

ESTTA Tracking number: **ESTTA775035**

Filing date: **10/06/2016**

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	Beachbody, LLC		
Entity	LIMITED LIABILITY COM-PANY	Citizenship	Delaware
Address	3301 Exposition Blvd., 3rd Floor Santa Monica, CA 90404 UNITED STATES		

Attorney information	Camille M. Miller Cozen O'Connor 1650 Market Street, Suite 2800 One Liberty Place Philadelphia, PA 19103 UNITED STATES cmiller@cozen.com, jcloak@cozen.com, treginelli@cozen.com Phone:215-665-7273
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Registration Subject to Cancellation

Registration No	5018234	Registration date	08/09/2016
Registrant	Giacoma, Justin 1861 Andrews Dr Concord, CA 94521 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2009/11/06 First Use In Commerce: 2011/07/16
All goods and services in the class are cancelled, namely: Belts; Gloves; Headwear; Jackets; Pants; Shirts; Shorts; Sweat shirts; Undergarments; Vests

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3794226	Application Date	12/17/2008
Registration Date	05/25/2010	Foreign Priority Date	NONE
Word Mark	DIG DEEPER		

Design Mark	DIG DEEPER
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2010/01/13 First Use In Commerce: 2010/01/13 Pre-recorded video tapes and cassettes, DVDs, CDs, featuring exercise, fitness and dietary information and instruction; downloadable audio files and video files featuring exercise, fitness and dietary information and instruction Class 041. First use: First Use: 2010/01/13 First Use In Commerce: 2010/01/13 Providing a web site featuring on-line instruction in the field of physical exercise and nutrition and tracking progress of workouts; educational services and on-line educational services, namely, providing instruction in the fields of exercise equipment, physical exercise and nutrition, and instructional materials distributed in connection therewith; physical fitness training services, namely, tracking progress of workouts for others; online journals, namely, blogs in the field of exercise, fitness, dietary information and instruction

U.S. Application No.	86768043	Application Date	09/24/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	DIG DEEPER
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Design Mark	DIG DEEPER
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 2013/04/30 First Use In Commerce: 2013/04/30 Athletic shirts; T-shirts
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U.S. Application No.	86767919	Application Date	09/24/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	DIG DEEPER
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Design Mark	DIG DEEPER
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Baseball caps; caps; sun visors; headbands; wristbands; bandanas; pants; shorts; sports bras; performance athletic clothing employing compression technology to support and enhance movement, namely, shorts, pants, sweatpants, t-shirts, sleeveless tops, polo-type shirts, sweatshirts, jackets, track suits, warm up suits, swimwear, underwear, tights, socks, gloves, headbands, wristbands; tank tops; t-shirts; polo-type shirts; long-sleeved shirts; woven shirts; sweatshirts; hooded sweatshirts; sweatpants; tights; warm up suits; yoga pants; yoga tops; jackets; vests; coats; sweaters; skirts; dresses; belts; pullovers; jerseys; underwear; athletic sleeves; gloves; hosiery; socks; bathing trunks; bathing suits; swimwear; athletic footwear; sandals

Attachments	77634877#TMSN.png(bytes) 86768043#TMSN.png(bytes) 86767919#TMSN.png(bytes) Petition_to_Cancel_DIG_DEEP.pdf(241720 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	/Camille M. Miller/
Name	Camille M. Miller
Date	10/06/2016

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

Beachbody, LLC,	:	
	:	Cancellation No.
Petitioner,	:	
	:	U.S. Reg. No. 5018234
v.	:	
	:	
Justin Giacom,	:	Mark: DIG DEEP
	:	
Registrant.	:	

USPTO-TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION

Beachbody, LLC, a Delaware limited liability company with a principal place of business at 3301 Exposition Blvd, Third Floor, Santa Monica, CA 90404 (“Petitioner” or “Beachbody”), believes that it will be damaged by the continued registration of U.S. Trademark Registration No. 5018234 for DIG DEEP and hereby petitions to cancel the same. As grounds for cancellation, it is alleged that:

1. Mr. Justin Giacom, an individual with an address at 1861 Andrews Dr., Concord, CA 94521 (“Registrant”), is the registrant of record for U.S. Trademark Registration No. 5018234 for DIG DEEP.

2. Registrant filed an intent-to-use application to register the mark DIG DEEP in the United States Patent and Trademark Office on June 20, 2013. This application was accorded U.S. Trademark Application No. 85/965,355.

3. Registrant's application issued into Registration No. 5018234 on August 9, 2016 for "Belts; Gloves; Headwear; Jackets; Pants; Shirts; Shorts; Sweat shirts; Undergarments; Vests" in International Class 25 (the "DIG DEEP Registration").

4. The DIG DEEP Registration claims a first use date of November 6, 2009 and a first use in commerce date of July 16, 2011.

5. Beachbody is the owner of U.S. Trademark Registration No. 3794226 for DIG DEEPER for "Pre-recorded video tapes and cassettes, DVDs, CDs, featuring exercise, fitness and dietary information and instruction; downloadable audio files and video files featuring exercise, fitness and dietary information and instruction" in International Class 9 and "Providing a web site featuring on-line instruction in the field of physical exercise and nutrition and tracking progress of workouts; educational services and on-line educational services, namely, providing instruction in the fields of exercise equipment, physical exercise and nutrition, and instructional materials distributed in connection therewith; physical fitness training services, namely, tracking progress of workouts for others; online journals, namely, blogs in the field of exercise, fitness, dietary information and instruction" in International Class 41 (the "DIG DEEPER Registration").

6. The application underlying the DIG DEEPER Registration was filed on an intent-to-use basis on December 17, 2008. The DIG DEEPER Registration issued on May 25, 2010 and the registration claims a first use and first use in commerce date of January 13, 2010 for the goods and services identified in Classes 9 and 41, respectively.

7. Beachbody also owns U.S. Trademark Application No. 86/768,043 for DIG DEEPER for "Athletic shirts; T-shirts" in International Class 25, which was filed on September 24, 2015 and which claims a first use and first use in commerce date of April 30, 2013; as well as

U.S. Trademark Application No. 86/767,919 for DIG DEEPER for “Baseball caps; caps; sun visors; headbands; wristbands; bandanas; pants; shorts; sports bras; performance athletic clothing employing compression technology to support and enhance movement, namely, shorts, pants, sweatpants, t-shirts, sleeveless tops, polo-type shirts, sweatshirts, jackets, track suits, warm up suits, swimwear, underwear, tights, socks, gloves, headbands, wristbands; tank tops; t-shirts; polo-type shirts; long-sleeved shirts; woven shirts; sweatshirts; hooded sweatshirts; sweatpants; tights; warm up suits; yoga pants; yoga tops; jackets; vests; coats; sweaters; skirts; dresses; belts; pullovers; jerseys; underwear; athletic sleeves; gloves; hosiery; socks; bathing trunks; bathing suits; swimwear; athletic footwear; sandals” in International Class 25, which was filed on an intent-to-use basis on September 24, 2015 (both of the foregoing applications referred to herein as the “DIG DEEPER Applications”).

8. The USPTO has cited the application underlying the DIG DEEP Registration as a potential bar to the registration of both of the DIG DEEPER Applications. The USPTO will likely imminently cite the DIG DEEP Registration as a bar to the registration of the DIG DEEPER Applications, as the USPTO had previously suspended prosecution of the DIG DEEPER Applications pending the disposition of the application underlying the DIG DEEP Registration. Therefore, Beachbody has standing to bring this action.

9. Beachbody’s rights in its DIG DEEPER mark that is the subject of its DIG DEEPER Registration predate those of the Registrant in its DIG DEEP designation at issue in the DIG DEEP Registration. Indeed, Beachbody’s rights in the DIG DEEPER mark identified in the DIG DEEPER Registration extend back to December 17, 2008, the filing date of the application underlying the DIG DEEPER Registration. This is earlier in time than either the application

filing date or the first use date identified by Registrant in connection with the DIG DEEP Registration. In fact, Registrant has advised that it began using its DIG DEEP designation in connection with clothing on July 16, 2011, well after Beachbody's filing of the application underlying its DIG DEEPER Registration and use of the DIG DEEPER mark at issue in such registration.

10. Since at least as early as January 13, 2010, Beachbody has been continuously using the DIG DEEPER mark and the DIG DEEPER mark represents the exceedingly valuable goodwill of Beachbody.

11. Through, among other things, Beachbody's advertising and promotion of the DIG DEEPER mark and associated goods and services, the DIG DEEPER mark has become well known throughout the consuming public and is a strong mark.

12. Beachbody has notified Registrant, via Registrant's counsel of record, of its DIG DEEPER mark and DIG DEEPER Registration, as well as the DIG DEEPER Applications.

13. Registrant's DIG DEEP designation that is the subject of the DIG DEEP Registration is nearly identical to Beachbody's DIG DEEPER mark, in which Beachbody has prior rights. The only difference between Registrant's and Beachbody's respective designation and mark, is the deletion of the -ER in "DEEPER" from Registrant's designation. Thus, the Registrant's and Beachbody's respective designation and mark are confusingly similar.

14. The goods that are the subject of the DIG DEEP Registration, namely, "Belts; Gloves; Headwear; Jackets; Pants; Shirts; Shorts; Sweat shirts; Undergarments; Vests" are related to the goods and services in the DIG DEEPER Registration. Indeed, such goods are of a type that frequently originate from the same source as exercise-based DVD programs and

associated fitness related goods and services identified in the DIG DEEPER Registration. In fact, Beachbody is aware of multiple third parties that either own trademark registrations that cover, or which offer for sale or sell, clothing-related goods such as those identified in the DIG DEEP Registration and goods and services of a type identified in the DIG DEEPER Registration including, but not limited to, Girls Gone Strong, Jazzercise, Inc., Raquel Horsford, The Bugarie Group, and Personal Best Enterprises, Inc., in addition to Beachbody itself. Thus, the Registrant's and Beachbody's respective goods and services are related.

15. Registrant allowed its DIG DEEP designation to register in bad faith. Registrant was aware of Beachbody's rights in and to its DIG DEEPER mark before such time as Registrant filed its statement of use on May 16, 2016 and well before Registrant's DIG DEEP Registration issued. Nevertheless, Registrant continued to prosecute the application underlying the DIG DEEP Registration through to registration. For similar reasons, Registrant's continued use of the DIG DEEP designation, if any, is also in bad faith.

16. Registrant's registration of the DIG DEEP designation as identified in the DIG DEEP Registration consists of a designation that when used on or in connection with those goods identified in such registration, is likely to confuse consumers into believing that Registrant, or its products offered under its DIG DEEP designation, is or are associated or otherwise affiliated with, or sponsored or endorsed by Beachbody or its respective goods and services offered under the DIG DEEPER mark when that, in fact, is not the case.

17. Therefore, the continued registration of Registrant's DIG DEEP designation will result in damage and injury to Beachbody as it is likely to, among other things, create and

perpetuate such confusion in the marketplace, thereby detracting from the considerable goodwill Beachbody has accrued in the DIG DEEPER mark.

WHEREFORE, Beachbody requests that U.S. Reg. No. 5018234 be cancelled in its entirety, and this Cancellation Proceeding be sustained in Beachbody's favor.

Respectfully submitted,

COZEN O'CONNOR



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Dated: October 6, 2016

Attorneys for Beachbody, LLC,

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing document was electronically filed with the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board on October 6, 2016, and will be mailed on this date via First Class Mail, postage prepaid, to Registrant at the following address:

Justin Giacoma
1861 Andrews Dr.
Concord, CA 94521

with courtesy copies via email to:

JungJin Lee
jj@llapc.com

and

Erin C. Bray
erin@llapc.com

Date: October 6, 2016



J. Trevor Cloak
Attorney