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Filing date: **11/12/2018**

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

Proceeding No.	92067273
Filing Party	Defendant Boston BioPharm, Inc.
Other Party	Plaintiff Dolcas Biotech, LLC
Pending Motion	There is no motion currently pending and no other motion is being filed concurrent with this consent motion.
Attachments	2018-08-08 - D.I. 1 - Complaint (COMPRESSED).pdf(4343685 bytes)

Consent Motion for Suspension in View of Civil Proceeding

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Boston BioPharm, Inc. hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Boston BioPharm, Inc. has secured the express consent of all other parties to this proceeding for the suspension requested herein.

Certificate of Service

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

Respectfully submitted,

/Sean T. Phelan/

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11/12/2018

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**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

BOSTON BIOPHARM, INC., a Delaware
Corporation,

Plaintiff,

v.

DOLCAS BIOTECH, LLC, a New Jersey
Limited Liability Company,

Defendant.

Civil Action No. 18-cv-12568

JURY TRIAL DEMANDED

*DOCUMENT FILED
ELECTRONICALLY*

COMPLAINT

Plaintiff Boston BioPharm, Inc. (“Boston BioPharm”), by and through undersigned counsel, brings this action against defendant Dolcas Biotech, LLC (“Dolcas”) and alleges as follows:

NATURE OF THE ACTION

1. This is an action for false advertising under the Lanham Act, 15 U.S.C. § 1125(a)(1)(B). Additionally, this action seeks cancellation of U.S. Reg. No. 3,221,204 (BIO-

CURCUMIN) for genericness under 15 U.S.C. §§ 1119 and 1064(3) and cancellation of U.S. Reg. No. 3,278,319 (BIO-CURCUMAX) for deceptiveness under 15 U.S.C. §§ 1119, 1052(a), and 1064(3).¹

THE PARTIES

2. Boston BioPharm is a Delaware corporation with its principal place of business at 950 E. State Highway 114, Suite 160, Southlake, TX 76092.

3. Upon information and belief, Dolcas is a New Jersey limited liability company with a principal place of business at 9 Lenel Rd., Landing, NJ 07850.

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction over this matter pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338.

5. This Court has personal jurisdiction over Dolcas because it is a resident of this District, is a limited liability company organized and existing under the laws of the State of New Jersey, and maintains its principal place of business in this District. Additionally, Dolcas has transacted substantial business and caused injury to Plaintiff in this District and thus, Dolcas's contacts with the State of New Jersey are sufficient for jurisdiction.

6. Venue is proper in this District under 28 U.S.C. § 1391(b) as Dolcas is a resident of this District and substantial events giving rise to this action occurred in this District.

¹ The parties are engaged in a cancellation proceeding before the Trademark Trial and Appeal Board (No. 92067273) where Dolcas filed a petition to cancel Boston BioPharm's BIOCURC registration (U.S. Reg. No. 5,209,646) and Boston BioPharm counterclaimed to cancel Dolcas's BIO-CURCUMIN registration (U.S. Reg. No. 3,221,204).

GENERAL ALLEGATIONS

I. BIO-CURCUMIN is Generic

7. Turmeric extract possesses many health benefits that make it theoretically valuable as a nutritional supplement or ingredient therefor. In an unprocessed state, however, turmeric extract's poor oral absorption rate leads to a practical problem: decreased ability to enter the body's circulation and have an active effect, diminishing its overall usefulness.

8. When consumed, turmeric extract undergoes extensive metabolism in the gastrointestinal tract. Much of the turmeric extract is metabolized into curcumin glucuronide and curcumin sulfate, both of which are inactive in the human body.

9. Various formulations have been developed with the goal of enhancing turmeric extract's oral absorption and ability to enter the body's circulation in order to have an active effect.

10. Dolcas owns a U.S. trademark registration for BIO-CURCUMIN: U.S. Reg. No. 3,221,204, filed September 21, 2006, for "nutritional supplements in tablets, capsules, powder, soft gel and granule form" in Class 5. **Exhibit A** (U.S. Reg. No. 3,221,204). However, the registered term BIO-CURCUMIN is generic.

11. The relevant purchasing public understands "CURCUMIN" as the common or class name for turmeric extract. Dolcas acknowledged as much by disclaiming "CURCUMIN" when it registered ENHANCED BIO AVAILABLE CURCUMIN on the Supplemental Register. **Exhibit B** (U.S. Reg. No. 3,697,233). A disclaimer in a registration on the Supplemental Register means that the disclaimed wording is generic. Therefore, Dolcas's disclaimer of "CURCUMIN" in U.S. Reg. No. 3,697,233 acknowledges that the term is generic with respect to

the goods in the registration, namely, “[d]ietary supplements in tablet, capsule, powder and liquid form.” *Id.*

12. The relevant purchasing public understands the designation “bioavailable” primarily as the common or class name for the quality of a substance to enter the body’s circulation and have an active effect. **Exhibit C** (showing the definition of “bioavailable”). Therefore, the term “BIOAVAILABLE” is generic.

13. Other registrants before the U.S. Patent and Trademark Office have acknowledged that “BIOAVAILABLE” and “CURCUMIN” lack distinctiveness, separately and together, by disclaiming both words.

14. The owner of U.S. Reg. Nos. 3,964,608 and 4,680,405, Indena Spa Corp., disclaimed “BIOAVAILABLE CURCUMIN” in both marks depicted below, attached hereto as **Exhibits D and E.**²



(Ex. D - U.S. Reg. No. 3,964,608)



(Ex. E - U.S. Reg. No. 4,680,405)

15. The term “bioavailable curcumin” has become a generic designation for turmeric extract that may enter the body’s circulation and have an active effect. Screenshots showing the term “bioavailable curcumin” appearing on or in connection with four third-party nutritional supplements are attached as **Exhibit F** hereto (results of an Amazon search for “bioavailable curcumin” and then clicking four products).

² U.S. Reg. No. 3,964,608 was cancelled on December 29, 2017 after Indena Spa Corp. failed to file an acceptable declaration under Section 71 of the Trademark Act.

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