

ESTTA Tracking number: **ESTTA717683**

Filing date: **12/30/2015**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	JJA Distributors, LLC
Granted to Date of previous extension	12/30/2015
Address	10226 Doncastle Court Mechanicsville, VA 23116 UNITED STATES

Attorney information	Matthew R. Schantz Frost Brown Todd LLC PO Box 44961 Indianapolis, IN 46244-0961 UNITED STATES mschantz@fbtlaw.com, fbtiplitigation@fbtlaw.com
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Applicant Information

Application No	86592058	Publication date	09/01/2015
Opposition Filing Date	12/30/2015	Opposition Period Ends	12/30/2015
Applicant	Vapir, Inc. 2365 Paragon Dr Suite B San Jose, CA 95131 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Vaporizers for smokers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85868510	Application Date	03/06/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PRIMAL		

Design Mark	<h1>PRIMAL</h1>
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0 Herbal smoking materials and non-tobacco smoking materials for use as tobacco substitutes, namely, non-tobacco, non-nicotine flavored liquids and dissolvable flavored powders for placement in hookah water jars; herbal smoking materials and non-tobacco smoking materials, namely, homogenized herbal smoking wrapper made primarily from plant matter used for rolling and smoking herbal smoking tobacco substitutes; non-tobacco, non-nicotine hookah and shisha smoking articles, namely, flavored porous stones, shredded processed shisha fruit, artificial pearls, and artificial crystals for smoking flavored vapor for personal inhalation; herbal smoking materials and non-tobacco smoking materials, namely, electronic hookahs for personal inhalation of vapor from non-tobacco filler and liquids; herbal smoking materials and non-tobacco smoking materials, namely, herbal and non-tobacco, non-nicotine shredded material in the nature of processed fruit suitable for use as tobacco substitutes

Related Proceedings	Opposition Proceeding No. 91225545 was filed against Applicant by Opposer's Licensee.
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Attachments	85868510#TMSN.png(bytes) Notice of Opposition - PRIMA - JJA Distributors LLC.pdf(13333 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/matthew r schantz/
Name	Matthew R. Schantz
Date	12/30/2015

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

In Re Trademark Application Serial No.: 86/592,058

Mark: PRIMA

Filed: April 9, 2015

Published: September 1, 2015

_____)	
JJA DISTRIBUTORS, LLC)	
)	
Opposer)	Opposition No. _____
)	
v.)	
)	
VAPIR, INC.)	
)	
Applicant)	
_____)	

NOTICE OF OPPOSITION

Pursuant to 15 U.S.C. §1063 and 37 C.F.R. §§2.101 and 2.104, Opposer, JJA Distributors, LLC (“JJA Distributors” or “Opposer”), believes it will be damaged by the registration of the above-referenced trademark, and hereby opposes the application to register same with the United States Patent & Trademark Office (“USPTO”), on the grounds set forth below.

Opposer and the PRIMAL Mark

1. Opposer, JJA Distributors, LLC, is a limited liability company organized under the laws of Virginia, with a current business address of 10226 Doncastle Court, Mechanicsville, VA 23116.

2. Intrepid Brands, LLC (“Intrepid”), is a limited liability company organized under the laws of Delaware, with a current business address of 5201 Interchange Way, Louisville, KY 40229.

3. Opposer is the owner of U.S. Serial No. 85/868,510 (the “PRIMAL Application”) for the mark PRIMAL (the “PRIMAL Mark”) for use in connection with the goods of “*Herbal smoking materials and non-tobacco smoking materials for use as tobacco substitutes, namely, non-tobacco, non-nicotine flavored liquids and dissolvable flavored powders for placement in hookah water jars; herbal smoking materials and non-tobacco smoking materials, namely, homogenized herbal smoking wrapper made primarily from plant matter used for rolling and smoking herbal smoking tobacco substitutes; non-tobacco, non-nicotine hookah and shisha smoking articles, namely, flavored porous stones, shredded processed shisha fruit, artificial pearls, and artificial crystals for smoking flavored vapor for personal inhalation; herbal smoking materials and non-tobacco smoking materials, namely, electronic hookahs for personal inhalation of vapor from non-tobacco filler and liquids; herbal smoking materials and non-tobacco smoking materials, namely, herbal and non-tobacco, non-nicotine shredded material in the nature of processed fruit suitable for use as tobacco substitutes*” in International Class 34 (the “PRIMAL Goods”).

4. Opposer filed the PRIMAL Application with the USPTO on March 6, 2013, on an intent-to-use basis under Section 1(b) of the Trademark Act.

5. The PRIMAL Application was published for opposition on March 25, 2014, and no opposition proceedings were instituted against the PRIMAL Application.

6. JJA Distributors and Intrepid entered into a Trademark License Agreement whereby JJA Distributors granted Intrepid the exclusive right to use, in the United States, the

PRIMAL Mark upon and in connection with the manufacture, marketing, promotion, and sale of the products included in the PRIMAL Application.

7. Pursuant to that Trademark License Agreement, Intrepid is using the PRIMAL Mark in commerce on certain goods covered by the PRIMAL Application, and Intrepid is preparing to introduce in commerce additional goods covered by the PRIMAL Application.

Applicant and the PRIMA Mark

8. Upon information and belief, Applicant, Vapir, Inc. (“Vapir” or “Applicant”), is a corporation organized under the laws of California, with a current business address of 2365 Paragon Dr, Suite B, San Jose, California 95131.

9. Upon information and belief, Applicant is the owner of U.S. Serial No. 86/592,058 (the “PRIMA Application”) for the mark PRIMA (the “PRIMA Mark”) for use in connection with the goods of “*vaporizers for smokers*” in International Class 34 (the “PRIMA Goods”).

10. The PRIMA Application was filed with the USPTO on April 9, 2015, on an intent-to-use basis under Section 1(b) of the Trademark Act.

11. The PRIMA Application was published for opposition on September 1, 2015.

12. On September 9, 2015, Opposer submitted a first request for an extension of time to oppose the PRIMA Application until October 31, 2015, and that initial extension request was granted by the TTAB on September 9, 2015. On October 30, 2015, Opposer submitted a second request for an extension of time to oppose the PRIMA Application until December 30, 2015, and that second extension request was granted by the TTAB on October 30, 2015.

COUNT ONE

Likelihood of Confusion, 15. U.S.C. § 1052(d)

13. Opposer repeats and realleges each and every allegation set forth in Paragraphs 1-12 above.

14. Opposer believes it will be damaged by registration of the PRIMA Mark, which is the subject of the PRIMA Application, pursuant to 15 U.S.C. §1063, and hereby opposes the same.

15. As the owner of the PRIMAL Application, Opposer has standing to file this Notice of Opposition and to participate in these opposition proceedings against the PRIMA Application.

16. Opposer's PRIMAL Mark has priority over Applicant's PRIMA Mark. The constructive first use date for the PRIMAL Mark (as provided by the filing date of the PRIMAL Application) predates the constructive first use date of the PRIMA Mark (as provided by the filing date of the PRIMA Application), as well as any subsequent *bona fide* use of the PRIMA Mark, if any, by over two years.

17. Opposer's PRIMAL Mark is arbitrary when used in connection with the PRIMAL Goods and is, therefore, a strong mark.

18. Applicant's PRIMA Mark is similar in sound, sight, and meaning to Opposer's PRIMAL Mark; indeed, the marks are essentially identical in appearance, except for Applicant's removal of a single letter from the end of Opposer's PRIMAL Mark.

19. The PRIMA Goods are similar to the PRIMAL Goods.

20. Upon information and belief, the PRIMA Goods are or will be advertised, promoted, and/or sold in the same trade channels as PRIMAL Goods.

21. Upon information and belief, the PRIMA Goods are or will be marketed to the same general class of consumers as the PRIMAL Goods.

22. Upon information and belief, the PRIMA Goods are or will compete with the PRIMAL Goods.

23. Upon information and belief, the PRIMA Goods and the PRIMAL Goods are or will be marketed, advertised, and sold under their respective marks in the same channels of trade, in the same outlets, and to the same customers or consumer groups.

24. Upon information and belief, the markets, channels of trade, and relevant consumers of the PRIMA Goods are sufficiently related to those of the PRIMAL Goods such that confusion is likely.

25. The PRIMA Mark is confusingly similar to the PRIMAL Mark such that the use and registration of the PRIMA Mark for the PRIMA Goods is likely to cause confusion in the minds of consumers as to the source of Opposer's or Applicant's goods, and is likely to confuse the trade and purchasing public into believing that Applicant's goods originate with or are otherwise authorized, licensed, affiliated or sponsored by Opposer, which is false and prohibited by 15 U.S.C. §1052(d).

26. Accordingly, Opposer will be damaged by the registration of the PRIMA Application because the PRIMA Mark otherwise so resembles the PRIMAL Mark, such that when used in connection with the goods identified in the PRIMA Application, it is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant or Applicant's goods by Opposer, which is prohibited by 15 U.S.C. §1052(d). Opposer has no control over the nature and quality of the goods that are or will be offered under the PRIMA

Mark. Consequently, any dissatisfaction with such goods by the affected public would reflect adversely on Opposer, thus damaging the goodwill and reputation garnered by the PRIMAL Mark.

27. By reason of the foregoing, Opposer's opposition should be sustained and Applicant's application refused registration pursuant to Section 13 of the Trademark Act (15 U.S.C. § 1063).

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that Application Serial No. 86/592,058 be refused registration.

The fee of \$300 as provided by Sections 13 and 31 of the Trademark Act of 1946 is paid by credit card upon electronic filing of this Notice of Opposition.

Respectfully submitted,

/Matthew R. Schantz/

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Counsel for JJA Distributors, LLC

Dated: December 30, 2015

CERTIFICATE OF FILING

I certify that this NOTICE OF OPPOSITION is being submitted electronically to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office on this 30th day of December, 2015.

/Matthew R. Schantz/
Matthew R. Schantz

CERTIFICATE OF SERVICE

I certify that a copy of this NOTICE OF OPPOSITION is being served via United States mail, postage prepaid, on this 30th day of December, 2015, on the following counsel of record for Applicant:

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/Matthew R. Schantz/
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