

ESTTA Tracking number: **ESTTA1386654**Filing date: **09/30/2024**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Ex Parte Appeal - Serial No.	90640003
Appellant	Masimo Corporation
Applied for mark	HOSPITAL AUTOMATION
Correspondence address	DEBORAH S. SHEPHERD KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES Primary email: efilings@knobbe.com 949-760-0404
Submission	Request for remand/amendment
Attachments	2024-09-30 Request for Remand - MASIT.986T.pdf(121004 bytes) Exhibit A - MASIT.986T.pdf(591986 bytes) Exhibit B - MASIT.986T.pdf(105324 bytes) Exhibit C - MASIT.986T.pdf(92427 bytes)
Filer's name	Charles K. Crane
Filer's email	efiling@knobbe.com
Signature	/CKC/
Date	09/30/2024

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

Applicant	:	Masimo Corporation
Serial No.	:	90/640003
Filing Date	:	April 12, 2021
Mark	:	HOSPITAL AUTOMATION

**APPLICANT’S MOTION FOR REMAND TO AMEND THE SUBJECT APPLICATION
TO SEEK REGISTRATION ON THE SUPPLEMENTAL REGISTER**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Pursuant to T.B.M.P. §§1205.01 and 1209.04, Masimo Corporation (“Applicant”) hereby requests that the Trademark Trial and Appeal Board (“Board”) suspend the appeal and remand U.S. Serial No. 90/640003 (“Subject Application”) to the Examining Attorney for entry of an Amendment to Allege Use and an amendment to seek registration on the Supplemental Register. The current deadline for submission of Applicant’s appeal brief is October 11, 2024.

Specifically, the Subject Application has been refused on the grounds that, in the Examining Attorney’s opinion, the wording “HOSPITAL AUTOMATION” is merely descriptive of a purpose, feature, or use of Applicant’s applied-for goods and services.

On June 5, 2024, Applicant submitted a Response to Office Action in which Applicant requested that the Subject Application be amended to seek registration on the Supplemental

Register to resolve the Section 2(e)(1) refusal. *See Exhibit A.* On June 13, 2024, the Examining Attorney denied Applicant’s Request for Reconsideration on the grounds that Applicant had not filed an acceptable Amendment to Allege Use. *See Exhibit B.* On September 27, 2024, Applicant filed an Amendment to Allege Use with the U.S. Patent and Trademark Office to comply with the requirement set forth by the Examining Attorney. *See Exhibit C.*

The Section 2(e)(1) refusal and Applicant’s amendment to seek registration on the Supplemental Register are the only issues on appeal. Accordingly, by allowing the Subject Application to be remanded to the Examining Attorney for entry of the Amendment to Allege Use and the amendment to seek registration on the Supplemental Register, the appeal will be rendered moot. As the amendments are an attempt to comply with the Examining Attorney’s requirement and will resolve all the issues on appeal, Applicant submits that it has good cause for its Request for Remand. *See T.B.M.P. §1205.01(b)(1)* (“Good cause will generally be found, for example... when the amendment will obviate a ground for refusal, such as an amendment to the Supplemental Register...”). If the Board has any questions, they are invited to contact the undersigned attorneys.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 30, 2024

By: /Charles K. Crane/
Gregory B. Phillips
Charles K. Crane
Attorneys for Applicant
2040 Main Street
14th Floor
Irvine, CA 92614
(949) 760-0404
efiling@knobbe.com

Exhibit A

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	90640003
MARK SECTION	
MARK	mark
LITERAL ELEMENT	HOSPITAL AUTOMATION
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1732271938-2024060513_1545402971_Response to Office Action - MASIT.986 T.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT18\IMAGEOUT 18\906\400\90640003\xml11 \ROA0002.JPG
	\\TICRS\EXPORT18\IMAGEOUT 18\906\400\90640003\xml11 \ROA0003.JPG
DESCRIPTION OF EVIDENCE FILE	Response to Office Action
ATTORNEY INFORMATION (current)	
NAME	DEBORAH S. SHEPHERD
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	KNOBBE, MARTENS, OLSON & BEAR, LLP
STREET	2040 MAIN STREET, 14TH FLOOR
CITY	IRVINE
STATE	California
POSTAL CODE	92614
COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	United States
PHONE	949-760-0404
FAX	949-760-9502
EMAIL	efiling@knobbe.com
DOCKET/REFERENCE NUMBER	MASIT.986T
ATTORNEY INFORMATION (proposed)	

NAME	DEBORAH S. SHEPHERD
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	KNOBBE, MARTENS, OLSON & BEAR, LLP
INTERNAL ADDRESS	KNOBBE, MARTENS, OLSON & BEAR, LLP
STREET	2040 MAIN STREET, 14TH FLOOR
CITY	IRVINE
STATE	California
POSTAL CODE	92614
COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	United States
PHONE	949-760-0404
FAX	949-760-9502
EMAIL	efiling@knobbe.com
DOCKET/REFERENCE NUMBER	MASIT.986T
OTHER APPOINTED ATTORNEY	Edward A. Schlatter, Joseph R. Re, Catherine J. Holland, Jeffrey L. Van Hoosear, Daniel E. Altman, Lynda J. Zadra-Symes, Stephen C. Jensen, Steven J. Nataupsky, Joseph F. Jennings, Craig S. Summers, Ronald J. Schoenbaum, John R. King, Adeel S. Akhtar, David N. Weiss, Stacey R. Halpern, Joseph M. Reisman, Michael L. Fuller, Paul N. Conover, Robert J. Roby, Sabin H. Lee, William R. Zimmerman, Eric S. Furman, Susan M. Natland, Bruce S. Itchkawitz, John M. Grover, Irfan A. Lateef, Mark J. Gallagher, Brian C. Horne, Sheila N. Swaroop, Benjamin A. Katzenellenbogen, Andrew N. Merickel, Linda H. Liu, James F. Herkenhoff, Andrew M. Douglas, Salima A. Merani, Jonathan A. Hyman, Curtiss C. Dosier, Joseph J. Mallon, Sean M. Murray, Christy G. Lea, Perry D. Oldham, Russell M. Jeide, Matthew S. Bellinger, Gregory A. Hermanson, Lauren Keller Katzenellenbogen, Ted M. Cannon, Carol Pitzel Cruz, Josué A. Villalta, Andrew I. Kimmel, Brenden Gingrich, Maria Culic Anderson, Melanie J. Seelig, Mauricio A. Uribe, Curtis R. Huffmire, Christopher L. Ross, Eli A. Loots, Ryan E. Melnick, Yanna S. Bouris, Philip M. Nelson, Marko R. Zoretic, Derek C. Dailey, Jarom D. Kesler, Colin B. Heideman, Theodore G. Papagiannis, Nicholas M. Zovko, Adam J. Gilbert, Kimberly J. Miller, Agnes Juang, Jason J. Jardine, Jared C. Bunker, Lance D. Smemoe, Joshua J. Stowell, Jonathan E. Bachand, Ali S. Razai, Terry K. Tullis, Derek R. Bayles, Cheryl T. Burgess, Gregory B. Phillips, Brian C. Claassen, Mark Lezama, Sean Ambrosius, Stephen W. Larson, Michael R. Christensen, Benjamin J. Everton, Jason A. Gersting, Baraa Kahf, Alan G. Laquer, Vlad Teplitskiy, Jeffery L. Hallstrom, Maria V. Stout, William O. Adams, Ian W. Gillies, Andrew W. Lloyd, Mark D. Kachner, Lincoln S. Essig, David R. Trossen, Aaron M. Davis, Jason R. Swartz, Benjamin B. Anger, Jason A. Champion, Daniel V. Gibson, Jeremy J. Carney, Karen Cassidy Selvaggio, Adam B. Powell, Karen J. Lenker, Bryan G. McWhorter, Nathanael R. Luman, Andrea L. Cheek, Damien J. Howard, Jane Q. Dai, Shannon Lam, Peter Law, Jacob Peterson, Christie R.W. Matthaehi, Vladimir S. Lozan, Paul S. Stellman, Heungsoo Choi, Vikas Bhargava, Jeremy A. Anapol, Scott A. Cromar, Kendall M. Loebbaka, David R. Schmidt, Harnik Shukla, Charlene A. Azema, Morgan R. Coates, Jessica L. Achtsam, Jonathan A. Menkes, Rosaleen H. Chou, Kyu S. Min, Chang Sik Lim, Thomas S.H. Cowan, Devanie A. DuFour, Hans L. Mayer, Jessica C. Sganga, Justin J. Gillett, Alexander J. Martinez, Brian M. Graham, Brian J. Flynn, Mitchell B. Hadley, Robert J. Hilton, Daniel P. Hughes, Jeremiah S. Helm, David M. Cohen, Jordan Gottdank, Nathan D. Reeves, Brandon G. Smith, Xiaoyan Sabrina Wang, Kregg A. Koch, Daniel C. Kiang, Daniel A. Kamkar, Jacob R. Rosenbaum, Douglas B. Wentzel, Aaron S. Johnson, Bryan J. Johnson, Mark D. Marsden, Joan Y. Chan, Nicholas A. Belair, Angela K. Dremann,

Ashley C. Morales, Mark Rubinshtein, Clayton R. Henson, Aryeh N. Feinstein, Lindsay A. Laddaran, Janet M. Allendorph, Alexander Zeng, Samuel I. Cockriel, Serah R. Friedman, Justin E. Culbertson, Marissa M. Rosenbaum, Christopher L. Lewis, Ben K. Shiroma, Makoto Tsunozaki, Paige L. Cappelli, Matthew S. Friedrichs, Silas K. Alexander, Brian C. Barnes, Spencer R. Carter, Xiaoyu Shelley Chen, Laura E. Liebman, Katherine R. McMorrow, Alexander G. Trimes, Logan P. Young, Julie T. Vo, Jose A. Martin del Campo, Michelle J. Ziperstein, Cesar A. Estrada, Hyunjin Park, Matthew T. Pham, Julia N. Hanson, Brianne M. Kingery, Joshua C. Loader, Raymond S. Lu, Alistair J. McIntyre, Morgan E. Robertson, Geetha Durairaj, Joseph A.R. Gerber, Holly M. Gordon, Inzer C. Ni, Charles K. Crane, Christian D. Boettcher, Nefi R. Oliva, Stacy L. N. Rush, Arash Pia, Paul D. Spiel, Savannah J. Torborg, Matthew S. Whitehead, Raina J. Patel, Brittany M. Penn, PoAn Chen, Mengmeng Du, Zachary B. Messick, Kenneth O. Aruda, Matthew J. Petersen, Rhett D. Ramsey, Joel D. Andersen, Adam G. Copeland, Tyler S. Cox, Douglas W. Crandell, Brandon D. Hupka, Jeremy P. Johansen, Emily K. McCorry, Daniel M. Mittelstein, Shloka K. Raghavan, Matthew C. Ruth, Robert W. Servilio, Justin K. Theam, Eric L. Wittgrove, Chunbaixue Yang, Rory R. Lootsma, Susan E. Pratt, Christy M. Goudamanis, John P.B. Hendershott, Kemarie Jorgensen, Nicole E. Kim, Susan M. Janicki, Juhyun Kim, Sara Witty, Rachel J. Zacuto, Jamal L. Perry, James M. Raleigh, Charles J. Sirek, Harper L. Beasley, Jordan A. DeOrio, Jacob J. Golan, Anna Hankal, Shawn P. Hickey, Luke D. Holbrook, Andrew Huntsinger, Juliana H. Kirby, Isabella C. Pestana, Kelsey S. Weinman, Abigail K. Dagher, Zachary B. Grinovich, Sashank Krothapally, Emmett J. Litvak, Nickolas R.S. Taylor, Melis Tirhi, Zoe Vikstrom, Baiyu Zhu, Ryan B. Freedman, Jae Jin Lee, Ryan M. Newell, Joshua M. Martineau, Sophia F. Zahn, Martin S. Sulsky, Tirzah A. Lowe, Deborah S. Shepherd, Elenore Niu, Erin M. Cardinal, Paige E. Radtke, and Aerie Y. Lin

CORRESPONDENCE INFORMATION

NAME	DEBORAH S. SHEPHERD
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	efiling@knobbe.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	NOT PROVIDED
DOCKET/REFERENCE NUMBER	MASIT.986T

SIGNATURE SECTION

RESPONSE SIGNATURE	/CKC/
SIGNATORY'S NAME	Charles K. Crane
SIGNATORY'S POSITION	Attorney of record, California Bar member
SIGNATORY'S PHONE NUMBER	9497600404
DATE SIGNED	06/05/2024
ROLE OF AUTHORIZED SIGNATORY	Authorized U.S.-Licensed Attorney
SIGNATURE METHOD	Sent to third party for signature

FILING INFORMATION SECTION

SUBMIT DATE	Wed Jun 05 13:37:21 ET 2024
TEAS STAMP	USPTO/ROA-XXX.XXX.XX.XX-2 0240605133721706595-90640 003-850f1a1f01a6789a16f55 b54d81ab96aca6c3985cab62a ec3633bdeef92214-N/A-N/A -20240605131545402971

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **90640003** HOSPITAL AUTOMATION(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/90640003/large>) has been amended as follows:

EVIDENCE

Evidence has been attached: Response to Office Action

Original PDF file:

[evi_1732271938-2024060513_1545402971_. Response to Office Action - MASIT.986 T.pdf](#)

Converted PDF file(s) (2 pages) [Evidence-1Evidence-2](#)

The owner's/holder's current attorney information: DEBORAH S. SHEPHERD. DEBORAH S. SHEPHERD of KNOBBE, MARTENS, OLSON & BEAR, LLP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, is located at

2040 MAIN STREET, 14TH FLOOR

IRVINE, California 92614

United States

The docket/reference number is MASIT.986T.

The phone number is 949-760-0404.

The fax number is 949-760-9502.

The email address is efiling@knobbe.com

The owner's/holder's proposed attorney information: DEBORAH S. SHEPHERD. Other appointed attorneys are Edward A. Schlatter, Joseph R. Re, Catherine J. Holland, Jeffrey L. Van Hoosear, Daniel E. Altman, Lynda J. Zadra-Symes, Stephen C. Jensen, Steven J. Nataupsky, Joseph F. Jennings, Craig S. Summers, Ronald J. Schoenbaum, John R. King, Adeel S. Akhtar, David N. Weiss, Stacey R. Halpern, Joseph M. Reisman, Michael L. Fuller, Paul N. Conover, Robert J. Roby, Sabing H. Lee, William R. Zimmerman, Eric S. Furman, Susan M. Natland, Bruce S. Itchkawitz, John M. Grover, Irfan A. Lateef, Mark J. Gallagher, Brian C. Horne, Sheila N. Swaroop, Benjamin A. Katzenellenbogen, Andrew N. Merickel, Linda H. Liu, James F. Herkenhoff, Andrew M. Douglas, Salima A. Merani, Jonathan A. Hyman, Curtiss C. Dosier, Joseph J. Mallon, Sean M. Murray, Christy G. Lea, Perry D. Oldham, Russell M. Jeide, Matthew S. Bellinger, Gregory A. Hermanson, Lauren Keller Katzenellenbogen, Ted M. Cannon, Carol Pitzel Cruz, Josué A. Villalta, Andrew I. Kimmel, Brenden Gingrich, Maria Culic Anderson, Melanie J. Seelig, Mauricio A. Uribe, Curtis R. Huffmire, Christopher L. Ross, Eli A. Loots, Ryan E. Melnick, Yanna S. Bouris, Philip M. Nelson, Marko R. Zoretic, Derek C. Dailey, Jarom D. Kesler, Colin B. Heideman, Theodore G. Papagiannis, Nicholas M. Zovko, Adam J. Gilbert, Kimberly J. Miller, Agnes Juang, Jason J. Jardine, Jared C. Bunker, Lance D. Smemoe, Joshua J. Stowell, Jonathan E. Bachand, Ali S. Razai, Terry K. Tullis, Derek R. Bayles, Cheryl T. Burgess, Gregory B. Phillips, Brian C. Claassen, Mark Lezama, Sean Ambrosius, Stephen W. Larson, Michael R. Christensen, Benjamin J. Everton, Jason A. Gersting, Baraa Kahf, Alan G. Laquer, Vlad Teplitskiy, Jeffery L. Hallstrom, Maria V. Stout, William O. Adams, Ian W. Gillies, Andrew W. Lloyd, Mark D. Kachner, Lincoln S. Essig, David R. Trossen, Aaron M. Davis, Jason R. Swartz, Benjamin B. Anger, Jason A. Champion, Daniel V. Gibson, Jeremy J. Carney, Karen Cassidy Selvaggio, Adam B. Powell, Karen J. Lenker, Bryan G. McWhorter, Nathanael R. Luman, Andrea L. Cheek, Damien J. Howard, Jane Q. Dai, Shannon Lam, Peter Law, Jacob Peterson, Christie R.W. Matthaehi, Vladimir S. Lozan, Paul S. Stellman, Heungsoo Choi, Vikas Bhargava, Jeremy A. Anapol, Scott A. Cromar, Kendall M. Loebbaka, David R. Schmidt, Harnik Shukla, Charlene A. Azema, Morgan R. Coates, Jessica L. Achtsam, Jonathan A. Menkes, Rosaleen H. Chou, Kyu S. Min, Chang Sik Lim, Thomas S.H. Cowan, Devanie A. DuFour, Hans L. Mayer, Jessica C. Sganga, Justin J. Gillett, Alexander J. Martinez, Brian M. Graham, Brian J. Flynn, Mitchell B. Hadley, Robert J. Hilton, Daniel P. Hughes, Jeremiah S. Helm, David M. Cohen, Jordan Gottdank, Nathan D. Reeves, Brandon G. Smith, Xiaoyan Sabrina Wang, Kregg A. Koch, Daniel C. Kiang, Daniel A. Kamkar, Jacob R. Rosenbaum, Douglas B. Wentzel, Aaron S. Johnson, Bryan J. Johnson, Mark D. Marsden, Joan Y. Chan, Nicholas A. Belair, Angela K. Dremann, Ashley C. Morales, Mark Rubinshtein, Clayton R. Henson, Aryeh N. Feinstein, Lindsay A. Laddaran, Janet M. Allendorph, Alexander Zeng, Samuel I. Cockriel, Serah R. Friedman, Justin E. Culbertson, Marissa M. Rosenbaum, Christopher L. Lewis, Ben K. Shiroma, Makoto Tsunozaki, Paige L. Cappelli, Matthew S. Friedrichs, Silas K. Alexander, Brian C. Barnes, Spencer R. Carter, Xiaoyu Shelley Chen, Laura E. Liebman, Katherine R. McMorro, Alexander G. Trimes, Logan P. Young, Julie T. Vo, Jose A. Martin del Campo, Michelle J. Ziperstein, Cesar A. Estrada, Hyunjin Park, Matthew T. Pham, Julia N. Hanson, Brianne M. Kingery, Joshua C. Loader, Raymond S. Lu, Alistair J. McIntyre, Morgan E. Robertson, Geetha Durairaj, Joseph A.R. Gerber, Holly M. Gordon, Inzer C. Ni, Charles K. Crane, Christian D. Boettcher, Nefi R. Oliva, Stacy L. N. Rush, Arash Pia, Paul D. Spiel, Savannah J. Torborg, Matthew S. Whitehead, Raina J. Patel, Brittany M. Penn, PoAn Chen, Mengmeng Du, Zachary B. Messick, Kenneth O. Aruda, Matthew J. Petersen, Rhett D. Ramsey, Joel D. Andersen, Adam G. Copeland, Tyler S. Cox, Douglas W. Crandell, Brandon D. Hupka, Jeremy P. Johansen, Emily K. McCorry, Daniel M. Mittelstein, Shloka K. Raghavan, Matthew C. Ruth, Robert W. Servilio, Justin K. Theam, Eric L. Wittgrove, Chunbaixue Yang, Rory R. Lootsma, Susan E. Pratt, Christy M. Goudamanis,

John P.B. Hendershott, Kемarie Jorgensen, Nicole E. Kim, Susan M. Janicki, Juhyun Kim, Sara Witty, Rachel J. Zacuto, Jamal L. Perry, James M. Raleigh, Charles J. Sirek, Harper L. Beasley, Jordan A. DeOrio, Jacob J. Golan, Anna Hankal, Shawn P. Hickey, Luke D. Holbrook, Andrew Huntsinger, Juliana H. Kirby, Isabella C. Pestana, Kelsey S. Weinman, Abigail K. Dagher, Zachary B. Grinovich, Sashank Krothapally, Emmett J. Litvak, Nickolas R.S. Taylor, Melis Tirhi, Zoe Vikstrom, Baiyu Zhu, Ryan B. Freedman, Jae Jin Lee, Ryan M. Newell, Joshua M. Martineau, Sophia F. Zahn, Martin S. Sulsky, Tirzah A. Lowe, Deborah S. Shepherd, Elenore Niu, Erin M. Cardinal, Paige E. Radtke, and Aerie Y. Lin. DEBORAH S. SHEPHERD of KNOBBE, MARTENS, OLSON & BEAR, LLP, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, and the attorney(s) is located at

KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
IRVINE, California 92614
United States

The docket/reference number is MASIT.986T.

The phone number is 949-760-0404.

The fax number is 949-760-9502.

The email address is efilings@knobbe.com

DEBORAH S. SHEPHERD submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

Correspondence Information

DEBORAH S. SHEPHERD

PRIMARY EMAIL FOR CORRESPONDENCE: efilings@knobbe.com

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is MASIT.986T.

Requirement for Email and Electronic Filing: I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

SIGNATURE(S)

Response Signature

Signature: /CKC/ Date: 06/05/2024

Signatory's Name: Charles K. Crane

Signatory's Position: Attorney of record, California Bar member

Signatory's Phone Number: 9497600404 Signature method: Sent to third party for signature

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: DEBORAH S. SHEPHERD
KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 MAIN STREET, 14TH FLOOR
IRVINE, California 92614

Mailing Address: DEBORAH S. SHEPHERD
KNOBBE, MARTENS, OLSON & BEAR, LLP
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
IRVINE, California 92614

Serial Number: 90640003

Internet Transmission Date: Wed Jun 05 13:37:21 ET 2024

TEAS Stamp: USPTO/ROA-XXX.XXX.XX.XX-2024060513372170
6595-90640003-850f1a1f01a6789a16f55b54d8
1ab96aca6c3985cab62aec3633bdeef92214-N/
A-N/A-20240605131545402971

Mark: HOSPITAL AUTOMATION
Serial No.: 90/640003
Applicant: Masimo Corporation
International Classes: 009, 036, 037 and 042
Internal Reference: MASIT.986T

Response to Office Action

Masimo Corporation (“Applicant”) submits the following remarks and amendments in response to the Office Action issued in the matter of U.S. Serial No. 90/640003 (“Subject Application”) for the HOSPITAL AUTOMATION mark (“Applicant’s Mark”).

Remarks

I. SECTION 2(e)(1) REFUSAL

In the Office Action, the Examining Attorney maintains the refusal of Applicant’s Mark on descriptiveness grounds because purportedly the mark merely describes a purpose, function, or use of Applicant’s goods and services. Applicant disagrees and submits that Applicant’s Mark is, at minimum, suggestive. As set forth in Applicant’s previous Response to Office Action, the wording “HOSPITAL AUTOMATION” has no recognized meaning, and a consumer viewing Applicant’s Mark must go through a multi-step reasoning process in order to ascertain any possible meaning between the wording “HOSPITAL AUTOMATION” and Applicant’s goods and services.

Notwithstanding the above, solely to expedite the prosecution of Applicant’s Mark, Applicant requests that the Subject Application be amended to the Supplemental Register.

Amendments

II. AMENDMENT TO SUPPLEMENTAL REGISTER

Although Applicant maintains that Applicant’s Mark is not merely descriptive, and without waiving all common law rights that Applicant maintains in Applicant’s Mark, Applicant requests

that the Subject Application be amended to the Supplemental Register.

Following the submission of this Response to Office Action, Applicant plans to file an Amendment to Allege Use to amend the filing basis from Section 1(b) to 1(a).

Conclusion

Applicant submits that it has responded to all issues raised in the Office Action and requests that the mark be approved for registration. Should the Examining Attorney have any questions, the Examining Attorney is encouraged to contact the undersigned attorney.

Exhibit B

To: DEBORAH S. SHEPHERD(efiling@knobbe.com)
Subject: U.S. Trademark Application Serial No. 90640003 - HOSPITAL AUTOMATION - - MASIT.986T
Sent: June 13, 2024 06:03:48 AM EDT
Sent As: tmng.notices@uspto.gov

Attachments

**United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application**

U.S. Application Serial No. 90640003

Mark: HOSPITAL AUTOMATION

Correspondence Address:

DEBORAH S. SHEPHERD
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET, 14TH FLOOR
KNOBBE, MARTENS, OLSON & BEAR, LLP
IRVINE CA 92614
United States

Applicant: MASIMO CORPORATION

Reference/Docket No. MASIT.986T

Correspondence Email Address: efiling@knobbe.com

SUBSEQUENT FINAL OFFICE ACTION

Issue date: June 13, 2024

INTRODUCTION

This Office action is in response to applicant's communication filed on June 5, 2024.

In a previous Office action(s) dated December 5, 2023, the trademark examining attorney issued the following refusal(s) and/or requirement(s):

- Section 2(e)(1) Refusal - Merely Descriptive
- Refusal - Amendment to Supplemental Register Unacceptable

The trademark examining attorney maintains and now makes FINAL the refusal(s) and/or requirement(s) in the summary of issues below. *See* 37 C.F.R. §2.63(b); TMEP §714.04.

SUMMARY OF ISSUES

- Section 2(e)(1) Refusal - Merely Descriptive
- Refusal - Amendment to Supplemental Register Unacceptable

SECTION 2(e)(1) REFUSAL - MERELY DESCRIPTIVE

Registration is refused because the applied-for mark merely describes a purpose, function or use of applicant's goods and services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if "it immediately conveys knowledge of a quality, feature, function, or characteristic of [an applicant's] goods or services." *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b); *see DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 814, 200 USPQ 215, 218 (C.C.P.A. 1978)).

In the present case, applicant's proposed mark is HOSPITAL AUTOMATION for the following goods and services:

- International Class 009: Downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing, and displaying information and alerts relating to medical conditions; Downloadable communication software to facilitate communications among patients and medical personnel, or between medical personnel; Downloadable computer software for admitting, discharging, and transferring patients from hospitals; Downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment
- International Class 036: Extended warranty services, namely, service contracts
- International Class 037: Installation of monitoring and data reporting systems consisting of computer hardware
- International Class 042: Computer network configuration services for monitoring and data reporting systems consisting of hardware and software; Computer network configuration services for medical monitoring and data reporting systems consisting of hardware and software; Providing temporary use of non-downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing and displaying information and alerts relating to medical conditions; Providing temporary use of non-downloadable communication software to facilitate communications among patients and medical personnel, and between medical personnel; Providing temporary use of non-downloadable computer software for admitting, discharging, and transferring patients from hospitals; Providing temporary use of non-downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Providing temporary use of non-downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed

positioning, communication systems, or audio and visual equipment; Updating of computer software; Installation of computer software for monitoring and data reporting systems

The previously attached dictionary evidence from Merriam-Webster shows that the term HOSPITAL is defined as "an institution where the sick or injured are given medical or surgical care" and the term AUTOMATION is defined as "the technique of making an apparatus, a process, or a system operate automatically" or "the state of being operated automatically." Similar dictionary evidence further supporting the understanding of these terms was previously attached from The American Heritage Dictionary of the English Language and Macmillan Dictionary.

Thus, the wording merely describes a function, feature, purpose, or use of applicant's goods and/or services, i.e., the Class 9 and Class 42 software is for automatically operating medical equipment in an institution where the sick or injured are given medical or surgical care, and the Class 36 service contracts, Class 37 installation services, Class 41 education and training services, and Class 42 configuration and software updating services are all in the field of and/or to permit clients to use equipment that is operated automatically in an institution where the sick or injured are given medical or surgical care.

This understanding is confirmed by the previously attached excerpt from applicant's website (<https://www.masimo.com/hospital-automation/>), noting that "Masimo hospital automation integrates patient monitoring ... with sophisticated connectivity and interoperability solutions to seamlessly provide access to the most accurate, relevant patient data in the most helpful ways at the most important moments".

Applicant argues that the mark is suggestive because HOSPITAL AUTOMATION does not have a dictionary definition. The fact that a word or term is not found in the dictionary is not controlling on the question of registrability. *In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *8 (TTAB 2019) (citing *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1603 (TTAB 2014); *In re Dairimetics, Ltd.*, 169 USPQ 572, 573 (TTAB 1971)); TMEP §1209.03(b); *see In re Gould Paper Corp.*, 834 F.2d 1017, 1018, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987).

Further, if the individual components of a mark retain their descriptive meaning in relation to the goods and/or services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016) (citing *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1317-18 (TTAB 2002)); TMEP §1209.03(d); *see, e.g., In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015) (holding SMART SERIES merely descriptive of metal gun safes); *In re King Koil Licensing Co.*, 79 USPQ2d 1048, 1052 (TTAB 2006) (holding THE BREATHABLE MATTRESS merely descriptive of beds, mattresses, box springs, and pillows).

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the goods and/or services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

In this case, both the individual components and the composite result are descriptive of applicant's goods and/or services and do not create a unique, incongruous, or nondescriptive meaning in relation to the goods and/or services. Specifically, consumers would understand HOSPITAL AUTOMATION, as

a phrase, to describe applicant's goods' ability to operate automatically or cause other devices to operate automatically in a hospital setting.

Applicant also argues that the mark is suggestive because it requires a multi-step process of thought to arrive at the goods and/or services at issue. However, the determination of whether a mark is merely descriptive is made in relation to an applicant's goods and/or services, not in the abstract. *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); TMEP §1209.01(b). "Whether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Next, applicant argues that the mark is suggestive because the terms HOSPITAL AUTOMATION form an incongruous phrase. A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 1332, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251-52, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012)); TMEP §1209.01(a). A composite mark that is "incongruous" is one where the combination of terms results in a "bizarre" meaning. TMEP §1209.03(d). That is not the case here because the phrase would be immediately understood by consumers as referring to the automation of devices and procedures used in a hospital; no secondary or bizarre meaning exists.

Finally, applicant argues that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. *E.g.*, *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

Applicant's proposed mark is therefore refused as merely descriptive under Trademark Act Section 2(e)(1).

Please note, if applicant properly amends the application to the Supplemental Register after submitting an amendment to allege use, this refusal will be withdrawn.

Applicant should note the following additional ground for refusal.

REFUSAL -- AMENDMENT TO SUPPLEMENTAL REGISTER UNACCEPTABLE

Registration is refused on the Supplemental Register because the proposed mark is not in lawful use in commerce, as required by Trademark Act Section 23(a). *See* 15 U.S.C. §1091(a); 37 C.F.R. §2.47(a); TMEP §714.05(a)(i). The application in this case is based solely on applicant's bona fide intention to use the mark in commerce under Section 1(b) and no amendment to allege use has been filed, despite applicant's stated intent in its response to do so. Accordingly, applicant is not eligible for registration on the Supplemental Register until applicant files an acceptable amendment to allege use. *See* 37 C.F.R. §§2.47(d), 2.75(b), 2.76(a)-(c); TMEP §§815.02, 1102.03.

This refusal will be withdrawn if applicant (1) withdraws the amendment to the Supplemental Register

or (2) timely submits an amendment to allege use that meets the requirements of 37 C.F.R. §2.76. *See* 37 C.F.R. §2.47(d); TMEP §§815.02, 1102.03.

If applicant does not withdraw the amendment to the Supplemental Register and provides an acceptable amendment to allege use, the application effective filing date will become the date applicant met the minimum filing requirements under 37 C.F.R. §2.76(c) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03. The trademark examining attorney will then conduct a new search of the Trademark database for potentially conflicting marks based on this later date. TMEP §§206.01, 206.04, 1102.03.

RESPONSE GUIDANCE

Response deadline. File a request for reconsideration of this final Office action and/or a timely appeal to the Trademark Trial and Appeal Board (TTAB) within three months of the “Issue date” below to avoid [abandonment](#) of the application. Review the Office action and respond using one of the links below to the appropriate electronic forms in the “How to respond” section below.

Request an extension. For a fee, applicant may [request one three-month extension](#) of the response deadline prior to filing a response and/or an appeal. The request must be filed within three months of the “Issue date” below. If the extension request is granted, the USPTO must receive applicant’s response and/or appeal within six months of the “Issue date” to avoid abandonment of the application.

How to respond. File a [request form for reconsideration of this final Office action](#) that fully resolves all outstanding requirements and/or refusals and/or file a timely [appeal form to the Trademark Trial and Appeal Board](#) with the required fee(s). Alternatively, applicant may file a [request form for an extension of time to file a response](#) for a fee.

/Andrea Cornwell/
Andrea Cornwell
Examining Attorney
LO115--LAW OFFICE 115
(571) 272-4608
Andrea.Cornwell@USPTO.GOV

RESPONSE GUIDANCE

- **Missing deadline to responding to this letter will cause the application to [abandon](#).** A response, appeal, or extension request must be received by the USPTO before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Trademark Electronic Application System (TEAS) and Electronic System for Trademark Trials and Appeals (ESTTA) [system availability](#) could affect an applicant’s ability to timely respond. For help resolving technical issues with TEAS, email TEAS@uspto.gov.
- [Responses signed by an unauthorized party](#) are not accepted and can **cause the application to**

abandon. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with **legal authority to bind a juristic applicant**. If applicant has an attorney, the response must be signed by the attorney.

- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on June 13, 2024 for
U.S. Trademark Application Serial No. 90640003

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS) or the Electronic System for Trademark Trials and Appeals (ESTTA), as appropriate. Your response and/or appeal must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Otherwise, your application will be **[abandoned](#)**. See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and whether there are outstanding deadlines to the [Trademark Assistance Center \(TAC\)](#).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. Verify the correspondence originated from us by using your serial number in our database, [TSDR](#), to confirm that it appears under the “Documents” tab, or contact the [Trademark Assistance Center](#).

- **[Hiring a U.S.-licensed attorney.](#)** If you do not have an attorney and are not required to have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.

Exhibit C

Filing Receipt for Amendment to Allege Use Form and Next Steps in the Application Process

Application serial no. 90640003.

Mark. HOSPITAL AUTOMATION(Standard Characters, see [mark](#)).

Thank you for submitting your form to the U.S. Patent and Trademark Office (USPTO). Please read this filing receipt carefully and keep a copy for your records. If you find an error, the [After You File](#) page gives information about correcting errors.

Next steps

1. **If you also need to respond to an Office action**, use the [Response to Office Action](#) form and in the Miscellaneous Statement field state that you filed an Amendment to Allege Use form. Filing only an Amendment to Allege Use is not considered a response to the Office action.
2. **If you changed the owner name in the form**, visit our page on [trademark assignments and ownership](#).
3. **In four to five days, please confirm that we received the documents submitted with this form** by checking [Trademark Status and Document Retrieval](#) (TSDR). If your documents do not appear in TSDR after four to five days, please email TrademarkAssistanceCenter@uspto.gov.
4. **Within one to two months, we will review your submission.**

If your submission is accepted, we will send you a notice that the Amendment to Allege Use has been accepted.

If your submission is not accepted, you will receive an Office action explaining why it was not accepted and listing your options for responding.

5. **Continue to check [TSDR](#) every three to four months for any updates to your application status until you receive your registration certificate.**
6. **Keep your addresses, including email addresses, current in USPTO records using the [address forms](#) on our website.**
7. **Questions?** Please visit [our website](#), [email us](#), or call us at 1-800-786-9199 and select option 1.
8. **System experiences issues when trying to connect to message retriever**

The information submitted in the form appears below:

PTO- 1553

Approved for use through 04/30/2027. OMB 0651-0054

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

Trademark/Service Mark Amendment to Allege Use (15 U.S.C. Section 1051(c))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	90640003
EXTENSION OF USE	NO
MARK SECTION	
MARK	mark
LITERAL ELEMENT	HOSPITAL AUTOMATION

STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
OWNER SECTION	
NAME	MASIMO CORPORATION
MAILING ADDRESS	52 Discovery
CITY	Irvine
STATE	California
ZIP/POSTAL CODE	92618
STATE/COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	United States
EMAIL	TMO*****@KNOBBE.COM
CORRESPONDENCE INFORMATION	
NAME	DEBORAH S. SHEPHERD
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	efiling@knobbe.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	NOT PROVIDED
DOCKET/REFERENCE NUMBER	MASIT.986T
GOODS AND/OR SERVICES SECTION	
INTERNATIONAL CLASS	009
CURRENT IDENTIFICATION	Downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing, and displaying information and alerts relating to medical conditions; Downloadable communication software to facilitate communications among patients and medical personnel, or between medical personnel; Downloadable computer software for admitting, discharging, and transferring patients from hospitals; Downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment
GOODS OR SERVICES DELETED FROM THE APPLICATION	; Downloadable communication software to facilitate communications among patients and medical personnel, or between medical personnel; Downloadable computer software for admitting, discharging, and transferring patients from hospitals; Downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital

	bed positioning, communication systems, or audio and visual equipment
GOODS OR SERVICES IN USE IN COMMERCE	Downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing, and displaying information and alerts relating to medical conditions
FIRST USE ANYWHERE DATE	07/00/2020
FIRST USE IN COMMERCE DATE	07/00/2020
SPECIMEN FILE NAME(S)	SPN0-1732271938-202409261 72143110445_._Class_9_-_S pecimen_-_MASIT.986T.pdf
SPECIMEN DESCRIPTION	Excerpts of operator's manual displaying the subject mark and goods; Highlighting added for clarity
WEBPAGE URL	None Provided
WEBPAGE DATE OF ACCESS	None Provided
INTERNATIONAL CLASS	036
CURRENT IDENTIFICATION	Extended warranty services, namely, service contracts
GOODS OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	07/00/2020
FIRST USE IN COMMERCE DATE	07/00/2020
SPECIMEN FILE NAME(S)	SPN1-1732271938-202409261 72143110445_._Class_36_-_Specimen_-_MASIT.986T.pdf
SPECIMEN DESCRIPTION	Printouts of Applicant's website promoting the subject mark and services; Red arrow added for clarity
WEBPAGE URL	Printouts of Applicant's website promoting the subject mark and services; Red arrow added for clarity
WEBPAGE DATE OF ACCESS	09/26/2024
INTERNATIONAL CLASS	037
CURRENT IDENTIFICATION	Installation of monitoring and data reporting systems consisting of computer hardware
GOODS OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	07/00/2020
FIRST USE IN COMMERCE DATE	07/00/2020
SPECIMEN FILE NAME(S)	SPN2-1732271938-202409261 72143110445_._Class_37_-_Specimen_-_MASIT.986T.pdf
SPECIMEN DESCRIPTION	Printouts of Applicant's website promoting the subject mark and services; Red arrow added for clarity
WEBPAGE URL	https://professional.masimo.com/hospital-automation/
WEBPAGE DATE OF ACCESS	09/26/2024
INTERNATIONAL CLASS	042

<p>CURRENT IDENTIFICATION</p>	<p>Computer network configuration services for monitoring and data reporting systems consisting of hardware and software; Computer network configuration services for medical monitoring and data reporting systems consisting of hardware and software; Providing temporary use of non-downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing and displaying information and alerts relating to medical conditions; Providing temporary use of non-downloadable communication software to facilitate communications among patients and medical personnel, and between medical personnel; Providing temporary use of non-downloadable computer software for admitting, discharging, and transferring patients from hospitals; Providing temporary use of non-downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Providing temporary use of non-downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment; Updating of computer software; Installation of computer software for monitoring and data reporting systems</p>
<p>GOODS OR SERVICES DELETED FROM THE APPLICATION</p>	<p>Providing temporary use of non-downloadable communication software to facilitate communications among patients and medical personnel, and between medical personnel; Providing temporary use of non-downloadable computer software for admitting, discharging, and transferring patients from hospitals; Providing temporary use of non-downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Providing temporary use of non-downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment;</p>
<p>GOODS OR SERVICES IN USE IN COMMERCE</p>	<p>Computer network configuration services for monitoring and data reporting systems consisting of hardware and software; Computer network configuration services for medical monitoring and data reporting systems consisting of hardware and software; Providing temporary use of non-downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing and displaying information and alerts relating to medical conditions; Updating of computer software; Installation of computer software for monitoring and data reporting systems</p>
<p>FIRST USE ANYWHERE DATE</p>	<p>07/00/2020</p>
<p>FIRST USE IN COMMERCE DATE</p>	<p>07/00/2020</p>
<p>SPECIMEN FILE NAME(S)</p>	<p>SPN3-1732271938-202409261 72143110445_._Class_42_ - _Specimen_1_ - _MASIT.986T.p</p>
<p>SPECIMEN FILE NAME(S)</p>	<p>SPN3-1732271938-202409261 72143110445_._Class_42_ - _Specimen_2_ - _MASIT.986T.p</p>
<p>SPECIMEN DESCRIPTION</p>	<p>Brochure and printout of Applicant's website promoting the subject mark and services; Red arrow added for clarity</p>
<p>WEBPAGE URL</p>	<p>https://professional.masimo.com/hospital-automation/</p>

WEBPAGE DATE OF ACCESS	09/26/2024
REQUEST TO DIVIDE	NO
PAYMENT SECTION	
NUMBER OF CLASSES IN USE	4
SUBTOTAL AMOUNT [ALLEGATION OF USE FEE]	400
TOTAL AMOUNT	400
SIGNATURE SECTION	
DECLARATION SIGNATURE	/craig johnson/
SIGNATORY'S NAME	Craig Johnson
SIGNATORY'S POSITION	Assistant General Counsel, Senior Vice President
DATE SIGNED	09/26/2024
SIGNATORY'S PHONE NUMBER	9497600404
SIGNATURE METHOD	Sent to third party for signature
FILING INFORMATION	
SUBMIT DATE	Fri Sep 27 11:52:39 ET 2024
TEAS STAMP	USPTO/AAU-173.227.19.38-2 0240927115241103095-90640 003-850e7e27fe91fcc97993b 92fda9458f6ef27e6ba2976a1 557bbbb76a25dc8ded2d-CC-5 2399202-20240926182745169 566

Trademark/Service Mark Amendment to Allege Use (15 U.S.C. Section 1051(c))

To the Commissioner for Trademarks:

MARK: HOSPITAL AUTOMATION(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/90640003/large>)

SERIAL NUMBER: 90640003

OWNER AND/OR ENTITY INFORMATION

The owner proposes to amend the following:

MASIMO CORPORATION, having an address of

52 Discovery

Irvine, California 92618

United States

Email: TMO*****@KNOBBE.COM

The owner is submitting the following allegation of use information:

For International Class 009:

Current identification: Downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing, and displaying information and alerts relating to medical conditions; Downloadable communication software to facilitate communications among patients and medical personnel, or between medical personnel; Downloadable computer software for admitting, discharging, and transferring patients from hospitals; Downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment

This **allegation of use** does **NOT** cover the following goods/services listed in either the application or Notice of Allowance or as subsequently modified for this specific class; these goods/services are **permanently deleted**: ; Downloadable communication software to facilitate communications among patients and medical personnel, or between medical personnel; Downloadable computer software for admitting, discharging, and transferring patients from hospitals; Downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment

The mark is in use in commerce on or in connection with the following goods/services listed in either the application or Notice of Allowance or as subsequently modified for this specific class: Downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing, and displaying information and alerts relating to medical conditions

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 07/00/2020, and first used in commerce at least as early as 07/00/2020, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Excerpts of operator's manual displaying the subject mark and goods; Highlighting added for clarity.

1 [SPN0-1732271938-202409261 72143110445_ _Class_9_ _ _Specimen_ _ _MASIT.986T.pdf]

Webpage URL: None Provided

Webpage Date of Access: None Provided

For International Class 036:

Current identification: Extended warranty services, namely, service contracts

The mark is in use in commerce on or in connection with all of the goods/services, or to indicate membership in the collective organization listed in the application or Notice of Allowance or as subsequently modified for this specific class.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 07/00/2020, and first used in commerce at least as early as 07/00/2020, and is now in use in such commerce. The

applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Printouts of Applicant's website promoting the subject mark and services; Red arrow added for clarity.

1 [SPN1-1732271938-202409261 72143110445_._Class_36_-_Specimen_-_MASIT.986T.pdf]

Webpage URL: Printouts of Applicant's website promoting the subject mark and services; Red arrow added for clarity
Webpage Date of Access: 09/26/2024

For International Class 037:

Current identification: Installation of monitoring and data reporting systems consisting of computer hardware

The mark is in use in commerce on or in connection with all of the goods/services, or to indicate membership in the collective organization listed in the application or Notice of Allowance or as subsequently modified for this specific class.

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 07/00/2020, and first used in commerce at least as early as 07/00/2020, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Printouts of Applicant's website promoting the subject mark and services; Red arrow added for clarity.

1 [SPN2-1732271938-202409261 72143110445_._Class_37_-_Specimen_-_MASIT.986T.pdf]

Webpage URL: <https://professional.masimo.com/hospital-automation/>
Webpage Date of Access: 09/26/2024

For International Class 042:

Current identification: Computer network configuration services for monitoring and data reporting systems consisting of hardware and software; Computer network configuration services for medical monitoring and data reporting systems consisting of hardware and software; Providing temporary use of non-downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing and displaying information and alerts relating to medical conditions; Providing temporary use of non-downloadable communication software to facilitate communications among patients and medical personnel, and between medical personnel; Providing temporary use of non-downloadable computer software for admitting, discharging, and transferring patients from hospitals; Providing temporary use of non-downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Providing temporary use of non-downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment; Updating of computer software; Installation of computer software for monitoring and data reporting systems

This **allegation of use** does **NOT** cover the following goods/services listed in either the application or Notice of Allowance or as subsequently modified for this specific class; these goods/services are **permanently deleted**: Providing temporary use of non-downloadable communication software to facilitate communications among patients and medical personnel, and between medical personnel; Providing temporary use of non-downloadable computer software for admitting, discharging, and transferring patients from hospitals; Providing temporary use of non-downloadable computer software for hospital patients to obtain entertainment options, food, beverages, and personal care products; Providing temporary use of non-downloadable computer software for hospital patients and medical personnel to control patients' environments in the nature of lighting, temperature, HVAC, security, hospital bed positioning, communication systems, or audio and visual equipment;

The mark is in use in commerce on or in connection with the following goods/services listed in either the application or Notice of Allowance or as subsequently modified for this specific class: Computer network configuration services for monitoring and data reporting systems consisting of hardware and software; Computer network configuration services for medical monitoring and data reporting systems consisting of hardware and software; Providing temporary use of non-downloadable computer software for wired and wireless data communication for controlling, receiving, processing, transmitting, aggregating, analyzing and displaying information and alerts relating to medical conditions; Updating of computer software; Installation of computer software for monitoring and data reporting systems

The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 07/00/2020, and first used in commerce at least as early as 07/00/2020, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) Brochure and printout of Applicant's website promoting the subject mark and services; Red arrow added for clarity.

1 [SPN3-1732271938-202409261 72143110445_._Class_42_-_Specimen_1_-_MASIT.986T.pdf]

2 [SPN3-1732271938-202409261 72143110445_._Class_42_-_Specimen_2_-_MASIT.986T.pdf]

Webpage URL: <https://professional.masimo.com/hospital-automation/>
Webpage Date of Access: 09/26/2024

The applicant is not filing a Request to Divide with this Allegation of Use form.

Correspondence Information

DEBORAH S. SHEPHERD
PRIMARY EMAIL FOR CORRESPONDENCE: efiling@knobbe.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is MASIT.986T.

Requirement for Email and Electronic Filing: I understand that a valid email address must be maintained by the applicant owner/holder and the applicant owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

A fee payment in the amount of \$400 has been submitted with the form, representing payment for the allegation of use for 4 classes.

Declaration

- The signatory believes that the applicant is the owner of the mark sought to be registered.
For a trademark or service mark application, the mark is in use in commerce on or in connection with all the goods/services in the application or notice of allowance, or as subsequently modified.
For a collective trademark, collective service mark, collective membership mark application, the applicant is exercising legitimate control over the use of the mark in commerce by members on or in connection with all the goods/services/collective membership organization in the application or notice of allowance, or as subsequently modified.
For a certification mark application, the applicant is exercising legitimate control over the use of the mark in commerce by authorized users on or in connection with the all goods/services in the application or notice of allowance, or as subsequently modified, and the applicant is not engaged in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.
- The specimen(s) shows the mark as used on or in connection with the goods/services/collective membership organization in commerce.
- To the best of the signatory's knowledge and belief, no other persons, except, if applicable, authorized users, members, and/or concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.
- To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: /craig johnson/ Date: 09/26/2024

Signatory's Name: Craig Johnson

Signatory's Position: Assistant General Counsel, Senior Vice President

Signatory's Phone: 9497600404

Signature method: Sent to third party for signature

Thank you,

The TEAS support team

Fri Sep 27 11:52:41 ET 2024

STAMP: USPTO/AAU-173.227.19.38-20240927115241103095-90640003-

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