

ESTTA Tracking number: **ESTTA130771**

Filing date: **03/20/2007**

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

Proceeding	91176062
Party	Defendant Neuronetics, Inc. Neuronetics, Inc. One Great Valley Parkway, Suite 2 Malvern, PA 19355
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Date	03/20/2007
Attachments	NNIL1MotionSusp.pdf (2 pages)(23241 bytes) NNIL1ExA.pdf (13 pages)(5947467 bytes) NNIL1ExB.pdf (13 pages)(638172 bytes)

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

Northstar Neuroscience, Inc. Opposer, v. Neuronetics, Inc. Applicant.	Opposition No.: 91176062 Serial Nos.:78904768, 78904775, and 78904747
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MOTION TO SUSPEND PENDING OPPOSITION PROCEEDING

Sir:

Applicant moves to suspend the above-captioned proceeding pending disposition of Civil Action 07-0351 filed by Opposer against Applicant in the United States District Court for the Western District of Washington at Seattle and of Civil Action 07-1046 filed by Applicant against Opposer in the United States District Court for the Eastern District of Pennsylvania.

Applicant applied to register NEUROSTAR TMS THERAPY, NEUROSTAR & Design, and NEUROSTAR TMS THERAPY & Design (respectively, Application Serial Nos. 78904747, 78904775, and 78904768, and collectively referred to as the NEUROSTAR Applications) and has registered NEUROSTAR (Registration No. 3187054), all for “transcranial magnetic stimulation devices consisting of a stimulator and a patient positioning system, namely, a chair and headset,” in International Class 10.

Opposer filed a Notice of Opposition on March 7, 2007, against the Neurostar Applications, claiming that Applicant’s NEUROSTAR TMS THERAPY, NEUROSTAR & Design, and NEUROSTAR TMS THERAPY & Design marks are likely to cause confusion with Opposer’s registered mark NORTHSTAR NEUROSCIENCE.

On March 7, 2007, Opposer also filed a civil action against Applicant, charging Applicant with infringement of Opposer’s trademark rights as well as false designation of origin, common law infringement, and unfair competition. Opposer also requests that Applicant’s registration for NEUROSTAR be cancelled. Opposer’s complaint in this civil action is attached hereto as Exhibit A.

On March 15, 2007, Applicant filed a civil action against Opposer, requesting a declaratory judgment of noninfringement of Opposer’s NORTHSTAR NEUROSCIENCE trademark. Applicant’s complaint in this civil action is attached hereto as Exhibit B.

Disposition of the aforementioned civil actions will determine whether Applicant is entitled to use and register NEUROSTAR TMS THERAPY, NEUROSTAR & Design, and NEUROSTAR TMS THERAPY & Design, the marks at issue in the instant Opposition. Accordingly, it is respectfully submitted that all further proceedings in Opposition No. 91176062 be suspended pending the disposition of Civil Action 07-0351 in the U.S. District Court for the Western District of Washington at Seattle and Civil Action 07-1046 in the U.S. District Court for the Eastern District of Pennsylvania.

Respectfully submitted,



Date: March 20, 2007

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AT SEATTLE
CLERK OF DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
SEATTLE

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

CV 07-0351 JC

NORTHSTAR NEUROSCIENCE, INC., a Washington Corporation,

Plaintiff,

v.

NEURONETICS, INC., a Delaware Corporation,

Defendant.

COMPLAINT FOR TRADEMARK
INFRINGEMENT, FALSE
DESIGNATION OF ORIGIN,
CANCELLATION OF REGISTRATION,
AND COMMON LAW INFRINGEMENT
AND UNFAIR COMPETITION

JURY DEMAND

Plaintiff Northstar Neuroscience, Inc. alleges as follows:

PARTIES

1. Plaintiff Northstar Neuroscience, Inc. ("Northstar") is a Washington corporation with its principal place of business at 2401 Fourth Avenue, Suite 300, Seattle, Washington 98121.
2. Northstar is informed and believes and on that basis alleges that defendant Neuronetics, Inc. ("Defendant" or "Neuronetics") is a Delaware corporation which maintains its principal place of business at One Great Valley Parkway, Suite 2, Malvern, Pennsylvania 19355. Northstar is further informed and believes and on that basis alleges that Defendant has

COMPLAINT - 1

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1 conducted clinical trials in Washington concerning the products at issue in this case, including
2 in this judicial district.

3
4 **NATURE OF THE CASE**

5 3. This is an action for trademark and trade name infringement and related causes
6 of action arising out of Defendant 'Neuronetics's use of the marks NEUROSTAR,
7 NEUROSTAR TMS THERAPY, NEUROSTAR and Design, and NEUROSTAR TMS
8 THERAPY and Design, and each of them (collectively, the "NEUROSTAR Marks"), which
9 infringe Plaintiff's trade name and trademark NORTHSTAR NEUROSCIENCE, and each of
10 them (collectively the "NORTHSTAR NEUROSCIENCE Mark" or "Mark"). Despite
11 Northstar's request that Defendant Neuronetics cease or limit use of the infringing
12 NEUROSTAR Marks, Defendant has declined to do so and has continued to use the infringing
13 Marks in connection with products used to treat neurological or psychiatric conditions, in clear
14 violation of Northstar's rights. Northstar seeks immediate injunctive relief to prevent
15 Defendant from using the NEUROSTAR Marks, as well as any damages, Defendant's profits,
16 fees, costs, and other monetary and equitable relief.

17 **JURISDICTION AND VENUE**

18 4. Plaintiff Northstar brings claims for: (i) infringement in violation of Section 32
19 of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1114; (ii) false
20 designation of origin and unfair competition in violation of Section 43(a) of the Lanham Act,
21 15 U.S.C. § 1125(a); (iii) cancellation of registration under 15 U.S.C. § 1119; and (iv)
22 infringement and unfair competition in violation of the common law of the state of
23 Washington.

24 5. This Court has jurisdiction over the subject matter of this action pursuant to 28
25 U.S.C. § 1338 and 1119, and has supplemental jurisdiction over the claims arising out of state
26 law pursuant to 28 U.S.C. § 1367(a).

COMPLAINT - 2

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