

ESTTA Tracking number: **ESTTA855702**

Filing date: **11/01/2017**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Chef One Corporation		
Entity	Corporation	Citizenship	New York
Address	513 Irving Avenue Brooklyn, NY 11237 UNITED STATES		

Attorney information	Chull S. Park, Esq. Choi & Park, LLC 23 South Warren Street, 2nd Floor Trenton, NJ 08608 UNITED STATES Email: cpark@choiandpark.com, lkleist@choiandpark.com, hchoi@choiandpark.com, jpatten@choiandpark.com Phone: 609.396.2800
----------------------	---

Registration Subject to Cancellation

Registration No.	4787760	Registration date	08/11/2015
International Registration No.	NONE	International Registration Date	NONE
Registrant	Daesang Corporation 26 (Sinsul-dong), Cheonhodaero, REPUBLIC OF KOREA		

Goods/Services Subject to Cancellation

<p>Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Frozen processed beans; frozen vegetables; vegetable juices for cooking; preserved beans; frozen fruit; meat; eggs; preserved meat; sausages; ham; milk; cheese; milk products excluding ice cream, icemilk, and frozen yogurt; butter; edible oils; sunflower oil for food; maize oil for food; soybean oil for food; palm oil for food; sesame oil for food; olive oil for food; margarine; fish and shellfish, not live, for food; toasted laver; bacon; food products made from meat, namely, meat-based snack foods; pork cutlets; broth; yogurt</p>
<p>Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Flour for food; starch for food; cereal-based snack food; noodles; pizzas; pasta; baking powder; confectionery, namely, pastilles and chips for baking; bread; candy for food; chocolate; sugar; honey; rice cakes; soya sauce; chemical seasonings; fermented soybean paste for use a condiment, namely, known as 'doyn-jang'; chinese soybean paste for use a condiment, namely, known as 'chun-jang'; fermented hot pepper paste for use a condiment, namely, known as 'gochu-jang'; fermented soybean paste for use a condiment, namely, known as 'chonggug-jang'; mayonnaise; vinegar; sauces being condiments; ketchup sauce; starch syrup for food; cinnamon spice; cooking salt; tea; coffee; cocoa; tea-based beverages; curry powder spice; meat tenderizers for household purposes; salad dressing; mustard; hot dogs and-</p>

wiches; barley tea; coffee flavored syrup used in making food beverages; pepper powder spice; ice cream; biscuits; dry cakes; processed cereals; chinese noodles, uncooked, namely, known as 'dang-myun'; preparations made from cereals, namely, wheat bread; cereal-based processed products, namely, processed cereal-based food to be used as a breakfast food, snack food or ingredient for making other foods; spices; breadcrumbs; cake powder; wheat flour


Class 032. First Use: 0 First Use In Commerce: 0

All goods and services in the class are subject to cancellation, namely: Extracts of hops for making beer; non-alcoholic fruit juice beverages; fruit powder for making fruit-based drinks; syrups for making fruit-flavored drinks; non-alcoholic fruit extracts used in the preparation of beverages; apple juice beverages; tomato juice beverages; syrups for beverages; vegetable juice beverages; mineral water; aerated water; drinking water; beer; malt wort; preparations for making effervescent beverages, namely, fruit drinks; non-alcoholic beverages, namely, beverages made from vinegar; vegetable or fruit processed beverages; lemonades


Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
--------------------------------------	---------------------------------------

Marks Cited by Petitioner as Basis for Cancellation


U.S. Registration No.	2573505	Application Date	07/02/2001
Registration Date	05/28/2002	Foreign Priority Date	NONE
Word Mark	CHEF ONE		
Design Mark	 <p style="text-align: center;">C H E F O N E</p>		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1998/07/00 First Use In Commerce: 1999/11/00 Processed food, namely, baked buns, steamed buns, cakes, pastries, dumplings, and dim sum		

U.S. Registration	3472727	Application Date	05/26/2004
-------------------	---------	------------------	------------


No.			
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	CHEF ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 Asian-style frozen food products, namely, dumplings, spring rolls, egg rolls, samosas, wonton appetizers		

U.S. Application No.	87104183	Application Date	07/14/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CHEF ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2002/12/18 First Use In Commerce: 2002/12/18 Asian style frozen foods, namely, noodles, dumplings, spring rolls, egg rolls, samosas, wonton appetizers; noodles and Asian noodles; dumplings; Chinese stuffed dumplings (gyoza, cooked); Korean-style dumplings (mandu); spring rolls; egg rolls; samosas; appetizers, namely, wontons; Asian-style buns; ramen noodles; potstickers; Asian-style sauces and fermented sauces; tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca		

	pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea; sausage rolls; sausage rolls marinated or cooked in Asian-style sauces
--	---

U.S. Registration No.	5146262	Application Date	07/14/2016
Registration Date	02/21/2017	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a sideways fan designed with an alternating pattern of forks and spoons.		
Goods/Services	Class 030. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 Asian style frozen foods, namely, noodles, dumplings, spring rolls, egg rolls, samosas, wonton appetizers; noodles and Asian noodles; dumplings; Chinese stuffed dumplings (gyoza, cooked); Korean-style dumplings (mandu); spring rolls; egg rolls; samosas; appetizers, namely, wontons; Asian-style buns; ramen noodles; potstickers; Asian-style sauces and fermented sauces; tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea; sausage rolls; sausage rolls marinated or cooked in Asian-style sauces		

U.S. Registration No.	5283788	Application Date	07/15/2016
Registration Date	09/12/2017	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of an incomplete circle that's partially shaded with two Chinese characters overlaid atop, within, and slightly extended beyond the incomplete circle and with the entirety of the logo having a brushed calligraphy look.
Goods/Services	Class 030. First use: First Use: 1998/07/01 First Use In Commerce: 1999/11/19 Asian style frozen foods, namely, noodles, dumplings, spring rolls, egg rolls, samosas, wonton appetizers; noodles and Asian noodles; dumplings; Chinese stuffed dumplings (gyoza, cooked); Korean-style dumplings (mandu); spring rolls; egg rolls; samosas; appetizers, namely, wontons; Asian-style buns; ramen noodles; potstickers; Asian-style sauces and fermented sauces; tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea; sausage rolls; sausage rolls marinated or cooked in Asian-style sauces

Attachments	76280767#TMSN.png(bytes) 76594182#TMSN.png(bytes) 87104183#TMSN.png(bytes) 87104314#TMSN.png(bytes) 87106111#TMSN.png(bytes) 109530.pdf(231932 bytes)
-------------	---

Signature	/Chull S. Park/
Name	Chull S. Park, Esq.
Date	11/01/2017

CHOI & PARK, LLC

Attorneys for Petition Chef One Corporation
Hyun Suk Choi, Esq.
(hchoi@choiandpark.com)
Chull S. Park, Esq.
(cpark@choiandpark.com)
23 South Warren Street, 2nd Floor
Trenton, New Jersey 08608
Tel.: 609.396.2800
Fax: 609.396.2801

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

In the Matter of Registration No. 4787760
For the mark: ChefONE
Registered: August 11, 2015

CHEF ONE CORPORATION,

PETITIONER,

V.

DAESONG CORPORATION,

RESPONDENT.

Cancellation No. _____

PETITION FOR CANCELLATION

Chef One Corporation (“Petitioner”), a corporation organized and existing under the laws of the State of New York with a principal place of business at 513 Irving Avenue, Brooklyn, New York 11237, believes that it has been and will continue to be damaged by U.S. Trademark Registration No. 4787760 for the mark “ChefONE” (“Challenged Mark”), and hereby petitions for cancellation of same and as grounds for cancellation, Petitioner alleges as follows:

I. The Parties.

1. Petitioner is a producer of noodles, steamed buns, dumplings, and other Asian-inspired foods (“Goods”) and began distributing the Goods in the United States in 1999 and has since expanded its production and distribution throughout the United States, selling its Goods to restaurants and grocery stores nationwide.

2. Upon information and belief, Respondent Daesong Corporation (“Respondent”) is a Korean corporation with an address of 26 (Sinsuldong), Cheonhodaero, Dongdaemunku, Seoul Republic of Korea and is the owner of the Challenged Mark.

II. Petitioner’s Prior Registrations and Registration of Challenged Mark.

3. On July 2, 2001, Petitioner filed a trademark application for the word mark “Chef One” in combination with a design and Chinese characters, which was registered on May 28, 2002, as U.S. Registration No. 2573505, for goods under international class 30 (“First Chef One Mark”).

4. Petitioner has been using the First Chef One Mark in the United States in connection with the Goods since at least as early as November of 1999.

5. On May 26, 2004, Petitioner filed a trademark application for the word mark “Chef One” in combination with a fan logo consisting of forks and spoons, which was registered on July 22, 2008, as U.S. Registration No. 3472727, for goods under international class 30 (“Second Chef One Mark”).

6. Petitioner has been using the Second Chef One Mark in the United States in connection with the Goods since at least as early as May 2001.

7. On February 6, 2012, while the registrations for the First Chef One Mark and Second Chef One Mark (collectively, “Chef One Marks”) were still alive, Respondent filed its

application to register the Challenged Mark under filing basis 66A, listing a priority date of January 20, 2012, for goods under international classes 29, 30, 45, 46, and 48.

8. On July 8, 2013, the USPTO issued a refusal to register the Challenged Mark based upon likelihood of confusion with the Chef One Marks (“Rejection”).

9. During the pendency of the Respondent’s time to respond to the Rejection, the Chef One Marks were cancelled for failure to file a declaration of use on March 7, 2009 and April 9, 2015, respectively.

10. As a result of the cancellation of the Chef One Marks, the USPTO allowed the Challenged Mark to register.

11. Petitioner inadvertently and by mistake, failed to timely file declarations of use continuing the registration of the Chef One Marks.

12. Despite the cancellation of the Chef One Marks, Petitioner has continued to use the Chef One Marks in interstate commerce in the United States continuously since November 1999 and May 2001, respectively, in connection with the manufacturing, distribution, sale, advertising, and promotion of the Goods.

13. Petitioner has not abandoned the Chef One Marks at any time since their first use in November 1999 and May 2001, and as such, Petitioner has priority.

14. Petitioner has invested and continues to invest considerable time, money and effort to promote and build the reputation of the Chef One Marks throughout the United States and to identify Petitioner as the source of the Goods associated with the Chef One Marks.

15. Petitioner has continuously and exclusively used the Chef One Marks in connection with the sale of the Goods prior to Respondent’s application date of February 6, 2012 and priority date of January 20, 2012.

16. The Chef One Marks are recognized and relied upon by the relevant consumers as identifying Petitioner's Goods, and as distinguishing them from the goods of others, and has come to represent and symbolize valuable goodwill belonging exclusively to Petitioner.

III. Petitioner's Recent Trademark Applications.

17. In July 2016, Petitioner filed the following trademark applications:

- a. Application for word mark "Chef One", Serial No. 87104183 ("Pending Application");
- b. Application for Chinese characters design mark, Serial No. 87106111 ("Chinese Character Mark"); and
- c. Application for fan logo of spoons and forks, Serial No. 87104314 ("Fan Mark").

18. The Fan Mark was accepted and registered on February 21, 2017, U.S. Registration No. 5146262.

19. The Chinese Character Mark was accepted and registered on September 12, 2017, U.S. Registration No. 5283788.

20. On October 26, 2016, the USPTO issued an Office Action refusing the Pending Application to register "Chef One" based upon the likelihood of confusion with the Challenged Mark.

21. Petitioner has been damaged and will continue to be damaged by Respondent's continued registration of the Challenged Mark because (1) the Challenged Mark has prevented registration of "Chef One" under the Pending Application despite Petitioner's prior use of the Chef One Marks and (2) the Challenged Mark is identical to Petitioner's Chef One Marks and the goods identified in the Challenged Mark are the same as the goods provided by Petitioner

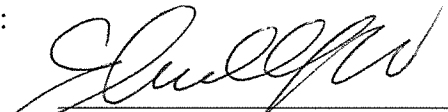
under the Chef One Marks resulting in a likelihood of confusion between the Challenged Mark and the Chef One Marks.

WHEREFORE, Petitioner requests that its petition to cancel Registration No. 4787760 be granted and that the Trademark Trial and Appeal Board grant any and all further relief to Petitioner that the Board finds necessary and just.

Date: November 1, 2017

CHOI & PARK, LLC
Attorneys for Petitioner
Chef One Corporation

By:



Chull S. Park, Esq.

Petitioner appoints as its attorneys in these proceedings Hyun Suk Choi, Esq. and Chull S. Park, Esq. of the firm Choi & Park, LLC to whom all correspondence in this proceeding should be addressed.

Dated: November 1, 2017

CHOI & PARK, LLC
Attorneys for Petitioner
Chef One Corporation

By:


Chull S. Park, Esq.