

ESTTA Tracking number: **ESTTA1153049**

Filing date: **08/13/2021**

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	KP Apparel Group, Inc.		
Entity	Corporation	Citizenship	New York
Address	237 WEST 35TH STREET SUITE 706 NEW YORK, NY 10001 UNITED STATES		
Attorney information	MARK J. ROSENBERG TARTER KRINSKY & DROGIN LLP TARTER KRINSKY & DROGIN LLP 1350 BROADWAY NEW YORK, NY 10018 UNITED STATES Primary Email: mrosenberg@tarterkrinsky.com Secondary Email(s): ashravah@tarterkrinsky.com 2122161127		
Docket Number			

**Registration Subject to Cancellation**

Registration No.	3975111	Registration date	06/07/2011
Registrant	Ventex Co., Ltd. 5F GUM-SUK BLDG. 195-3 CHAMSIL-DONG, SONGPA-GU SEOUL 138-229 REPUBLIC OF KOREA		

**Goods/Services Subject to Cancellation**

Class 024. First Use: 2008/10/20 First Use In Commerce: 2008/10/20 All goods and services in the class are subject to cancellation, namely: Woven fabrics; metal fiber fabrics; synthetic fiber fabrics; laminated, coated and piled fabrics for the manufacture of clothing
Class 025. First Use: 2008/10/20 First Use In Commerce: 2008/10/20 All goods and services in the class are subject to cancellation, namely: Footwear; shoes; kumdo suits (Korean fencing suits); wet suits for water-skiing; anoraks for exercises; aerobics suits; judo suits; Taekwondo suits; swimsuits; bathing trunks; sports shirts; uniforms for exercises; tee-shirts; pants; stockings for exercises; tights; headwear; caps

**Grounds for Cancellation**

Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir.
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	2009)
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Attachments	ICE-FIL Petition to Cancel.PDF(263145 bytes )
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Signature	/Mark J Rosenberg/
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Name	Mark J. Rosenberg
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Date	08/13/2021
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KP APPAREL GROUP, INC.,	)	
	)	
Petitioner,	)	Cancellation No. _____
	)	
v.	)	Registration No. 3,975,111
	)	
VENTEX CO., LTD.,	)	Mark: ICE-FIL and Design
	)	
Registrant.	)	Registration Date: November 27, 2018
	)	

**PETITION FOR CANCELLATION**

1. Petitioner KP Apparel Group, Inc. (“KPA”) is a corporation formed under the laws of the State of New York with a place of business at 237 West 35th Street, Suite 706, New York, NY.

2. According to U.S. Trademark Registration No. 3,975,111 for ICE-FIL and Design for woven fabrics; metal fiber fabrics; synthetic fiber fabrics; laminated, coated and piled fabrics for the manufacture of clothing in Class 24 and footwear; shoes; kumdo suits (Korean fencing suits); wet suits for water-skiing; anoraks for exercises; aerobics suits; judo suits; Taekwondo suits; swimsuits; bathing trunks; sports shirts; uniforms for exercises; tee-shirts; pants; stockings for exercises; tights; headwear; caps in Class 25, (respectively, the “Registration,” the “Registered Mark” and the “Registered Goods”), the registrant, Ventex Co., Ltd., is a corporation formed in the Republic of Korea with an address of 5F Gum-Suk Building, 195-3 Chamsil-dong, Songpa-gu, Seoul, 138-229, Republic of Korea (“Registrant”). A true and correct copy of a printout of the Registration from the United States Patent and Trademark Office (“USPTO”) Internet database is attached hereto as Exhibit A.

3. In an action entitled *IBKUL Corp. v. Dabney, et al.*, No. 20-cv-25193-MGC (S.D. Fla.), Registrant's licensee, IBKUL Corp., has asserted causes of action against KPA and others for trademark infringement under 15 U.S.C. §1114 and unfair competition under 15 U.S.C. §1125(a) both of which are based on KPA's alleged use of a mark that is likely to cause confusion with the Registered Mark. That action is currently pending.

4. As a result of Registrant's assertion of the Registered Mark against KPA, KPA has standing to bring this claim.

5. Upon information and belief, there has never bona fide use in United States commerce of the ICE-FIL and Design Mark that is the subject of the Registration in connection with at least some if not all of the Registered Goods.

6. Specifically, the application for the Registered Mark was filed on an intent-to-use basis under Section 1(b) of the Lanham Act.

7. In a Statement of Use filed on or about September 8, 2010, Registrant, by its president, Kyung Chan Koh, stated that "Applicant is using, or using through a related company, the mark in use in commerce on or in connection with the goods identified in the Notice of Allowance."

8. Upon information and belief, at all relevant times, this statement was false and was submitted for the express purpose of deceiving the USPTO into granting a trademark registration for a design mark that had never been used in United States commerce on or in connection with all or most of the goods identified in the Notice of Allowance.

9. To the best of KPA's knowledge, the ICE-FIL and Design mark that is the subject of the Registration, has never been used by Registrant or a related company on most, if not all, of the goods identified in the Notice of Allowance.

10. The Statement of Use contained the following declaration:

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this Statement of Use on behalf of the applicant; he/she believes the applicant to be the owner of the mark sought to be registered; the mark is now in use in commerce; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

11. In connection with the Statement of Use, Registrant submitted specimens of use that were rejected by the USPTO in an office action dated October 20, 2010 on the grounds that design mark depicted in the specimens did not match the applied for design mark, namely the ICE-FIL and Design mark that is the subject of the Registration.

12. Upon information and belief, the specimens submitted with the Statement of Use did not match the ICE-FIL and Design mark that is the subject of the Registration because at the time it filed the Statement of Use, neither Registrant nor a related company had ever used the ICE-FIL and Design mark on all or most of the goods identified in the Notice of Allowance.

13. On April 20, 2011, Registrant responded to the October 20, 2010 office action by submitting substitute specimens which matched the design mark that is the subject of the Registration.

14. The response to the office action failed to include the required statement for each class of goods that "The substitute specimen was in use in commerce prior to the expiration of the deadline for filing the statement of use." Upon information and belief, the response to the October 20, 2010 office action intentionally omitted that statement because it was not true.

15. In a final office action dated April 21, 2011, the USPTO rejected the substitute specimens because those specimens were not accompanied by a statement for each class of goods that "The substitute specimen was in use in commerce prior to the expiration of the deadline for filing the statement of use."

16. On April 26, 2011, Registrant, in connection with a request for reconsideration after a final office action, submitted to the USPTO a Substitute Specimen Declaration dated April 15, 2011 and signed by Registrant's president Ko Kyoung Chan which stated:

That the substitute specimen(s) submitted herewith to the U.S. Patent and Trademark Office for the above-captioned trademark was in use in commerce in connection with the goods recited in the Notice of Allowance for Classes 24 and 25 since at least as early as September 16, 2010, the expiration date of the time allowed for filing the Statement of Use, and is now in use in such commerce;

That the facts set forth herein are true; and that all statements made of his/her own knowledge are true, and all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application and any registration resulting therefrom.

17. Upon information and belief, these statements are false in that the substitute specimen for the ICE-FIL and Design mark that is the subject of the Registration was not in use in commerce in connection with all or most of the goods recited in the Notice of Allowance for Classes 24 and 25 since at least September 16, 2010. Upon information and belief, these false statements submitted for the express purpose of deceiving the USPTO into granting a trademark registration for a design mark that had never been used in United States commerce on or in connection with all or most of the goods identified in the Notice of Allowance.

18. Relying on these false statements, the USPTO accepted the Notice of Allowance and issued the Registration on June 7, 2011.

19. Upon information and belief, at all relevant times, Registrant knew that the representations in the Statement of Use and Substitute Specimen Declaration regarding the use of the ICE-FIL and design mark in connection with the Registered Goods were false.

20. The false representations in the Statement of Use and Substitute Specimen Declaration were material to the registrability of the ICE-FIL and Design mark.

21. Upon information and belief, in making the material misrepresentations in its Statement of Use and Substitute Specimen Declaration, Registrant acted willfully and intended that the USPTO would be deceived and would rely on the information in registering the ICE-FIL and design mark to cover a broad category of goods when, in fact, such registration should have covered only a narrow category of goods or not have registered at all.

22. Therefore, Petitioner will be damaged by the continued registration of Registrant's U.S. Registration No. 3,975,111 and hereby petitions to cancel the Registration under Section 14 of the Lanham Act, 15 U.S.C. § 1064.

WHEREFORE, Petitioner respectfully requests that the Registration be canceled and that this Petition be sustained in favor of Petitioner.

Dated: August 13, 2021

Tarter Krinsky & Drogin LLP

By: /s/ Mark J. Rosenberg  
Mark J. Rosenberg  
1350 Broadway  
New York, New York 10018  
(212) 216-1127

*Attorneys for Petitioner  
KP Apparel Group, Inc.*

## EXHIBIT A





## United States Patent and Trademark Office

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**Word Mark** ICE-FIL

**Goods and Services** IC 024. US 042 050. G & S: Woven fabrics; metal fiber fabrics; synthetic fiber fabrics; laminated, coated and piled fabrics for the manufacture of clothing. FIRST USE: 20081020. FIRST USE IN COMMERCE: 20081020

IC 025. US 022 039. G & S: Footwear; shoes; kumdo suits (Korean fencing suits); wet suits for water-skiing; anoraks for exercises; aerobics suits; judo suits; Taekwondo suits; swimsuits; bathing trunks; sports shirts; uniforms for exercises; tee-shirts; pants; stockings for exercises; tights; headwear; caps. FIRST USE: 20081020. FIRST USE IN COMMERCE: 20081020

**Mark Drawing Code** (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Serial Number** 77741339

**Filing Date** May 20, 2009

**Current Basis** 1A

**Original Filing Basis** 1B

**Published for Opposition** December 22, 2009

**Registration Number** 3975111

**Registration Date** June 7, 2011

**Owner** (REGISTRANT) Ventex Co., Ltd. CORPORATION REPUBLIC OF KOREA 5F Gum-Suk Bldg. 195-3 Chamsil-dong, Songpa-gu Seoul 138-229 REPUBLIC OF KOREA

**Attorney of Record** Jody H. Drake

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of the stylized word mark "ice-fil".

**Type of** TRADEMARK

**Mark**

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR).

**Live/Dead Indicator** LIVE

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