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

Proceeding	92056574
Party	Plaintiff Frank Clegg Leatherworks LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Reg. No. 3872561
Date Registered: November 9, 2010

Frank Clegg Leatherworks LLC,

Petitioner,

v.

El Group, LLC,

Respondent.

Cancellation No. 92056574

**AMENDED PETITION FOR
CANCELLATION**

TO: ASSISTANT COMMISSIONER FOR TRADEMARKS
BOX TTAB –FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Petitioner Frank Clegg Leatherworks LLC (“Petitioner”), a limited liability company organized and existing under the laws of the State of Massachusetts, believes that it would be damaged by the continued registration of the above-referenced mark, and hereby petitions to cancel the same. As grounds for this Petition, Petitioner respectfully alleges as follows:

1. Petitioner is a limited liability company organized and existing under the laws of the State of Massachusetts, having a principal place of business at 1 Ace Street, Fall River, Massachusetts 02720.

2. The mark subject to this Petition is LOTUFF & CLEGG, Reg. No. 3872561 (the ‘Respondent’s Mark’) for “All purpose sport bags; All-purpose athletic bags; All-purpose carrying

bags; All-purpose reusable carrying bags; Amenity bags sold empty; Athletic bags; Backpacks, book bags, sports bags, bum bags, wallets and handbags; Bags and holdalls for sports clothing; Beach bags; Book bags; Briefcase-type leather business folders; Briefcases; Canvas shopping bags; Carry-all bags; Carry-on bags; Clutch bags; Cosmetic bags sold empty; Duffel bags; Duffel bags for travel; Duffel bags; Flexible bags for garments; Flight bags; Garment bags for travel; Garment bags for travel made of leather; General purpose bags for holding dance equipment; Gym bags; Hiking bags; Hobo bags; Key cases; Key-cases of leather and skins; Leather and imitation leather bags; Leather and imitation leather sport bags and general purpose trolley bags; Leather bags and wallets; Leather bags, suitcases and wallets; Leather briefcases; Leather cases; Leather cases for keys; Leather credit card cases; Leather credit card holder; Leather credit card wallets; Leather handbags; Leather key cases; Leather key chains; Leather pouches; Leather purses; Leather shopping bags; Luggage; Luggage and trunks; Luggage label holders; Luggage tags; Make-up bags sold empty; Men's clutch bags; Messenger bags; Military duffel bags, garment bags for travel, tote bags, shoulder bags and backpacks; Overnight bags; School bags; School book bags; Shaving bags sold empty; Shoe bags for travel; Shopping bags made of skin; Shoulder bags; Sling bags; Small bags for men; Sport bags; Sports bags; Suit bags; Toiletry bags sold empty; Travel bags; Traveling bags; Travelling bags; Travelling cases of leather; Trunks; Trunks and suitcases. Waist bags; Wallets made of leather or other materials; Wash bags for carrying toiletries; Wheeled bags; Wheeled duffel bags; Wheeled messenger bags; Wheeled shopping bags; Wheeled tote bags' in International Class 018.

3. Said registration matured from application Serial No. 77/938,595, filed on February 18, 2010, based on actual use in United States commerce, with a claimed date of first use of November 25, 2009, and registered on November 9, 2010.

First Ground for Cancellation

(Failure to Obtain Petitioner's Written Consent under Section 2(c) of the Lanham Act)

4. Petitioner is the exclusive owner in the United States of common law rights in the marks FRANK CLEGG, F. CLEGG and FRANK CLEGG LEATHERWORKS for briefcases, bags and related leather goods, and owns USPTO Applications for the marks FRANK CLEGG and F. CLEGG for "Backpacks; Briefcases; Business card cases; Coin purses; Document cases; Duffle bags; Handbags; Leather bags and wallets; Leather purses; Luggage tags; Messenger bags; Tote bags; Wallets" in International Class 018, USPTO Application Serial Nos. 85/677,529 and 85/677,632, respectively (collectively, the "FRANK CLEGG Marks").

5. Petitioner, and its sole member Frank Clegg, have used the FRANK CLEGG Marks in the United States since at least as early as 1976. For more than thirty years, Petitioner and its sole member Frank Clegg have produced, advertised, distributed and sold goods in interstate commerce under the FRANK CLEGG Marks.

6. Petitioner and its sole member Frank Clegg, as well as the FRANK CLEGG Marks, have been well known in the leather goods industry for over thirty years due to Petitioner and Frank Clegg's consistent marketing and sale of leather goods under the FRANK CLEGG Marks to consumers in interstate commerce throughout that time, and because of the high quality of Petitioner's products and workmanship. The names FRANK CLEGG and CLEGG in the leather goods industry are exclusively associated with Frank Clegg, who is a well-known designer and craftsman of leather goods.

7. In 2009, Respondent sought out Frank Clegg to enter into a business relationship with Respondent, wherein Mr. Clegg, through Petitioner, was to design and produce products to be sold through Respondent's website and be marketed by Respondent. The relationship was

never formalized and was ultimately terminated when Petitioner discovered that Respondent was engaged in a concerted, unfairly competitive conspiracy to misappropriate Petitioner's well-known FRANK CLEGG name and goodwill, as well as Petitioner's leather patterns and designs, and to exclude Mr. Clegg and Petitioner from the business.

8. As part of this unfairly competitive scheme, Respondent applied to register Respondent's Mark, which consists of the name of a particular living individual, Frank Clegg, who is Petitioner's sole member, without gaining Frank Clegg's written consent, and indeed without any notification to Mr. Clegg or Petitioner. Specifically, Respondent's Mark, LOTUFF & CLEGG, contains the word CLEGG, which identifies Petitioner's sole member, Frank Clegg. Respondent has admitted that the word CLEGG in Respondent's Mark refers to Frank Clegg numerous times in its marketing materials, as well as in various written correspondence between Respondent and Frank Clegg. Further, Mr. Clegg has made it clear to Respondent and its principals that they cannot use or register any name or mark that contains his surname or full name.

9. Respondent failed to gain Frank Clegg's written consent to the registration of Respondent's Mark, and neither Petitioner nor Frank Clegg consent to Respondent's use or registration of Respondent's Mark or any other mark containing CLEGG for leather bags or related products or services.

Second Ground for Cancellation

(Abandonment under Section 3 of the Lanham Act)

10. Petitioner incorporates Paragraphs 1 through 9 as though alleged fully herein.

11. Upon the termination of Petitioner and Respondent's brief business relationship, Respondent represented to Petitioner that it would not use Frank Clegg's name in connection with

Respondent's business of marketing and selling leather products, and upon information and belief Respondent has ceased all such use and has no intention to resume such use.

12. Further, Respondent has claimed that its use of Respondent's Mark was to be solely in connection with an online business of selling leather briefcases, bags and related products through the website www.lotuffclegg.com. The website www.lotuffclegg.com is not active. Additionally, Respondent's current website, www.lotuffleather.com does not feature any products bearing Respondent's Mark. Upon information and belief, there are no products bearing Respondent's Mark currently being offered for sale in interstate commerce through Respondent's websites or any other means.

13. Because Respondent is not using Respondent's Mark in commerce, and has no intention to resume any such use, Respondent's Mark has lost all capacity as a source indicator for Respondent or any of Respondent's products.

Third Ground for Cancellation

(Likelihood of Confusion under Section 2(d) of the Lanham Act)

14. Petitioner incorporates Paragraphs 1 through 13 as though alleged fully herein.

15. Because Petitioner and its sole member Frank Clegg first used one or more of the FRANK CLEGG Marks on leather briefcases, bags and related products several decades before Respondent filed application Serial No. 77/938,595, or began using Respondent's Mark, and such use by Petitioner and Frank Clegg has been continuous, Petitioner has priority of use.

16. By virtue of Frank Clegg and Petitioner's long, continuous, extensive and exclusive use and marketing, production and sale of, and the consistent sale and purchase of leather briefcases, bags and related products under the FRANK CLEGG Marks, the FRANK CLEGG Marks have come to be recognized by the relevant public as identifying leather

briefcases, bags and related products having their origin in or otherwise associated exclusively with Petitioner.

17. The Respondent's Mark for leather bags and related products is similar to Petitioner's FRANK CLEGG Marks. For example, both marks are comprised of the word CLEGG. Further, Respondent's Mark evokes the same or a highly similar connotation as the FRANK CLEGG Marks, and both marks are used for identical goods, namely leather bags, briefcases and related products. Indeed, the use by Respondent of the CLEGG portion of Respondent's Mark was intended to borrow from the reputation and recognition of the CLEGG name and the FRANK CLEGG Marks. The parties' respective products as sold under their respective marks are marketed to and purchased by the same class of consumers in the same and overlapping trade channels. Accordingly, it is likely that consumers will mistakenly believe that Respondent's Mark for bags and other leather goods is connected to or associated with Petitioner or its FRANK CLEGG, F. CLEGG or FRANK CLEGG LEATHERWORKS leather products.

18. The continued registration of the Respondent's Mark for International Class 018 goods would be inconsistent with Petitioner's rights in its FRANK CLEGG Marks and will cause damage to Petitioner.

WHEREFORE, Petitioner Frank Clegg Leatherworks LLC respectfully prays that federal registration number 3872561 be cancelled.

DATED this 13th day of March, 2014.

Respectfully submitted,

By: 
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Attorneys for Petitioner
Frank Clegg Leatherworks LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing AMENDED PETITION FOR CANCELLATION was served by USPS Priority mail to Registrant and Registrant's attorney at the following addresses:

El Group, LLC
Carriage House
44 East Main Street
Ware, Massachusetts 01082

James C. Duda
Bulkley, Richardson & Gelinas LLP
1500 Main Street, Suite 2700
PO Box 15507
Springfield, MA 01115

Dated: March 13, 2014

By: /s/ Nelda Piper _____
Nelda Piper
Paralegal