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

| | |
|------------------------|--|
| Proceeding | 92074712 |
| Party | Defendant Nutrasource Diagnostics Inc. |
| Correspondence Address | JOHN A. CLIFFORD MERCHANT & GOULD P.C. P.O. BOX 2910 MINNEAPOLIS, MN 55402 UNITED STATES Primary Email: jclifford@merchantgould.com Secondary Email(s): aavery@merchantgould.com, dockm- pls@merchantgould.com, tsinnott@bereskinparr.com 612-336-4616 |
| Submission | Motion to Suspend for Civil Action |
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| Date | 09/01/2020 |
| Attachments | 001 Complaint 2020.09.01(6434777.1) (003).pdf(1074294 bytes) |

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

| | | |
|---------------------------------|---|---------------------|
| NUTRASOURCE DIAGNOSTICS INC., |) | |
| (A Canadian Corporation), |) | |
| |) | Civil Action No. __ |
| Plaintiff, |) | |
| |) | |
| v. |) | |
| |) | JURY TRIAL DEMANDED |
| NUTRASOURCERD, LLC, |) | |
| (A New Jersey Limited Liability |) | |
| Company), |) | |
| Defendant. |) | |
| |) | |
| |) | |

COMPLAINT

COMES NOW the Plaintiff, Nutrasource Diagnostics Inc., by its attorneys, to assert its claims against Defendant NutrasourceRD. Plaintiff states and alleges as follows:

The Parties

1. Plaintiff, Nutrasource Diagnostics Inc. is a corporation formed under the laws of Canada, having a principal place of business at 120 Research Lane, Suite 101, Guelph, Ontario,

Canada N1G 0B4. Plaintiff does business as NUTRASOURCE and is a full service contract research organization in the fields of foods, pharmaceuticals, dietary supplements and more.

Plaintiff was founded in 2002 and has operated throughout the United States since its founding.

2. Defendant, NutraSourceRD, LLC is a limited liability company formed under the laws of New Jersey, having a principal place of business at 101 Crawford's Corner, Holmdel, NJ 07733. Upon information and belief, Defendant was formed in November of 2010 and claims to be a company of dietetic professionals offering "The right dietician at the right time" to clients in the United States.

Jurisdiction and Venue

3. Subject matter jurisdiction is provided under 28 U.S.C. §§1331 and 1338. Because the amount in controversy is in excess of \$75,000 and is between a Canadian corporation, a citizen or subject of a foreign state, and a New Jersey citizen, jurisdiction is also present under 28 U.S.C. § 1332. Supplemental jurisdiction of the related state law and common law claims is provided by 28 U.S.C. Sec. 1367(a).

4. Personal jurisdiction over Defendant exists because Defendant is incorporated in this judicial district and has a principal place of business here.

5. Venue is proper in this judicial district because the Defendant is a New Jersey corporation and resides within this district.

Factual Background

Introduction

6. The parties to this action are no strangers to each other. They have a history of interaction, negotiation and resolution of a trademark dispute concerning the names and trademarks NUTRASOURCE and NUTRASOURCERD. This is an action to enforce that

Settlement Agreement and contract entered between the parties concerning that matter, and, in the alternative if the court determines there was no such contract, for trademark infringement and unfair competition under federal, state statutes, and the common law. Specifically, the Lanham Act, 15 U.S.C. § 1051 et seq., New Jersey Statute Section 56:3-13.16 and 13.20 and the common law of the State of New Jersey. This also is an action to rectify and settle the United States Trademark Register as maintained by the United States Patent and Trademark Office concerning the trademarks NUTRASOURCE and NUTRASOURCERD.

Plaintiff and its NUTRASOURCE trademark.

7. Nutrasource Diagnostics Inc. (“Plaintiff”) was founded in 2002 and is a full service contract research organization helping health and food companies discover a strategic pathway to market so they can reach more consumers and grow their business. Plaintiff works with clients across the United States, and worldwide, in the fields of foods, pharmaceuticals, dietary supplements, foods and beverages, biologics, fats and oils and other similar product lines. Plaintiff employs scientists, sports nutritionists, engineers, medical doctors, nurses, pharmacists, and researches to assist clients with advice, consulting, testing and analysis of ingredients, foods, and the like.

8. Plaintiff adopted the name Nutrasource Diagnostics Inc. as its trade name, company name and mark at its incorporation in 2002, and quickly adopted NUTRASOURCE as its principal trademark and moniker. Plaintiff does business as NUTRASOURCE and refers to its employees and staff as the Nutrasource Team.

9. Plaintiff obtained the Internet domain name www.nutrasource.ca on July 17, 2001, while preparing to launch its business and has maintained and used that domain name to host a web page since that time. Plaintiff’s web page provides information about Plaintiff to

customers, prospective customers, and the public through the world, and has routinely been accessed by residents of the United States since first created.

10. The name and trademark NUTRASOURCE have been widely and heavily used by Plaintiff, in the U.S. and worldwide, and the brand NUTRASOURCE is well known in the relevant industry.

11. Plaintiff owns U.S. Trademark Registration No. 5,367,424, for NUTRASOURCE on the Principal Register of the United States Patent and Trademark Office, issued January 2, 2018 based on an application filed on July 21, 2016. That application was itself based on a prior-filed Canadian application that is now Canadian Trademark Registration TMA 978693.

12. Plaintiff's Trademark Registration No. 5,367,424 covers the following services in International Class 42: Testing, analysis and evaluation of natural health products, functional foods, and nutraceuticals; Medical and scientific research, namely, conducting human clinical trials in the field of natural health products and supplements; conducting research and providing consulting services in the field of nutrition and nutraceuticals, and the following services in International Class 44: Conducting human diagnostic testing of levels of compounds in the blood, namely, fatty acids, lipids, and carbohydrates; Conducting glycemic index testing, and is entitled to all of the statutory presumptions accorded it under Section 33 of the Lanham Act 15 U.S.C §:1115. A copy of this Registration is attached hereto as Exhibit A.

13. Prior to filing the above application, Plaintiff previously owned U.S. Trademark Registration No. 3,871,901 for the mark NDI NUTRASOURCE DIAGNOSTICS INC. and Oval Design on the Principal Register of the United States Patent and Trademark Office, issued on November 9, 2010 based on an application filed on October 20, 2008. "Diagnostics Inc." was disclaimed. That application was itself based on a prior-filed Canadian trademark application

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