

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICE ACTION**

Serial No: 85503362
Applicant: Primitive Shoes, Inc.
Filed: December 23, 2011
Mark: Primitive Apparel
Examining Attorney: Mary Rossman
Law Office: 109

Dear Ms. Rossman:

Applicant Primitive Shoes, Inc. (“Applicant”) filed a trademark application for the word mark “Primitive Apparel” on December 23, 2011 for International Classes 25 and 35 (“Application”). The USPTO issued an Office Action dated March 29, 2012, finding that the Application created a likelihood of confusion between an earlier filed application and other registered marks. In this response to the Office Action, Applicant informs the USPTO that it has reached a settlement agreement with the owner of the opposing application and registered marks to ensure that no consumer confusion will occur between their respective marks based on certain conditions. As a result, Applicant hereby seeks to (1) amend the Application for International Class 25, and (2) withdraw the Application for International Class 35.

I. Response to Office Action

The USPTO found that Applicant’s mark created a likelihood of confusion with then pending application for the word mark “Primitive” Serial Number 77833726 in International Class 25 for “Men’s and women’s apparel” (the application has since been amended and approved for registration- see below for more information), and the marks in (1) U.S. Registration No. 2899923- “Primitive” in International Class 14 for “Jewelry,” (2) U.S. Registration No. 4014066 - “Primitive” in International Class 18 for “Handbags and purses,” and (3) U.S. Registration No. 3304024 - “Primitive” in International Class 35 for “Art gallery services and retail store services featuring a wide variety of goods.” The referenced application and registered marks are owned by the same party- Primitive, Inc. (“Registrant”).

Up until March of this year, Applicant and Registrant were involved in a trademark dispute before the U.S. District Court in connection with their respective marks. The USPTO cited Registrant's registrations against registration of Applicant's mark on the grounds that the marks may be confusingly similar. However, Applicant and Registrant reached a settlement on March 12, 2012, whereby both sides agreed, among other terms, to amend their respective applications for International Class 25 (and for Applicant to withdraw its International Class 35 Application) to avoid any potential likelihood of confusion with the other party’s mark, and concluding that their respective marks as amended would not create consumer confusion. (See attached **Exhibit A**- Final Consent Judgment *in the matter of Primitive, Inc., v. Primitive Shoes, Inc.*, Case No. 1:10-cv-7431 dated March 12, 2012).

Accordingly, as set forth in the Final Consent Judgment, Registrant consents to allowing Application for International Class 25 as amended because such modifications will avoid any likelihood of confusion between the Registrant and Applicant's respective marks. The Court of Appeals for the Federal Circuit has indicated that consent agreements should be given substantial weight by the USPTO when reviewing trademark applications. 8-1200 Trademark Manual of Examining Procedure (TMEP) 1207.01(d)(viii). "When those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not." In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362 (C.C.P.A 1973)); see In re Four Seasons Hotels Ltd., 987 F.2d 1565 (Fed. Cir. 1993).

Applicant and Registrant recognize the validity of each other's use and registration of their respective marks in connection with their respective goods and services and have entered into a detailed settlement agreement to avoid any conflict with the other's use or registration of its mark. "Naked" consent agreements are considered to be less persuasive than agreements that specify the arrangements undertaken by the parties to avoid confusing the public. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A 1973). "[T]he more information that is in the consent agreement as to why the parties believe confusion to be unlikely, and the more evidentiary support for such conclusions in the facts of record or in the way of undertakings by the parties, the more we can assume that the consent is based on a reasoned assessment of the marketplace, and consequently the more weight the consent will be accorded." In re Donnay Int'l, S.A., 31 USPQ2d 1953, 1956 (TTAB 1994).

In this instance, Registrant and Applicant assessed the likelihood of confusion for their respective marks in the relevant marketplaces and agreed to specifically amend their applications. Pursuant to the settlement agreement in the Final Consent Order, Registrant agreed to amend its application for the word mark "Primitive" Serial Number 77833726 in International Class 25 from "Men's and women's apparel" to "Men and women's apparel, namely, men's and women's shirts, trousers, jackets, hats, scarves, outerwear, namely, tee-shirts, and jersey shirts, but not including men's athletic apparel specifically related to skateboarding and lidded caps." Registrant also agreed to limit its business activities under the mark to refrain from selling skateboards or skateboard accessories and to refrain from wholesaling its apparel items to certain identified stores that Applicant may transact with. At the same time, Applicant agreed to amend its application (the application at issue herein) for the mark "Primitive Apparel" in International Class 25 from "Men's and women's clothing, namely jackets, pants, shirts, shoes, belts and hats" to "Men's athletic apparel specifically related to skateboarding and lidded caps."

Accordingly, with respect to any likelihood of confusion between the Applicant's mark for "Primitive Apparel" in International Class 25 and Registrant's mark for "Primitive" in International Class 25, the parties concluded that confusion is not likely to arise from their use and registration of their respective marks as amended. This is based on differences in the goods and services, in the marks, in the potential consumers, and in the channels of trade. As evidenced by settlement agreement embodied in the Final Consent Judgment, Applicant and Registrant have acknowledged that their respective marks (as amended)- "Primitive" and "Primitive

Apparel”- will not create a likelihood of confusion based on the differences in the marks as well as the modified and limited goods their marks will apply to pursuant to the agreed to amendments.

Moreover, the conditions under which sales are made to the consumers of Registrant and Applicant under their respective marks dispel any potential for likelihood of confusion. Applicant and Registrant’s businesses are contrastingly different. Applicant is a skateboard lifestyle apparel company, while Registrant is primarily an art gallery and furniture store. Applicant sells its products in its one retail store in Los Angeles, CA, and online through its website. Registrant primarily offers its goods and services through its retail store in Chicago, Ill. Applicant also sells its products wholesale to third parties that both Applicant and Registrant have identified and agreed will not overlap going forward. As such, their potential consumers and channels of trade are substantially different to eliminate any possibility for consumer confusion between the respective goods and services of Applicant and Registrant. In fact, Applicant has used the mark “Primitive Apparel” for the manufacturing and sale of skateboarding apparel and lidded caps in commerce since at least as early as January 2011, and the mark “Primitive” since 2008, and to date, there has not been one reported instance of actual consumer confusion.

Finally, to avoid any potential likelihood of confusion with Registrant’s registered marks for “Primitive” in International Classes 14 (“Jewelry”), 18 (“Handbags and purses”) and 35 (“Art Gallery services and retail store services for a wide variety of goods”), Applicant has agreed to withdraw its International Class 35 application for “Retail store and on-line retail store services in the field of general consumer merchandise, namely jackets, pants, shirts, shoes, belts, hats, backpacks, beanies, watches, sunglasses, wallets, socks, backpacks, skateboard decks, scarves, jewelry, towels, stickers and accessories for the foregoing.”

II. Amendment & Withdrawal

Based On the foregoing and in response to issues raised in the Office Action dated March 29, 2012, Applicant hereby seeks to:

1. Amend its trademark Application Serial No. 85503362 for the mark “Primitive Apparel” in International Class 25 from “Men’s and women’s clothing, namely jackets, pants, shirts, shoes, belts and hats” to “Men’s athletic apparel specifically related to skateboarding and lidded caps;”
2. Withdraw the International Class 35 Application for “Retail store and on-line retail store services in the field of general consumer merchandise, namely jackets, pants, shirts, shoes, belts, hats, backpacks, beanies, watches, sunglasses, wallets, socks, backpacks, skateboard decks, scarves, jewelry, towels, stickers and accessories for the foregoing;” and
3. Disclaim the wording “Apparel” for the International Class 25 application.

III. Conclusion

Applicant and Registrant have used their marks in commerce in connection with their respective goods for several years without any instances of actual confusion. They have expressly agreed to limit their goods and services and amend their Class 25 applications in order to avoid any potential for consumer confusion.

Applicant and Registrant agree and acknowledge that as amended, their marks- “Primitive Apparel” and “Primitive” (respectively) - for International Class 25 do not create a likelihood for consumer confusion, and that they may co-exist under the conditions agreed to in their binding settlement agreement and court order (Exhibit A). The parties also impliedly agreed to continue to take reasonable action to prevent any confusion due to the coexistence and registration of their respective marks, and to notify each other of any instances of confusion. Finally, Applicant has agreed to withdraw its International Class 35 Application for “Primitive Apparel” in order to avoid any potential confusion with Registrant’s marks.

In view of the foregoing, Applicant submits that its Application for International Class 25 is not likely to be confused with Registrant’s marks, and is therefore in condition for allowance and requests that it be promptly passed for publication.

Dated: August 11, 2012

Respectfully submitted,

/s/ Shahrokh Sheik
Shahrokh Sheik
Attorney for Applicant
10850 Wilshire Blvd., 9th Floor
Los Angeles, CA 90024
310-446-1055 Office

EXHIBIT: A

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**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

PRIMITIVE, INC.,
an Illinois corporation,

Plaintiff and Counter-
Defendant,

v.

PRIMITIVE SHOES, INC.,
a California corporation,

Defendant and
Counterclaimant.

Case Number: 1:10 - cv - 7431

Judge: Amy J. St. Eve

Magistrate Judge: Jeffrey Cole

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MAGISTRATE JUDGE JEFFREY COLE
UNITED STATES DISTRICT COURT

FINAL CONSENT JUDGMENT

This cause having come on for hearing, and by and with the consent of all parties, it is hereby ORDERED, ADJUDGED and DECREED that:

1. This Court has jurisdiction over the subject matter of this action and the parties hereto, namely, plaintiff and counter-defendant Primitive, Inc., an Illinois corporation, and defendant and counterclaimant Primitive Shoes, Inc., a California corporation.

2. Plaintiff contends that for many years it has used its trademark and service mark PRIMITIVE in connection with the manufacturing, advertising, distribution and sale of proprietary apparel, furniture, jewelry, and other products and in connection with the retail sale of a variety of goods, including apparel, furniture, jewelry and other products, and that plaintiff is the owner of valid and subsisting federal registrations covering said PRIMITIVE trademark and service mark.

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Exhibit A

3. Subsequent to plaintiff's claimed adoption and use of the PRIMITIVE trademark and service mark, plaintiff alleges that defendant commenced using PRIMITIVE on and in connection with its sale of apparel and in connection with retail store services including apparel.

4. Defendant counter-claimant Primitive Shoes, Inc. denies plaintiff's allegations, counter-claims against plaintiff for cancellation of plaintiff's federal registrations, contending that plaintiff's registrations for the PRIMITIVE mark for retail services and apparel are invalid, and further contends that defendant Primitive Shoes has the lawful right to use the mark PRIMITIVE in connection with the manufacture and sale of apparel and related goods.

5. Defendant Primitive Shoes, Inc., its officers, agents, servants, employees, and attorneys, and all others holding by, through or under defendant, or in active concert or participation with defendant, are permanently enjoined and restrained from:

a. Directly or indirectly selling, offering for sale or causing to be sold apparel products bearing the trademark PRIMITIVE or providing retail or wholesale selling services by means of either physical locations or on-line or mobile applications which include apparel products under or in association with the service mark PRIMITIVE; provided, however, that defendant Primitive Shoes, Inc. may:

i. adopt the trademark and/or service marks PRIMITIVE APPAREL and PRIMITIVE SHOES for use in connection with Defendant Primitive Shoes, Inc.'s manufacture, distribution, and sale of (A) men's athletic apparel products specifically related to skateboarding, including jeans, tee-shirts, lidded caps, shoes, athletic socks, outerwear, shorts, boardshorts, and sandals; and (B) watches and sunglasses;

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ii. seek to register the trademarks PRIMITIVE APPAREL and PRIMITIVE SHOES with the United States Patent & Trademark Office for men's athletic apparel specifically related to skateboarding and lidded caps;

iii. display the word "primitive" on the surface of men's tee-shirts, sweatshirts (including hooded sweatshirts)' skateboard decks, skateboard wheels and skateboard "trucks", and lidded caps in an ornamental fashion without any claim of trademark status, such as the use of the letters "TM", the words "brand" or "trademark", or in a font or script style used by defendant as a logotype as long as such apparel product and skateboard products also bear a visible, legible, non-detachable permanent label or tag that identifies defendant by the trademark or service mark PRIMITIVE APPAREL or PRIMITIVE SHOES as the brand source of the product;

iv. display a reproduction of a product conforming to the requirements of Paragraph 5(a)(iii) in advertising or promotional material only on the condition that such reproduction be accompanied by a legible display of the trademark or service mark PRIMITIVE APPAREL or PRIMITIVE SHOES that identifies defendant Primitive Shoes, Inc. as the brand source of the conforming product depicted in the reproduction; and

v. liquidate its inventory of apparel products and accessories bearing the mark PRIMITIVE that are identified in Exhibit A attached hereto, together with its inventory of apparel products being manufactured for its Holiday 2011, Spring 2012, and Fall 2012 collections but (A) shall not manufacture or cause to be manufactured any additional such inventory bearing the mark PRIMITIVE

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except as provided by 5(a)(iii); and (B) shall not ship to wholesalers or retailers any of the foregoing inventory after the date of November 1, 2012.

b. Doing any other act or thing likely to cause confusion, mistake or deception with respect to plaintiff Primitive, Inc.'s PRIMITIVE trademark and service mark or plaintiff Primitive, Inc.'s trade name Primitive, Inc.

6. Within sixty (60) days of the effective date of this order, defendant Primitive Shoes shall change the present building signage at its current physical retail locations at 17060 Ventura Boulevard, Encino, California from PRIMITIVE to PRIMITIVE SHOES. Within sixty (60) days of the effective date of this order, defendant Primitive Shoes shall change its present account name at Twitter.com from PRIMITIVE_ to a different account name that does not use the word PRIMITIVE by itself as the only text portion of the account name.

7. Plaintiff Primitive, Inc., its officers, agents, servants, employees, and attorneys, and all others holding by, through or under plaintiff, or in active concert or participation with plaintiff, shall not:

a. sell skateboards or skateboard accessories;

b. sell on a wholesale basis or otherwise provide any of its products for the purpose of sale to the shops identified in Exhibit B attached hereto as well as other shops that are exclusively devoted to selling skateboarding products;

c. license to any third party the right to use the mark PRIMITIVE for men's athletic apparel specifically related to skateboarding, including jeans, tee-shirts, lidded caps, shoes, athletic socks, outerwear, shorts, boardshorts, and sandals that are intended ~~exclusively~~ ^{principally} for the skateboard market. Except as specifically set forth herein, nothing shall restrict plaintiff Primitive, Inc.'s right to use (subject to the provisions of this

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Paragraph 7(c)) the mark PRIMITIVE in connection with men's athletic apparel, lidded caps, or apparel related to skateboarding;

d. make reference to skateboarding in advertising or promotional material for its products or services;

e. for a period of two (2) years from the date of this Order, plaintiff shall not:

(i) make reference to surfing, wakeboarding, bmx, motorcross, or motox in advertising or promotional material for its products or services;

(ii) display, show, buy, sell, or otherwise participate in any streetwear industry tradeshows of the type represented by Magic, Agenda, and Bread and Butter;

(iii) advertise its products or services in any skateboard or action sports magazine or television program or print advertising channel dedicated to skateboarding or action sports participants, at any action sports event; or

(iv) advertise in magazines of the type represented by Maxim or FHM that are specifically targeted to males aged 18 to 25.

f. sponsor professional skateboarders.

g. use for any purpose the proprietary font style for the letter "P" or the proprietary font style for the word "primitive" adopted by Primitive Shoes that is displayed in Exhibit C attached hereto.

8. Defendant shall have until April 1, 2012 in which to dispose of all advertising, promotional materials, packages, and labels which bear the mark PRIMITIVE (other than those labels referred to in Paragraph 5(a)(v) herein) and to change all references on defendant's web

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site www.primitiveshoes.com, including but not limited to all meta tag references, from PRIMITIVE to PRIMITIVE APPAREL or PRIMITIVE SHOES.

9. Defendant's counterclaims for Cancellation of Trademark Registrations, Limitation or Modification of Trademark Registration, Damages for False or Fraudulent Registrations, and Common Law Unfair Competition are dismissed with prejudice.

10. Within thirty (30) days of the entry of this Final Consent Judgment, defendant shall file with the United States Patent & Trademark Office its notice of withdrawal of Application Serial No. 85030245 for the mark PRIMITIVE for retail services.

11. Within thirty (30) days of the entry of this Final Consent Judgment, defendant shall file with the United States Patent & Trademark Office its notice of withdrawal of Application Serial No. 77792167 for the mark PRIMITIVE for apparel.

12. Within thirty (30) days of the entry of this Final Consent Judgment, defendant shall file with the United States Patent & Trademark Office its notice of withdrawal in Opposition Proceeding No. 91196854 of its opposition to Primitive's Application Serial No. 77833726, which Opposition Proceeding has been consolidated in Opposition No.91193536 as the "parent" case.

13. Within thirty (30) days of the entry of this Final Consent Judgment, plaintiff shall file with the United States Patent & Trademark Office its request to amend the description of goods recited in Application Serial No. 77833726 to the following: "Men and women's apparel, namely, men's and women's shirts, trousers, jackets, hats, scarves, outerwear, namely, tee-shirts, and jersey shirts, but not including men's athletic apparel specifically related to skateboarding and lidded caps."

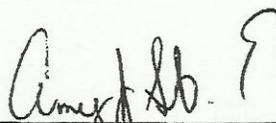

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14. Within thirty (30) days of the entry of this Final Consent Judgment, defendant shall file with the United States Patent & Trademark Office its notice of withdrawal of Application Serial No. 85503423, Application Serial No. 85503419, Application Serial No. 85503413, Application Serial No. 85503404, , and Application Serial No. 85503379. Defendant shall not at any time reapply or apply for registration in the United States Patent & Trademark Office for registration of the marks PRIMITIVE LIFE, PRIMITIVE LOS ANGELES, THE PRIMITIVE BRAND, PRIMITIVE CALIFORNIA, or THE PRIMITIVE COMPANY for apparel products or for retail or wholesale selling services.

15. Within thirty (30) days of the entry of this Final Consent Judgment, defendant shall file with the United States Patent & Trademark Office its notice of withdrawal of its application in Class 35 in Application Serial No. 85503362 and its request to amend the description of goods recited in Class 25 in Application Serial No. 85503362 to the following: "Men's athletic apparel specifically related to skateboarding and lidded caps."

16. Each party shall bear its own costs and attorneys' fees.

ENTER:


United States District Judge 3-12-12

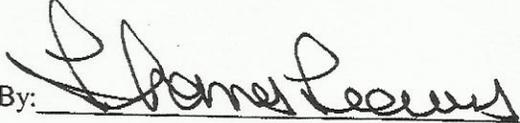
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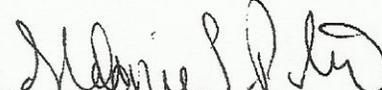
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APPROVED AS TO FORM AND CONTENT:

LEAVENS, STRAND, GLOVER & ADLER, LLC

THE GROTIAN LAW GROUP

By: 

By: 

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Chicago, Illinois 60601

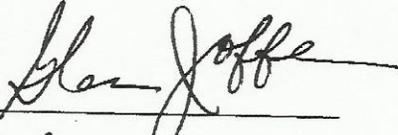
Melanie T. Partow
9107 Wilshire Boulevard
Suite 450
Beverly Hills, California 90210

Attorneys for Plaintiff

Attorneys for Defendant

Plaintiff, Primitive, Inc. hereby consents to the entry of the foregoing Final Consent Judgment.

PRIMITIVE, INC.

By: 
Office: PRESIDENT

Defendant, Primitive Shoes, Inc. hereby consents to the entry of the foregoing Final Consent Judgment.

PRIMITIVE SHOES, INC.

By: 
Office: VP


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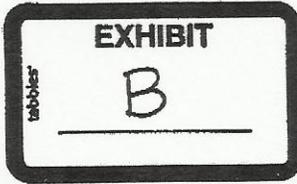
Primitive Shoes Inc, Domestic
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Shop names may represent
multiple locations

- Above the Belt
- Active Rideshop
- Art Culture Creation
- Attic Zoo
- Awol
- Axis
- Backside
- Black Flag
- Black Sheep
- Black Sheet
- Blades
- Boardwalk
- Boundless
- Bricksworth
- Burn Rubber
- Caliroots
- Cap City
- CCS
- Classic Skate Shop
- Complete
- Core
- Cranium Fitteds
- Damins
- Denim Exchange
- Designers Closet
- digital Gravel
- District
- DOPE
- Dwntwn
- Eight Rocks
- Family Affair
- Family Sports
- Fice
- Fifty50
- Fits R US
- Fly streetwear
- Focus Victory
- Foot Soldiers
- Fresh Konnexion
- Galactic G
- Getta Clue
- Hatclub
- High Point
- House of Flava

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Kicks Hi Hawaii
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Let it roll
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Lust
MADE
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Moda 3
Moose limited
Motivation
Muddy Waters
New World Culture
Nouveau
o1ne
One world access
Oneness
Orchard
Palace 5
Peep Flow
Persona
Phat Caps
premier
Premium Goods
Reed Space
revolution rideshop
revolver
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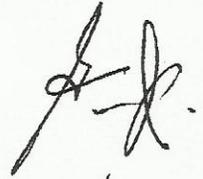
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