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

Proceeding	91203260
Party	Plaintiff Action Products, Inc.
Correspondence Address	THOMAS J VANDE SANDE HALL VANDE SANDE LLC 10220 RIVER ROAD , SUITE 200 POTOMAC, MD 20854 UNITED STATES
Submission	Opposition/Response to Motion
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Date	06/30/2014
Attachments	Opposer's Brief in Response to Applicant's Motion to Strike.pdf(222030 bytes) Declaration of Thomas J. Vande Sande, Esq 6-30-2014.pdf(30600 bytes) Exhibit 1.pdf(624659 bytes) Exhibit 2.pdf(968285 bytes)

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

Application No. 85/160,970
Mark: COOL ACTION
International Classes: 20, 25
Publication Date: August 30, 2011

Atty. Dkt. 4001.890

Action Products, Inc.

Opposer,

vs.

Serta, Inc.

Applicant.

Opposition No. 91203260

OPPOSER'S BRIEF IN RESPONSE TO APPLICANT'S MOTION TO STRIKE

I. INTRODUCTION

Applicant's Motion to Strike represents its latest attempt to deprive the Board of facts important to the adjudication of this case. Earlier manifestations of this theme of obfuscation and denial include Applicant's evasion of *du Pont* factor-related discovery, its belated and compelled divulgence of information confirming the naming of the wrong party as the owner of the involved application, and its ignoring the existence and impact of indisputable facts clearly of record warranting the grant of summary judgment in Action's favor. Now, Applicant would have the Board exclude from its consideration all exhibits offered by Action in connection with its Summary Judgment Motion.¹

¹ Paragraph 13 of Applicant's Motion to Strike curiously identifies those exhibits it seeks to have excluded from the Board's consideration as "Exhibits 1-55, 56-60, and 61-83". This is, of course, the full range of Exhibits 1-83 submitted with Action's brief. This sweeping broadside, attacking all of Action's exhibits is also curious in that Applicant previously acknowledged the admissibility of at least Exhibits 1-3, 6, 10, 13, 17, 19-20, 61, 63 and 78-81. (App.'s brief in Resp. to Opp. Motion for Summary Judgment, p. 4)

Applicant's Motion to Strike Exhibits 84 and 86, offered in response to allegations made in Applicant's Response brief, is supported neither by relevant facts nor applicable law and thus should be denied. Similarly, Applicant's renewed attempt to deprive the Board of the ability to consider the exhibits offered by Action in support of its opening brief should be denied.

II. ARGUMENT

A. Applicant's Attempts To Deny The Board The Ability To Consider Exhibits 84 And 86 Are Ill-Founded.

Applicant's attacks on Exhibits 84 and 86 are based upon its broad pronouncement that "The Board does not allow new evidence to be submitted with the movant's reply". (App. Br. 1). This assertion is overly broad by miles. In fact, the Board *does* allow new evidence to be submitted through a reply brief under certain circumstances. For instance, it has long been recognized that reply brief evidence, exhibits, and declarations are entirely appropriate when offered in response to issues asserted or statements made in a Response brief. See, for instance, *Grupo Marti, S.A. v. Marti's S.A.*, 2006 WL 896920 (Trademark Tr. & App. Bd.) at FN3 wherein the Board stated:

Respondent filed a reply brief, which included the declaration, with exhibits, of James Robinson. Petitioner has moved to strike the declaration and exhibits, as well as those portions of the reply brief that discuss them, stating that the Trademark Rules do not provide for the submission of additional evidence with a reply brief. Respondent has opposed the Motion to Strike. Because the evidence submitted by respondent is directed to the statements made by petitioner in its opposing brief regarding stores such as WALMART and TARGET, the motion to strike is denied.²

See also, *Sysco Corp. v. Princess Paper, Inc.*, 2006 WL 752426 (Trademark Tr. & App. Bd.), p. 5, (The Board exercised its discretion to consider amended affidavits and exhibits submitted with

² True and accurate copies of unpublished decisions cited herein are appended hereto as Vande Sande Dec. Ex. 1.

summary judgment Reply brief); and *Mattel, Inc. v. The Brainy Baby Company, LLC*, 101 USPQ 2d 1140 (TTAB 2011). (Reply brief exhibits considered as rebuttal evidence, even where the Reply brief itself received no consideration).

Here, Applicant acknowledges that its Response brief provided “Serta’s explanation why COOL is not descriptive of the goods and services with which COOL ACTION is used”. (App. Br. p. 2 at ¶ 3). Moreover, Applicant acknowledges that Exhibit 84 “Is offered to rebut Serta’s explanation”. (App. Br. p. 2 at ¶ 3). This is exactly the situation contemplated by the cases referred to above. Serta has, through its Response brief, espoused the position that COOL is not descriptive and, as acknowledged by Serta, Exhibit 84 has been offered to rebut Serta’s Response brief contention. Neither common sense nor fundamental fairness can compel the silence of a moving party under such circumstances.

The situation surrounding Exhibit 86 is quite similar. Applicant, through the Gross Affidavit accompanying its Response brief, saw fit to raise the assertion that “Serta now also uses its COOL ACTION gel in its iSeries and other select Serta products”. Applicant cannot be heard to object to Action’s introduction of an exhibit demystifying Mr. Gross’ Response Brief Affidavit assertion and providing for the Board’s benefit the articulation of the exact nature of Applicant’s expanded usage of the COOL ACTION mark.³

Applicant’s attempts to shield these exhibits from the Board’s consideration is unwarranted, disturbing, and also, it is respectfully submitted, speak volumes about the lack of a substantive basis underlying Applicant’s case.

³ Applicant’s contention that these exhibits should not be considered because they comprise documents which were available at the time Action filed its summary judgment motion simply misses the point. The assertions raised in Applicant’s Response brief and the accompanying Gross Affidavit permit the introduction and consideration of Exhibits 84 and 86, respectively. Their availability at a time prior to Applicant’s Response brief interjections as to “why COOL is not descriptive” and as to the identification of “other select Serta products” is of no moment.

B. Applicant's Attempt To Exclude From The Board's Consideration All Exhibits (1-83) Offered By Action In Support Of Its Summary Judgment Is Without Merit.

Each of Action's Exhibits 1-83 was either generated by, or produced to, Applicant during discovery. Applicant does not, because it cannot, argue otherwise. Nor can, or does, Applicant assert that it has been in any way prejudiced as a result of any alleged shortcomings in the identifications of those exhibits as set forth in either the original or supplemental declarations of Action's counsel. Nevertheless, through its Motion to Strike, Applicant, consistent with its recurring theme of seeking to shield pertinent information from the Board's consideration, again attacks Action's summary judgment exhibits under the ruse of a hyper-technical argument pursuant to Rule 2.127(e)(2).

In fact, the argument presented by Applicant in its Motion to Strike is more strident, and more desperate, than the argument advanced in its Response to Action's Summary Judgment Motion. Its Response Brief at least acknowledged that it has no basis to complain about Exhibits 1-3, 6, 10, 13, 17, 19-20, 61, 63 or 78-81. Its Motion to Strike, on the other hand, urges the Board to exclude "Exhibits 1-55, 56-60, and 61-83" (App. Br. p. 4 at ¶ 13), and counsel's Supplemental Declaration as well.

With the likelihood of confusion firmly established by facts of record found in the asserted registrations and the challenged application, Applicant's desperate attempt to have all of Action's exhibits, and even counsel's declaration, barred from consideration is somewhat puzzling. Perhaps Applicant's objective is to exclude from the Board's viewing those exhibits (55-60, all of which are Serta documents) evidencing Applicant's dealings with Action prior to Applicant's selection of the mark in dispute, as only that factor is not evidenced by the asserted registrations or the challenged application. Whatever its motivation, Applicant's continued

attacks under Rule 2.127(e)(2) are unwarranted, as Exhibits A-E submitted with counsel's Supplemental Declaration not only set forth interrogatory answers and document request responses, but also recite, prior to each answer and response, verbatim, each corresponding specific interrogatory and document request. Simply put, both the letter and the spirit of Rule 2.127(e)(2) have been satisfied through Action's submission of "the interrogatory and answer thereto" and the "request for production and the documents or things produced in response thereto". Applicant's attack, and the draconian exclusion it seeks, are simply without merit and must be denied.

Applicant has been unable to identify in either its Response brief or its Motion to Strike a scintilla of prejudice it will suffer as a result of the Board's consideration of documents and discovery long in Applicant's possession. Faced with the reality that counsel's Supplemental Declaration in fact laid this issue to rest by providing the Board with interrogatories and answers thereto, and document production requests and responses thereto, per Rule 2.127(e)(2), Applicant asserts that without the definitions and instructions which accompanied the parties' discovery "The Board is unable to appreciate the context in which the documents offered by Opposer were produced". (App. Br. p. 4 at ¶ 13). No basis or support is provided for this contention nor is a single definition, instruction, document, request, response, interrogatory, answer or exhibit referred to as being likely to pose a problem for the Board in its attempt to "appreciate" the "context". While convinced that the makeweight nature of this argument is obvious, in order to assuage Applicant's expressed concerns regarding the Board's abilities to comprehend Exhibits 1-83, submitted herewith as Vande Sande Declaration Ex. 2, are true and accurate copies of the parties' discovery as served, providing yet again the interrogatories and document requests.

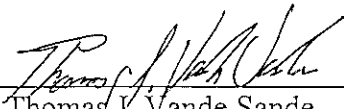
III. CONCLUSION

For the reasons set forth above Applicant's Motion to Strike should be denied in its entirety.

Respectfully submitted,

HALL & VANDE SANDE, LLC

Date: 6/30/14

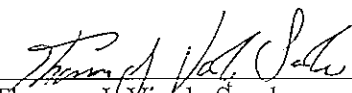
By: 
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CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer, hereby certifies that one (1) copy of the foregoing "OPPOSER'S BRIEF IN RESPONSE TO APPLICANT'S MOTION TO STRIKE", DECLARATION OF THOMAS J. VANDE SANDE, ESQUIRE and Exhibits 1-2 appended thereto were this day served on Applicant by mailing same, first class mail, to:

Matthew Ingersoll, Esquire
Nicole Murray, Esquire
Quarles & Brady LLP
300 North LaSalle Street, Suite 4000
Chicago, Illinois 60654-3422

Date: 6/30/14



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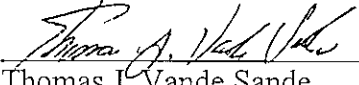
Opposition No. 91203260

DECLARATION OF THOMAS J. VANDE SANDE, ESQUIRE

1. The undersigned is counsel for Action Products, Inc. in the above-captioned case.
2. Attached hereto as Exhibit 1 are true and accurate copies of those unpublished Trademark Trial and Appeal Board decisions referred to in Action's Brief in Response to Applicant's Motion to Strike.
3. Attached hereto as Exhibit 2 are true and accurate copies of Opposer's First Set of Interrogatories, Opposer's First Requests for the Production of Documents and Things, Serta's First Set of Interrogatories and Serta's First Set of Requests for Production of Documents.

This Declaration is made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

Date: 6/30/14



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H

2006 WL 896920 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

GRUPO MARTI, S.A.

v.

MARTI'S S.A.

Cancellation No. 92044602

April 4, 2006

Before Seeherman, Bucher and Walsh
Administrative Trademark Judges

By the Board:

Respondent, Marti's S.A., owns U.S. Registration No. 1866585 for the mark MARTI'S for "retail department store services" in International Class 42.^[FN1] On June 8, 2005 petitioner filed a petition for partial cancellation of the registration alleging that respondent "does not and never has used the mark ... for the full range of services, but rather in connection with 'retail store specializing in artwork and handicrafts from Mexico'"^[FN2] and seeking to restrict respondent's recitation of services to reflect this.

This case now comes up on respondent's motion for summary judgment, filed July 17, 2005. Respondent recognizes that, in order to restrict a registration under Section 18 of the Trademark Act, 15 U.S.C. §1068, a party must prove "(i) the entry of a proposed restriction to the goods or services in its opponent's application or registration will avoid a finding of likelihood of confusion and (ii) the opponent is not using its mark on those goods or services that will be effectively excluded from the ... registration if the proposed restriction is entered." *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1995). Respondent's motion seeks summary judgment only as to the second of these two elements.

As grounds for its motion, respondent contends that there is no genuine issue of material fact that it renders retail department store services as described in its registration, and therefore petitioner's petition for partial cancellation must be denied. In opposition to the motion, petitioner argues that the question is not whether respondent's establishment is a retail department store,

but whether the restriction proposed by petitioner would exclude any of the services currently provided by respondent. In this connection, petitioner asserts that the evidence shows that respondent specializes in the sale of Mexican arts and handicrafts. Petitioner also contends that there is a genuine issue as to whether respondent's goods are organized into separate or meaningful departments.^[FN3]

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence of record and any inferences, which may be drawn from the underlying undisputed facts, must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

*2 Having carefully considered the evidence and arguments submitted by the parties in connection with the motion, we find that there is a genuine issue as to whether respondent's services are properly identified as retail department store services. There is also a genuine issue as to whether respondent is using its mark in connection with the services sought to be excluded, such that the restriction sought by petitioner — “retail store specializing in artwork and handicrafts from Mexico” — would be an accurate identification of the services with which respondent is using its mark and, thus, whether the full proposed restriction is warranted.^[FN4]

Accordingly, respondent's motion for summary judgment is hereby denied.^[FN5] Proceedings are resumed and trial dates, including discovery,^[FN6] are reset as indicated below.

Discovery period to close:

9/1/2006

30-day testimony period for party in position of plaintiff to close:

11/30/2006

30-day testimony period for party in position of defendant to close:

1/29/2007

15-day rebuttal testimony period to close:

3/15/2007

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as

provided by Trademark Rule 2.129.

FN1. U.S. Reg. No. 1866585 issued December 6, 1994 and was renewed November 15, 2004.

FN2. Petitioner also alleges that it intends to apply for registration of the same mark, MARTI'S, for "retail sporting goods store services," and believes it will be denied registration due to an apparent conflict with respondent's registration if it is not restricted. Petitioner asserts further that the USPTO has refused registration based on respondent's registration when petitioner filed a similar application previously.

FN3. Respondent filed a **reply brief**, which included the declaration, with exhibits, of James Robinson. Petitioner has moved to strike the declaration and exhibits, as well as those portions of the **reply brief** that discuss them, stating that the Trademark Rules do not provide for the submission of additional evidence with a **reply brief**. Respondent has opposed the motion to strike. Because the evidence submitted by respondent is directed to the statements made by petitioner in its opposing brief regarding stores such as WALMART and TARGET, the motion to strike is denied.

FN4. The fact that we have identified only certain genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

FN5. The parties are reminded that our decision denying summary judgment is interlocutory in nature and may not be appealed until a final decision is rendered in the proceeding. *Copeland's Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562, 1565 (Fed. Cir. 1989).

FN6. The parties are allowed thirty days from the mailing date of this order to respond to any outstanding discovery requests.

2006 WL 896920 (Trademark Tr. & App. Bd.)

END OF DOCUMENT

2006 WL 752426 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

SYSCO CORPORATON

v.

PRINCESS PAPER, INC.

Cancellation No. 92042937

March 22, 2006

Before Hohein, Hairston and Zervas
Administrative Trademark Judges

By the Board:

On January 20, 2004, Sysco Corporation ("petitioner") filed a petition to cancel the registration of Princess Paper ("respondent") for the mark IMPERIAL for "paper products, namely, napkins, facial tissue, bathroom tissue, paper towels" in International Class 16.^[FN1] As grounds for cancellation, petitioner alleges priority of use of the mark IMPERIAL "on a variety of goods ... particularly, paper products, namely, napkins, facial tissue, bathroom tissue, and paper towels," and that use of the parties' respective marks in connection with their goods is likely to cause confusion.

In its answer to the petition for cancellation, respondent denied the salient allegations thereof and asserted various affirmative defenses, including that "[p]etitioner's use of the word IMPERIAL is not entitled to trademark status because it is laudatory and therefore merely descriptive."

This case now comes up for consideration of (1) respondent's motion for summary judgment, filed December 3, 2004; (2) petitioner's motion for extension of time to answer respondent's second set of interrogatories, filed December 14, 2004; (3) respondent's motion for sanctions in response to petitioner's motion for extension of time to answer respondent's second set of interrogatories, filed January 3, 2005; (4) petitioner's motion for extension of time to respond to respondent's motion for summary judgment, filed December 21, 2004; (5) respondent's motion for sanctions in response to petitioner's motion for extension of time to respond to respondent's motion for summary judgment, filed January 3, 2005; (6) petitioner's cross-motion for summary judgment, filed February 10, 2005; and (7) respondent's

combined motion to strike petitioner's responsive brief to respondent's motion for summary judgment as well as the affidavits of Chris Shepardson and Mariusz Martula, and motion for sanctions in the form of judgment, filed February 23, 2005. The motions are contested, and where applicable, the Board has exercised its discretion to consider any reply briefs filed in support of a particular motion. *See* Trademark Rule 2.127(a).

I. Petitioner's Motion for Extension of Time to Respond to Respondent's Motion for Summary Judgment; Respondent's Motion to Strike Petitioner's Responsive Brief as Untimely; and Respondent's Motion for Sanctions

First we will consider (1) petitioner's motion for extension of time to respond to respondent's motion for summary judgment, (2) respondent's motion to strike petitioner's responsive brief as untimely, and (3) respondent's motion for sanctions. Petitioner requested a 30-day extension of time until February 5, 2005, to respond to respondent's motion for summary judgment, citing the following reason:

*2 Petitioner will be unable to prepare a full and complete [r]esponse and [b]rief by that date, because several persons needed to assist with preparing and signing accurate [a]ffidavits will be unavailable during the Christmas holidays.

In opposition thereto, respondent contends that motions to extend are not routinely granted; that petitioner's motion merely states in a cursory fashion that the necessary persons are unavailable due to the Christmas holiday; that nothing in petitioner's motion sets forth the names of the intended affiants, their positions, and holiday vacation schedules; that petitioner has failed to explain the nature of the testimony that it intends to submit from these individuals; and that as such, petitioner has failed to demonstrate the requisite good cause to warrant an extension of time. Alternatively, respondent has requested that the Board deny petitioner's motion for extension of time as a sanction under Trademark Rule 2.120(g)(1) for petitioner's failure to produce additional witnesses in response to respondent's previously noticed deposition pursuant to Fed. R. Cir. P. 30(b)(6).

As correctly noted by respondent, the appropriate standard for allowing an extension of a prescribed period prior to the expiration of the time period is "good cause." *See* Fed. R. Civ. P. 6(b) and TBMP § 509 (2nd ed. rev. 2004) and authorities cited therein. To the extent, if any, that respondent intends to suggest that extensions of time are rarely granted, respondent's interpretation of the case law is misplaced. To the contrary, the Board generally is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. *See, e.g., American Vitamin Products Inc., v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992); and *Sunkist Growers, Inc. v. Benjamin Ansehl Company*, 229 USPQ 147 (TTAB 1985).

We find that in this particular instance, petitioner has demonstrated the requisite good cause to warrant an extension of time to file a responsive brief to respondent's motion for summary judgment. The absence of key individuals necessary for the preparation of a responsive brief constitutes good cause for requesting an extension of time. We further note that this is petitioner's first and only request for extension of time to file a responsive brief, that the request is for a relatively short extension of only 30 days, that the request was made well prior to the deadline as originally set, and that petitioner did indeed file a brief within the requested time frame, all of which evidence petitioner's good faith and diligence.

Respondent has also moved for sanctions under Trademark Rule 2.120(g)(1) on the ground that petitioner now seeks

additional time to submit the affidavits of witnesses it failed to produce in response to respondent's duly noticed Fed. R. Cir. P. 30(b)(6) deposition served August 9, 2004. As a sanction, respondent requests that the Board deny petitioner's motion to extend its time to reply to respondent's motion for summary judgment.

*3 The Board declines to impose a sanction under Trademark Rule 2.120(g)(1) on petitioner for its purported failure to produce additional witnesses in response to respondent's previously noticed Rule 30(b)(6) deposition. By way of background, petitioner initially refused to produce any Rule 30(b)(6) witnesses and moved for a protective order, contending that the notice failed to describe "with reasonable particularity" the matters to be covered during the deposition, and that because petitioner is "a large corporation with a complex organizational structure," it would be unduly burdensome for petitioner "to make an intelligent designation of one or more agents to testify in its behalf." On August 19, 2004, the Board denied petitioner's motion for protective order, finding that it was improper for petitioner to object to the production of witnesses on these grounds. Following the issuance of the Board's order, petitioner did produce one corporate representative^[FN2] as a witness in response to respondent's Rule 30(b)(6) deposition. Trademark Rule 2.120(g) does not apply here because the prior Board order did not specify the number of Rule 30(b)(6) witnesses to be produced. Thus, the production of only one witness in response to the Rule 30(b)(6) deposition did not in any way violate the Board's August 19, 2004 order.^[FN3]

In view of the foregoing, petitioner's motion for an extension of time to respond to respondent's motion for summary judgment is granted. The brief in opposition to respondent's motion for summary judgment that petitioner filed by certificate of mailing on February 7, 2005 is therefore timely filed. Respondent's motion to strike petitioner's responsive brief as untimely and motion for sanctions are denied.^[FN4]

II. Respondent's Motion For Summary Judgment; Petitioner's Cross-Motion For Summary Judgment; Respondent's Motion to strike the affidavits of Chris Shepardson and Mariusz Martula

The Board now turns to a review of the parties' respective arguments as to summary judgment.

Respondent has moved for summary judgment on the grounds of priority and likelihood of confusion. More specifically, on the issue of priority, respondent maintains that it first used its IMPERIAL mark in interstate commerce "in February or March 1999"; that since that time, it has continuously used its mark in interstate commerce on paper goods, including paper towels, napkins and bathroom tissue; that petitioner has produced only three pieces of advertising that show use of its IMPERIAL designation on paper goods prior to respondent's date of first use; and that petitioner uses the term IMPERIAL in a descriptive, self-laudatory manner and has not shown acquired distinctiveness prior to respondent's date of first use. On the issue of likelihood of confusion, respondent contends that the marks at issue are dissimilar because petitioner's use of the term IMPERIAL is always accompanied by petitioner's house mark SYSCO; that although the parties target the same customers, they have mutually exclusive trade channels (respondent markets through its wholesalers, distributors and manufacturer's representatives while petitioner markets through its own trade channels); that there is no evidence of actual confusion; that numerous competing goods use the term IMPERIAL, thereby diluting petitioner's rights in the mark; and that the purchasers are sophisticated.

*4 As evidence in support of its motion for summary judgment, respondent has submitted the declaration (with exhibits) of its counsel, I. Braun Degenshein, with various exhibits attached thereto, including a copy of respondent's involved registration obtained from the Office's TESS web site; excerpts from the discovery deposition transcript of

Mr. Chris Shepardson, Senior Director of Merchandising for petitioner; excerpts from the discovery deposition transcript of Mr. Abraham Hakimi, a corporate representative for respondent; various authenticated print-outs from the Internet from petitioner's web site; respondent's first set of interrogatories and petitioner's initial responses and first and second amended responses thereto; respondent's second set of interrogatories and petitioner's responses thereto; and various documentary evidence produced by petitioner displaying use of its mark.

Petitioner, in response to respondent's motion for summary judgment, and in support of its cross-motion for summary judgment on its claim of priority of use and likelihood of confusion, argues that contrary to respondent's assertions, petitioner has presented undisputed documentary evidence of prior use; that petitioner's IMPERIAL mark is not descriptive, and even assuming that it is descriptive, it has acquired secondary meaning; that while petitioner does in many instances use its IMPERIAL mark in connection with its house mark SYSCO, it also uses the mark alone; that the parties' goods are identical; that where the marks and goods at issue are identical, likelihood of confusion is "inevitable;" that because respondent's registration is not restricted to any particular trade channel, it is presumed that the goods travel in all normal and usual trade channels therefor; that petitioner's mark IMPERIAL is strong and distinctive for use in connection with paper products; that there are few similar third-party marks in use on similar goods; that the period of contemporaneous use has been relatively short; and that the products in question are sold to customers of varying sophistication.

In support of its position, petitioner has submitted the affidavit of Mr. Chris Shepardson, Senior Director of Merchandising for petitioner, with various exhibits attached thereto; the affidavit of Mr. Mariusz Martula, Senior Merchandiser — Disposables for petitioner, with various exhibits attached thereto; and "notice of reliance" third party registrations.^[FN5]

In response to petitioner's cross-motion for summary judgment, and in reply in support of its own motion for summary judgment, respondent argues that petitioner has not made prior use of its IMPERIAL mark in a prominent manner; that the fact that the involved registration is not restricted to any particular trade channels is irrelevant because respondent does not have access to petitioner's own trade channels; that petitioner's mark is weak; and that the parties have co-existed for several years without instances of confusion.

*5 Before further discussing the merits of the parties' respective summary judgment motions, we will consider respondent's motion to strike the affidavits of Mr. Chris Shepardson and Mr. Mariusz Martula. Respondent has moved to strike the affidavits on the grounds that they constitute "shams" insofar as they now suggest that the term IMPERIAL has been used to identify a "brand;" that the affiants failed to provide sufficient factual support to establish that the affiants have personal knowledge of the facts stated; and that the affidavits lack foundation.

In response, petitioner argues that the affidavits are entirely proper, but in the event that the Board finds that they are unacceptable, petitioner has submitted substitute affidavits which contain additional background facts to explain the basis for personal knowledge of each affiant, as well as explaining the method by which petitioner calculated its annual sales of paper products under the IMPERIAL mark.

Respondent's motion to strike is denied. The original affidavits are not "shams" since the information contained therein is consistent with the information provided during the taking of the discovery deposition of Mr. Shepardson as

well as petitioner's other documentary evidence. In addition, the Board finds that contrary to respondent's assertions, the affiants did provide sufficient factual support to establish that they have personal knowledge of the facts stated therein, and that the affidavits contain the requisite foundation.

Notwithstanding the above, while the original affidavits are acceptable, the Board will consider the amended affidavits. Under Fed. R. Civ. P. 56(e), the Board may permit a party to supplement its summary judgment affidavits or to submit additional affidavits. *See Shalom Children's Wear, Inc. v. In-Wear A/S*, 26 USPQ2d 1516 (TTAB 1993). We exercise our discretion under the rule in favor of considering and accepting the amended affidavits filed with petitioner's reply brief as well as the exhibits introduced therewith.

We now discuss whether summary judgment is warranted in this case. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. *See* Fed. R. Civ. P. 56(c); *Celotex Corp.*, *supra*, at 322-23. The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

*6 Based on the submissions of the parties, we find that petitioner has met its burden of demonstrating that there are no genuine issues of material fact, and that petitioner is entitled to judgment as a matter of law.

A party moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) that it is the prior user of its pleaded mark; and (3) that contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001).

A. Standing

With regard to whether petitioner has standing to maintain this proceeding, we note that respondent has not challenged petitioner's standing to cancel the involved registration. As discussed in more detail below, we find that the evidence of petitioner's prior use of the IMPERIAL mark is sufficient to establish petitioner's standing to bring this case. As such, no genuine issue of material fact exists on the issue of standing.

B. Priority

We turn next to the issue of whether there is a genuine issue of material fact regarding petitioner's asserted priority of use. To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-a-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. A plaintiff may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. *See* Trademark Act Sections 2(d) and 45, 15 U.S.C. Section 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating *Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

The crux of the parties' dispute on this issue lies in their disagreement regarding the probative value of petitioner's evidence of prior use. The most relevant documentary evidence consists of the following items produced by petitioner during discovery and submitted by respondent as Exhibit U to its counsel's declaration in support of its motion for summary judgment:

(1) A two-page advertisement which appeared in petitioner's publication entitled "Sysco's Menus Today" featuring a roll of toilet paper with the mark IMPERIAL appearing on the packaging dated Fall 1995;

*7 (2) A three-page product brochure displaying a photograph of a box of facial tissue bearing the IMPERIAL mark with a 1996 copyright date; and

(3) an eight-page publication entitled "SYSCO CORPORATION Cleaning chronicle" showing the mark IMPERIAL on a box of tissue dated Winter 1998.

At the outset, the Board rejects respondent's contention that petitioner's evidence of prior use falls short because petitioner uses the term "imperial" in a descriptive, self-laudatory manner and has not shown that its use of the term has acquired secondary meaning prior to respondent's first use. Respondent points to the following language from petitioner's advertising material:

With SYSCO, Quality is a matter of choice. Our premium Toilet Tissue is available in three quality levels, while our soft, delicate Facial Tissue is available in two ...

Luxuriously soft, SYSCO Imperial Tissue is truly the industry standard for premium, unsurpassed quality. Quite simply, it's the best; and

Attractive designs in three quality levels, choose from Imperial, luxuriously soft ...

While petitioner does use laudatory language to tout the superior qualities of its products, this language in no way undermines the trademark usage of the term IMPERIAL as an inherently distinctive mark. Thus, petitioner is not required to establish that the term has acquired distinctiveness.

Indeed, we find that contrary to respondent's assertions, the evidence of prior use relied on by petitioner is sufficiently probative. In particular, with respect to the first submission of documentary evidence, made through the discovery deposition and affidavit of Chris Shepardson, petitioner has corroborated and established that it made its first actual

use of the IMPERIAL mark in 1995 by selling its paper products under that mark and has continuously used the mark since then. Mr. Shepardson authenticated the 1995 publication and stated under oath that the publication was distributed to all of petitioner's customers at that time -- approximately 255,000. Mr. Shepardson also averred that in 1990 he "became personally aware" that petitioner was selling paper products, including napkins, facial tissue, bathroom tissue and paper towels, under the mark IMPERIAL, and that through June 30, 2004, petitioner's total sales of paper products under the brand name IMPERIAL totaled \$55 million. The remaining two pieces of documentary evidence have probative weight as well. Each displays the mark IMPERIAL in a manner demonstrating actual or technical trademark usage (i.e. on packaging for the product).

We now turn to respondent's evidence of use. The earliest date respondent can rely on is February or March 1999, as established by the deposition testimony given by Mr. Hakimi.

We therefore find that petitioner has established that there is no genuine issue of fact that it is the prior user of its pleaded IMPERIAL mark.

C. Likelihood of Confusion

*8 Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.^[FN6]

(i). *Similarity of the Parties' Marks*

It is clear that there is no genuine issue of material fact that the marks at issue are identical and consist of the following single word mark -- IMPERIAL. Respondent's contention that petitioner does not use its IMPERIAL mark alone, but rather uses its mark in connection with its house mark SYSCO, is belied by the record evidence. The three examples of trademark use discussed previously in the section on the issue of priority of use clearly display the IMPERIAL mark as a single word mark. This factor therefore weighs heavily in favor of petitioner.

(ii). *Similarity of the Parties' Goods*

With regard to the similarity of the goods at issue, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in respondent's registration vis-à-vis the goods recited in petitioner's petition to cancel, rather than what respondent's goods are asserted or shown to actually be. *See, e.g., Octocom Systems Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). As such, the goods identified in respondent's involved registration, i.e., "paper products, namely, napkins, facial tissue, bathroom tissue, paper towels" are identical to petitioner's goods which, as shown by the evidence, are paper towels, napkins, and bathroom tissue. Indeed, we note that respondent does not dispute that the parties' respective goods are identical.

(iii). *Channels of Trade*

Because the goods in question are identical, respondent relies heavily on the factor regarding the channels of trade, contending that the parties market their goods in distinct trade channels. In this case, however, the involved registration is unrestricted. The Board therefore must presume that respondent's goods are marketed or will be marketed in all

the normal channels of trade for the identified goods and to all the usual classes of purchasers of such goods. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); see also *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835 (TTAB 1989). Respondent's assertion that the parties market their products in mutually exclusive trade channels is therefore unavailing since there is no such restriction in respondent's identification of goods.

(iv). *Buyer Conditions*

*9 Respondent relies on the deposition of Mr. Shepardson to support its assertion that petitioner's purchasers are not ordinary consumers, but rather sophisticated professional buyers.^[FN7] Assuming such is the case, even sophisticated persons would be susceptible to source confusion, particularly under circumstances where, as here, the goods are identical and are sold under the same marks. See *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289 (CCPA 1962). In addition, insofar as there are no limitations in the identification of goods regarding the purchasers, we must assume that it encompasses all purchasers, including those buying on the retail level who are not sophisticated.

(v). *Variety of Goods on Which a Mark is Used*

Respondent contends that petitioner's use of the IMPERIAL mark on a wide variety of goods dilutes petitioner's rights in the mark because there are numerous competing goods that use the IMPERIAL trademark yet coexist in the marketplace. Respondent's argument is misplaced. The fact that petitioner uses the mark on a wide variety of goods actually increases the likelihood of confusion.

(vi). *Contemporaneous Use and Lack of Actual Confusion*

With regard to respondent's arguments as to the parties contemporaneous use and lack of actual confusion, we find that the absence of actual confusion under these circumstances is not sufficient to raise a genuine issue because petitioner is not required to prove actual confusion in order to make a prima facie showing of likelihood of confusion. See *McDonald's Corp. v. McClain*, 37 USPQ2d 1274 (TTAB 1995).

Based on the foregoing, we find that there is no genuine issue of material fact for trial. Moreover, as a matter of law, our finding that confusion is likely is consistent with the case law holding that in circumstances where the marks are identical and used on identical goods, confusion is not only likely but inevitable. See *Reflange Inc. v. R-Con Int'l*, 17 USPQ2d 1125 (TTAB 1990). We therefore find that there is no genuine issue of material fact and that confusion is likely to result as a matter of law.

In view of the foregoing, petitioner's cross-motion for summary judgment is granted, and respondent's motion for summary judgment is denied. Judgment is hereby entered against respondent, the petition to cancel is granted, and Registration No. 2449142 will be cancelled in due course.

In light of our ruling on the parties' respective motions for summary judgment, the remaining motions pending before the Board in this case are moot.

FN1. Registration No. 2449142, issued on May 8, 2001, which sets forth August 2, 1999 as the date of first use anywhere and in commerce.

FN2. The witness produced was Mr. Chris Shepardson, Senior Director of Merchandising for petitioner.

FN3. Alternatively, if petitioner is allowed to produce the affidavits of previously undesignated witnesses, respondent requests that petitioner be required to produce those witnesses for depositions in Oakland, California, at petitioner's expense. As will be evident later in this order, while petitioner has submitted the affidavit of one previously undesignated witness, Mariusz Martula, Senior Merchandiser — Disposables for petitioner, the production of this witness for a deposition is unnecessary since his testimony is not pivotal to the Board's ruling regarding the parties' respective motions for summary judgment.

FN4. Subsequent to petitioner's filing of both its response to respondent's motion for summary judgment and cross-motion for summary judgment, respondent reiterated its contention that petitioner's responsive brief should be stricken from the record on the new basis that no affidavits were filed in support of petitioner's brief. Respondent also requested dismissal of the case as a sanction for petitioner's alleged subterfuge. The renewed motion for sanctions is denied. The Board notes that while the affidavits were submitted with petitioner's two page cross-motion for summary judgment, petitioner filed a combined brief responding to respondent's motion for summary judgment and outlining its arguments in support of its cross-motion for summary judgment. We find that this demonstrates that petitioner was not disingenuous in requesting an extension of time. Respondent's *ex post facto* analysis of this issue essentially amounts to elevating form over substance.

FN5. Petitioner also submitted the pleadings in this proceeding as exhibits. Petitioner is reminded that these papers, by their very nature, already form part of the record in this proceeding. Accordingly, petitioner is requested to refrain from attaching portions thereof to future filings.

FN6. Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

FN7. Virtually all of petitioner's consumers are institutional buyers — “commercial, nonretail purchasers who purchase in bulk, such as hotels, restaurants, and other food service providers, but not purchasers for the purpose of resale such as supermarkets...” Exhibit T (Petitioner's Responses to Registrant's Second Set of Interrogatories, Response to Interrogatory No. 6) to Degenshein Declaration.

2006 WL 752426 (Trademark Tr. & App. Bd.)

END OF DOCUMENT

1. As used herein, "Opposer" includes Action Products, Inc., as well as its officers, directors, attorneys and all persons in privity with it with regard to the matters inquired about herein.
2. As used herein the designation "Applicant" refers to the named Applicant, and any and all predecessor or successor companies, assignors, corporations, or other business entities; any company, corporation or other business entity affiliated with Applicant or owned by it in whole or in part or which owns Applicant in whole or in part; and the directors, officers, agents, employees and attorneys of any of them, including all persons acting or purporting to act on behalf of, or who are subject to the direction or control of, any of the foregoing. In each instance where an answer to an interrogatory differs as between Applicant and any predecessor or successor companies, corporations, assignor, licensee or any other business entities or person(s) as described above, the

answer shall so state, shall set forth such difference(s) and shall state separately all information applicable to Applicant, and all information applicable to each such predecessor or successor company, assignor, licensee, corporation or other business entity or person as described above.

3. The term '970 refers to U.S. Trademark Application Serial No. 85/160,970 for the mark "COOL ACTION".

4. The term "person" refers to any individual, corporation, proprietorship, association, joint venture, company, partnership or other business or legal entity, including governmental bodies and agencies.

5. The term "document" is used in its customary broad sense to include, without limitation, the following items, whether or not prepared by Applicant, whether printed or reproduced by any process, or written or produced by hand, and whether or not claimed to be privileged or otherwise excludable from discovery, namely, notes, letters, correspondence, communications, telegrams, memoranda, summaries or records of telephone conversations, summaries or records of personal conversations, diaries, reports, laboratory and research reports, notebooks, charts, plans, drawings, photographs, minutes or records of meetings, including directors' meetings, reports and/or summaries of interviews, reports and/or summaries of investigations, opinions or reports of consultants, reports of trademark searches, trademark appraisals, opinions of counsel, agreements, reports or summaries of negotiations, brochures, pamphlets, advertisements, circulars, trade letters, press releases, drafts of documents, and all material fixed in a tangible medium of whatever kind known to or in the possession or control of the Applicant. "Document" or "documents" also includes all copies which are not identical to the original.

6. The term "communication" refers to any exchange or transfer, known to Applicant, of information between two or more persons, whether written, oral, or in any other form.

7. The term "business entity" means a partnership, corporation, proprietorship, association or any other business organization, whether formal or informal.

8. The term "date" means the exact day, month and year, if ascertainable, or if not, the best approximation (including relationships to other events).

9. The masculine includes the feminine and vice versa; the singular includes the plural and vice versa.

10. As used herein, the term "control" or "controlled" means the power or ability of Applicant to direct the actions, management, or policies of any person, firm or corporation.

11. The term "describe in detail" means describe every fact, statistic, inference, supposition, estimate, consideration, conclusion, study or analysis known to Applicant which relates to the allegation or contention, or which Applicant believes to be evidence of the truth or accuracy of the allegation or contention, and to identify each document relating thereto.

12. Whenever an interrogatory requires the identification of a document, the answer shall state the following information with respect to each such document:

- (a) the date appearing on such document, and if no date appears thereon, the answer shall so state and shall give the date or approximate date such document was prepared;
- (b) the identifying or descriptive code number, file number, title or label of such document;
- (c) the general nature or description of such document (i.e., whether it is a letter, memorandum, drawing, etc.) and the number of pages of which it consists;
- (d) the name of the person who signed such document and if it was not signed, the answer shall so state and shall give the name of the person or persons who prepared it;
- (e) the name of the person to whom such document was addressed and the name of each person other than such addressee to whom such document or copies thereof were given or sent;

- (f) the name of the person having possession, custody or control of such document;
- (g) whether any draft, copy or reproduction of such document contains or has been subject to any postscript, notation, change, amendment or addendum not appearing on said document itself, and, if so, the answer shall identify as herein required each such draft, copy or reproduction;
- (h) the source or origin of said document and, if the document was not generated by Applicant, specify from whom the document was obtained and identify said person and that person's relationship to Applicant;
- (i) if such document was, but is no longer, in Applicant's possession or subject to its control, state what disposition was made of it and when.

13. If the attorney/client privilege or work product protection is claimed with respect to a document or oral communication for which identification is sought herein, with respect to each such interrogatory answer or document request response, a separate list of all such documents or oral communications shall be served with the answers hereto. Such separate list shall identify each document or oral communication by author, recipient and recipients of copies (including titles and whether or not they are attorneys), the date of such document or oral communication, and a summary of the subject matter of the document or oral communication.

14. Whenever an interrogatory requests the identification of an individual or person, state to the extent known, his or her full name, present or last known employer; and if employed by Applicant at any time, the period of time so employed, and the areas of responsibility during such times.

15. Whenever an interrogatory requests the identity of a company, corporation, or other business or legal entity, state to the extent known:

- (a) the full name;

- (b) the location of divisions, branches or offices which are connected with or handled the matters referred to in the interrogatory; and
- (c) the identity of the person acting or purporting to act on behalf of the business entity in connection with the matters referred to in the interrogatory.

These interrogatories shall be deemed continuing and Applicant shall be obligated to change, supplement and amend its answers thereto as prescribed by the Federal Rules of Civil Procedure and the rules of the Trademark Trial and Appeal Board.

INSTRUCTIONS

1. If Applicant elects to avail itself of the procedure authorized by Rule 33(d) of the Federal Rules of Civil Procedure, as that rule is applied and interpreted by the Trademark Trial and Appeal Board, Applicant shall classify or otherwise appropriately arrange and correlate its documents according to the specific interrogatory to which each such document is responsive. Similarly, in responding to Opposer's requests for production of documents, Applicant shall likewise classify or otherwise appropriately arrange and correlate its documents according to the specific document request to which each such document is responsive.

2. If, in responding to any interrogatory or document request, any information or document is withheld from disclosure under the Federal Rules of Civil Procedure because of an alleged privilege or other exclusionary ground, Applicant shall state the basis for the claim of privilege or exclusion and identify the document within the meaning of Definitions 12 through 15 above.

3. Whenever information requested in an interrogatory is itemized in subparagraphs, or subparts, Applicant shall answer each such subparagraph or subpart separately.

4. Where a document has been destroyed, or is alleged to have been destroyed, state the date of and reason for its destruction, identify each person having any knowledge of its destruction, and each person responsible for its destruction.

5. Once a person has been identified in an answer to an interrogatory, it shall be sufficient thereafter when identifying that person merely to state his or her name.

INTERROGATORIES

INTERROGATORY NO. 1

Describe the facts surrounding the selection of the "COOL ACTION" mark by Applicant, identifying relevant dates and the persons most closely connected with the selection of the mark. Identify all related documents.

INTERROGATORY NO. 2

Identify each meeting or discussion at which the consideration, selection, approval or adoption of the "COOL ACTION" mark for use on any of Applicant's services and/or goods was discussed, and for each such meeting or discussion, identify each participant. Identify all related documents.

INTERROGATORY NO. 3

Identify the individual(s) employed by or associated with Applicant who are most knowledgeable about Applicant's intended and/or actual use of the "COOL ACTION" mark.

INTERROGATORY NO. 4

Identify and describe all goods and/or services in connection with which the "COOL ACTION" mark is used, or is intended to be used, by Applicant, and by any licensee or other entity

using that mark with Applicant's permission. As to each item of goods and services state the annual revenues in dollars since use of the mark commenced.

INTERROGATORY NO. 5

Identify the types and classes of purchasers of the goods and services offered by Applicant under the "COOL ACTION" mark.

INTERROGATORY NO. 6

Describe in detail the nature of Applicant's business.

INTERROGATORY NO. 7

With respect to each and every opinion of counsel which relates to or refers to Applicant's right to use or register "COOL ACTION", identify each written or oral communication by counsel providing each such opinion and each such communication requesting each such opinion. Provide the date any such opinion(s) was or were requested, as well as the date any such opinion was rendered. Identify all related documents.

INTERROGATORY NO. 8

Identify with specificity when and under what circumstances Applicant first learned of (a) Opposer and (b) Opposer's use of "ACTION".

INTERROGATORY NO. 9

Describe in detail Applicant's first use of "COOL ACTION" with respect to any and all goods and services. Identify all documents and things which Applicant contends supports its alleged first use date(s) and its alleged date(s) of first use in commerce.

INTERROGATORY NO. 10

Identify the person(s) most knowledgeable concerning:

- (a) the goods and services offered by Applicant;
- (b) trademarks, trade names, and service marks used by Applicant;
- (c) advertising and advertising plans in connection with which the "COOL ACTION" mark has been or is currently used or is intended to be used.

INTERROGATORY NO. 11

Identify and describe in detail any conflict, allegation of infringement, or controversy, whether currently pending or resolved, with any third party involving Applicant and the "COOL ACTION" mark. Identify all documents referring or relating thereto.

INTERROGATORY NO. 12

State Applicant's annual expenditures for advertising and/or promotion for each of Applicant's goods and/or services offered in connection with the "COOL ACTION" mark since the date of first use of that mark.

INTERROGATORY NO. 13

Identify all uses of the term ACTION, either alone or in combination with another word or words, as a corporate name, trade name, service mark, trademark or other type of use by third parties in connection with visco-elastic foam, either alone or as an integral part of any of pillows, furniture, mattress toppers, chair seats, chair or bed pads, cushions or mattresses or bed headboards of which Applicant has knowledge.

INTERROGATORY NO. 14

Describe in detail the relationship between Serta International and Serta Inc.

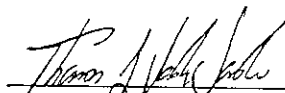
INTERROGATORY NO. 15

Identify the person or persons most knowledgeable as to each of the answers provided to each of the foregoing Interrogatories.

HALL & VANDE SANDE, LLC

Date:

5/25/12



Thomas J. Vande Sande
Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
(301) 983-2500

CERTIFICATE OF SERVICE

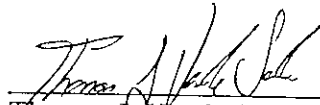
The undersigned, Thomas J. Vande Sande, attorney for Opposer, hereby certifies that one (1) copy of the foregoing "OPPOSER'S FIRST SET OF INTERROGATORIES" was this day served on Applicant by mailing same to:

Nicole Bashor, Esquire
Quarles & Brady, LLP
300 North LaSalle Street, Suite 4000
Chicago, IL 60654-3422

HALL & VANDE SANDE, LLC

Date:

5/25/12



Thomas J. Vande Sande

Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
(301) 983-2500

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

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

OPPOSER'S FIRST REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS

Opposer, Action Products, Inc., requests that Applicant, within 30 days of the service hereof, produce the following documents and things. The Definitions and Instructions set forth in Opposer's First Set of Interrogatories to Applicant are incorporated herein by reference.

Request No. 1

All documents of any kind which contain or reflect information bearing upon the conception, adoption and selection of "COOL ACTION" as a mark by Applicant.

Request No. 2

Samples and/or specimens of each different use made by Applicant of "COOL ACTION" in connection with Applicant's goods and/or services.

Request No. 3

All advertising, publicity releases, promotional pieces and materials used by Applicant, or by others at Applicant's request or direction or under license from Applicant, in the marketing, advertising, sale, and/or offering for sale, of goods and/or services under the "COOL ACTION" mark.

Request No. 4

All documents which comprise, relate to, or refer to any market plans, forecasts, or sales strategies for goods or services offered by or intended to be offered by Applicant, under the "COOL ACTION" mark.

Request No. 5

All documents comprising, reflecting, relating to, or including, opinions of counsel regarding Applicant's right to use or register "COOL ACTION" as a trademark or service mark.

Request No. 6

All documents relating to or reflecting the results of any polls or surveys which Applicant has conducted regarding the "COOL ACTION" mark.

Request No. 7

All assignments, license agreements, and any other agreements relating to the "COOL ACTION" mark as well as all correspondence between Applicant and any third party concerning or referring to the "COOL ACTION" mark.

Request No. 8

All documents which mention, relate or refer to

- (a) Opposer, or;
- (b) Opposer's goods or services, or the promotion or sale of same, or;
- (c) Opposer's marks or trade name.

Request No. 9

All documents comprising, reflecting or relating to any search made by or on behalf of Applicant relating to the "COOL ACTION" mark, or any "ACTION" formative marks.

Request No. 10

All documents which refer to, relate to, or involve, any challenge by any third party to Applicant's right to use or register "COOL ACTION" or which contain any suggestion or demand by any third party that Applicant use a different mark.

Request No. 11

All documents evidencing Applicant's first use of "COOL ACTION".

Request No. 12

Documents sufficient to show all channels of trade through which Applicant offers, or intends to offer, goods or services under the "COOL ACTION" mark.

Request No. 13

Documents showing the types of purchasers to whom Applicant has offered goods or services, or intends to offer, goods or services under the "COOL ACTION" mark.

Request No. 14

Documents evidencing Applicant's intention to use "COOL ACTION" in commerce in connection with the goods recited in U.S. Application Serial No. 85/160,970.

Request No. 15

Documents showing the circumstances under which Applicant first became aware of Opposer's use of "ACTION".

Request No. 16

All documents for which identification is requested in Opposer's Interrogatory No. 1.

Request No. 17

All documents for which identification is requested in Opposer's Interrogatory No. 2.

Request No. 18

All documents for which identification is requested in Opposer's Interrogatory No. 8.

Request No. 19

All documents for which identification is requested in Opposer's Interrogatory No. 9.

Request No. 20

All documents for which identification is requested in Opposer's Interrogatory No. 10.

Request No. 21

All documents consulted by Applicant in responding to Opposer's Interrogatory No. 12.

Request No. 22

Documents recording or reflecting the annual revenues received by Applicant from each item of goods and services offered under the "COOL ACTION" mark.

Request No. 23

All documents making reference to both Serta International and "COOL ACTION".

Request No. 24

All documents making reference to both Serta International and Opposer or any employee or representative of Opposer.

Request No. 25

All documents identified in any of Applicant's answers to Opposer's First Set of Interrogatories not otherwise produced pursuant to a previous request.

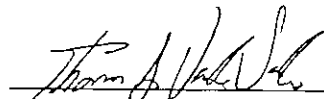
Request No. 26

Any and all documents and things, not produced in response to any other document request, which are within Applicant's possession, custody or control and which are identified or were referred to, reviewed, or consulted in response to, or in preparing answers to, Opposer's First Set of Interrogatories.

HALL & VANDE SANDE, LLC

Date: _____

5/25/12



Thomas J. Vande Sande

Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
(301) 983-2500

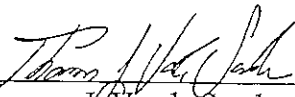
CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposer, hereby certifies that one (1) copy of the foregoing "OPPOSER'S FIRST REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS" was this day served on Applicant by mailing same, first class mail, to:

Nicole Bashor, Esquire
Quarles & Brady, LLP
300 North LaSalle Street, Suite 4000
Chicago, IL 60654-3422

HALL & VANDE SANDE, LLC

Date: 5/25/12



Thomas J. Vande Sande
Attorneys for Opposer
10220 River Road, Suite 200
Potomac, Maryland 20854
(301) 983-2500

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

In the matter of Application Serial No.
85160970 for COOL ACTION

Published: August 30, 2011

ACTION PRODUCTS, INC.,

Opposition No. 91203260

Opposer,

v.

SERTA, INC.

Applicant.

SERTA'S FIRST SET OF INTERROGATORIES

In accordance with Rule 2.130 of the Trademark Rules of Practice, Rule 33 of the Federal Rules of Civil Procedure and the definitions and instructions attached hereto as Appendix A, Applicant/Registrant, Serta, Inc., by and through its attorneys, hereby requests that Opposer/Petitioner, Action Products, Inc, answer the following interrogatories under oath within thirty (30) days.

Interrogatory No. 1

Identify each of Action Product's Goods, and for each identify:

- (a) the customers;
- (b) the manner of advertising, solicitation and/or targeting of customers and/or potential customers (e.g., advertisements, sales visits, brochures, mailings, trade shows, social media, etc.);

(c) the publications, directories and broadcasting outlets through which Action Products promotes or advertises Action Product's Goods; and

(d) the recommended retail price.

Interrogatory No. 2

Identify the persons who participated in or who were consulted about the creation and adoption of Action Product's Marks by Action Products, including the person(s) who first conceived of Action Product's Marks, the person(s) who approved Action Product's Marks for adoption and use, and the person(s) responsible for designing any and all of Action Product's Goods bearing Action Product's Marks, and describe the responsibility, role, activity, and contribution made by each such person.

Interrogatory No. 3

Identify the three persons most knowledgeable about the creation and adoption of Action Product's Marks.

Interrogatory No. 4

Identify the three persons most knowledgeable about the sales and marketing of Action Product's Goods sold under Action Product's Marks.

Interrogatory No. 5

Identify any market studies, searches, surveys, investigations, focus groups, or other evaluations relating to the adoption or use of the Action Product's Marks.

Interrogatory No. 6

State whether Action Products, its employees, officers, directors, attorneys or other agents, affiliated firms, distribution and service groups, or anyone acting on Action Product's behalf, have ever received any communication or inquiry relating, directly or indirectly, to Serta's Mark or Serta's Goods. If the answer is anything but an unqualified no, set forth as to each communication or inquiry:

- (a) A description of the communication or inquiry;
- (b) All persons with knowledge of the facts relating to the communication or inquiry;
- (c) The date and time of the communication or inquiry;
- (d) The place where the communication or inquiry occurred; and
- (e) An identification of all documents relating to the communication or inquiry.

Interrogatory No. 7

Identify any search, investigation, or other evaluation relating to Serta's Mark.

Interrogatory No. 8

State whether Action Products or anyone acting on behalf of Action Products has had any communications with Serta and, if so, identify:

- (a) The date of such communication(s);
- (b) The individuals present during such communication(s);
- (c) The substance of such communication(s);
- (d) All documents relating to such communications, and
- (e) The three persons most knowledgeable about such communications.

Interrogatory No. 9

State for each of Action Product's Goods:

- (a) The date of first use of each of Action Product's Marks;
- (b) The date of first use of each of Action Product's Marks in commerce;
- (c) The manner in which each of Action Product's Marks were and are currently used;
- (d) Whether or not Action Product's Marks are in current use; and
- (e) The name and location of each point of purchase for Action Product's Goods

including any retail stores, wholesale stores, online stores, or otherwise.

Interrogatory No. 10

Identify any survey, pretest, poll, investigation, or other evaluation relating to any consumer recognition or confusion (or lack thereof) in connection with Action Product's Marks or Serta's Mark.

Interrogatory No. 11

Identify all uses of the term ACTION, either alone or in combination with another word or words, as a corporate name, trade name, service mark, trademark or other type of use by third parties in connection with visco-elastic foam, either alone or as an integral part of any of pillows, furniture, mattress toppers, office chair seats, and bed headboards of which Action Products has knowledge.

Interrogatory No. 12

Describe all facts and identify all documents relating to Action Product's allegation that the registration and use of Serta's Mark in connection with Serta's Goods is likely to cause confusion.

Interrogatory No. 13

Describe all facts and identify all documents that relate to Action Product's allegation that Serta's Mark would be a source of damage and injury to Action Products.

Interrogatory No. 14

Describe all facts and identify all documents that relate to Action Product's allegation that Action Product's Marks have become well-known to the extent that the public associates Action Product's Marks with Action Product's Goods.

Interrogatory No. 15

Describe all facts and identify all documents that relate to Action Product's allegation that Serta is not entitled to registration of the COOL ACTION mark for the goods recited in the application.

Interrogatory No. 16

Describe all facts and identify all documents that relate to Action Product's allegation that Action Product's Goods are highly related to Serta's Goods.

Interrogatory No. 17

For each person whose testimony Action Products expects or anticipates to introduce, whether by way of affidavit, deposition, or otherwise in this manner:

- (a) name the person;
- (b) state the subject matter on which he or she is expected to testify;
- (c) provide a summary of the expected testimony; and
- (d) state whether the witness or affiant will be offering evidence in the capacity as an expert.

Interrogatory No. 18

Identify, separately for each interrogatory, each person furnishing information or who was asked to furnish information in answering such interrogatory.

Dated: March 16, 2012

By: 

Nicole A. Bashor
Richard W. Young
Nicole M. Murray
Quarles & Brady, LLP
300 North LaSalle Street, Suite 4000
Chicago, IL 60654-3422

Attorneys for Applicant Serta, Inc.

APPENDIX A

DEFINITIONS

A. Reference to any person, including without limitation "Opposer," "Petitioner" or "Action Products," herein should be understood as including such person's parents, subsidiaries of parents, subsidiaries, divisions, affiliated investment management firms and distribution and service groups, predecessors and successors and assigns of each of the foregoing, and all of their agents, officers, directors, employees, representatives, consultants, and attorneys.

B. As used herein, "communication" shall mean any transmission of information by one or more persons or between two or more persons by any means including, but not limited to, telephone conversations, letters, telegrams, teletypes, telexes, telecopies, computer linkups, written memoranda, and face-to-face conversations.

C. As used herein, "day" or "date" shall mean the exact day, month, and year if ascertainable, or if not, the best available approximation (including relationship to other events).

D. As used herein, "identify" when used in reference to:

(1) an individual, shall mean to state his or her full name, present or last known residential and business addresses and present or last known position and/or business affiliation;

(2) a firm, partnership, corporation, proprietorship, joint venture, association or other organization or entity, shall mean to state its full name, present or last known address and place of incorporation or formation and to identify each agent that acted for it with respect to the matters relating to the interrogatory or answer;

(3) a document, shall mean to state the date, title (if any), each author, each recipient, type of document (i.e. publication, letter, memorandum, book, telegram, chart, etc.) or some other means of identifying it, and its present location or custodian;

(4) a communication, shall mean to state its date and place, the person(s) who participated in it or who were present during any part of it or who have knowledge about it.

E. The term "documents" shall have the same meaning as set forth in Rule 34 of the Federal Rules of Civil Procedure, and includes, without limitation, the original (and every copy of the original that differs in any way from it) of any written, recorded or graphic matter or any medium of any type or description upon which intelligence or information is recorded or from which intelligence or information can be recorded, which is or has been in your possession, control, or custody, or of which you have knowledge, including but not limited to, the original and any non-identical copy (whether different from the original because of notes made on said copy or otherwise) of any advertising literature; agreement; bank record or statement; blueprint; book; book of account; booklet; brochure; calendar; catalog; chart; check; circular; coding form; communication (intra- or inter-company); computer printout; computer-readable form; contract; copy; correspondence; database; diary; display; draft of any document; drawing; film; film transparency; flyer; forecast; graph; index; instruction; instruction manual or sheet; invoices; job requisition; letter; license; magnetic media of all kinds (including, but not limited to, disks, tapes, or other media) containing computer software with supporting indices, data, documentation, flow charts, comments, object code, source code, and computer programs relating thereto; manual; map; memoranda; minute; newspaper or other clipping; note; notebook; opinion; pamphlet; paper; periodical or other publication; photograph; price

list; print; printed circuit board; promotional literature; receipt; record; recorded Read-Only-Memory (ROM); recording; report; solicitation; statement; statistical compilation; stenographic notes, records, or summary of any (a) telephone or intercom conversation or message, (b) personal conversation or interview, or (c) meeting or conference; telegram; telephone calling card; telephone log; travel or expense records; video recording; video tape; voice recording; voucher; worksheet or working paper; writing or other handwritten, printed, reproduced, recorded, typewritten, or otherwise produced graphic material from which the information required may be obtained, or any other documentary material of any nature, in the possession, custody, or control of Action Products.

F. If copies of documents are produced in lieu of the originals, such copies should be legible and bound or stapled in the same manner as the original.

G. As used herein, "person" shall mean an individual, firm, partnership, corporation, proprietorship, joint venture, group, association or any other organization or entity.

H. A document or communication "referring," "relating" or "related" to any given subject shall mean, without limitation, any document or communication that constitutes, contains, embodies, reflects, identifies, states, refers directly or indirectly to, or is in any way relevant to the particular subject matter identified.

I. Action Product's Marks shall mean the trademark ACTION and the trademarks that are the subject of U.S. Trademark Reg. Nos. 1,346,201, 1,346,202, and 1,398,590.

J. Action Product's Goods shall be the goods listed in U.S. Trademark Reg. Nos. 1,346,201, 1,346,202, and 1,398,590 and all other goods on which or in connection with which Action Products has used the ACTION trademark.

K. Serta's Mark shall mean the mark identified in U.S. Trademark Application Serial No. 85/160,970.

L. Serta's Goods shall mean the goods listed in U.S. Trademark Application Serial No. 85/160,970.

INSTRUCTIONS

A. In answering each interrogatory, identify each person who assisted or participated in preparing or supplying any of the documents or information given in response to or relied upon in preparing answers to that request.

B. The production shall segregate and identify such business records according to the interrogatory to which the records are responsive.

C. If any document requested has been destroyed, describe the content of said document, the location of any copies of said document, the date of such destruction and the name of the person who ordered or authorized such destruction.

D. If any request for the production of any document is objected to on the ground of privilege or work product, or for any other reason, with respect to each such document state: (1) the identity of its author(s) or creator(s); (2) the identity of its recipient(s); (3) its subject matter; (4) the identity of person(s) to whom the document, or any portion thereof, has already been revealed; (5) the source of the document; (6) the date of the document; (7) the number of pages in the document; and (8) the basis upon which it is being withheld, including sufficient facts from which the court and Seta can assess and determine the validity of such assertion of privilege, work product, or other immunity.

E. Where appropriate, the singular form of a word should be interpreted in the plural and vice versa, to obtain the broadest possible meaning.

F. As used herein, "and" and "or" shall be construed conjunctively and disjunctively so as to acquire the broadest meaning possible.

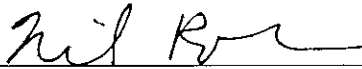
G. These interrogatories shall be deemed continuing and supplemental answers should be provided as additional information becomes available.

CERTIFICATE OF SERVICE

The undersigned attorney states that a copy of the foregoing FIRST SET OF INTERROGATORIES was served upon

Thomas J. Vande
HALL & VANDE SANDE, LLC
10220 River Road, Suite 200
Potomac, Maryland 20854

by electronically mailing a copy to tv@hvsllc.com and by depositing a courtesy copy thereof in the United States Mail, First Class, postage prepaid, this 16th day of March, 2012



Nicole A. Bashor
Richard W. Young
Nicole M. Murray
Quarles & Brady, LLP
300 North LaSalle Street, Suite 4000
Chicago, IL 60654-3422

Attorneys for Serta, Inc.

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

In the matter of Application Serial No.
85160970 for COOL ACTION

Published: August 30, 2011

ACTION PRODUCTS, INC.,

Opposition No. 91203260

Opposer,

v.

SERTA, INC.

Applicant.

SERTA'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS

In accordance with Rule 2.120 of the Trademark Rules of Practice, Rule 34 of the Federal Rules of Civil Procedure and the definitions and instructions attached hereto as Appendix A, Applicant/Registrant, Serta, Inc., by and through its attorneys, hereby requests that Opposer/Petitioner, Action Products, Inc., produce for inspection and copying by Serta, within thirty (30) days at such time and place as agreed by the parties, all of the following documents and things in the possession, custody or control of Action Products.

Request No. 1

All documents and things identified in response to, or for which identification is sought in, Serta's First Set of Interrogatories.

Request No. 2

All documents or things that were relied upon in responding to Serta's First Set of Interrogatories.

Request No. 3

All documents relating to the clearance, selection, or application to register Action Product's Marks.

Request No. 4

All documents relating to any searches, investigations, or other evaluations relating to the adoption of Action Product's Marks.

Request No. 5

All documents relating to the manner of advertising, solicitation, and/or targeting of customers and/or potential customers used by Action Products, which include Action Product's Marks since the first use of Action Product's Marks.

Request No. 6

Representative samples of all cards, labels, signs, packaging or promotional materials that have been used on or in connection with Action Product's Goods.

Request No. 7

All documents relating to any searches, surveys, pretests, polls, investigations or other evaluations relating to the use of, or any consumer recognition or confusion (or lack thereof) in connection with, Serta's Mark, Action Product's Marks, Serta's Goods, or Action Product's Goods.

Request No. 8

All documents relating to knowledge of each incident of actual confusion, mistake or deception arising from the use of Serta's Mark and of Action Product's Marks.

Request No. 9

All documents that will or may be offered into evidence by Action Products in this action.

Request No. 10

All documents relating to the channels of trade or commerce in which Action Products distributes, sells, or offers for sale Action Product's Goods, including but not limited to documents sufficient to identify all actual or intended distributors, sales agents, sales representatives, retailers, and other persons from whom Action Product's Goods may be purchased or obtained.

Request No. 11

All documents relating to test marketing conducted by Action Products or on its behalf, of any product using Action Product's Marks, including but not limited to any market surveys, focus groups, analyses or studies concerning the promotion, use, potential sale, or sale of any such product.

Request No. 12

All documents, including any correspondence or memoranda, referring to the registration, use, possible likelihood of confusion with or possible infringement of Action Product's Marks.

Request No. 13

All documents relating to uses of the term ACTION, either alone or together with another word or words, as a corporate name, trade name, service mark, trademark, or other type of use by third parties in connection with visco-elastic foam, either alone or as an integral part of any of pillows, furniture, mattress toppers, office chair seats, and bed headboards of which Action Products has knowledge.

Request No. 14

All documents relating to Action Product's allegation that the registration and use of Serta's Mark in connection with Serta's Goods is likely to cause confusion.

Request No. 15

All documents relating to Action Product's allegation that registration of Serta's Mark would be a source of damage and injury to Action Products.

Request No. 16

All documents relating to Action Product's allegation that Action Product's Marks have become well-known to the extent that the public associates Action Product's Marks with Action Product's Goods.

Request No. 17

All documents relating to Action Product's allegation that Serta is not now and never was entitled to registration of the COOL ACTION mark for the goods recited in the application.

Request No. 18

All documents relating to Action Product's allegation that Action Product's Goods are highly related to Serta's Goods.

Dated: March 16, 2012

By: _____

Nicole A. Bashor
Richard W. Young
Nicole M. Murray
Quarles & Brady, LLP
300 North LaSalle Street, Suite 4000
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Attorneys for Applicant Serta, Inc.

APPENDIX A

DEFINITIONS

A. Reference to any person, including without limitation "Opposer," "Petitioner" or "Action Products," herein should be understood as including such person's parents, subsidiaries of parents, subsidiaries, divisions, affiliated investment management firms and distribution and service groups, predecessors and successors and assigns of each of the foregoing, and all of their agents, officers, directors, employees, representatives, consultants, and attorneys.

B. As used herein, "communication" shall mean any transmission of information by one or more persons or between two or more persons by any means including, but not limited to, telephone conversations, letters, telegrams, teletypes, telexes, telecopies, computer linkups, written memoranda, and face-to-face conversations.

C. As used herein, "day" or "date" shall mean the exact day, month, and year if ascertainable, or if not, the best available approximation (including relationship to other events).

D. As used herein, "identify" when used in reference to:

(1) an individual, shall mean to state his or her full name, present or last known residential and business addresses and present or last known position and/or business affiliation;

(2) a firm, partnership, corporation, proprietorship, joint venture, association or other organization or entity, shall mean to state its full name, present or last known address and place of incorporation or formation and to identify each agent that acted for it with respect to the matters relating to the interrogatory or answer;

(3) a document, shall mean to state the date, title (if any), each author, each recipient, type of document (i.e. publication, letter, memorandum, book, telegram, chart, etc.) or some other means of identifying it, and its present location or custodian; (4) a communication,

shall mean to state its date and place, the person(s) who participated in it or who were present during any part of it or who have knowledge about it.

E. The term "documents" shall have the same meaning as set forth in Rule 34 of the Federal Rules of Civil Procedure, and includes, without limitation, the original (and every copy of the original that differs in any way from it) of any written, recorded or graphic matter or any medium of any type or description upon which intelligence or information is recorded or from which intelligence or information can be recorded, which is or has been in your possession, control, or custody, or of which you have knowledge, including but not limited to, the original and any non-identical copy (whether different from the original because of notes made on said copy or otherwise) of any advertising literature; agreement; bank record or statement; blueprint; book; book of account; booklet; brochure; calendar; catalog; chart; check; circular; coding form; communication (intra- or inter-company); computer printout; computer-readable form; contract; copy; correspondence; database; diary; display; draft of any document; drawing; film; film transparency; flyer; forecast; graph; index; instruction; instruction manual or sheet; invoices; job requisition; letter; license; magnetic media of all kinds (including, but not limited to, disks, tapes, or other media) containing computer software with supporting indices, data, documentation, flow charts, comments, object code, source code, and computer programs relating thereto; manual; map; memoranda; minute; newspaper or other clipping; note; notebook; opinion; pamphlet; paper; periodical or other publication; photograph; price list; print; printed circuit board; promotional literature; receipt; record; recorded Read-Only-Memory (ROM); recording; report; solicitation; statement; statistical compilation; stenographic notes, records, or summary of any (a) telephone or intercom conversation or message, (b) personal conversation or interview, or (c) meeting or conference; telegram; telephone calling card; telephone log; travel or expense records; video recording; video tape; voice recording;

voucher; worksheet or working paper; writing or other handwritten, printed, reproduced, recorded, typewritten, or otherwise produced graphic material from which the information required may be obtained, or any other documentary material of any nature, in the possession, custody, or control of Action Products.

F. If copies of documents are produced in lieu of the originals, such copies should be legible and bound or stapled in the same manner as the original.

G. As used herein, "person" shall mean an individual, firm, partnership, corporation, proprietorship, joint venture, group, association or any other organization or entity.

H. A document or communication "referring," "relating" or "related" to any given subject shall mean, without limitation, any document or communication that constitutes, contains, embodies, reflects, identifies, states, refers directly or indirectly to, or is in any way relevant to the particular subject matter identified.

I. Action Product's Marks shall mean the trademark ACTION and the trademarks that are the subject of U.S. Trademark Reg. No. 1,346,201, 1,346,202, and 1,398,590.

J. Action Product's Goods shall be the goods listed in U.S. Trademark Reg. No. 1,346,201, 1,346,202, and 1,398,590 and all other goods on which or in connection with which Action Products has used the ACTION trademark.

K. Serta's Mark shall mean the mark identified in U.S. Trademark Application Serial No. 85/160,970.

L. Serta's Goods shall mean the goods listed in U.S. Trademark Application Serial No. 85/160,970.

INSTRUCTIONS

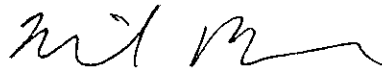
- A. In answering each document request, identify each person who assisted or participated in preparing or supplying any of the documents or information given in response to or relied upon in preparing answers to that request.
- B. If any document requested has been destroyed, describe the content of said document, the location of any copies of said document, the date of such destruction and the name of the person who ordered or authorized such destruction.
- C. If the production of any document is objected to on the ground of privilege or work product, or for any other reason, with respect to each such document state: (1) the identity of its author(s) or creator(s); (2) the identity of its recipient(s); (3) its subject matter; (4) the identity of person(s) to whom the document, or any portion thereof, has already been revealed; (5) the source of the document; (6) the date of the document; (7) the number of pages in the document; and (8) the basis upon which it is being withheld, including sufficient facts from which the court and Opposer can assess and determine the validity of such assertion of privilege, work product, or other immunity.
- D. Where appropriate, the singular form of a word should be interpreted in the plural and vice versa, to obtain the broadest possible meaning.
- E. As used herein, "and" and "or" shall be construed conjunctively and disjunctively so as to acquire the broadest meaning possible.
- F. These document requests shall be deemed continuing and supplemental answers should be provided as additional information becomes available.

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by electronically mailing a copy to tv@hvsllc.com and by depositing a courtesy copy thereof in the United States Mail, First Class, postage prepaid, this 16th day of March, 2012



Nicole A. Bashor
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Quarles & Brady, LLP
300 North LaSalle Street, Suite 4000
Chicago, IL 60654-3422

Attorneys for Serta, Inc.

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