

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78273213
LAW OFFICE ASSIGNED	LAW OFFICE 109
MARK SECTION (no change)	
ARGUMENT(S)	
<p>Applicant respectfully submits that no likelihood of confusion exists between the Class 41 services for its mark, ALBERT EINSTEIN (“Applicant’s Mark”), and the marks ALBERT EINSTEIN, U.S. Registration No. 1,216,122, and ALBERT EINSTEIN COLLEGE OF MEDICINE, U.S. Registration No. 2,804,138 (“Cited Marks”) in Class 41 or otherwise. As discussed more fully below, there is no likelihood of confusion because Applicant was granted the right to use Applicant’s Mark and Applicant has modified the Class 41 identification of services.</p> <p>As background, Dr. Albert Einstein was one of the founder’s of Applicant’s organization. At death, Dr. Einstein left all of his intellectual property rights, including trademark rights and publicity rights to Applicant (“EINSTEIN Rights”). In Applicant’s role as owner of the EINSTEIN Rights, Applicant has filed this application to provide services in fields in which Dr. Einstein studied, worked, and demonstrated interest. Applicant’s Mark is a natural outgrowth of the services provided by Applicant as the custodian of Dr. Einstein’s legacy. As the owner of the EINSTEIN Rights, Applicant respectfully requests that the Examining Attorney withdraw his refusal.</p> <p><i>Modified Identification of Services in Class 41</i></p> <p>Without conceding a likelihood of confusion, Applicant has revised its Class 41 services in its application for Applicant’s Mark. This revision should address the Examining Attorney’s concern that the Applicant does not identify the subject matter of the demonstrations. It is now clear that the services listed in the application do not overlap with the services in the Cited Marks. Therefore, there should be no likelihood of confusion between Applicant’s Mark and the Cited Marks. As for the remaining goods and services in Applicant’s application, the USPTO has already made a determination that there is no likelihood of confusion between Applicant’s Mark and the Cited Marks.</p> <p><i>The EINSTEIN Rights</i></p> <p>There is no likelihood of confusion because Applicant is owner of the EINSTEIN Rights and Yeshiva University was only granted the narrow right to use Dr. Einstein’s name in connection with its medical college. However, all other EINSTEIN Rights belong to Applicant. Therefore, whenever the EINSTEIN Rights are used in connection with anything other than a medical college run by</p>	

Yeshiva University, those rights identify Applicant as the source. Noting Applicant's agreement to limit the services to specifically exclude the rights granted to Yeshiva University in its medical college, Applicant respectfully requests that the Examining Attorney approve Applicant's Mark for publication.

Finally, pursuant to 37 C.F.R. §2.64(b), TMEP §715.03, Applicant respectfully requests that the Examining Attorney reconsider and withdraw his refusal to register Applicant's Mark. In the event that the Examining Attorney does not grant this request, a Notice of Appeal to the Trademark Trial and Appeal Board is being filed simultaneously herewith to preserve Applicant's rights. A copy of said Notice is attached hereto for Examining Attorney's ready reference as **Exhibit A**.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_20447535-192029628 . ALBERTEINSTEIN ExA.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT11\IMAGEOUT11\782\732\78273213 \xml3\RFR0002.JPG
DESCRIPTION OF EVIDENCE FILE	Notice of Appeal

GOODS AND/OR SERVICES SECTION (009)(current)

INTERNATIONAL CLASS	009
DESCRIPTION	
Computer software, computer hardware and peripherals, mouse pads, computer games, video games, prerecorded audio and video tapes and discs, audio and video recorders and players, calculators, children's educational software, decorative magnets, eyeglasses, sunglasses, eyeglass frames, laboratory equipment, magnifying glasses, metal detectors, personal digital assistants, radios, remote controls, telephones, telescopes, electronic testers, cameras	
FILING BASIS	Section 1(b)

GOODS AND/OR SERVICES SECTION (009)(proposed)

INTERNATIONAL CLASS	009
TRACKED TEXT DESCRIPTION	
<p>Computer software, computer hardware and peripherals, mouse pads, computer games, video games, prerecorded audio and video tapes and discs, audio and video recorders and players, calculators, children's educational software, decorative magnets, eyeglasses, sunglasses, eyeglass frames, laboratory equipment, magnifying glasses, metal detectors, personal digital assistants, radios, remote controls, telephones, telescopes, electronic testers, cameras; <u>Computer software, for use in the field of database management, marketing and website design; computer hardware and peripherals; mouse pads; computer games, namely computer game software on cartridges and discs and downloadable via a global computer network; interactive video game programs, video game software, cartridges and discs and downloadable via a global computer network; prerecorded audio and video tapes and discs featuring music and recorded books in the fields of math, science, reading, and test preparation at the primary and secondary level; audio tape recorders and players; video tape recorders and players; calculators; children's educational software; decorative magnets; eyeglasses; sunglasses; eyeglass frames; laboratory equipment, namely thermometers, flasks, Petri dishes, test tubes, microscopes and</u></p>	

<u>microscope slides sold as a kit; magnifying glasses; metal detectors; personal digital assistants; radios; remote controls for radios, televisions, stereos; telephones; telescopes; electronic testers for testing voltage, light, sounds, pH and temperature; cameras.</u>	
FINAL DESCRIPTION	
Computer software, for use in the field of database management, marketing and website design; computer hardware and peripherals; mouse pads; computer games, namely computer game software on cartridges and discs and downloadable via a global computer network; interactive video game programs, video game software, cartridges and discs and downloadable via a global computer network; prerecorded audio and video tapes and discs featuring music and recorded books in the fields of math, science, reading, and test preparation at the primary and secondary level; audio tape recorders and players; video tape recorders and players; calculators; children's educational software; decorative magnets; eyeglasses; sunglasses; eyeglass frames; laboratory equipment, namely thermometers, flasks, Petri dishes, test tubes, microscopes and microscope slides sold as a kit; magnifying glasses; metal detectors; personal digital assistants; radios; remote controls for radios, televisions, stereos; telephones; telescopes; electronic testers for testing voltage, light, sounds, pH and temperature; cameras.	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (041)(current)	
INTERNATIONAL CLASS	041
DESCRIPTION	
Educational and entertainment services including educational demonstrations and programs, and providing courses of instruction at the primary and secondary level and the distribution of course material in connection therewith	
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (041)(proposed)	
INTERNATIONAL CLASS	041
TRACKED TEXT DESCRIPTION	
Educational and entertainment services including educational demonstrations and programs, and providing courses of instruction at the primary and secondary level and the distribution of course material in connection therewith; <u>Educational and entertainment services, namely providing classroom instruction and educational demonstrations and programs in the fields of math, science, reading, and test preparation at the primary and secondary level, excluding educational services in the field of medicine or biological science at the graduate and professional level; and the distribution of course material in connection therewith.</u>	
FINAL DESCRIPTION	
Educational and entertainment services, namely providing classroom instruction and educational demonstrations and programs in the fields of math, science, reading, and test preparation at the primary and secondary level, excluding educational services in the field of medicine or biological science at the graduate and professional level; and the distribution of course material in connection therewith.	

FILING BASIS	Section 1(b)
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Eva J. Pulliam/
SIGNATORY'S NAME	Eva J. Pulliam
SIGNATORY'S POSITION	Attorney of record (Arent Fox LLP), D.C. bar member
SIGNATORY'S PHONE NUMBER	202-857-6000
DATE SIGNED	11/30/2011
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Wed Nov 30 19:35:47 EST 2011
TEAS STAMP	USPTO/RFR-204.4.75.35-201 11130193547049307-7827321 3-490781ab2d8e78cdb469497 756798b693e0-N/A-N/A-2011 1130192029628345

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **78273213** ALBERT EINSTEIN has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Applicant respectfully submits that no likelihood of confusion exists between the Class 41 services for its mark, ALBERT EINSTEIN ("Applicant's Mark"), and the marks ALBERT EINSTEIN, U.S. Registration No. 1,216,122, and ALBERT EINSTEIN COLLEGE OF MEDICINE, U.S. Registration No. 2,804,138 ("Cited Marks") in Class 41 or otherwise. As discussed more fully below, there is no likelihood of confusion because Applicant was granted the right to use Applicant's Mark and Applicant has modified the Class 41 identification of services.

As background, Dr. Albert Einstein was one of the founder's of Applicant's organization. At death, Dr. Einstein left all of his intellectual property rights, including trademark rights and publicity rights to Applicant ("EINSTEIN Rights"). In Applicant's role as owner of the EINSTEIN Rights,

Applicant has filed this application to provide services in fields in which Dr. Einstein studied, worked, and demonstrated interest. Applicant's Mark is a natural outgrowth of the services provided by Applicant as the custodian of Dr. Einstein's legacy. As the owner of the EINSTEIN Rights, Applicant respectfully requests that the Examining Attorney withdraw his refusal.

Modified Identification of Services in Class 41

Without conceding a likelihood of confusion, Applicant has revised its Class 41 services in its application for Applicant's Mark. This revision should address the Examining Attorney's concern that the Applicant does not identify the subject matter of the demonstrations. It is now clear that the services listed in the application do not overlap with the services in the Cited Marks. Therefore, there should be no likelihood of confusion between Applicant's Mark and the Cited Marks. As for the remaining goods and services in Applicant's application, the USPTO has already made a determination that there is no likelihood of confusion between Applicant's Mark and the Cited Marks.

The EINSTEIN Rights

There is no likelihood of confusion because Applicant is owner of the EINSTEIN Rights and Yeshiva University was only granted the narrow right to use Dr. Einstein's name in connection with its medical college. However, all other EINSTEIN Rights belong to Applicant. Therefore, whenever the EINSTEIN Rights are used in connection with anything other than a medical college run by Yeshiva University, those rights identify Applicant as the source. Noting Applicant's agreement to limit the services to specifically exclude the rights granted to Yeshiva University in its medical college, Applicant respectfully requests that the Examining Attorney approve Applicant's Mark for publication.

Finally, pursuant to 37 C.F.R. §2.64(b), TMEP §715.03, Applicant respectfully requests that the Examining Attorney reconsider and withdraw his refusal to register Applicant's Mark. In the event that the Examining Attorney does not grant this request, a Notice of Appeal to the Trademark Trial and Appeal Board is being filed simultaneously herewith to preserve Applicant's rights. A copy of said Notice is attached hereto for Examining Attorney's ready reference as **Exhibit A**.

EVIDENCE

Evidence in the nature of Notice of Appeal has been attached.

Original PDF file:

[evi_20447535-192029628_-_ALBERTEINSTEIN_ExA.pdf](#)

Converted PDF file(s) (1 page)

[Evidence-1](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 009 for Computer software, computer hardware and peripherals, mouse pads, computer games, video games, prerecorded audio and video tapes and discs, audio and video recorders and players, calculators, children's educational software, decorative magnets, eyeglasses, sunglasses, eyeglass frames, laboratory equipment, magnifying glasses, metal detectors, personal digital assistants, radios, remote controls, telephones, telescopes, electronic testers, cameras

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Computer software, computer hardware and peripherals, mouse pads, computer games, video games, prerecorded audio and video tapes and discs, audio and video recorders and players, calculators, children's educational software, decorative magnets, eyeglasses, sunglasses, eyeglass frames, laboratory equipment, magnifying glasses, metal detectors, personal digital assistants, radios, remote controls, telephones, telescopes, electronic testers, cameras; Computer software, for use in the field of database management, marketing and website design; computer hardware and peripherals; mouse pads; computer games, namely computer game software on cartridges and discs and downloadable via a global computer network; interactive video game programs, video game software, cartridges and discs and downloadable via a global computer network; prerecorded audio and video tapes and discs featuring music and recorded books in the fields of math, science, reading, and test preparation at the primary and secondary level; audio tape recorders and players; video tape recorders and players; calculators; children's educational software; decorative magnets; eyeglasses; sunglasses; eyeglass frames; laboratory equipment, namely thermometers, flasks, Petri dishes, test tubes, microscopes and microscope slides sold as a kit; magnifying glasses; metal detectors; personal digital assistants; radios; remote controls for radios, televisions, stereos; telephones; telescopes; electronic testers for testing voltage, light, sounds, pH and temperature; cameras.~~

Class 009 for Computer software, for use in the field of database management, marketing and website design; computer hardware and peripherals; mouse pads; computer games, namely computer game software on cartridges and discs and downloadable via a global computer network; interactive video game programs, video game software, cartridges and discs and downloadable via a global computer network; prerecorded audio and video tapes and discs featuring music and recorded books in the fields of math, science, reading, and test preparation at the primary and secondary level; audio tape recorders and players; video tape recorders and players; calculators; children's educational software; decorative magnets; eyeglasses; sunglasses; eyeglass frames; laboratory equipment, namely thermometers, flasks, Petri dishes, test tubes, microscopes and microscope slides sold as a kit; magnifying glasses; metal detectors; personal digital assistants; radios; remote controls for radios, televisions, stereos; telephones; telescopes; electronic testers for testing voltage, light, sounds, pH and temperature; cameras.

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 041 for Educational and entertainment services including educational demonstrations and programs, and providing courses of instruction at the primary and secondary level and the distribution of course material in connection therewith

Original Filing Basis:

Filing Basis: Section 1(b), Intent to Use: The applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

Proposed:

Tracked Text Description: ~~Educational and entertainment services including educational demonstrations and programs, and providing courses of instruction at the primary and secondary level and the distribution of course material in connection therewith; Educational and entertainment services, namely providing classroom instruction and educational demonstrations and programs in the fields of math, science, reading, and test preparation at the primary and secondary level, excluding educational services in the field of medicine or biological science at the graduate and professional level; and the distribution of course material in connection therewith.~~

Class 041 for Educational and entertainment services, namely providing classroom instruction and educational demonstrations and programs in the fields of math, science, reading, and test preparation at the primary and secondary level, excluding educational services in the field of medicine or biological science at the graduate and professional level; and the distribution of course material in connection therewith.

Filing Basis: Section 1(b), Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. (15 U.S.C. Section 1051(b)).

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /Eva J. Pulliam/ Date: 11/30/2011

Signatory's Name: Eva J. Pulliam

Signatory's Position: Attorney of record (Arent Fox LLP), D.C. bar member

Signatory's Phone Number: 202-857-6000

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

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

Serial Number: 78273213

Internet Transmission Date: Wed Nov 30 19:35:47 EST 2011

TEAS Stamp: USPTO/RFR-204.4.75.35-201111301935470493

07-78273213-490781ab2d8e78cdb46949775679

8b693e0-N/A-N/A-20111130192029628345

ESTTA Tracking number: **ESTTA443982**

Filing date: **11/30/2011**

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

Application Serial No.	78273213
Applicant	The Hebrew University of Jerusalem

Notice of Appeal

Notice is hereby given that The Hebrew University of Jerusalem appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 78273213.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:

- Class 041.

All goods and services in the class are appealed, namely: Educational and entertainment services including educational demonstrations and programs, and providing courses of instruction at the primary and secondary level and the distribution of course material in connection therewith

Respectfully submitted,

/Eva J. Pulliam/

11/30/2011

Eva J. Pulliam

Arent Fox, LLP

1050 Connecticut Avenue, N.W.

Washington, DC 20036

UNITED STATES

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