

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

BARRY D. SEARS, PH.D. AND ZONE LABS,
INC.

Plaintiffs,

v.

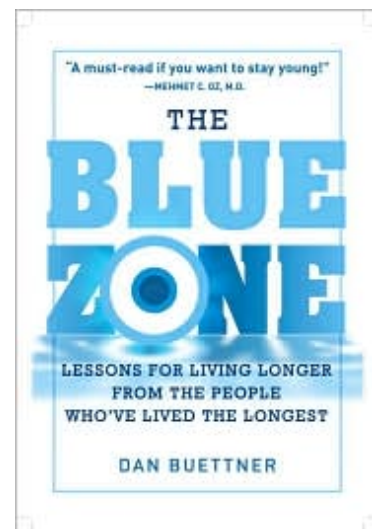
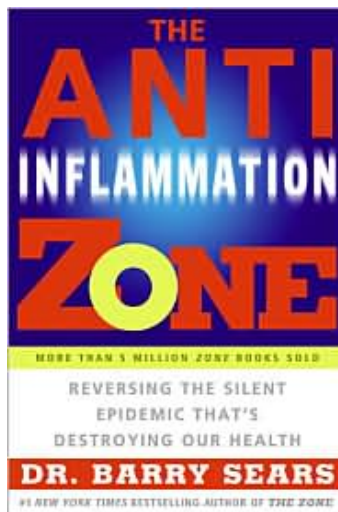
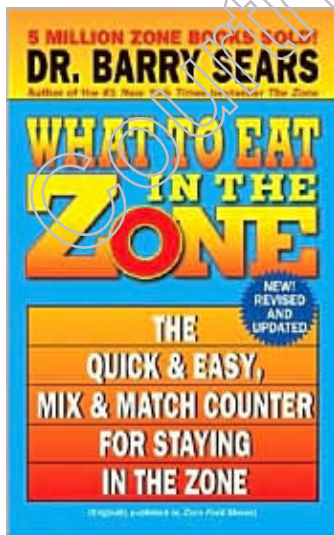
NATIONAL GEOGRAPHIC SOCIETY AND
DAN BUETTNER

Defendants.

Civil Action No. 08-10617

COMPLAINT

This is a complaint for infringement of a family of famous ZONE-formative federally-registered trademarks for nutrition and health books owned by plaintiff Barry D. Sears, Ph.D. (“Dr. Sears”). Defendant National Geographic Society (“NGS”) recently began selling a nutrition and health book using a confusingly similar title – The Blue Zone – written by defendant Dan Buettner (“Buettner”) (together with NGS, “Defendants”). In addition to the use of the identical word ZONE, Defendants adopted a strikingly similar design, insofar as Defendants use a nearly identical typeface and stylized version of the word:



Defendants' conduct constitutes federal trademark infringement in violation of 15 U.S.C. § 1114, false designation of origin in violation of 15 U.S.C. § 1125(a), dilution in violation of 15 U.S.C. § 1125(c), and common law trademark infringement. In addition, Defendants' conduct constitutes statutory (Mass. Gen. L. ch. 93A) and common law unfair competition.

PARTIES

1. Dr. Sears, an individual domiciled in Massachusetts, is the scientist and author who achieved considerable fame in connection with the lifelong nutrition and health strategy, known as ZONE or ZONE DIET, that he first created more than 15 years ago. Dr. Sears is the founder of Zone Labs, Inc.

2. Zone Labs, Inc. is a Delaware corporation which has a principal place of business at 222 Rosewood Drive, Suite 500, Danvers, Massachusetts 01923.

3. Upon information and belief, defendant NGS is a nonprofit organization, with a principal place of business address at 1145 17th Street N.W., Washington, D.C. 20036-4688.

4. Defendant Buettner is an individual who, upon information and belief, resides at 2008 Iglehart Avenue, St. Paul, Minnesota 55104.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction over the claims stated herein pursuant to 28 U.S.C. §§ 1331 and 1338(a) and (b), and this Court's supplemental jurisdiction under 28 U.S.C. § 1367.

6. Upon information and belief, venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) and (c) because this is the judicial district where (i) a substantial part of the events or omissions giving rise to the claim occurred; and (ii) where Defendants reside and/or conduct business.

7. Upon information and belief, Defendants regularly solicit and conduct business in the Commonwealth of Massachusetts.

8. Upon information and belief, Defendants promote, sell, and offer for sale The Blue Zone in the Commonwealth of Massachusetts. In addition, upon information and belief, Defendants maintain websites available in Massachusetts, www.nationalgeographic.com, www.bluezones.com, and www.danbuettner.com, that enable users to purchase the book The Blue Zone.

9. Upon information and belief, Defendants have allowed other commercial websites available in Massachusetts, including but not limited to www.amazon.com, to distribute the book The Blue Zone.

10. Upon information and belief, The Blue Zone has been sold in the Commonwealth of Massachusetts and Defendants have derived profit from the sale of The Blue Zone in the Commonwealth of Massachusetts.

FACTS

11. More than 15 years ago, Dr. Sears created the “Zone” brand lifestyle program. Dr. Sears’ program uses food as a drug to help people control and balance their hormonal and insulin levels to achieve maximum mental productivity and as a means to improve long-term health, including weight loss.

12. Dr. Sears holds a Ph.D. degree in biochemistry from Indiana University. He has worked as a researcher at the University of Virginia School of Medicine, the Boston University School of Medicine, and the Massachusetts Institute of Technology.

13. After receiving his Ph.D. degree, Dr. Sears focused his research on the structure of phospholipids, fat derivatives that are one of the major constituents of cell membranes. In the

early 1980's, Dr. Sears' research began to focus on how little-known hormones called eicosanoids could cause or influence chronic disease states, including heart disease, cancer, and diabetes. Eicosanoids are generated by body tissue in response to stimuli. They are formed from highly unsaturated fatty acids that can be acquired only by consuming them in foods or supplements.

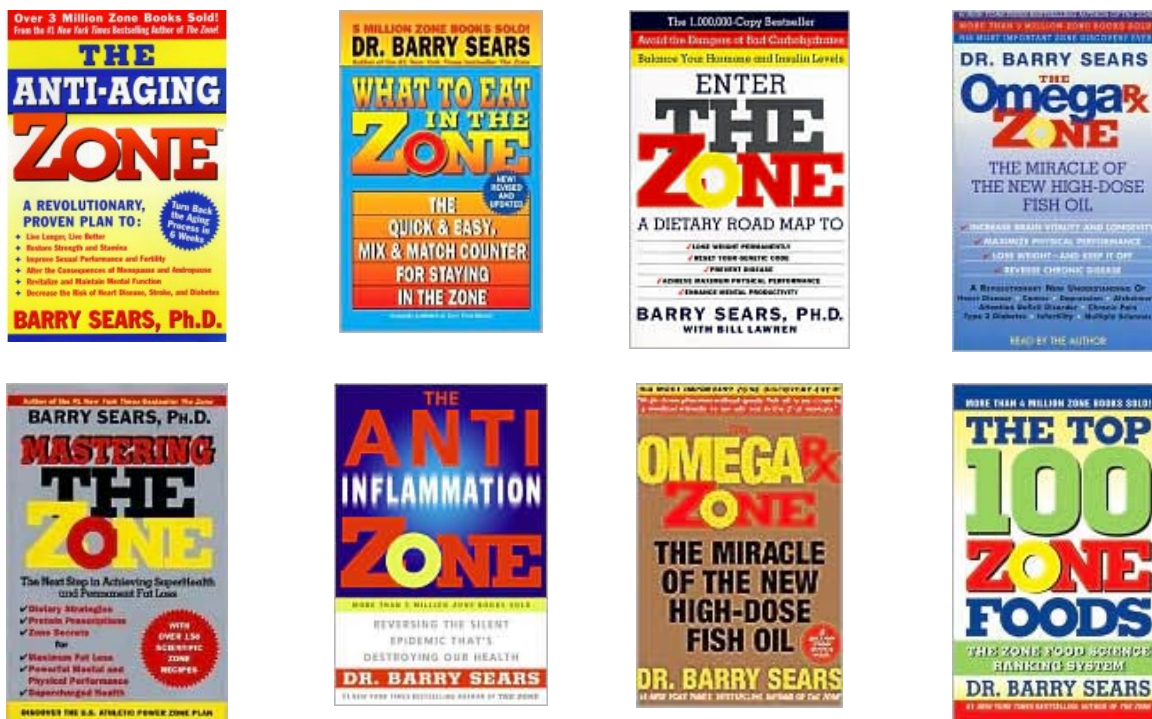
14. In particular, Dr. Sears began to study methods of controlling the production of eicosanoids at the cellular level by controlling the production of insulin. His work and the work of others (including studies conducted at the Harvard Medical School) confirmed that appropriate levels of Omega-3 (in particular, eicosapentaenoic acid, or "EPA") and Omega-6 (gamma linolenic acid, or "GLA") essential fatty acids could aid in the treatment of type II diabetes and heart disease as well as significantly increase performance in elite athletes.

15. While working with the Stanford University Swim Team in the early 1990's, Dr. Sears discovered that a diet with a ratio of protein to carbohydrate between 0.6 and 1.0 could optimize athletic performance in combination with appropriate use of EPA and GLA. In particular, Dr. Sears discovered that such a regime could control insulin and blood sugar levels, thereby achieving a state of hormonal balance that Dr. Sears would later call "the Zone." Also at that time, Dr. Sears created the first nutrition bar based on his insulin control theories. As a result, in part, of Dr. Sears' work, the Men's and Women's Stanford Swim Teams dominated collegiate swimming in the early 1990's, and Stanford swimmers won seven gold medals in the 1992 Barcelona Olympics. Dr. Sears path-breaking work and its results were reflected in favorable articles in sports and fitness magazines, but remained largely unknown to the general public.

Dr. Sears' Trademark Rights in ZONE

16. In 1995, Dr. Sears published The Zone. The book, which represented the summation of his life's work to that point, was ignored by most media outlets and sank to the bottom of the trade lists. As a result of Dr. Sears' own efforts to publicize the book, however, it slowly developed a cadre of devoted followers. By April 1996, word-of-mouth advertising lifted The Zone to #1 on the New York Times Best Sellers List.

17. Since The Zone in 1995, all of Dr. Sears' books have prominently featured ZONE in the title. In total, Dr. Sears has authored, promoted, offered for sale, and sold at least thirteen books concerning nutrition and health that prominently feature ZONE in the title. For example:



18. Dr. Sears' ZONE-branded books have been translated into more than 22 languages and sold in 40 countries worldwide. Dr. Sears' Zone-branded books have sold over 5 million copies in the United States alone.


19. Through a variety of efforts over the last thirteen years, Dr. Sears and the company he founded, Zone Labs, Inc. (collectively, “Plaintiffs”) have established a strong customer base and become famous as the source of quality goods and services in the fields of diet, health, and nutrition, specifically books and publications, all marketed under the ZONE mark. For example, Dr. Sears has promoted his ZONE-branded books on numerous nationally broadcast television shows, including The Today Show, 20/20, and Good Morning America.

20. By virtue of the quality of their products and services, and as a result of the expenditure of considerable sums of money on advertising and promotional activity in various media, Plaintiffs have acquired exclusive and protectable rights to use ZONE in connection with certain goods and services and developed substantial goodwill. The goodwill connected with the use of, and symbolized by, the ZONE brand and family of marks is an extremely valuable asset of Plaintiffs.


21. Dr. Sears has applied for and received numerous ZONE-formative trademark registrations from the United States Patent and Trademark Office (“USPTO”) related to books and publications, including:

- a. U.S. Reg. No. 2,689,749 for the mark ZONE, for “publications, namely a series of books in the field of diet and nutrition” (registered February 25, 2003);




- b. U.S. Reg. No. 3,161,339 for the design mark , for “retail store, catalog ordering and mail order services featuring vitamins and nutritional supplements, nutritional food bars, health foods, computer software and publications in the fields of diet, health and nutrition” (registered October 24, 2006);




- c. U.S. Reg. No. 3,159,649 for the design mark , for, *inter alia*, “printed materials, namely newsletters, magazines, and a series of books, all in the field of diet, health and nutrition” and “providing on-line newsletters, magazines, and bulletins in the field of diet, health and nutrition via e-mail” (registered October 17, 2006);



- d. U.S. Reg. No. 3,159,650 for the design mark , for, *inter alia*, “printed materials, namely newsletters, magazines, and a series of books, all in the field of diet, health and nutrition” and “providing on-line newsletters and bulletins in the field of diet, health and nutrition via e-mail” (registered October 17, 2006);
- e. U.S. Reg. No. 3,170,193 for the mark DR. SEARS ZONE APPROVED, for, *inter alia*, “printed materials, namely newsletters, magazines, and a series of books, all in the field of diet, health and nutrition” (registered November 7, 2006);



- f. U.S. Reg. No. 3,059,308 for the design mark , for, *inter alia*, “providing on-line magazines, newsletters, bulletins, in the fields of diet, health, and nutrition; providing on-line newsletters in the fields of diet, health and nutrition by e-mail” (registered February 14, 2006); and
- g. U.S. Reg. No. 3,060,942 for the mark DR. SEARS ZONE APPROVED, for, *inter alia*, “providing on-line magazines, newsletters, bulletins, in the fields of diet,

health, and nutrition; providing on-line newsletters in the fields of diet, health, and nutrition by e-mail” (registered February 21, 2006).

22. In total, Dr. Sears is the owner of numerous (approximately fifty) United States trademark registrations and applications for ZONE and ZONE-formative marks for a wide array of health, nutrition, and diet products and services (the “ZONE Marks”). A list of Dr. Sears’ family of ZONE Marks federal registrations and applications is attached as Exhibit A.

Defendants’ Intentional Adoption of a Confusingly Similar Mark

23. Upon information and belief, in or about April 2008, Defendants published and offered for sale in commerce a nutrition and health book using the title The Blue Zone.

24. Defendants’ book focuses on lifestyle and nutritional strategies to improve the quality and duration of life.

25. In connection with its Internet marketing for the book, defendant Beuttner publishes related articles on the website www.bluezones.com. One of these specifically focuses on the importance of a diet rich in Omega-3 fatty acids—a core principle of Dr. Sears’ ZONE products and publications:

Okinawan centenarians recognize that eating healthy fat, calcium, flavonoid and omega-3 rich foods is a great part of your daily eating routine.

Whole grains and vegetables are the foundation of the Okinawan diet, sharing equal emphasis. Fruits, flavonoid-rich foods like onions and spinach, and dairy foods should take up slightly less of your diet, but should still be an integral part of your eating pattern.

Omega-3 rich foods like shrimp and other seafoods are another important part of the Okinawan diet. Omega-3 rich oils like extra virgin olive oil should not be left out, they are great cooking oils and taste delicious in salad dressings.

26. Defendants’ use of the word “Zone” in connection with their nutrition and health book is confusingly similar to Dr. Sears’ ZONE Marks. In addition, Defendants’ adoption and

use of the identical typeface and stylized version of the word greatly increases the already existing confusing similarity.

27. Defendants' book is marketed and sold to the same classes of purchasers and through the same channels of trade.

28. Upon information and belief, the use of the Internet to promote and sell books makes the likelihood of initial interest and actual confusion a near certainty. For example, it is a common practice for third-party websites to generate advertising revenue by permitting the Internet bookseller Amazon.com to suggest books related to a website's content. In such a scenario, Amazon.com suggests Defendants' book in connection with Dr. Sears' Zone-branded books and interspersed among them. *See, e.g.*, <http://hubpages.com/hub/Principles-of-the-Zone-Diet--Can-It-Work-for-You>, visited April 9, 2008 (attached hereto as Exhibit B).

29. Likewise, it is also a common practice for third-party websites to generate revenue by permitting Google.com to advertise books related to the website's content. In such a scenario, Google.com suggests Defendants' books under the heading "Zone Diet Books":



Ads by Google

Zone Diet Books



[The Blue Zone: Lessons for Living Longer From the People Who've Lived the Lon...](#)

by Dan Buettner

Amazon Price: \$17.16

Customer Review: Dan Buettner has captured, in my assessment, the essence of vitality and longevity. When people can answer the question, "Why do I get up in the morning?", they have the grounding upon which to build a long and vital life. Without the power of purpose the healthy habits don't take hold as well. This book should be on the bedside reading stand of everyone, age 50 and beyond!



[What to Eat in the Zone: The Quick & Easy, Mix & Match Counter for Staying in...](#)

by Barry Sears

Amazon Price: \$7.99

Customer Review: Excellent book on finding out what to eat to get into the ZONE - would love to have an updated version in the near future.

See, e.g., <http://www.magnetic-diet.com/zone-diet.php>., visited on April 9, 2008 (attached hereto as Exhibit C).

30. Plaintiffs have never authorized or licensed Defendants to use the ZONE Marks.

31. The use by Defendants of a mark that is virtually identical to Dr. Sears' registered ZONE Marks, on or in connection with goods that are so closely related to Plaintiffs' goods, is likely to cause confusion, mistake, and deception among Plaintiffs' customers, potential customers, and the general public, to the irreparable harm and detriment of Plaintiffs and the substantial goodwill they have developed in the ZONE Marks.

32. Upon information and belief, given the fame of Dr. Sears' ZONE Marks in connection with nutrition and health publications, Defendants' use of the word "Zone" and adoption of a strikingly similar stylized design for the word was intended to free-ride on the fame and goodwill of Plaintiffs and Dr. Sears' ZONE Marks.

COUNT I
(Trademark Infringement—15 U.S.C. § 1114)

33. Plaintiffs repeat and reallege the allegations contained in paragraphs 1 through 32 above as if fully set forth herein.

34. As described above, Dr. Sears is the owner of numerous federal trademark registrations for the ZONE Marks.

35. Dr. Sears' ownership and use in commerce of the ZONE Marks predate the use by Defendants of the ZONE mark. Dr. Sears' federal registration of the ZONE Marks also predates the use by Defendants of the Zone mark.

36. Upon information and belief, given the fame of Plaintiffs and Dr. Sears' family of ZONE Marks, Defendants' conduct is willful and intentional and intended to free-ride off of the goodwill associated with the ZONE Marks. Defendants are and were at all relevant times at least

constructively aware of Plaintiffs' prior use, ownership, and registration of the ZONE Marks, and Defendants' conduct is therefore also willful and intentional.

37. Defendants use the ZONE mark in interstate commerce in connection with the sale, offering for sale, distribution, and/or advertising of its goods or services.

38. Defendants' use in commerce of the ZONE mark, as described above, constitutes trademark infringement in violation of 15 U.S.C. § 1114 in that it is without Plaintiffs' consent and is likely to cause confusion, mistake, and/or deception with respect to Dr. Sears' registered trademark, all to the irreparable injury of Plaintiffs and the goodwill they have developed in the ZONE Marks.

39. As a direct and proximate result of Defendants' violations of 15 U.S.C. § 1114, Plaintiffs have been and will continue to be damaged.

40. Upon information and belief, Defendants have realized, and continue to realize, substantial profits and other benefits rightfully belonging to Plaintiffs as a result of their wrongful conduct.

41. Defendants' conduct is causing and will continue to cause Plaintiffs to suffer irreparable harm and, unless Defendants are restrained, Plaintiffs will continue to be so damaged, because they have no adequate remedy at law.

COUNT II
(False Designation of Origin—15 U.S.C. § 1125(a)(1)(A))

42. Plaintiffs repeat and reallege the allegations contained in paragraphs 1 through 41 above as if fully set forth herein.

43. As described above, since at least as early as 1995, Dr. Sears has been the continuous owner of, and has continuously used and exercised valid trademark rights in, the distinctive ZONE Marks.

44. As described above, Dr. Sears is the owner of numerous federal trademark registrations for the ZONE Marks.

45. Dr. Sears' ownership and use in commerce of the ZONE Marks predate the use by Defendants of the ZONE mark. Dr. Sears' federal registration of the ZONE Marks also predates the use by Defendants of the Zone mark.

46. Upon information and belief, given the fame of Plaintiffs and Dr. Sears' family of ZONE Marks, Defendants' conduct is willful and intentional and intended to free-ride off of the goodwill associated with the ZONE Marks. Defendants are and were at all relevant times at least constructively aware of Plaintiffs' prior use, ownership, and registration of the ZONE Marks, and Defendants' conduct is therefore also willful and intentional.

47. Defendants use the ZONE Mark in interstate commerce in connection with their goods or services.

48. Defendants' use of the ZONE Marks, as described above, constitutes false designation of origin in violation of 15 U.S.C. § 1125(a)(1)(A) in that it is likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Defendants with Plaintiffs and/or as to the origin, sponsorship, or approval by Plaintiffs of Defendants' goods, services, or commercial activity, all to the irreparable injury of Plaintiffs and the goodwill they have developed in the ZONE Marks.

49. As a direct and proximate result of Defendants' violations of 15 U.S.C. § 1125(a)(1)(A), Plaintiffs have been and will continue to be damaged.

50. Upon information and belief, Defendants have realized, and continue to realize, substantial profits and other benefits rightfully belonging to Plaintiffs as a result of their wrongful conduct.

51. Defendants' conduct is causing and will continue to cause Plaintiffs to suffer irreparable harm and, unless Defendants are restrained, Plaintiffs will continue to be so damaged, because they have no adequate remedy at law.

COUNT III
(Dilution—15 U.S.C. § 1125(c))

52. Plaintiffs repeat and reallege the allegations contained in paragraphs 1 through 51 above as if fully set forth herein.

53. As described above, since as early as 2003, Dr. Sears has been the continuous owner of, and has exercised valid trademark rights in, the distinctive ZONE Marks.

54. As described above, Dr. Sears is the owner of at least seven trademark registrations in the distinctive ZONE Marks for books and publications.

55. Dr. Sears' ownership and use in commerce of the ZONE Marks predates Defendants' use of the Zone Mark.

56. Defendants were aware of Plaintiffs' prior use, ownership, and registration of the ZONE Marks at all relevant times, and Defendants' conduct is therefore willful and intentional.

57. Through consistent and continued use, product promotion, distinctiveness in the diet, nutrition, and health product market, and consumer and industry recognition, Plaintiffs have developed Dr. Sears' ZONE Marks to the point that the ZONE Marks are famous in the diet, nutrition, and health market.

58. Defendants' use of the ZONE mark is confusingly similar to Dr. Sears' ZONE Marks. The Zone Mark identifies products nearly identical to those identified by Dr. Sears' ZONE Marks, using identical marketing and advertising channels.

59. Upon information and belief, Defendants have adopted the Zone Mark to cause confusion, take advantage of the goodwill and reputation established in the ZONE Marks, and

dilute the strength of the ZONE Marks. Defendants' use of the Zone Mark to identify a competing diet, nutrition, and health product will cause dilution of the distinctive qualities of Dr. Sears' ZONE Marks.

60. Defendants' conduct is causing and will continue to cause Plaintiffs to suffer irreparable harm and, unless Defendants are restrained, Plaintiffs will continue to be so damaged, because they have no adequate remedy at law.

COUNT IV
(Common Law Trademark Infringement)

61. Plaintiffs repeat and reallege the allegations contained in paragraphs 1 through 60 above as if fully set forth herein.

62. As described above, since at least as early as 1995, Dr. Sears has been the continuous owner of, and has continuously used and exercised valid trademark rights in, the distinctive ZONE Marks.

63. Dr. Sears' ownership and use in commerce of the ZONE Marks predates Defendants' use of the Zone Mark.

64. Upon information and belief, given the fame of Plaintiffs and Dr. Sears' family of ZONE Marks, Defendants' conduct is willful and intentional and intended to free-ride off of the goodwill associated with the ZONE Marks. Defendants are and were at all relevant times at least constructively aware of Plaintiffs' prior use, ownership, and registration of the ZONE Marks, and Defendants' conduct is therefore also willful and intentional.

65. Defendants' use in commerce of the ZONE Mark, as described above, constitutes common law trademark infringement in that it is without Plaintiffs' consent and creates and will continue to create a substantial likelihood of injury to business reputation or of the distinctive quality of the ZONE Marks.

66. As a direct and proximate result of Defendants' common law trademark infringement, Plaintiffs have been damaged and will continue to be damaged.

67. Upon information and belief, Defendants have realized, and continue to realize, substantial profits and other benefits rightfully belonging to Plaintiffs as a result of their wrongful conduct.

68. Defendants' conduct is causing and will continue to cause Plaintiffs to suffer irreparable harm and, unless Defendants are restrained, Plaintiffs will continue to be so damaged, because they have no adequate remedy at law.

COUNT V
(Unfair Competition—Mass. Gen. Laws ch. 93A)

69. Plaintiffs repeat and reallege the allegations contained in paragraphs 1 through 68 above as if fully set forth herein.

70. Plaintiffs and Defendants are persons engaged in the conduct of trade or commerce within the meaning of Mass. Gen. Laws ch. 93A, § 11.

71. As described above, since at least as early as 1995, Dr. Sears has been the continuous owner of, and has continuously used and exercised valid trademark rights in, the distinctive ZONE Marks.

72. As described above, Dr. Sears is the owner of numerous federal trademark registrations for the ZONE Marks.

73. Dr. Sears' ownership and use in commerce of the ZONE Marks predate the use by Defendants of the ZONE mark. Dr. Sears' federal registration of the ZONE Marks also predates the use by Defendants of the Zone mark.

74. Defendants' acts, conduct, and practices described above occurred and are occurring primarily and substantially within the Commonwealth of Massachusetts.

75. Upon information and belief, given the fame of Plaintiffs and Dr. Sears' family of ZONE Marks, Defendants' conduct is willful and intentional and intended to free-ride off of the goodwill associated with the ZONE Marks. Defendants are and were at all relevant times at least constructively aware of Plaintiffs' prior use, ownership, and registration of the ZONE Marks, and Defendants' conduct is therefore also willful and intentional.

76. Defendants' acts, conduct, and practices described above, including without limitation the use of the ZONE mark in connection with the promotion, sale, or licensing of products in Massachusetts, constitute unfair methods of competition and/or unfair or deceptive acts or practices, which are unlawful under Mass. Gen. Laws ch. 93A.

77. As a direct and proximate result of Defendants' violations of Mass. Gen. Laws ch. 93A, Plaintiffs have been damaged and will continue to be damaged.

COUNT VI
(Common Law Unfair Competition)

78. Plaintiffs repeat and reallege the allegations contained in paragraphs 1 through 77 above as if fully set forth herein.

79. Defendants' acts, conduct, and practices described above, including without limitation the use of the ZONE mark in connection with the promotion, sale, or licensing of products in Massachusetts, constitute unfair methods of competition and/or unfair or deceptive acts or practices, which are unlawful under Massachusetts common law principles.

80. As a direct and proximate result of Defendants' acts, conduct, and practices described above, Plaintiffs have been damaged and will continue to be damaged.

PRAYER FOR RELIEF

WHEREFORE, Plaintiffs respectfully request the following relief:

- A. That this Court permanently enjoin Defendants, their employees, agents, servants, and all in privity with any of them, from using the ZONE Mark, or any derivative thereof or any designation similar thereto, in commerce;
- B. That this Court enter an order recalling all books presently printed and distributed;
- C. That this Court award Plaintiffs Defendants' profits and/or compensatory damages in an amount to be determined at trial;
- D. That this Court award Plaintiffs treble damages;
- E. That this Court award Plaintiffs their attorneys' fees and costs; and
- F. That this Court award Plaintiffs such other and further relief that this Court deems just and proper.

JURY DEMAND

Plaintiffs demand a trial by jury of all claims so triable.

Respectfully submitted,

BARRY D. SEARS, PH.D. and ZONE
LABS, INC.,

By their Attorneys,

Dated: April 10, 2008

/s/ R. David Hosp
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