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

Proceeding	91222837
Party	Defendant Mustapha, Donny
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Submission	Answer
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Signature	/ s / Donald G. Mustapha
Date	08/20/2015
Attachments	(Exhibit A ) Report and Recommendation on CrossFit's Motion to Modify Preliminary Injunction.pdf(116157 bytes ) ( Exhibit B) Memorandum and Order Massachusetts District Judge Dennis Saylor.pdf(24773 bytes ) ( Exhibit C ) CrossFit's Motion for Summary Judgement.pdf(540288 bytes ) Donals G. Mustapha's , Motion to Suspend Proceeding' s Pursuant to Trade-mark Rule 2.117(a).pdf(105447 bytes )

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS

CROSSFIT, INC.,	)	
	)	
Plaintiff,	)	
v.	)	CIVIL ACTION
	)	NO. 13-11498-FDS
DONNY MUSTAPHA, individually,	)	
and d/b/a CHELMSFORD SPORTS	)	
CLUB,	)	
	)	
Defendants.	)	

**REPORT AND RECOMMENDATION ON CROSSFIT’S  
MOTION TO MODIFY PRELIMINARY INJUNCTION**

August 4, 2014

DEIN, U.S.M.J.

**I. INTRODUCTION**

The plaintiff, CrossFit, Inc. (“CrossFit”), has brought this action against Donny Mustapha (“Mustapha”), individually and doing business as the Chelmsford Sports Club (“CSC”), claiming that the defendants infringed upon its registered “CrossFit” trademark.<sup>1</sup> Specifically, CrossFit alleges that it has developed a unique fitness training regimen, which has become the principal strength and conditioning program for thousands of professional and amateur athletes throughout the world, and that it licenses

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<sup>1</sup> Throughout this Report and Recommendation, this court has used the term “trademark” to encompass both trademarks and service marks. “Trademarks serve to identify and distinguish goods; service marks perform the same function for services.” Boston Duck Tours, LP v. Super Duck Tours, LLC, 531 F.3d 1, 12 n.8 (1st Cir. 2008). Although the CrossFit mark at issue is technically a service mark, the distinction makes no difference in the context of this case.

its “CrossFit” mark to entities and individuals who have engaged in specialized training and have entered into written affiliation agreements defining the terms and conditions of their relationship with the plaintiff. It further alleges that CSC, which is owned by Mustapha, has been using the “CrossFit” trademark to advertise and promote its own fitness services even though it is not a CrossFit affiliate and has never been licensed or otherwise authorized to use the plaintiff’s intellectual property. By its complaint, CrossFit has asserted claims against the defendants, pursuant to the Lanham Act, for trademark infringement, false designation of origin, and trademark dilution. It has also asserted a state law claim against the defendants for unfair and deceptive trade practices under Mass. Gen. Laws ch. 93A.<sup>2</sup> Although the defendants were represented by counsel at the start of the litigation, they are presently proceeding pro se.

Pursuant to a Preliminary Injunction Order that was issued by the Court on September 30, 2013 and modified on April 25, 2014, Mustapha and CSC are currently enjoined from using the “CrossFit” trademark, including any substantially similar variation thereof, in connection with the advertising or provision of fitness training services. The matter is presently before the court on “CrossFit’s Motion to Modify Preliminary Injunction” (Docket No. 88), by which CrossFit is seeking to expand the scope of the preliminary injunction so that Mustapha and CSC also are:

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<sup>2</sup> Mustapha asserted counterclaims against CrossFit and third-party claims against various other parties. However, all of those claims have been dismissed. (See Docket No. 145).

- (a) required to delete all references to, and restrained and enjoined from using, “CrossBox,” “CrossKick,” “CrossTrain,” and “Fitness isn’t a sport its [sic] a lifestyle” or substantially similar variations;
- (b) required to replace all references to “Fitness” with “fitness” when adjacent to “Cross” or any word containing the prefix “Cross”; and
- (c) restrained and enjoined from using “Fitness” when adjacent to “Cross” or any word containing the prefix “Cross.”

After careful consideration of the parties’ written submissions and their oral arguments, this court recommends to the District Judge to whom this case is assigned that CrossFit’s motion to modify the preliminary injunction be **ALLOWED IN PART** and **DENIED IN PART**. Specifically, this court recommends that the defendants (1) be required to delete any remaining references to, and be restrained and enjoined from using, “Fitness isn’t a sport its a lifestyle;” (2) be required to replace all references to “Fitness” with “fitness” when adjacent to “Cross”; and (3) be restrained and enjoined from using the word “Fitness” when adjacent to “Cross.” However, because this court finds that the factual circumstances presented at this stage in the litigation do not support CrossFit’s remaining requests for relief, this court recommends that the plaintiff’s motion for a modification otherwise be denied.

## II. FACTUAL BACKGROUND<sup>3</sup>

On September 30, 2013, the Court issued a Preliminary Injunction Order enjoining Mustapha and CSC from using or displaying the “Protected Mark,” which was defined to mean “‘CROSSFIT,’ including any substantially similar variation, such as ‘CrossFit’ or ‘Cross Fit.’” (Docket No. 28 ¶ 1(b)). Specifically, the Order provided in pertinent part:

2. Defendants shall not use or display the Protected Mark in connection with the provision of Fitness Training Services.<sup>4</sup>
3. Defendants shall not use or display the Protected Mark in any Advertisement<sup>5</sup> for Fitness Training Services.
4. Notwithstanding the foregoing, Defendants may use or display the Protected Mark if legally permissible as a nominative fair use. If Defendants intend to make a nominative fair use of the Protected Mark in connection with the provision of Fitness Training Services, they shall provide a copy of each such proposed use to counsel for

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<sup>3</sup> The facts set forth herein are derived from the pleadings filed and orders issued in this case, as well as from the following evidence submitted by the parties at various stages in the litigation: (1) the Affidavit of Mojda Najafi (“Najafi Aff.”) (Docket No. 14); (2) portions of the Affidavit of Donny Mustapha (“Mustapha Aff.”) (Docket No. 19) that have not been stricken by the court; (3) the Affidavit of Zachary C. Kleinsasser (“Kleinsasser Aff. I”) (Docket No. 34); (4) the Affidavit of Zachary C. Kleinsasser in Support of CrossFit’s Motion to Modify Preliminary Injunction (“Kleinsasser Aff. II”) (Docket No. 90); and (5) Exhibit A to the defendants’ Memorandum in Opposition of Plaintiff’s Modification of the Preliminary Injunction (“Def. Ex. A”) (Docket No. 92).

<sup>4</sup> The phrase “Fitness Training Services” is defined in the Preliminary Injunction Order to mean “any training, coaching, or education services concerning physical fitness or exercise.” (Docket No. 28 ¶ 1(c)).

<sup>5</sup> The term “Advertisement” is defined in the Preliminary Injunction Order to mean “any advertisement, flyer, brochure, billboard, display, direct mailing, television commercial, radio commercial, or similar communication of marketing, advertising, sales, or promotional information or materials directed to the general public or segments of the general public.” (Docket No. 28 ¶ 1(d)).

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