

ESTTA Tracking number: **ESTTA1329519**
Filing date: **12/19/2023**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer information

Name	Factory Direct, Inc.
Granted to date of previous extension	12/23/2023
Address	219 S. PORTLAND OKLAHOMA CITY, OK 73108 UNITED STATES
Attorney information	KURT M. RUPERT HARTZOG CONGER CASON 201 ROBERT S. KERR AVE. SUITE 1600 OKLAHOMA CITY, OK 73102 UNITED STATES Primary email: trademarks@hartzoglaw.com Secondary email(s): krupert@hartzoglaw.com, delder@hartzoglaw.com, mail@marymlee.com (405) 235-7000
Docket no.	2012.1604

Applicant information

Application no.	97417654	Publication date	10/24/2023
Opposition filing date	12/19/2023	Opposition period ends	12/23/2023
Applicant	Serta, Inc. 2451 INDUSTRY AVENUE DORAVILLE, GA 30360 UNITED STATES		

Goods/services affected by opposition

Class 020. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Mattresses; Pillows; Mattress toppers
Class 024. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Bed sheets

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Mark cited by opposer as basis for opposition

U.S. registration no.	3609893	Application date	01/24/2008
Register	Principal		
Registration date	04/21/2009	Foreign priority date	NONE
Word mark	ECO COMFORT		
Design mark			
Description of mark	NONE		
Goods/services	Class 020. First use: First Use: Mar 1, 2008 First Use In Commerce: Mar 1, 2008 Sleep products, namely, mattresses, spring mattresses, box springs and mattress foundations		

Attachments	Notice of Opposition 97417654.pdf(443200 bytes) Exhibit 1_red.pdf(5445607 bytes)
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Signature	/Kurt M. Rupert/
Name	KURT M. RUPERT
Date	12/19/2023

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

Factory Direct, Inc.,)	
)	
Opposer,)	Opposition No. _____
)	Serial No. 97417654
v.)	Mark: ICOMFORTECO
)	Filing Date: May 18, 2022
Serta, Inc.)	Publication Date: October 24, 2023
)	
Applicant.)	

NOTICE OF OPPOSITION

Factory Direct, Inc., an Oklahoma corporation, located and doing business at 3920 W. I-40 Service Rd., Oklahoma City, OK 73108 (“Factory Direct”) provides its Notice of Opposition to the registration of the Mark shown in Application Serial No. 97417654 in International Class 24 and U.S. Classes 42 and 50 for Bed Sheets, and in International Class 20 and U.S. Classes 2, 13, 22, 25, 32 and 50 for Mattresses; Pillows; and Mattress toppers filed by Serta, Inc. (“Serta”) on May 18, 2022. In support of its Notice of Opposition, Factory Direct states as follows:

1. Factory Direct has been engaged in the manufacture, distribution, sale, advertising, and promotion in interstate commerce of Factory Direct’s ECO COMFORT mattresses and related sleep products since March 2008.

2. Since at least March 2008, Factory Direct has used, and is now using, Factory Direct’s registered ECO COMFORT trademark in connection with the products it manufactures, distributes, sells, advertises, and promotes in interstate commerce on its mattresses and related sleep products.

3. Factory Direct is the owner of, and will rely herein upon, the following Federal Trademark Registration:

Mark	ECO COMFORT
Registration Number	3,609,893
Issue Date	April 21, 2009
Goods	Sleep products, namely, mattresses, spring mattresses, box springs and mattress foundations

(the “ECO COMFORT Registered Mark”).

4. Registration of Factory Direct’s ECO COMFORT Registered Mark is valid, subsisting, and conclusive evidence of Factory Direct’s exclusive right to use the ECO COMFORT Registered Mark in commerce on the goods specified in said registration.

5. In addition to its rights to use the ECO COMFORT Registered Mark, Factory Direct additionally claims rights under common law to the exclusive use of the ECO COMFORT mark for various promotional purposes relating to mattresses and related sleep products.

6. The validity of the ECO COMFORT Registered Mark; the registration of the ECO COMFORT Registered Mark; Factory Direct’s ownership of the ECO COMFORT Registered Mark; and Factory Direct’s exclusive right to use the ECO COMFORT Registered Mark in commerce for the above-mentioned goods are incontestable under 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b). Factory Direct has filed the required Affidavit with the Commissioner of Patents and Trademarks.

7. Factory Direct has continuously used the ECO COMFORT Registered Mark to identify its ECO COMFORT line of mattresses since March 2008, and to distinguish them from those made and sold by others. Factory Direct has identified its ECO COMFORT line of mattresses by, among other things, prominently displaying the ECO COMFORT Registered Mark on mattresses that it manufactures, and with respect to all related promotional materials associated therewith. As a result of sales, advertising, and marketing by Factory Direct, the ECO COMFORT Registered Mark is inherently distinctivegoodwillrly identifies Factory Direct as the manufacturer

of the ECO COMFORT line of mattresses, and Factory Direct's use of the ECO COMFORT Registered Mark has developed substantial goodwill and great value in the mattress market.

8. The ECO COMFORT Registered Mark is strong and distinctive. It has long been used by Factory Direct in connection with the goods on which it appears and has long been the subject of substantial advertising and promotion by Factory Direct. Factory Direct has used and advertised the ECO COMFORT Registered Mark throughout the United States, and it is widely recognized by consumers and those in the trade and is exclusively used by Factory Direct. Factory Direct has expended and continues to expend significant amounts of time and money to advertise, offer for sale, and promote its products through its distinctive ECO COMFORT Registered Mark throughout the United States.

9. On May 18, 2022, Applicant filed an application for registration of the proposed stylized ICOMFORTECO trademark for "Bed Sheets" in International Class 24 and U.S. Classes 42 and 50 and for "Mattresses; Pillows; Mattress toppers" in International Class 20 and U.S. Classes 2, 13, 22, 25, 32 and 50. The Application was assigned Serial Number 97417654 and was published for Opposition in the Official Gazette of October 24, 2023.

10. Applicant's stylized ICOMFORTECO mark so resembles Factory Direct's ECO COMFORT Registered Mark that when applied to the goods of Applicant it is likely to cause confusion, mistake, and to deceive as to the affiliation, connection, or association of Applicant with Factory Direct, and as to the origin, sponsorship, or approval of Factory Direct, resulting in damage and detriment to Factory Direct and to its reputation.

11. Beginning in February 2023 Applicant caused mattresses to enter interstate commerce with the unregistered designation and representation ICOMFORTECO on a new line of mattresses using the stylized ICOMFORTECO presentation in which the "I" is barely visible,

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