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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Slumberland, Inc.

Serial No. 78525454

James A. Wahl of Krass Monroe, P.A. for Slumberland, Inc.

Kristina Kloiber Morris, Trademark Examining Attorney, Law Office 116 (Michael W. Baird, Managing Attorney).

Before Seeherman, Grendel and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Slumberland, Inc. filed a use-based application for the mark SLUMBERLAND FURNITURE ADVANTAGE CARD, in standard character form, for a "customer loyalty incentive program" (Serial No. 78525454). Applicant disclaimed the exclusive right to use "furniture" and "card," and claimed ownership of the following two registrations, both for "retail store services in the fields of mattresses and furniture":

1. Registration No. 1967577 for SLUMBERLAND, shown below;[1] and,

slumberland

2. Registration No. 2247003 for SLUMBERLAND FURNITURE, in typed drawing form.[2]

The Examining Attorney refused to register applicant's mark under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with a "customer loyalty incentive program," so closely resembles the one registration shown below owned by Slumberland USA Corporation, a Georgia corporation, and the three registrations shown below owned by Dreamwell, Ltd. as to be likely to cause confusion.

Slumberland USA Corporation Registration

Registration No. 0297286 for the mark SLUMBERLAND, shown below, for "mattresses, and box springs."[3]

SLUMBERLAND

[1] Affidavits under Sections 8 and 15 accepted and acknowledged; renewed.
[2] Affidavits under Sections 8 and 15 accepted and acknowledged. Applicant disclaimed the exclusive right to use "furniture."
[3] Registration No. 0297286, issued September 6, 1932; affidavit under Section 8 accepted; fourth renewal.

Dreamwell Ltd. Registrations

1. Registration No. 1175204 for the mark SLUMBERLAND, in typed drawing form, for "mattress, box springs."[4]

2. Registration No. 2091517 for the mark SLUMBERLAND, shown below, for "bedroom furniture, namely mattresses and box springs."[5]

3. Registration No. 2147937 for the mark SLUMBERLAND, shown below for "bedroom furniture, namely, mattresses and box springs; and pillows."[6]

[4] Registration No. 1175204, issued October 27, 1981; affidavits under Sections 8 and 15 accepted and acknowledged; renewed. The registration shows a claim of ownership of Registration No. 0297286 noted above, which Office records show to be owned by Slumberland USA Corporation (GA).
[5] Registration No. 2091517, issued August 26, 1997; affidavit under Section 8 accepted; renewed. This registration also shows a claim of ownership of Registration No. 0297286 noted above.
[6] Registration No. 2147937, issued March 31, 1998; affidavit under Section 8 accepted.

The Record

The record in this application includes the following evidence:

1. Excerpts from applicant's website submitted by the Examining Attorney to show that applicant intends to use its mark to identify a customer loyalty incentive program in connection with the purchase of bedroom furniture, beds, and mattresses;[7]

2. Excerpts from three informational websites submitted by the Examining Attorney to show that incentive programs are designed to build brand loyalty;[8]

3. Copies of seven registrations from the U.S. Patent and Trademark Office trademark database for "registrations of marks used in connection with the same or similar goods and services as those of applicant and registrant (sic) in this case."[9] We note that three of the registrations also include retail store services;

4. Excerpts from two websites to show that "[c]ustomer loyalty programs are designed to build brand loyalty and make (sic) take a number of different forms, including rebates, financing offers, and credit cards";[10]

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[7] The July 6, 2005 Office Action.
[8] The July 6, 2005 Office Action.
[9] The September 29, 2006 Office Action.
[10] The September 29, 2006 Office Action.

5. Excerpts from ten websites which, according to the Examining Attorney, show that "it is common practice in the industry to providing (sic) customer incentive and loyalty programs for the purchase of furniture, including box springs, mattresses, and beds."[11] We note that these excerpts were from companies providing retail store and online retail store stores, and not from furniture or mattress manufacturers.

6. A copy of a consent agreement, dated March 21, 1989, between applicant and Slumberland U.S.A. Corporation, a Delaware corporation.[12] The consent agreement was executed in connection with the prosecution of applicant's application to register SLUMBERLAND and Design (Registration No. 1967577). The relevant terms of the agreement are summarized below:

A. Slumberland U.S.A. Corporation (DE) unequivocally claimed ownership of Registration No. 0297286 and Registration No. 1175204, as well as the applications that subsequently issued as

[11] The September 29, 2006 Office Action. The Examining Attorney claimed that there were eleven websites, but there were two excerpts from Mattress Discounters.

[12] Slumberland PLC, an English limited liability company, was also a party to the agreement. Slumberland PLC is not an applicant or registrant of any of the cited registrations and there is no explanation as to its ownership role vis-à-vis the SLUMBERLAND marks. For the sake of simplicity, we will only refer to Slumberland U.S.A. Corporation (DE).

Registration No. 2091517 and Registration No. 2147937 (*i.e.*, the four registrations that have been cited against applicant's application);[13]

B. Applicant "agrees that it will not use or register the mark SLUMBERLAND for goods or services other than retail store services," specifically, it will not use or register SLUMBERLAND for mattresses, box springs, and beds;

C. Slumberland USA Corporation (DE) agrees that it will not use or register SLUMBERLAND for any goods or services other than mattresses, box springs and beds and it will specifically not use or register SLUMBERLAND for retail stores services;

[13] According to the assignment records in the U.S. Patent and Trademark Office, Slumberland USA Corporation (DE) was never a record owner of Registration No. 0297286. Nor was it a record owner of Registration No. 1175204 in 1989 when the agreement was executed. At that time, Office records show that Eclipse Sleep Products of New England, Inc owned both registrations. We cannot determine from our review of the assignment records anything about the relationship, if any, between Slumberland USA Corporation (DE) and Slumberland USA Corporation (GA). Nevertheless, because Slumberland Corporation (DE) made an unequivocal claim of ownership of Registration Nos. 0297286 and 1175204, and because the Examining Attorney never raised a question regarding ownership, we have considered the consent agreement to be from the owner of the registrations at the time it was executed, and have accorded it the probative value to which it is entitled.

D. Applicant consents to the use and registration of SLUMBERLAND for mattresses, box springs and beds by Slumberland USA Corporation (DE);

E. Slumberland USA Corporation (DE) consents to applicant's use and registration of SLUMBERLAND in connection with retail store services; and,

F. Applicant and Slumberland USA Corporation (DE) and their predecessors have been concurrently using SLUMBERLAND for over 25 years in connection with their respective goods and services without any reported instances of confusion, and therefore they believe that compliance with the provisions of the agreement will avoid confusion.

The Examining Attorney contends that there is a likelihood of confusion because the marks, goods and services, and channels of trade are similar. The Examining Attorney is not persuaded that the consent agreement is sufficient to permit applicant to register its mark for a "customer loyalty incentive program" for the following reasons:

1. The agreement provides that applicant will only use and register SLUMBERLAND for retail store services, and "customer loyalty incentive programs" are not retail store services;

2. Since the agreement was executed in 1995, "the circumstances surrounding the parties' circumstances may have changed"; and,

3. Dreamwell, Ltd., the owner of Registration Nos. 1175204, 2091517, and 2147937, was not a party to the agreement and "would therefore not be bound by the terms of the agreement."[14]

Applicant, on the other hand, argues that the marks are not similar and the goods and services are not closely related. Applicant points out that the Internet evidence submitted by the Examining Attorney to show that it is common practice to have customer loyalty incentive programs in connection with furniture actually demonstrates that furniture retailers such as applicant, not mattress manufacturers such as the registrants, sponsor such customer loyalty incentive programs. Therefore, a customer loyalty incentive program is more closely associated with applicant's retail store services than the registrants' mattresses, box springs, and pillows.[15] With respect to the consent agreement, applicant contends that Dreamwell, Ltd.

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[14] Examining Attorney's Brief, p. 10. Since the owner of Registration No. 0297286 is Slumberland USA Corporation (GA), not Slumberland USA Corporation (DE), the Examining Attorney presumably would not consider Slumberland USA Corporation (GA) bound by the terms of the agreement either.
[15] Applicant's Reply Brief, pp. 6-8.

is the successor-in-interest to Slumberland USA Corporation (DE), and therefore it is bound by the terms of the agreement.[16]

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

First, we analyze the strength of SLUMBERLAND when used in connection with mattresses, box springs and retail store services in the field of mattresses because our finding will affect the scope of protection or exclusivity of use that we accord the cited registrations in determining whether applicant's mark is likely to cause confusion. SLUMBERLAND is highly suggestive when used in connection with mattresses, box springs and retail store services in the field of mattresses because "slumberland" means "an imaginary land described to children as the place

[16] Applicant's Reply Brief, pp. 8-10.

they enter during sleep."[17] Accordingly, when the word "slumberland" is used in connection with mattresses, box springs, or retail stores services in the field of mattresses, it conjures up the commercial impression of peaceful, child-like sleep.

It appears from the record that three different entities own registrations for marks incorporating the word SLUMBERLAND for mattresses, box springs and related retail store services. The following entities own registrations incorporating SLUMBERLAND:

1. Applicant owns two registrations for the marks SLUMBERLAND and SLUMBERLAND FURNITURE for retail store services in the field of mattresses and furniture;
2. Slumberland USA Corporation (GA) is the owner of a registration for the mark SLUMBERLAND (stylized) for mattresses and box springs; and,
3. Dreamwell, Ltd. is the owner of a registration for the mark SLUMBERLAND, in typed drawing form,

[17] The Random House Dictionary of the English Language Unabridged, p. 1802 (2nd ed. 1987). *See also* Webster's Third New International Dictionary of the English Language Unabridged, p. 2148 (1993) ("an unreal country that is a realm of sleep"). The Board may take judicial notice of these definitions. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.,* 213 USPQ 594, 596 (TTAB 1982), *aff'd,* 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

for mattresses and box springs, and two registrations for the mark SLUMBERLAND (stylized) for mattresses, box springs, and pillows.

"While third-party registrations, the marks in which have not been shown to be in actual use, have little, if any probative value in a case based on the likelihood of confusion between two other marks, they may be relied on to show that a word common to each of the third-party marks has a readily understood and well-known meaning and that it has been adopted by third parties to express that meaning." *The Ritz Hotel v. Ritz Closet Seat Corp.,* 17 USPQ2d 1466, 1470 n.10 (TTAB 1990). *See also Red Carpet Corporation v. Johnstown American Enterprises Inc.,* 7 USPQ2d 1404, 1406 (TTAB 1988); *Plus Products v. Star-Kist Foods, Inc.,* 220 USPQ 541, 544 (TTAB 1983). In this case, the multiple SLUMBERLAND registrations owned by different entities suggest that consumers encountering these marks will attribute the above-noted commercial impression of peaceful, child-like sleep to those marks. In such circumstances, the presence of a common, suggestive element, like SLUMBERLAND, may not be a sufficient basis upon which to support a finding of likelihood of confusion. *Tektronix Inc. v. Daktronics Inc.,* 534 F.2d 915, 189 USPQ

693, 694 (CCPA 1976); *Red Carpet Corporation v. Johnstown American Enterprises Inc., supra.*

In this regard, we have the additional fact that Slumberland USA Corporation (DE), the purported owner, at least at one time, of all the cited registrations,[18] consented to applicant's use and registration of SLUMBERLAND in connection with retail store services. The consent agreement in this case is entitled to only limited probative value because the agreement provides that applicant will use and register the mark SLUMBERLAND only for retail store services and that Slumberland USA Corporation (DE) consents only to applicant's use of SLUMBERLAND for retail store services. There is no specific consent to applicant's use and registration of SLUMBERLAND in connection with applicant's "customer loyalty incentive programs." However, the websites submitted by the Examining Attorney show that it is common practice to provide customer incentive and loyalty programs for the purchase of furniture, including box springs, mattresses, and beds. This evidence indicates that customer loyalty incentive programs are offered in connection with retail store and online retail store

[18] *See* footnote 13 *supra.*

services, and are not services by furniture or mattress manufacturers. Thus, although we do not view the prior consent agreement as providing for applicant to obtain registration for customer loyalty incentive programs, it does lend support to the conclusion that the use of the word "slumberland" in connection with mattresses and box springs, on the one hand, and a customer loyalty incentive program, on the other, is not likely to cause confusion. *In re Donnay International Societe Anonyme,* 31 USPQ2d 1953, 1956 (TTAB 1994) (while naked consent was given limited probative value, the Board did infer from the fact that consent was given that registrant did not believe that confusion was likely).

Taking into consideration all of the relevant likelihood of confusion factors, and in particular the inherent weakness of SLUMBERLAND, and the consent agreement between applicant and the registrants' predecessor-in-interest, as well as the fact that a customer loyalty incentive program is more closely associated with applicant's retail store services than registrants' products, we find on the record before us that confusion is not likely. Furthermore, to the extent that we have any doubts on this matter, the consent of registrants' predecessor-in-interest to applicant's registration of

SLUMBERLAND in connection with retail store services negates the presumption that doubts about likelihood of confusion are to be resolved in favor of the registrants. *In re Donnay International Societe Anonyme, supra* at 1957 (by giving consent to the registration of applicant's mark, registrant has removed the basis for applying the equitable concept of resolving doubt in favor of the registrant).

Decision: The refusal to register applicant's mark is reversed.