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Filing date: **11/06/2015**

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	CrossFit, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1250 Connecticut Ave., N.W., Suite 200 Washington, DC 20036 UNITED STATES		

Attorney information	Yuo-Fong C. Amato, Susan B. Meyer Gordon Rees Scully Mansukhani, LLP 101 W. Broadway, Suite 2000 San Diego, CA 92101 UNITED STATES bamato@gordonrees.com, smeyer@gordonrees.com, hpan- gan@gordonrees.com, rkellogg@gordonrees.com Phone:619-696-6700		
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**Registrations Subject to Cancellation**

Registration No	3838462	Registration date	08/24/2010
Registrant	5280 Realty, Inc. 992 S. 4th St, 100-258 Brighton, CO 80601 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 036. First Use: 2001/02/27 First Use In Commerce: 2001/02/27 All goods and services in the class are cancelled, namely: Providing a database of residential real estate listings within neighborhoods and communities specifically identified by users; Providing real estate listings via the Internet; Real estate brokerage; Real estate listing
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Abandonment	Trademark Act section 14		
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14		
Registration No	3871084	Registration date	11/02/2010
Registrant	5280 Realty, Inc. 992 South 4th Street, 100-258 Brighton, CO 80601 UNITED STATES		

## Goods/Services Subject to Cancellation

Class 036. First Use: 2001/02/27 First Use In Commerce: 2001/02/27

All goods and services in the class are cancelled, namely: Classified real estate listings of apartment rentals and housing rentals; Commercial and residential real estate agency services; Leasing of real property; Providing a database of information about residential real estate listings in different neighborhoods and communities; Providing a database of residential real estate listings within neighborhoods and communities specifically identified by users; Real estate brokerage; Real estate listing; Real estate listing services for the housing rentals and apartment rentals; Real estate multiple listing services

## Grounds for Cancellation

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Attachments	Cancellation-5280.pdf(126851 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 Overnight Courier on this date.

Signature	/Yuo-Fong C. Amato/
Name	Yuo-Fong C. Amato
Date	11/06/2015

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

In the matter of Registration No. 3,838,462 ) Cancellation No. \_\_\_\_\_  
For the Trademark **5280** )  
Registered August 24, 2010 )  
\_\_\_\_\_)  
In the matter of Registration No. 3,871,084 )  
For the Trademark **5280 REALTY** )  
Registered November 2, 2010 )  
\_\_\_\_\_)  
CROSSFIT, INC., )  
 )  
 )  
Petitioner, )  
 )  
v. )  
 )  
5280 REALTY, INC. )  
 )  
 )  
Registrant. )  
 )  
\_\_\_\_\_)

**PETITION FOR CANCELLATION**

CROSSFIT, INC. (“Petitioner”), a Delaware corporation, believes that it has and will continue to be damaged by Registration Nos. 3,838,462 (“the ‘462 Registration”) and 3,871,084 (“the ‘084 Registration”) (collectively, the “Registrations”), and hereby petitions to cancel the same. As grounds for cancellation, Petitioner asserts the following:

1. On information and belief, 5280 Realty, Inc. (“Registrant”) is a Colorado corporation with its principal place of business at 10087 Telluride Street, Commerce City, CO 80222 and/or 4432 Mt. Harvard St., Brighton, CO 80601.
2. On or around January 26, 2015, Petitioner filed a complaint against Registrant in the United States District Court, District of Colorado, under Case No. 1:15-cv-00176 (“Lawsuit”). The only claim asserted against Registrant is cybersquatting under 15 U.S.C.

§ 1125(d) for the domain names [www.5280crossfit.com](http://www.5280crossfit.com) and [www.5280crossfitgym.com](http://www.5280crossfitgym.com) (“Domain Names”) that incorporate Petitioner’s CROSSFIT® trademarks (see Registration Nos. 3,007,458; 3,826,111; 4,049,689; 4,053,443; and 4,122,681).

3. Although Registrant has not asserted any counterclaims (and time for asserting such counterclaims has passed), Registrant has argued throughout litigation as part of his defense that (a) the Domain Names cannot be transferred to Petitioner because doing so would infringe these Registrations, as well as Colorado trademark registrations which were obtained based on these Registrations; (b) that the registration of the domain name [www.5280-crossfit.com](http://www.5280-crossfit.com) for Petitioner’s licensed affiliate, which does business as 5280 CrossFit, infringes these Registrations, as well as Colorado trademark registrations which were obtained based on these Registrations.

4. Further, on October 19, 2015, Registrant stated in an e-mail to Petitioner that it will be seeking a permanent injunction against Petitioner from being able to use the term “5280” based upon the Registrations.

5. Petitioner is therefore being damaged and will continue to be damaged by these Registrations because, unless canceled, Registrant is using and will continue to use the Registrations to prevent Petitioner from using the term “5280,” despite the lack of protectability of Registrant’s trademark under the Registrations for the following reasons.

**BASIS FOR CANCELLATION (BOTH REGISTRATIONS) – VOID AB INITIO**

6. On August 15, 2008, Registrant filed the application for the ‘462 Registration.

7. On June 6, 2010, Registrant filed a Statement of Use for the ‘462 Registration under penalty of perjury, attesting that Registrant had been using the mark in commerce in association with the identified services as of February 27, 2001.

8. On February 17, 2009, Registrant filed the application for the '084 Registration.

9. On July 9, 2010, Registrant filed a Statement of Use for the '084 Registration under penalty of perjury, attesting that Registrant had been using the mark in commerce in association with the identified services as of February 27, 2001.

10. On information and belief, Registrant never used the term "5280" until Registrant was incorporated on or around December 4, 2007, over 6 years after the alleged dates of first use. Prior to that date, any purported real estate listings were offered under the terms "Lillypad" or "Freelisting.biz."

11. On information and belief, at the time of the filing of the Statement of Use for both Registrations, Registrant did not in fact offer *bona fide* services identified in the Registrations. Instead, Registrant intended to use the Registrations for at least two different purposes: (a) to bully and/or extort money from other users of the "5280" term, the number of which is considerable, as the term "5280" is synonymous with the city of Denver, the "mile-high" (i.e., 5280-foot) city, and (b) to use his websites to drive consumers to purchase Registrant's publications and other products relating to credit repair.

12. On information and belief, while Registrant purported to offer online real estate listing services, such services were never in fact offered. Registrant's websites only ever listed 4-5 properties, all of which were homes owned by Joe P. Sainz, III—Chief Executive Officer of Registrant—or his friends and family, for the purpose of making the website look legitimate.

13. Further, Mr. Sainz, the sole employee of Registrant, was not a licensed real estate broker who could offer real estate brokerage and related services until September 7, 2012, years after the Statement of Use. Registrant was likewise not a licensed real estate

company until September 5, 2014. On information and belief, at no time did Registrant hire any other independent contractors who are licensed brokers.

14. On information and belief, Mr. Sainz and Registrant only sought real estate licenses because their lack of licensing was brought as an issue in a trademark infringement case brought by Registrant, *5280 Realty, Inc. v. The 5280 Group, LLC et al.*, U.S.D.C., District of Colorado, Case no. 1:12-cv-00970-CMA-MJW.

15. Based on the above, at the time of filing the Statement of Use, Registrant did not have a *bona fide* use of the mark in the ordinary course of trade in association with any of the identified services. Therefore, the Registrations are void *ab initio*.

**BASIS FOR CANCELLATION (BOTH REGISTRATIONS) – ABANDONMENT**

16. On information and belief, Registrant has abandoned the Registrations as used in connection with the following services in that Registrant has failed to use the mark in connection with those services for three consecutive years and/or have failed to use the mark in connection with those goods with no intent to resume such use (if Registrant ever did use it).

Those services under the ‘462 Registration include:

- a. “Providing a database of residential real estate listings within neighborhoods and communities specifically identified by users”;
- b. “Providing real estate listings via the Internet”;
- c. “Real estate listing.”

Those services under the ‘084 Registration include:

- a. “Classified real estate listings of apartment rentals and housing rentals”;
- b. “Commercial and residential real estate agency services”;
- c. “Leasing of real property”;

- d. “Providing a database of information about residential real estate listings in different neighborhood and communities”;
- e. “Providing a database of residential real estate listings within neighborhoods and communities specifically identified by users”;
- f. “Real estate listing”;
- g. “Real estate listing services for the housing rentals and apartment rentals”;
- h. “Real estate multiple listing services.”

17. Instead, on information and belief, Registrant’s websites only ever listed 4-5 properties, all of which were homes owned by Joe P. Sainz, III—Chief Executive Officer of Registrant—or his friends and family, for the purpose of making the website look legitimate.

18. For the above reasons, the above-identified services of the Registrations should be deemed abandoned and stricken from the Registrations.

**BASIS FOR CANCELLATION (BOTH REGISTRATIONS) – FRAUD**

19. On information and belief, Registrant registered and maintained the Registration fraudulently, with the intent to defraud the United States Patent and Trademark Office (“USPTO”).

20. On June 6, 2010, Registrant filed a Statement of Use for the ‘462 Registration under penalty of perjury, that Registrant had been using the mark in commerce in association with the identified services. On information and belief that representation was false, as Registrant had not used its mark in association with all or any of the services listed in the application. On information and belief, Registrant’s false representation was made with the intent to mislead the USPTO for the purposes of obtaining the Registration.

21. On August 31, 2015, Registrant filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 under penalty of perjury, alleging use of the mark for five consecutive years in association with the identified services of the '462 Registration. On information and belief that representation was false, as Registrant had not used its mark in association with all or any of the services listed in the application, let alone for five consecutive years. As to the real estate brokerage services, Registrant was only a licensed real estate company as of September 5, 2014. On information and belief, Registrant's false representation was made with the intent to mislead the USPTO for the purposes of maintaining the '462 Registration and falsely achieving incontestable status for the '462 Registration.

22. On July 9, 2010, Registrant filed a Statement of Use for the '084 Registration under penalty of perjury, that Registrant had been using the mark in commerce in association with the identified services. On information and belief that representation was false, as Registrant had not used its mark in association with all or any of the services listed in the application. On information and belief, Registrant's false representation was made with the intent to mislead the USPTO for the purposes of obtaining the '084 Registration.

23. For the above reasons, the Registrations should be cancelled in their entirety.

**BASIS FOR CANCELLATION (BOTH REGISTRATIONS) – MERELY**

**DESCRIPTIVE**

24. Although the '462 Registration (but not the '084 Registration) has purportedly achieved incontestable status, such status, given the above bases for cancellation, should not be afforded to the '462 Registration.

25. The term "5280" is highly descriptive of the purported services provided under the mark. Namely, Registrant purports to offer real estate-related services in the Denver,

Colorado area. The term “5280” is synonymous with Denver, the “mile-high” (i.e., 5280-feet) city. The term “realty” merely refers to the purported real estate-related services, and is a disclaimed term of the ‘084 Registration.

26. Consumers do not associate the marks or terms “5280” nor “5280 REALTY” with a single source as to the identified services of the Registration, and the marks have no secondary meaning.

27. To allow the continuation of a monopoly on descriptive terms where the terms has no secondary meaning would be contrary to the public interest in promoting competition.

28. The Registrations, which are merely descriptive and lacking in secondary meaning, should not exist in view of 15 U.S.C. § 1052(e).

**WHEREFORE**, Petitioner prays that Registration Nos. 3,838,462 and 3,871,084 be cancelled pursuant reasons enumerated above. The required fee is submitted herewith.

Respectfully submitted,

Date: November 6, 2015

/s/ Yuo-Fong C. Amato  
Yuo-Fong C. Amato  
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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of this Petition for Cancellation is being served on November 6, 2015 by overnight courier pursuant to 37 C.F.R. §2.119(b)(5) to the following address:

5280 Realty, Inc.  
992 South 4<sup>th</sup> Street, 100-258  
Brighton, CO 80601

*Registrant Address of Record*

5280 Realty, Inc.  
4432 Mt. Harvard St.  
Brighton, CO 80601

*Registrant Address of Record*

Kendal M. Sheets  
Sheets Law Office, LLC  
1855 MacArthur Dr.  
McLean, VA 22101-5339

*Attorney Address of Record*

Ken Sheets  
Kenealy Vaidya LLP  
3000 K. Street, NW, Suite 310  
Washington, D.C. 20007

*Attorney Address Believed to Be Currently Valid*

I declare, under penalty of perjury of the law of the United States, that the foregoing is true and correct.

Signed this 6th day of November, 2015.

  
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Yuo-Fong C. Amato