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

Proceeding no.	92081480
Party	Plaintiff Frank August, LLLP
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	06/30/2023
Attachments	4892-5314-4142 v3 Petition to Cancel BFRANK Design.pdf(210730 bytes)

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

Frank August, LLLP	Cancellation No. 92081480
Petitioner	
v.	
BFRANK, LLC	Registration No. 6,291,012 for BFRANK & Design
Registrant	
	International Class: 25 Registration Date: March 9, 2021

AMENDED PETITION FOR CANCELLATION

Pursuant to 15 U.S.C. § 1064 and 37 C.F.R. §§ 2.111(b), Petitioner, Frank August, LLLP, a Kentucky limited liability limited partnership, with an address of 114 South Third Street, Bardstown, KY 40004, believes it has been and will continue to be damaged by the registration of the mark “BFRANK & Design” (“Registrant’s Mark”) in International Class 25 shown in Registration No. 6,291,012 (the “’012 Registration”) and hereby petitions the Board to cancel the same.

As grounds for cancellation, it is alleged that:

1. Petitioner is the owner of United States Trademark Registration Application Serial No. 974835147 for BE FRANK in International Class 025 for “Hats; Shirts” (“Petitioner’s Goods”).
2. Registrant, BFRANK, LLC, is a Louisiana limited liability company, with a stated address of 61498 Graham Road, Amite, Louisiana 70422.

3. On May 19, 2020, Registrant filed United States Trademark Registration Application Serial No. 88922872 for BFRANK & Design in International Class 025, claiming a bona fide intention to use this mark in connection with: “Hats; Hoodies; Leggings; Pants; Shirts; Shirts and short-sleeved shirts; Socks; Sports bras; Tights; Athletic jackets; Athletic pants; Athletic shirts; Athletic tights; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Body shirts; Gym pants; Jogging pants; Lounge pants; Moisture-wicking sports bras; Moisture-wicking sports shirts; Short-sleeve shirts; Sport shirts; Sports jackets; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports caps and hats; Stretch pants; Sweat jackets; Sweat shirts; T-shirts; Tee shirts; Wind pants; Wind shirts; Women's hats and hoods; Yoga pants; Yoga shirts.”

4. On January 5, 2021, Applicant filed a Statement of Use claiming actual use of the mark in commerce on all of the following goods: “Hats; Hoodies; Leggings; Pants; Shirts; Shirts and short-sleeved shirts; Socks; Sports bras; Tights; Athletic jackets; Athletic pants; Athletic shirts; Athletic tights; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Body shirts; Gym pants; Jogging pants; Lounge pants; Moisture-wicking sports bras; Moisture-wicking sports shirts; Short-sleeve shirts; Sport shirts; Sports jackets; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports caps and hats; Stretch pants; Sweat jackets; Sweat shirts; T-shirts; Tee shirts; Wind pants; Wind shirts; Women's hats and hoods; Yoga pants; Yoga shirts” (“Registrant’s Goods”).

5. As a result of Registrant’s claim of actual use on all listed goods, as required before any registration can issue pursuant to Section 1(a) of the Trademark Act, the ‘012 Registration for the BFRANK & Design mark issued on March 9, 2021.

6. Petitioner's BE FRANK mark of United States Trademark Registration Application Serial No. 97483514 has been refused registration based on the BFRANK & Design mark of the '012 Registration.

7. On information and belief, Registrant did not use Registrant's Mark in commerce in connection with any or all Registrant's Goods prior to May 17, 2021, the end of the first six month period for showing use set in the Notice of Allowance mailed November 17, 2020, so the verified statement made that the mark was in use on all Registrant's goods made in the Statement of Use filed January 15, 2021 was false, and such false statement was relied upon by the U.S. Patent and Trademark Office in issuing the '012 Registration and therefore material to the decision to issue said registration.

8. In the alternative, upon information and belief, Registrant has never used Registrant's Mark in a manner that functions as a trademark under Sections 1, 2, and 45 of the Lanham Act. As shown in the specimen presented to the U.S. Patent and Trademark Office, Registrant's Mark appears on front of a baseball cap:



Registrant's Mark is thus located where ornamental elements often appear on baseball caps in order to provide decoration. Likewise, Registrant's Mark appears on a sweatshirt in a similar manner:



Registrant's Mark also connotes the common expression "be frank," which will be understood as conveying the ordinary, familiar concept associated with that expression ("to speak in a very direct or truthful way"), rather than identifying source. Thus, Registrant's Mark is ornamental, does not provide any source identifying function, and thus fails to function as a trademark.

9. WHEREFORE, Petitioner believes that it will be damaged by the continued registration of Registrant's Mark and requests that the '012 Registration be cancelled.

Please recognize as attorneys for Petitioner in this process Andrew D. Dorisio and the firm Dickinson Wright PLLC at 300 West Vine Street, Suite 1700, Lexington, Kentucky 40507.

Dated: June 30, 2023

Respectfully Submitted,

/s/ Andrew D. Dorisio

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