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

Proceeding	92048392
Party	Defendant RyMed Technologies, Inc.
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Submission	Motion to Suspend for Civil Action
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Attachments	Motion to Suspend TTAB Proceeding.pdf (5 pages)(108270 bytes) Gordon Decl. Exh. 1.pdf (28 pages)(1980861 bytes) Gordon Decl. Exh. 2.pdf (12 pages)(891470 bytes) Gordon Declaration.pdf (3 pages)(88985 bytes)

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Registration No.: 3,168,566
Mark: NEUTRAL
Registered: November 7, 2006

<p>ICU MEDICAL, INC.,</p> <p>Petitioner,</p> <p>v.</p> <p>RYMED TECHNOLOGIES, INC.,</p> <p>Registrant.</p>	<p>Cancellation No. 92048392</p>
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**MOTION TO SUSPEND PROCEEDING
PENDING OUTCOME OF FEDERAL COURT LITIGATION**

I. INTRODUCTION

The central issue in this cancellation proceeding – whether or not the trademark NEUTRAL is “generic” and/or “merely descriptive” of the identified goods (certain medical equipment) – is currently the subject of pending federal court litigation. Therefore, pursuant to 37 C.F.R. § 2.117(a) and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 510.02, Registrant Rymed Technologies, Inc. (“Rymed”) respectfully moves the Board to suspend this proceeding by Petitioner ICU Medical, Inc. (“ICU”) pending the outcome of the likely determinative federal court litigation.

II. SUMMARY OF PROCEEDINGS

On July 27, 2007, ICU filed against Rymed a Complaint in the District of Delaware alleging that Rymed’s products infringe four patents held by ICU (“the Delaware Action”).

On October 10, 2007, Rymed filed against ICU a Complaint for Injunctive Relief and Damages in the United States District Court, Central District of California, Case No. SA CV 07-1199 (DOC) (the “California Action”).¹ In the complaint, Rymed asserts claims for declaratory relief of invalidity and non-infringement of the patents asserted by ICU in the Delaware Action, and infringement of Rymed’s United States Trademark Registration No. 3,168,566 (“the ’566 Registration”) for the mark NEUTRAL.

On November 6, 2007, ICU filed this proceeding against Rymed, seeking to cancel Rymed’s ’566 Registration for the mark NEUTRAL. The ’566 Registration covers “medical apparatus for use in performing intravenous procedures, namely, tubing connectors and valves for use in the collection of and distribution of blood and intravenous fluids” in International Class 10. ICU claims the NEUTRAL is “generic” and/or “merely descriptive” of the identified goods and therefore should not have registered as a trademark. In paragraph 8 of its petition, ICU alleged that it will be harmed “by the continuing costs associated with defending against Registrant’s infringement allegations and its efforts to enforce this descriptive/generic mark.”

ICU has not yet filed its answer to Rymed’s trademark infringement complaint in the California Action, instead seeking to dismiss or transfer the California Action to Delaware. ICU, however, has made clear in its correspondence to Rymed’s counsel², and in pleadings filed in the California action³, that it intends to argue, among other things, that the NEUTRAL mark is unenforceable as generic and/or descriptive of Rymed’s products.⁴

¹ See Exhibit 1 attached to the Declaration of David P. Gordon (“Gordon Declaration”) filed herewith.

² ICU’s correspondence was designated confidential, and is therefore not attached to this public filing. Rymed is willing to submit the correspondence under seal on reply, should ICU chose to deny this fact.

³ See p. 4, lines 20-22 of Exhibit 2 to Gordon Declaration (“Rymed improperly assumes that the highly descriptive term “neutral” is a protectable trademark”).

⁴ ICU also apparently intends to argue that Rymed’s claims in the California Action are “moot” because ICU is allegedly no longer Rymed’s mark “NEUTRAL” alone, but is now using it in combination with the word “DISPLACEMENT” – i.e. “NEUTRAL DISPLACEMENT.” ICU, however, is wrong for several reasons: (1) its past use of NEUTRAL alone can result in a finding of willful infringement and an award of damages, and (2) its

There is currently pending in the California Action a motion by ICU to either dismiss RyMed's claims or transfer RyMed's claims to Delaware (including the NEUTRAL trademark infringement claims) so RyMed's California claims can be litigated in Delaware with ICU's patent claims. On January 30, 2008, in a telephonic hearing in the California Action, ICU's counsel represented to the Court that it would stipulate that RyMed could re-file its NEUTRAL trademark infringement claims as counterclaims in the Delaware Action, should the Court dismiss the California Action or transfer it to Delaware. ICU's motion was continued to March 3, 2008. There is also pending in the Delaware Action a motion for reconsideration of that Court's decision not to transfer that action to California so it can be consolidated with the pending California action. Regardless of the outcome of these venue disputes, RyMed's NEUTRAL trademark infringement claims *will proceed* in federal court, and the validity and enforceability of the NEUTRAL '566 Registration is currently at issue.

III. DISCUSSION

37 C.F.R. § 2.117(a) states:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that parties to a pending case are engaged in a civil action which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action.

See also General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1936-37 (TTAB 1992); *Marie Claire Album S.A. v. Kruger GmbH & Co. KG*, 29 USPQ2d 1792, 1794 (TTAB 1993); TBMP § 510.02(a) ("Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.") The rationale for this rule is that, "[t]o the extent that a civil action in

alleged current use of NEUTRAL DISPLACEMENT could still be found to infringe RyMed's NEUTRAL mark. See p. 4, line 22 – p.5, line 4 of Exhibit 2 to Gordon Declaration.

Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board” TBMP § 510.02(a).

Rymed and ICU are clearly involved in district court litigation that will be dispositive of this case. The trademark infringement claims asserted by Rymed against ICU in the California Action involve the same trademark registration asserted in this proceeding. Furthermore, ICU has made clear in paragraph 8 of its Cancellation Petition, in correspondence to Rymed, and in one of its venue-battle pleadings filed in the California Action, that ICU intends to challenge Rymed’s NEUTRAL as generic and/or descriptive of Rymed’s goods. That is the same argument made by ICU in this cancellation proceeding. Therefore, regardless of whether Rymed’s trademark infringement claims proceed in California (as currently filed), or in Delaware (as desired by ICU), the issue of the validity of Rymed’s NEUTRAL registration is before the federal court. In the interest of efficiency and economy, and in light of the fact that a district court decision is binding on the TTAB, this proceeding should be suspended pending the outcome of the determinative federal court litigation.

Respectfully submitted,

Dated: February 14, 2008

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