

ESTTA Tracking number: **ESTTA698737**

Filing date: **09/28/2015**

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	ICON Health & Fitness, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1500 South 1000 West Logan, UT 84321 UNITED STATES		

Attorney information	Gregory M. Hess Parr Brown Gee & Loveless, P.C. 101 S. 200 E., Suite 700 Salt Lake City, UT 84111 UNITED STATES ghess@parrbrown.com, lshaw@parrbrown.com, calendar@parrbrown.com Phone:8015327840		
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Registration Subject to Cancellation

Registration No	4411096	Registration date	10/01/2013
Registrant	Mihm, Steve 18227 Justice Way Lakeville, MN 55044 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2012/10/24 First Use In Commerce: 2013/01/10 All goods and services in the class are cancelled, namely: Bracket featuring an adaptor for cell phones that holds it securely while usingspeaker systems, clock docking stations, and chargers

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2618509	Application Date	02/11/1999
Registration Date	09/10/2002	Foreign Priority Date	NONE
Word Mark	IFIT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 fitness and exercise machines Class 041. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 educational services, namely, conducting personal training in the field of health and fitness

U.S. Registration No.	2466474	Application Date	07/21/1999
Registration Date	07/03/2001	Foreign Priority Date	NONE
Word Mark	IFIT.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1999/02/00 First Use In Commerce: 1999/02/00 providing information and consultation services in the field of exercise equipment and personal health, fitness and nutrition by means of a global computer network		

U.S. Registration No.	4450213	Application Date	12/27/2012
Registration Date	12/17/2013	Foreign Priority Date	NONE
Word Mark	IFIT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2012/10/01 First Use In Commerce: 2012/10/01 Personal fitness training services and consultancy; Physical fitness instruction;		

	Physical fitness training services; Providing an on-line computer database featuring information regarding exercise and fitness; Providing information in the field of exercise training
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U.S. Registration No.	4500591	Application Date	02/21/2013
Registration Date	03/25/2014	Foreign Priority Date	NONE
Word Mark	IFIT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 2012/06/04 First Use In Commerce: 2012/06/04</p> <p>An application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities; ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities</p>		

U.S. Registration No.	4604633	Application Date	12/18/2013
Registration Date	09/16/2014	Foreign Priority Date	NONE
Word Mark	IFIT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2010/06/06 First Use In Commerce: 2010/06/06</p> <p>Web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities</p>		

Attachments	75638662#TMSN.png(bytes) 85811286#TMSN.png(bytes) 85856673#TMSN.png(bytes) 86147433#TMSN.png(bytes) Petition for Cancellation ifit 5 SN 4411096.pdf(186092 bytes)
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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	/Gregory M. Hess/
Name	Gregory M. Hess
Date	09/28/2015

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

In the Matter of Registration No. 4,411,096 (ifit 5)
Registered: October 1, 2013

ICON HEALTH & FITNESS, INC.,)	
)	
Petitioner,)	Cancellation No. _____
)	
v.)	<u>PETITION FOR</u>
)	<u>CANCELLATION</u>
)	
STEVE MIHM,)	
)	
Respondent.)	

ICON Health and Fitness, Inc. (“ICON”) believes it has been and will continue to be damaged by U.S. Trademark Registration No. 4,411,096 for the mark ifit 5, and hereby petitions for cancellation of same pursuant to Section 14(1) of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1046(1). As grounds for cancellation, ICON alleges as follows:

1. ICON is a corporation organized and existing under the laws of Delaware with a principal place of business at 1500 South 1000 West, Logan, Utah 84321
2. ICON is the world’s largest manufacturer of exercise equipment and sells fitness products and services throughout Asia, Europe, and North and South America, including throughout the United States.
3. ICON is the owner of the following five 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
IFIT	2,618,509	9/10/2002	Fitness and exercise machines Educational services, namely, conducting personal training in the field of health and fitness

IFIT.COM	2,466,474	4/3/2001	Providing information and consultation services in the field of exercise equipment and personal health, fitness and nutrition by means of a global computer network.
iFIT	4,450,213	12/17/2013	Personal fitness training services and consultancy; Physical fitness instruction; Physical fitness training services; Providing an on-line computer database featuring information regarding exercise and fitness; Providing information in the field of exercise training.
IFIT	4,500,591	3/25/2014	An application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities; ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities.
IFIT	4,604,633	9/16/2014	Web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities.

Collectively these five marks shall be referred to herein as the “IFIT Marks.”

4. ICON has used the mark protected by U.S. Trademark Registration No. 2618509 in interstate commerce in the United States continuously since at least February 1999 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of fitness and exercise machines. Attached as Exhibit A is a true and correct copy of U.S. Trademark Registration No. 2466474, which was issued by the PTO on September 10, 2002. U.S. Trademark Registration No. 2466474 has become incontestable under 15 U.S.C. § 1065.

5. ICON has used the mark protected by U.S. Trademark Registration No. 2466474 in interstate commerce in the United States continuously since at least February 1999 in connection with the provision, sale, marketing, advertising, and promotion of information and consultation services in the field of exercise equipment and personal health, fitness and nutrition by means of a global computer network. Attached as Exhibit B is a true and correct copy of U.S.

Trademark Registration No. 2466474, which was issued by the PTO on July 3, 2001. U.S. Trademark Registration No. 2466474 has become incontestable 15 U.S.C. § 1065.

6. ICON has used the mark protected by U.S. Trademark Registration No. 4450213 in interstate commerce in the United States continuously since at least October 1, 2010 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of personal fitness training services and consultancy, physical fitness instruction, physical fitness training services, an on-line computer database featuring information regarding exercise and fitness, and information in the field of exercise training. Attached as Exhibit C is a true and correct copy of U.S. Trademark Registration No. 4450213, which was issued by the PTO on December 17, 2013.

7. ICON has used the mark protected by U.S. Trademark Registration No. 4500591 in interstate commerce in the United States continuously since at least June 4, 2012 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and promotion of an application service provider (ASP) featuring software for use with mobile devices, tablet, and computers for tracking, storing, and displaying personal performance data for various fitness activities and ASP featuring application programming interface (API) software for connecting and interacting with software applications on mobile devices, tablets, and computers to track, store, and display personal performance data for various fitness activities. Attached as Exhibit D is a true and correct copy of U.S. Trademark Registration No. 4500591, which was issued by the PTO on March 25, 2014.

8. ICON has used the mark protected by U.S. Trademark Registration No. 4604633 in interstate commerce in the United States continuously since at least June 6, 2010 in connection with the manufacture, distribution, provision, offering for sale, sale, marketing, advertising, and

promotion of web-based, downloadable software for the collection, storage and display of personal performance data from various fitness activities, display of nutritional information and fitness and athletic programs and workouts, software for tracking, monitoring and planning fitness training activities. Attached as Exhibit E is a true and correct copy of U.S. Trademark Registration No. 4604633, which was issued by the PTO on September 16, 2014.

9. As a result of its widespread, continuous, and exclusive use of Petitioner's IFIT Marks to identify its goods and services with ICON as their source, ICON owns valid and subsisting federal statutory and common law rights to Petitioner's IFIT Marks.

10. Petitioner's IFIT 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 Petitioner's IFIT Marks, including, among other things, television, newspaper, and the Internet, including social media.

12. ICON's promotional efforts have led to ICON's patrons, potential patrons, and the general public coming to know and recognize Petitioner's IFIT Marks and associate them with ICON and its goods and services. ICON has therefore built up extensive, valuable goodwill in Petitioner's IFIT Marks.

13. As a result of their distinctiveness and widespread use and promotion throughout the United States, Petitioner's IFIT Marks are famous trademarks within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. 1125(c), and two of them became famous prior to the filing of the Application at issue herein and prior to Respondent's claimed priority date.

14. Upon information and belief, Respondent, Steve Mihm, with an address at 18227 Justice Way, Lakesville Minnesota, is the current listed owner of Registration No. 4411096 for

the mark ifit 5 in connection with cell phone brackets, docking systems, and chargers in International Class 009. That trademark registration, based on an application filed on February 28, 2013, was issued on October 1, 2013 and bears a first-use date of October 24, 2012.

15. Two of Petitioner's IFIT Marks have priority over Respondent's mark because Petitioner's first-use and registration dates for those IFIT Marks predate the filing date of the Application and Respondent's claimed priority date. In addition, the goods and services listed in Petitioner's three other IFIT Marks are within the zone of natural expansion of the two earlier IFIT Marks, and Petitioner therefore has priority over Respondent with respect to all of the IFIT Marks.

16. Respondent's mark ifit 5 is confusingly similar to the IFIT Marks, as all six marks consist primarily of the four-letter word "ifit", which word does not have independent meaning in the English language. As a result, Respondent's Mark is strikingly similar to the IFIT Marks in appearance, sound, and connotation, and creates a similar commercial impression.

17. The likelihood of confusion is heightened because the goods covered by Respondent's Trademark Registration No. 441096 are brackets, docking stations, and chargers designed for cell phones, while the goods and services promoted by Petitioner under the IFIT Marks include online services and software that may be accessed through a cell phone, as well as applications designed specifically for use on cell phones and tablet computers.

18. In addition, the Respondent's goods appear to be designed to promote cell phone user mobility, which is often associated with exercise and fitness activities.

FIRST GROUND FOR CANCELLATION – LIKELIHOOD OF CONFUSION

19. Respondent's registration should be cancelled because it consists of or comprises a mark which so resembles Petitioner's previously used and registered IFIT Marks as to be

likely, when used in connection with the Respondent's goods, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d), and to cause damage to Petitioner thereby.

SECOND GROUND FOR CANCELLATION - DILUTION

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

21. The IFIT Marks became distinctive and famous prior to the filing date of Respondent's application for Registration No. 441096 or any other date on which the Respondent may rely for purposes priority.

22. Respondent's Registration No. 441096 impairs the distinctiveness and causes dilution by blurring of, and thereby damages, Petitioner's famous IFIT Marks in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, Respondent's Registration No. 441096 should be cancelled.

23. Furthermore, if and to the extent that Respondent sells substandard products using the ifit5 mark, Respondent's Registration No. 441096 will also likely harm the reputation and cause dilution by tarnishment of, and thereby damage, Petitioner's IFIT Marks in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, Respondent's Registration No. 441096 should be cancelled.

WHEREFORE, Petitioner respectfully prays that its cancellation be sustained and that U.S. Trademark Registration No. 441096 be cancelled.

Dated: September 28, 2015

Respectfully submitted,
PARR BROWN GEE & LOVELESS

/s/ Gregory M. Hess

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EXHIBIT A

United States of America
United States Patent and Trademark Office

IFIT

Reg. No. 2,618,509 ICON HEALTH & FITNESS, INC. (DELAWARE CORPORATION)
1500 SOUTH 1000 WEST
Registered Sep. 10, 2002 LOGAN, UT 84321
Amended Aug. 18, 2015 FOR: FITNESS AND EXERCISE MACHINES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).
Int. Cls.: 28 and 41 FIRST USE 2-0-1999; IN COMMERCE 2-0-1999.

TRADEMARK FOR: EDUCATIONAL SERVICES, NAMELY, CONDUCTING PERSONAL TRAINING IN THE FIELD OF HEALTH AND FITNESS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).
SERVICE MARK FIRST USE 2-0-1999; IN COMMERCE 2-0-1999.

PRINCIPAL REGISTER THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 75-638,662, FILED 2-11-1999.



Michelle K. Lee

Director of the United States
Patent and Trademark Office

EXHIBIT B

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,466,474

Registered July 3, 2001

**SERVICE MARK
PRINCIPAL REGISTER**

IFIT.COM

**ICON HEALTH & FITNESS, INC. (DELAWARE
CORPORATION)
1500 SOUTH 1000 WEST
LOGAN, UT 84321**

**FOR: PROVIDING INFORMATION AND CON-
SULTATION SERVICES IN THE FIELD OF EXER-
CISE EQUIPMENT AND PERSONAL HEALTH,
FITNESS AND NUTRITION BY MEANS OF A**

**GLOBAL COMPUTER NETWORK , IN CLASS 42
(U.S. CLS. 100 AND 101).**

FIRST USE 2-0-1999; IN COMMERCE 2-0-1999.

SN 75-757,235, FILED 7-21-1999.

**CIMMERIAN COLEMAN, EXAMINING ATTOR-
NEY**

EXHIBIT C

United States of America

United States Patent and Trademark Office

iFIT

Reg. No. 4,450,213

ICON HEALTH & FITNESS, INC. (DELAWARE CORPORATION)

Registered Dec. 17, 2013

1500 SOUTH 1000 WEST

LOGAN, UT 84321

Int. Cl.: 41

FOR: PERSONAL FITNESS TRAINING SERVICES AND CONSULTANCY; PHYSICAL FITNESS INSTRUCTION; PHYSICAL FITNESS TRAINING SERVICES; PROVIDING AN ON-LINE COMPUTER DATABASE FEATURING INFORMATION REGARDING EXERCISE AND FITNESS; PROVIDING INFORMATION IN THE FIELD OF EXERCISE TRAINING, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

SERVICE MARK

PRINCIPAL REGISTER

FIRST USE 10-1-2012; IN COMMERCE 10-1-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,466,474 AND 2,618,509.

SER. NO. 85-811,286, FILED 12-27-2012.

TRACY FLETCHER, EXAMINING ATTORNEY



Deborah S. Cohn

Commissioner for Trademarks of the
United States Patent and Trademark Office

EXHIBIT D

United States of America

United States Patent and Trademark Office

IFIT

Reg. No. 4,500,591

Registered Mar. 25, 2014

Int. Cl.: 42

SERVICE MARK

PRINCIPAL REGISTER

ICON HEALTH & FITNESS, INC. (DELAWARE CORPORATION)
LEGAL DEPT.
1500 SOUTH 1000 WEST
LOGAN, UT 84321

FOR: AN APPLICATION SERVICE PROVIDER (ASP) FEATURING SOFTWARE FOR USE WITH MOBILE DEVICES, TABLET, AND COMPUTERS FOR TRACKING, STORING, AND DISPLAYING PERSONAL PERFORMANCE DATA FOR VARIOUS FITNESS ACTIVITIES; ASP FEATURING APPLICATION PROGRAMMING INTERFACE (API) SOFTWARE FOR CONNECTING AND INTERACTING WITH SOFTWARE APPLICATIONS ON MOBILE DEVICES, TABLETS, AND COMPUTERS TO TRACK, STORE, AND DISPLAY PERSONAL PERFORMANCE DATA FOR VARIOUS FITNESS ACTIVITIES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 6-4-2012; IN COMMERCE 6-4-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-856,673, FILED 2-21-2013.

TRACY FLETCHER, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT E

United States of America

United States Patent and Trademark Office

IFIT

Reg. No. 4,604,633

ICON HEALTH & FITNESS, INC. (UTAH CORPORATION)

Registered Sep. 16, 2014

1500 SOUTH 1000 WEST

LOGAN, UT 84321

Int. Cl.: 9

FOR: WEB-BASED, DOWNLOADABLE SOFTWARE FOR THE COLLECTION, STORAGE AND DISPLAY OF PERSONAL PERFORMANCE DATA FROM VARIOUS FITNESS ACTIVITIES, DISPLAY OF NUTRITIONAL INFORMATION AND FITNESS AND ATHLETIC PROGRAMS AND WORKOUTS, SOFTWARE FOR TRACKING, MONITORING AND PLANNING FITNESS TRAINING ACTIVITIES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

TRADEMARK

PRINCIPAL REGISTER

FIRST USE 6-6-2010; IN COMMERCE 6-6-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,466,474 AND 2,618,509.

SER. NO. 86-147,433, FILED 12-18-2013.

NANCY CLARKE, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

CERTIFICATE OF SERVICE

I hereby certify that on September 28, 2015, I caused a true and correct copy of the foregoing Petition for Cancellation to be served by United States First Class Mail, postage prepaid, upon the following correspondent of record for Respondent:

Steve Mihm
18227 Justice Way
Lakesville, Minnesota 65044

/Gregory M. Hess/