From: Rossman, William

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Subject: U.S. TRADEMARK APPLICATION NO. 78273213 - ALBERT EINSTEIN - 28000.00001 - Request for Reconsideration Denied - Return to TTAB - Message 1 of 0

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 78273213

MARK: ALBERT EINSTEIN

CORRESPONDENT ADDRESS:
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GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: The Hebrew University of Jerusalem

CORRESPONDENT'S REFERENCE/DOCKET NO:
28000.00001
CORRESPONDENT E-MAIL ADDRESS:

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE:

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.64(b); TMEP §§715.03(a), 715.04(a). The requirement(s) and/or refusal(s) made final in the Office action dated May 31, 2011 are maintained and continue to be final. *See* TMEP §§715.03(a), 715.04(a).

In the present case, applicant's request has not resolved all the outstanding issue(s), nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue(s) in the final Office action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

The filing of a request for reconsideration does not extend the time for filing a proper response to a final Office action or an appeal with the Trademark Trial and Appeal Board (Board), which runs from the date the final Office action was issued/mailed. *See* 37 C.F.R. §2.64(b); TMEP §§715.03, 715.03(a), (c).

If time remains in the six-month response period to the final Office action, applicant has the remainder of the response period to comply with and/or overcome any outstanding final requirement(s) and/or refusal(s) and/or to file an appeal with the Board. TMEP

§715.03(a), (c). However, if applicant has already filed a timely notice of appeal with the Board, the Board will be notified to resume the appeal when the time for responding to the final Office action has expired. *See* TMEP §715.04(a).

A. Refusal to Register: Likelihood of Confusion

Registration of the applied-for mark ALBERT EINSTEIN 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)** in class 041 is refused because of a likelihood of confusion with the mark in U.S. Registration Nos. 1216122 and 2804138 for ALBERT EINSTEIN and ALBERT EINSTEIN COLLEGE OF MEDICINE respectively for **(educational services-namely, conducting a medical school and educational services, namely, providing courses of instruction and training in the field of medicine and biological science)** Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* The registrations were previously attached.

For the reasons discussed below, the examining attorney concludes that confusion as to the source of goods and services is likely between the applicant's mark ALBERT EINSTEIN and the registrant's marks ALBERT EINSTEIN and ALBERT EINSTEIN COLLEGE OF MEDICINE for the goods and/or services listed in the application.

As previously discussed, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services.

Similarity of the Marks

1. The applicant has submitted no arguments as to the similarities of the mark

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The examining attorney finds that the marks are identical except for the wording “COLLEGE OF MEDICINE” which is highly descriptive or generic as to the educational services in registrant’s mark and have little if any trademark significance. Furthermore, the marks also create the same connotation and overall, the marks have the same commercial impression. The examining attorney also incorporates by reference herein the arguments submitted in the first and final office actions as to the similarities of the mark.

If the marks of the respective parties are identical or highly similar, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Similarity of the Goods/Services

The second part of the legal analysis involves comparing the goods to determine whether they are similar or related, and could cause a mistaken belief among potential purchasers that the goods come from a common source.

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The applicant has submitted no arguments that the services are different. Applicant has only excluded medical and biological services in their identification. However, as shown in the new evidence and past evidence in the first and final office actions, there are numerous third party registrations and Internet evidence that indicates many institutions offer both primary, secondary and graduate education and many also offer medical or science related education services. Excluding educational services in the field of medicine and biological science as the graduate and professional level does not alter the relatedness of the services.

2. <u>Applicant respectfully submits that there is no likelihood of confusion because Applicant has modified the Class 41 identification of services and is owner of the EINSTEIN Rights and Yeshiva University (the registrant) 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</u>

Applicant again has made no argument as to the similarities of the services but has only excluded specific language from their identification. Applicant's argument has relied on ownership rights. It is noted that no supporting documentation has been submitted as to these rights. Even if the applicant has submitted some licensing agreement this is not the type of evidence to overcome a likelihood of confusion refusal. Applicant has also not

submitted any type of consent from the registrant. The applicant has merely restricted there identification by excluding medical and biological science. However, this does not overcome the likelihood of confusion as the base educational services are still related. The consumer would not know that the services are restricted.

The common ground as between the applicant's and registrant's services is the provision of instruction. Granted, registrant uses the instant marks in connection with those services at the *graduate and professional* levels whereas the applicant intends to use the marks in connection with its educational services as the primary and secondary level. Nevertheless, there is significant evidence, some already of record, to support the fact that these offerings are related.

The applicant's services are namely:

Class 041: 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"

These services are quite similar to registrant's services, namely:

Class 041: Educational services, namely, "providing courses of instruction and training in the field of medicine and biological science at the graduate and professional levels and distributing course material in connection therewith" and "Educational Services-Namely, Conducting a Medical School".

Applicant services, namely, the educational demonstrations and programs are very broad in the wording and may cause confusion between the marks. The applicant still provides educational science services that may be similar or related to the registrant's medical school and training services.

The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely, education in the primary, secondary and graduate level and full educational disciplines including medicine and science, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

A. In particular please view the attached registration 2792172 for the University of Texas that offers both undergraduate and graduate education courses including medicine

B. Also view attached registration 2995504 for education and training, namely, providing academic courses at the primary, secondary, college and post-graduate level, and vocational training in the fields of the arts, sciences, humanities and vocations
C. Also view attached registration 2915536 for Southern Methodist University that offers numerous different fields of education including medicine but also offers courses for secondary students in the field of science

The trademark examining attorney refers to the excerpted materials derived from a search of the Google® search engine in which a large number of educational institutions direct instruction in a variety of ways to primary, secondary, post-secondary and graduate school students. Indeed, as the attached evidence indicates both the applicant and cited registrant are involved is this wide-spectrum of educational programs. See attachments and also the dictionary definition of primary and secondary education. .

1. See university also offering elementary and secondary education services from the internet as of December 30, 2011http://www.gallaudet.edu/gallaudet_university/about_gallaudet/birth_-_grade_12.html
2. Also see use of universities offering primary and secondary education from the internet as of December 30, 2011 http://www.summer.harvard.edu/programs/ssp/default.jsp
3. See high school also offering medical science services from the Internet as of December 30, 2011 http://insideschools.org/high/browse/school/400
4. http://insideschools.org/high/browse/school/480 see attached Bronx community college also offering secondary school services from the Internet as of December 30, 2011
5. http://www.ucls.uchicago.edu/schools/index.aspx see attached University of Chicago offering lower school, pre-school, middle school and high school programs from the Internet as of December 30, 2011
6. http://www.uhigh.lsu.edu/about/about.html see attached LSU offering lower school, pre-school, middle school and high school programs from the Internet as of December 30, 2011
7. http://coe.illinoisstate.edu/labschools/ see attached ILLINOISE offering lower school, pre-school, middle school and high school programs from the Internet as of December 30, 2011
8. http://smysp.stanford.edu/ see attached Stanford offering summer medical program to high school students from the Internet as of December 30, 2011
9. http://www.lausd.k12.ca.us/King_Drew_Medical_Magnet/ see attached high school of medicine and science from the Internet as of December 30, 2011
10. http://pediatrics.medschool.ucsf.edu/youth/training/intern.aspx see attached opportunities as internships for high school from California in medicine and science from the Internet as of December 30, 2011

Please also see evidence below and attached from the applicant's own website showing a FACULTY OF MEDICINE, SCHOOL OF VETERINARY MEDICINE, and FACULTY OF SCIENCE some of which appears similar as to the services the applicant is attempting to exclude in the present application.

11. http://www.huji.ac.il/huji/eng/&ei=Q-H9TpjbFePu0gHqj-29Bg&sa=X&oi=translate&ct=result&resnum=1&ved=0CCIQ7gEwAA&prev=/search%3Fq%3Dwww.huji.ac.il/huji/eng%26hl%3Den%26biw%3D1230%26bih%3D789%26prmd%3Dimvns

12. Primary and secondary explanation: http://en.wikipedia.org/wiki/Primary_Education

The presumption under Trademark Act Section 7(b), 15 U.S.C. §1057(b), is that the registrant is the owner of the mark and that use of the mark extends to all goods and/or services identified in the registration. The presumption also implies that the registrant operates in all normal channels of trade and reaches all classes of purchasers of the identified goods and/or services. *In re Melville Corp.*, 18 USPQ2d 1386, 1389 (TTAB 1991); *McDonald's Corp. v. McKinley*, 13 USPQ2d 1895, 1899 (TTAB 1989); *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964-65 (TTAB 1980); *see* TMEP §1207.01(a)(iii).

It is therefore quite likely that both applicant's and registrant's goods/services will travel through the same channels of trade to the same classes of purchasers.

The marks are very similar . The goods/services appear highly related. The similarities among the marks and the goods/services are so great as to create a likelihood of confusion among consumers. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

/wrossman/
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