

ESTTA Tracking number: **ESTTA729990**

Filing date: **02/27/2016**

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

Proceeding	91226201
Party	Plaintiff ICON Health & Fitness, Inc.
Correspondence Address	GREGORY M HESS PARR BROWN GEE & LOVELESS PC 101 S 200 E STE 700 SALT LAKE CITY, UT 84111 UNITED STATES ghess@parrbrown.com, lshaw@parrbrown.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Gregory M. Hess
Filer's e-mail	ghess@parrbrown.com
Signature	/Gregory M. Hess/
Date	02/27/2016
Attachments	Motion for Leave to file Amended Notice of Opposition in 91226201.pdf(1005450 bytes )

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

In the Matter of Application Serial No. 86728087 (PRO-FORM 2)

Filed: August 19, 2015

Published for Opposition: December 8, 2015

ICON HEALTH & FITNESS, INC.,	)	
	)	Opposition No. 91226201
Opposer,	)	
	)	<b><u>MOTION TO AMEND</u></b>
v.	)	<b><u>NOTICE OF OPPOSITION</u></b>
	)	
	)	
MYCONE DENTAL SUPPLY CO., INC.,	)	
	)	
Applicant.	)	

Pursuant to TMBP § 507.01 and Federal Rule of Civil Procedure 15(a)(2), Opposer ICON Health and Fitness, Inc. hereby moves the Board for leave to file an Amended Notice of Opposition in the form attached hereto as Exhibit 1. A redline showing the changes from the original Notice of Opposition is attached hereto as Exhibit 2. As grounds for the motion, Opposer submits as follows: Opposer attempted to file an amended notice of opposition as a matter of course to correct an error in the original notice and made several additional changes, within twenty-one (21) days after service of the original Notice of Opposition as permitted by TMBP § 507.01 and Rule 15(a)(1)(A) of the Federal Rules of Civil Procedure, but Opposer did not make the deadline due to technical and other difficulties. Opposer could wait to file its Amended Notice of Opposition until after receiving Applicant's response to the original Notice of Opposition, as permitted by TMBP § 507.01 and Rule 15(a)(1)(B), but it would be more efficient for Opposer and for Applicant for the Amended Notice of Opposition to be filed before Applicant answers. In addition, the rules

applicable to this proceeding provide that leave to amend should be freely granted when justice so requires, as in these circumstances. TMBP § 507.01; F. R. Civ. P. 15(a)(1)(2).

WHEREFORE, Opposer hereby requests leave to file the Amended Notice of Opposition submitted herewith.

Dated: February 27, 2016

Respectfully submitted,  
PARR BROWN GEE & LOVELESS

/s/ Gregory M. Hess\_\_\_\_\_

Gregory M. Hess  
LaShel Shaw  
PARR BROWN GEE & LOVELESS, P.C.  
101 South 200 East, Suite 700  
Salt Lake City, Utah 84111  
801-532-7840  
[ghess@parrbrown.com](mailto:ghess@parrbrown.com)  
[lshaw@parrbrown.com](mailto:lshaw@parrbrown.com)  
Attorneys for ICON Health and Fitness, Inc.

# EXHIBIT 1

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

In the Matter of Application Serial No. 86728087 (PRO-FORM 2)

Filed: August 19, 2015

Published for Opposition: December 8, 2015

ICON HEALTH & FITNESS, INC.,	)	
	)	Opposition No. 91226201
Opposer,	)	
	)	<b><u>AMENDED</u></b>
v.	)	<b><u>NOTICE OF</u></b>
	)	<b><u>OPPOSITION</u></b>
	)	
MYCONE DENTAL SUPPLY CO., INC.,	)	
	)	
Applicant.	)	

ICON Health and Fitness, Inc. (“ICON”), a corporation organized and existing under the laws of Delaware with a place of business at 1500 South 1000 West, Logan, Utah 84321, believes that it will be damaged by the issuance of a registration for the alleged mark shown in Application Serial No. 86728087 for the mark PRO-FORM 2 in international classes 010 and 028. ICON hereby opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1046(1).

As grounds for opposition, ICON alleges as follows:

1.       ICON is one of the world’s largest manufacturers of exercise and fitness equipment and sells exercise and fitness products and services throughout Asia, Europe, and North and South America, including throughout the United States.

2.       Since at least as early as 1982, ICON’s predecessor in interest began using the trademark PROFORM in connection with clothing. Since at least as early as 1988, ICON’s predecessor in interest began using the trademark PROFORM in connection with exercise

equipment, including stepping machines, treadmills, striding machines, stationary cycles, rowing machines, and other exercise-related equipment.

3. ICON owns the following five relevant valid and subsisting U.S. Trademark Registrations on the Principal Register in the U.S. Patent and Trademark Office (“PTO”):

<b>Mark</b>	<b>No.</b>	<b>Date Issued</b>	<b>Goods &amp; Services</b>
PRO FORM	1,346,441	7/2/1985	Exercising Apparatus-Namely, Rowing Machines and Multiple Purpose Exercising Machines.
PRO FORM	1,525,754	2/21/1989	Clothing, namely shorts, pants, shirts, tops, sweat pants and jackets.
PRO FORM	1,718,385	9/22/1992	Exercising apparatus; namely, stepping machines, striding machines, and stationary cycles.
PRO FORM	2,944,885	4/26/2005	Clothing, namely, t-shirts, long sleeve t-shirts, tank tops, jackets, shorts, sport tops.
PRO-FORM	4,665,905	1/6/2015	Elliptical exercise machines; Exercise balls; Exercise doorway gym bars; Exercise machines; Exercise weights; Manually-operated exercise equipment; Physical fitness equipment, namely, treadmills, ellipticals, stationary exercise bicycles, stepping machines; Vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance; Wrist and ankle weights for exercise; Yoga mats.

Collectively these five marks shall be referred to herein as the “PRO-FORM Marks” and the associated registrations shall be referred to herein as the “PRO-FORM Registrations.”

4. ICON and its predecessors in interest first used the mark protected by U.S. Trademark Registration No. 1,346,441 in the United States at least as early as December 22, 1982 and first used the mark in interstate commerce in the United States at least as early as January 10, 1983 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of exercising equipment, namely, rowing machines and multiple purpose exercise machines. Attached as Exhibit A is a true and correct printout of the PTO’s information about U.S. Trademark Registration No. 1,346,441, which was issued by the PTO on

July 2, 1985. ICON and its predecessors in interest have used the mark continually in interstate commerce in the United States since that time.

5. ICON and its predecessors in interest have used the mark protected by U.S. Trademark Registration No. 1,525,754 in interstate commerce in the United States continuously since at least November 26, 1984 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of clothing. Attached as Exhibit B is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 1,525,754, which was issued by the PTO on February 21, 1989.

6. ICON and its predecessors in interest have used the mark protected by U.S. Trademark Registration No. 1,718,385 in interstate commerce in the United States continuously since at least February, 1988 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of exercising apparatus. Attached as Exhibit C is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 1,718,385, which was issued by the PTO on September 22, 1992.

7. ICON has used the mark protected by U.S. Trademark Registration No. 2,944,885 in interstate commerce in the United States continuously since at least January 2, 2003 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of clothing. Attached as Exhibit D is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 2,944,885, which was issued by the PTO on April 26, 2005.

8. ICON has used the mark protected by U.S. Trademark Registration No. 4,665,905 in interstate commerce in the United States continuously since at least February 7, 2004 in connection with the provision, sale, marketing, advertising, and promotion of exercise equipment, machines,

balls, bars, apparatus, weights, and mats. Attached as Exhibit E is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 4,665,905, which was issued by the PTO on January 6, 2015.

9. As a result of its widespread, continuous, and exclusive use of the PRO-FORM Marks to identify its goods and services with ICON as their source, ICON owns valid and subsisting federal statutory and common law rights to the PRO-FORM Marks.

10. The PRO-FORM Marks are distinctive to both the consuming public and within the exercise and fitness industry.

11. ICON has expended substantial time, money, and resources in marketing, advertising, and promoting the goods and services offered under the PRO-FORM Marks, including, among other things, television, radio, newspaper, magazine, internet, social media, and other media.

12. ICON's promotional efforts have led to ICON's patrons, potential patrons, and the general public coming to know and recognize the PRO-FORM Marks and associate them with ICON and its goods and services. ICON has therefore built up extensive, valuable goodwill in the PRO-FORM Marks. As a result of their distinctiveness and widespread use and promotion throughout the United States, the PRO-FORM Marks are famous trademarks within the meaning of 15 U.S.C. 1125(c).

13. Applicant Mycone Dental Supply Co., Inc. ("Mycone"), with an address at 480 South Democrat Road, Gibbstown, New Jersey, 08027, on August 19, 2015 filed trademark Application Serial No. 86728087 to register the proposed mark PRO-FORM 2 for the following goods and services:

International Class 001	Plastic molding compounds for use in the manufacture of molded plastic articles.
-------------------------	--

International Class 010	Dental instruments for use in protection of mouth and teeth.
International Class 028	Athletic equipment, namely, mouth guards; Mouth guards for athletic use.

14. The PRO-FORM Registrations have priority over Applicant’s application because Petitioner’s first-use and registration dates for the PRO-FORM Marks predate the filing date of Applicant’s application and any other date on which Mycone may rely for purposes of priority for use of its mark in international classes 010 and 028.

15. Applicant’s mark PRO-FORM 2 is confusingly similar to the PRO-FORM Marks, as it wholly incorporates the text of all four of the PRO-FORM MARKS, distinguished only by the Applicant’s addition of the character “2” at the end of the mark. As a result, Applicant’s mark is strikingly similar to the PRO-FORM Marks in appearance, sound, and connotation, and creates a similar commercial impression.

16. The likelihood of confusion is heightened because the goods covered by Applicant’s Application Serial No. 86728087 are sports and fitness-related products, including without limitation mouth guards and athletic mouth guards, while the goods and services promoted by ICON under the PRO-FORM Marks include, in addition to the items previously listed above, wearable fitness-related accessories, such as wrist and ankle weights, heart-rate monitor watches and chest straps, and waist wraps, as well as protective gear for use in athletic activities, such as training gloves and weightlifting belts.

17. Also, on information and belief, Applicant’s PRO-FORM 2 branded goods will be sold in some of the same channels of trade that ICON sells its PRO-FORM goods. For example, Applicant’s PRO-FORM athletic mouth guards are sold online. See Exhibit F attached hereto, which is a printout from a website offering Applicant’s PRO-FORM branded goods for sale. ICON

also markets and sells its PRO-FORM branded goods directly to consumers through major online retailers such as [www.walmart.com](http://www.walmart.com), [www.shopko.com](http://www.shopko.com), [www.overstock.com](http://www.overstock.com), and [www.khols.com](http://www.khols.com). See Exhibit G, which are sample printouts showing various PRO-FORM branded goods being sold on such websites.

#### **FIRST GROUND FOR OPPOSITION – LIKELIHOOD OF CONFUSION**

18. The proposed mark is barred from registration in international classes 010 and 028 because it consists of or compromises a mark which so resembles ICON's previously used and registered PRO-FORM Marks as to be likely, when used in connection with the alleged goods of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

#### **SECOND GROUND FOR OPPOSITION - DILUTION**

19. Petitioner's PRO-FORM Marks are distinctive and a "famous mark" within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

20. The PRO-FORM Marks became distinctive and famous prior to the filing date of Applicant's application or any other date on which the Respondent may rely for purposes priority.

21. Applicant's Application Serial No. 86728087 impairs the distinctiveness and causes dilution by blurring of, and thereby damages, Petitioner's famous PRO-FORM Marks in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, the proposed PRO-FORM 2 mark is not entitled to registration.

22. Furthermore, if and to the extent that Mycone sells substandard products using the PRO-FORM 2 mark, Applicant's Application Serial No. 86728087 will also likely harm the reputation and cause dilution by tarnishment of, and thereby damage, Petitioner's PRO-FORM Marks in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, the proposed PRO-FORM 2 mark is not entitled to registration.

WHEREFORE, Petitioner respectfully prays that its opposition be sustained and that registration to the pursuant to Applicant's Application Serial No. 86728087 be refused in international classes 10 and 28.

Dated: February 27, 2016

Respectfully submitted,  
PARR BROWN GEE & LOVELESS

/s/ Gregory M. Hess

Gregory M. Hess  
LaShel Shaw  
PARR BROWN GEE & LOVELESS, P.C.  
101 South 200 East, Suite 700  
Salt Lake City, Utah 84111  
801-532-7840  
[gness@parrbrown.com](mailto:gness@parrbrown.com)  
[lshaw@parrbrown.com](mailto:lshaw@parrbrown.com)  
Attorneys for ICON Health and Fitness, Inc.

# EXHIBIT A



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# Typed Drawing

**Word Mark** PRO FORM  
**Goods and Services** IC 028. US 022. G & S: Exercising Apparatus-Namely, Rowing Machines and Multiple Purpose Exercising Machines. FIRST USE: 19821222. FIRST USE IN COMMERCE: 19830110  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 73440886  
**Filing Date** August 25, 1983  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** April 23, 1985  
**Registration Number** 1346441  
**Registration Date** July 2, 1985  
**Owner** (REGISTRANT) Pro Form Industries, Inc. CORPORATION OREGON 459 SW. 9th St. Dundee OREGON 97115  
 (LAST LISTED OWNER) **ICON** Health & Fitness, Inc. CORPORATION DELAWARE 1500 SOUTH 1000 WEST LOGAN UTAH 84321  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** Richard K.C. Chang II  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20150819.  
**Renewal** 2ND RENEWAL 20150819

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# EXHIBIT B



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# ProForm

**Word Mark** PRO FORM  
**Goods and Services** IC 025. US 039. G & S: CLOTHING, NAMELY SHORTS, PANTS, SHIRTS, TOPS, SWEAT PANTS AND JACKETS. FIRST USE: 19841126. FIRST USE IN COMMERCE: 19841126  
**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS  
**Design Search Code** 26.17.13 - Letters or words underlined and/or overlined by one or more strokes or lines; Overlined words or letters; Underlined words or letters  
**Serial Number** 73517585  
**Filing Date** January 14, 1985  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** August 27, 1985  
**Change In Registration** CHANGE IN REGISTRATION HAS OCCURRED  
**Registration Number** 1525754  
**Registration Date** February 21, 1989  
**Owner** (REGISTRANT) PRO FORM FITNESS PRODUCTS, INC. CORPORATION UTAH P.O. BOX 10 875 SOUTH MAIN LOGAN UTAH 843210270

(LAST LISTED OWNER) **ICON** HEALTH & FITNESS, INC. CORPORATION BY MERGER WITH DELAWARE 1500 SOUTH 1000 WEST LOGAN UTAH 84321

**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** Richard K.C. Chang II  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20090224.  
**Renewal** 1ST RENEWAL 20090224  
**Live/Dead Indicator** **LIVE**

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## Typed Drawing

**Word Mark** PRO FORM  
**Goods and Services** IC 028. US 022 023 038 050. G & S: exercising apparatus; namely, stepping machines, treadmills, striding machines, [ multigyms ] and stationary cycles. FIRST USE: 19880200. FIRST USE IN COMMERCE: 19880200  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 74239191  
**Filing Date** January 21, 1992  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** June 30, 1992  
**Registration Number** 1718385  
**Registration Date** September 22, 1992  
**Owner** (REGISTRANT) PROFORM FITNESS PRODUCTS, INC. CORPORATION UTAH 1550 South 1000 West Logan UTAH 84321  
(LAST LISTED OWNER) **ICON** HEALTH & FITNESS, INC. CORPORATION By merger with DELAWARE 1500 South 1000 West Logan UTAH 84321  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** Richard K.C. Chang II

**Prior** 1346441

**Registrations**

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130208.

**Renewal** 2ND RENEWAL 20130208

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# PRO·FORM

**Word Mark** PRO FORM

**Goods and Services** IC 025. US 022 039. G & S: [Shoes and] clothing, namely, t-shirts, long sleeve t-shirts, tank tops,[ sweat shirts, hooded sweat shirts,] jackets, [hooded jackets,] shorts, [pants, long pants, capri pants, sport bras,] sport tops, [ socks, ] [hats, caps, and gloves]. FIRST USE: 20030102. FIRST USE IN COMMERCE: 20030102

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code** 26.01.21 - Circles that are totally or partially shaded.  
27.03.01 - Geometric figures forming letters, numerals or punctuation

**Serial Number** 78199571

**Filing Date** January 2, 2003

**Current Basis** 1A

**Original Filing Basis** 1B

**Published for Opposition** August 26, 2003

**Registration Number** 2944885

**Registration Date** April 26, 2005

**Owner** (REGISTRANT) **ICON** IP, INC. CORPORATION DELAWARE 1500 South 1000 West Logan UTAH 84321  
(LAST LISTED OWNER) **ICON** Health & Fitness, INC. CORPORATION DELAWARE 1500 South 1000 West Logan UTAH 84321

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Richard Chang

**Prior Registrations** 1346441;1525754;1718385

**Description of Mark** Color is not claimed as a feature of the mark.

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20150905.

**Renewal** 1ST RENEWAL 20150905

**Live/Dead Indicator** LIVE

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# PRO-FORM

**Word Mark** PRO-FORM

**Goods and Services** IC 028. US 022 023 038 050. G & S: Elliptical exercise machines; Exercise balls; Exercise doorway gym bars; Exercise machines; Exercise weights; Manually-operated exercise equipment; Physical fitness equipment, namely, treadmills, ellipticals, stationary exercise bicycles, stepping machines; Vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance; Wrist and ankle weights for exercise; Yoga mats. FIRST USE: 20040207. FIRST USE IN COMMERCE: 20040207

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 86135165

**Filing Date** December 4, 2013

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** October 21, 2014

**Registration Number** 4665905

**Registration Date** January 6, 2015  
**Owner** (REGISTRANT) **ICON** Health & Fitness, Inc. CORPORATION DELAWARE Legal Department 1500 South 1000 West Logan UTAH 84321  
**Assignment Recorded** ASSIGNMENT RECORDED  
**Attorney of Record** Richard K. C. Chang II  
**Prior Registrations** 1346441;1718385  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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<a href="#">TESS HOME</a>	<a href="#">NEW USER</a>	<a href="#">STRUCTURED</a>	<a href="#">FREE FORM</a>	<a href="#">BROWSE DICT</a>	<a href="#">SEARCH OG</a>	<a href="#">TOP</a>	<a href="#">HELP</a>	<a href="#">PREV LIST</a>	<a href="#">CURR LIST</a>
<a href="#">NEXT LIST</a>	<a href="#">FIRST DOC</a>	<a href="#">PREV DOC</a>	<a href="#">NEXT DOC</a>	<a href="#">LAST DOC</a>					

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# EXHIBIT F

Product Categories

- Dental Packaging
- Disposables & Infection Control
- Laboratory
- Operator
- Oral Health
- Pro-Form & Vacuum Forming
  - Thermal Plastics**
  - Vacuum Formers
  - Vacuum Forming Accessories
- Enamelite
- NiteBite



HOME / PRODUCTS / PRO-FORM & VACUUM FORMING / THERMAL PLASTICS

Pro-Form Mouthguard Tri-Color Laminates

Match your team colors or styles with Pro-Form Mouthguard Tri-Color Laminates, a strong two-layer material made of high-energy absorbing EVA vinyl. The laminate is 0.160" thick in dual-color sheets. Get Tri-Color Mouthguard Laminate in assorted three-color combos to match any team colors or styles.

- |   |   |                |
|---|---|----------------|
| ○ | .160 (4mm) Red/White/Black 5"x 5" (127x127mm) – 12/Pkg (#9598800)       | <b>\$84.95</b> |
| ○ | .160 (4mm) Red/White/Blue 5"x 5" (127x127mm) – 12/Pkg (#9598840)        | <b>\$84.95</b> |
| ○ | .160 (4mm) Red/White/Blue Round 125mm – 12/Pkg (#9598840R1)             | <b>\$84.95</b> |
| ○ | .160 (4mm) Red/White/Blue Round 120mm – 12/Pkg (#9598840R2)             | <b>\$84.95</b> |
| ○ | .160 (4mm) Black/White/Green 5"x 5" (127x127mm) – 12/Pkg (#9598803)     | <b>\$84.95</b> |
| ○ | .160 (4mm) Red/White/Red Canada 5"x 5" (127x127 mm) – 12/Pkg (#9598900) | <b>\$84.95</b> |
| ○ | .160 (4mm) Red/White/Red Round 125mm – 12/Pkg (#9598900R1)              | <b>\$84.95</b> |
| ○ | .160 (4mm) Red/White/Red Round 120mm – 12/Pkg (#9598900R2)              | <b>\$84.95</b> |
| ○ | .160 (4mm) Blue/Yellow/Blue 5"x 5" (127x127mm) – 12/Pkg (#9598920)      | <b>\$84.95</b> |

# EXHIBIT G

< BACK

# ProForm Adjustable Waist Trimmer Belt



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**SALE**  
**\$11.99**

Regular \$12.99

★★★★★ 5 1 Review Write a review  
Be the first to ask a question

Quantity:  
- 1 +

- ADD TO REGISTRY
- ADD TO LIST
- FIND IN STORE

SHIP PICK UP IN STORE  
Available to Ship  
**ADD TO BAG**

## PRODUCT DETAILS

Featuring a breathable, smooth and adjustable this ProForm waist trimmer belt will help you reach your fitness goals.

*Limit 5 per household.*

## PRODUCT FEATURES

- Five different fits for comfortable wear.
- Zip closures for easy on and off.
- Neoprene construction ensures durability.

CUSTOMERS ALSO VIEWED CUSTOMERS ALSO VIEWED



http://www.walmart.com/ip/ProForm-SmartBeat-Flexible-Heart-Rate-Monitor-Strap/21811897

ProForm SmartBeat Flexible...

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All Departments Daily Savings Center My Local Store Pick it up TODAY Tips & Ideas



Sports & Outdoors > Team Sports > Sports Mats & Accessories

# ProForm SmartBeat Flexible Heart Rate Monitor Strap

★★★★☆ 8 reviews Q&A By: ProForm Walmart #: 550923519



**\$38<sup>95</sup>**  
FREE shipping on orders \$50 + FREE pickup

Quantity: 1

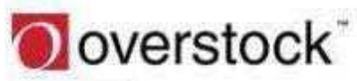
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Sold by Walma

Shipping  
See delivery options

Continuous heart rate reading  
Transmits to smartphones, fitness machines

FREE Shipping over \$50\* & Easy Returns



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### ProForm Heart Rate Monitor Watch with Bonus Step Pro Pedometer

★★★★☆ 3 Reviews

Today: \$28.49

OUT

ITEM# 13910601

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Shop by Department

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My Store: Select Store

**sale** \$5 off \$25 with code SWEET5  
see coupon for details

FREE standard shipping  
on orders over \$75 see deta

Sports & Team Shop > Exercise & Fitness > Strength Training > Weights > Proform 4 Pound Ankle/Wrist Weights

## Proform 4 Pound Ankle/Wrist Weights

Item #161951 Model PFAW414

**Sale \$10.39**

Reg. \$12.99

New



CLICK TO ZOOM

Quantity: 1

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Select a store to see if this item is eligible for free st

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http://www.walmart.com/ip/Proform-Nano-Arm-Band/15188956



ProForm Nano Arm Band - ... X



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Daily Savings Center My Local Store Pick it up TODAY Tips & Ideas



Save on all your tax prep & filing needs

Shop Now

Electronics > Portable Audio > MP3 Accessories > Cases, Skins & Armbands

# ProForm Nano Arm Band

2 reviews Q&A By: ProForm Walmart #: 000983474



\$15.00 Only 6 left!

FREE pickup

Quantity: 1

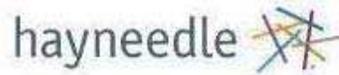
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Sold by Walmart

Shipping

See delivery options

Clear screen protector  
Slim, lightweight design



Find Everything Home



Favorites Account

Furniture Outdoor Decor Baby & Kids Bed & Bath Kitchen & Dining Lighting Pet Supplies Sports & Fitness

Dining Room Event  
Up to 45% off >

Kids Bedroom Event  
Up to 45% off >

Mirrors, Wall Art & More  
Up to 55% off >

Pet Supply  
Save up to 45% +

20 Fitness Gloves  
to choose from

Hayneedle > Sports & Fitness > Fitness Accessories > Fitness Gloves



[Be the first to write a review](#) | [Q&A](#)

**\$9.99**

List Price: \$12.99  
You save 23%

**Free Shipping** on orders over \$50  
[Upgrade to get it as soon as Mar. 8](#)

Earn \$0.30 in [My Reward points](#)

Small/Medium - Size

1

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Registry

## ProForm Weight Lifting Gloves Item # HN-ICON217



- A perfect set of
- Microfiber leat
- Breathable des
- Velcro closure
- Ideal for seriou

Images

Full Descrip

Specificatio

Delivery Op

About This I

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# EXHIBIT 2

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

In the Matter of Application Serial No. 86728087 (PRO-FORM 2)

Filed: August 19, 2015

Published for Opposition: December 8, 2015

ICON HEALTH & FITNESS, INC.,	)	
	)	<u>Opposition No. 91226201</u>
Opposer,	)	
	)	<u>AMENDED</u>
v.	)	<u>NOTICE OF</u>
	)	<u>OPPOSITION</u>
	)	
MYCONE DENTAL SUPPLY CO., INC.,	)	
	)	
Applicant.	)	

ICON Health and Fitness, Inc. (“ICON”), a corporation organized and existing under the laws of Delaware with a place of business at 1500 South 1000 West, Logan, Utah 84321, believes that it will be damaged by the issuance of a registration for the alleged mark shown in Application Serial No. ~~86729827~~86728087 for the mark PRO-FORM 2 in international classes 010 and 028. ICON hereby opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1046(1).

As grounds for opposition, ICON alleges as follows:

1. ICON is one of the world’s largest manufacturers of exercise and fitness equipment and sells exercise and fitness products and services throughout Asia, Europe, and North and South America, including throughout the United States.

2. Since at least as early as 1982, ICON’s predecessor in interest began using the trademark PROFORM in connection with clothing. Since at least as early as 1988, ICON’s predecessor in interest began using the trademark PROFORM in connection with exercise

equipment, including stepping machines, treadmills, striding machines, stationary cycles, rowing machines, and other exercise-related equipment.

3. ICON owns the following five relevant valid and subsisting U.S. Trademark Registrations on the Principal Register in the U.S. Patent and Trademark Office (“PTO”):

Mark	No.	Date Issued	Goods & Services
PRO FORM	1,346,441	7/2/1985	Exercising Apparatus-Namely, Rowing Machines and Multiple Purpose Exercising Machines.
PRO FORM	1,525,754	2/21/1989	Clothing, namely shorts, pants, shirts, tops, sweat pants and jackets.
PRO FORM	1,718,385	9/22/1992	Exercising apparatus; namely, stepping machines, striding machines, and stationary cycles.
PRO FORM	2,944,885	4/26/2005	Clothing, namely, t-shirts, long sleeve t-shirts, tank tops, jackets, shorts, sport tops.
PRO-FORM	4,665,905	1/6/2015	Elliptical exercise machines; Exercise balls; Exercise doorway gym bars; Exercise machines; Exercise weights; Manually-operated exercise equipment; Physical fitness equipment, namely, treadmills, ellipticals, stationary exercise bicycles, stepping machines; Vibrating apparatus used in fitness and exercise programs to stimulate muscles and increase strength and physical performance; Wrist and ankle weights for exercise; Yoga mats.

Collectively these five marks shall be referred to herein as the “PRO-FORM Marks” and the associated registrations shall be referred to herein as the “PRO-FORM Registrations.”

4. ICON and its predecessors in interest have first used the mark protected by U.S. Trademark Registration No. 1,346,441 in the United States at least as early as December 22, 1982 and first used the mark in interstate commerce in the United States ~~continuously since~~ at least December 22, 1982, as early as January 10, 1983 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of exercising equipment, namely, rowing machines and multiple purpose exercise machines. Attached as Exhibit A is a true and correct printout of the PTO’s information about U.S. Trademark Registration No. 1,346,441, which was issued by the PTO on July 2, 1985. ICON and its predecessors in interest have used the mark continually in interstate commerce in the United States since that time.

5. ICON and its predecessors in interest have used the mark protected by U.S. Trademark Registration No. 1,525,754 in interstate commerce in the United States continuously since at least November 26, 1984 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of clothing. Attached as Exhibit B is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 1,525,754, which was issued by the PTO on February 21, 1989.

6. ICON and its predecessors in interest have used the mark protected by U.S. Trademark Registration No. 1,718,385 in interstate commerce in the United States continuously since at least February, 1988 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of exercising apparatus. Attached as Exhibit C is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 1,718,385, which was issued by the PTO on September 22, 1992.

7. ICON has used the mark protected by U.S. Trademark Registration No. 2,944,885 in interstate commerce in the United States continuously since at least January 2, 2003 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of clothing. Attached as Exhibit D is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 2,944,885, which was issued by the PTO on April 26, 2005.

8. ICON has used the mark protected by U.S. Trademark Registration No. 4,665,905 in interstate commerce in the United States continuously since at least February 7, 2004 in connection with the provision, sale, marketing, advertising, and promotion of exercise equipment, machines, balls, bars, apparatus, weights, and mats. Attached as Exhibit E is a true and correct printout of the PTO's information about U.S. Trademark Registration No. 4,665,905, which was issued by the PTO on January 6, 2015.

9. As a result of its widespread, continuous, and exclusive use of the PRO-FORM Marks to identify its goods and services with ICON as their source, ICON owns valid and subsisting federal statutory and common law rights to the PRO-FORM Marks.

10. The PRO-FORM Marks are distinctive to both the consuming public and within the exercise and fitness industry.

11. ICON has expended substantial time, money, and resources in marketing, advertising, and promoting the goods and services offered under the PRO-FORM Marks, including, among other things, television, radio, newspaper, magazine, internet, social media, and other media.

12. ICON's promotional efforts have led to ICON's patrons, potential patrons, and the general public coming to know and recognize the PRO-FORM Marks and associate them with ICON and its goods and services. ICON has therefore built up extensive, valuable goodwill in the PRO-FORM Marks. As a result of their distinctiveness and widespread use and promotion throughout the United States, the PRO-FORM Marks are famous trademarks within the meaning of 15 U.S.C. 1125(c).

13. Applicant Mycone Dental Supply Co., Inc. ("Mycone"), with an address at 480 South Democrat Road, Gibbstown, New Jersey, 08027, on August 19, 2015 filed trademark Application Serial No. 86728087 to register the proposed mark PRO-FORM 2 for the following goods and services:

International Class 001	Plastic molding compounds for use in the manufacture of molded plastic articles.
International Class 010	Dental instruments for use in protection of mouth and teeth.
International Class 028	Athletic equipment, namely, mouth guards; Mouth guards for athletic use

14. The PRO-FORM Registrations have priority over Applicant's application because Petitioner's first-use and registration dates for the PRO-FORM Marks predate the filing date of

Applicant's application and any other date on which Mycone may rely for purposes of priority for use of its mark in international classes 010 and 028.

15. Applicant's mark PRO-FORM 2 is confusingly similar to the PRO-FORM Marks, as it wholly incorporates the text of all four of the ~~term~~ PRO-FORM ~~and is~~ MARKS, distinguished only by the Applicant's addition of the character "2-"" at the end of the mark. As a result, Applicant's mark is strikingly similar to the PRO-FORM Marks in appearance, sound, and connotation, and creates a similar commercial impression.

16. The likelihood of confusion is heightened because the goods covered by Applicant's Application Serial No. 86728087 are sports and fitness-related products, including without limitation mouth guards and athletic mouth guards, while the goods and services promoted by ICON under the PRO-FORM Marks include ~~fitness equipment, exercise clothing, and exercise-related accessories such as wearable weights,~~ in addition to the items previously listed above, ~~wearable fitness-related accessories, such as wrist and ankle weights, heart-rate monitor watches and chest straps, and waist wraps, as well as protective gear for use in athletic activities, such as training gloves and weightlifting belts.~~

17. Also, on information and belief, Applicant's PRO-FORM 2 branded goods will be sold in some of the same channels of trade that ICON sells its PRO-FORM goods. For example, Applicant's PRO-FORM athletic mouth guards are sold online. See Exhibit F attached hereto, which is a printout from a website offering Applicant's PRO-FORM branded goods for sale. ICON also markets and sells its PRO-FORM branded goods directly to consumers through major online retailers such as [www.walmart.com](http://www.walmart.com), [www.shopko.com](http://www.shopko.com), [www.overstock.com](http://www.overstock.com), and [www.khols.com](http://www.khols.com). See Exhibit G, which are sample printouts showing various PRO-FORM branded goods being sold on such websites.

**FIRST GROUND FOR OPPOSITION – LIKELIHOOD OF  
CONFUSION**

18. The proposed mark is barred from registration in international classes 010 and 028 because it consists of or compromises a mark which so resembles ICON’s previously used and registered PRO-FORM Marks as to be likely, when used in connection with the alleged goods of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

**SECOND GROUND FOR OPPOSITION - DILUTION**

19. Petitioner’s PRO-FORM Marks are distinctive and a “famous mark” within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

20. The PRO-FORM Marks became distinctive and famous prior to the filing date of Applicant’s application or any other date on which the Respondent may rely for purposes priority.

21. Applicant’s Application Serial No. 86728087 impairs the distinctiveness and causes dilution by blurring of, and thereby damages, Petitioner’s famous PRO-FORM Marks in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, the proposed PRO-FORM 2 mark is not entitled to registration.

22. Furthermore, if and to the extent that Mycone sells substandard products using the PRO-FORM 2 mark, Applicant’s Application Serial No. 86728087 will also likely harm the reputation and cause dilution by tarnishment of, and thereby damage, Petitioner’s PRO-FORM Marks in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, the proposed PRO-FORM 2 mark is not entitled to registration.

WHEREFORE, Petitioner respectfully prays that its opposition be sustained and that registration to the pursuant to Applicant’s Application Serial No. 86728087 be refused in international classes 10 and 28.

**CERTIFICATE OF SERVICE**

I hereby certify that on February 27, 2016, I caused a true and correct copy of the foregoing Motion for Leave to File Amended Notice of Opposition to be served by United States First Class Mail, postage prepaid, upon the following attorney of record for applicant:

Lisa A. Lori  
KLEHR HARRISON HARVEY BRANZBURG LLP  
1835 Market Street, Suite 1400  
Philadelphia, PA 19103

/Gregory M. Hess/