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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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WESTERN DISTRICT OF WASHINGTON
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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

NORTHSTAR NEUROSCIENCE, INC., a Washington Corporation,

CV 07-0351 JC

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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1 6. Venue in this district is proper under 28 U.S.C. § 1391(b)(1) and (2) as
2 Northstar is informed and believes and on that basis alleges that Defendant Neuronetix has
3 conducted business in this judicial district, including conducting clinical trials in this judicial
4 district, and a substantial part of the events giving rise to the claims alleged occurred in this
5 district. Northstar is further informed and believes and on that basis alleges that Defendant
6 operates a website at www.neuronetix.com which is accessible in this judicial district and
7 which indicates that it has conducted clinical trials at the University of Washington. See
8 Exhibit B (referenced below and <http://www.neuronetix.com/sites.html>).

9
10 **PLAINTIFF NORTHSTAR NEUROSCIENCE
AND ITS NORTHSTAR NEUROSCIENCE MARK**

11 7. Northstar is a medical device company that develops and provides innovative
12 neurostimulation therapies to restore function and quality of life for people suffering from
13 stroke and other neurological diseases and disorders, including stroke motor recovery, aphasia,
14 tinnitus and depression. Northstar's innovative technology is designed to deliver targeted
15 electrical stimulation to the brain, in a process referred to as cortical stimulation. Northstar has
16 used the tradename and mark NORTHSTAR NEUROSCIENCE since at least as early as June
17 2004. Northstar is also the owner of a federal trademark registration for the NORTHSTAR
18 NEUROSCIENCE Mark, which was issued on August 16, 2005 (Reg. No. 2,986,214) for
19 "medical electrical stimulation generators and accessories for application of electrical
20 stimulation signals to the cerebral cortex of the brain, namely medical electrodes, medical
21 electrode applicators and medical electrode cables." Attached as Exhibit A is a true and correct
22 copy of the registration certificate issued to Northstar from the United States Patent and
23 Trademark ("USPTO") for the NORTHSTAR NEUROSCIENCE Mark.

24 8. By virtue of such use and registration of the NORTHSTAR NEUROSCIENCE
25 Mark, Northstar has acquired protectable intellectual property rights in the NORTHSTAR
26 NEUROSCIENCE Mark. Northstar has established considerable reputation and goodwill in

COMPLAINT • 3

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1 the NORTHSTAR NEUROSCIENCE Mark, and medical professionals, clinical trial patients,
2 customers and potential customers and others in the industry associate the Mark with
3 Northstar's products. Attached as Exhibit B are true and correct copies of printouts from
4 Plaintiff Northstar's website at www.northstarneuro.com showing its Mark.

5 DEFENDANT'S INFRINGING ACTIVITIES

6 9. Northstar is informed and believes and on that basis alleges that Defendant
7 Neuronetics is a medical device company that develops products for treatment of neurological
8 and psychiatric disorders. Northstar is informed and believes and on that basis alleges that
9 Neuronetics uses the NEUROSTAR Marks in connection with its NeuroStar TMS Therapy
10 System which is a product or products for the treatment of major depression, and which
11 provides stimulation to the cortex of the brain. Attached hereto as Exhibit C are printouts from
12 the Neuronetics website at www.neuronetics.com describing this product or showing its
13 NEUROSTAR Marks.

14 10. Northstar is informed and believes and on that basis alleges that Defendant has
15 conducted clinical trials of its product, has given presentations about its products and related
16 technology, and intends to sell its products to customers throughout the country, using the
17 NEUROSTAR Marks.

18 11. Northstar is informed and believes and on that basis alleges that Defendant first
19 began using the infringing NEUROSTAR Marks in connection with Defendant's products or
20 services in or about May 2006 - about two years after the date when Northstar first began using
21 its NORTHSTAR NEUROSCIENCE Mark, and after Northstar had obtained a federal
22 registration for its NORTHSTAR NEUROSCIENCE Mark. Northstar is further informed and
23 believes and on that basis alleges that Defendant was aware or should have been aware of
24 Northstar and its NORTHSTAR NEUROSCIENCE Mark and registration at the time that
25 Defendant adopted and began using the infringing NEUROSTAR Marks. The parties are both
26

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