This Opinion is Not a Precedent of the TTAB

Mailed: September 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Allure Furniture & Mattress, Inc.
v.
J. Becker Management

Opposition No. 91203625

James Hastings of Collen IP
for Allure Furniture & Mattress, Inc.

Allison M. Corder of Valauskas Corder LLC
for J. Becker Management.

Before Kuhlke, Wellington, and Gorowitz,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Allure Furniture & Mattress, Inc. ("Opposer") opposes the application filed by J. Becker Management, Inc. to register the following mark on the Principal Register:

for "retail store and on-line retail store services featuring furniture and sleep products" in International Class 35.[1] The mark is described in the application as "consist[ing] of the word 'mattress' in purple and the stylized word 'overstock' in orange including a four icon configuration with the top left icon in purple and the remaining three icons in orange." Color is claimed as a feature of the mark and the exclusive right to use the wording MATTRESS OVERSTOCK is disclaimed.

Opposer claims a likelihood of confusion with its previously used marks that include **MATTRESS OVERSTOCK**. In particular, Opposer pleaded that "since 1995 [it has] conducted business under the name 'Mattress Overstock' … throughout the United States" (Not. of Opposition ¶ 1); it "has continuously and regularly widely sold, distributed and advertised furniture and sleep produces (sic), including mattresses, throughout the United States under the trademark applied for by Applicant, and other marks featuring prominently the term 'Mattress Overstock' …" (*Id.*, ¶ 2); Opposer's "goods bearing the trademark 'Mattress Overstock' have acquired a high reputation for quality and utility, and Opposer for 17 years has continuously used the term 'Mattress Overstock' as a dominant term in the operation of its business …" (*Id.*, ¶ 4); and that Applicant's applied-for mark "so resembles Opposer's trademark and other marks featuring prominently the

[1] Application Serial No. 77587536 was filed on October 7, 2008, based upon Applicant's claim of first use anywhere and use in commerce since at least as early as May 11, 2005, under Section 1(a) of the Trademark Act.

term 'Mattress Overstock' … to cause confusion, mistake or deception of purchasers as to source or sponsorship …" (*Id.*, ¶ 10).

Applicant filed an answer denying the salient allegations of Opposer's likelihood of confusion claim. Applicant also alleged several "affirmative defenses," including the allegation that "Opposer's alleged use of the mark MATTRESS OVERSTOCK does not constitute trademark use sufficient to support trademark rights on which this opposition is based." (*Id.*, Ans. at "Affirmative Defenses" ¶ 1).

I. Record

The record in this case consists of the pleadings and, by rule, the file of the involved application. Trademark Rule 2.122(b)(1).

Opposer submitted copies of the deposition testimony, with accompanying exhibits, of Bradford Cameron, Opposer's owner, and James Becker, Applicant's president.[2]

Opposer also submitted the following materials under a notice of reliance:[3]

- Applicant's responses to Opposer's interrogatories nos. 1, 10, 12-13, 15, 16 (supplemental response), 17-19, and 23;
- Applicant's responses to Opposer's document production requests nos. 1-7, 9, 15-18, and 22-28;[4]
- Printouts from Opposer's website (www.mattressoverstock.com);

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[2] 26 TTABVUE.

[3] 24 TTABVUE.

[4] 16 TTABVUE.

- Printouts from Applicant's website (www.mattressoverstockusa.com);

- Printouts from the Google search engine website pages purportedly showing results of an Internet search for the term "mattress overstock"; and

- Printouts from the Better Business Bureau, MapQuest and Who Is websites.

For its part, Applicant submitted the following materials under a notice of reliance during its trial period:[5]

- Opposer's responses to Applicant's interrogatories nos. 1-3, 5, 10, 14, 24-25, and 27; and

- Opposer's responses to Applicant's requests for admissions nos. 3-4 and (second set) nos. 16-20, 22-25, 27-32, 34, 37-39, 42-44, 46-48, and 50-60;

- Opposer's "Answers to Affirmative Defenses Nos. 1a, 1d";

- Copy of a State of Wisconsin website record from the Department of Financial Institutions;

- Copy of a State of Michigan website record from the Department of Licensing and Regulatory Affairs;

- Printouts from the internet purportedly showing use of MATTRESS OVERSTOCK by Opposer and use of Applicant's MATTRESS OVERSTOCK with design mark; and

- A copy of a State of Illinois trademark application prepared by the Secretary of State.

II. Opposer's Standing

Through the testimony of Opposer's principal, Mr. Cameron, Opposer has established that it is a retail furniture and mattress company with alleged

[5] 25 TTABVUE.

trademark rights in the term MATTRESS OVERSTOCK.[6] This is sufficient to establish that Opposer is more than a mere intermeddler and has standing in this matter. *Cunningham v. Laser Golf Corp*., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

III. Opposer's Asserted Common Law Rights in MATTRESS OVERSTOCK

In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981); see also, *Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1721 (Fed. Cir. 2001). Here, Opposer has asserted that it acquired common law rights in the mark MATTRESS OVERSTOCK prior to any date that Applicant may rely upon for the applied-for mark.

Applicant has challenged Opposer's asserted common-law rights in its answer, contending that the mark is not distinctive. Applicant further argues in its brief that "Opposer has the burden to establish that [its] term has acquired distinctiveness [with respect to] its goods and services, whether inherently or through secondary meaning." Brief, p. 15. Applicant notes that the record "does not

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[6] *See*, *e.g.*, Cameron Dep. 7:15-16, 18-21 ("I own a furniture and mattress company … Corporation is Allure Furniture and Mattress Incorporated, of which we have several trademarks, one being Mattress Overstock, the subject of today"). 26 TTABVUE 8.

reflect how many customers or potential customers were reached by Opposer's efforts let alone how many sales have been made" and that it is ultimately "devoid of evidence to establish that [Opposer's] promotional efforts have borne fruit and it is unclear whether the purchasing public has created an association between the term MATTRESS OVERSTOCK and Opposer's goods and services." *Id.* at 16.

In its reply brief, Opposer counters that "Applicant cannot argue that the MATTRESS OVERSTOCK trademark is distinctive as applied to Applicant's goods (sic) and services but not distinctive [as applied] to Opposer's identical goods and services." Reply Brief, p. 7. Opposer also contends that the record reflects its use of the term MATTRESS OVERSTOCK since 1995, that there have been "134,583 unique visitors" to its website www.mattressoverstock.com, "as a result of its Google AdWords marketing campaign," that it owns state trademark registrations, and that this all "show[s] distinctiveness of the trademark as used by Opposer." *Id.*

The record establishes that the term MATTRESS OVERSTOCK is not inherently distinctive but is instead merely descriptive for retail services involving the sale of mattresses. That is, the term immediately and easily conveys to consumers of these retail services information about the type of goods being sold, namely, overstocked mattresses, and that this is usually done in a discounted

manner. Clearly, the term MATTRESS is generic for the sale of mattresses or the goods themselves. As to the word "overstock," it is defined as:[7]

> (verb) to cause (something) to have a larger amount of something than is needed or wanted — often used as *(be) overstocked*
> - The stores *are overstocked* with toys around Christmas.
> - The pond *is overstocked* with fish.
> - an *overstocked* refrigerator/warehouse
>
> (noun) 1. Too large a stock.
> - At the end of the season, the *overstock* is sold off at a discount.

The term OVERSTOCK is merely descriptive of the services because it describes the type of goods being sold, as the provided example sentence from the above dictionary definition illustrates.

The Examining Attorney responsible for reviewing the subject application submitted evidence showing that the combination term MATTRESS OVERSTOCK is merely descriptive and thus required Applicant to disclaim this term during the prosecution of the application.[8] The materials submitted by the Examining Attorney include printouts from the Internet showing on their face third parties using

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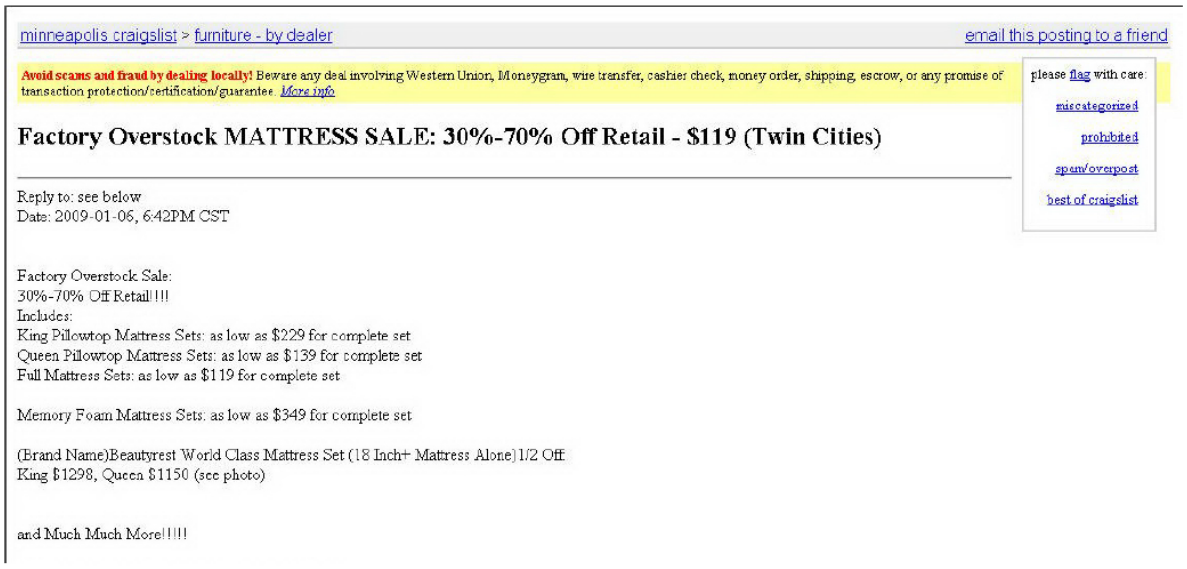
[7] Definition taken from Merriam-Webster Online Dictionary (based on the print version of *Merriam-Webster's Collegiate Dictionary, Eleventh Edition*). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

[8] Evidence submitted during *ex parte* prosecution of underlying application or registration is of record in subsequent *inter partes* proceeding involving that application or registration. *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009).

MATTRESS OVERSTOCK in a descriptive manner in connection with the sale of mattresses:[9]



In the face of this evidence, and as previously noted, Applicant indeed has disclaimed exclusive rights to use of the term MATTRESS OVERSTOCK apart from

[9] Office Action dated January 7, 2009.

the entire mark with the design element. Thus, Opposer's argument that Applicant is attempting to adopt the term as a distinctive element of its mark contradicts the disclaimer statement.

Having determined that MATTRESS OVERSTOCK is not inherently distinctive but merely descriptive of retail mattress services, we must review the record to determine whether or not Opposer has demonstrated that this term has acquired distinctiveness as a source-indicator for Opposer's services. In this regard, we note that the amount of evidence required to establish acquired distinctiveness varies correlating to the degree of descriptiveness of the mark. *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 (Fed. Cir. 1990); and *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). *See also Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976). Here, we find MATTRESS OVERSTOCK not just merely descriptive of retail store services involving mattresses, but because this term so clearly and readily conveys information about the goods being sold, it is highly descriptive. We would also be remiss if we did not point out that Opposer's principal, Bradford Cameron, offered testimony that corroborates the very descriptive nature of the term; Mr. Cameron stated that "[b]ecause we purchased the mattresses in bulk as a truckload … we came up [with] the name Mattress Overstock" and that "[Opposer] was again buying additional

quantities from our manufacturers, overstock, … and market it under Mattress Overstock."[10] In other words, Mr. Cameron's own explanation that because he was purchasing "mattresses in bulk" or by the "truckload," he decided to use the term "Mattress Overstock," clearly contemplates consumers being familiar with the term and understanding its descriptive significance.

Based on the record before us, and bearing in mind the greater evidentiary burden given the degree of descriptiveness of the term MATTRESS OVERSTOCK, we find that Opposer has not met its burden to establish proprietary rights in the term MATTRESS OVERSTOCK. Opposer has not demonstrated that this term has acquired distinctiveness as a source identifier for Opposer's services.

Although Mr. Cameron testified that Opposer began use of the term approximately twenty years ago, in 1995, including "in-store signage," on letterhead, business cards, newspaper advertisements, and in other ways, there is no real evidence showing the breadth of any advertising campaign to establish that consumers have become conditioned or would understand the descriptive term as a source identifier for Opposer. Indeed, Mr. Cameron remarkably did not provide any sales volume figures for any of the years since 1995. Rather, Mr. Cameron's testimony contains only general statements that he was selling mattresses and a single exhibit comprising an invoice for approximately 13 mattresses.[11] To wit, in

[10] 26 TTABVUE; Cameron Dep. 9:16-18 and 21:1-7.

[11] *Id.*, Cameron Exhib. 11.

response to Opposer's counsel's query as to the basis for his opinion that "customers associate you with the name Mattress Overstock," he replied:

> Our web site has received several hundred thousand unique visitors over its operation since 2003. We have sold mattresses from as far away as two or three states, and we continue to sell and have people come in and buy mattresses. So I think we're very well known for what we do.[12]

Without further information, we cannot decipher whether the number of sales of mattresses is in the dozens or thousands. In addition, this information does not show how the term MATTRESS OVERSTOCK has been displayed throughout this period, *i.e.*, in a manner to identify source or simply to provide information.

Furthermore, the facts that Opposer listed an entity identified as "Mattress Overstock" with the Better Business Bureau and obtained state trademark registrations do not establish that consumers perceive this term as a trademark or are even aware of Applicant's use of the term. *See Faultless Starch Co. v. Sales Producers Assocs., Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976) (a state registration by itself has limited probative value for purposes of establishing rights in the asserted trademark and does not carry the same presumptions as a federal registration); s*ee also W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 USPQ2d 1660, 1664-65 (Fed. Cir. 1994).

With regard to Opposer's reference to "134,583 unique visitors" since 2008 to its www.mattressoverstock.com website, Opposer does not provide the context to

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[12] *Id.*, Cameron Dep. 118:13-19.

evaluate this evidence to determine whether it is relevant to consumers' perception of its use of the term MATTRESS OVERSTOCK. In other words, there is no real indication or way to measure how (or if) these "unique visitors" to the website would view MATTRESS OVERSTOCK for us to determine why the merely descriptive term would be understood as a source identifier or why consumers would therefore consider it as a unique reference to Opposer. Thus, while Mr. Cameron testified that Opposer engaged in a paid advertising "Google AdWords campaign" for the years 2011-2014, there is no clear explanation or exhibit demonstrating how these advertisements or the number of visitors result in consumers associating "Mattress Overstock" with Opposer. Referencing an exhibit, Mr. Cameron stated:

> It shows our campaign of Mattress Overstock showing from the dates July 26, 2011 through November 9, 2014, we had 2,178,173 impressions and 23,151 clicks to our web site. Paid Advertised search results.[13]

Upon review of this exhibit, and in conjunction with Mr. Cameron's entire testimony, we remain in the dark as to what consumers are clicking on or if they are even seeing the terms "Mattress Overstock" in a manner such that they would associate the term with Opposer. Finally, Opposer's domain name registration for the website www.mattressoverstock.com does not constitute trademark usage. The mere registration of a term as a domain name does not establish trademark rights in the term. *See Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ2d 1545, 1555 (9th Cir. 1999); see also TMEP § 1215.02(a)

[13] Id., Cameron Dep. 119:18-21, referencing Exhib. 70.

(8th ed. 2011) (noting that a domain name may be registered as a trademark only if it functions as a source identifier).

Finally, we address Mr. Cameron's testimony, and related exhibits, and what it calls "ample evidence of actual confusion." Brief, p. 13. Although this evidence was submitted by Opposer in the context of proving its likelihood of confusion claim, we acknowledge that verifiable instances of actual confusion may also be construed as evidence of consumer awareness of the term as a source-identifier. Here, all of the incidents mentioned by Opposer appear to be nothing more than misdirected emails resulting from one party's email address ending in "@mattressoverstock.com" (Opposer's) and the other party's email addresses ending with "@mattressoverstockusa.com" (Applicant's). In all cases, third parties (or, in a few instances, Applicant's employees) attempted to send emails to Applicant or individual employees of Applicant and the emails were sent to Opposer instead because the sender lopped the "usa" portion from the email address. It has not been shown and we do not see how any of these misdirected emails constitute instances of actual trademark confusion. Pointedly, there is no evidence that consumers confused the source of Opposer's retail services and goods with the source of the retail services of Applicant *as a result of any exposure to* trademark usage of the term MATTRESS OVERSTOCK and Applicant's proposed mark.

Ultimately, we cannot find on this record that Opposer has established that the term MATTRESS OVERSTOCK has acquired distinctiveness as a source-indicator for its retail store services featuring mattresses, or for the goods themselves. The

amount and nature of evidence that the Board generally relies upon for making such findings of acquired distinctiveness is simply not before us. *See, e.g.*, *Cicena Ltd. v. Columbia Telecomms Group*, 900 F.2d 1546, 14 USPQ2d 1401 (Fed. Cir. 1990) (factors the Board may consider include: advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies linking the name to a source). While there is no *per se* rule that any one certain type of evidence must be submitted to establish acquired distinctiveness, there must be sufficient circumstantial or direct evidence for the Board to make this finding. *In re Tires, Tires, Tires Inc.*, 94 USPQ2d 1153, 1157 (TTAB 2009). *See also In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000) ("Acquired distinctiveness may be shown by direct and/or circumstantial evidence. Direct evidence includes actual testimony, declarations or surveys of consumers as to their state of mind. Circumstantial evidence, on the other hand, is evidence from which consumer association might be inferred, such as years of use, extensive amount of sales and advertising, and any similar evidence showing wide exposure of the mark to consumers.").

Accordingly, under the rule of *Otto Roth,* discussed *supra,* Opposer cannot prevail against Applicant on the ground of a likelihood of confusion with its own unregistered term because it has not demonstrated that the term MATTRESS OVERSTOCK is distinctive.

IV. Applicant's Motion to Amend Its Recitation of Services

In a separate but related opposition proceeding, involving this application and a different opposer, Applicant filed a motion to amend the application's recitation of services to exclude "online" retail store services from the recitation of services.[14] The Board acknowledged the motion in both proceedings and deferred consideration until final decision.[15] Having now reached our decisions in both the related proceeding and herein, the Board deems it necessary and appropriate to remand the application to the assigned Trademark Examining Attorney for further examination of the proposed amendment. Rule 2.131; s*ee also* TBMP § 805.[16]

Decision: The opposition is dismissed. The application will be remanded to the Examining Attorney for further consideration of the issue identified herein, under Rule 2.131, after the appeal period for this proceeding has expired.

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[14] Opposition No. 91203624; 7 TTABVUE.

[15] See 9 TTABVUE for this proceeding.

[16] As explained in more detail in our decision in the related opposition, statements made by Applicant, raise the issue of whether or not Applicant is currently using the mark in connection with "on-line retail services" and whether it has any intent to use the mark in connection with on-line retail services. Because the application is based on use, under Section 1(a) ("use in commerce"), it should be amended to delete any services for which Applicant does not currently use the mark and has no intent to do so. This is an issue that may render the mark of the involved application unregistrable with respect to those services. The assigned Examining Attorney should inquire about whether the application requires further amendment; in particular, a query should be made about whether Applicant is no longer using its mark in connection with on-line services and confirmation that the application's declaration of use of the mark in commerce remains valid.