

ESTTA Tracking number: **ESTTA156093**

Filing date: **08/10/2007**

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

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	ILSI Health and Environmental Sciences Institute
Granted to Date of previous extension	08/12/2007
Address	One Thomas Circle, NW9th Floor Washington, DC 20005-5802 UNITED STATES

Attorney information	Shawn N. Sullivan ILSI Health and Environmental Sciences Institute One Thomas Circle, NW9th Floor Washington, DC 20005-5802 UNITED STATES ssullivan@ilsis.org Phone:202-659-0074
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### Applicant Information

Application No	76651527	Publication date	02/13/2007
Opposition Filing Date	08/10/2007	Opposition Period Ends	08/12/2007
Applicant	ELSEVIER INC. 360 PARK AVENUE SOUTH NEW YORK, NY 10010 UNITED STATES		

### Goods/Services Affected by Opposition

Class 035. First Use: 1990/01/31 First Use In Commerce: 1990/01/31 All goods and services in the class are opposed, namely: computerized testing to determine employment skills in the field of nursing
Class 041. First Use: 1990/01/31 First Use In Commerce: 1990/01/31 All goods and services in the class are opposed, namely: computerized educational testing related to nursing; Nurse training; Development and dissemination of educational materials of others in the nature of examinations in the field of nurse training, education and registration
Class 042. First Use: 1990/01/31 First Use In Commerce: 1990/01/31 All goods and services in the class are opposed, namely: Computer services, namely design and development of software featuring examinations relating to nursing education, training and registration

### Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

## Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3032209	Application Date	12/07/2004
Registration Date	12/20/2005	Foreign Priority Date	NONE
Word Mark	HESI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00  Printed publications, namely, newsletters, books, magazines, pamphlets, journals, monographs, white papers, brochures, printed articles, catalogs, printed supplements, printed agendas, directories, posters, informational flyers, printed announcements, reports, studies, reviews, folders, calendars, bulletins, and treatises in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health</p> <p>Class 036. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00  Providing research grants in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health</p> <p>Class 041. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00  Educational services, namely, arranging, organizing, and conducting symposiums, workshops, and conferences in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health</p>		

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Signature	/shawn n sullivan/
Name	Shawn N. Sullivan
Date	08/10/2007

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

ILSI HEALTH AND	§	Opposition No. _____
ENVIRONMENTAL SCIENCES	§	
INSTITUTE,	§	
	§	
Opposer,	§	
	§	
v.	§	Serial No. 76/651,527
	§	
ELSEVIER INC.,	§	Published: February 13, 2007
	§	
Applicant.	§	
	§	

**NOTICE OF OPPOSITION**

ILSI Health and Environmental Sciences Institute, a District of Columbia nonprofit corporation with a principal place of business at One Thomas Circle, NW, Ninth Floor, Washington, DC 20005 ("Opposer"), believes it will be damaged by the registration of the mark HESI ("Applicant's Alleged Mark") which is the subject of Application Serial No. 76/651,527 (the "Application"), and hereby opposes the Application under 15 U.S.C. § 1063. The Application was filed on December 7, 2005, by Health Education Systems, Inc. and, upon information and belief, was assigned to Elsevier Inc. ("Applicant"), and seeks to register Applicant's Alleged Mark for the following services ("Applicant's Services"):

Computerized educational testing related to nursing; nurse training; development and dissemination of educational materials of others in the nature of examinations in the field of nurse training, education and registration, in International Class 41;

Computer services, namely design and development of software featuring examinations relating to nursing education, training and registration, in International Class 42; and

Computerized testing to determine employment skills in the field of nursing, in International Class 35.

Applicant's Alleged Mark was published for opposition in the Trademark Official Gazette on February 13, 2007, and extensions of time to oppose have been granted to Opposer through August 13, 2007.

As grounds for the opposition, Opposer alleges the following:

1. Since 1989, Opposer itself and through its predecessor-in-interest, the International Life Sciences Institute, has been engaged in the offering of a wide range of services related to the identification and resolution of health and environmental issues of concern to the public, scientific community, government agencies, and industry.
2. In connection with these activities, Opposer and its predecessor-in-interest have adopted the word mark "HESI" ("Opposer's HESI Mark") and has used Opposer's HESI Mark for and in connection with Opposer's goods and services in interstate commerce in and throughout the United States continuously and extensively since at least as early as November 1989.
3. On December 7, 2004, Opposer filed an application for registration of Opposer's HESI Mark in the United States Patent and Trademark Office.
4. On December 20, 2005, the United States Patent and Trademark Office issued to Opposer Registration No. 3,032,209 ("Opposer's Registration") for Opposer's HESI Mark for the following goods and services ("Opposer's Goods and Services"):

Printed publications, namely, newsletters, books, magazines, pamphlets, journals, monographs, white papers, brochures, printed articles, catalogs, printed supplements, printed agendas, directories, posters, informational flyers, printed announcements, reports, studies, reviews, folders, calendars, bulletins, and treatises in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health, in International Class 16;

Providing research grants in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health, in International Class 36; and

Educational services, namely, arranging, organizing, and conducting symposiums, workshops, and conferences in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health, in International Class 41.

5. Opposer is the owner of all right, title and interest in and to the mark HESI for Opposer's Goods and Services and for goods and services related thereto, and Opposer's registration number 3,032,209 for Opposer's HESI Mark is good and valid in law.

6. Applicant's Alleged Mark consists of or comprises a mark which is identical to Opposer's previously used and registered Opposer's HESI Mark, and is likely, when used in connection with Applicant's Services, to cause confusion, or to cause mistake or to deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d).

7. Upon information and belief, Applicant is unable to establish, with respect to Opposer's uses of Opposer's HESI Mark, priority of use or priority of rights in the United States in connection with Applicant's Alleged Mark.

8. Opposer is not connected in any way with the Applicant or the intended use by Applicant of the Opposer's Alleged Mark.

9. The registration of Applicant's Alleged Mark would be inconsistent with Opposer's rights under Opposer's Registration and the common law and would be damaging to Opposer.

10. Opposer would be damaged by registration of Applicant's Alleged Mark because such registration would constitute prima facie evidence of Applicant's exclusive

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right to use Applicant's Alleged Mark in connection with Applicant's Services, which would be inconsistent with and detrimental to Opposer's prior, established and superior rights in Opposer's HESI Mark.

11. Applicant's Alleged Mark falsely suggests a connection or affiliation with Opposer, and Applicant is therefore not entitled to registration of Applicant's Alleged Mark.

WHEREFORE, Opposer ILSI Health and Environmental Sciences Institute respectfully prays that application Serial No. 76/651,527, filed December 7, 2005, for registration of the mark HESI for Applicant's Services in International Classes 35, 41, and 42 be refused, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

ILSI HEALTH AND ENVIRONMENTAL  
SCIENCES INSTITUTE

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Dated: August 10, 2007