

ESTTA Tracking number: **ESTTA959738**

Filing date: **03/12/2019**

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	Hospital for Special Surgery
Granted to Date of previous extension	03/13/2019
Address	535 East 70th Street New York, NY 10021 UNITED STATES

Attorney information	Brendan J. O'Rourke, Bela P. Amladi, Maya L. Tarr Proskauer Rose LLP Eleven Times Square New York, NY 10036-8299 UNITED STATES trademark@proskauer.com, bamladi@proskauer.com 212-969-3000
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**Applicant Information**

Application No	87960948	Publication date	11/13/2018
Opposition Filing Date	03/12/2019	Opposition Period Ends	03/13/2019
Applicant	Omniome, Inc. 10575 Roselle Street San Diego, CA 92121 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: research laboratory analyzers for analysis of biological analytes for non-medical purposes
Class 010. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: devices for analysis of biological analytes for medical purposes
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: analysis of biological analytes; development of new technology for others for analysis of biological analytes

**Grounds for Opposition**


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

## Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1838935	Application Date	08/31/1993
Registration Date	06/07/1994	Foreign Priority Date	NONE
Word Mark	HSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 1963/00/00 First Use In Commerce: 1963/00/00 medical and hospital services		

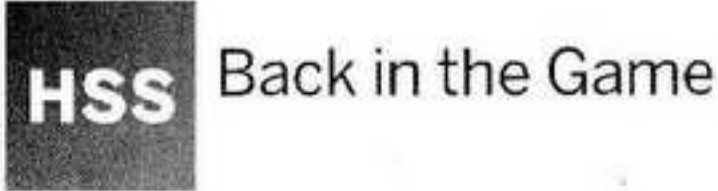
U.S. Registration No.	4440015	Application Date	04/16/2013
Registration Date	11/26/2013	Foreign Priority Date	NONE
Word Mark	HSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1963/00/00 First Use In Commerce: 1963/00/00 Educational services namely conducting classes, seminars, conferences and workshops in the fields of healthcare, orthopedics, rheumatology and musculo-skeletal medicine; distribution of educational materials in connection therewith		



U.S. Registration No.	4979246	Application Date	03/10/2015
Registration Date	06/14/2016	Foreign Priority Date	NONE
Word Mark	HSS		

Design Mark	
Description of Mark	The mark consists of a square within which the letters "HSS" all in capital letters appear in the center of the square.
Goods/Services	<p>Class 041. First use: First Use: 2015/04/02 First Use In Commerce: 2015/04/02  Educational services, namely, conducting classes, seminars, conferences and workshops in the fields of healthcare, orthopedics, rheumatology and musculo-skeletal medicine; dissemination of educational materials in connection therewith</p> <p>Class 044. First use: First Use: 2014/11/00 First Use In Commerce: 2014/11/00  Medical and hospital services</p>

U.S. Registration No.	4979245	Application Date	03/10/2015
Registration Date	06/14/2016	Foreign Priority Date	NONE
Word Mark	HSS		

Design Mark	
Description of Mark	The mark consists of a blue square graded from a darker blue at the top to a lighter blue at the bottom within which the letters "HSS" all in capital white letters appear in the center of the square.
Goods/Services	Class 041. First use: First Use: 2015/04/02 First Use In Commerce: 2015/04/02 Educational services, namely, conducting classes, seminars, conferences and workshops in the fields of healthcare, orthopedics, rheumatology and musculo-skeletal medicine; dissemination of educational materials in connection therewith Class 044. First use: First Use: 2014/11/00 First Use In Commerce: 2014/11/00 Medical and hospital services

U.S. Registration No.	4841542	Application Date	05/27/2015
Registration Date	10/27/2015	Foreign Priority Date	NONE
Word Mark	HSS BACK IN THE GAME		
Design Mark			
Description of Mark	The mark consists of a square within which the letters "HSS" all in capital letters appear in the center of the square with the words "Back in the Game" to the right of the square.		
Goods/Services	Class 038. First use: First Use: 2015/02/02 First Use In Commerce: 2015/02/02 Providing an online forum for the sharing and transmission of patient stories concerning orthopedic, neurologic and rheumatological treatment and care, in-		

	cluding patient videos and photographs		
U.S. Registration No.	4741912	Application Date	03/21/2014
Registration Date	05/26/2015	Foreign Priority Date	NONE
Word Mark	HSS ECADEMY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 2013/10/15 First Use In Commerce: 2013/10/15 Educational services, namely, providing education programs, academic programs, lectures and courses in the fields of orthopedics, rheumatology and musculoskeletal medicine, musculoskeletal rehabilitation and anesthesiology and distribution of course material in the nature of publications and articles in connection therewith, all provided via an electronic digital platform including live streaming, videos, webcasts and webinars on demand; educational services, namely, providing education programs, academic programs, lectures and courses on clinical research, translational research, and basic science research in the fields of orthopedics, rheumatology, musculoskeletal medicine, musculoskeletal rehabilitation and anesthesiology and distribution of course material in the nature of publications and articles in connection therewith, all provided via an electronic digital platform including live streaming, videos, webcasts and webinars on demand</p>		
U.S. Registration No.	5277394	Application Date	10/21/2015
Registration Date	08/29/2017	Foreign Priority Date	NONE
Word Mark	HSS FOUNDATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 036. First use: First Use: 2016/05/08 First Use In Commerce: 2016/05/08 Charitable Fundraising services</p>		
U.S. Registration No.	4098606	Application Date	06/13/2011
Registration Date	02/14/2012	Foreign Priority Date	NONE
Word Mark	HSS JOURNAL		

Design Mark	<b>HSS JOURNAL</b>
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Publications, namely, journals in the field of orthopaedics, rheumatology and musculoskeletal medicine and in the field of research in orthopaedics, rheumatology and musculoskeletal medicine

U.S. Registration No.	4378718	Application Date	06/25/2012
Registration Date	08/06/2013	Foreign Priority Date	NONE

Word Mark	HSS ON THE MOVE
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Design Mark	<b>HSS ON THE MOVE</b>
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 2012/05/13 First Use In Commerce: 2012/05/13 Online educational services, namely, providing online training in the field of orthopedics, rheumatology, neurology, pediatrics, pain management, sports medicine, sports performance, physical therapy, nutrition, fitness, wellness, and prevention, treatment, management and rehabilitation options for a variety of musculoskeletal conditions Class 044. First use: First Use: 2012/05/13 First Use In Commerce: 2012/05/13 Providing a website featuring information about health and wellness in the field of orthopedics, rheumatology, neurology, pediatrics, pain management, sports medicine, sports performance, physical therapy, nutrition, wellness, and prevention, treatment, management and rehabilitation options for a variety of musculoskeletal conditions
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U.S. Registration No.	4841531	Application Date	05/22/2015
Registration Date	10/27/2015	Foreign Priority Date	NONE

Word Mark	HSS ORTHOLINK
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Design Mark	<b>HSS ORTHOLINK</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2015/04/30 First Use In Commerce: 2015/04/30 Providing online newsletters in the field of orthopedics and musculoskeletal medicine via e-mail		

U.S. Registration No.	4841530	Application Date	05/22/2015
Registration Date	10/27/2015	Foreign Priority Date	NONE

Word Mark	HSS RHEUMLINK		
Design Mark	<b>HSS RHEUMLINK</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2015/04/30 First Use In Commerce: 2015/04/30 Providing online newsletters in the field of rheumatology, lupus, autoimmune diseases and musculoskeletal medicine via e-mail		



U.S. Registration No.	5521288	Application Date	02/28/2017
Registration Date	07/17/2018	Foreign Priority Date	NONE
Word Mark	HSS EMPLOYERCONNECT		

Design Mark	<b>HSS EMPLOYERCONNECT</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2017/03/14 First Use In Commerce: 2017/03/14 Appointment scheduling services provided to employers in the field of musculoskeletal health; confirming scheduled appointments for others in the field of musculoskeletal health provided to employers; physician referrals, namely, second opinion services provided to employers in the field of musculoskeletal health</p> <p>Class 044. First use: First Use: 2017/03/14 First Use In Commerce: 2017/03/14 Providing health and consultative services in the field of musculoskeletal health to employees and their family members, namely, onsite physician services, medical care, physical rehabilitation, conducting medical physical activity evaluations</p>		

U.S. Registration No.	5519952	Application Date	10/21/2015
Registration Date	07/17/2018	Foreign Priority Date	NONE
Word Mark	HSS FOUNDATION		
Design Mark	<b>HSS FOUNDATION</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2017/11/16 First Use In Commerce: 2017/11/16 Downloadable electronic newsletters to support and promote research and education in the field of orthopedics, rheumatology and musculoskeletal medicine</p> <p>Class 016. First use: First Use: 2017/11/16 First Use In Commerce: 2017/11/16 Printed matter, namely, newsletters, brochures and magazines to support and promote research and education in the field of orthopedics, rheumatology and musculoskeletal medicine</p>		


U.S. Registration No.	5580941	Application Date	05/11/2018
Registration Date	10/09/2018	Foreign Priority Date	NONE
Word Mark	HSS		



Design Mark			
Description of Mark	The mark consists of the term "HSS" in capital white letters inside a solid blue square.		
Goods/Services	<p>Class 041. First use: First Use: 2017/10/00 First Use In Commerce: 2017/10/00  Educational services, namely, conducting classes, seminars, conferences and workshops in the field of healthcare, orthopedics, rheumatology and musculoskeletalmedicine; dissemination of educational materials in connection therewith; Providing online newsletters in the field of healthcare, orthopedics, rheumatology and musculoskeletal medicine</p> <p>Class 044. First use: First Use: 2017/11/30 First Use In Commerce: 2017/11/30  Medical and hospital services</p>		
U.S. Registration No.	5294164	Application Date	08/09/2016
Registration Date	09/26/2017	Foreign Priority Date	NONE
Word Mark	MYHSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 2016/01/11 First Use In Commerce: 2016/01/11  Providing a web site featuring technology that enables users to access their health summaries, laboratory results, and health care resources, request medic-</p>		

	al records, refill prescriptions, schedule appointments, make bill payments, manage and receive information about their health care, search for medical information and healthcare providers, and communicate electronically with their health care team
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U.S. Registration No.	2325056	Application Date	12/27/1995
Registration Date	03/07/2000	Foreign Priority Date	NONE
Word Mark	HOSPITAL FOR SPECIAL SURGERY		
Design Mark	<b>HOSPITAL FOR SPECIAL SURGERY</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1940/12/31 First Use In Commerce: 1940/12/31 education services, namely, conducting classes, seminars, conferences and workshops in the fields of health care and medicine Class 042. First use: First Use: 1940/12/31 First Use In Commerce: 1940/12/31 distribution and dissemination of educational materials to the public in the field of public health care and medicine; hospital services		

U.S. Registration No.	4181989	Application Date	06/13/2011
Registration Date	07/31/2012	Foreign Priority Date	NONE
Word Mark	HOSPITAL FOR SPECIAL SURGERY		
Design Mark			
Description of Mark	The mark consists of the terms "HOSPITAL FOR" in uppercase letters above the terms "SPECIAL SURGERY" in bold uppercase letters, all of which is to the right of a square box containing a stylized representation of a human.		
Goods/Services	Class 009. First use: First Use: 2009/01/00 First Use In Commerce: 2009/01/00 Downloadable electronic newsletters in the field of orthopaedics, rheumatology and musculoskeletal medicine and in the field of research in orthopaedics, rheumatology and musculoskeletal medicine		

U.S. Registration No.	5612186	Application Date	05/27/2015
Registration Date	11/20/2018	Foreign Priority Date	NONE
Word Mark	HOSPITAL FOR SPECIAL SURGERY		

Design Mark	HOSPITAL FOR SPECIAL SURGERY
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2015/04/30 First Use In Commerce: 2015/04/30 T-shirts, sweatshirts

U.S. Registration No.	4458305	Application Date	04/29/2013
Registration Date	12/31/2013	Foreign Priority Date	NONE

Word Mark	HOSPITAL FOR SPECIAL SURGERY
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Design Mark	<p>HOSPITAL FOR <b>SPECIAL</b> <b>SURGERY</b></p> 
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Description of Mark	The mark consists of the word "hospital" in all capital letters on the first line, the word "for" in all capital letters on the second line, the word "special" in bold-faced all capital letters on the third line, and the word "surgery" in bold-faced all capital letters on the fourth line. Below the word "surgery" is a square containing a stylized representation of a human.
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Goods/Services	Class 041. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Education services, namely, conducting classes, seminars, conferences and workshops in the fields of healthcare, orthopedics, rheumatology and musculo-skeletal medicine; dissemination of education materials in connection therewith Class 044. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Medical and hospital services
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Attachments	85905744#TMSN.png( bytes ) 86559657#TMSN.png( bytes ) 86559652#TMSN.png( bytes ) 86642695#TMSN.png( bytes ) 86228049#TMSN.png( bytes ) 86982653#TMSN.png( bytes ) 85344494#TMSN.png( bytes ) 85660053#TMSN.png( bytes ) 86639665#TMSN.png( bytes ) 86639664#TMSN.png( bytes ) 87977633#TMSN.png( bytes ) 86794905#TMSN.png( bytes ) 87917015#TMSN.png( bytes ) 87132063#TMSN.png( bytes ) 75038935#TMSN.png( bytes ) 85344598#TMSN.png( bytes ) 86642673#TMSN.png( bytes ) 85917340#TMSN.png( bytes ) Notice of Opposition HSS - OMNIOME.pdf(32158 bytes )
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Signature	/Maya L. Tarr/
Name	Maya L. Tarr
Date	03/12/2019

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

In The Matter of Application Serial No.: 87960948  
Filed: June 13, 2018  
For Trademark: HSS  
Published in the Official Gazette of November 13, 2018

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HOSPITAL FOR SPECIAL SURGERY :  
v. Opposer, : Opposition No. \_\_\_\_\_  
OMNIOME, INC., : **NOTICE OF OPPOSITION**  
Applicant. :  
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Hospital for Special Surgery, a New York not-for-profit corporation with an address of 535 East 70th Street, New York, NY 10021, (“Opposer”), believes that it would be damaged by registration of the mark HSS (“Applicant’s Mark”) for “research laboratory analyzers for analysis of biological analytes for non-medical purposes” in International Class 9, “devices for analysis of biological analytes for medical purposes” in International Class 10 and “analysis of biological analytes; development of new technology for others for analysis of biological analytes” in International Class 42 (“Applicant’s Goods and Services”) filed by Omniome, Inc. (“Applicant”), as shown in application Serial No. 87/960,948, and having been granted an extension of time to oppose up to and including March 13, 2019, hereby opposes registration of Applicant’s Mark.

As grounds for opposition it is alleged that:

1. Opposer is the owner of the well-known and famous HSS mark and numerous HSS formative marks that it uses in connection with the goods and services it provides. Opposer is the oldest orthopedic hospital in the United States and has been operating since 1863. Opposer has been operating under the name and mark HOSPITAL FOR SPECIAL SURGERY since 1940 and is and has been referred to as HSS since at least as early as 1963 (collectively, the HSS mark, the HSS formative marks, the HOSPITAL FOR SPECIAL SURGERY mark, and Opposer's HOSPITAL FOR SPECIAL SURGERY formative marks are hereinafter referred to as the "HSS Marks"). Opposer has been ranked the top hospital in the country for orthopedics by *U.S. News and World Report* and is on the Healthgrades list of America's 100 Best Hospitals for Spine Surgery and has been ranked the "Best Hospital" in the New York City tri-state area for knee surgery, spine surgery, and hip replacement by *New York Magazine*.

2. For many years and long prior to June 13, 2018, Applicant's constructive first use date, Opposer has used its HSS Marks in connection with a broad range of medical, hospital, educational and research related goods and services, including, without limitation, medical, hospital, educational and research services in the fields of orthopedics, rheumatology and musculoskeletal health and good and services related thereto.

3. Moreover, long prior to June 13, 2018, Applicant's constructive first use date, in connection with its HSS Marks, HSS has conducted research in the area of DNA sequencing. HSS's DNA-based research includes removing defective DNA or adding new DNA related to "turning-off" or "reprogramming" the switch required for arthritis; Development, implementation, and maintenance of RNA-seq, ChIP-seq, and ATAC-seq

data processing workflows on high performance computing clusters; Investigating DNA sequences that regulate the expression of genes; Single cell analysis and investigations of how individual cells influence disease and respond to treatment and investigating and establishing a streamlined collection and clinical metagenomic sequencing program for joint infections.

4. Opposer is the owner of several federally registered trademark registrations and applications for its HSS Marks including United States Registration Nos. 1838935, 4440015, 4979246, 4979245, 4841542, 4741912, 5277394, 4098606, 4378718, 4841531, 4841530, 5521288, 5519952, 5580941, 5294164, 2325056, 4181989, 5612186, and 4458305, all in connection with a wide variety of medical, hospital, educational and research related goods and services. Opposer's Registration No. 1838935 for the mark HSS has become incontestable.

5. Opposer has extensively advertised and promoted its goods and services under its well-known HSS Marks.

6. By virtue of extensive use in commerce and promotion of the well-known HSS Marks in the United States and worldwide, Opposer has built up highly valuable goodwill in its HSS Marks, and said goodwill has become closely and uniquely identified with Opposer. Through such long, extensive, and exclusive use, through international advertising and promotion, and through the rendering of the broad range of high quality medical related services to countless patients over the course of more than (5) five decades, the HSS mark has become famous within the meaning of 15 U.S.C. § 1125(c), entitling the HSS mark to the widest possible scope of protection, including against dilution.

7. On June 13, 2018, Applicant filed the Application in the United States Patent and Trademark Office seeking registration on the Principal Register of the mark HSS for “research laboratory analyzers for analysis of biological analytes for non-medical purposes” in Class 9, “devices for analysis of biological analytes for medical purposes” in Class 10, and “analysis of biological analytes; development of new technology for others for analysis of biological analytes” in Class 42 on the basis of an intent-to-use.

8. Commencing long prior to June 13, 2018, the constructive first use date in the Application, Opposer has used, advertised and otherwise promoted its medical, research and hospital-related goods and services in connection with the HSS Marks.

9. Applicant’s proposed goods and services are closely related to the goods and services that Opposer provides in connection with its HSS Marks.

**Likelihood of Confusion (15 U.S.C. § 1052 (d))**

10. Applicant's Mark, as applied to the goods and services set forth in the application herein opposed, is identical to Opposer’s famous HSS mark and if applied to Applicant’s goods and services is likely to cause confusion, mistake and/or deception and to deceive the trade and public, who are likely to believe that Applicant’s goods and services have their origin with Opposer and/or that such goods and services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

11. If Applicant is permitted to register the HSS mark for the goods and services set forth in the application, confusion of the trade and public is likely to result in damage and injury to Opposer.



12. If Applicant were granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer.

13. Applicant's mark is not registrable under Section 2(d) of the Lanham Act (15 U.S.C. § 1052 (d)) in view of Opposer's prior continuous and ongoing use and registration of its HSS Marks.

**Dilution (15 U.S.C. § 1125(c))**

14. Opposer's HSS mark is distinctive and famous, and has enjoyed such distinction and fame since long before the filing date of Applicant's constructive first use date.

15. Applicant's Mark, has or is likely to dilute the distinctive quality of Opposer's famous HSS mark by lessening the ability and capacity of the mark to identify and distinguish Opposer as the sole source or origin of its high quality goods and services and/or by lessening the extensive and valuable goodwill, quality and honor that is associated with Opposer's HSS mark.

16. Applicant's dilution of Opposer's HSS mark is a violation of Section 43(c) of the Lanham Act of 1946, as amended (15 U.S.C. §1125(c)).

WHEREFORE, Opposer believes it will be damaged by said registration, and requests that this Notice of Opposition be sustained and that the intent-to-use application for the registration of Applicant's Mark be refused.

Please recognize as attorneys for Opposers in this proceeding Brendan O'Rourke,

Bela P. Amladi, Maya L. Tarr, Tiffany Woo, Jennifer Yang and Russell Kostelak (members of the bar of the state of New York) and the firm of Proskauer Rose LLP, Eleven Times Square, New York, New York 10036-8299.

Dated: March 12, 2019

Respectfully submitted,

PROSKAUER ROSE LLP

*Attorneys for Opposers*

/ Maya L. Tarr/

Brendan J. O'Rourke

Bela P. Amladi

Maya L Tarr

Eleven Times Square

New York, New York 10036-8299

(212) 969-3000

**CERTIFICATE OF SERVICE**

I hereby certify that on March 12, 2019, I caused a true and correct copy of the foregoing Notice of Opposition to be served on Applicant's counsel of record by *electronic mail* as follows:

Jared M. Barrett, Esq.  
Seed Intellectual Property Law Group LLP  
701 Fifth Avenue  
Suite 5400  
Seattle, WA 98104  
[JaredB@SeedIP.com](mailto:JaredB@SeedIP.com)

Date: March 12, 2019

/Maya L. Tarr/  
Maya L. Tarr