

ESTTA Tracking number: **ESTTA612919**

Filing date: **06/30/2014**

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 | Red Frog Events, LLC | | |
| Entity | Limited Liability Company (IL) | Citizenship | Illinois |
| Address | 320 West Ohio Street Suite 1W Chicago, IL 60654 UNITED STATES | | |

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|----------------------|---|--|--|
| Attorney information | Thomas M. Williams Ulmer & Berne LLP 500 West Madison Street Suite 3600 Chicago, IL 60661 UNITED STATES twilliams@ulmer.com, mrink@ulmer.com, ipdocketing@ulmer.com Phone: 312-658-6556 | | |
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Registration Subject to Cancellation

| | | | |
|--------------------------------|---|---------------------------------|------------|
| Registration No | 4423409 | Registration date | 10/29/2013 |
| International Registration No. | NONE | International Registration Date | NONE |
| Registrant | Big Red Frog Limited Dorey Court, Admiral Park St. Peter Port, GY13BG GG | | |

Goods/Services Subject to Cancellation

Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are cancelled, namely: Entertainment services in the nature of providing temporary use of non-downloadable interactive computer games, online electronic games, webisodes, amusement arcade services, pre-recorded performances, live performances and plays to promote a healthy way of life or in the field of education, recreation, entertainment or health and fitness; online electronic games and interactive computer games; organisation of competitions for education or entertainment in the nature of prize give-aways and games via television, radio or a global computer network; providing television and radio programs to promote a healthy way of life or in the field of education, recreation, entertainment or health and fitness; arranging and presenting live and pre-recorded performances and plays; production and presentation of television programs; distribution of television programs for others; rental of television programs that are pre-recorded on video cassette and video discs; production and presentation of motion picture films; distribution of motion picture films for others; rental of motion picture films; production and presentation of sound and video recordings; distribution of sound and video recordings for others; rental of sound and video recordings; arranging and conducting training workshops; arranging and providing recreational activities, namely, activities to promote or, involving, physical activity, including sporting events and fitness and exercise classes; arranging and conducting exhibitions for educational, training and entertainment purposes; conducting fitness and exercise classes or clinics; provision of physical fitness education

and instruction; provision of dietary and health education classes, workshops or seminars; provision of online forums for education and entertainment; publication of magazines and periodicals; publication of educational materials in the nature of books, periodicals and instructional manuals; electronic publishing services, namely, publication of text and graphic works of others on DVDs, compact discs, video and computer gameprogram cartridges in the field of education, recreation, entertainment or health and fitness; provision of studio recording facilities

Grounds for Cancellation

| | |
|-------------|--------------------------|
| Abandonment | Trademark Act section 14 |
| Other | Lack of bona fide intent |

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| Attachments | Red Frog Events v. Big Red Frog - Petition for Cancellation.pdf(19618 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 | /Thomas M. Williams/ |
| Name | Thomas M. Williams |
| Date | 06/30/2014 |

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

| | | |
|-------------------------------------|---|---|
| Registration No. 4,423,409 |) | |
| Registration Date: Oct. 29, 2013 |) | |
| Service Mark: BIG RED FROG & Design |) | |
| RED FROG EVENTS, LLC, |) | |
| Petitioner, |) | <u>PETITION FOR CANCELLATION</u> |
| vs. |) | |
| BIG RED FROG LIMITED |) | |
| Respondent. |) | |

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Red Frog Events, LLC (“Petitioner”), an Illinois limited liability company having its principal place of business in Chicago, Illinois, believes that it is or will be damaged by U.S. Trademark Reg. No. 4,423,409 for the mark BIG RED FROG & Design and hereby petitions to cancel the registration in International Class 41 under Section 44 (15 U.S.C. § 1126) and Section 14(3) (15 U.S.C. § 1064(3)) of the Lanham Act.

As grounds for this Petition, Petitioner alleges that:

1. Petitioner is an Illinois limited liability company having its principal place of business at 320 West Ohio Street, Suite 1W, Chicago, Illinois 60654. Petitioner is the owner of pending U.S. Service Mark Ser. No. 85/534,111 for the mark RED FROG EVENTS, filed on February 4, 2012, and U.S. Service Mark Ser. No. 85/232,240 for the mark RED FROG EVENTS & Design, filed on February 2, 2011. Both pending applications cover “arranging, organizing,

conducting, and hosting social entertainment events” in International Class 41. Both pending applications were filed on an actual use basis under Section 1(a). Petitioner is currently using both service marks in commerce.

2. Respondent Big Red Frog Limited (“Respondent”) is a foreign registrant, a Guernsey company limited by shares, having its principal place of business at Dorey Court, Admiral Park, St. Peter Port GYI3BG, Guernsey. Respondent is the owner of record for U.S. Service Mark Reg. No. 4,423,409 for the mark BIG RED FROG & Design, covering goods and services in four International Classes, including the following services in International Class 41:

Entertainment services in the nature of providing temporary use of non-downloadable interactive computer games, online electronic games, webisodes, amusement arcade services, pre-recorded performances, live performances and plays to promote a healthy way of life or in the field of education, recreation, entertainment or health and fitness; online electronic games and interactive computer games; organisation of competitions for education or entertainment in the nature of prize give-aways and games via television, radio or a global computer network; providing television and radio programs to promote a healthy way of life or in the field of education, recreation, entertainment or health and fitness; arranging and presenting live and pre-recorded performances and plays; production and presentation of television programs; distribution of television programs for others; rental of television programs that are pre-recorded on video cassette and video discs; production and presentation of motion picture films; distribution of motion picture films for others; rental of motion picture films; production and presentation of sound and video recordings; distribution of sound and video recordings for others; rental of sound and video recordings; arranging and conducting training workshops; arranging and providing recreational activities, namely, activities to promote or, involving, physical activity, including sporting events and fitness and exercise classes; arranging and conducting exhibitions for educational, training and entertainment purposes; conducting fitness and exercise classes or clinics; provision of physical fitness education and instruction; provision of dietary and health education classes, workshops or seminars; provision of online forums for education and entertainment. publication of magazines and periodicals; publication of educational materials in the nature of books, periodicals and instructional manuals; electronic publishing services, namely, publication of text and graphic works of others on DVDs, compact discs, video and computer game program cartridges in the field of education, recreation, entertainment or health and fitness; provision of studio recording facilities.

The registration issued under Section 44(e) based on a United Kingdom registration, registration number 2435855, which issued on October 18, 2006.

3. The United States Patent and Trademark Office has issued refusals against Petitioner's pending service mark applications covering RED FROG EVENTS (Ser. No. 85/534,111) and RED FROG EVENTS & Design (Ser. No. 85/232,240), citing Respondent's BIG RED FROG & Design registration (Reg. No. 4,423,409) in International Class 41 as a bar to registration under Section 2(d).

4. Respondent's continuing registration of BIG RED FROG & Design in International Class 41 is likely to cause injury to Petitioner and Petitioner's rights in its RED FROG EVENTS and RED FROG EVENTS & Design marks.

5. Respondent filed the application that matured into the BIG RED FROG & Design service mark at issue (Reg. No. 4,423,409) under Section 44(d) and Section 1(b) on March 7, 2007. Respondent subsequently deleted its Section 1(b) filing basis and amended the application to claim priority to its United Kingdom registration under Section 44(e). The application has never included an assertion of use in U.S. commerce. Upon information and belief, Registrant has never used the mark in U.S. commerce in connection with the identified International Class 41 services.

6. Upon information and belief, Respondent lacked a bona fide intent to use the BIG RED FROG & Design mark in U.S. commerce in connection with the identified Class 41 services at the time it filed the application on March 7, 2007 and at the time it deleted its Section 1(b) filing basis and proceeded solely under Section 44. Respondent's allegation that it had a bona fide intent to use the mark in commerce in connection with Class 41 services was false.

Consequently, the registration should be cancelled in Class 41 based on Respondent's lack of bona fide intent to use the mark in commerce as required under Section 44, 15 U.S.C. § 1126.

7. In March 2014, Respondent filed a "Voluntary Strike Off" from the Guernsey Registry of registered companies in accordance with Section 357 of the Guernsey Companies Law. Upon information and belief, Respondent has ceased operations.

8. Upon information and belief, Respondent has not used, is not using, and has no intent to use or intent to resume use of, the BIG RED FROG & Design service mark (Reg. No. 4,423,409) in commerce in connection with the identified International Class 41 services. The mark has been abandoned pursuant to Section 45, 15 U.S.C. § 1127.

9. For the reasons set forth above, Petitioner believes that it will be damaged by the continued registration of the mark, Reg. No. 4,423,409, in International Class 41. Therefore, the registration should be cancelled in Class 41.

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained and that Reg. No. 4,423,409 be cancelled in Class 41 pursuant to Section 44 (15 U.S.C. § 1126) and Section 14(3) (15 U.S.C. § 1064(3)).

The Director is hereby authorized to charge the filing fee for this Petition for Cancellation, \$300.00, to Deposit Account No. 50-1884.

Dated: June 30, 2014

Respectfully submitted,
ULMER & BERNE, LLP

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*Attorneys for Petitioner,
Red Frog Events, LLC*

CERTIFICATE OF SERVICE

On June 30, 2014, I served the foregoing **PETITION FOR CANCELLATION** on the party in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to Respondent's designated domestic representative as follows:

James R. Robinson
Robinson Law Office,
PLLC
925 Allston Street
Houston, TX 77008

Dated: June 30, 2014

By: /s/ Thomas M. Williams
Thomas M. Williams

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