

ESTTA Tracking number: **ESTTA462139**

Filing date: **03/15/2012**

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	HMS Holdings Corporation		
Entity	Corporation	Citizenship	New York
Address	401 Park Avenue South New York, NY 10016 UNITED STATES		

Attorney information	Angela C. Wilcox Vanek, Vickers & Masini, P.C. 111 South Wacker Drive Suite 4050 Chicago, IL 60606 UNITED STATES methier@vaneklaw.com, awilcox@vaneklaw.com Phone:3122241500		
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Applicant Information

Application No	85424329	Publication date	02/21/2012
Opposition Filing Date	03/15/2012	Opposition Period Ends	03/22/2012
Applicant	Highmark Medicare Services Suite 1A L2 1800 Center Street Camp Hill, PA 17011 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: administration of health care benefit programs

Applicant Information

Application No	85426644	Publication date	02/28/2012
Opposition Filing Date	03/15/2012	Opposition Period Ends	03/29/2012
Applicant	Highmark Medicare Services Suite 1A L2 1800 Center Street Camp Hill, PA 17011 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. All goods and services in the class are opposed, namely: Administration of health care benefit programs

Grounds for Opposition

Other	Priority of Opposer's common law use of the HMS trademark and false designation of origin/likelihood of confusion under 15 U.S.C. Â§ 1125(a)
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Attachments	HMSPHERE_Consolidated Notice of Opposition_Final__CPDF_03 15 2012.pdf (5 pages)(174081 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Angela C. Wilcox/
Name	Angela C. Wilcox
Date	03/15/2012

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

*In re Application Serial Nos. 85-424,329: HMSphere in International Class 36
85-426,644: HMSPHERE+DESIGN in International Class 36*

HMS HOLDINGS CORPORATION)
)
 Opposer,)
)
 v.) Opposition No. _____
)
 HIGHMARK MEDICARE SERVICES)
 CORPORATION)
)
 Applicant.)

CONSOLIDATED NOTICE OF OPPOSITION

HMS Holdings Corporation ("HMS"), a New York corporation with a principal place of business at 401 Park Avenue South, New York, NY 10016, believes it will be damaged by registration of the marks HMSphere and HMSPHERE+DESIGN for "administration of health care benefit programs" in International Class 36 (Application Serial Nos. 85-424,329 and 85-426,644), and hereby opposes the same.

As grounds for opposition, HMS alleges as follows:

1. HMS, through its wholly-owned subsidiary Health Management Systems, Inc., a New York Corporation also located at 401 Park Avenue South, New York, NY 10016, is a nationally-known leader of health care services in the areas of cost containment, fraud and abuse identification, eligibility determination, eligibility and claim audits, and medical review. With a reputation as a leading provider of health care services for government-funded, commercial, and

private healthcare entities, HMS's services are well-known throughout the health care industry for their innovation, high quality, value, and reliability.

2. Since long before Applicant's filing dates, HMS, through its wholly-owned subsidiary Health Management Systems, Inc., has continuously used the HMS acronym as a trademark in connection with a broad array of health care related services provided to government-funded, commercial, and private healthcare entities, such as Medicaid, the Centers for Medicare & Medicaid Services, HMOs, and managed care organizations.

3. HMS has sold hundreds of millions of dollars' worth of the aforesaid health care related services under the HMS mark in the United States, and has spent substantial sums in developing, producing, advertising and marketing such services under the HMS trademark.

4. HMS, through its wholly-owned subsidiary Health Management Systems, Inc., is the registered owner of the domain name www.hms.com, which is an integral part of its business and on which HMS uses the trademark HMS extensively to advertise its services.

5. By virtue of HMS's aforesaid extensive use, sales, advertising and promotions, the HMS trademark represents extraordinarily valuable goodwill.

6. Applicant, like HMS, provides health care related services to government entities, including the Centers for Medicare & Medicaid Services. On September 16, 2011 and September 20, 2011, respectively, Applicant filed intent-to-use applications to register the marks HMSphere and HMSPHERE+DESIGN in connection with "administration of health care benefit programs" in International Class 36.

7. On information and belief, Applicant knew or had reason to know of HMS's extensive use of and prior rights in the HMS trademark when Applicant applied to register the HMSphere and HMSPHERE+DESIGN marks.

8. On information and belief, neither Applicant nor any predecessor or related company of Applicant has any basis for claiming rights in the HMSphere or HSMSPHERE+DESIGN marks prior to September 16, 2011 or September 20, 2011, the respective filing dates of Applicant's HMSphere and HMSPHERE+DESIGN applications.

9. Applicant's applications to register the marks HMSphere and HMSPHERE+DESIGN are without HMS's consent or permission.

10. The marks which Applicant seeks to register fully contain HMS's HMS trademark in capital letters as the primary feature and, under 15 U.S.C. § 1125(a)(1)(A), the use and registration thereof would be likely to result in confusion, mistake or deception with HMS's HMS trademark and to create a false impression that Applicant and its services are affiliated, connected, or associated with, or licensed or approved by HMS.

11. Further, any defect, objection or fault found with Applicant's services marketed under the applied-for HMSphere and HMSPHERE+DESIGN marks may reflect upon and irreparably injure the reputation that HMS has established for its services in association with its HMS trademark.

WHEREFORE, registration by Applicant of the HMSphere and HMSPHERE+DESIGN marks would be damaging to HMS, and HMS respectfully requests that the HMSphere and HMSPHERE marks be denied registration.

Payment of \$600.00, the requisite filing fee for this consolidated opposition, is submitted herewith. Please address all correspondence to Angela C. Wilcox, Esq., at Vanek, Vickers & Masini, P.C., 111 South Wacker Drive, Suite 4050, Chicago, Illinois, 60606, telephone 312.224.1500.

Dated: March 15, 2012

Respectfully submitted,

VANEK, VICKERS & MASINI, P.C.

By: /s/ Angela C. Wilcox
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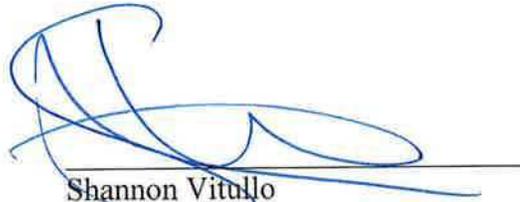
CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the foregoing CONSOLIDATED NOTICE OF OPPOSITION is being served by Certified Mail Return Receipt Requested, postage prepaid, this 15th day of March, 2012, on Applicant in care of Applicant's attorney of record:

JOHN A. GREENBAUM
1800 CENTER STREET
CAMP HILL, PA 17011-1702

Executed this 15th day of March, 2012

at Chicago, Illinois.



Shannon Vitullo