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

Proceeding	91220321
Party	Defendant Primal Nutrition, Inc.
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Submission	Motion to Suspend for Civil Action
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Date	08/26/2015
Attachments	Applicant's Motion to Suspend Proceedings Until Termination of the Civil Action.pdf(1602297 bytes)

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

IN THE MATTER OF TRADEMARK SERIAL NO. 85/150,072

Primal Kitchen LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No.: 91220321
)	
Primal Nutrition, Inc.,)	
)	
Applicant.)	
)	
)	

**APPLICANT’S MOTION TO SUSPEND PROCEEDINGS UNTIL TERMINATION OF THE CIVIL
ACTION**

Applicant, Primal Nutrition, Inc. by its undersigned counsel, moves to suspend the proceedings in the above-captioned opposition pending the disposition of a civil action between the same parties and the same mark at issue, which raises the same issues of fact and law. This motion is brought in accordance with Trademark Rule 2.117(a) (37 C.F.R. §2.117(a)) and Trademark Board Manual of Procedure (“TBMP”) §510.02(a). As grounds for this motion, Applicant states as follows.

FACTS

On January 19, 2015, Opposer Primal Kitchen LLC filed a Notice of Opposition No. 91220321 (“Opposition”) to Applicant’s U.S. Serial No. 85/150,072 for the mark PRIMAL

KITCHEN (“the ‘072 application”), asserting that the U.S. Trademark Office should deny registration of the mark based upon priority and a likelihood of confusion under Trademark Act Section 2(d) with Opposer’s mark PRIMAL KITCHEN. Opposer cited its pending application, U.S. Serial No. 86/390,627 for PRIMAL KITCHEN (“the ‘627 application”), as the basis for the opposition. See Notice of Opposition, TTABVUE Prosecution History #1.

On August 21, 2015, Applicant Primal Nutrition filed a civil action against Opposer Primal Kitchen LLC in the United States District Court for the Central District of California (the “Civil Action”), seeking a declaration that Primal Nutrition’s PRIMAL KITCHEN mark, for use in connection with the goods and services in the ‘072 application at issue in this Opposition proceeding was not likely to cause consumer confusion and therefore does not infringe Opposer’s rights in its PRIMAL KITCHEN mark in connection with the goods and services listed in the ‘627 application. See Complaint for Declaratory Judgment, *Primal Nutrition, Inc. v. Primal Kitchen LLC*, Civil Action No. 2:15-cv-06387-CAS, attached as Exhibit A.

Applicant requests that the Opposition be suspended pending the outcome of the Civil Action because the Opposition seeks to address the same claims that are set forth in the Civil Action and the Civil Action has a bearing on the Opposition.

ARGUMENT

It is standard procedure for the Board to suspend proceedings before it pending the outcome of a civil action between the same parties involving related issues where the civil action has a bearing on the Board proceeding. See 37 C.F.R. §2.117(a); 6 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, §32:47 (citing *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412

(C.C.P.A. 1961); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 1971 WL16554 (TTAB 1971)). Specifically, the TBMP provides that the “most common” requests to suspend concern a proceeding where a civil action is pending between the same parties in a federal district court. TBMP §510.02(a). Also, “unless there are unusual circumstances, the Board will suspend proceedings in the case before it if the final determination of the other proceeding may have a bearing on the issues before the Board.” TBMP §510.01(a); *Other Telephone Co. v. Connecticut National Telephone Co.*, 181 USPQ 125, 126-7 (TTAB 1974) (decision in civil action for infringement and unfair competition would have bearing on outcome of Trademark Act §2(d) claim before the board). The fact that a civil action is filed after the Board proceeding does not change this analysis. McCarthy § 32:47 (citing *Midland Cooperatives, Inc. v. Midland Int’l Corp.*, 421 F.2d 754, 755-56 (C.C.P.A. 1970)).

Suspension of this proceeding pending the outcome of the Civil Action is proper because the Central District of California’s decision in that action “will have a bearing on the issues before the Board” as required by the Trademark Rules 2.117 (37 C.F.R. §2.117(a)). Both proceedings involve the same parties, the same disputed issues, namely, the likelihood of confusion between the parties’ respective marks, and the same marks. There are no unusual circumstances that warrant a decision otherwise, and Applicant’s request is the most common type of request to suspend that is granted by the Board.

The District Court’s decision in the Civil Action will be dispositive, and where the decision by the court will be dispositive of the issues before the Board, a “motion to suspend is well taken.” See *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992), *abrogation on other grounds recognized by Gaylord Enter. Co. v. Calvin Gilmore Prod., Inc.*, 59 USPQ2d 1369 (TTAB 2000); see also *Kearns-Tribune, LLC v. Salt Lake Tribune*

Publ'g Co., LLC, Opp. No. 151,843, 2003 WL 221324916, at *3 (TTAB Sept. 11, 2003) (citing *General Motors Corp.* and suspension proceeding where outcome of civil action “may have a bearing on the issues before the Board”); *Society of Mexican Am. Engineers and Scientists, Inc. v. GVR Public Relations Agency, Inc.*, Opp. No. 121,723, 2002 WL 31488947, at *4 (TTAB Nov. 6, 2002) (same). Accordingly, suspension of the instant Opposition is warranted because the final determination of the Civil Action has a bearing on the issues before the Board.

For all of the above reasons, Applicant Primal Nutrition requests that the Board suspend the instant Opposition proceeding pending the disposition of the Civil Action filed with the United States District Court.

Respectfully submitted,

CISLO & THOMAS LLP

A handwritten signature in blue ink, appearing to be 'D. M. Cislo', written over a horizontal line.

Dated: August 26, 2015

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Exhibit A

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6 Attorneys for Plaintiff,
PRIMAL NUTRITION, INC.

7
8 **UNITED STATES DISTRICT COURT**
9 **CENTRAL DISTRICT OF CALIFORNIA**

10
11 PRIMAL NUTRITION, INC., a
California corporation,

12 Plaintiff,

13 vs.

14
15 PRIMAL KITCHEN LLC, a
Washington Limited Liability company,

16 Defendant.
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28

) Case No.

) **COMPLAINT FOR
DECLARATORY JUDGMENT OF
NONINFRINGEMENT OF A
TRADEMARK**

1 For its Complaint, Plaintiff, Primal Nutrition, Inc., alleges as follows:
2

3 **NATURE OF THE ACTION**
4

5 1. This action arises under the Lanham Act, 15 U.S.C. §§ 1051 et seq.
6 and the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201–02. This is an action
7 for declaratory judgment and relief for an actual controversy between the parties
8 and seeks the remedies and relief provided in 28 U.S.C. §§ 2201–02 and 15 U.S.C.
9 §§ 1051 et seq.
10

11 **PARTIES**
12

13 2. Plaintiff Primal Nutrition, Inc. (“Plaintiff” or “Primal Nutrition”) is a
14 California corporation having its principal place of business at 6202 Ramirez Mesa
15 Drive, Malibu, California 90265.
16

17 3. Defendant Primal Kitchen, LLC (“Defendant” or “PK”) is a
18 Washington Limited Liability Company having offices at 6077 K.C. SE, Port
19 Orchard, Washington 98367.
20

21 **JURISDICTION AND VENUE**
22

23 4. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1121,
24 1331, and 1338(a) as it arises under Acts of Congress related to trademarks and the
25 Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201–02.
26

27 5. This Court has personal jurisdiction over PK since PK operates the
28 highly interactive e-commerce website, www.primalkitchencompany.com, that is

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1 accessible to residents of this judicial district, and that offers for sale the goods and
2 services claimed by PK under its PRIMAL KITCHEN trademark to residents of
3 this judicial district. Also, PK offers for sale and sells goods through Amazon.com
4 under the name PRIMAL KITCHEN. It is believed that PK has sold and is selling
5 products, and has provided and is providing goods and services, to customers in this
6 judicial district by way of Amazon.com, as well as other e-commerce websites such
7 as Etsy, Food52, and Scoutmob. In addition, on its own website, PK does not
8 appear to place any limitations on where it will ship its products; and, on
9 information and belief, PK has sold and shipped its products to residents of this
10 judicial district. Furthermore, on information and belief, there exist users of, and
11 visitors to, PK’s website who reside in this judicial district, and PK uses or places
12 “cookies” on such users’ and/or visitors’ computers when such users and/or visitors
13 visit PK’s website. Still further, in the Terms and Conditions section of PK’s
14 website, PK states that the applicable law and proper venue relative to any dispute
15 is to be determined by the user’s location:

16
17 “Applicable laws (choice of venue and forum)—Use of
18 this website shall in all respects be governed by the laws
19 of the state of [insert your state], U.S., regardless of the
20 laws that might be applicable under principles of conflicts
21 of law. The parties agree that the [insert state] courts
22 located in [insert county] county, [insert state], shall have
23 exclusive jurisdiction over all controversies arising under
24 this agreement and agree that venue is proper in those
25 courts.”

26 ///

27 ///

28 ///

1 Thus, PK is taking advantage of the benefits and protections offered by the user's
2 state, including California and this judicial district, where, on information and
3 belief, numerous users of PK's website are located.
4

5 6. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b)
6 as a substantial amount of the events giving rise to the declaratory judgment claim
7 occurred in this judicial district.
8

9 **FACTUAL ALLEGATIONS**
10

11 7. Plaintiff Primal Nutrition is a California corporation located in Malibu,
12 California. Primal Nutrition is a company devoted to health education and
13 designing state-of-the-art supplements that address the challenges of living in the
14 modern world. Primal Nutrition was founded by Mark Sisson, the author of a
15 number one best-selling health book called The Primal Blueprint along with other
16 books including The Primal Blueprint Cookbook, and other titles, and provides a
17 health and fitness blog, MarksDailyApple.com. Primal Nutrition's mission is to
18 empower people to take responsibility for their own health and enjoyment of life by
19 investigating, discussing, and critically rethinking everything we've assumed to be
20 true about health and wellness. Primal Nutrition's PRIMAL KITCHEN expands
21 this mission, bringing uncompromisingly delicious, high quality, nutrient-dense
22 sauces and dressings to kitchens everywhere. In the world of real food, it's often
23 what you put on your food that keeps it interesting.
24

25 8. On December 20, 2013, Primal Nutrition filed a U.S. Trademark
26 Application for PRIMAL KITCHEN based upon an intent to use the mark in
27 connection with Pre-packed food products, namely, meal replacements, namely,
28 nutritional supplement meal replacement bars, and energy bars, namely, nutritional

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1 supplement energy bars in International Class 5, Pre-packed food products, namely,
2 sauces, namely, cranberry sauces, meal replacements, namely, fruit-based meal
3 replacement bars, and snack foods, namely, meat-based snack foods, fruit-based
4 snack food, nut and seed based snack food, vegetable based snack food, dairy based
5 snack food excluding ice cream, ice milk and frozen yogurt, potato based snack
6 food in International Class 29, and Pre-packed food products, namely, condiments,
7 namely, mustard, mayonnaise, ketchup, horseradish, salad dressings, sauces,
8 namely, barbeque sauce, chicken wing sauce, chili sauce, chimichurri sauce,
9 cocktail sauce, curry sauce, garlic-based sauce, honey mustard sauce, marinades,
10 teriyaki sauce, meat gravies, ready-made sauces, steak sauces, sloppy joe sauce,
11 tomato sauce, chocolate sauce, caramel sauce, toppings, namely, chocolate topping,
12 marshmallow topping, rubs, namely, spice rubs, barbecues dry rubs, meal
13 replacements, namely, chocolate-based meal replacement bars, energy bars,
14 namely, high protein cereal based energy bar, and snack foods, namely, snack
15 cakes, granola snacks; dairy based snack food namely, ice cream, ice milk and
16 frozen yogurt in International Class 30, Ser. No. 86/150,072 (“Primal Nutrition’s
17 PRIMAL KITCHEN ‘072 application” or “the ‘072 application”).

18
19 9. Primal Nutrition’s PRIMAL KITCHEN application was published for
20 opposition on December 23, 2014.

21
22 10. Primal Nutrition is the owner of several other registered marks that
23 includes the term PRIMAL such as PRIMAL BLUEPRINT, U.S. Reg. No.
24 3,890,494 for use in connection with Pre-recorded DVD's and videotapes on the
25 subjects of diet, health, fitness, evolution, genetics, epigenetics, metabolism,
26 medicine, weight loss, supplementation and related topics to how the human body
27 functions in International Class 9, Books in the field of diet, health, fitness,
28 evolution, genetics, epigenetics, metabolism, medicine, weight loss,

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1 supplementation and related topics to how the human body functions in
2 International Class 16, and Educational services, namely, conducting conferences
3 and lectures in the field of diet, health, fitness, evolution, genetics, epigenetics,
4 metabolism, medicine, weight loss, supplementation and related topics to how the
5 human body functions in International Class 41; PRIMAL NUTRITION, U.S. Reg.
6 No. 4,516,876 for use in connection with dietary supplements in International Class
7 5; PRIMAL BLUEPRINT (and logo) U.S. Reg. No. 3,937,143 for use in
8 connection with Educational services, namely, conferences and lectures concerning
9 nutrition, fitness and wellness in International Class 41, and Providing online
10 information via the internet concerning nutrition, fitness and wellness in
11 International Class 44; PRIMAL FUEL, U.S. Reg. No. 3,942,256 for use in
12 connection with Food and dietary supplements in International Class 5; and owns
13 several pending applications, including PRIMAL KITCHEN, Ser. No. 86/456,726,
14 for restaurants in International Class 43 that was filed on November 17, 2014 based
15 upon an intent to use the mark in commerce, published on March 12, 2015, and
16 allowed on July 7, 2015, PRIMAL KITCHEN LIVE AWESOME, Ser. No.
17 86/428,875, for Pre-packed food products, namely, meal replacements, namely,
18 nutritional supplement meal replacement bars for medical purposes, and energy
19 bars, namely, nutritional supplement energy bars; Nutritional and food supplements
20 in the form of pills and capsules containing vitamins, minerals and weight loss
21 nutrients; chocolate flavored meal replacement shakes, vanilla flavored meal
22 replacement shakes, and fruit flavored meal replacement shakes for weight loss
23 purposes; chocolate flavored meal replacement snack bars, vanilla flavored meal
24 replacement bars, and fruit flavored meal replacement bars for medical purposes,
25 dietary and nutritional supplement in the nature of weight loss powders containing
26 vitamins, minerals and weight loss nutrients in International Class 5, Pre-packed
27 food products, namely, sauces, namely, cranberry sauces, meal replacements,
28 namely, fruit-based meal replacement bars, and snack foods, namely, meat-based

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1 snack foods, fruit-based snack food, nut and seed based snack foods, vegetable
2 based snack food, dairy based snack food excluding ice cream, ice milk and frozen
3 yogurt, potato based snack food; Food, namely, packaged foods for weight loss,
4 namely, full meals, entrees, appetizers and snacks, namely, prepared meals
5 consisting primarily of meat, fish, poultry or vegetables; prepared entrees consisting
6 primarily of meat, fish, poultry or vegetables; frozen appetizers consisting primarily
7 of chicken or seafood; dehydrated fruit snacks, and instantized packets of dried
8 food components, namely, instant mashed potato, instant soups, instant potatoes,
9 instant frozen vegetables; fortified foods with vitamins, minerals, and plant
10 nutrients for weight loss, namely, full meals, entrees, appetizers and snacks,
11 namely, prepared meals consisting primarily of meat, fish, poultry or vegetables;
12 prepared entrees consisting primarily of meat, fish, poultry or vegetables; frozen
13 appetizers consisting primarily of chicken or seafood; dehydrated fruit snacks and
14 instantized packets of dried food components, namely, instant mashed potato,
15 instant soups, instant potatoes, instant frozen vegetables, all with vitamins,
16 minerals, and plant nutrients added in International Class 29, Pre-packed food
17 products, namely, condiments, namely, mustard, mayonnaise, ketchup, horseradish,
18 salad dressings, sauces, namely, barbeque sauce, chicken wing sauce, chili sauce,
19 chimichurri sauce, cocktail sauce, curry sauce, garlic-based sauce, honey mustard
20 sauce, marinades, teriyaki sauce, meat gravies, ready-made sauces, steak sauces,
21 sloppy joe sauce, tomato sauce, chocolate sauce, caramel sauce, toppings, namely,
22 chocolate topping, marshmallow topping, rubs, namely, spice rubs, barbecues dry
23 rubs, meal replacements, namely, chocolate-based meal replacement bars, energy
24 bars, namely, high protein cereal based energy bar, and snack foods, namely, snack
25 cakes, granola snacks; dairy based snack food, namely, ice cream, ice milk and
26 frozen yogurt in International Class 30, restaurants in International Class 43, and
27 providing websites featuring information regarding a healthy living in International
28 Class 40, which was filed on October 20, 2014 based upon an intent to use the

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1 mark, published on May 12, 2015, and allowed on July 7, 2015; and PRIMAL
2 BLUEPRINT LIVE AWESOME, Ser. No, 86/428,862, for use in connection with
3 Pre-packed food products, namely, meal replacements, namely, nutritional
4 supplement meal replacement bars for medical purposes, and energy bars, namely,
5 nutritional supplement energy bars; Nutritional and food supplements in the form of
6 pills and capsules containing vitamins, minerals and weight loss nutrients;
7 chocolate flavored meal replacement shakes, vanilla flavored meal replacement
8 shakes, and fruit flavored meal replacement shakes for weight loss purposes;
9 chocolate flavored meal replacement snack bars, vanilla flavored meal replacement
10 bars, and fruit flavored meal replacement bars for medical purposes, dietary and
11 nutritional supplement in the nature of weight loss powders containing vitamins,
12 minerals and weight loss nutrients in International Class 5, Pre-packed food
13 products, namely, sauces, namely, cranberry sauces, meal replacements, namely,
14 fruit-based meal replacement bars, and snack foods, namely, meat-based snack
15 foods, fruit-based snack food, nut and seed based snack foods, vegetable based
16 snack food, dairy based snack food excluding ice cream, ice milk and frozen
17 yogurt, potato based snack food; Food, namely, packaged foods for weight loss,
18 namely, full meals, entrees, appetizers and snacks, namely, prepared meals
19 consisting primarily of meat, fish, poultry or vegetables; prepared entrees consisting
20 primarily of meat, fish, poultry or vegetables; frozen appetizers consisting primarily
21 of chicken or seafood; dehydrated fruit snacks, and instantized packets of dried
22 food components, namely, instant mashed potato, instant soups, instant potatoes,
23 instant frozen vegetables; fortified foods with vitamins, minerals, and plant
24 nutrients for weight loss, namely, full meals, entrees, appetizers and snacks,
25 namely, prepared meals consisting primarily of meat, fish, poultry or vegetables;
26 prepared entrees consisting primarily of meat, fish, poultry or vegetables; frozen
27 appetizers consisting primarily of chicken or seafood; dehydrated fruit snacks and
28 instantized packets of dried food components, namely, instant mashed potato,

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1 instant soups, instant potatoes, instant frozen vegetables, all with vitamins,
2 minerals, and plant nutrients added in International Class 29, Pre-packed food
3 products, namely, condiments, namely, mustard, mayonnaise, ketchup, horseradish,
4 salad dressings, sauces, namely, barbeque sauce, chicken wing sauce, chili sauce,
5 chimichurri sauce, cocktail sauce, curry sauce, garlic-based sauce, honey mustard
6 sauce, marinades, teriyaki sauce, meat gravies, ready-made sauces, steak sauces,
7 sloppy joe sauce, tomato sauce, chocolate sauce, caramel sauce, toppings, namely,
8 chocolate topping, marshmallow topping, rubs, namely, spice rubs, barbecues dry
9 rubs, meal replacements, namely, chocolate-based meal replacement bars, energy
10 bars, namely, high protein cereal based energy bar, and snack foods, namely, snack
11 cakes, granola snacks; dairy based snack food, namely, ice cream, ice milk and
12 frozen yogurt in International Class 30, Restaurants in International Class 43, and
13 Providing a websites (sic) featuring information regarding healthy living in
14 International Class 44, filed on October 20, 2014, published by the U.S. Trademark
15 Office on May 12, 2015, and allowed on July 7, 2015.

16
17 11. Primal Nutrition purchased the PRIMAL KITCHEN mark and the
18 www.primalkitchen.com domain, and all of the goodwill associated with the mark,
19 in or about February of 2014, from a third party based upon the third party's use of
20 the mark in commerce in connection with restaurant and catering services occurring
21 at least as early as March of 2012.

22
23 12. In or about February of 2014, counsel for Primal Nutrition received a
24 letter dated February 11, 2014 from counsel for PK claiming that Primal Nutrition's
25 intent to use the PRIMAL KITCHEN mark as stated in Primal Nutrition's PRIMAL
26 KITCHEN '072 application "is likely to cause confusion with PK's name and
27 mark." The letter further stated that PK uses its PRIMAL KITCHEN name and
28 trademark in connection with the sale of kitchen supplies, and the evidence attached

1 to the letter showed products for sale on amazon.com and
2 primalkitchencompany.com that are kraut caps, a fermenter, glass lids, primal
3 pickler, grommets, silicone valves, and the like. The letter asked Primal Nutrition
4 to abandon its '072 application.

5
6 13. In response, by way of a letter dated February 24, 2014, counsel for
7 Primal Nutrition responded disagreeing with the allegations of a likelihood of
8 confusion between Primal Nutrition's intent to use the PRIMAL KITCHEN mark
9 andPK's use of PRIMAL KITCHEN. The letter indicated that Primal Nutrition
10 was willing to work out a concurrent use agreement so that both parties may
11 continue to use or continue their intent to use the respective marks in a manner that
12 would not create any likelihood of confusion. Further, the letter analyzed the facts
13 under the applicable *Sleekcraft* factors used in the Ninth Circuit to assess whether
14 two respective marks are likely to cause confusion among an appreciable number of
15 ordinary prudent buyers. The analysis demonstrated that consumer confusion was
16 unlikely.

17
18 14. Confusion was, and continues to be, unlikely in light of the differences
19 in: (1) goods and services offered under the respective marks, namely, retail store
20 services for kitchen gadgets versus pre-packaged food products; (2) the widespread
21 third party trademark registrations using the term "primal"; (3) the differences in
22 the parties' respective marketing channels; (4) the degree of care exercised by a
23 purchaser; (5) the good faith intent of Primal Nutrition in selecting the mark; (6) the
24 lack of actual confusion; and, (7) the fact that the term PRIMAL KITCHEN is a
25 natural expansion of Primal Nutrition's related product lines and services and
26 registered Primal Family marks.

27 ///

28 ///

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1 15. In response, in a letter dated March 17, 2014, counsel for PK disagreed
2 with the conclusion of no likelihood of confusion and stated that “[w]e are well-
3 acquainted with the *Sleekcraft* factors that you discussed in your letter. As
4 discussed below, we believe they indicate a likelihood of confusion exists and,
5 therefore, we will need to take appropriate legal measures to protect our trademark
6 rights.” The letter analyzed some of the applicable factors and concluded “[f]or
7 these reasons, we remain convinced that a strong likelihood of confusion would
8 exist if Primal Nutrition adopted its contemplated trademark.”
9

10 16. Following this exchange, the parties separately negotiated a resolution
11 to coexist, and representatives of PK wrote to Primal Nutrition on around April 7,
12 2014 stating “[w]e have evaluated the situation carefully and have decided to drop
13 our claim to Primal Kitchen for food products and re-brand our food category items
14 for the stated sum. We will still use ‘Primal Kitchen’ for our kitchen items
15 (excluding food items) and you would sell your food items under the ‘Primal
16 Kitchen’ brand.”
17

18 17. Negotiations continued into the Summer of 2014. The parties,
19 however, never reached a formal agreement. Absent any further action on behalf of
20 PK, and in light of the differences in goods and services offered under the
21 respective marks, namely, retail store services for kitchen gadgets versus pre-
22 packaged food products, the widespread third party trademark registrations using
23 the term “primal”, the differences in the parties’ respective marketing channels, the
24 degree of care exercised by a purchaser, the good faith intent of Primal Nutrition in
25 selecting the mark, the lack of actual confusion, and the fact that the term PRIMAL
26 KITCHEN is a natural expansion of Primal Nutrition’s related product lines and
27 services and registered Primal Family marks, and the prior rights purchased from a
28 third party regarding PRIMAL KITCHEN, Primal Nutrition believed that it had full

1 legal rights to proceed and continued with its intent to use the mark, and it began
2 using the mark for the goods stated in its '072 application, and filed two additional
3 intent to use applications containing the term PRIMAL KITCHEN, namely, the
4 '726 application for PRIMAL KITCHEN for restaurants and the '875 application
5 for PRIMAL KITCHEN LIVE AWESOME for the goods and services listed above.
6

7 18. Primal Nutrition began selling, and currently sells, mayonnaise under
8 the PRIMAL KITCHEN name on amazon.com and through its own
9 primalblueprint.com and primalkitchen.com websites, and other food retailers, and
10 runs a website featuring information regarding a healthy living using the mark.
11

12 19. On or about September 10, 2014, PK filed a trademark application for
13 PRIMAL KITCHEN for use in connection with Retail store services featuring
14 cooking and food preparation products, namely, Pizza Cutters, Pizza Peels, Bread
15 knives, Replacement blades for bread knives, Wooden Sauerkraut Tampers, Linen
16 Bread cloths, Rolling Pins, Baguette boards, Baguette Peel Fermentation lids being
17 plastic lids for mason jars with airlocks and seals, Fermentation Jars being glass
18 swing top jars with airlocks and seals, Pickling Gift Packs containing fermentation
19 lids with glass weights and a pack of salt, Glass Pickling Weights, silicone seals for
20 use with mason jars, valves, and grommets, namely, silicone valves used with
21 fermentation containers and grommets used with fermentation containers and
22 drinking vessels; Mesh lids for sprouting jars, Grape Leaves, Sourdough, Starters
23 being a mixture of dehydrated flour and yeast culture, Brine Mixes being mixtures
24 of many different herbs, spices and salts, and Salt in International Class 35 based
25 upon a first use and first use in commerce of November 2012, Serial No.
26 86/390,627 ("the '627 application").

27 ///

28 ///

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1 20. On or about December 23, 2014, the U.S. Trademark Office published
2 Primal Nutrition's '072 application for opposition.

3
4 21. On or about January 19, 2015, PK filed a Notice of Opposition with
5 the U.S. Trademark Trial and Appeal Board alleging that it would be damaged by
6 the registration of the mark in Primal Nutrition's '072 application based upon a
7 likelihood of confusion with its PRIMAL KITCHEN mark in connection with the
8 goods listed in the '627 application, namely, retail store services featuring cooking
9 and food preparation products and the like. In other words, PK's opposition to
10 Primal Nutrition's mark applied for in the '072 application, was predicated upon a
11 likelihood of confusion. This proceeding is pending and has Trademark Trial and
12 Appeal Board Opposition No. 91220321.

13
14 22. In or about July of 2015, counsel for PK contacted Primal Nutrition by
15 way of a letter dated July 23, 2015 indicating that PK "maintains its assertions that
16 it has priority in the PRIMAL KITCHEN mark for cooking and food preparation
17 products, and that there is a likelihood of confusion between its mark and the same
18 mark used by Primal Nutrition." In other words, PK maintains that there is a
19 likelihood of confusion (i.e., trademark infringement).

20
21 **CLAIM – DECLARATORY JUDGMENT OF NONINFRINGEMENT**
22 **OF GARDNER'S TRADEMARK**

23
24 23. Primal Nutrition repeats and incorporates here the allegations set forth
25 in paragraphs 1 through 22 above.

26
27 24. PK has engaged in conduct that gives rise to an actual case and
28 controversy with Primal Nutrition within the meaning of Article III of the United

1 States Constitution, namely whether or not Primal Nutrition's past use and
2 continued use of PRIMAL KITCHEN on or in connection with the services listed
3 in its '072 application constitutes trademark infringement under 15 U.S.C. §1114(1)
4 of the trademark rights owned by PK.

5
6 25. PK charged that Primal Nutrition's commercial activities discussed
7 herein are likely to cause consumer confusion and therefore constitute infringement
8 of PK's rights in its PRIMAL NUTRITION trademark for the services listed in its
9 '627 application.

10
11 26. Primal Nutrition denies and disputes this allegation and contends that
12 its above-referenced activities do not infringe PK's purported trademark rights and
13 that Primal Nutrition should be free to continue to provide and continue its intent to
14 provide its goods and services under its PRIMAL KITCHEN trademark clear from
15 the charge that it is infringing the trademark rights of another or any cloud
16 suspicion that it does not have rights in its own trademark on which it has invested
17 much time, expense, and reputation.

18
19 27. Therefore, a case of controversy exists between Primal Nutrition and
20 PK concerning Primal Nutrition's use of the PRIMAL KITCHEN mark in
21 connection with the goods listed in its '072 application, and whether such use
22 infringes PK's purported trademark rights.

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1 **PRAYER FOR RELIEF**

2
3 WHEREFORE, Primal Nutrition prays that the Court enter judgment:

4
5 A. In favor of Primal Nutrition, declaring that Primal Nutrition's above-
6 referenced conduct, including its providing the goods listed in U.S. trademark
7 application serial number 86/150,072 under its PRIMAL KITCHEN trademark,
8 does not infringe PK's trademark under 15 U.S.C. §1114;

9
10 B. In favor of Primal Nutrition, declaring that Primal Nutrition's above-
11 referenced conduct, including its providing the goods listed in U.S. trademark
12 application serial number 86/150,072 under its PRIMAL KITCHEN trademark,
13 does not constitute unfair competition, a false designation of origin, or false
14 description under 15 U.S.C. § 1125(a);

15
16 C. A determination that this case is exceptional, and awarding Primal
17 Nutrition its attorneys' fees, costs, and expenses pursuant to 15 U.S.C. § 1117; and,

18
19 D. Awarding Primal Nutrition such other relief as the Court may deem
20 just and proper.

21 Respectfully submitted:

22 CISLO & THOMAS LLP

23
24 Dated: August 21, 2015

25 /s/ Daniel M. Cislo

26 Daniel M. Cislo, Esq.

27 Mark D. Nielsen, Esq.

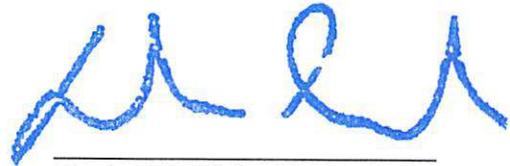
28 Attorneys for Plaintiff,
PRIMAL NUTRITION, INC.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S MOTION TO SUSPEND PROCEEDINGS UNTIL TERMINATION OF THE CIVIL ACTION** was served upon the attorney for Primal Kitchen LLC, by first class mail, postage prepaid, to Erin Bray, Trademark Lawyer Law Firm, 455 E. Eisenhower Pkwy, Suite 360, Ann Arbor, MI 48108, with a copy by electronic mail to erinb@trademarklawyerfirm.com, on the date given below.

Dated: August 26, 2015

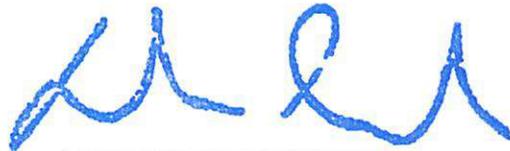


Daniel M. Cislo, Esq.
Kristin B. Kosinski, Esq.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on the date shown below.

Dated: August 26, 2015



Daniel M. Cislo, Esq.
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