

ESTTA Tracking number: **ESTTA579971**

Filing date: **01/03/2014**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

|         |   |             |       |
|---------|---|-------------|-------|
| Name    | Dynamax, Inc.   |             |       |
| Entity  | Corporation   | Citizenship | Texas |
| Address | 1300 Smith Road, Suite 104<br>Austin, TX 78721<br>UNITED STATES |             |       |

|                      |   |
|----------------------|---|
| Attorney information | Heather A. Dunn, Esq.<br>DLA Piper LLP (US)<br>555 Mission Street, Suite 2400<br>San Francisco, CA 94105<br>UNITED STATES<br>heather.dunn@dlapiper.com, carolanne.bashir@dlapiper.com,<br>shannon.mo@dlapiper.com, tmfilings@dlapiper.com |
|----------------------|---|

**Registration Subject to Cancellation**

|                 |  |                   |            |
|-----------------|--|-------------------|------------|
| Registration No | 3559114  | Registration date | 01/06/2009 |
| Registrant      | Dynaflex International, Inc.<br>1144 Grove Street<br>Anaheim, CA 92806<br>CANADA |                   |            |

**Goods/Services Subject to Cancellation**

|  |
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| <p>Class 028. First Use: 2007/07/18 First Use In Commerce: 2007/07/18<br/>All goods and services in the class are cancelled, namely: [ Exercise benches; Exercise doorway gym bars; Exercise equipment for lateral movement in a skating motion; Exercise equipment, namely, manually operated jogging machines; Exercise equipment, namely, rowing machines; Exercise equipment, namely, shoulder stretcher using a cable; Exercise equipment, namely, shoulder stretcher using resistance cables; Exercise equipment, namely, abdominal boards; Exercise equipment, namely, chest expanders; Exercise equipment, namely, chest pulls; Exercise equipment, namely, rotary abdominal boards; Exercise equipment, namely, stair-stepping machines; Exercise equipment, namely, stationary cycles; Exercise machines; Exercise machines incorporating electronic and video game controllers, Exercise platforms; Exercise weight cuffs; Exercise weights; Exercise wrist weights; Exercising equipment, namely, manually operated jogging machines; Exercising equipment, namely, powered treadmills for running; Exercising equipment, namely, pulleys; Exercising equipment, namely, rowing machines; Exercising equipment, namely, weight lifting machines; Exercising pulleys; Infant exercise seats, namely, jumpers and infant saucers; Leg weights for exercising; Manual leg exercisers; ] Manually-operated exercise equipment [ ; Personal exercise mats; Portable support structures for dance and other exercises; Spring bar tension sets for use in exercising; Spring bars for exercising; Stationary exercise bicycles; Stationary exercise bicycles and rollers therefor; Stress relief balls for hand exercise; Wrist and ankle weights for exercise ]</p> |
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**Grounds for Cancellation**

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

## Marks Cited by Petitioner as Basis for Cancellation

|                      |          |                       |      |
|----------------------|----------|-----------------------|------|
| U.S. Application No. | 86156412 | Application Date      |      |
| Registration Date    | NONE     | Foreign Priority Date | NONE |
| Word Mark            | NONE     |                       |      |
| Design Mark          |          |                       |      |
| Description of Mark  | NONE     |                       |      |
| Goods/Services       |          |                       |      |

|                      |          |                       |      |
|----------------------|----------|-----------------------|------|
| U.S. Application No. | 86156371 | Application Date      |      |
| Registration Date    | NONE     | Foreign Priority Date | NONE |
| Word Mark            | NONE     |                       |      |
| Design Mark          |          |                       |      |
| Description of Mark  | NONE     |                       |      |
| Goods/Services       |          |                       |      |

|                      |          |                       |      |
|----------------------|----------|-----------------------|------|
| U.S. Application No. | 86156383 | Application Date      |      |
| Registration Date    | NONE     | Foreign Priority Date | NONE |
| Word Mark            | NONE     |                       |      |
| Design Mark          |          |                       |      |
| Description of Mark  | NONE     |                       |      |
| Goods/Services       |          |                       |      |

|                                   |  |                  |      |
|-----------------------------------|--|------------------|------|
| U.S. Application/Registration No. | NONE   | Application Date | NONE |
| Registration Date                 | NONE   |                  |      |
| Word Mark                         | DYNAMAX (Application Serial No. 86156412), filed on or about January 2, 2014   |                  |      |
| Goods/Services                    | Providing workshops and training sessions regarding coaching, exercise, physical training, and use of exercise balls |                  |      |

|                                   |  |                  |      |
|-----------------------------------|--|------------------|------|
| U.S. Application/Registration No. | NONE   | Application Date | NONE |
| Registration Date                 | NONE   |                  |      |
| Word Mark                         | DYNAMAX (Application Serial No. 86156371), filed on or about January 2, 2014   |                  |      |
| Goods/Services                    | Downloadable information and instructions, courses, and videos regarding coaching, exercise, and physical training, and use of exercise balls; DVDs featuring information and instructions, courses, and videos regarding coaching, exercise, and physical training, and |                  |      |

|                                       |   |                  |      |
|---------------------------------------|---|------------------|------|
|                                       | use of exercise balls   |                  |      |
| U.S. Application/<br>Registration No. | NONE  | Application Date | NONE |
| Registration Date                     | NONE  |                  |      |
| Word Mark                             | DYNAMAX (Application Serial No. 86156383), filed on or about<br>January 2, 2014 |                  |      |
| Goods/Services                        | Balls, exercise balls   |                  |      |

|             |                                    |
|-------------|------------------------------------|
| Attachments | DYNAMAX 3559114.pdf(171608 bytes ) |
|-------------|------------------------------------|

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

|           |  |
|-----------|--|
| Signature | /Heather Dunn/                           |
| Name      | Heather A. Dunn, Esq.-DLA Piper LLP (US) |
| Date      | 01/03/2014                               |

Petition to Cancel Registration No. 3559114 – DYNAMAX  
 Registered on the Principal Register on January 6, 2009

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

|   |   |                  |
|---|---|------------------|
| Dynamax, Inc., a Texas Corporation                      | ) |                  |
|   | ) |                  |
| Petitioner,   | ) | Cancellation No. |
| v.  | ) |                  |
|   | ) |                  |
| Dynaflex International, Inc., a California Corporation, | ) |                  |
|   | ) |                  |
| Respondent.   | ) |                  |
|   | ) |                  |
|   | ) |                  |
|   | ) |                  |

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PETITION TO CANCEL

Dynamax, Inc. ("Petitioner"), a Texas corporation, having its principal business address at 1300 Smith Road, Suite 104, Austin, Texas 78721, believes that it will be damaged by the continued presence on the Principal Register of Registration No. 3559114 for the mark DYNAMAX for "Manually-operated exercise equipment" (the "Dynaflex Goods") in Class 28 (the "Dynaflex Registration"). Petitioner hereby petitions to cancel the Dynaflex Registration.

Petitioner's grounds for this Petition are as follows:

1. Petitioner applied to register the mark DYNAMAX for "[b]alls, exercise balls" in Class 28 in the United States Patent and Trademark Office ("USPTO") on or about January 2, 2014, based on its use of the mark for such goods since at least as early as December 31, 1985, and to which U.S. Application Serial No. 86156383 was assigned.

2. Petitioner applied to register the mark DYNAMAX for "[p]roviding workshops and training sessions regarding coaching, exercise, physical training, and use of exercise balls" in Class 41 in the USPTO on or about January 2, 2014, based on its use of the mark for such

goods since at least as early as December 31, 1992, and to which U.S. Application Serial No. 86156412 was assigned.

3. Petitioner applied to register the mark DYNAMAX for “[d]ownloadable information and instructions, courses, and videos regarding coaching, exercise, and physical training, and use of exercise balls; DVDs featuring information and instructions, courses, and videos regarding coaching, exercise, and physical training, and use of exercise balls” in Class 9 in the USPTO on or about January 2, 2014, based on its use of the mark DYNAMAX for these goods since at least as early as December 31, 2007, and to which U.S. Application Serial No. 86156371 was assigned.

4. Petitioner has been using the mark DYNAMAX in connection with the sale and distribution of its products and services in the United States continuously since at least as early as December of 1985, and has been using the trade name Dynamax and/or Dynamax, Inc. since, upon information and belief, as early as December of 1985, and owns valid common law rights to DYNAMAX for all of the goods and services listed in Paragraphs 1, 2, and 3 above.

5. The DYNAMAX mark and trade name are among the most valuable assets of Petitioner and principal symbols of its extensive goodwill. By reason of widespread use of the mark and trade name, the trade and purchasing public have come to recognize DYNAMAX as signifying Petitioner and as identifying Petitioner as the source of its goods and services provided under the DYNAMAX mark.

6. Upon information and belief, respondent Dynaflex International, Inc. ("Respondent") is the record owner of Registration No. 3559114 for the mark DYNAMAX.

7. Upon information and belief, and to the best of Petitioner's information, Respondent's last known address is 1144 Grove Street, Anaheim, CA 92806.

8. According to the USPTO records, on or about June 16, 2006, Respondent applied to register DYNAMAX based on an intent to use the mark for " Exercise benches; Exercise doorway gym bars; Exercise equipment for lateral movement in a skating motion; Exercise equipment, namely, manually operated jogging machines; Exercise equipment,

namely, rowing machines; Exercise equipment, namely, shoulder stretcher using a cable; Exercise equipment, namely, shoulder stretcher using resistance cables; Exercise equipment, namely, abdominal boards; Exercise equipment, namely, chest expanders; Exercise equipment, namely, chest pulls; Exercise equipment, namely, rotary abdominal boards; Exercise equipment, namely, stair-stepping machines; Exercise equipment, namely, stationary cycles; Exercise machines; Exercise machines incorporating electronic and video game controllers, Exercise platforms; Exercise weight cuffs; Exercise weights; Exercise wrist weights; Exercising equipment, namely, manually operated jogging machines; Exercising equipment, namely, powered treadmills for running; Exercising equipment, namely, pulleys; Exercising equipment, namely, rowing machines; Exercising equipment, namely, weight lifting machines; Exercising pulleys; Infant exercise seats, namely, jumpers and infant saucers; Leg weights for exercising; Manual leg exercisers; Manually-operated exercise equipment ; Personal exercise mats; Portable support structures for dance and other exercises; Spring bar tension sets for use in exercising; Spring bars for exercising; Stationary exercise bicycles; Stationary exercise bicycles and rollers therefor; Stress relief balls for hand exercise; Wrist and ankle weights for exercise" (the "Original Goods").

9. According to the USPTO records, on or about July 18, 2007 Respondent filed an Amendment to Allege Use of the mark claiming use of the mark anywhere and in interstate commerce since July 18, 2007.

10. According to the USPTO records, on or about January 6, 2009, the USPTO granted Registration No. 3559114 for the mark DYNAMAX to Respondent.

11. According to the USPTO records, on or about June 08, 2009 Respondent filed a Section 7 Amendment requesting an amendment of the Original Goods to delete all but "Manually-operated exercise equipment" from the goods description, which the USPTO granted.

12. Upon information and belief, Respondent did not file its intent-to-use application to register DYNAMAX before June 16, 2006, and did not begin using DYNAMAX in connection

with the Dynaflex Goods prior to July 18, 2007.

13. Petitioner has been using its DYNAMAX trademark on and in connection with exercise equipment in the nature of exercise balls since at least as early as December 31, 1985, which is over twenty years before Respondent filed to register DYNAMAX and over twenty years before Respondent claims to have first used DYNAMAX.

14. Petitioner has extensively advertised and sold its goods in the United States for at least twenty-eight years, including its exercise balls, under the DYNAMAX mark, and has created widespread goodwill under its DYNAMAX trademark throughout the United States.

15. Upon information and belief, Petitioner has used the trade name Dynamax and/or Dynamax, Inc. (the "Dynamax Trade Name") continuously since at least as early as 1985 to identify its goods and services, which is over twenty years before Respondent filed to register DYNAMAX and over twenty years before Respondent claims to have first used DYNAMAX.

16. Petitioner's DYNAMAX mark is inherently distinctive with respect to its fitness equipment, specifically, exercise balls, and related goods and services and, therefore, was protectable as a mark from the first day Dynamax used the DYNAMAX mark for exercise balls, namely, at least since December 31, 1985.

17. Petitioner's rights to the DYNAMAX mark and the Dynamax Trade Name predate and are superior to any rights Respondent may have in its alleged mark DYNAMAX and the Dynaflex Registration.

18. Petitioner's mark DYNAMAX and the mark in Respondent's Registration No. 3559114 are identical.

19. The Dynaflex Goods and the goods sold by Petitioner and/or identified in Petitioner's U.S. Application Serial Nos. 86156371, 86156383, and 86156412 ("Petitioner's DYNAMAX Applications"), and to which Petitioner owns valid common law rights, are identical, overlap, and/or are closely related, and are of the type that could be offered in the same channels of trade and to the same prospective customers.

20. Respondent's Registration No. 3559114 is in violation and derogation of

Petitioner's common law rights and is likely to cause confusion, mistake, and deception among purchasers and users as to the source or origin of the goods and services, or their affiliation with or sponsorship by Petitioner, thereby causing loss, damage, injury, and irreparable harm to Petitioner.

21. If Respondent's Registration No. 3559114 remains registered on the Principal Register, Respondent would thereby have a prima facie exclusive right, and could gain an incontestable right, to the alleged DYNAMAX mark. Such continued registration is and would be a source of damage and injury to Petitioner.

22. If Respondent's Registration No. 3559114 remains registered on the Principal Register, it may block the registration of Petitioner's DYNAMAX Applications. Such continued registration is and would be a source of damage and injury to Petitioner.

23. Given that Respondent's use and registration of DYNAMAX is likely to cause confusion with Petitioner's valid earlier common law DYNAMAX mark and Dynamax Trade Name, Registration No. 3559114 is subject to cancellation under 15 U.S.C. § 1064.

24. By virtue of the foregoing, Petitioner is now and will be damaged by the continued presence on the Register of Registration No. 3559114 for the mark DYNAMAX in Class 28 for the Dynaflex Goods.

WHEREFORE, the Petitioner prays that Registration No. 3559114 be cancelled and that this Petition for Cancellation be sustained in favor of the Petitioner.

Please recognize as attorneys for petitioner Heather A. Dunn, Esq., member of the Bar of the State of California, and the law firm of DLA Piper LLP (US), 555 Mission Street, Suite 2400, San Francisco, CA 94105. All communications regarding this petition should be addressed to Heather A. Dunn at the foregoing address.

Please charge the filing fees of this Petition to Cancel to our Deposit Acct. No. 07-1907.

Please charge any additional fees, or credit any overpayment, to Deposit Acct. No. 07-1907.

DLA PIPER US LLP

A handwritten signature in black ink, appearing to read 'H. Dunn', is written over a horizontal line. The signature is stylized with large loops and a long horizontal stroke.

BY:

Dated: January 3, 2014

Heather A. Dunn, Esq.  
DLA Piper LLP (US)  
555 Mission Street, Suite 2400  
San Francisco, CA 94105  
Telephone: (415) 836-2557

Attorneys for Petitioner  
Dynamax, Inc.

CERTIFICATE OF SERVICE BY MAIL

I hereby certify that a true and correct copy of the foregoing PETITION TO CANCEL is being served by First Class mail, postage prepaid, this 3rd day of January 2014, on Respondent:

Dynaflex International, Inc.  
1144 Grove Street  
Anaheim, CA 92806

With a courtesy copy to:

Clement Cheng  
Newhope Law, Pc  
17220 Newhope Street, Suite 127  
Fountain Valley, CA 92708-4283

Executed this 3rd day of January 2014,

at San Francisco, California.

  
Paul Stickel