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

Proceeding	91220321
Party	Plaintiff Primal Kitchen
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

PRIMAL KITCHEN, LLC.,)	
Opposer,)	Opposition No. 91220321
v.)	Serial No. 86/150,072
PRIMAL NUTRITION, INC..)	Mark: PRIMAL KITCHEN
Applicant.)	

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

Opposer, Primal Kitchen, LLC, by and through its attorneys, provides the following Response to Applicant’s Motion to Suspend Proceedings Until Termination of the Civil Action:

FACTS

In October, 2012 Primal Kitchen, LLC began using its “PRIMAL KITCHEN” mark in connection with retail store services featuring various cooking and food preparation products. On December 20, 2013, Applicant filed an Application for Registration of the mark “PRIMAL KITCHEN” stating a bona fide intent to use the mark in connection with pre-packed food products.

In February 2014, Primal Kitchen, LLC sent correspondence to Registrant to notify the Registrant of its impermissible use of the PRIMAL KITCHEN mark in connection with the same or substantially similar goods as Opposer. After extensive attempts to settle the matter without resorting to litigation, Primal Kitchen, LLC filed a Notice of Opposition No. 91220321 (“Opposition”) to Applicant’s U.S. Serial no. 85150072 for the mark PRIMAL KITCHEN on January 19, 2015, following Applicant’s refusal to withdraw its application and discontinue its use of Opposer’s mark on the same or similar goods.

Since that time, the parties have attempted resolution of this matter without success. On July 10, 2015, Applicant served numerous requests for discovery on Primal Kitchen, LLC. As required by law and rules, Primal Kitchen, LLC responded to Applicant’s requests in their entirety. On July 23, 2015, Primal Kitchen, LLC served Requests for Admissions, Interrogatories, and Production of Documents in accordance with all Rules of Discovery.

On August 22, 2015, notwithstanding Applicant's knowledge that Primal Kitchen was represented by counsel in this matter, Applicant served notice of civil action seeking declaratory judgment on the issue of likelihood of confusion directly on Primal Kitchen at its place of business.

On August 25, 2015, Applicant responded to Primal Kitchen's requests for discovery with woefully insufficient information which did not address the requests in substance, but instead, were clearly intended to evade Primal Kitchen's reasonable requests, and imposed unnecessary time and fees on Primal Kitchen.

On August 26, 2015, again without prior notice to Primal Kitchen's counsel, or without effort to meet and confer regarding stipulation of this motion, Applicant filed its Motion to Stay the Proceedings pending termination of the recently filed civil action in the same matter.

ARGUMENT

Primal Kitchen does not dispute the Board's authority to suspend proceedings where the final determination of another proceeding, particularly a civil action, may have a bearing on the issues before the Board.

Notably, in conjunction with this authority, if there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. 37 CFR § 2.117(b). *See also Boyds Collection Ltd. v. Herrington & Co.*, 65 USPQ2d 2017 (TTAB 2003) (motion to strike petitioner's notice of reliance, its only evidence in the case, decided before motion to suspend, and granted). The purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion.

Although there is no pending motion at this time, the parties are in the midst of the discovery period in the matter pending before the Board. The purpose of the various discovery devices is to allow the parties to ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case and simplify the issues. At the very least, discovery enables the discovering party to better prepare for trial.

In flagrant disregard to this process, Applicant, in responding the Opposer's discovery requests, improperly cited 37 CFR § 2.120(d)(1), objecting to Opposer's Interrogatories as exceeding the number allowable under the rule. In its counting methodology Applicant concluded that each good should be treated as a separate "issue" for purposes of counting subparts. The Board specifically addressed the error in this counting method in *South Cone v. Swimwear Anywhere*, Opposition No. 91195911 and 9119872.

“Applicant's interrogatories do not exceed seventy-five. Opposer's proposed counting methodology, calling for multiplication of certain interrogatories by the number of goods and services in the application or registration, and concluding that each good and services

should be treated as a separate “issue” for purposes of counting subparts, is incorrect and inconsistent with the purpose and scope of discovery. Additionally, Opposer’s arguments that the requirement to respond with the date of first use of each of its goods poses an “excessive burden” and raises the issue of relevance is unpersuasive.”

Additionally, even where Opposer’s interrogatories exceeded seventy five, the Board has found that “a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. TBMP § 402.01; see also, *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666, 667 (TTAB 1986) (parties who served identical discovery requests on each other in effect waived their right to object and must answer each request completely); See also *Miss America Pageant v. Petite Productions, Inc.*, 17 USPQ2d 1067, 1069 (TTAB1990) (petitioner estopped to challenge respondent’s interrogatories as excessive in number having served virtually identical set on respondent). Of the discovery requests exchanged by the parties in this proceeding, all but four of the 15 Requests for Production propounded by Opposer and four of the 20 Interrogatories were virtually identical to those served by Applicant.

In light of Applicant’s apparent refusal to proceed in a manner which could possibly facilitate settlement in the pending matter, including its failure to reasonably participate in the discovery process, Primal Kitchen, LLC requests that, prior to suspension of the proceedings, the Board allow a reasonable time for the parties to meet and confer regarding Applicant’s deficiencies. Should a resolution fail to be reached, Primal Kitchen further requests that the Board allow it to submit the appropriate Motion to Compel Discovery on which the Board rules prior to suspension of the pending matter.

Such action is in conjunction with the spirit of discovery, facilitation of potential resolution of the pending matter, and not unlike the Board’s actions in circumstances where a Motion has been filed prior to the request for suspension.

Dated: September 2, 2015

Respectfully Submitted,
Primal Kitchen, LLC.

By: /Erin C. Bray/
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CERTIFICATE OF SERVICE

I hereby certify that on September 2, 2015, a true and correct copy Response to Applicant's Motion to Suspend Proceedings until Termination of the Civil Action was served upon:

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UNITED STATES

By Electronic Mail.
By Priority First Class Mail

I further certify that the foregoing paper is being filed electronically via the Electronic System for Trademark Trials and Appeals (ESTTA).

Date: September 2, 2015

/ Erin C. Bray /
Erin C. Bray