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

Proceeding	91203260
Party	Defendant Serta Inc.
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Attachments	Serta's Reply in Support of Its Motion to Compel.pdf(401926 bytes)

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

Application Serial Nos.: 85160970
Mark: COOL ACTION
International Classes: 20, 25
Applicant: Serta, Inc.
Date of Publication: August 30, 2011

Action Products, Inc.,)
)
Opposer,) Opposition No.: 91203260
)
v.)
)
Serta, Inc.,)
)
Applicant.)

SERTA’S REPLY IN SUPPORT OF ITS MOTION TO COMPEL

In its Response, Action insists that its discovery responses are sufficient, indeed, “more than adequate,” using as a measuring stick its own beliefs, void of almost any reference to the Notice of Opposition, Board Rules, Federal Rules or case authority. While Action alleges in its Notice of Opposition a likelihood of confusion with the “goods long offered by [Action] under [its] ACTION marks, . . . corporate name and Action’s trade name,” it steadfastly refuses to provide discovery about that allegation. *See* Notice of Opposition paragraphs 7, 9, 10, 12, 13 and 15. It refuses to provide discovery about customers or channels of commerce other than to say that it sells to “wholesale, retail and Internet purchasers.” And it refuses to explain the basis for its allegations of likely confusion even though the respective goods appear to travel through very different channels of commerce to entirely different purchasers. This Board’s Rules clearly require more. The Board should grant Serta’s Motion and order Action to provide the requested discovery.

I. Action's Notice of Opposition Alleges Confusion With All Action-Branded Goods.

Action misstates the scope of its own Opposition. Action states “[i]nitially, it should be noted that Action has not alleged that its estimated 2,000 goods are highly related to Serta’s goods.” Opposer Action Products’ Brief in Response to Applicant’s Motion to Compel (“Response”), at 10. However, in its Notice of Opposition, Action alleged:

The goods recited in [Serta’s Application] are also **closely related** to the goods long offered by [Action] under [Action’s] ACTION marks, [Action’s] inherently distinctive ACTION formative common law marks, Action’s corporate name and Action’s trade name

Notice of Opposition, paragraph 12; and

On information and belief, Action avers that in the eyes and minds of a large part of the public, the mark COOL ACTION as recited in U.S. Trademark Application Serial No. 85160970 is closely associated with the goods in connection with which Action has long used and is using ACTION as a mark and corporate and trade names

Notice of Opposition paragraph 15. Action is relying not only on use of the mark with the goods identified in its registrations, but also goods offered under the “distinctive ACTION formative common law marks,” corporate name and trade name without limitation. *See* Notice of Opposition, paragraphs 7, 9, 10, 12, 13 and 15.

Serta attempted on numerous occasions to discover the uses of the ACTION mark on which Action is relying. During a telephonic meet and confer last August, Serta inquired about Action’s reliance on its common law rights, and asked that discovery responses be supplemented to address those claims. In a follow-up letter, Serta invited Action to limit the scope of the Opposition to Action’s registrations and offered that a majority of Serta’s issues relating to Action’s discovery responses would be addressed if it did so. *See* August 16, 2013 Letter.

Action responded that it had no interest in limiting the scope of the Opposition. *See* August 29, 2013 Letter.

Action's Notice of Opposition defined the scope of this proceeding. Action elected to rely on its registrations and claim sweeping common law rights. It has refused to narrow the rights on which it is relying. Serta is entitled to discovery on Action's claims, including use of the mark on all of the goods on which Action relies.

II. Action's Discovery Responses Are Deficient.

A. Action's Response to Interrogatory 1 Requires Supplementation.

Serta uses and seeks to register its COOL ACTION mark for a component of finished mattresses, mattress pads, crib mattresses, pillows, furniture, mattress toppers, office chair seats and bed headboards. Serta uses the mark to identify at the point of sale of the finished product a specific component of that product. Serta does not sell COOL ACTION foam and it is not applying to register COOL ACTION for the sale of foam. Rather, Serta has applied to register COOL ACTION for:

“foam, namely, visco-elastic foam sold as an integral component of pillows, furniture, mattress toppers, office chair seats, and bed headboards”, in Class 20 and “foam, namely, visco-elastic foam sold as an integral component of mattresses, mattress pads, and crib mattresses”, in Class 25.

All of the finished goods with which COOL ACTION is used are customarily sold - and Serta sells them - at retail to the ultimate consumer. They are typically sold in department stores, mattress specialty stores and furniture stores.

Action appears to manufacture and supply various materials – primarily foams – to other manufacturers or commercial customers. It uses the slogan “making a material difference” and broadly categorizes its products as “Hospital Products” and “Home Medical Equipment.” The goods identified in the asserted registrations are likewise components used to make other

products. It appears that Action does not make, nor do its registrations cover, the finished beds, chairs, operating tables or bassinets for which its pads and cushions are made. The likely channels of commerce and customers for Action's goods appear to be other manufacturers, hospitals and health care institutions. The customers and channels of commerce for the parties' respective goods thus appear to be very different.

Serta served Interrogatory 1 to identify the ACTION-branded goods on which Action is relying and to assess the customers and channels of trade to which they are sold. Action complains in its response that the interrogatory is "overly broad" because it seeks information about "approximately 2,000 items of goods in connection with which Opposer has used its mark over the years." If the request for identification of the goods is "overly broad" it is because Action has alleged confusion with the "goods long offered by [Action] under [Action's] ACTION marks" and Action has refused time and again to limit those goods in any way. Serta knows of no "uninvolved goods" because, other than the goods identified in the asserted registrations, Action has identified no specific goods as either "involved" or "uninvolved." The interrogatory is only as broad as the list of ACTION-branded goods on which Action is relying. Serta is entitled to discovery regarding all of the goods on which Action is relying.

Serta is also entitled to discover the customers of ACTION-branded goods. *See* §§ TBMP 402, 414(3) (2013). Action refused to identify or even characterize by industry or function its customers. Instead, it responded that its customers are "wholesale, retail, and Internet purchasers with respect to virtually all goods offered by [Action]" Action's response is so general as to be completely meaningless. When an "opposer is relying upon common law use of its mark, consideration of the question of likelihood of confusion must be confined to the specific goods on which the mark has been used, as well as the **specific trade**

channels and actual purchasers or potential purchasers, as disclosed by evidence”

Boucheron Holding v. Second Wind Consulting, Inc., 2009 WL 4075378, 6 (T.T.A.B. 2009) (emphasis added); citing *Asplundh Tree Expert Co. v. Defibrator Fiberboard Aktiebolag*, 208 USPQ 954, 959 (T.T.A.B. 1980). At a minimum, Action must provide its classes of customers. “The classes of customers for a party’s goods are discoverable.” § TBMP 414(3) (2013).

Advertising is likewise relevant to an analysis of trade channels. See *Triumph Mach. Co. v. Kentmaster Mfg. Co., Inc.*, 1987 WL 124143, 3-4 (T.T.A.B. 1987). Action’s response to Serta’s interrogatory regarding advertising, solicitation and/or targeting of customers (Interrogatory 1(b)) is so general as to also be meaningless. Action responded that it advertises ACTION-branded goods through: “all means of print advertising, sales visits, catalogs, flyers, brochures, websites, mailings, tradeshow participation, and an extensive social media presence.” Action’s generic response is not “fully responsive” and should be supplemented. Where does Action advertise? What trade shows does it participate in? What social media does it use and to whom is it targeted? Who does it mail advertising to?

The channels of trade for the respective goods must be considered in assessing Action’s allegations of likely confusion. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). The fact that the registrations and subject application are unrestricted with respect to channels of trade does not free Action of its obligation to provide discovery regarding channels of trade. See § TBMP 414(3) (2013).

B. Action’s Response to Interrogatory 9 Requires Supplementation.

Interrogatory 9 seeks for each of the ACTION-branded goods on which Action relies, *inter alia*, the manner in which the mark is used with the goods and the name and location of each point of purchase for the goods.

Action's claim that its "ACTION marks have been . . . used in all the usual and customary manner" and that the "goods are sold through all channels in which such goods are ordinarily and customarily offered for sale and sold, including retail stores, online stores, through distributors and dealers and also at the wholesale level" is clearly inadequate. Like the answer to Interrogatory 1, the response is so general as to be meaningless. Action's claim that its response "provided Applicant with the information to which it is entitled," Response, at 6, is sophistry. It certainly provides no basis on which to assess the *DuPont* factor for likelihood of confusion relating to "the similarity or dissimilarity of established, likely-to-continue trade channels." *In re E.I. DuPont DeNemours & Co.*, 476 F.2d at 1361. "Information relating to the areas of distribution for a party's involved goods . . . sold under its involved mark is discoverable." § TBMP 414 (16) (2013). Action should be ordered to supplement its response to identify the channels of trade and points of purchase for all of the ACTION-branded goods on which it relies.

C. Action's Responses to Interrogatory 16 and Document Request 18 Require Supplementation.

Interrogatory 16 and Document Request 18 seek facts and documents supporting Action's allegation that its goods are highly related to Serta's goods. Action responded to the interrogatory by referring to "the identifications of those goods as set forth in the subject application and [Action's registrations]" and all of its produced documents. Eventually, Action supplemented its response to identify certain "representative" goods. Incredibly, in its Response to Serta's Motion, Action blames the inadequacy of its discovery responses on Serta's discovery requests which were directed to all of the goods that were the basis of Action's Opposition. *See* Response, at fn. 6. Action complains that Serta should have inquired about only "mattress-related goods" even though Action has never itself so limited its allegations. *Id.* Still, Action has provided no factual basis for its allegation that the goods (even the "representative goods")

are “highly related.” *See* Notice of Opposition paragraph 12. It has said nothing whatsoever about Serta’s goods, much less their alleged relationship to Action’s goods. Action has not “fully, thoroughly or repeatedly” answered the interrogatory nor has it met its obligations under the Rules. It should be ordered to do so.

D. Action’s Responses to Document Requests 5 and 6 Require Supplementation.

Document Request 5 seeks documents relating to the advertising of Action’s goods. Document Request 6 seeks representative samples of all cards, signs, packaging or promotional materials used on or in connection with Action’s goods. In response to each of these requests, Action referred Serta to “promotional materials located at Opposer’s publicly available websites.” Action’s reference to its website does not satisfy its discovery obligation. *See* F.R.C.P. 34(b)(2)(E); *see also* *Jalin Realty Capital Advisors, LLC v. A Better Witness, NISP, LLC*, 917 F.Supp.2d 927, 931-32 (D.Minn.2013). Action does not dispute the insufficiency of such a response. Moreover, Action admits that some of the website information that it referenced in its discovery responses is no longer even on its website. *See* Response at 4 (“pricing information was available to Applicant by its simply viewing Action’s publicity accessible websites *until January 2013*”). Moreover, nowhere on Action’s website or in its document production are there any documents responsive to Serta’s request for samples of cards, labels, signs, or packaging used with Action’s goods. Action neither identifies nor submits any in its response. Action should be made to supplement its response to Document Requests 5 and 6.

E. Action’s Response to Document Request 10 Requires Supplementation.

Document Request 10 seeks documents relating to the channels of trade in which Action’s goods travel. This Request, like Interrogatories 1 and 9(e), goes to the heart of Action’s

claimed likelihood of confusion. Once again, Action responded by referring Serta to documents APS 0001-0133, 0186-0221, the same documents that it identified in response to Requests 5 and 6. It should come as no surprise that these documents do not disclose Action's customers or channels of trade for the Action-branded goods at issue. The documents produced do not provide Serta "with that which it is reasonably entitled to." Response, at 13. Action should be made to supplement its response to Document Request 10.

F. Action Must Provide the Basis for its Allegations.

Through Interrogatories 12-15 Serta sought to determine the foundation for Action's claim of likelihood of confusion. Serta is entitled to discover the basis for Action's allegations so it can prepare a defense to those allegations. § TBMP 402 (2013); *citing Mack Trucks, Inc. v. Monroe Auto Equip. Co.* 181 USPQ 286 (T.T.A.B. 1974).

First, Action objected that the interrogatories were premature. The Federal Rules of Civil Procedure make clear that the interrogatories were not premature. *See* F.R.C.P. Rule 26(d)(2). Then, in its response to Serta's Motion, Action maintains that the responses are complete, without any mention of most of the *DuPont* factors, including similarity of trade channels, purchase conditions (i.e. impulse vs. careful, sophisticated purchasing), actual confusion, concurrent use without confusion, the market interface between Serta and Action, or the extent of potential confusion. Action should either supplement its responses or be barred from introducing evidence that any of these factors support a finding of a likelihood of confusion. *See* § TBMP 527.01(e) (2013).

III. Conclusion

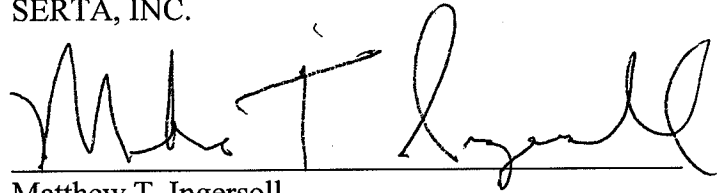
For the reasons stated above, Serta respectfully requests that the Board order Action to supplement its responses to Serta's discovery requests.

Dated: October 29, 2013

Respectfully submitted,

SERTA, INC.

By:

A handwritten signature in black ink, appearing to read "Matthew T. Ingersoll", written over a horizontal line.

Matthew T. Ingersoll

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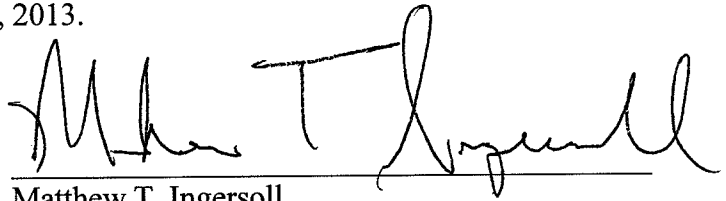
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CERTIFICATE OF SERVICE

The undersigned states that a copy of the foregoing SERTA'S REPLY IN SUPPORT OF
ITS MOTION TO COMPEL was served upon

Thomas J. Vande Sande
Hall & Vande Sande, LLC
10220 River Road, Suite 200
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via UPS Overnight, this 29th day of October, 2013.

A handwritten signature in black ink, appearing to read "Matthew T. Ingersoll", written over a horizontal line.

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