

ESTTA Tracking number: **ESTTA465430**

Filing date: **04/04/2012**

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

Proceeding	91202162
Party	Plaintiff Biotivia, LLC
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Date	04/04/2012
Attachments	Next Gen Response to Motion to Suspend.pdf (4 pages)(46893 bytes)

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

In the matter of trademark application Serial No. 85193003
For the mark: THE NEXT GENERATION RESVERATROL
Published in the Official Gazette on August 23, 2011

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BIOTIVIA, LLC

Opposition No.: 91202162

Opposer

v.

CHROMADEX, INC.
Applicant

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**BIOTIVIA, LLC'S RESPONSE TO APPLICANT'S MOTION TO SUSPEND PENDING
OUTCOME OF CIVIL LITIGATION**

INTRODUCTION

Opposer Biotivia's Notice of Opposition was filed on *October 18, 2011*. (The "Opposition" filed by "Biotivia"). The Opposition is based on the *descriptive nature* of Applicant's mark "The Next Generation Resveratrol" (the "Mark"), which accurately describes the ingredient pterostilbene – a selling point of Applicant's products, and common phrasing in the industry. The Opposition makes full disclosure of the civil lawsuit, which was filed by Applicant in or about August, 2011.

On January 25, 2012, Biotivia served its Initial Disclosures on Applicant, and on February 8, 2012, Biotivia served written discovery on Applicant, which it has since received

responses to. As part of its Initial Disclosures, Biotivia produced printouts of numerous websites demonstrating the use of the Mark as a description of the main ingredient in Applicant's product, as well as a dictionary definition of "next generation" (also attached as Exhibit A to the Opposition), and other evidence of common industry use of the Mark.

Applicant now seeks to use the civil lawsuit as a shield to delay the inevitable. Applicant did not bring its motion to suspend until nearly *six months* after the Opposition was filed, three months after discussing the matter with counsel for Biotivia, and after Biotivia began conducting discovery and preparing its motion for summary judgment in this matter.

As explained below, Applicant's motion should be denied; not just because of Applicant's delay, but also because the issues in the civil lawsuit are different than those currently before the Board.

DISCUSSION

The basis for the Opposition is that the Mark is descriptive. The Opposition is not based on a likelihood of confusion. The Opposition alleges that the Mark is descriptive, and hence registration will allow Applicant to abuse a phrase which is commonly used within the industry. The Opposition then points to Applicant's civil lawsuit as one instance of Applicant's abuse.

The lawsuit alleges Biotivia's infringement of *five* trademarks. Specifically with reference to the Mark, Applicant alleges that Biotivia used "words and phrases" similar to the Mark, such as "pterostilbene has been described as the taking Resveratrol to the next level" and "PteroMax, in many important ways, takes resveratrol to a new level." (*FAC* ¶ 31-33.) Applicant asserts that these phrases "are likely to confuse consumers." (*Id.*)

In its Answer, Biotivia denies that there is a likelihood of consumer confusion between the Mark and the language used by Biotivia. (*Answer* ¶ 33.) There are few instances in the *FAC* and Answer where the *validity* of the Mark arises: (1) in paragraph 13 Biotivia denies that Applicant is the owner of trademark rights in and to the Mark, and (2) in its eighth affirmative defense Biotivia asserts that some of the intellectual property rights by Applicant are invalid

and/or unenforceable.

The clear gravamen of the FAC are allegations that Biotivia infringed on Applicant's intellectual property rights by purchasing Applicant's trademarks as ad-keywords and has also committed false advertising. Biotivia denies any wrongful conduct. Thus the focus of the civil lawsuit is on whether there is a *likelihood of confusion* due to Opposer's alleged use of the Mark and similar phrasing. This is wholly different than the issue currently pending before the Board, namely, whether the Mark is valid or descriptive.

CONCLUSION

Applicant's motion to suspend the current proceeding should be denied. The civil lawsuit is unlikely to have a bearing on this current proceeding. Furthermore, Applicant delayed bringing the motion until it became clear that the weight of the evidence demonstrating the descriptiveness of the Mark is insurmountable.

DATED: April 4, 2012

CHANDLER & SHECHET, LLP

By: 

AARON SHECHET
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BIOTIVIA, LLC

CERTIFICATE OF SERVICE

I, AARON SHECHET, Attorney of Record for Opposer, Biotivia, LLC, hereby certify that a true and correct copy of:

BIOTIVIA, LLC'S RESPONSE TO APPLICANT'S MOTION TO SUSPEND PENDING OUTCOME OF CIVIL LITIGATION

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