

ESTTA Tracking number: **ESTTA1036697**

Filing date: **02/18/2020**

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	llumina, Inc.
Granted to Date of previous extension	02/16/2020
Address	5200 ILLUMINA WAY SAN DIEGO, CA 92122 UNITED STATES

Attorney information	HANS L. MAYER AND SUSAN M. NATLAND KNOBBE, MARTENS, OLSON & BEAR LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES efiling@knobbe.com 949-760-0404
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**Applicant Information**

Application No	88135789	Publication date	08/20/2019
Opposition Filing Date	02/18/2020	Opposition Period Ends	02/16/2020
Applicant	Chan Zuckerberg Biohub, Inc. 499 Illinois Street, 4th Floor San Francisco, CA 94158 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Scientific research, testing and development in the field of nucleic acid sequencing and analysis
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	common law rights as asserted in the Notice of Opposition

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	5711043	Application Date	01/10/2018
Registration Date	03/26/2019	Foreign Priority	NONE

		Date	
Word Mark	ISEQ		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 001. First use: First Use: 2018/01/08 First Use In Commerce: 2018/01/08  Reagents, assays, enzymes, chemical preparations, biological specimens in the nature of human tissue, human body fluid, animal tissue, and animal body fluid, cultures of microorganisms, plant tissue and nucleotides for scientific and research use in the fields of nucleic acid sequencing, genotyping, diagnostics, clinical research, drug development, drug development research, laboratory research, scientific research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, and genetics, not for medical or veterinary purposes; reagents kits comprised primarily of nucleotides, reagents, enzyme substrates, buffers, chemical preparations, biological preparations in the nature of human tissue, human body fluid, animal tissue, and animal body fluid, cultures of microorganisms, plant tissue and enzymes for scientific and research use in the fields of nucleic acid sequencing, genotyping, diagnostics, clinical research, drug development, drug development research, laboratory research, scientific and research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, and genetics, not for medical or veterinary purposes</p> <p>Class 005. First use: First Use: 2018/01/08 First Use In Commerce: 2018/01/08  Reagents, clinical diagnostic reagents, medical diagnostic assays for medical and diagnostic purposes, enzymes, nucleotides, buffers, chemical reagents, and biological preparations in the nature of human tissue, human body fluids, animal tissue, and animal body fluids, cultures of microorganisms, and plant tissue for medical and veterinary use in the fields of medical diagnostics, veterinary diagnostics, laboratory medicine, veterinary medicine, and genetics</p> <p>Class 009. First use: First Use: 2018/01/08 First Use In Commerce: 2018/01/08  Computer hardware and computer software for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics; scientific apparatus and instruments, namely, nucleic acid sequencers for laboratory use in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostics, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics</p> <p>Class 010. First use: First Use: 2018/01/08 First Use In Commerce: 2018/01/08  Clinical and medical diagnostic instruments, namely, nucleic acid sequencers;</p>		

	<p>scientific apparatus and instruments, namely, nucleic acid sequencers for use in medical and veterinary diagnosis and in medical and veterinary treatment in the fields of nucleic acid sequencing, genotyping, and genetics</p> <p>Class 042. First use: First Use: 2018/01/08 First Use In Commerce: 2018/01/08</p> <p>Providing on-line non-downloadable computer search engine software; providing online non-downloadable computer software for the custom design and ordering of assays, nucleic acids and reagents; software as a service (SaaS), namely, hosting software for use by others for use in the custom design and ordering of assays, nucleic acids and reagents in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics; Nucleic acid sequencing and analysis services for scientific and research purposes; Genome sequencing and analysis services for scientific and research purposes; genetic analysis and reporting services for scientific and research purposes; installation and maintenance of computer software and database applications for others for use in the fields of nucleic acid sequencing and genotyping, medical diagnostics, clinical diagnostics, medical research, clinical research, life sciences, biology, drug development, drug development research, molecular diagnostics, laboratory medicine, biotechnology, agriculture, forensics, and genetics</p>
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Attachments	<p>87750350#TMSN.png( bytes )  Notice of Opposition - ILLINCT.647M.pdf(35774 bytes )  Exhibit A.pdf(115927 bytes )</p>
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Signature	/Hans Mayer/
Name	HANS L. MAYER
Date	02/18/2020

ILLINCE.647M

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

Illumina, Inc.

Opposer,

v.

Chan Zuckerberg Biohub, Inc.

Applicant.

Application No.: 88/135789

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

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

Illumina, Inc., a Delaware corporation, with a place of business at 5200 Illumina Way, San Diego, CA 92122 (“Illumina”), believes that it will be damaged by the registration of U.S. Trademark Application Serial No. 88/135789 (the “Application”) for the mark IDSEQ in International Class 42, filed by Chan Zuckerberg Biohub, Inc., a California Corporation, having an address at 499 Illinois Street, 4th Floor, San Francisco, CA 94158 (“Applicant”), and therefore opposes the same.

A description of Applicant’s Application is as follows:

Mark	:	IDSEQ
Serial No.	:	88/135789
Filed	:	September 28, 2018
Published	:	August 20, 2019
Services	:	Scientific research, testing and development in the field of nucleic acid sequencing and analysis
Int’l. Class	:	42
Filing Basis	:	Intent to Use

As grounds for opposition, it is alleged:

**I. Illumina's Business and ISEQ Mark**

1. Founded in 1998 and headquartered in San Diego, California, Illumina is the recognized global leader in next-generation genetic sequencing, having over \$3.5 billion in total revenue for the year 2019. Since at least 2007, Illumina has been, and still is, engaged in the development, production, marketing and sale of next-generation genetic testing and sequencing devices and related goods such as DNA chips, reagents, medical diagnostic instruments, and computer hardware/software and laboratory equipment for scientific, medical, diagnostic and research purposes in connection with its various marks. Illumina also offers a variety of services, including, but not limited to, genetic sequencing, analysis, and reporting services for scientific and clinical research, and providing software for the custom design and ordering of assays, nucleic acids and reagents.

2. Illumina is widely acknowledged to have revolutionized DNA sequencing and is the first company to enable sequencing of the human genome for under \$1,000 – a landmark achievement. What once took billions of dollars and years to perform can now be done on an Illumina sequencer in a matter of hours. Illumina's sequencing systems are enabling genetic studies that were not even imaginable just a few years ago, and are fueling groundbreaking advancements in life sciences, genomics, and molecular diagnostics.

3. Illumina is currently the largest producer of DNA sequencing machines in the world and a majority of all the world's genome sequencing data is generated using Illumina's technology.

4. One of Illumina's next-generation sequencing devices is its ISEQ-branded system. Launched in January 2018, prior to the filing date of the Application, the ISEQ-branded sequencing system was unveiled as Illumina's smallest sequencer and was designed to provide an

easy to use and affordable product for next-generation sequencing. Designed for simplicity, it allows laboratories of all sizes to sequence DNA and RNA at the push of a button. At the time of release, it was Illumina's latest solution for fast and efficient low-throughput sequencing for virtually any laboratory. By way of example, even high school students can, and have used, Illumina's ISEQ-branded products for educational purposes. Products bearing the ISEQ brand have been sold continuously in the United States (and throughout the world), since launch.

5. Illumina's products, including its ISEQ products, principally target markets and customers in the fields of life sciences and clinical genomics, including life sciences research, consumer genomics, agrigenomics, reproductive and genetic health, personalized medicine, and oncology. Illumina's ISEQ products are complimentary goods for and enable scientific research, testing and development in the field of nucleic acid sequencing and analysis. Further, in connection with its ISEQ mark, Illumina provides services such as genetic sequencing, analysis, and reporting services for scientific and clinical research, as well as software for the custom design and ordering of assays, nucleic acids and reagents.

6. Illumina is committed to protecting its reputation of quality and high degree of integrity. As a result of its investment in its ISEQ mark, its high requirements for quality, accuracy, and reliability, and the popularity and widespread commercial success of Illumina's goods and services offered in connection with the ISEQ mark, Illumina has developed a tremendous amount of goodwill and consumer recognition in its ISEQ mark.

7. Illumina's ISEQ mark, by virtue of substantial use, recognition, and promotion, has acquired great value as an indicator of Illumina's goods and services from the goods and services of others.

## **II. Illumina's Registrations**

8. In addition to Illumina's common law rights, Illumina owns the following U.S.

trademark filing for the ISEQ mark (collectively, “Illumina’s Registration”).

9. Illumina is the owner and relies upon United States Trademark Registration No. 5,711,043 for the mark ISEQ for “Reagents, assays, enzymes, chemical preparations, biological specimens in the nature of human tissue, human body fluid, animal tissue, and animal body fluid, cultures of microorganisms, plant tissue and nucleotides for scientific and research use in the fields of nucleic acid sequencing, genotyping, diagnostics, clinical research, drug development, drug development research, laboratory research, scientific research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, and genetics, not for medical or veterinary purposes; reagents kits comprised primarily of nucleotides, reagents, enzyme substrates, buffers, chemical preparations, biological preparations in the nature of human tissue, human body fluid, animal tissue, and animal body fluid, cultures of microorganisms, plant tissue and enzymes for scientific and research use in the fields of nucleic acid sequencing, genotyping, diagnostics, clinical research, drug development, drug development research, laboratory research, scientific and research, life sciences, biology, microbiology and metagenomics, biotechnology, agriculture, forensics, food safety, and genetics, not for medical or veterinary purposes” in International Class 1, “Reagents, clinical diagnostic reagents, medical diagnostic assays for medical and diagnostic purposes, enzymes, nucleotides, buffers, chemical reagents, and biological preparations in the nature of human tissue, human body fluids, animal tissue, and animal body fluids, cultures of microorganisms, and plant tissue for medical and veterinary use in the fields of medical diagnostics, veterinary diagnostics, laboratory medicine, veterinary medicine, and genetics” in International Class 5, “Computer hardware and computer software for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research,

drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics; scientific apparatus and instruments, namely, nucleic acid sequencers for laboratory use in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostics, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics” in International Class 9, “Clinical and medical diagnostic instruments, namely, nucleic acid sequencers; scientific apparatus and instruments, namely, nucleic acid sequencers for use in medical and veterinary diagnosis and in medical and veterinary treatment in the fields of nucleic acid sequencing, genotyping, and genetics” in International Class 10, and “Providing on-line non-downloadable computer search engine software; providing online non-downloadable computer software for the custom design and ordering of assays, nucleic acids and reagents; software as a service (SaaS), namely, hosting software for use by others for use in the custom design and ordering of assays, nucleic acids and reagents in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics; Nucleic acid sequencing and analysis services for scientific and research purposes; Genome sequencing and analysis services for scientific and research purposes; genetic analysis and reporting services for scientific and research purposes; installation and maintenance of computer software and database applications for others for use in the fields of nucleic acid sequencing and genotyping, medical diagnostics, clinical diagnostics,



medical research, clinical research, life sciences, biology, drug development, drug development research, molecular diagnostics, laboratory medicine, biotechnology, agriculture, forensics, and genetics” in International Class 42 (“the ‘043 Registration”) which was registered on the Principle Register in March 26, 2019 and claims a date of first use in commerce at least as early as January 8, 2018. Thus, the first use date and application date of the mark shown in the ‘043 Registration are prior to the filing date listed in Applicant’s Application. True and correct copies of the specifics of the ‘043 Registration obtained from the PTO’s TSDR database are attached hereto as Exhibit A and made of record.

10. The foregoing Registration is valid, subsisting, unrevoked, and uncanceled. As such, it constitutes *prima facie* evidence of the validity of the registered mark and of the registration thereof, of Illumina’s ownership of the mark shown therein, and of Illumina’s exclusive right to use the mark in commerce in connection with the goods and services named therein, without condition or limitation. Illumina’s foregoing Registration also constitutes notice to Applicant of Illumina’s claim of ownership of the mark shown therein, as provided in Sections 7(b), 22, and 33(a) of the Trademark Act of 1946, as amended.

11. In addition to the protection afforded to Illumina by its Registration, Illumina has extensive non-registered statutory and common law rights in the ISEQ mark for its goods and services throughout the United States. Illumina’s common law rights in the ISEQ mark were established before and predate the filing date of the Application. Illumina’s rights in the ISEQ mark are prior to and superior to the Application.

### **III. Applicant’s Application and Illumina’s Cause of Action**

12. Illumina repeats and realleges each and every allegation as set forth above.

13. By the Application filed on September 28, 2018, Applicant seeks to obtain registration on the Principal Register for the trademark IDSEQ for “Scientific research, testing and

development in the field of nucleic acid sequencing and analysis” in International Class 42 based on an alleged intent to use the mark in interstate commerce.

14. Applicant seeks a federal registration for the mark IDSEQ, which is highly similar to Illumina’s well-known ISEQ mark. As such, if a registration issues for Applicant’s mark, such registration will constitute *prima facie* evidence of the Applicant’s exclusive right to use the registered mark in commerce on or in connection with the listed services throughout the United States with no limitation thereon.

15. Applicant’s IDSEQ mark is nearly identical to Illumina’s ISEQ mark in appearance, sound and connotation. Opposer’s ISEQ mark is fully encompassed in Applicant’s mark. Indeed, the only difference between the respective marks is the addition of the letter “D” buried between the “I” and “S” of Illumina’s ISEQ mark.

16. Applicant was aware of Illumina’s ISEQ-branded products and its trademark rights in its ISEQ mark prior to the filing date of Applicant’s Application.

17. Additionally, the Application covers services identical, highly related and complimentary to the goods and services covered under Illumina’s Registration and previously provided by Illumina under its ISEQ mark, and the respective services are marketed to and used by, or will be marketed to and used by, the same consumers and potential consumers in the same channels of trade.

18. As such, Illumina will be damaged by registration of the Application in that Applicant’s mark so resembles Illumina’s ISEQ mark, including as registered in the United States Patent and Trademark Office, and in which Illumina owns common law trademark rights, as to be likely, when used on or in connection with the services as they are identified in the Application, as to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

19. In view of Illumina's prior statutory and common law trademark rights, Applicant is not entitled to registration of the mark in Applicant's Application pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Illumina prays that Applicant's Application, U.S. Trademark Application Serial No. 88/135789, be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Illumina.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 14, 2020

By: /Hans L. Mayer/  
Susan M. Natland  
Hans L. Mayer  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404  
Attorneys for Opposer,  
Illumina, Inc.

32111370

# EXHIBIT A



United States Patent and Trademark Office

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IC 005. US 006 018 044 046 051 052. G &amp; S: Reagents, clinical diagnostic reagents, medical diagnostic assays for medical and diagnostic purposes, enzymes, nucleotides, buffers, chemical reagents, and biological preparations in the nature of human tissue, human body fluids, animal tissue, and animal body fluids, cultures of microorganisms, and plant tissue for medical and veterinary use in the fields of medical diagnostics, veterinary diagnostics, laboratory medicine, veterinary medicine, and genetics. FIRST USE: 20180108. FIRST USE IN COMMERCE: 20180108

IC 009. US 021 023 026 036 038. G &amp; S: Computer hardware and computer software for use with medical patient monitoring equipment, for receiving, processing, transmitting and displaying data in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics; scientific apparatus and instruments, namely, nucleic acid sequencers for laboratory use in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostics, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture,

forensics, food safety, metagenomics, and genetics. FIRST USE: 20180108. FIRST USE IN COMMERCE: 20180108

IC 010. US 026 039 044. G & S: Clinical and medical diagnostic instruments, namely, nucleic acid sequencers; scientific apparatus and instruments, namely, nucleic acid sequencers for use in medical and veterinary diagnosis and in medical and veterinary treatment in the fields of nucleic acid sequencing, genotyping, and genetics. FIRST USE: 20180108. FIRST USE IN COMMERCE: 20180108

IC 042. US 100 101. G & S: Providing on-line non-downloadable computer search engine software; providing online non-downloadable computer software for the custom design and ordering of assays, nucleic acids and reagents; software as a service (SaaS), namely, hosting software for use by others for use in the custom design and ordering of assays, nucleic acids and reagents in the fields of nucleic acid sequencing, genotyping, medical diagnostics, veterinary diagnostics, clinical diagnostics, medical research, veterinary research, diagnostic research, clinical research, drug development, drug development research, medical laboratory research, veterinary science and research, life sciences, biology, microbiology, biotechnology, agriculture, forensics, food safety, metagenomics, and genetics; Nucleic acid sequencing and analysis services for scientific and research purposes; Genome sequencing and analysis services for scientific and research purposes; genetic analysis and reporting services for scientific and research purposes; installation and maintenance of computer software and database applications for others for use in the fields of nucleic acid sequencing and genotyping, medical diagnostics, clinical diagnostics, medical research, clinical research, life sciences, biology, drug development, drug development research, molecular diagnostics, laboratory medicine, biotechnology, agriculture, forensics, and genetics. FIRST USE: 20180108. FIRST USE IN COMMERCE: 20180108

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 87750350

**Filing Date** January 10, 2018

**Current Basis** 1A

**Original Filing Basis** 1B

**Published for Opposition** July 10, 2018

**Registration Number** 5711043

**Registration Date** March 26, 2019

**Owner** (REGISTRANT) Illumina Inc. CORPORATION DELAWARE 5200 Illumina Way San Diego CALIFORNIA 92122

**Attorney of Record** Susan M. Natland

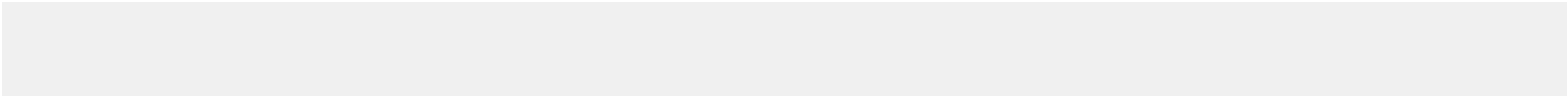
**Type of Mark** TRADEMARK. SERVICE MARK

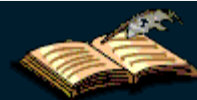
**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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For Serial Number: 87750350

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.6  
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