

ESTTA Tracking number: **ESTTA889359**

Filing date: **04/11/2018**

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	U.S. Department of Health and Human Services
Granted to Date of previous extension	04/11/2018
Address	Bldg 31 Rm 2B 50 31 Center Drive Bethesda, MD 20892 UNITED STATES

Correspondence information	Dale D. Berkley HHS Office of the General Counsel 31 Center Drive Bldg. 31 Suite 2B 50 Bethesda, MD 20892-2111 UNITED STATES Email: berkleyd@od.nih.gov, johnsonmk@mail.nih.gov, dichter@mail.nih.gov Phone: 301-496-6043
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Applicant Information

Application No	87264561	Publication date	12/12/2017
Opposition Filing Date	04/11/2018	Opposition Period Ends	04/11/2018
Applicant	Nelson, Lawrence M 1306 Baker Crest Court McLean, VA 22101 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2016/12/10 First Use In Commerce: 2016/12/11 All goods and services in the class are opposed, namely: Public advocacy to promote awareness of american history and the values of our founding patriots

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4388184	Application Date	02/13/2013
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Registration Date	08/20/2013	Foreign Priority Date	NONE
Word Mark	N I H		
Design Mark			
Description of Mark	The mark consists of a horizontally arranged chevron pointing to the right and stylized letters. Within a solid background contiguous with the chevron and to its left are the stylized upper case letters "N", "I", and "H".		
Goods/Services	<p>Class 009. First use: First Use: 2012/09/08 First Use In Commerce: 2012/09/08 Downloadable electronic educational and professional publications, namely, newsletters, fact sheets, and brochures about a federally funded biomedical and scientific research facility; downloadable electronic educational and professional podcasts and webcasts featuring information about federally funded biomedical and scientific research on human health and human diseases</p> <p>Class 035. First use: First Use: 2012/09/08 First Use In Commerce: 2012/09/08 Promoting research in the field of human health and human diseases through the support and coordination of research projects conducted by universities, hospitals, research foundations and businesses</p> <p>Class 042. First use: First Use: 2012/09/08 First Use In Commerce: 2012/09/08 Providing biomedical and scientific information via a global internet web site related to the field of human health and human diseases</p>		

Attachments	85848580#TMSN.png(bytes) Notice of Opposition--App Ser No 87264561--Opposer HHS-4-11-2018.pdf(219631 bytes)
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Signature	/Dale D. Berkley/
Name	Dale D. Berkley
Date	04/11/2018

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

U.S. Department of Health and Human Services,
Opposer,
v.
Lawrence M. Nelson, AKA General Brown,
M.D.
Applicant.

NOTICE OF OPPOSITION

Opposition No. _____
Application Ser. No. 87/264561

NOTICE OF OPPOSITION

Opposer, U.S. Department of Health and Human Services (“HHS” or “Opposer”), a federal agency with an address of 31 Center Dr., Bldg. 31, Room 2B-50, MSC 2111, Bethesda, Maryland 20892-2111, believes that it will be damaged by registration of the mark NIH shown in Application Serial No. 87/264561 for the services recited therein.

As grounds for opposition, Opposer alleges that:

1. Opposer U.S. Department of Health and Human Services (“HHS”) is a federal agency within the Executive Branch of the United States Government. The National Institutes of Health (“NIH”) is an agency of HHS.

2. Opposer, on its own and through NIH, uses in common law the mark NIH, and variations thereon for biomedical research services; pharmaceutical research and development services; providing grants and financial support for biomedical and pharmaceutical research and development; promoting collaboration within the scientific research, pharmaceutical research, and medical research communities to accelerate the development and use of therapies and

diagnostics human health and human diseases and for providing an Internet web site, social media sites, medical information, and scientific research information.

3. Opposer, through NIH, has been using the mark NIH and variations thereon in common law in association with the services identified in paragraph two since at least 1948. Please see Exhibit A.

4. Opposer also owns and uses the mark NIH (Exhibit B), under Registration No. 4388184, with a Registration Date of August 20, 2013 and first use and first use in commerce of September 8, 2012. The Goods and Services are downloadable electronic educational and professional publications, namely, newsletters, fact sheets, and brochures about a federally funded biomedical and scientific research facility; downloadable electronic educational and professional podcasts and webcasts featuring information about federally funded biomedical and scientific research on human health and human diseases; promoting research in the field of human health and human diseases through the support and coordination of research projects conducted by universities, hospitals, research foundations and businesses; and Providing biomedical and scientific information via a global internet web site related to the field of human health and human diseases.

5. Upon information and belief, Applicant Lawrence M. Nelson, AKA General Brown, M.D. has applied for Application Serial No. 87/264561 (“the ‘561 Application”).

6. The services identified in the ‘561 Application are “public advocacy to promote awareness of American history and the values of our founding patriots.”

7. The date of first use claimed in the ‘561 Application is December 10, 2016 and the date of first use in commerce is December 11, 2016.

8. Opposer has been using the mark NIH, and variations thereon in association with

the services in paragraphs two and four since well before the December 10, 2016 date of first use anywhere and December 11, 2016 date of first use in commerce claimed in Applicant's NIH application.

9. Applicant's NIH mark so resembles Opposer's mark, NIH, that Applicant's mark is likely to cause confusion and lead to deception as to the origin of Opposer's services among consumers within the meaning of 15 U.S.C. § 1052(d) when used on or in connection with the services identified in the '591 Application. When Applicant's mark is applied to services which are closely similar, or identical, to the services of Opposer, as identified in paragraph two, above, Applicant's mark is likely to be confused with that of Opposer's marks and mistaken therefor.

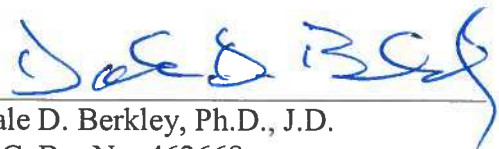
10. Under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), a trademark or service mark shall be refused registration on the Principal Register on account of its nature if it "falsely suggest[s] a connection with persons, living or dead, *institutions*, beliefs, or national symbols, or bring them into contempt, or disrepute...." (emphasis added). If Applicant's mark were to proceed to registration, not only will Applicant own a mark that embeds the recognized name of a federal agency in its mark, Applicant will also create confusion in the marketplace, leading consumers to falsely believe that somehow, NIH endorses or sponsors Applicant's services. Neither HHS nor NIH has licensed "NIH" to Applicant, and neither HHS nor NIH endorse or sponsor Applicant's services.

WHEREFORE, Opposer will be injured and damaged by registration of the marks for the identified services in Application Serial Number 87/264561 and Opposer requests that this opposition be sustained, that said application be rejected, and that no registrations be issued thereon.

Respectfully submitted,

U.S. DEPARTMENT OF HEALTH AND
HUMAN SERVICES

By: _____



Dale D. Berkley, Ph.D., J.D.

D.C. Bar No. 462668

Office of the General Counsel

Public Health Division

National Institutes of Health Branch

31 Center Drive, Suite 2B-47

MSC 2111

Bethesda, Maryland 20892-2111

Telephone: (301) 496-6043

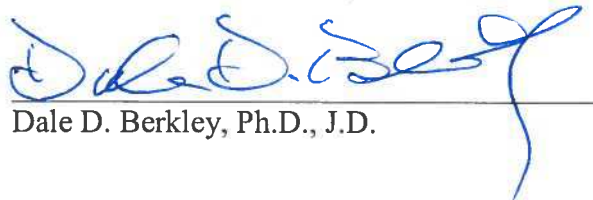
Facsimile: (301) 402-1034

HHS v. HHS v. Lawrence M. Nelson, AKA General Brown, M.D.
Opposition No. _____

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on April 11, 2018 he caused to be served a true copy of the foregoing NOTICE OF OPPOSITION on Applicant pursuant to 37 CFR §2.101 at the correspondence address of record in the Patent and Trademark Office by Federal Express, to:

Lawrence M. Nelson
1306 Baker Crest Court
McLean, VIRGINIA 22101
1066LMN@gmail.com



Dale D. Berkley, Ph.D., J.D.

A Short History of the National Institutes of Health

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New Institutes

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Accompanying growth in the grants program was the proliferation of new categorical institutes. Between 1946 and 1949, voluntary health organizations motivated Congress to create institutes for research on mental health, dental diseases, and heart disease. In 1948, language in the National Heart Act also made the name of the umbrella organization plural: National Institutes of Health. The original divisions of the old National Institute of Health were divided into two newly created institutes: the National Microbiological Institute (NMI) and the Experimental Biology and Medicine Institute (EMBI). The tradition of using such academic medical names, however, was being transformed by the conviction that institutes named after diseases stood a better chance for being funded by Congress. In 1950, the EMBI was absorbed by the newly created National Institute of Arthritis and Metabolic Diseases. In 1955 the NMI similarly became part of the National Institute of Allergy and Infectious Diseases. By 1960 there were ten components. This number increased by 1970 to 15, and by 1998 the NIH had 27 institutes and centers.

In addition, specialized offices such as the Office of AIDS Research, were created but subsumed administratively under existing components.

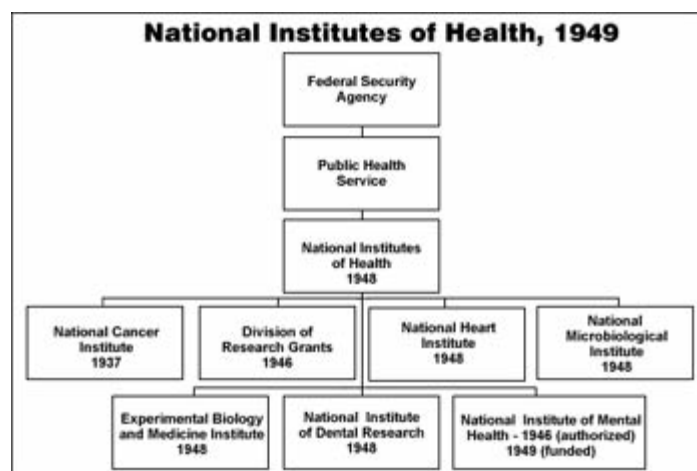

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[Office of NIH History](#) | NIH | DHHS

Exhibit B

Generated on:

This page was generated by TSDR on 2018-04-11 14:11:08 EDT

Mark:

N I H



US Serial Number:

85848580

Application Filing Date:

Feb. 13, 2013

US Registration Number:

4388184

Registration Date:

Aug. 20, 2013

Register:

Principal

Mark Type:

Trademark, Service Mark

TM5 Common Status Descriptor:

Exhibit B



LIVE/REGISTRATION/Issued and Active
The trademark application has been registered with the Office.

Status:

Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date:

Aug. 20, 2013

Publication Date:

Jun. 04, 2013

Mark Information

Related Properties Information

Claimed Ownership of US Registrations:

[4168707](#)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For:

Exhibit B

Downloadable electronic educational and professional publications, namely, newsletters, fact sheets, and brochures about a federally funded biomedical and scientific research facility; downloadable electronic educational and professional podcasts and webcasts featuring information about federally funded biomedical and scientific research on human health and human diseases

International Class(es):

009 - Primary Class

U.S Class(es):

021, 023, 026, 036, 038

Class Status:

ACTIVE

Basis:

1(a)

First Use:

Sep. 08, 2012

Use in Commerce:

Sep. 08, 2012

For:

Promoting research in the field of human health and human diseases through the support and coordination of research projects conducted by universities, hospitals, research foundations and businesses

International Class(es):

035 - Primary Class

U.S Class(es):

100, 101, 102

Class Status:

ACTIVE

Basis:

1(a)

First Use:

Sep. 08, 2012

Exhibit B

Use in Commerce:

Sep. 08, 2012

For:

Providing biomedical and scientific information via a global internet web site related to the field of human health and human diseases

International Class(es):

042 - Primary Class

U.S Class(es):

100, 101

Class Status:

ACTIVE

Basis:

1(a)

First Use:

Sep. 08, 2012

Use in Commerce:

Sep. 08, 2012

Basis Information (Case Level)

Filed Use:

Yes

Currently Use:

Yes

Amended Use:

No

Filed ITU:

No

Currently ITU:

Exhibit B

No

Amended ITU:

No

Filed 44D:

No

Currently 44D:

No

Amended 44D:

No

Filed 44E:

No

Currently 44E:

No

Amended 44E:

No

Filed 66A:

No

Currently 66A:

No

Filed No Basis:

No

Currently No Basis:

No

Current Owner(s) Information

Owner Name:

U.S. Department of Health and Human Services

Exhibit B

Owner Address:

Bldg 31 Rm 2B50
31 Center Drive
Bethesda, MARYLAND UNITED STATES 20892

Legal Entity Type:

agency of the united states government

State or Country Where Organized:

UNITED STATES

Attorney/ Correspondence Information

Attorney of Record

Attorney Name:

Melanye K. Johnson

Attorney Primary Email Address:

johnsonmk@od.nih.gov

Attorney Email Authorized:

No

Correspondent

Correspondent Name/Address:

MELANYE K. JOHNSON
OFFICE OF THE GENERAL COUNSEL
31 CENTER DRIVE BLDG 31 RM 2B50
BETHESDA, MARYLAND UNITED STATES 20892-0001

Phone:

301-496-6043

Fax:

301-402-1034

Exhibit B

Correspondent e-mail:

johnsonmk@od.nih.gov berkleyd@od.nih.gov dichter@od.nih.gov

Correspondent e-mail Authorized:

Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 20, 2013	REGISTERED-PRINCIPAL REGISTER	
Jun. 04, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 04, 2013	PUBLISHED FOR OPPOSITION	
May 15, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Apr. 25, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 22, 2013	ASSIGNED TO EXAMINER	74305
Feb. 21, 2013	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Feb. 20, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Feb. 16, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location:

PUBLICATION AND ISSUE SECTION

Date in Location:

Aug. 20, 2013