, when spoken, will be the same. The designs of each mark are also similar. Both figures appear to be unclothed, and are lying on their side on top

of the word portion of the mark as if the words were a mattress. Petitioner's figure is clearly feminine and Respondent's figure suggests feminine curves rather than masculine ones. Of lesser significance are the facts that the figures are facing in different directions, which is not likely to be recalled by consumers, and that Petitioner's mark is prefaced by a cross/plus design, which is a common geometric shape that consumers are unlikely to focus on. And although "Tempur" and "Bodi" are distinguishable separate elements, they are not considered in a vacuum. The analysis must be based on the entire marks, not just on part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion"). For these reasons, the marks are similar in overall appearance and somewhat similar in pronunciation. In connotation and overall commercial impression, both marks suggest that the goods are intended to conform to one's body to create a restful sleep, relieve pressure and provide orthopedic support. Accordingly, due to the presence of similar word and design elements, we find that the marks are similar in appearance, pronunciation, connotation and overall commercial impression.

Respondent argues that because it owns an unchallenged registration for the word mark BODIPEDIC that is more than five years old,⁴⁹ we are precluded in our

⁴⁹ Reg. No. 3137309.

analysis from finding a likelihood of confusion between the two word marks, and by extension, between the marks at issue in this proceeding. We disagree. Respondent's BODIPEDIC and design mark is not substantially identical to its previously registered BODIPEDIC word mark. *O-M Bread Inc. v. U.S. Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995) (stating that the *Morehouse* defense requires "that the prior and proposed marks be essentially the same"); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1711 (TTAB 2010) ("For purposes of the *Morehouse* defense, the two marks must be 'substantially identical,' meaning that they are either literally identical or legally equivalent."), *aff'd unpublished*, Nos. 2011-1052, -1053 (Fed. Cir. Nov. 9, 2011). The reclining figure in Respondent's mark is a significant feature thereof and its presence is critical in defining the commercial impression made by the mark at issue herein. Therefore, the *Morehouse* defense is unavailing. We also disagree with Respondent's argument that there can be no likelihood of confusion where, as here, the words TEMPUR-PEDIC and BODIPEDIC have been separately registered as standard character marks that have co-existed on the Principal register for more than five years. Even if the marks are dominated by their word elements, the fact that the word marks have co-existed on the register does not mean there can be no likelihood of confusion between the composite marks. We reiterate that our determination rests on the public perception of the overall commercial impressions of the marks and not on their constituent parts.

The similarity between the marks outweighs their dissimilarity. The first *du Pont* factor weighs in Petitioner's favor in our likelihood of confusion analysis.

Actual Confusion

The final *du Pont* factor discussed by Petitioner and Respondent is Petitioner's assertion of actual confusion. The existence of actual confusion is normally very persuasive evidence and undercuts any possible claim that the marks are so dissimilar that there can be no likelihood of confusion. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201 (Fed. Cir. 2003) ("A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion."); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1604 (TTAB 2011); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975) (single instance of confusion is at least "illustrative of how and why confusion is likely").

Petitioner submits the testimony deposition of Jane Martin, who purchased a mattress through Overstock.com in 2008. She testified that she thought the mattress she had purchased was a Tempur-Pedic brand, when in fact it was a Bodipedic brand.⁵⁰ About a year later, she purchased a mattress topper that she also believed was sold by Petitioner, but again was Respondent's brand.⁵¹ Although she did not recall seeing Respondent's design mark on the website, Ms. Martin

⁵⁰ 89 TTABVUE 559.

⁵¹ *Id.*, at 561.

stated that she assumed the mattress was a Tempur-Pedic product because it “was advertised” as such.⁵²

Respondent argues that Ms. Martin’s testimony, standing alone, is insufficient to prove actual confusion, and that because Ms. Martin was unable to recall seeing Respondent’s design mark when she shopped for a mattress online, her confusion is attributable to the words alone, which are irrelevant, the word marks having been concurrently registered for well over five years.

We find Ms. Martin’s mistaken impression that she was purchasing a TEMPUR-PEDIC mattress highly probative that a likelihood of confusion exists between the word marks TEMPUR-PEDIC and BODIPEDIC. This testimony is not irrelevant. The fact that Ms. Martin does not specifically recall whether there was a reclining figure design as part of the mark that appeared in the website at the time she purchased her mattress or mattress topper, is not critical; Ms. Thorstenson, in her testimony, confirmed that Respondent’s design mark appears on the Overstock.com website.⁵³ Further, Petitioner submitted additional evidence of actual confusion: two confidential reports produced by Overstock.com consisting of transcripts of customer inquiries regarding any BODIPEDIC product, where the customer or Overstock’s representative referred to either “tempur,” “tempurpedic,” or “tempur-pedic” during the conversation. The first report was prepared in 2012;⁵⁴

⁵² *Id.*, at 560.

⁵³ Thorstenson Dep., 71 TTABVUE 43 (confidential).

⁵⁴ Neeshan Test. Dep., 68 TTABVUE 73-157 (confidential).

the second was prepared in 2013.⁵⁵ They were authenticated by Victoria Neeshan, Associate Director of Technology Operations at Overstock.com, who explained the manner in which customer comments are collected and retained.⁵⁶ In about a half-dozen instances, the recorded statements indicate the caller's belief that he or she ordered a "Tempur-pedic" mattress when they had actually ordered a BODIPEDIC mattress.

We find the totality of the evidence sufficient to support a finding that actual confusion occurred, and consider this *du Pont* factor to strongly favor Petitioner. We recognize that none of the recorded sessions include any reference by either a customer or sales representative to the "BODIPEDIC and design" mark involved herein, the oral references being to the word marks alone. However, it would be highly unconventional for someone to reference the design as part of the mark over the telephone, in email or during an online chat. Even if we were to consider the probative value of the Overstock.com reports as neutral in light of the lack of direct statements from confused customers referring to the design mark *per se*, we would still find confusion based on Ms. Martin's testimony. This *du Pont* factor strongly favors a finding of likelihood of confusion.

Balancing the factors.

Petitioner's mark has marketplace fame and as such is accorded the wide scope of protection to which a famous mark is entitled. The parties' goods are in-part identical and the trade channels overlap. There is also evidence that actual

⁵⁵ *Id.*, 68 TTABVUE 162-233 (confidential).

⁵⁶ *Id.*, at 68 TTABVUE 18.

confusion has occurred. The purchasers include ordinary consumers who would exercise only ordinary care, particularly in the purchase of the lesser-priced pillows. The marks are more similar than dissimilar in their overall appearance, pronunciation, connotation and commercial impressions. To the extent the term “-pedic” and a reclining figure design are common themes among marks for bedding products, Petitioner’s mark nonetheless has achieved marketplace fame. On balance, the fame of Petitioner’s mark, the evidence of actual confusion, the relatedness of the goods and trade channels and the fact that the classes of potential purchasers includes average consumers outweigh the dissimilarities in the marks and weakness of constituent parts. We find that Respondent’s registration of

the mark  is likely to cause confusion with Petitioner’s previously used and registered mark  under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Decision: The petition to cancel is granted.