

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

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ITG BRANDS, LLC, 24 Civ. \_\_\_\_\_

Plaintiff,

**COMPLAINT**

v.

**JURY TRIAL DEMANDED**

FREMADA GOLD, INC.,  
a New York corporation,

Defendant.

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Plaintiff ITG Brands, LLC (“ITGB”) states, upon knowledge with respect to itself and its own actions and upon information and belief with respect to the actions of others, the following for its Complaint against Defendant Fremada Gold, Inc. (“Defendant” or “Fremada”).

**NATURE OF THIS ACTION**

1. This is an action at law and in equity for trademark infringement, dilution, unfair competition, and unfair business practices arising under the Trademark Act of 1946, 15 U.S.C. §§ 1051 et seq. (“Lanham Act”); the fair business practices and unfair and deceptive trade practices acts of New York; and New York common law. Among other relief, ITGB asks this Court to: (a) permanently enjoin Fremada from distributing, marketing, or selling jewelry using or bearing confusingly similar and dilutive imitations of ITGB’s KOOL marks and logos; (b) sustain the Trademark Trial and Appeal Board’s (TTAB) opposition number 91289585 to Fremada’s PTO application Serial No. 97881270<sup>1</sup>; (c) award ITGB monetary damages and to treble that award; (d)

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<sup>1</sup> For the reasons described more fully below, on February 5, 2024, ITGB filed a Notice of Opposition in the United States Patent and Trademark Office before the Trademark Trial and Appeal Board. The Opposition challenges Fremada’s use-based Application to register the mark KOOL JEWELRY & DESIGN, with a design element consisting of Interlocking “os” in the word KOOL, Serial No. 97881270, for *“on-line retail store services featuring gold and silver in the form of jewelry,”* in International Class 35, with April 10, 2023 as the claimed date of first use.

require Fremada to disgorge all of its profits from its sales of jewelry made using confusingly similar and dilutive imitations of ITGB's KOOL marks and logos; and (e) award ITGB punitive damages, attorneys' fees, and costs.

2. For many years, ITGB and its predecessors have continuously and extensively used and promoted its famous KOOL marks in connection with the advertising, distribution, sale, and/or offering for sale of cigarettes. As described more fully below, without ITGB's authorization or consent, and with clear knowledge of ITGB's prior rights in its federally protected KOOL marks, Defendant began to use the confusingly similar and dilutive mark KOOL JEWELRY & Design, as depicted below,



in connection with the advertising, promotion, and online sale of jewelry. Defendant's conduct is likely to mislead the public into believing that Defendant's services and products sold using the mark KOOL JEWELRY & Design are authorized by, sponsored by, or otherwise affiliated with ITGB, its famous and well-known KOOL marks and the goods ITGB makes and sells thereunder. What is exacerbating the likelihood of confusion and dilution of ITGB's famous KOOL marks is the fact that Defendant is using an interlocking OO design element that is nearly identical to the interlocking OO design element in ITGB's famous KOOL marks and logos. ITGB accordingly brings this action to protect its valuable federally protected marks and to halt the damages and

irreparable harm it has suffered and will continue to suffer as a direct and proximate result of Defendant's actions.

### **PARTIES**

3. Plaintiff ITGB is a Texas limited liability company with a place of business at 714 Green Valley Road., Greensboro, North Carolina 27408. ITGB is a subsidiary of Imperial Brands plc, a British multinational company headquartered in Bristol, United Kingdom. ITGB is the owner of all relevant trademark rights associated with KOOL branded cigarettes.

4. Defendant Fremada Gold, Inc. is a corporation organized and existing under the laws of the State of New York and has its principal place of business at 2 West 45th Street, Suite 1605, New York, New York 10036.

### **JURISDICTION AND VENUE**

5. This Court has federal question and subject matter jurisdiction under section 39 of the Lanham Act, 15 U.S.C. § 1121 and under 28 U.S.C. §§ 1331 and 1338. Subject matter jurisdiction over ITGB's related state and common law claims is proper pursuant to 28 U.S.C. §§ 1338 and 1367.

6. This Court has general personal jurisdiction over Fremada because, (a) Fremada's principal place of business is in the State of New York; (b) Fremada regularly transacts and conducts business within the State of New York, including in this District; and (c) the infringing products and/or services at issue have been offered for sale in this District.

7. Venue is proper with respect to Defendant in this district pursuant to 28 U.S.C. § 1391(b)(1) because, on information and belief, Fremada resides in this judicial district, and/or venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 (b)(2) because a substantial part of the events and omissions giving rise to the claims alleged occurred in this

district. In the alternative, venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 (b)(3) because Fremada is subject to the Court's personal jurisdiction.

### **FACTUAL ALLEGATIONS**

8. ITGB is the third largest tobacco company in the United States and offers a broad portfolio of some of the most famous and well-known cigarette, cigar and e-vapor brands. This iconic portfolio of brands includes KOOL cigarettes.

9. KOOL was launched in 1933 and was the first menthol brand to gain nationwide distribution. ITGB and its predecessors have invested substantial time, effort and money in advertising and promoting cigarettes under the KOOL brand throughout the United States. ITGB and its predecessors established, and ITGB has maintained, a strong reputation among adult smokers for quality and consistency in its products. As a result of ITGB's excellent reputation and its investment in its brands, KOOL remains one of the world's most famous brands of menthol cigarettes.

10. KOOL is distinctive among menthol cigarettes because it delivers an intense menthol smoking experience that is bold, yet smooth. KOOL achieves the perfect balance of rich tobaccos with the fresh flavor of menthol.

11. ITGB owns federal registrations of the mark KOOL and solid and outlined versions of the interlocking "Os" in the KOOL logo on the Principal Register of the United States Patent and Trademark Office. These include Registration Nos. 508538, 747482, 2218589, 2578658, and 2617994 of the marks KOOL (stylized), KOOL (word mark), KOOL (logo) and solid and outlined versions of the Interlocking "Os in the KOOL logo, each for cigarettes. The registrations issued April 12, 1949, April 2, 1963, January 19, 1999, June 11, 2002, and September 10, 2002, respectively. True and correct copies of the certificates of these registrations, including the title history showing ITGB as owner of these registrations, are attached hereto as Exhibit 1. These

registrations remain in full force and effect and are conclusive evidence of the validity of the KOOL marks, of ITGB's registration and ownership of the KOOL marks, and of ITGB's exclusive right to use the KOOL marks.

12. Registration Nos. 508,538, 747,482, 2,218,589, 2578658, and 2617994 are prima facie evidence of the validity of and ITGB's exclusive right to use the KOOL marks, and are constructive notice of ITGB's ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act, 15 U.S.C. §§ 1057(b) and 1072. As the right to use the KOOL marks has become incontestable, Registration Nos. 508,538, 747,482, 2,218,589, 2578658, and 2617994 are conclusive evidence of ITGB's exclusive right to use the KOOL Marks shown therein in commerce as provided by §§ 15 and 33(b) of the Federal Trademark Act, 15 U.S.C. §§ 1065 and 1115(b).

13. Together, the marks identified in paragraph 10 are referred to as the "KOOL Marks." Images of the KOOL Marks are reproduced below:



14. ITGB has the exclusive right to use the KOOL Marks in connection with any importation, sale, offer to sell, or distribution of cigarettes and related goods or services in the United States.

15. The KOOL Marks are inherently distinctive and, as a result of ITGB's longstanding use and promotion, the KOOL Marks have become widely recognized by the general consuming public and the trade as a designation of source identifying ITGB and its KOOL brand of cigarettes.

16. As a result of ITGB's continuous and extensive use, sales, advertising and promotions, the KOOL Marks have become extremely valuable and tremendously important assets belonging exclusively to ITGB, symbolizing ITGB's highly successful products and the goodwill appurtenant thereto. The KOOL Marks are well known, highly distinctive and famous, and became famous long before Defendant commenced the actions complained of in this Complaint.

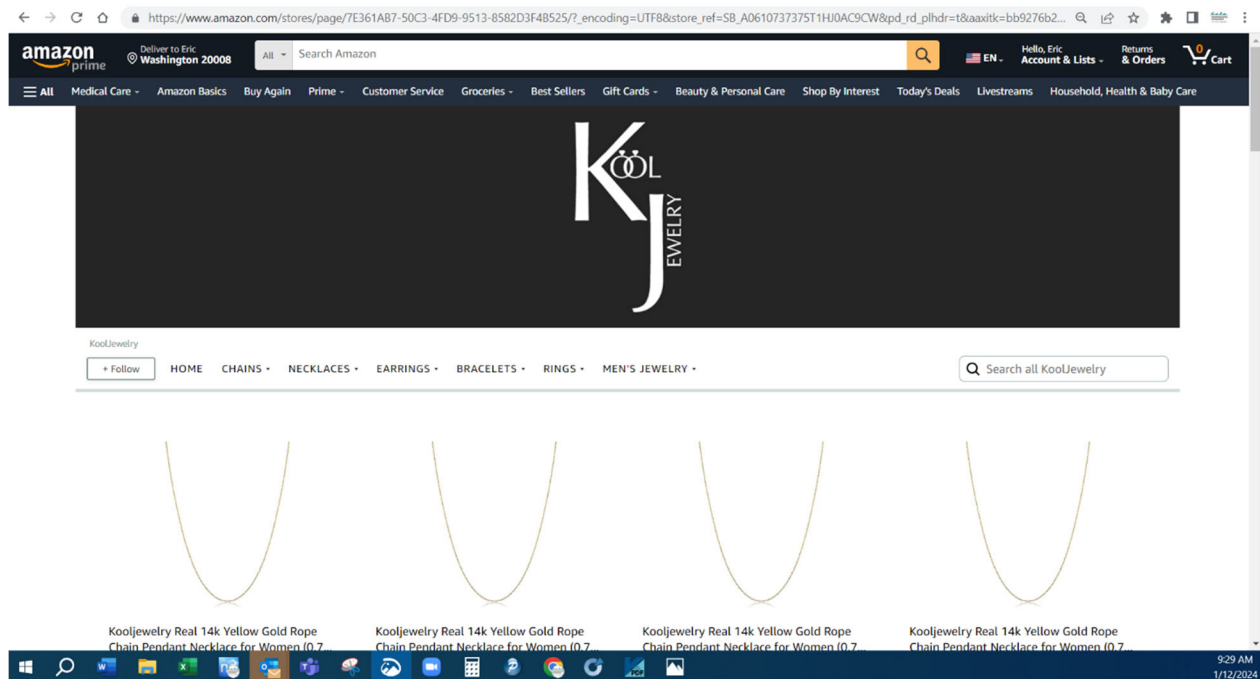
**DEFENDANT'S UNLAWFUL ACTS**

17. Before Defendant commenced the conduct complained of below, Defendant was aware of the existence and fame of the KOOL Marks, of the goodwill represented and symbolized in the KOOL Marks, and of the public recognition and reliance upon the KOOL Marks to identify authentic products of ITGB and distinguish ITGB's goods and services from those of others.

18. In what appears to be an obvious attempt to capitalize on the renown of ITGB's KOOL Marks, Defendant advertises, promotes, distributes, imports, sells and/or offers for sale jewelry under the mark KOOL JEWELRY in the form shown below:



(“KOOL JEWELRY Logo”). The KOOL JEWELRY Logo appears on Defendant's Amazon storefront at: <https://www.amazon.com/stores/page/8DFB723D-5F56-4F9A-8C63-1E1FDBEE2524>.



19. The KOOL JEWELRY Logo contains interlocking “OOs” which mimic the interlocking “OOs” in ITGB’s famous KOOL Marks.

20. Defendant advertised, promoted, distributed, imported, sold and/or offered for sale jewelry under the KOOL JEWELRY Logo, which is highly similar to the KOOL Marks, and has obtained substantial profits thereby. Such advertisement, distribution, sales and profits are ongoing as of the date of this Complaint.

21. On April 10, 2023, Defendant filed an application with the U.S. Patent and Trademark Office, seeking registration of the KOOL JEWELRY Logo for “on-line retail store services featuring gold and silver in the form of jewelry.” This application was filed under Serial No. 97881270 based on Defendant’s use of the KOOL JEWELRY Logo in commerce.

22. Upon information and belief, for many years prior to April 10, 2023 (i.e., since at least as early as January 18, 2004) Defendant used the following form of the mark KOOL JEWELRY for online retail store services featuring fine gold and silver:

**KoolJewelrÿ**

23. This form of the KOOL JEWELRY mark was the subject of Application No. 97205808, which was filed by Defendant on January 6, 2022, but abandoned on May 17, 2023, as a result of Defendant's failure to respond to an Office Action. Importantly, ITGB does not object to Defendant's use and registration of this form of the mark since it does not include ITGB's interlocking OOs that are such an iconic design element of ITGB's KOOL Marks.

24. On January 10, 2024, after learning of Defendant's advertising, promotion, distribution, importation, sale, and/or offering for sale of jewelry and other related products and services under the infringing and diluting KOOL JEWELRY Logo, ITGB sent Defendant's trademark counsel a letter demanding Defendant cease and desist the use of the KOOL JEWELRY Logo shown in Application No. 97881270 in connection with the online sale of jewelry. ITGB made its position clear that Defendant cease and desist any and all use of any KOOL mark that includes interlocking "OOs", that it abandon Application No. 97881270, and that it refrain from using any mark and filing any applications to register marks containing interlocking "OOs" in the future. A true and correct copy of the January 10, 2024, letter from ITGB to Defendant's counsel, is attached hereto as Exhibit 2. Despite receipt of ITGB's correspondence, Defendant has refused to comply with ITGB's requests.

25. By using the KOOL JEWELRY Logo, Defendant intends to trade off the strong consumer goodwill in ITGB's KOOL Marks.



26. There is no association or affiliation of any kind between ITGB and Defendant, and Defendant is using the KOOL JEWELRY Logo without ITGB's permission or consent. ITGB has no control over the manner of Defendant's use of the KOOL JEWELRY Logo, or the nature or quality of any products promoted, advertised, distributed, imported, sold and/or offered for sale by Defendant.

27. Defendant's actions have caused, or are likely to cause, great and irreparable injury to ITGB, including irreparable injury to its goodwill and reputation, for which ITGB has no adequate remedy at law.

28. Defendant's use of the KOOL JEWELRY Logo in connection with the online sale of jewelry has the potential to diminish adult consumer opinion of ITGB's KOOL Marks and KOOL brand cigarettes by associating them with potentially inferior products and services.

29. Defendant will continue to commit the acts complained of unless enjoined.

30. As a direct and proximate result of Defendant's conduct, ITGB has suffered and continues to suffer great and irreparable injury. ITGB has no adequate remedy at law.

31. Defendant's acts were deliberately and intentionally carried out in bad faith, or with reckless disregard for or with willful blindness to ITGB's rights in the KOOL Marks, for the purpose of trading on ITGB's reputation and diluting the KOOL Marks.

### **CLAIMS FOR RELIEF**

#### **FIRST CLAIM FOR RELIEF FOR TRADEMARK INFRINGEMENT UNDER THE LANHAM ACT (15 U.S.C. § 1114)**

32. ITGB repeats and incorporates by reference the allegations in the preceding paragraphs.

33. Defendant's use of confusingly similar imitations of ITGB's KOOL Marks is likely to cause confusion, deception, and mistake by creating the false and misleading impression that

the jewelry sold, and retail services provided by Defendant are manufactured, distributed, and/or offered by ITGB, or are associated or connected with ITGB, or have the sponsorship, endorsement, or approval of ITGB.

34. Defendant is using a mark confusingly similar to ITGB's federally registered marks in violation of 15 U.S.C. §§ 1114 and 1125(a). Defendant's activities have caused and, unless enjoined by this Court, will continue to cause a likelihood of confusion and deception of members of the trade and public, and, additionally, injury to ITGB's goodwill and reputation as symbolized by ITGB's KOOL Marks, for which ITGB has no adequate remedy at law.

35. Defendant has unfairly profited from its acts of trademark infringement.

36. Defendant's actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with ITGB's KOOL Marks to ITGB's great and irreparable harm.

37. Defendant has caused and is likely to continue causing substantial injury to the public and to ITGB; therefore, ITGB is entitled to injunctive relief and to recover Defendant's profits, actual damages, enhanced profits and damages, costs, and reasonable attorneys' fees under 15 U.S.C. §§ 1114, 1116, and 1117.

**SECOND CLAIM FOR RELIEF  
FOR UNFAIR COMPETITION UNDER THE LANHAM ACT  
(15 U.S.C. § 1125(a))**

38. ITGB repeats and incorporates by reference the allegations in the preceding paragraphs.

39. Defendant's use of confusingly similar imitations of ITGB's KOOL Marks has caused and is likely to continue to cause confusion, deception, and mistake by creating the false and misleading impression that Defendant's jewelry and services are manufactured, distributed and/or offered by ITGB, or are affiliated, connected, or associated with ITGB, or have the sponsorship, endorsement, or approval of ITGB.

40. Defendant has made false representations, false descriptions, and false designations of its jewelry and services in violation of 15 U.S.C. § 1125(a). Defendant's activities have caused and, unless enjoined by this Court, will continue to cause a likelihood of confusion and deception of members of the trade and public, as well as injury to ITGB's goodwill and reputation as symbolized by ITGB's KOOL Marks, for which ITGB has no adequate remedy at law.

41. Defendant's actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with ITGB's KOOL Marks to the great and irreparable injury of ITGB.

42. Defendant's conduct has caused, and is likely to continue causing, substantial injury to the public and to ITGB. ITGB is entitled to injunctive relief and to recover Defendant's profits, actual damages, enhanced profits and damages, costs, and reasonable attorneys' fees under 15 U.S.C. §§ 1125(a), 1116, and 1117.

**THIRD CLAIM FOR RELIEF  
FOR TRADEMARK DILUTION UNDER THE LANHAM ACT  
(15 U.S.C. § 1125(c))**

43. ITGB repeats and incorporates by reference the allegations in the preceding paragraphs.

44. For more than ninety (90) years, ITGB has exclusively and continuously promoted and used its registered KOOL Marks in the United States. The KOOL Marks became a famous and well-known symbol of ITGB and its products among the general public in the United States well before Defendant began advertising, promoting, distributing, selling, or offering for sale jewelry under the KOOL JEWELRY Logo.

45. Defendant is making use in commerce of confusingly similar imitations of ITGB's famous KOOL Marks that dilute and are likely to dilute the distinctiveness of ITGB's famous KOOL Marks by eroding the public's exclusive identification of this famous mark with ITGB, and

otherwise lessening the capacity of the famous KOOL Marks to identify and distinguish ITGB's goods.

46. Defendant's actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with ITGB's KOOL Marks or to cause dilution of the mark to the great and irreparable injury of ITGB.

47. Defendant has caused and, unless enjoined by this Court, will continue to cause irreparable injury to ITGB's goodwill and business reputation, and dilution of the distinctiveness and value of ITGB's famous KOOL Marks in violation of 15 U.S.C. § 1125(c). ITGB therefore is entitled to injunctive relief and to Defendant's profits, actual damages, enhanced profits and damages, costs, and reasonable attorneys' fees under 15 U.S.C. §§ 1125(c), 1116, and 1117.

**FOURTH CLAIM FOR RELIEF FOR  
INJURY TO BUSINESS REPUTATION AND DILUTION  
UNDER NEW YORK LAW  
(N.Y. GEN. BUS. LAW § 360-L)**

48. ITGB repeats and incorporates by reference the allegations in the preceding paragraphs.

49. For more than ninety (90) years, ITGB has exclusively and continuously promoted and used its registered KOOL Marks in New York and the United States. The KOOL Marks became a famous and extremely well-known symbol of ITGB and its products among the general public in New York and the United States well before Defendant began advertising, promoting, distributing, selling, or offering for sale jewelry under the KOOL JEWELRY Logo. The KOOL Marks are strong and have a "distinctive quality" within the meaning of New York General Business Law §360-1.

50. Defendant is making use in commerce in New York of confusingly similar imitations of ITGB's famous KOOL Marks that blur and dilute and are likely to blur and dilute

the distinctiveness of ITGB's famous KOOL Marks by eroding the public's exclusive identification of this famous mark with ITGB and otherwise lessening the capacity of the famous KOOL Marks to identify and distinguish ITGB's goods.

51. Defendant's actions demonstrate an intentional, willful, and malicious intent to trade on the goodwill associated with ITGB's KOOL Marks or to cause blurring and dilution of the mark to the great and irreparable injury of ITGB.

52. Defendant has caused and, unless enjoined by this Court, will continue to cause irreparable injury to ITGB's goodwill and business reputation, and blurring and dilution of the distinctiveness and value of ITGB's famous KOOL Marks in violation of the New York Injury to Business Reputation and Dilution Act, N.Y. Gen. Bus. Law § 360-1 (2009).

53. ITGB, therefore, is entitled to injunctive relief, damages, and costs, as well as, if appropriate, enhanced damages, punitive damages, and reasonable attorneys' fees.

**FIFTH CLAIM FOR RELIEF FOR  
NEW YORK COMMON LAW TRADEMARK INFRINGEMENT  
AND UNFAIR COMPETITION**

54. ITGB repeats and incorporates by reference the allegations in the preceding paragraphs.

55. Defendant's use in commerce in New York of confusingly similar imitations of ITGB's famous KOOL Marks constitute New York common law trademark infringement and unfair competition, and have created and will continue to create, unless enjoined by this Court, a likelihood of confusion to the irreparable injury of ITGB. ITGB has no adequate remedy at law for this injury.

56. Defendant acted with full knowledge of ITGB's use of, and statutory and common law rights to, the KOOL Marks and without regard to the likelihood of confusion of the public created by Defendant's activities.

57. Defendant's actions demonstrate an intentional, willful, and malicious intent to deceive, cause confusion, and trade on the goodwill associated with ITGB's KOOL Marks to the great and irreparable injury of ITGB. Defendant's conduct is in bad faith.

58. As a direct and proximate result of Defendant's actions, ITGB has been damaged in an amount not yet determined or ascertainable. At a minimum, however, ITGB is entitled to injunctive relief, to an accounting of Defendant's profits, damages, and costs. Further, in light of Defendant's deliberate and malicious use of confusingly similar imitations of ITGB's KOOL Marks and the need to deter Defendant from engaging in similar conduct in the future, ITGB additionally is entitled to punitive damages.

**SIXTH CLAIM FOR RELIEF FOR  
INJURY DUE TO DECEPTIVE PRACTICES  
UNDER NEW YORK LAW  
(N.Y. GEN. BUS. LAW § 349)**

59. ITGB repeats and incorporates by reference the allegations in the preceding paragraphs.

60. Defendant engaged in consumer-oriented conduct by advertising and selling its products to consumers. Defendant is attempting to deceive or mislead the public into believing that Defendant's services and products sold using the mark KOOL JEWELRY & Design are authorized by, sponsored by, or otherwise affiliated with ITGB, its famous and well-known KOOL marks and the goods ITGB makes and sells thereunder.

61. Defendant's actions were materially misleading and were designed to deceive and cause confusion with ITGB's KOOL Marks.

62. As a direct and proximate result of Defendant's actions, ITGB has been damaged in an amount not yet determined. ITGB is thus entitled to injunctive relief.

63. Defendant willfully and/or knowingly committed its illicit actions in violation of N.Y. Gen. Bus. Law § 349. ITGB is therefore also entitled to an award of up to treble damages, to the extent applicable.

**PRAYER FOR RELIEF**

**WHEREFORE**, ITGB prays that:

1. Defendant and all of its agents, officers, employees, representatives, successors, assigns, attorneys, and all other persons acting for, with, by through or under authority from Defendant, or in concert or participation with Defendant, and each of them, be enjoined permanently from:

- a. using the KOOL Marks or any other copy, reproduction, colorable imitation, or simulation of ITGB's KOOL Marks on or in connection with jewelry and the retail sale thereof;
- b. passing off, palming off, or assisting in the passing off or palming off the Defendant's jewelry and services as that of ITGB, or otherwise continuing any and all acts of unfair competition as alleged in this Complaint; and
- c. advertising, promoting, offering for sale, or selling jewelry or other goods bearing confusingly similar imitations of ITGB's Marks.

2. Defendant be ordered to cease offering for sale, marketing, promoting, and selling and to recall all jewelry sold under or bearing any confusingly similar imitations of ITGB's KOOL Marks that are in Defendant's possession, custody, or control, or have been shipped by Defendant or under its authority, to any customer, including but not limited to, any wholesaler, distributor, retailer, consignor, or marketer, and also to deliver to each such customer a copy of this Court's order as it relates to said injunctive relief against Defendant;

3. Defendant be ordered to deliver up for impoundment and for destruction, all jewelry, signs, advertising, sample books, promotional materials, or other materials in the possession, custody, or control of Defendant that are found to adopt, infringe, or dilute ITGB's KOOL Marks or that otherwise unfairly compete with ITGB and its products;

4. The Court sustain TTAB opposition number 91289585 to Defendant's PTO application, Serial No. 97881270;

5. Defendant be compelled to account to ITGB for any and all profits derived by Defendant from the sale or distribution of jewelry as described in this Complaint;

6. ITGB be awarded all damages caused by the acts forming the basis of this Complaint, including lost profits, a reasonable royalty, and/or corrective advertising;

7. Based on Defendant's knowing and intentional use of confusingly similar imitations of ITGB's KOOL Marks, the damages awarded be trebled and the award of Defendant's profits be enhanced as provided for by 15 U.S.C. § 1117(a) and state law;

8. Defendant be required to pay to ITGB the costs of this action and ITGB's reasonable attorneys' fees pursuant to 15 U.S.C. § 1117(a) and state law;

9. Defendant be required to pay damages to ITGB (including treble damages to the extent applicable) and reasonable attorneys' fees under NY GBL Section 349;

10. Based on Defendant's willful and deliberate infringement and/or dilution of ITGB's KOOL Marks, and to deter such conduct in the future, ITGB be awarded punitive damages;

11. ITGB be awarded prejudgment and post-judgment interest on all monetary awards;  
and

12. ITGB have such other and further relief as the Court may deem just.



**JURY TRIAL DEMAND**

ITGB respectfully demands a trial by jury on all claims and issues so triable.

DATED: February 5, 2024

COHEN TAUBER SPIEVACK & WAGNER, PC

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