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

Proceeding	92071435
Party	Plaintiff Engage Health, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 4,715,257
Mark: CLINEDGE ENGAGE

ENGAGE HEALTH, INC.

Petitioner,

v.

Cancellation No. 92071435

CLINEDGE, LLC

Registrant.

PETITIONER’S ANSWER TO COUNTERCLAIM

Petitioner, Engage Health, Inc. (“Petitioner”) answers the alternative Counterclaim (“Counterclaim”) filed by ClinEdge, LLC (“Registrant”) as set forth below. The capitalized terms “Petitioner’s Marks” and “Registrant’s Mark” have the meaning set forth in the Petition to Cancel filed by Petitioner on June 5, 2019, *see* 1 TTABVue:

1. Petitioner admits the averments in Paragraph 1 of the Counterclaim are consistent with the data in the TSDR database maintained by the U.S. Patent and Trademark Office in as much as Registrant’s U.S. Registration No. 4,715,257 identifies the services “patient recruitment and retention services for clinical studies conducted by others” in Class 35.

2. Petitioner admits the averments in Paragraph 2 of the Counterclaim are consistent with the data in the TSDR database maintained by the U.S. Patent and Trademark Office in as much as U.S. Registration No. 4,267,458 identifies the services “Business advice and analysis of markets; Business meeting planning; Market analysis; Market assessment services; Market research; Market research consultation” in Class 35.

3. Petitioner admits the averments in Paragraph 3 of the Counterclaim are consistent with the data in the TSDR database maintained by the U.S. Patent and Trademark Office in as much as U.S. Registration No. 4,267,459 identifies the services “product development consultation; Product research and development” in Class 42.

4. Petitioner admits the averments in Paragraph 4 of the Counterclaim are consistent with the data in the TSDR database maintained by the U.S. Patent and Trademark Office in as much as U.S. Registration No. 2,856,390 identifies the services “consulting services in the fields of pharmaceuticals, biotechnology, and medical products and services” in Class 44.

5. Petitioner admits the averments in Paragraph 5 of the Counterclaim are consistent with the data in the TSDR database maintained by the U.S. Patent and Trademark Office in as much as U.S. Registration No. 4,715,257 identifies services without identifying an express restriction on “the identification of goods[sic] or channels of trade.”

6. Petitioner admits the averments in Paragraph 6 of the Counterclaim are consistent with the data in the TSDR database maintained by the U.S. Patent and Trademark Office in as much as Petitioner’s U.S. Registration Nos. 4,267,458, 4,267,459, and 2,856,390 identify services without identifying an express restriction on “the identification of goods[sic] or channels of trade.”

7. Petitioner denies the averments in Paragraph 7 of the Counterclaim. Petitioner in fact offers under Petitioner’s Marks the services identified in Petitioner’s U.S. Registration Nos. 4,267,458, 4,267,459, and 2,856,390, as well as other services, including the services identified in Registrant’s U.S. Registration No. 4,715,257, namely, “patient recruitment and retention services for clinical studies conducted by others” in Class 35, to organizations in fields outside of rare disease and orphan drugs.

8. Petitioner denies the averments in Paragraph 8 of the Counterclaim. Registrant in fact has admitted, in Paragraphs 16 and 17 of its Answer to the Petition to Cancel, that Registrant

sent “marketing solicitations by email, all featuring Registrant’s Mark in the signature block, to other attendees of the 2109 World Orphan Drug conference,” the World Orphan Drug Conference being a conference for organizations in the fields of rare disease and orphan drugs.

9. The averments in Paragraph 9 of the Counterclaim are premature and do not require an admission or denial and are therefore denied, except that Petitioner admits the Trademark Trial and Appeal Board should find that there exists a likelihood of confusion between Petitioner’s Marks and Registrant’s Mark.

10. Petitioner denies the averments in Paragraph 10 of the Counterclaim. The proposed amendments to restrict the services identified in Petitioner’s U.S. Registration Nos. 4,267,458, 4,267,459, and 2,856,390 and Registrant’s U.S. Registration No. 4,715,257 would not prevent the likelihood of confusion between Petitioner’s Marks and Registrants Mark because, among other reasons, customers of Petitioner and Registrant are accustomed to such services in both the fields of rare diseases and orphan drugs and fields outside rare diseases and orphan drugs being offered by a single source, and in fact, Petitioner and Registrant are such sources.

11. Petitioner denies any remaining averments in the Counterclaim.

WHEREFORE, Petitioner respectfully requests that the Board deny the Counterclaim and award Petitioner any further relief the Board deems equitable.

Dated: August 16, 2019

Respectfully submitted,

GREENBERG TRAURIG, LLP

___/DHW/_____

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing PETITIONER'S ANSWER TO COUNTERCLAIM has been served on ClinEdge, LLC by forwarding said copy on August 16, 2019 via email to:

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