

**IN THE MATTER OF AN OPPOSITION
by Simmons I.P. Inc. and Simmons Canada Inc.
to application No. 761,232 for the trade-mark
SLEEP QUEEN filed by Literie Primo Inc./
Primo Bedding Company Inc.**

On August 5, 1994, the applicant, Literie Primo Inc./Primo Bedding Company Inc., filed an application to register the trade-mark SLEEP QUEEN for “beds, mattresses, sofa-beds, bed frames and box springs” based on proposed use in Canada. The application was amended to include a disclaimer to the word QUEEN and was subsequently advertised for opposition purposes on March 8, 1995.

The opponents, Simmons I.P. Inc. and Simmons Canada Inc., filed a statement of opposition on May 8, 1995, a copy of which was forwarded to the applicant on July 28, 1995. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with each of the following registered trade-marks owned by the first opponent Simmons I.P. Inc.:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>
TMDA46083	SLUMBER QUEEN	(1) bedding generally, and particularly mattresses, couch pads, pillows, bolster rolls and cushions, (2) furniture, namely upholstered furniture, box springs, bed frames, head boards, foot boards, and cribs
UCA34244	BABYSLEEP	cribs, cots and mattresses therefor
TMDA40869	BEAUTYSLEEP	pillows, mattresses, comforters, bolster rolls and cushions
TMDA48375	DEEPSLEEP	mattresses and box springs
TMDA48376	DEEPSLEEP	bedding generally and particularly mattresses, pillows, bolster rolls and cushions
TMDA30136	SLUMBER KING	mattresses and box springs, pillows and upholstered furniture
392,900	PRINCESS	mattresses, box springs and mattress foundations

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the registered trade-marks noted above previously

used in Canada by the opponents. The third ground is that the applied for trade-mark is not distinctive because it is confusing with the opponents' trade-marks.

The applicant filed and served a counter statement. As their evidence, the opponents filed an affidavit of R. Edward Jackson, the Vice-President - Marketing of Simmons Canada Inc. As its evidence, the applicant filed an affidavit of its Vice-President - Purchasing, George Itzkovitz. Both parties submitted a written argument and an oral hearing was conducted at which both sides were represented.

The opponents' first ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with a number of registered trade-marks. The first mark relied on is SLUMBER QUEEN registered under No. TMDA46083. The material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's mark is comprised of the word SLEEP which describes what the wares are used for and the word QUEEN which denotes a standard size of mattress. Thus, the applicant's mark is not inherently strong. Mr. Itzkovitz states that the applicant has sold over 1,000 SLEEP QUEEN mattresses to various retailers across Canada. However, the applicant's mark appears to have been used only as a trade-name on mattress labels subordinate to a product mark. Thus, I am only able to conclude that the applicant's mark has become known to a limited extent.

The opponents' mark SLUMBER QUEEN is also comprised of a word which describes what the wares are used for together with a word which denotes a standard size of mattress.

Thus, the opponents' mark is also not inherently strong. The Jackson affidavit fails to evidence any use of the mark SLUMBER QUEEN. Thus, I must conclude that it has not become known at all in Canada.

In view of the opponents' failure to evidence any use of their mark, the length of time the marks have been in use is not a material factor in the present case. As conceded by the parties, the wares and trades at issue are the same. However, as noted by the applicant, wares such as mattresses and furniture are relatively expensive. This suggests that consumers will take more care in purchasing such items and will be less likely to be confused by similar trade-marks used by different manufacturers.

As for Section 6(5)(e) of the Act, I consider there to be a fairly high degree of resemblance between the marks at issue in all respects. The second component of each mark is identical and the first component of each comprises a word commencing with the letters SL and which connotes nighttime rest.

As an additional surrounding circumstance, I have considered the use of other trade-marks owned by the first opponent. For example, the Jackson affidavit evidences some recent use of the marks SLUMBER KING and PRINCESS which points to the beginnings of a family or series of marks incorporating the concepts of sleep and royalty. Thus, those consumers familiar with the opponents' additional marks may be more likely to assume that the mark SLEEP QUEEN is part of the opponents' family.

The opponents have also evidenced extensive sales of mattresses and the like in association with the mark BEAUTYSLEEP. Consumers familiar with that mark may also view some connection with the applicant's mark which includes the identical (albeit weak) component SLEEP.

The applicant contended that an additional surrounding circumstance of note is the absence of evidence of incidents of actual confusion. However, given that no use has been

shown of the opponents' mark SLUMBER QUEEN, that limited use has been shown of the applicant's mark and that the applicant's mark appears to have been used solely as a trade-name subordinate to the applicant's trade-mark MONACO (see Exhibit 2 to the Itzkovitz affidavit), one would not expect incidents of actual confusion to have yet arisen.

The applicant referred to the decision of the Federal Court of Appeal in Park Avenue Furniture v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 413 (F.C.A.); revg. (1989), 25 C.P.R.(3d) 408; affg. (1987), 18 C.P.R.(3d) 84 (T.M.O.B.) which held that the trade-marks POSTURE-BEAUTY and BABYBEAUTY were not confusing in part due to the narrow range of protection accorded to the component BEAUTY. However, in that case, the applicant-appellant had evidenced use of a number of third party marks including the component BEAUTY in the same area of commerce (see page 428). No such evidence has been adduced in the present case respecting the words SLEEP and SLUMBER. In fact, notwithstanding the inherent weakness of those words for mattresses and the like, the only relevant registrations of record in the present case are owned by the first opponent. If similar marks are owned or used by other parties, presumably the applicant would have evidenced that fact. At page eight of its written argument, the applicant states as follows:

Insofar as the Opponent's SLUMBER QUEEN trade mark is concerned, there is a certain degree of resemblance, both visually and orally, as well as in the ideas conveyed, between the said mark and the Applicant's SLEEP QUEEN trade mark. However, all traders of mattresses seek to adopt, and do adopt, trade-marks that allude to qualities or characteristics of the wares or of the state of the user of such wares. The Canadian public has for many years distinguished between these suggestive marks and will readily continue to do so.

Without evidence on point, I am not in a position to make the same conclusions.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks of the parties and the reputation associated with the opponents' additional marks SLUMBER KING, PRINCESS and BEAUTYSLEEP and notwithstanding the price of the wares at issue, I find that I am left in a state of doubt respecting the issue of confusion. Since the onus is on the applicant, I must

resolve that doubt against it and find the first ground to be successful. Thus, the remaining grounds need not be considered. Had the applicant been able to evidence common use of similar marks by other traders, the result may have been different.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 28th DAY OF AUGUST, 1997.

**David J. Martin,
Member,
Trade Marks Opposition Board.**