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Mark: RACE4 RESEARCH 5K AND WALK



US Serial Number: 86799581

Application Filing Date: Oct. 26, 2015

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Appeal of Refusal Pending

An appeal of the Office's final refusal to register a pending trademark application is currently pending.

Status: An appeal of a final refusal to register the mark is pending before the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date: Oct. 14, 2016

## Mark Information

Mark Literal Elements: RACE4 RESEARCH 5K AND WALK

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "RACE 4 RESEARCH" OR "5K AND WALK"

Design Search Code(s): 01.15.11 - Bubbles; Foam (bubbles); Foamy mass; Soap suds; Suds, soap  
02.01.33 - Stick figures; Grotesque men formed by letters, numbers, punctuation or geometric shapes  
02.09.05 - Humans, including men, women and children, depicted running; Running, humans  
19.13.25 - Beakers  
26.17.01 - Bars, straight; Lines, straight; Bands, straight; Straight line(s), band(s) or bar(s)  
26.17.05 - Bands, horizontal; Bars, horizontal; Lines, horizontal; Horizontal line(s), band(s) or bar(s)

## 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: Charitable fundraising services, namely, organizing events to raise money for ALS research and awareness programs

International Class(es): 036 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 07, 2015

Use in Commerce: Jan. 09, 2015

## Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: 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:** ALS Therapy Development Foundation

**DBA, AKA, Formerly:** DBA ALS Therapy Development Institute

**Owner Address:** 300 Technology Square Suite 400  
Cambridge, MASSACHUSETTS UNITED STATES 02139

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** MASSACHUSETTS

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Thomas J. Engellenner

**Docket Number:** 140211.10007

**Attorney Primary Email Address:** [DocketingBN@pepperlaw.com](mailto:DocketingBN@pepperlaw.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** THOMAS J. ENGELLENNER  
PEPPER HAMILTON LLP  
125 HIGH STREET 19TH FLOOR- HIGH STREET TOWER  
BOSTON, MASSACHUSETTS UNITED STATES 02110

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[w.com\\_engellennert@pepperlaw.com](mailto:w.com_engellennert@pepperlaw.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Oct. 14, 2016	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Oct. 14, 2016	EX PARTE APPEAL-INSTITUTED	799581
Oct. 14, 2016	JURISDICTION RESTORED TO EXAMINING ATTORNEY	799581
Oct. 14, 2016	EXPARTE APPEAL RECEIVED AT TTAB	
Apr. 14, 2016	NOTIFICATION OF FINAL REFUSAL EMAILED	
Apr. 14, 2016	FINAL REFUSAL E-MAILED	
Apr. 14, 2016	FINAL REFUSAL WRITTEN	91234
Mar. 22, 2016	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 21, 2016	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 21, 2016	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Feb. 19, 2016	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Feb. 19, 2016	NON-FINAL ACTION E-MAILED	6325
Feb. 19, 2016	NON-FINAL ACTION WRITTEN	91234
Feb. 17, 2016	ASSIGNED TO EXAMINER	91234
Oct. 30, 2015	NOTICE OF DESIGN SEARCH CODE AND PSEUDO MARK E-MAILED	
Oct. 29, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 29, 2015	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information

**TM Attorney:** BHUPATHI, TARA LUISE

**Law Office Assigned:** LAW OFFICE 102

### File Location

**Current Location:** TMEG LAW OFFICE 102 - EXAMINING ATTORNEY ASSIGNED

**Date in Location:** Apr. 14, 2016

# Proceedings

## Summary

Number of Proceedings: 1

### Type of Proceeding: Exparte Appeal

Proceeding Number: [86799581](#)

Filing Date: Oct 14, 2016

Status: Pending

Status Date: Oct 14, 2016

Interlocutory Attorney:

### Plaintiff(s)

Name: ALS Therapy Development Foundation

Correspondent Address: THOMAS J. ENGELLENNER  
PEPPER HAMILTON LLP  
125 HIGH STREET 19TH FLOOR- HIGH STREET TOWER  
BOSTON MA UNITED STATES , 02110

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### Associated marks

Mark	Application Status	Serial Number	Registration Number
RACE4 RESEARCH 5K AND WALK	Ex Parte Appeal Pending	<a href="#">86799581</a>	

### Prosecution History

Entry Number	History Text	Date	Due Date
1	APPEAL TO BOARD	Oct 14, 2016	
2	Appeal Acknowledged; Case Remanded	Oct 14, 2016	
3	INSTITUTED	Oct 14, 2016	

## Request for Reconsideration after Final Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86799581
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 102
<b>MARK SECTION</b>	
<b>MARK FILE NAME</b>	<a href="http://tmng-al.uspto.gov/resting2/api/img/86799581/large">http://tmng-al.uspto.gov/resting2/api/img/86799581/large</a>
<b>LITERAL ELEMENT</b>	RACE4 RESEARCH 5K AND WALK
<b>STANDARD CHARACTERS</b>	NO
<b>USPTO-GENERATED IMAGE</b>	NO
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_38104670-20161014102935215567_.2016-10-14_ROA_Race-4_Research_Design_86799581.PDF</a>
<b>CONVERTED PDF FILE(S) (4 pages)</b>	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\867\995\86799581\xml1\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\867\995\86799581\xml1\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\867\995\86799581\xml1\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT17\IMAGEOUT17\867\995\86799581\xml1\RFR0005.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Response to Final Action and Request for Reconsideration
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/ThomasEngellenner/
<b>SIGNATORY'S NAME</b>	Thomas Engellenner
<b>SIGNATORY'S POSITION</b>	Attorney of record
<b>SIGNATORY'S PHONE NUMBER</b>	617-204-5189
<b>DATE SIGNED</b>	10/14/2016
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Fri Oct 14 10:41:09 EDT 2016
<b>TEAS STAMP</b>	USPTO/RFR-XX.XXX.X.XX-201 61014104109209330-8679958 1-57047f774b5bb976fd1d7d9 0c362a15e903052fbe4c5f501 6fea5949dad55c994-N/A-N/A -20161014102935215567

## Request for Reconsideration after Final Action

### To the Commissioner for Trademarks:

Application serial no. **86799581** RACE4 RESEARCH 5K AND WALK (Stylized and/or with Design, see <http://tmng-al.uspto.gov/resting2/api/img/86799581/large>) has been amended as follows:

#### EVIDENCE

Evidence in the nature of Response to Final Action and Request for Reconsideration has been attached.

#### Original PDF file:

[evi\\_38104670-20161014102935215567 . 2016-10-14 ROA Race-4-Research Design 86799581.PDF](#)

#### Converted PDF file(s) ( 4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

#### SIGNATURE(S)

##### Request for Reconsideration Signature

Signature: /ThomasEngellenner/ Date: 10/14/2016

Signatory's Name: Thomas Engellenner

Signatory's Position: Attorney of record

Signatory's Phone Number: 617-204-5189

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; 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. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86799581

Internet Transmission Date: Fri Oct 14 10:41:09 EDT 2016

TEAS Stamp: USPTO/RFR-XX.XXX.X.XX-201610141041092093

30-86799581-57047f774b5bb976fd1d7d90c362

a15e903052fbc4c5f5016fea5949dad55c994-N/

A-N/A-20161014102935215567

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Trademark Application of  
ALS Therapy Development Foundation

For: "RACE 4 RESEARCH  
5K AND WALK  
& DESIGN"

Serial No.: 86799581

Filed: October 26, 2015

Trademark Law Office 102  
(571) 272-5557

Examining Attorney:  
Tara L. Bhupathi

**RESPONSE TO OFFICE ACTION**

**TO COMMISSIONER FOR TRADEMARKS:**

ALS Therapy Development Foundation ("Applicant"), by and through its undersigned counsel, hereby responds to the Final Office Action, emailed April 14, 2016, on the above-captioned trademark application.

**3. Likelihood of Confusion Issue:**

The Examiner has refused registration of applicant's mark because of a likelihood of confusion with the mark in U.S. Registration 3487214 (RACING4RESEARCH). The Office Action states "applicant's addition of design elements fails to obviate similarity of the marks because greater weight is often given to the word portion of marks when determining whether marks are confusingly similar." Applicant respectfully disagrees.

The Court of Appeals for the Federal Circuit has noted "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647, 16 USPQ2d

1239, 1240 (Fed. Cir. 1990). The fundamental rule is that the marks must be considered in their entireties. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993)

In present case, the Examiner has required that the word portion of Applicant's mark be disclaimed as "*merely descriptive*" of the services. Thus, the only portions where any overlap of features exists between the applicant's and registrants marks exist are the three words that the Office Action insists are "merely descriptive." Even if word portions of marks are *often* given greater weight than design features, this should not be the case here where the *only* similarity lies in *merely descriptive* words. *Country Floors, Inc. v. Gepner*, 930 F.2d 1056, 1065, 18 U.S.P.Q.2d 1577 (3d Cir. 1991) ("disclaimed matter ... is not usually regarded as the dominant part of a mark").<sup>1</sup>

Because of the disclaimer, Applicant submits that the dominant portion of its mark is the design feature:



The cited registration RACING4RESEARCH has no design features, much less any design feature than could be confusingly similar. Thus, when the two marks are viewed in their entireties, there is no likelihood of confusion.

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<sup>1</sup> See also, *In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (holding confusion unlikely between REDNECK RACEGIRL and design of large, double-letter RR configuration and registered mark RACEGIRL, even when used on largely identical goods).

The April 14, 2016 Office Action states:

Finally, applicant's addition of design elements fails to create a distinct commercial impression because, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, *even where the word portion has been disclaimed*. (emphasis added) *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Applicant submits that the above cited *In re Viterra Inc.* case is not pertinent to the issue here and it does not stand for the proposition that the word portion of the mark should be considered the dominant feature or be accorded greater weight in the present instance.

*In re Viterra, Inc.* involved an attempt to register the mark XCEED *in standard character form*. Registration was refused based on a prior registration of a word and design mark:



for similar goods. On appeal the Federal Circuit affirmed the denial of registration on the ground that Viterra's decision to seek registration *in standard character form* permitted the Patent and Trademark Office to take into account and give greater weight to the verbal portion of the prior registration even though the registrant had disclaimed any rights to the word "seed."<sup>2</sup>

The present application is not seeking registration in standard character form as in the *In re Viterra Inc.* case. Quite to the opposition, the applicant is seeking a *word and design mark* in

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<sup>2</sup> In the *In re Viterra, Inc.* decision, the Federal Circuit also cautioned "[T]here is no general rule that the letter portion of the mark will form the dominant portion of the mark." 671 F.3d 1363

which all of the wording has been disclaimed – at the Examiner’s insistence because the words were deemed merely descriptive. Accordingly, the dominant portion of applicant’s mark is its *design*. The cited registration cannot be confusingly similar to applicant’s design because it has no design element!

In light of the additional arguments presented herein, Applicant respectfully requests that the Examining Attorney withdraw the refusal to register based on likelihood of confusion with registration 3487214.

**Conclusion**

Applicant respectfully requests reconsideration and allowance of the present application. In the event that the remarks are not deemed to overcome the grounds for rejection, the Examiner is kindly requested to telephone the undersigned representative to discuss any remaining issues.

Respectfully submitted,

Dated: October 14, 2016

Electronic Signature: /ThomasEngellenner/  
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