

ESTTA Tracking number: **ESTTA978540**

Filing date: **06/05/2019**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Engage Health, Inc.		
Entity	Corporation	Citizenship	Minnesota
Address	3265 Lexington Avenue South Eagan, MN 55121 UNITED STATES		

Attorney information	Stephen R. Baird Greenberg Traurig, LLP 90 South Seventh Street, Suite 3500 Minneapolis, MN 55402 UNITED STATES gtipmail@gtlaw.com, bairds@gtlaw.com, wesemand@gtlaw.com, classenc@gtlaw.com 6122599718		
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Registration Subject to Cancellation

Registration No.	4715257	Registration date	04/07/2015
Registrant	ClinEdge, LLC 222 Field Street New Bedford, MA 02740 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2014/06/02 First Use In Commerce: 2014/06/16 All goods and services in the class are subject to cancellation, namely: patient recruitment and retention services for clinical studies conducted by others
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2856390	Application Date	03/06/2002
Registration Date	06/22/2004	Foreign Priority Date	NONE
Word Mark	ENGAGE HEALTH		

Design Mark	ENGAGE HEALTH		
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 2001/09/00 First Use In Commerce: 2001/09/00 Consulting services in the fields of pharmaceuticals, biotechnology, and medical products and services		

U.S. Registration No.	4267458	Application Date	04/12/2012
Registration Date	01/01/2013	Foreign Priority Date	NONE

Word Mark	ENGAGE HEALTH		
Design Mark	ENGAGE HEALTH		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2001/09/00 First Use In Commerce: 2001/09/00 Business advice and analysis of markets; Business meeting planning; Market analysis; Market assessment services; Marketresearch; Market research consultation		

U.S. Registration No.	4267459	Application Date	04/12/2012
Registration Date	01/01/2013	Foreign Priority Date	NONE

Word Mark	ENGAGE HEALTH		
Design Mark	ENGAGE HEALTH		
Description of Mark	NONE		

Goods/Services	Class 042. First use: First Use: 2001/09/00 First Use In Commerce: 2001/09/00 Product development consultation; Product research and development		
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U.S. Application No.	88307568	Application Date	02/19/2019
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Registration Date	NONE	Foreign Priority Date	NONE
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Word Mark	ENGAGE ENCOMPASS		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 035. First use: First Use: 2019/02/13 First Use In Commerce: 2019/02/13 Business advice and analysis of markets; Market analysis; Market assessment services; Market research; Market research consultation; Providing consumer information in the field of medicine, doctors, and medical professionals; Providing information in the field of the medical industry; Market research by means of a computer database; Collection and compilation of information into computer databases in the fields of medicine, patients, doctors, medical professionals, pharmaceuticals, biotechnology, and medical products and services		
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U.S. Application No.	88307592	Application Date	02/19/2019
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Registration Date	NONE	Foreign Priority Date	NONE
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Word Mark	ENGAGE ENCOMPASS		
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Design Mark			
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Description of Mark	NONE		
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Goods/Services	Class 042. First use: First Use: 2019/02/13 First Use In Commerce: 2019/02/13 Product development consultation; Product research and development		
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U.S. Application No.	88307585	Application Date	02/19/2019
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ENGAGE ENCOMPASS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 044. First use: First Use: 2019/02/13 First Use In Commerce: 2019/02/13 Consulting services in the fields of pharmaceuticals, biotechnology, and medical products and services		

U.S. Application No.	88460714	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

U.S. Application No.	88460722	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

U.S. Application No.	88460968	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

Attachments	76379828#TMSN.png(bytes) 85595853#TMSN.png(bytes) 85595858#TMSN.png(bytes) 88307568#TMSN.png(bytes) 88307592#TMSN.png(bytes) 88307585#TMSN.png(bytes) Petition to Cancel - CLINEDGE ENGAGE - Filed 6-5-19.pdf(761111 bytes)
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Signature	/DHW/
Name	Draeke H. Weseman
Date	06/05/2019

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

In the Matter of Registration No.: 4,715,257

Mark: 
Registered: April 7, 2015

ENGAGE HEALTH, INC.

Petitioner,

v.


Cancellation No.

CLINEDGE, LLC

Registrant.

PETITION TO CANCEL

Petitioner Engage Health, Inc. (“Petitioner”), a Minnesota corporation with offices at 3265 Lexington Avenue South, Eagan, Minnesota 55121, believes that it is being and will be

damaged by the continued registration of the mark  (“Registrant’s Mark”) on the Principal Register in Class 35 for “patient recruitment and retention services for clinical studies conducted by others” (“Registrant’s Services”) as shown in U.S. Registration No. 4,715,257 (the “Registration”), issued to ClinEdge, LLC (“Registrant”) on April 7, 2015.

Petitioner hereby petitions to cancel the Registration.

The grounds for cancellation are as follows:

1. Petitioner is an innovative and experienced health research firm serving the pharmaceutical, biotechnology, and medical device sectors in the commercialization of medical products, offering a variety of health research and related services under the marks ENGAGE,

ENGAGE & Design, ENGAGE HEALTH, and ENGAGE ENCOMPASS (collectively, “Petitioner’s Marks”).

2. Upon information and belief, Registrant did not use Registrant’s Mark in commerce for the services covered by the Registration prior to the claimed first use in commerce date of June 16, 2014.

3. Since at least as early as September of 2001, more than a decade before Registrant’s claimed date of first use in commerce of June 16, 2014 for Registrant’s Mark, Petitioner has continuously used marks comprising or containing the word “engage,” including without limitation, the word mark ENGAGE HEALTH in connection with health research services, consulting services in the fields of pharmaceutical, biotechnology, and medical products and services, business advice and analysis of markets, business meeting planning, market analysis, market assessment services, market research, market research consultation, product development consultation, product research and development, and patient recruitment and retention services for clinical studies conducted by others, patient and caregiver identification and mapping, and other services (“Petitioner’s Services”).

4. Since at least as early as July 2003, Petitioner has continuously used the word mark ENGAGE standing alone and/or with the following design mark in connection with Petitioner’s Services (the “ENGAGE & Design Mark”):



5. Since at least as early as February 13, 2019, Petitioner has continuously used the word mark ENGAGE ENCOMPASS in connection with Petitioner's Services.

6. Petitioner owns incontestable U.S. Registration No. 4,267,458, registered January 1, 2013, for the mark ENGAGE HEALTH, in standard characters, for "Business advice and analysis of markets; Business meeting planning; Market analysis; Market assessment services; Market research; Market research consultation" in Class 35.

7. Petitioner owns incontestable U.S. Registration No. 4,267,459, registered January 1, 2013, for the mark ENGAGE HEALTH, in standard characters, for "Product development consultation; Product research and development" in Class 42.

8. Petitioner owns incontestable U.S. Registration No. 2,856,390, registered June 22, 2004, renewed July 24, 2013, for the mark ENGAGE HEALTH, in standard characters, for "Consulting services in the fields of pharmaceuticals, biotechnology, and medical products and services" in Class 44.

9. Petitioner is the applicant in U.S. Trademark Application Serial No. 88/307,568, filed February 19, 2019, for the mark ENGAGE ENCOMPASS, in standard characters, for registration on the Principal Register for "Business advice and analysis of markets; Market analysis; Market assessment services; Market research; Market research consultation; Providing consumer information in the field of medicine, doctors, and medical professionals; Providing information in the field of the medical industry; Market research by means of a computer database; Collection and compilation of information into computer databases in the fields of medicine, patients, doctors, medical professionals, pharmaceuticals, biotechnology, and medical products and services" in Class 35.

10. Petitioner is the applicant in U.S. Trademark Application Serial No. 88/307,592, filed February 19, 2019, for the mark ENGAGE ENCOMPASS, in standard characters, for

registration on the Principal Register for “Product development consultation; Product research and development” in Class 42.

11. Petitioner is the applicant in U.S. Trademark Application Serial No. 88/307,585, filed February 19, 2019, for the mark ENGAGE ENCOMPASS, in standard characters, for registration on the Principal Register for “Consulting services in the fields of pharmaceuticals, biotechnology, and medical products and services” in Class 44.

12. Petitioner is the applicant in U.S. Trademark Application Serial No. 88/460,968, filed June 5, 2019, for the ENGAGE & Design Mark for registration on the Principal Register for “Advertising and marketing services, namely, promoting the goods and services of others; Advertising, marketing and promotion services; Collection of market research information; Consumer research; Business advice and analysis of markets; Business meeting planning; Market analysis; Market assessment services; Market research; Market research consultation; Marketing services for the medical goods and services of others; Promoting medical professionals and medical goods and services for others; Providing consumer information in the field of medicine, doctors, and medical professionals; Providing information in the field of the medical industry; Market research by means of a computer database; Collection and compilation of information into computer databases in the fields of medicine, patients, doctors, medical professionals, pharmaceuticals, biotechnology, and medical products and services; Recruitment advertisement services, namely, posting of clinical trial notices for the purpose of recruiting patients for participation in clinical trials for the testing of drugs; Business consulting and management in the field of clinical trials, namely, providing information management services; Identification of patients for clinical trials; Patient recruitment and retention services for clinical studies conducted by others; Patient referrals; Patient screening services for clinical trials;

Consulting services in the field of commercial information for consumers of medical products and services; Identification of healthcare providers for patients” in Class 35.

13. Petitioner is the applicant in U.S. Trademark Application Serial No. 88/460,714, filed June 5, 2019, for the ENGAGE & Design Mark for registration on the Principal Register for “Product development consultation; Product research and development; Health research; Health research by means of a computer database; Collection of health research information; Health research consultation; Health information assessment services; Providing medical and scientific research information in the field of clinical trials; Consulting services in the field of clinical trials; Consulting services in the field of biotechnology; Providing information about clinical trials; Providing information about clinical trials through means of a call center; Providing information in the field of health research; Processing health research information” in Class 42.

14. Petitioner is the applicant in U.S. Trademark Application Serial No. 88/460,722, filed June 5, 2019, for the ENGAGE & Design Mark for registration on the Principal Register for “Consulting services in the fields of pharmaceuticals and medical products and services” in Class 44.

15. As a result of the extensive sales and promotion of Petitioner’s Services under Petitioner’s Marks, Petitioner has built up highly valuable goodwill in Petitioner’s Marks that is closely and uniquely identified and associated with Petitioner.

16. On March 20, 2019, Registrant sent Petitioner a marketing solicitation by email featuring Registrant’s Mark in the signature block and seeking Petitioner’s participation in a meeting at the 2019 World Orphan Drug conference in Baltimore, Maryland, *see* Exhibit A.

17. Upon information and belief, Registrant sent nearly identical marketing solicitations by email, all featuring Registrant’s Mark in the signature block, to other attendees of the 2019 World Orphan Drug conference.

18. Prior to the 2019 World Orphan Drug conference, Petitioner has, at the World Orphan Drug conference, had a booth displaying Petitioner's Marks in connection with Petitioner's Services and has sponsored a workshop about Petitioner's Services in which Petitioner's Marks were displayed.

19. On March 26, 2019, Petitioner sent Registrant a letter notifying Registrant of Petitioner's claim of a likelihood of confusion and demanding that Registrant cease use of Registrant's Mark and surrender the Registration for cancellation.

20. As of the date hereof, Registrant has not ceased using Registrant's Mark nor agreed to surrender the Registration for cancellation despite being put on notice of the likelihood confusion caused by Registrant's use and registration of Registrant's Mark.

21. Registrant's Mark contains the word "engage" that is exactly the same as the word "engage" in Petitioner's Marks.

22. Registrant's Mark depicts the word "engage" in larger font size than the word "ClinEdge:"



See also Exhibit B.

23. The dominant portion of Registrant's Mark is the word "engage."

24. When presented in color, the design portion of Petitioner's ENGAGE & Design Mark is depicted in green.

25. When presented in color, Registrant's Mark is depicted in green.

26. Registrant's Services are identical and/or closely related to Petitioner's Services.

27. The term "engage" as used in Petitioner's Marks in connection with Petitioner's Services is inherently distinctive.

28. Registrant markets and sells Registrant's Services through identical channels of trade as those through which Petitioner markets and sells Petitioner's Services.

29. Registrant markets and sells Registrant's Services to the same classes of purchasers as to whom Petitioner markets and sells Petitioner's Services.

30. On May 14, 2019 Petitioner received a LinkedIn message from a recent connection who mistakenly believed, based on an actual confusion of Registrant's Mark with Petitioner's Mark, that she had worked for Petitioner when instead she had worked for Registrant. *See Exhibit C.*

31. Registrant has caused actual confusion by use of Registrant's Mark.

32. Registrant's Mark so resembles Petitioner's Mark as to be likely, when used in connection with Registrant's Services, to cause confusion, to cause mistake, and to deceive consumers, who are likely to believe that Registrant's Services have their origin with Petitioner and/or are approved, endorsed, or sponsored by Petitioner, or associated in some way with Petitioner.

33. Petitioner is being and would be injured by the continued registration of Registrant's Mark.

WHEREFORE, Petitioner believes that it is being damaged by the registration of Registrant's Mark and requests that this Petition for Cancellation be granted under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and the Registration be cancelled.

[Signature page follows]

Dated: June 5, 2019

Respectfully submitted,

GREENBERG TRAURIG, LLP

By: ____/DHW/_____

Stephen R. Baird
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3500 Wells Fargo Center
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Attorneys for Petitioner

EXHIBIT A

From: Amanda Finlayson <afinlayson@clin-edge.com>
Sent: Wednesday, March 20, 2019 4:10 PM
To: Jordan Abhold <jabhold@engagehealth.com>
Subject: World Orphan Meet & Greet: ClinEdge

Good afternoon Jordan,

I hope your week is going well!

I understand you will be attending the World Drug Orphan conference this year! ClinEdge will also be there and we would love to meet with you to see if we may be able to support your ongoing or future clinical trials.

Some ways we support sponsors/CROs:

- **Patient Engagement & Recruitment Tactics:** Study branding and materials, social listening and patient panels, highly targeted digital strategies, community outreach & advocacy group partnerships, enrollment center prescreening
- **Full Service Patient Travel Coordination:** We remove burden from sites, caregivers, patients, and sponsors by serving as a single point of contact for all travel coordination, patient stipends/reimbursements, and itinerary management
- **Research Naïve Site Initiative:** We implement back-end infrastructure to support research naïve clinics who may have high recruitment/retention potential based on patient access and underserved patient populations

Please let me know when you are available and I will send over a calendar invite. We look forward to meeting with you!

Best,



*Two Divisions Dedicated to the
Success of Clinical Trials*

Amanda Finlayson | Therapeutic Strategy Lead II: Site and Patient Networks

T (857) 496-0054 ext.533 | F (857) 496-0056



www.clin-edge.com | afinlayson@clin-edge.com



EXHIBIT B



EXHIBIT C

The screenshot shows an Outlook email window. The top ribbon includes 'File', 'Message', 'Help', 'Adobe PDF', and a search bar. The ribbon contains various actions like 'Delete', 'Archive', 'Reply', 'Forward', 'Move', 'Mark Unread', 'Categorize', 'Follow Up', 'Translate', 'Read Aloud', and 'Zoom'. Below the ribbon, the sender is identified as 'Patti Engel' and the time as 'Mon 2:31 PM'. The subject line is redacted with a black box labeled 'Redacted'. A small icon and a message 'If there are problems with how this message is displayed, click here to view it in a web browser.' are visible. The main body of the email features a LinkedIn logo, the name 'Patti Engel' with a profile picture, and the text: 'Hi Patti, So nice to get to meet you at the PPAL course last week. I think I'd mentioned that I am a seasoned clinical operations person who is looking to get into Patient Advocacy. I'd love to be able to speak with you sometime and see if you have any ideas or connections that might help me get there. We also had the connection on the 'Engage' name if you remember. I no longer work there, actually it was a short stay there! Anyway, hope to connect with you soon.' Below the text are two buttons: 'Reply' and 'Not interested'. The 'Reply' button is redacted with a black box labeled 'Redacted'.

Int. Cl.: 44

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,856,390

Registered June 22, 2004

**SERVICE MARK
PRINCIPAL REGISTER**

ENGAGE HEALTH

ENGAGE HEALTH, INC. (MINNESOTA COR-
PORATION)
852 BASSWOOD LANE
EAGAN, MN 55123

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "HEALTH", APART FROM THE
MARK AS SHOWN.

FOR: CONSULTING SERVICES IN THE FIELDS
OF PHARMACEUTICALS, BIOTECHNOLOGY,
AND MEDICAL PRODUCTS AND SERVICES, IN
CLASS 44 (U.S. CLS. 100 AND 101).

SN 76-379,828, FILED 3-6-2002.

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

JENNIFER DIXON, EXAMINING ATTORNEY

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Mark: ENGAGE HEALTH

ENGAGE HEALTH

US Serial Number: 76379828

Application Filing Date: Mar. 06, 2002

US Registration Number: 2856390

Registration Date: Jun. 22, 2004

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Jul. 24, 2013

Publication Date: Jul. 29, 2003

Notice of Allowance Date: Oct. 21, 2003

Mark Information

Mark Literal Elements: ENGAGE HEALTH

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Disclaimer: "HEALTH"

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: Consulting services in the fields of pharmaceuticals, biotechnology, and medical products and services

International Class(es): 044 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 2001

Use in Commerce: Sep. 2001

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Engage Health, Inc.

Owner Address: 852 Basswood Lane
Eagan, MINNESOTA UNITED STATES 55123

Legal Entity Type: CORPORATION

State or Country MINNESOTA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Stephen Baird
Attorney Primary Email Address: trademark@winthrop.com
Docket Number: 11402.2
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Stephen Baird
WINTHROP & WEINSTINE, P.A.
225 SOUTH SIXTH STREET
Capella Tower, Suite 3500
MINNEAPOLIS, MINNESOTA UNITED STATES 55402
Phone: (612) 604-6585
Correspondent e-mail: trademark@winthrop.com
Fax: (612) 604-6985
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 24, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jul. 24, 2013	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75184
Jul. 24, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	75184
Jul. 24, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
Jul. 09, 2013	TEAS SECTION 8 & 9 RECEIVED	
Sep. 30, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	74886
Sep. 30, 2009	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	74886
Sep. 16, 2009	TEAS SECTION 8 & 15 RECEIVED	
Jun. 22, 2004	REGISTERED-PRINCIPAL REGISTER	
Apr. 15, 2004	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 08, 2004	ASSIGNED TO EXAMINER	74814
Apr. 07, 2004	CASE FILE IN TICRS	
Mar. 25, 2004	STATEMENT OF USE PROCESSING COMPLETE	
Mar. 18, 2004	USE AMENDMENT FILED	
Mar. 18, 2004	TEAS STATEMENT OF USE RECEIVED	
Dec. 04, 2003	PAPER RECEIVED	
Oct. 21, 2003	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 03, 2003	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 29, 2003	PUBLISHED FOR OPPOSITION	
Jul. 09, 2003	NOTICE OF PUBLICATION	
Jun. 05, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 05, 2003	EXAMINERS AMENDMENT MAILED	
Jun. 04, 2003	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Apr. 22, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 22, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jan. 23, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Aug. 06, 2002	NON-FINAL ACTION MAILED	
Jul. 24, 2002	ASSIGNED TO EXAMINER	74814

TM Staff and Location Information

TM Staff Information - None

File Location

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91220249](#)

Filing Date: Jan 20, 2015

Status: Terminated

Status Date: Feb 02, 2015

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: The WorkCare Group, Inc.

Correspondent Address: THE WORKCARE GROUP INC
4077 BLUFTON MILL ROAD
FREE UNION VA UNITED STATES , 22940

Correspondent e-mail: workcaregroup@earthlink.net , georgeworkcare@earthlink.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
ENGAGE IN HEALTH	Abandoned - After Inter-Partes Decision	85173778	

Plaintiff(s)

Name: Engage Health, Inc.

Correspondent Address: STEPHEN R BAIRD
WITHROP & WEINSTINE PA
225 SOUTH SIXTH STREET , SUITE 3500 CAPELLA TOWER
MINNEAPOLIS MN UNITED STATES , 55402

Correspondent e-mail: trademark@winthrop.com , sbaird@winthrop.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ENGAGE HEALTH	REGISTERED AND RENEWED	76379828	2856390
ENGAGE HEALTH	Section 8 and 15 - Accepted and Acknowledged	85595853	4267458
ENGAGE HEALTH	Section 8 and 15 - Accepted and Acknowledged	85595858	4267459

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 20, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 20, 2015	Mar 01, 2015
3	PENDING, INSTITUTED	Jan 20, 2015	
4	W/DRAW OF APPLICATION	Jan 26, 2015	
5	BD DECISION: SUSTAINED	Feb 02, 2015	
6	TERMINATED	Feb 02, 2015	

United States of America

United States Patent and Trademark Office

ENGAGE HEALTH

Reg. No. 4,267,458

Registered Jan. 1, 2013

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

ENGAGE HEALTH, INC. (MINNESOTA CORPORATION)
852 BASSWOOD LANE
EAGAN, MN 55123

FOR: BUSINESS ADVICE AND ANALYSIS OF MARKETS; BUSINESS MEETING PLANNING; MARKET ANALYSIS; MARKET ASSESSMENT SERVICES; MARKET RESEARCH; MARKET RESEARCH CONSULTATION, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,856,390.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HEALTH", APART FROM THE MARK AS SHOWN.

SER. NO. 85-595,853, FILED 4-12-2012.

KATHY DE JONGE, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

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Mark: ENGAGE HEALTH

ENGAGE HEALTH

US Serial Number: 85595853

Application Filing Date: Apr. 12, 2012

US Registration Number: 4267458

Registration Date: Jan. 01, 2013

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Feb. 02, 2018

Publication Date: Oct. 16, 2012

Mark Information

Mark Literal Elements: ENGAGE HEALTH

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "HEALTH"

Related Properties Information

Claimed Ownership of US Registrations: 2856390

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: Business advice and analysis of markets; Business meeting planning; Market analysis; Market assessment services; Market research; Market research consultation

International Class(es): 035 - Primary Class

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

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 2001

Use in Commerce: Sep. 2001

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Engage Health, Inc.

Owner Address: 3265 Lexington Avenue S
Eagan, MINNESOTA UNITED STATES 55121

Legal Entity Type: CORPORATION

State or Country Where Organized: MINNESOTA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Stephen R. Baird

Docket Number: 11402.3

Attorney Primary Email Address: trademark@winthrop.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: STEPHEN R. BAIRD
WINTHROP & WEINSTINE, P.A.
225 South Sixth Street
Capella Tower, Suite 3500
MINNEAPOLIS, MINNESOTA UNITED STATES 55402-4629

Phone: (612) 604-6585

Fax: (612) 604-6985

Correspondent e-mail: trademark@winthrop.com sbaird@winthrop.com sitzmann@winthrop.com jbriley@winthrop.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 02, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Feb. 02, 2018	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70131
Feb. 02, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70131
Jan. 16, 2018	TEAS SECTION 8 & 15 RECEIVED	
Jan. 01, 2018	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Jan. 01, 2013	REGISTERED-PRINCIPAL REGISTER	
Oct. 16, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 16, 2012	PUBLISHED FOR OPPOSITION	
Sep. 26, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Sep. 13, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
Sep. 13, 2012	ASSIGNED TO LIE	68123
Sep. 04, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 04, 2012	EXAMINER'S AMENDMENT ENTERED	88888
Sep. 04, 2012	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Sep. 04, 2012	EXAMINERS AMENDMENT E-MAILED	6328
Sep. 04, 2012	EXAMINERS AMENDMENT -WRITTEN	72505
Aug. 02, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 02, 2012	NON-FINAL ACTION E-MAILED	6325
Aug. 02, 2012	NON-FINAL ACTION WRITTEN	72505
Jul. 27, 2012	ASSIGNED TO EXAMINER	72505
Apr. 19, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 17, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 107

Date in Location: Feb. 02, 2018

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91220249](#)

Filing Date: Jan 20, 2015

Status: Terminated

Status Date: Feb 02, 2015

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: The WorkCare Group, Inc.

Correspondent Address: THE WORKCARE GROUP INC
4077 BLUFTON MILL ROAD
FREE UNION VA UNITED STATES , 22940

Correspondent e-mail: workcaregroup@earthlink.net , georgeworkcare@earthlink.net

Associated marks

Mark	Application Status	Serial Number	Registration Number
ENGAGE IN HEALTH	Abandoned - After Inter-Partes Decision	85173778	

Plaintiff(s)

Name: Engage Health, Inc.

Correspondent Address: STEPHEN R BAIRD
WITHROP & WEINSTINE PA
225 SOUTH SIXTH STREET , SUITE 3500 CAPELLA TOWER
MINNEAPOLIS MN UNITED STATES , 55402

Correspondent e-mail: trademark@winthrop.com , sbaird@winthrop.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ENGAGE HEALTH	REGISTERED AND RENEWED	76379828	2856390
ENGAGE HEALTH	Section 8 and 15 - Accepted and Acknowledged	85595853	4267458
ENGAGE HEALTH	Section 8 and 15 - Accepted and Acknowledged	85595858	4267459

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 20, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 20, 2015	Mar 01, 2015
3	PENDING, INSTITUTED	Jan 20, 2015	
4	W/DRAW OF APPLICATION	Jan 26, 2015	
5	BD DECISION: SUSTAINED	Feb 02, 2015	
6	TERMINATED	Feb 02, 2015	

United States of America

United States Patent and Trademark Office

ENGAGE HEALTH

Reg. No. 4,267,459

ENGAGE HEALTH, INC. (MINNESOTA CORPORATION)
852 BASSWOOD LANE
EAGAN, MN 55123

Registered Jan. 1, 2013

Int. Cl.: 42

FOR: PRODUCT DEVELOPMENT CONSULTATION; PRODUCT RESEARCH AND DEVELOPMENT, IN CLASS 42 (U.S. CLS. 100 AND 101).

SERVICE MARK

FIRST USE 9-0-2001; IN COMMERCE 9-0-2001.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,856,390.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HEALTH", APART FROM THE MARK AS SHOWN.

SER. NO. 85-595,858, FILED 4-12-2012.

KATHY DE JONGE, EXAMINING ATTORNEY



David J. Kyjko

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

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Mark: ENGAGE HEALTH

ENGAGE HEALTH

US Serial Number: 85595858

Application Filing Date: Apr. 12, 2012

US Registration Number: 4267459

Registration Date: Jan. 01, 2013

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Feb. 02, 2018

Publication Date: Oct. 16, 2012

Mark Information

Mark Literal Elements: ENGAGE HEALTH

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "HEALTH"

Related Properties Information

Claimed Ownership of US Registrations: 2856390

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
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For: Product development consultation; Product research and development

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 2001

Use in Commerce: Sep. 2001

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: Engage Health, Inc.

Owner Address: 3265 Lexington Avenue S
Eagan, MINNESOTA 55121
UNITED STATES

Legal Entity Type: CORPORATION

State or Country MINNESOTA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Stephen R. Baird

Docket Number: 11402.4

Attorney Primary trademark@winthrop.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent STEPHEN R. BAIRD
Name/Address: WINTHROP & WEINSTINE, P.A.
225 South Sixth Street
Capella Tower, Suite 3500
MINNEAPOLIS, MINNESOTA 55402-4629
UNITED STATES

Phone: (612) 604-6585

Fax: (612) 604-6985

Correspondent e- trademark@winthrop.com sbaird@winthrop.com t
mail: sitzmann@winthrop.com jbriley@winthrop.com

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
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Feb. 02, 2018	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70131
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Apr. 17, 2012	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Section 8 - Accepted
Continued Use:

Affidavit of Section 15 - Accepted

Incontestability:

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 107

Date in Location: Feb. 02, 2018

Proceedings

Summary

Number of
Proceedings: 1

Type of Proceeding: Opposition

Proceeding
Number: [91220249](#)

Filing Date: Jan 20, 2015

Status: Terminated

Status Date: Feb 02, 2015

Interlocutory
Attorney: GEORGE POLOGEORGIS

Defendant

Name: The WorkCare Group, Inc.

Correspondent
Address: THE WORKCARE GROUP INC
4077 BLUFTON MILL ROAD
FREE UNION VA , 22940
UNITED STATES

Correspondent e-
mail: workcaregroup@earthlink.net , georgeworkcare@earthlink.net

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MINNEAPOLIS MN , 55402
UNITED STATES

Correspondent e-
mail: trademark@winthrop.com , sbaird@winthrop.com

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