

ESTTA Tracking number: **ESTTA1040083**

Filing date: **03/04/2020**

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 6122599700		
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Registration Subject to Cancellation

Registration No.	4829029	Registration date	10/06/2015
Registrant	ClinicalMind, LLC 640 West 28th Street, 5th Floor New York, NY 10001 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2014/12/11 First Use In Commerce: 2014/12/11 All goods and services in the class are subject to cancellation, namely: Provision of digital marketing and related consultancy services in the fields of healthcare, medicine, and pharmacology; development of marketing strategies and customer relationship management strategies in the fields of healthcare, medicine, and pharmacology; market analysis services in the fields of healthcare, medicine, and pharmacology

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	NONE

		Date	
Word Mark	ENGAGE HEALTH		
Design Mark	<p style="text-align: center;">ENGAGE HEALTH</p>		
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	<p style="text-align: center;">ENGAGE HEALTH</p>		
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	<p style="text-align: center;">ENGAGE HEALTH</p>		

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

U.S. Application No.	88460698	Application Date	06/05/2019
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	ENGAGE
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Design Mark	
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Description of Mark	The mark consists of the word "ENGAGE" with five green hexagons placed equal distances apart around the top, left, and bottom of the letters 'EN'.
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Goods/Services	Class 035. First use: First Use: 2003/07/00 First Use In Commerce: 2003/07/00 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
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Attachments	76379828#TMSN.png(bytes) 85595853#TMSN.png(bytes) 85595858#TMSN.png(bytes) 88460698#TMSN.png(bytes) PTC ENGAUGE.pdf(659423 bytes)
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Signature	/DHW/
Name	Draeke H. Weseman
Date	03/04/2020

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

In the Matter of Registration No. 4,829,029
For the Mark: ENGAUGE
Date of Issue: October 6, 2015

_____)	
ENGAGE HEALTH, INC.)	
)	
Petitioner,)	
)	
v.)	Cancellation No.:
)	
)	
CLINICALMIND, LLC)	
)	
)	
Respondent.)	
)	
_____)	

PETITION TO CANCEL

Pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064 and 37 C.F.R. § 2.111, Engage Health, Inc. (“Petitioner”), a Minnesota corporation, through undersigned counsel, files this petition to cancel U.S. Registration No. 4,829,029 (the “Registration”) for the standard character mark ENGAUGE (the “Registered Mark”), held by ClinicalMind, LLC (“Respondent”), a Delaware limited liability company, having its address of record at 640 West 28th Street, 5th Floor, New York, NY 10001. The grounds for this petition 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 a family marks featuring the distinctive term “ENGAGE,” including the marks ENGAGE, ENGAGE & Design, ENGAGE HEALTH, and ENGAGE ENCOMPASS (collectively, “Petitioner’s Marks”).

2. Since at least as early as September 2001, 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”).

3. Petitioner is the owner of incontestable U.S. Registration No. 4,267,458, filed April 12, 2012 and 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.

4. Petitioner is the owner of incontestable U.S. Registration No. 4,267,459, filed April 12, 2012 and registered January 1, 2013, for the mark ENGAGE HEALTH, in standard characters, for “product development consultation; product research and development” in Class 42.

5. Petitioner is the owner of incontestable U.S. Registration No. 2,856,390, filed March 6, 2002 and registered June 22, 2004, 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.

6. Petitioner is the owner of U.S. Registration No. 5,844,550, registered August 27, 2019, for the mark ENGAGE ENCOMPASS, in standard characters, for “product development consultation; product research and development” in Class 42.

7. 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"):



8. Petitioner is the owner of U.S. Trademark Application Serial No. 88/460,698 (the "Application") for the ENGAGE & Design Mark 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 International Class 35.

9. 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.

10. The Registered Mark is registered for "Provision of digital marketing and related consultancy services in the fields of healthcare, medicine, and pharmacology; development of marketing strategies and customer relationship management strategies in the fields of healthcare, medicine, and pharmacology; market analysis services in the fields of healthcare, medicine, and pharmacology" in Class 35 ("Respondent's Services").

11. The Registration claims December 11, 2014 as the date of first use in commerce for the Registered Mark.

12. Upon information and belief, Respondent did not use the Registered Mark in commerce for Respondent's Services prior to the claimed first use in commerce date of December 11, 2014.

13. Respondent first used the Registered Mark in commerce after Petitioner first used many of Petitioner's Marks in commerce, including but not limited to Petitioner's ENGAGE HEALTH marks registered in incontestable U.S. Registration Nos. 2,856,390, 4,267,458, and 4,267,459 and Petitioner's ENGAGE & Design Mark in the Application.

14. Respondent first used the Registered Mark in commerce after the filing dates of incontestable U.S. Registration Nos. 2,856,390, 4,267,458, and 4,267,459.

15. Respondent first used the Registered Mark in commerce after the registration dates of incontestable U.S. Registration Nos. 2,856,390, 4,267,458, and 4,267,459.

16. The Registered Mark is visually nearly identical to the word "engage," differing in spelling by one additional letter "u" while containing all of the letters in the word "engage."

17. The Registered Mark is phonetically equivalent to the word "engage."

18. The word “engage” is the dominant portion of Petitioner’s Marks, including but not limited to, Petitioner’s ENGAGE HEALTH marks registered in incontestable U.S. Registration Nos. 2,856,390, 4,267,458, and 4,267,459 with the term “HEALTH” disclaimed.

19. The word “engage” is the only literal element in, and the dominant portion of, Petitioner’s ENGAGE & Design Mark.

20. The Registered Mark is essentially identical to the dominant portion of Petitioner’s Marks, the word “engage,” in sight, sound, and appearance.

21. Upon information and belief, Respondent markets and sells Respondent’s Services through identical channels of trade as those through which Petitioner markets and sells Petitioner’s Services.

22. Upon information and belief, Respondent markets and sells Respondent’s Services to the same class of purchasers as to whom Petitioner markets and sells Petitioner’s Services.

23. The Registered Mark is confusingly similar to Petitioner’s Marks, including but not limited to, Petitioner’s ENGAGE HEALTH marks registered in incontestable U.S. Registration Nos. 2,856,390, 4,267,458, and 4,267,459 and Petitioner’s ENGAGE & Design Mark in the Application.

24. Respondent’s Services, specifically “Provision of digital marketing and related consultancy services in the fields of healthcare, medicine, and pharmacology; development of marketing strategies and customer relationship management strategies in the fields of healthcare, medicine, and pharmacology; market analysis services in the fields of healthcare, medicine, and pharmacology” are identical to, substantially overlap with, or are closely related to Petitioner’s Services.

25. Petitioner is being and will continue to be damaged by the Registration because the Registered Mark so resembles Petitioner’s Marks as to be likely, when used in connection with

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

Docket Number: 11402.2

Attorney Primary Email Address: trademark@winthrop.com

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

Fax: (612) 604-6985

Correspondent e-mail: trademark@winthrop.com

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
- Asterisks *..* identify additional (new) wording in the goods/services.

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
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	

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

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 , 55402
UNITED STATES

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
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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	

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Mark: ENGAGE



US Serial Number: 88460698

Application Filing Date: Jun. 05, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Sep. 04, 2019

Mark Information

Mark Literal Elements: ENGAGE

Standard Character Claim: No

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

Description of Mark: The mark consists of the word "ENGAGE" with five green hexagons placed equal distances apart around the top, left, and bottom of the letters 'EN'.

Color Drawing: Yes

Color(s) Claimed: The color(s) green is/are claimed as a feature of the mark.

Design Search Code(s): 26.15.28 - Polygonal shapes (miscellaneous overall shape); Miscellaneous designs with overall polygon shape

Related Properties Information

Claimed Ownership of US Registrations: 2856390, 4267458, 4267459

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: 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

International Class(es): 035 - Primary Class

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

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 2003

Use in Commerce: Jul. 2003

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 South
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

Attorney Primary Email Address: gtipmail@gtlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: STEPHEN R. BAIRD
GREENBERG TRAUIG, LLP
90 SOUTH SEVENTH STREET, SUITE 3500
MINNEAPOLIS, MINNESOTA UNITED STATES 55402

Phone: 612-259-9718

Correspondent e-mail: gtipmail@gtlaw.com bairds@gtlaw.com weseman@gtlaw.com claseenc@gtlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 04, 2019	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 04, 2019	NON-FINAL ACTION E-MAILED	6325
Sep. 04, 2019	NON-FINAL ACTION WRITTEN	77979
Aug. 27, 2019	ASSIGNED TO EXAMINER	77979
Jun. 21, 2019	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jun. 20, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 08, 2019	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: SNYDER, NELSON B

Law Office Assigned: LAW OFFICE 107

File Location

Current Location: TMEG LAW OFFICE 107 - EXAMINING ATTORNEY ASSIGNED

Date in Location: Sep. 04, 2019