



9720 Wilshire Boulevard, 5<sup>th</sup> Floor  
Beverly Hills, California 90212  
Main: 310.440.4100  
Fax: 310.765.7647  
kgatien@raineslaw.com  
www.raineslaw.com

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**VIA OVERNIGHT MAIL**

Deputy Commission for Trademark Examination Policy  
United States Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314-5793

Re: **Concerns re: Treatment of SPIN trademark in review process**

Dear Deputy Commissioner:

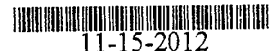
This letter respectfully is being submitted on behalf of our client, Mad Dogg Athletics, Inc. ("Mad Dogg").

We wish bring to your attention, and seek your kind cooperation in resolving, our client's grave concerns regarding what we believe to be improper and inconsistent treatment of its long-standing and incontestable trademark registrations for SPIN (Reg. No. 2,137,202) (hereinafter, the "SPIN mark") for stationary exercise bicycles and SPINNING (Reg. Nos. 1780650 and 2003922) (collectively, the "SPINNING mark") for fitness instruction and exercise equipment, during the review of third party trademark applications that use or incorporate these marks for identical and/or highly related goods and services.

In sum, while our client's marks have been cited from time to time,<sup>1</sup> we are concerned that on far too many occasions Examining Attorneys have not cited these marks as bars to the registration of confusingly similar third party marks. In addition, there have been instances in which Examining Attorneys have refused registration of confusingly similar third party marks on the basis that the term "spin" is merely descriptive under Section 2(e) of the Trademark Act, as opposed to citing our client's SPIN mark as the basis for refusal under Section 2(d) of the Act. Finally, on at least one occasion, an Examining Attorney has allowed our client's SPINNING mark to be included in the description of services for a confusingly similar third-party mark.

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<sup>1</sup> Mad Dogg's SPIN mark was cited as a bar to registration of the pending trademark applications for SPYN (Ser. No. 85276547) for, *inter alia*, consulting services in the fields of fitness and exercise, and SWEAT BOUTIQUE SPIN (Ser. No. 85568426) for providing exercise classes using stationary exercise bikes.



11-15-2012

U.S. Patent & TM/Ofc/TM Mail Rcpt Dt: #21

We strongly believe that the totality of these instances is causing irreparable harm to our client's brand, and amounts in effect to an impermissible collateral attack on its registered trademarks in violation of the United States Patent and Trademark Office's rules and standards of practice.

For example, it is a well-established rule of trademark law that a registration issued by the USPTO is "conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. § 1115(b). In other words, "it is conclusively presumed either that the mark is nondescriptive, or if descriptive, has acquired secondary meaning. 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:44 at 11-90.16 ("MCCARTHY ON TRADEMARKS") (2007). As more fully set forth below, case law is consistent with our position. See, e.g., Retail Services, Inc. v. Freebies Publishing, 364 F.3d 535, 70 U.S.P.Q.2d 1603 (4<sup>th</sup> Cir. 2004) ("The validity of the same registered mark, after qualifying for incontestable status, is conclusively presumed and may not be challenged as merely descriptive.").

Accordingly, we respectfully request that the Deputy Director take remedial action to ensure that our client's marks are given the deference to which they are entitled during the examination process of third party marks, and to ensure that Examining Attorneys do not refuse registration to third party marks on the basis that the terms "spin" and/or "spinning" are merely descriptive for goods and services related to indoor cycling.

#### **I. History of Mad Dogg and Its SPIN Family of Marks.**





Mad Dogg was founded in 1994 and is the world's largest equipment-based fitness education company.

Mad Dogg's SPIN mark has been registered with the United States Patent and Trademark Office since July 14, 1998, based on a first use date as early as January 1992. Based thereon, our client's registration for this mark has been in full force and effect without abandonment for a period of over 14 years. In addition, our client has used the mark continuously in commerce in the United States for over 20 years.

Mad Dogg's SPINNING mark has been registered with the United States Patent and Trademark Office since July 6, 1993, based on a first use date as early as March 31, 1982. Based thereon, our client's registration for this mark has been in full force and effect without abandonment for almost 20 years. In addition, our client has used the mark continuously in commerce in the United States for over 30 years.

The term SPIN is integral to Mad Dogg's business. So much so that Mad Dogg has developed an entire family of trademarks that include this key source-identifying term. Mad Dogg's federally registered SPIN Family of marks includes SPIN, SPIN BODY, SPINCIRCUIT, SPINCROSS, SPINERVALS, SPIN FITNESS, SPINGYM, SPINNER, SPINNING, SPINNING NATION, SPIN PILATES, SPINTECH, SPIN YOGA, CROSSSPINNER and JOHNNY G SPINNER, as set forth below:

Mark	Reg. No.	Class	Goods & Services	Reg. Date	Date of First Use
SPIN	2173202	028	Stationary exercise bicycles.	7/14/98	1/31/92
		041	Physical fitness instruction.		
SPIN	2721952	005	Nutritional supplements, vitamins and minerals, nutritional drink mix for use as meal replacement, dietary food supplements.	6/3/03	2/11/02
SPIN BODY	2475595	003	Non-medicated skin creams, all exercise related, namely a warm-up cream that stimulate skin and muscles prior to a work-out, a massage cream used as a lubricant before and after a work-out, a recovery cream for skin and muscles after a work-out and a pre and post-workout cream meant to reduce friction and eliminate chafing and soreness.	5/15/01	7/31/99
SPINCIRCUIT	4140957	009	Prerecorded video tapes featuring exercise and general physical fitness instruction.	3/28/00	8/31/99
		028	Exercise equipment, namely, stationary exercise bicycles.		9/30/98
		041	Physical fitness instruction.		9/30/98
SPINCROSS	3769393	009	Prerecorded audio and video recordings, namely, DVDs featuring exercise and general physical fitness instruction.	3/30/10	1/4/10
		028	Exercise equipment, namely, weight training machines.		
		041	Providing instruction and consultation in the fields of physical fitness and exercise.		
SPINERVALS	2336564	009	Prerecorded video cassettes featuring exercise and general physical fitness instruction.	3/28/00	10/31/97
SPIN FITNESS	3962020	009	Prerecorded audio and video recordings, namely, CDs, DVDs, featuring instruction in the field of health and exercise.	5/17/11	3/12/09
SPIN FITNESS	3990272	025	Apparel, namely, T-shirts, tank tops, polo shirts, sports bras, jackets, coats, rain suits, sweatshirts, hooded sweatshirts, sweatpants, warm-up suits, sweaters, jerseys, pullovers, tights, shorts, socks, caps.	7/5/11	5/31/09
SPIN FITNESS	3521332	028	Exercise equipment, namely, resistance training machines, elastic tubing, exercise	10/21/08	3/31/08

			mats, exercise blocks, exercise straps, exercise balls, stability balls, weighted resistance products in the nature of resistance cables, exercise weights.		
SPIN FITNESS	3978382	041	Providing physical fitness instruction and consultation in the fields of health and exercise; health club services, namely, providing instruction and equipment in the fields of health and exercise.	6/14/11	6/30/07
	3974847	009	Prerecorded audio and video recordings, namely, CDs, DVDs, featuring instruction in the field of health and exercise.	6/7/11	3/12/09
	3974848	025	Apparel, namely, T-shirts, tank tops, polo shirts, sports bras, jackets, coats, rain suits, sweatshirts, hooded sweatshirts, sweatpants, warm-up suits, sweaters, jerseys, pullovers, tights, shorts, socks, caps.	1/15/08	5/31/09
	3661476	028	Exercise equipment, namely, resistance training machines, elastic tubing, exercise mats, exercise blocks, exercise straps, exercise balls, stability balls, weighted resistance products in the nature of resistance cables, exercise weights.	7/28/09	1/6/09
	3994201	041	Providing physical fitness instruction and consultation in the fields of health and exercise; health club services, namely, providing instruction and equipment in the fields of health and exercise.	7/12/11	5/31/09
SPINGYM	3334266	009	Prerecorded video cassettes, DVDs, audio cassettes, and compact discs featuring exercise and general fitness instruction.	11/13/07	8/5/99
		041	Physical fitness instruction.		
SPINNER	1972363	028	Exercise equipment in the nature of stationary exercise bicycles and accessories, and weight training machines.	5/7/96	6/30/85
SPINNING	1780650	041	Providing training and instruction to others by simulating an outdoor bicycle workout completed indoors on a stationery bicycle.	7/6/1993	3/31/82
SPINNING	2003922	009	Prerecorded video cassettes featuring exercise and general physical fitness instruction.	10/1/1996	2/28/90
		025	Clothing in the nature of sports and leisure clothing, namely shoes, T-shirts, sweatshirts, sweat pants, polo shirts,		1/31/90

		028	shorts, sports coats and jackets, socks, sweatbands, and warm-up suits. Exercise equipment in the nature of stationary exercise bicycles and weight training machines.		1/31/90
SPINNING	2079624	005	Nutritional supplements.	7/5/1997	8/31/96
SPINNING	2341628	032	Sports drinks.	4/11/2000	9/1/99
SPINNING	2103574	003	Non-medicated lotions, creams, balms and oils for skin care and massage.	10/7/1997	7/31/96
		018	All purpose sports bags.		7/31/95
SPINNING	2424295	041	Providing facilities for recreation, physical fitness, exercising activities, fitness instruction, and fitness consultation.	1/30/2001	3/31/82
SPINNING	3286726	041	Providing information in the field of exercise and fitness via the Internet.	8/28/07	2/28/97
SPINNING	3298552	009	Computer software for tracking individual output in the field of exercise and fitness, computer software for pulmonary and cardiovascular analysis, computers, handheld computers, microcomputers, personal computers, computer hardware, computer peripherals, computer terminals.	9/25/07	3/31/06
		016	Computer program manuals for use in the field of exercise and fitness, computer program manuals for use in the field of pulmonary and cardiovascular analysis.		
SPINNING NATION	4221948	036	Charitable fundraising	10/9/12	6/28/08
SPIN PILATES	3990273	009	Prerecorded audio and video recordings, namely, DVDs featuring instruction in the fields of health and exercise.	7/5/11	12/31/07
SPIN PILATES	3990274	025	Apparel, namely, T-shirts.	7/5/11	2/11/08
SPIN PILATES	3521333	028	Exercise equipment, namely, resistance training machines.	10/21/08	10/31/07
SPIN PILATES	3528187	041	Providing physical fitness instruction and consultation in the fields of health and exercise; health club services, namely, providing instruction and equipment in the field of physical exercise.	11/4/08	6/30/07
SPINTECH	4051866	003	Cleaning preparations for exercise equipment and bicycles.	11/8/11	2/01/00

		004	Lubricants for exercise equipment and bicycles.		
SPIN YOGA	3981791	041	Providing physical fitness instruction and consultation in the fields of health and exercise; health club services, namely, providing instruction and equipment in the fields of health and exercise.	6/21/11	12/4/10
SPIN YOGA	3986020	025	Apparel, namely, T-shirts, tank tops, polo shirts, sports bras, sweatshirts, hooded sweatshirts, sweatpants, tights.	6/28/11	1/31/11
CROSSSPINNER	3769394	028	Exercise equipment, namely, weight training machines.	3/30/10	1/4/10
JOHNNY G SPINNER	1977743	028	Exercise equipment, namely stationary exercise bicycles.	6/4/96	6/30/85

(hereinafter, collectively referred to as the “SPIN Family of Marks”).

Since its inception, Mad Dogg has spent tens of millions of dollars and invested considerable time, effort and expense in developing, marketing and promoting its goods and services bearing the SPIN Family of marks (the “SPIN Products and Services”). Mad Dogg’s promotions consist of advertisements in and through mass media including without limitation the Internet, phone sales (800-847-SPIN), catalogs, fliers, promotional CDs and DVDs, in-store placards, in-store promotional cards, promotional postcard mailings, leading health and fitness trade shows throughout the United States and internationally such as ECA, NIRSA, DCAC, IHRSA and the Club Industry conference and exposition, the creation, staging and exhibition of the annual World Spinning® and Sports Conference, and the creation, staging and performance of the annual SPINNING NATION charity event. Hundreds of thousands of individuals and businesses attend these trade shows each year.

In addition, to Mad Dogg has secured over 400 SPIN-variant domain names, including [www.spinfitness.com](http://www.spinfitness.com) and [www.spinning.com](http://www.spinning.com) in connection with the promotion, distribution and protection of its SPIN Products and Services.

As a direct result of Mad Dogg’s efforts to protect and promote its business interests offered under the SPIN Family of Marks, Mad Dogg has enjoyed significant sales of its SPIN Products and Services, averaging over \$50,000,000 per year for the last 5 years.

Significantly, because of the quality of Mad Dogg’s SPIN-branded goods and services, Mad Dogg has successfully trained over 200,000 licensed SPINNING indoor cycling instructors, many of whom belong to the SPIN fitness instructor network. Through this network, Mad Dogg has reached millions of fitness enthusiasts by providing instruction in over 35,000 approved fitness facilities in the United States including without limitation Gold’s Gym, 24 Hour Fitness, Bally’s, and the Sports Clubs Network of health clubs.

In large part due to the industrious efforts of its founders for approximately 30 years, Mad Dogg's SPIN and SPINNING marks for goods and services related to indoor cycles and indoor cycling instruction are used daily across the United States (and around the world) by hundreds of thousands of health and fitness enthusiasts.

As a direct result of the longstanding, substantial and continuous use by Mad Dogg of its SPIN Family of Marks in connection with its SPIN Products and Services, these marks have long been immediately recognized by consumers and the trade as identifying Mad Dogg exclusively as the single source of these well-respected products and services. As such, the SPIN Family of Marks have become strong, famous trademarks entitled to a broad scope of protection and are included in Mad Dogg's most important business assets.

Because of this, the importance of the SPIN Family of Marks to Mad Dogg's business identity and livelihood cannot be understated.

## **II. Mad Dogg's SPIN and SPINNING Trademarks.**

### **A. Mad Dogg's SPIN and SPINNING Trademarks are Incontestable.**

Mad Dogg's use of the SPIN and SPINNING marks has been substantial, continuous and exclusive for a period of over five years. These marks are in full force and effect. Mad Dogg has never abandoned these marks, nor has Mad Dogg ever abandoned the goodwill of Mad Dogg's business in connection thereto. Mad Dogg intends to continue to preserve and maintain its rights with respect to its SPIN and SPINNING marks. As such, said registrations has become incontestable pursuant to 15 U.S.C. § 1065.

### **B. Mad Dogg Has Successfully Enforced Its SPIN and SPINNING Trademarks.**

Mad Dogg has successfully enforced its trademark rights against infringers. In addition to the ongoing cease-and-desist efforts carried out by its attorneys, Mad Dogg has successfully maintained actions in federal court and before the Trademark Trial and Appeal Board, which include, among others, the following actions and proceedings:

- *Mad Dogg Athletics, Inc. v. Pan Holdings, Inc.*, Central District of California Case No. CV 06-3071 AHM (JTLx);
- *Mad Dogg Athletics, Inc. v. Lifesports, Inc.*, Central District of California Case No. CV 06-8109 CAS (CTx);
- *Mad Dogg Athletics, Inc. v. SIFE-Athletics, Inc.*, Central District of California Case No. CV 07-0299 RGK (Rzx);
- *Mad Dogg Athletics, Inc. v. NYC Holding*, Central District of California Case No. CV 07-1074 RGK (SHx);
- *Mad Dogg Athletics, Inc. v. Fitness Concepts, Inc.*, Central District of California Case No. CV 07-1737 MMM (CTx);
- *Mad Dogg Athletics, Inc. v. NOKTA.com, Inc.*, Central District of California Case No. CV 07-1740 AHM (VBKx);

- *Mad Dogg Athletics, Inc. v. Body Bike International*, Central District of California Case No. CV 07-02519 R (SHx);
- *Mad Dogg Athletics, Inc. v. Sports-Spa-Plus, Inc.*, Central District of California Case No. CV 08-3682 RGK (MANx);
- *Mad Dogg Athletics, Inc. v. Wen Cheng Hsieh*, Trademark Trial and Appeal Board (Opp. No. 91164860), decided June 6, 2007;
- *Mad Dogg Athletics, Inc. v. Maxfit, Inc.*, Trademark Trial and Appeal Board (Opp. No. 91185063), decided October 29, 2008;
- *Mad Dogg Athletics, Inc. v. Great Sports, Inc.*, Central District of California Case No. CV 09-6540 FMC (RZx); and
- *Mad Dogg Athletics, Inc. v. Zazzle, Inc.*, Central District of California Case No. CV 12-1764 PA (FFMx).

As a direct result of Mad Dogg's efforts and vigilance, vendors and competitors in the industry have long recognized and respected Mad Dogg's trademark rights.

**C. The USPTO Has Ample Evidence of Use of Mad Dogg's SPIN Trademark.**

Representative samples of Mad Dogg's advertisement and promotional materials used to promote Mad Dogg's SPIN Products and Services are available to the Director by accessing the documents filed in *Mad Dogg Athletics, Inc. v. Wen Cheng Hsieh* (Opp. No. 91164860), as well the additional evidence offered in response to the Office Actions issued during the prosecution of the registration of Mad Dogg's SPIN FITNESS marks (Reg. Nos. 3962020; 3990272; 3521332; 3978382), which evidence Mad Dogg respectfully requests be made of record and incorporated herein with the kind consent of the Director.

**III. Treatment of Mad Dogg's SPIN Mark in Third Party Prosecution.**

Notwithstanding Mad Dogg's well-established and incontestable rights to its SPIN and SPINNING marks, and its SPIN Family of Marks, and the care Mad Dogg has demonstrated in promoting and protecting its marks, it has, unfortunately, come to Mad Dogg's attention that attorneys examining third party trademark applications filed with the USPTO are failing to cite these marks as a bar to registration based on a likelihood of confusion.

Examples of the failure to cite Mad Dogg's marks, and of the disparate and inconsistent treatment of Mad Dogg's marks in the prosecution of such third party marks fall into three basic categories: (A) Marks that are approved with no Section 2(d) refusal issued based on Mad Dogg's marks, (B) Marks that are refused registration based on Section 2(e), where the Examining Attorney has asserted that one of Mad Dogg's incontestable SPIN Family of Marks is merely descriptive, and (C) Marks approved for registration that include one of Mad Dogg's marks in the identification of goods or services. Each is discussed below.



**A. Marks Approved for Registration Without a Section 2(d)  
Refusal Issued Based on Mad Dogg's Marks.**

The following marks have been approved by Examining Attorneys without issuing a Section 2(d) refusal based on Mad Dogg's incontestable SPIN or SPINNING marks.

1. **SPIN DEEP** (Ser. No. 85321701) for "*Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes.*" The Applicant's specimen was refused as merely ornamental. The Applicant recently filed additional specimens of use.
2. **SPIN THE WORLD** (Ser. No. 85510107) for "*Entertainment in the nature of on-going television programs in the field of health and wellness.*" Internet evidence confirmed that this mark is to be used for a cycling program. The mark has been opposed by Mad Dogg (See Opp. No. 91207292).
3. **SPIN NATION** (Ser. No. 85260714) for "*Educational services, namely, conducting classes, seminars and workshops in the field of physical fitness and distribution of printed materials in connection therewith in hard copy or electronic format on the same topics.*" This mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant.
4. **SPINNING FOR TWO** (Ser. No. 85460041) for "*Maternity clothing, namely, athletic apparel, shirts, tank tops, long sleeve shirts, t-shirts, jackets, pants; Shorts; Skirts.*" Internet evidence confirmed that this mark refers to indoor cycling apparel for pregnant women. This mark was withdrawn from publication and returned to the Examining Attorney for review after Mad Dogg filed a letter of protest with the Director based on Mad Dogg's SPINNING trademark registrations for indoor cycling and apparel.
5. **SPINSATIONAL** (Ser. No. 85414945) for "*Manually-operated exercise equipment for physical fitness purposes.*" This mark was abandoned because the Applicant's description of goods did not match its services.
6. **SPINSATIONAL** (Ser. No. 85620810) for "*Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities.*" The Applicant of the above-referenced SPINSATIONAL mark re-filed its application with this identification of services. The mark was approved without an Office Action being issued. Mad Dogg has requested an extension of time to oppose this application.
7. **SPINBITCH** (Ser. No. 85277178) for "*Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms.*" This mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant.

8. **ROCK IT SPIN** (Ser. No. 85277178) for “*Manually operated exercise equipment; stationary exercise machines*” and “*Gymnasium services; providing fitness and exercise facilities.*” This mark has been suspended based on 2(d) refusals for the pending trademark application for ROCKIT (Ser. No. 85348762) for “*heavy duty playground equipment, namely, climbing walls*” and the existing registration for ROCKIT (Reg. No. 1929244) for “*exercise machines.*”
9. **SPINFOCUS** (Reg. No. 4136952) for “*Digital materials, namely, pre-recorded CDs and DVDs, and downloadable audio and video recordings featuring indoor cycling instruction, exercise instruction, yoga instruction and general fitness instruction.*” This mark registered and will be the subject of a cancellation proceeding if the issue is not amicably resolved between the Applicant and Mad Dogg.
10. **BECOME FIT SPINNING AND SPORTS YOGA** (Ser. No. 77595930) for “*Yoga instruction.*” This mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant.
11. **RHYTHMSPIN** (Ser. No. 85392078) for “*Physical fitness conditioning classes.*” Internet evidence confirmed that this mark refers to indoor cycling. This mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant.
12. **SPIN & TRIM** (Ser. No. 85658595) for “*Pre-recorded CDs, video tapes, laser discs and DVDs featuring physical fitness and exercise instruction; Video recordings featuring physical fitness and exercise instruction*” and “*Education and Entertainment services, namely, providing classes and instruction in the field of fitness and exercise.*” Mad Dogg has requested an extension of time to oppose this application.
13. **SPIN TO THIN** (Ser. No. 85658593) for “*Physical fitness conditioning classes.*” Mad Dogg has requested an extension of time to oppose this application.
14. **SPINCORE** (Ser. No. 85000986) for goods and services for fitness including DVDs, equipment and instruction. A statement of use has been accepted. Mad Dogg is attempting to amicably resolve this matter with the Applicant.
15. **SPIN NATION** (Ser. No. 85260714) for “*Educational services, namely, conducting classes, seminars and workshops in the field of physical fitness and distribution of printed materials in connection therewith in hard copy or electronic format on the same topics.*” This mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant.
16. **SPINDERELLA** (Ser. No. 85612301) for “*Organizing, arranging, and conducting women's cycling events.*” This mark is under review and a non-final action has been issued for collateral matters.

17. **SPYNERGY** (Ser. No. 85612301) for “*Providing fitness and exercise facilities; cycling-oriented, cardio-vascular fitness instruction and training; physical fitness instruction and training; physical fitness consultation.*” This mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant. Significantly, no Office Action was issued despite Mad Dogg’s success in opposing the phonetically equivalent mark SPNERGY for indoor cycles before the Trademark Trial and Appeal Board in *Mad Dogg Athletics, Inc. v. Wen Cheng Hsieh*, Trademark Trial and Appeal Board (Opp. No. 91164860).

**B. Office Actions Issued to Third Party Applications Based on Section 2(e) and Asserting One of Mad Dogg’s Incontestable SPIN Family of Marks As Being Merely Descriptive.**

Here, Office Actions were issued in connection with the following marks; however, rather than citing Mad Dogg’s marks as a bar to registration, the Examining Attorneys prosecuting these marks improperly asserted that Mad Dogg’s incontestable marks were “unregistrable” terms that had to be disclaimed as being descriptive in order for the marks to be approved for publication.

1. **ROCK IT SPIN** (Ser. No. 85277178) for “*Manually operated exercise equipment; stationary exercise machines*” and “*Gymnasium services; providing fitness and exercise facilities.*” As a condition for approving this mark, the Examining Attorney issued a disclaimer requirement, stating:

*Applicant must disclaim the descriptive wording “SPIN” apart from the mark as shown because it merely describes a feature of applicant’s goods and services; mainly, that the goods and services are used in conjunction with “spin class.” See 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a), also see attached Internet evidence for demonstration of the descriptive nature of the term “spin” with respect to fitness goods and services. The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). See TMEP §§1213, 1213.03.*

*Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).*

The computerized printing format for the Office’s Trademark Official Gazette requires a standardized format for a disclaimer.

TMEP §1213.08(a)(i). The following is the standard format used by the Office:

**No claim is made to the exclusive right to use "SPIN" apart from the mark as shown.**

2. **SPIN FOR HUNGER** (Reg. No. 4093964) for "*Services, namely, charitable fundraising for others.*" As a condition for approving this mark, the Examining Attorney issued a disclaimer requirement for "Spin for Hunger" contending the entire phrase is merely descriptive. In support of this contention, the Examining Attorney stated with respect to this special form mark that "*there appears to be the stylized image of a person cycling on an exercise spin bike.*" (Emphasis added.)
3. **BECOME FIT SPINNING AND SPORTS YOGA** (Ser. No. 77595930) for "*Yoga instruction.*" Although this mark was not refused registration under Section 2(e), and the mark was abandoned after Mad Dogg sent a cease-and-desist demand to the Applicant, the prosecution history of the mark notes that the Examining Attorney stated that the "*Applicant wishes to delete the descriptive wording "Spinning & Sports Yoga" from the mark,*" in characterizing a proposed voluntary amendment by the Applicant. (Emphasis added.)
4. **SPINFUSION** (Ser. No. 77680852) for "*Physical fitness conditioning classes.*" This mark was refused registration under Section 2(e). The Examining Attorney stated "*As the attached excerpts taken from the examining attorney's search of the internet indicate, "spin fusion" identifies a particular type of fitness program where spin classes and Pilates are combined.*" (Emphasis added.)
5. **SPINLATES BY HBHM STUDIOS** (Ser. No. 85322348) for "*Physical fitness studio services, namely, providing exercise classes, body sculpting classes, and group fitness classes; Physical fitness studio services, namely, providing group exercise instruction, equipment, and facilities; Providing a website featuring information on exercise and fitness; Providing fitness and exercise studio services, namely, pilates instruction and training; Providing physical fitness and exercise service, namely, indoor cycling and yoga instruction.*" This mark was refused registration under Section 2(e) based on it being descriptive. In doing so, the Examining Attorney stated "*the attached evidence from the Internet shows that SPINLATES refers to an exercise program combining spinning and pilates.*" (Emphasis added.) Significantly, the Examining Attorney made this statement notwithstanding the fact that the Applicant clearly identified the form of activity by its generic name, "indoor cycling."

**C. Office Action Issued Where Mad Dogg's Incontestable SPINNING Mark Was Included in the Description of Goods.**

In this unusual case, an Examining Attorney approved a trademark for registration where the identification of services included Mad Dogg's incontestable SPINNING mark.

1. **SPINNERCISE** (Reg. No. 3902404) for "*Fitness instruction featuring choreography on a stationary spinning bike as an aerobic exercise set to music; providing fitness and exercise facilities.*" The approval of this mark was surprising in that the mark wholly incorporates Mad Dogg's trademark SPINNER (Reg. No. 1972363) for stationary exercise bicycles, which the Board found to be a "strong" mark in *Mad Dogg Athletics, Inc. v. Wen Cheng Hsieh*, Trademark Trial and Appeal Board (Opp. No. 91164860), and because of the oversight in permitting this identification in the registration in derogation of Mad Dogg's rights to its incontestable SPINNING marks for indoor cycling and indoor cycles (Reg. Nos. 1780650, 2003922, and 2424295).

**IV. Mad Dogg's Request.**

Given the volume of trademark applications received by the United States Patent and Trademark Office, and the limited time in which an Examining Attorney has to review a trademark application, it is understandable that errors, omissions, or oversights will occur during the examination process.

That being said, it is clear given the number of applications cited in this correspondence, that Examining Attorneys have strayed from their obligation to review and give deference to Mad Dogg's long-standing and incontestable trademark registrations for its SPIN and SPINNING trademarks.

The failure to cite Mad Dogg's marks during the application process has unnecessarily shifted an undue burden to Mad Dogg to bring its marks to the attention of third party applicants. In doing so, Mad Dogg has been forced to correspond with applicants who have been emboldened by the USPTO's failure to cite its registrations. These applicants invariably contend that no confusion is likely because the Examining Attorney prosecuting their application did not cite any of Mad Dogg's marks. Thus, the failure to cite Mad Dogg's marks under Section 2(d) of the Act has unnecessarily resulted in increased enforcement costs to Mad Dogg and is causing irreparable harm to its brand.

In addition, as the owner of valid and incontestable trademark registrations, there are benefits and presumptions to which Mad Dogg is entitled under the Trademark Act. Mad Dogg believes that it is being unjustly stripped of these rights in instances where Examining Attorneys have refused registration to third party marks based on the contention that the terms "spin" and "spinning" are merely descriptive. Whether intentional or not, this practice amounts to an impermissible collateral attack on Mad Dogg's valid trademark registrations.

Mad Dogg's trademark registrations are "conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. § 1115(b). In other words, "it is conclusively presumed either that the mark is nondescriptive, or if descriptive, has acquired secondary meaning. 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 11:44 at 11-90.16 ("MCCARTHY ON TRADEMARKS") (2007).

Based on their incontestable status, Mad Dogg's SPIN and SPINNING marks are not subject to indirect challenges by Examining Attorneys or by direct challenges by third parties. See, e.g., Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 205 (1985) (an action for infringement of a registered mark that has become incontestable cannot be defended on the ground that the mark is "merely descriptive"); Retail Services, Inc. v. Freebies Publishing, 364 F.3d 535, 70 U.S.P.Q.2d 1603 (4<sup>th</sup> Cir. 2004) ("The validity of the same registered mark, after qualifying for incontestable status, is conclusively presumed and may not be challenged as merely descriptive.").

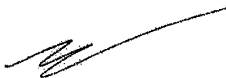
Finally, Mad Dogg's incontestable SPIN and SPINNING trademark registrations clearly prohibit the use of these marks to describe indoor cycles and indoor cycling in third party marks, such as the SPINNERCISE mark (Reg. No. 3902404) referred to above.

Based on the foregoing, Mad Dogg has three simple requests:

1. That Examining Attorneys reviewing third party trademark applications that include Mad Dogg's SPIN and SPINNING trademarks in whole or in part refuse registration of said marks under Section 2(d) of the Act where goods and services related to health and fitness, particularly indoor cycling and group fitness instruction, are involved;
2. That Examining Attorneys stop issuing refusals to third party trademark applications for goods and services related to indoor cycling on the basis that the terms "spin" and "spinning" are merely descriptive under Section 2(e) of the Act; and
3. That Examining Attorneys do not permit third parties to include the terms "spin" or "spinning" in the identification of goods or services for trademark applications relating to indoor cycles or indoor cycling instruction.

Mad Dogg's request is respectfully made to ensure greater consistency in the trademark review process and to ensure that its long-standing and incontestable trademark registrations are given the deference to which they are entitled.

Very truly yours,



Konrad K. Gatien  
Raines Feldman LLP