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IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

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GLO SCIENCE, INC.

Civil Action No. \_\_\_\_\_

Plaintiff,

v.

TODD E. SHATKIN, DDS

Defendant.

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**COMPLAINT**

GLO SCIENCE, INC. (hereinafter, “Plaintiff” or “GLO SCIENCE”) files this Complaint against Defendant TODD E. SHATKIN, DDS (hereinafter, “Defendant” or “SHATKIN”), and alleges as follows:

**THE PARTIES**

1. GLO SCIENCE is a corporation duly incorporated in the State of Delaware having a place of business at 10 West 37<sup>th</sup> Street, Suite 1001, New York, New York 10018. GLO SCIENCE is doing business in this District.

2. GLO SCIENCE is the exclusive licensee of JBL RADICAL INNOVATIONS, LLC (“JBL”), a Delaware limited liability company having a place of business at 923 Fifth Avenue, New York, New York 10021, for inventions covered by U.S. Patents at issue in this civil action as described in greater detail hereinafter.

3. Upon information and belief, SHATKIN is a dentist conducting a dental practice at 2500 Kensington Avenue, Amherst, New York 14226.

4. SHATKIN makes, uses, offers to sell and/or sells mouthpieces which infringe certain patents owned by JBL and which JBL exclusively licenses to GLO SCIENCE as will be described in greater detail hereinafter.

#### **NATURE OF THE ACTION**

5. This is an Action for patent infringement arising under the patent laws of the United States including 35 U.S.C. §§ 271, 281, 283, 284, 285 and 289, and for false advertising under the Lanham Act, 15 U.S.C. § 1125(a).

#### **JURISDICTION AND VENUE**

6. This is an Action for patent infringement arising under the patent laws of the United States, Title 35 of the United States Code, 35 U.S.C. § 271 *et seq.*, and for false advertising arising under the Lanham Act, 15 U.S.C. § 1125(a).

7. This Court has jurisdiction over the subject matter of this Action under 28 U.S.C. §§ 1331, 1338(a) and (b), and 1367(a), as well as 15 U.S.C. § 1121(a).

8. This Court has personal jurisdiction over Defendant because, upon information and belief, Defendant is doing business in this District, has committed acts of infringement in this

District, and has caused harm or tortious injury in this District by his acts therein, as covered by New York's Long-Arm Statute, N.Y. Civ. Pract. L. R. § 302.

9. Venue properly lies in this District under 28 U.S.C. §§ 1391(b) and (d), and 1400(b) because, upon information and belief: (1) Defendant is subject to personal jurisdiction in this District, (2) regularly conducts business in this judicial District, (3) offers products for sale in this judicial District that infringe Plaintiff's intellectual property rights, (4) has derived substantial revenue and profits from the sale of his infringing products in this judicial District to Plaintiff's detriment, and (5) a substantial part of the events or omissions giving rise to the claims set forth herein have occurred in this judicial District.

#### **FACTUAL BACKGROUND**

10. JBL is the owner of U.S. Patent No. D636,074 (the '074 patent), issued April 12, 2011 from application Serial No. 29/363,728, filed June 14, 2010. See Exhibit 1. The '074 patent remains in full force and effect.

11. GLO SCIENCE is the exclusive licensee of the '074 patent.

12. The '074 patent covers the ornamental appearance of a mouthpiece.

13. JBL is the owner of U.S. Patent No. D765,255 (the '255 patent), issued on August 30, 2016 from application Serial No. 29/492,179, filed on May 29, 2014. See Exhibit 2. The '255 patent remains in full force and effect.

14. GLO SCIENCE is the exclusive licensee of the '255 patent.

15. The '255 patent covers the ornamental appearance of a mouthpiece.

16. Upon information and belief, Defendant has been and is actively selling and marketing tooth whitening systems using the trademark "iSmile™." Among the products sold,

marketed and offered for sale under the “iSmile™” trademark (Defendant’s trademark) are tooth whitening mouthpieces virtually identical in appearance to the mouthpieces claimed in the ‘074 and ‘255 patents. See Exhibit 3.

17. Defendant has infringed and continues to infringe the ‘074 patent and ‘255 patent by making, using, offering to sell, and selling mouthpieces as shown in Exhibit 3 using Defendant’s trademark, throughout the United States including in this judicial District.

18. Plaintiff actively manufactures, markets and distributes tooth whitening mouthpieces covered by JBL’s patents. See Exhibit 4. Given the virtually identical appearance between Plaintiff’s mouthpiece and that of Defendant, upon information and belief, Defendant’s infringement is deliberate, willful, wanton, and intentional.

19. Defendant has caused and will continue to cause Plaintiff substantial damages and injury including Plaintiff’s loss of unique product positioning and lost profits due to lost sales of its systems including its patented mouthpieces by virtue of Defendant’s past and continuing infringement of the ‘074 and ‘255 patents.

20. About three years ago, a professional relationship commenced between GLO SCIENCE and Defendant. In essence, Defendant and GLO SCIENCE entered into an agreement in which Defendant would sell GLO SCIENCE’s tooth whitening products including the patented mouthpieces GLO SCIENCE manufactures and markets under its license from JBL.

21. On January 16, 2014, a video was posted on an Internet page controlled by Defendant at [www.youtube.com](http://www.youtube.com) that will be entered into evidence in this proceeding. The video shows Defendant being interviewed on a Buffalo, NY news program. During the interview, Defendant made several false statements including:

- a) That he worked together with Dr. Jonathan B. Levine (owner of JBL and Chairman of GLO SCIENCE) “to develop an in-office whitening system with GLO ...”;
- b) Discussing tooth sensitivity in the context of GLO SCIENCE products, Defendant stated “... we got rid of that now ...”;
- c) “... like I said, I’m a co-inventor of this product here, the GLO professional system with Dr. Levine ...”; and
- d) Concerning GLO SCIENCE’s tooth whitening products: “About a year ago, I came up with this GLO ...”.

22. All of the statements quoted in paragraph 21 above are false because, among other reasons, Defendant played no role whatsoever in inventing or developing any of the products manufactured and marketed by GLO SCIENCE. These false statements are disparaging of GLO SCIENCE and Dr. Jonathan B. Levine (who is the face of GLO SCIENCE) because not only do they suggest an affiliation that does not exist but, also, they in effect, accuse Dr. Levine of misrepresenting the inventorship in patents JBL has secured including those identified in Exhibits 1 and 2 which correctly list Dr. Levine as the sole inventor. Dr. Levine is a well-known dentist who often appears on nationally televised programs such as, for example, those of Dr. Mehmet Oz and often appears on widely seen programs on the QVC channel where he advertises and promotes his tooth whitening products including those covered by the patents identified in Exhibits 1 and 2. Dr. Levine enjoys a stellar reputation for honesty and integrity as well as for his skill as a dentist.

23. In February 2016, GLO SCIENCE entered into an agreement with a dental distribution company called Benco Dental (“Benco”), making them an exclusive distributor for

all of GLO SCIENCE's professional products including its patented mouthpieces. To satisfy Defendant, GLO SCIENCE arranged with Benco to provide Defendant with special pricing permitting him to maintain the profit margin he had attained when dealing directly with GLO SCIENCE.

24. Despite GLO SCIENCE's accommodation to Defendant as set forth in paragraph 23 above, on information and belief, Defendant commenced designing his own tooth whitening mouthpiece. See Exhibit 3. Comparing Exhibits 3 and 4, it is apparent that there is an uncanny resemblance between GLO SCIENCE's mouthpiece, both as sold and as patented on the one hand, and Defendant's mouthpiece on the other hand. Plaintiff first learned of Defendant's infringing mouthpiece when Plaintiff received a sample of Defendant's mouthpiece in late 2016. Comparing 2014 and 2016, Defendant's purchases of tooth whitening products from GLO SCIENCE diminished by over 80%.

25. Over and above monetary damages to Plaintiff caused by Defendant's actions to date, Plaintiff will suffer further damage and injury unless and until Defendant is enjoined by this Court from continuing such infringement. The damage caused by Defendant is irreparable and cannot be adequately compensated for solely in monetary damages.

### **COUNT I**

#### **(Infringement of the '074 Patent by Defendant under 35 U.S.C. § 271))**

26. Plaintiff repeats and realleges the allegations set forth in paragraphs 1-25.

27. Defendant has been and is now infringing the '074 patent by making, using, selling, offering for sale, and/or importing into the United States, including in this District, his mouthpiece.

28. Upon information and belief, and after a reasonable opportunity for further investigation or discovery, it is likely the evidence will show that Defendant's acts of infringement have been made with full knowledge of the '074 patent particularly since it issued over five years ago. Such acts constitute willful and deliberate infringement, entitling Plaintiff to enhanced damages and attorneys' fees.

29. As a consequence of Defendant's infringement, Plaintiff has been irreparably damaged, to an extent not yet determined, and will continue to be irreparably damaged by such acts in the future unless Defendant is enjoined by this Court from committing further acts of infringement.

30. Plaintiff is entitled to recover damages adequate to compensate for Defendant's infringement, which in no event can be less than a reasonable royalty, as well as for lost profits.

## **COUNT II**

### **(Infringement of the '255 Patent by Defendant under § 35 U.S.C. 271))**

31. Plaintiff repeats and realleges the allegations set forth in paragraphs 1-30.

32. Defendant has been and is now infringing the '255 patent by making, using, selling, offering for sale, and/or importing into the United States, including in this District, his mouthpiece.

33. Upon information and belief, and after a reasonable opportunity for further investigation or discovery, it is likely the evidence will show that Defendant's acts of infringement have been made with full knowledge of the '255 patent particularly since the mouthpiece covered by the '255 patent has been actively and extensively marketed by GLO

SCIENCE as exclusive licensee of JBL. Such acts constitute willful and deliberate infringement, entitling Plaintiff to enhanced damages and attorneys' fees.

34. As a consequence of Defendant's infringement, Plaintiff has been irreparably damaged, to an extent not yet determined, and will continue to be irreparably damaged by such acts in the future unless Defendant is enjoined by this Court from committing further acts of infringement.

35. Plaintiff is entitled to recover damages adequate to compensate for Defendant's infringement, which in no event can be less than a reasonable royalty, as well as for lost profits.

### **COUNT III**

#### **(False Advertising by Defendant under § 15 U.S.C. 1125(a))**

36. Plaintiff repeats and realleges the allegations set forth in paragraphs 1-35.

37. By making the false statements set forth in detail in paragraph 21 above concerning the development of the tooth whitening products invented by Dr. Jonathan B. Levine which are covered by patents exclusively licensed to GLO SCIENCE, Defendant is falsely suggesting that it has an affiliation with Dr. Levine and GLO SCIENCE that does not exist.

38. The false statements set forth in paragraph 21 above deceive consumers into believing that Defendant was involved in the development of tooth whitening mouthpieces patented by JBL, solely invented by Dr. Levine and exclusively licensed to GLO SCIENCE. Upon information and belief, this deception is undertaken by Defendant to trade on the stellar reputation of GLO SCIENCE and its chairman, Dr. Levine, for Defendant's commercial gain. Consumers induced to purchase Defendant's mouthpieces based upon the false claim that Defendant played a role in developing them deceives consumers in a material way.



39. Defendant's false statements have damaged or are likely to damage Plaintiff by causing injury to the good name of GLO SCIENCE as well as Dr. Jonathan B. Levine, owner of JBL, Chairman of GLO SCIENCE, and the face of GLO SCIENCE, and thereby causing competitive and commercial damage to Plaintiff.

40. Defendant's false and misleading statements and omissions violate Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

41. Defendant has caused, and will continue to cause, immediate and irreparable injury to GLO SCIENCE, including injury to GLO SCIENCE'S business, reputation and goodwill, for which there is no adequate remedy at law. GLO SCIENCE is therefore entitled to an injunction under 15 U.S.C. § 1116 restraining Defendant, its agents, employees, representatives and all persons acting in concert with Defendant from engaging in future acts of false advertising.

42. Pursuant to 15 U.S.C. § 1117, GLO SCIENCE is further entitled to recover from Defendant the gains, profits and advantages that Defendant has obtained as a result of Defendant's acts in violation of 15 U.S.C. § 1125(a).

43. Pursuant to 15 U.S.C. § 1117, GLO SCIENCE is further entitled to recover the costs of this action. Moreover, GLO SCIENCE is informed and believes, and on that basis alleges, that Defendant's conduct was undertaken willfully and with the intention of causing confusion, mistake or deception, making this an exceptional case entitling GLO SCIENCE to recover additional damages and reasonable attorneys' fees.

**COUNT IV**

**(Violations of N.Y. General Business Law § 350)**

44. Plaintiff repeats and realleges the allegations set forth in paragraphs 1-43.

45. Plaintiff has been injured and suffered damages by Defendant's violations of GBL § 350, which states: "False advertising in the conduct of any business, trade or commerce or in the furnishing of any service in this state is hereby declared unlawful," and GBL § 350-a, which states: "The term 'false advertising' means advertising, including labeling, of a commodity . . . if such advertising is misleading in a material respect. In determining whether any advertising is misleading, there shall be taken into account (among other things) not only representations made by statement, word, design, device, sound or any combination thereof, but also the extent to which the advertising fails to reveal facts material in the light of such representations with respect to the commodity . . . to which the advertising relates under the conditions prescribed in said advertisement, or under such conditions as are customary or usual."

46. Defendant has engaged in consumer-oriented acts and practices in the State of New York, including false advertising, that are deceptive or misleading in a material way. Such acts and practices are likely to mislead a reasonable consumer acting reasonably under the circumstances.

47. Defendant's deceptive acts and practices and false advertising include false and materially misleading statements set forth in detail in paragraph 21 above concerning the development of the tooth whitening products invented by Dr. Jonathan B. Levine which are covered by patents exclusively licensed to GLO SCIENCE.

48. Defendant's deceptive acts and practices, including false advertising, have a broad impact on the public at large, as they are disseminated to the public via state-wide advertising and promotions, and other public statements aimed at consumers throughout the State of New York.

49. Defendant's acts of false and deceptive advertising have caused damage to GLO SCIENCE.

50. Pursuant to GBL § 350-e, GLO SCIENCE is entitled to an injunction enjoining Defendant's wrongful acts and practices that violate GBL §§ 350 and 350-a, monetary damages in an amount to be proven at trial as a result of Defendant's willful and wrongful violations of GBL §§ 350 and 350-a, and reasonable attorneys' fees and costs.

#### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiff prays for the following relief:

(A) That this Court enter Judgment that the '074 patent has been infringed by Defendant (35 USC § 271(a)) and that such infringement has been willful.

(B) That this Court enter Judgment that the '255 patent has been infringed by Defendant (35 USC § 271(a)) and that such infringement has been willful.

(C) That this Court issue an injunction, permanently enjoining Defendant and any officers, agents, subsidiaries, successors, employees, representatives, and assigns affiliated with Defendant from further patent infringement (35 USC § 283).

(D) That this Court award damages to Plaintiff adequate to compensate Plaintiff for all acts of infringement by Defendant (35 USC § 284) including for lost profits (35 USC § 289).

(E) That this Court award damages in the amount of Defendant's total profits realized for the infringing mouthpieces (35 U.S.C. § 289).

(F) That the damages awarded be increased up to three times as provided for in 35 U.S.C. § 284 concerning patent infringement.

(G) That Plaintiff be awarded their attorneys' fees under 35 U.S.C. § 285.

(H) That Plaintiff be granted pre-judgment interest pursuant to 35 U.S.C. § 284 and post-judgment interest pursuant to 28 U.S.C. § 1961 continuing thereafter until such judgment is paid, on the damages caused by reason of the acts of Defendant as set forth above.

(I) That Plaintiff be granted an award of increased damages in an amount not less than three times the amount of damages found by the jury or assessed by this Court, for Defendant's willful and wanton acts of infringement, pursuant to 35 U.S.C. § 284.

(J) That Plaintiff be awarded their costs and expenses in this action pursuant to 35 U.S.C. § 284.

(K) That the Court enter judgment that Defendant has committed false advertising under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

(L) That the Court enter an Order awarding Plaintiff Defendant's profits directly attributable to its false advertising, all other damages sustained by Plaintiff resulting from Defendant's false advertising, and the costs of this action pursuant to 15 U.S.C. § 1117(a).

(M) That the Court enter an Order deeming this case an "exceptional case" concerning Defendant's false advertising and awarding Plaintiff their reasonable attorneys' fees expended in litigating the issues, pursuant to 15 U.S.C. § 1117(a).

(N) That the Court grant Plaintiff an injunction enjoining Defendant's wrongful acts and practices that violate GBL §§ 350 and 350-a, award monetary damages in an amount to be proven at trial as a result of Defendant's willful and wrongful violations of GBL §§ 350 and 350-a, and grant Plaintiff its reasonable attorneys' fees and costs.

(O) That the Court order Defendant to deliver to Plaintiff all infringing mouthpieces and their packaging as well as all mouthpiece and packaging molds, templates and proofs for destruction.

(P) That the Court order Defendant to identify the manufacturer of its infringing mouthpieces including their location and the location of any molds or other tooling employed in manufacturing the mouthpieces and creating their packaging.

(Q) That this Court grant Plaintiff such other and further relief as it may deem just and proper.

**DEMAND FOR JURY TRIAL**

Plaintiff hereby demands a trial by jury on all issues so triable.

DATED this 6 day of March, 2017.

Respectfully submitted,

By: /s/ David B. Sunshine

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