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

*In the Matter of Application No. 76/520,372*

Filed: May 29, 2003

Published in the Official Gazette of: November 26, 2003

Mark: TEMPER-PETIC



01-29-2004

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

TEMPUR WORLD, LLC,  
TEMPUR-PEDIC, INC., and  
DAN FOAM APS,

Opposers,

Opposition No. \_\_\_\_\_

v.

ROBERT A. MCNAE

Applicant.

**NOTICE OF OPPOSITION**

**Box TTAB FEE**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

In the matter of the application for registration of the trademark TEMPER-PETIC for animal beds in International Class 20, Application Serial No. 76/520,372, filed May 29, 2003, by Robert A. McNae, an individual residing at 1000 Superior Blvd., Wayzata, Minnesota 55391 (hereinafter "Applicant") and published for opposition in the Trademark Official Gazette of November 26, 2003, Tempur World LLC (formerly known as Tempur World, Inc.) a Delaware corporations of Lexington, Kentucky; Tempur-Pedic, Inc. a Kentucky corporation of Lexington, Kentucky; and Dan-Foam ApS, a Denmark corporation of Denmark, (hereinafter collectively referred to as "Opposers") believe they will be damaged by registration of said mark and hereby

oppose same. The grounds for this opposition are as follows:

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1. Opposers are in privity as affiliated companies whose use of these trademarks is under common control pursuant to 37 C.F.R. § 2.102(b).

2. Tempur World, LLC is an affiliate of Dan Foam ApS, a Denmark-based corporation and Tempur-Pedic, Inc., a U.S.-based corporation. Tempur World, LLC, through its wholly-owned subsidiary Tempur World Holdings, LLC owns Dan Foam ApS and Tempur-Pedic, Inc., and indirectly asserts control over the activities and operations of these companies, including the selection, adoption and use of its trademarks, providing unity of control as required under 15 U.S.C. § 1055.

3. All three Opposers have been named as several of the registrations pleaded herein are owned individually by Tempur World, LLC's subsidiaries, Tempur-Pedic, Inc. and Dan Foam ApS, while some of the registrations are owned by Tempur World, :LLC (formerly known as Tempur World, Inc.) The relationship of the parties named as Opposers in this action is one of "related companies" as that term is defined under 15 U.S.C. § 1127.

4. Long prior to March 29, 2003, the filing date of Applicant's application for the TEMPER-PETIC mark, the date of first use alleged by Applicant, Opposers adopted and used in commerce a distinctive family of "TEMPUR-" marks, including TEMPUR-PEDIC, TEMPUR MED, TEMPUR, and TEMPUR & Design, in connection with the manufacturing, marketing, sale and distribution of mattresses, cushions and pillows made of elastic viscous foam and related products.

5. Since at least as early as 1992, Opposers have made continuous use of the TEMPUR-PEDIC trademark. In addition, they have used the formative TEMPUR alone and with various suffixes since long prior to Applicant's filing date, and such use has been ongoing and continuous.

6. The following marks, United States Trademark Registrations for the TEMPUR marks are valid and subsisting on the Principal Register:

<u>Mark</u>	<u>Reg. No.</u>	<u>Registration Date</u>
a. TEMPUR	1,926,469	October 10, 1995
b. TEMPUR-PEDIC*	1,853, 088	September 6, 1994
c. TEMPUR & DESIGN*	2,495,299	October 9, 2001
d. TEMPUR MED*	1,924,637	October 3, 1995

7. The above registrations noted with an asterisk are incontestable and constitute conclusive evidence, and the remaining registration is valid and subsisting and constitutes *prima facie* evidence, of the validity of the registered marks and of the registration thereof and of the Applicant's ownership of the marks and exclusive right to control the use of the marks on and in connection with the goods recited in the registration certificates and related goods. Said registrations also constitute notice to Applicant of Opposers' rights in the marks shown therein.

8. For over ten (10) years, Opposers have been marketing and selling mattresses, cushions, pillows, and pads made of elastic viscous foam in the United States under the TEMPUR-PEDIC trademark and have sold such goods under the TEMPUR-PEDIC trademark and derivative TEMPUR- family of marks for many years.

9. Opposers developed their products using a secret and proprietary formula and process, which has been extensively tested. Opposers have expended tremendous time, effort, and money in developing and testing this unique, proprietary foam. The products sold under and bearing the TEMPUR-PEDIC mark and name and TEMPUR- family of marks are therefore unique and of extremely high quality.

10. Opposers have expended tremendous time, effort, and money in advertising and promoting these unique products under the TEMPUR-PEDIC mark and name and TEMPUR-family of marks. As a result, the TEMPUR-PEDIC mark and name and TEMPUR- marks are famous among the purchasing public and the trade as denoting Opposers as the source of high-quality mattresses, cushions, pillows, pads and related goods (including animal or pet beds.)

11. Opposers have a website where they advertise their products and services and also display information about the company and the products and services. This website is accessible through the domain name, [www.tempurworld.com](http://www.tempurworld.com), and the TEMPUR-PEDIC and TEMPUR-family of marks are used prominently on this site.

12. Opposers market their goods under the TEMPUR-PEDIC mark and TEMPUR-family of marks through extensive advertising in trade publications and magazines of general circulation, as well as through authorized retailers, sales associates and employees throughout the United States. The products marketed under the TEMPUR-PEDIC mark and TEMPUR-family of marks have been featured on NBC's Dateline NBC in a segment entitled, "Dateline Discovery." In addition, in May 1998, Tempur-Pedic received an award from NASA in recognition of its achievement in bringing NASA technology to consumer products. Recently, the President and CEO of Tempur World, Inc. accepted Ernst & Young's "2003 Entrepreneur of the Year" Award for Consumer Products. Ernst & Young highlighted Opposers' organization, noting their global staff of more than 900 employees selling products in more than 40 countries. All such media coverage has heightened consumer awareness about elastic viscous products and brought attention to Opposers such that customers rely on them to provide products of extremely high quality.

13. Opposers have sold elastic viscous foam products throughout the United States under the TEMPUR-PEDIC mark and trade name and the TEMPUR- family of marks. Opposers are well and favorably known throughout the United States and have built up valuable good will and reputation in the TEMPUR-PEDIC and TEMPUR- trademarks.

14. As a result of the widespread and continuous use and promotion of the TEMPUR-PEDIC and TEMPUR- family of marks, the marks have achieved tremendous fame and distinctiveness and are widely known and recognized as source-identifiers for a variety of goods and services originating with Opposers and serve to distinguish those goods and services from those of others. Said marks represent and embody Opposers' enviable reputation and very valuable goodwill among members of the trade and the purchasing public.

15. Opposers' distinctive TEMPUR-PEDIC mark and TEMPUR- family of marks are famous and identify Opposers as the source of the goods. Opposers' TEMPUR-PEDIC and TEMPUR- marks achieved fame long prior to Applicant's filing date or date of first use.

16. Applicant's application for THERMO PEDIC is based upon an intention to use the mark and was filed on May 29, 2003. The goods listed in the application are "animal beds" in International Class 20.

17. The mark TEMPER-PETIC sought to be registered by Applicant is confusingly similar in appearance, sound and connotation to Opposers' TEMPUR-PEDIC mark.

18. Use and/or registration of Applicant's mark on its goods will be likely to cause confusion, to cause mistake, and to deceive as to the source of Applicant's goods and to induce purchasers to believe that the goods of Applicant emanate from Opposers or are endorsed or licensed by Opposers or are in some other way connected with Opposers.

19. Applicant's registration of the mark TEMPER-PETIC, if granted, will lessen the capacity of TEMPUR-PEDIC to identify and distinguish Opposers' goods and therefore will dilute Opposers' famous TEMPUR-PEDIC mark and name and TEMPUR- family of marks, and the presence of Applicant's application on the register actually dilutes Opposers' rights in Opposers' marks. Additionally, said registration, if granted, will be considered at least *prima facie* evidence of Applicant's exclusive right to use the TEMPER-PETIC mark, a further source of damage to Opposers.

20. Due to Opposers' priority as to their use of Opposers' marks and the likelihood of confusion alleged above, Applicant is not entitled to the registration sought, and said registration, if allowed, would be a source of injury and damage to Opposers.

21. Applicant does not have permission from Opposers to use or register its mark.

WHEREFORE, Opposers request that the opposition be sustained and that the registration sought by Applicant be refused.

Enclosed herewith is a check in the amount of \$300.00 in payment of the requisite fee for one class. Please charge any underpayment or credit any overpayment to Deposit Account No. 09-0260. This document is being submitted in duplicate. In the event that the Board does not agree with Opposers' contention that the parties named as Opposers are in privity, please charge any additional sums due to the above-noted deposit account.

Dated this 26<sup>th</sup> day of January, 2004

Respectfully submitted,

Michael Best & Friedrich LLP  
Attorneys for Tempur World, LLC  
Tempur-Pedic, Inc. and Dan Foam ApS

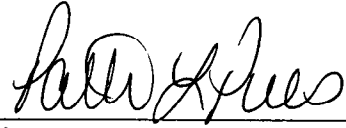
By: \_\_\_\_\_



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## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, Attention: TTAB on this 26th day of January, 2004.

A handwritten signature in cursive script, appearing to read "Patti L. Pues", written over a horizontal line.

Patti L. Pues