

ESTTA Tracking number: **ESTTA458450**

Filing date: **02/24/2012**

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

Proceeding	91193067
Party	Defendant Heidelberg University
Correspondence Address	LARA A. HOLZMAN, ESQ. ALSTON & BIRD LLP 90 PARK AVE NEW YORK, NY 10016-1301  ipnyc@alston.com
Submission	Answer
Filer's Name	Lara A. Holzman
Filer's e-mail	ipnyc@alston.com
Signature	/Lara A. Holzman/
Date	02/24/2012
Attachments	022412 Heidelberg University_1.PDF ( 4 pages )(124083 bytes )

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

In the Matter of Trademark Application Serial No. 77/636,839  
For the mark: HEIDELBERG UNIVERSITY  
Filed: December 19, 2008  
Published in the *Official Gazette* on June 23, 2009

Heidelberg University,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No.: 91193067
	)	
Heidelberg University,	)	
	)	
Applicant.	)	
	)	

U.S. PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT’S ANSWER TO OPPOSER’S NOTICE OF OPPOSITION**

Pursuant to Rule 2.106 of the Trademark Rules of Practice and Rule 8(b) of the Federal Rules of Civil Procedure, Applicant, Heidelberg University (“Applicant”), by and through its undersigned counsel, files its answer to the notice of opposition to Applicant’s U.S. Trademark application serial No. 77/636,839, filed by Heidelberg University (“Opposer”).

Applicant is a German public corporation, having an address at Grabengrasse 1, D-69115, Heidelberg, Germany, and the owner of U.S. Trademark Application Serial No. 77/636,839 (the “Application”) for its mark HEIDELBERG UNIVERSITY, filed in International Classes 36 and 41 on December 19, 2008. The Application was published for opposition in the June 23, 2009 issue of the *Official Gazette*.

Applicant answers the specifically enumerated paragraphs in the notice of opposition as follows:

1. Denied.
2. Denied.
3. Denied.
4. Denied.
5. Admitted.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations describing the nature of Opposer's Services and the provision of Opposer's Services, and therefore denies same. Applicant admits that the services described in Paragraph 1 of the Notice of Opposition and the services recited in Applicant's Application are identical.
7. Denied.
8. Denied.
9. Denied.
10. Denied.
11. Applicant admits that if it is granted the registration herein opposed, Applicant would obtain exclusive ownership and rights to the mark HEIDELBERG UNIVERSITY. Applicant denies the remaining allegations contained in Paragraph 11 of the Notice of Opposition.

## **AFFIRMATIVE DEFENSE**

### **Affirmative Defense 1:**

Opposer lacks standing to oppose Applicant's Application because Opposer does not use the trademark HEIDELBERG and is not the owner of the trademark HEIDELBERG.

### **Affirmative Defense 2:**

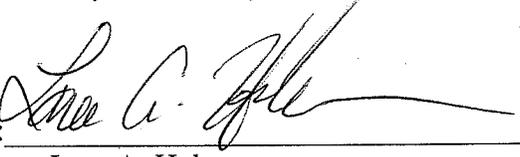
Opposer does not use the mark HEIDELBERG and thus does not have any common law rights in or to this mark in this format. On information and belief, since in or around 1926, Opposer has used the mark HEIDELBERG COLLEGE and has recently commenced use of the mark HEIDELBERG UNIVERSITY with full knowledge that Applicant is the owner of the mark HEIDELBERG UNIVERSITY. If prior to 1926, Opposer had any common law rights to the mark HEIDELBERG UNIVERSITY, it has abandoned these rights due to over 85 years of non-use. In any case, Applicant's use of the mark HEIDELBERG UNIVERSITY predates any use by Opposer, and Applicant therefore has superior rights to HEIDELBERG UNIVERSITY.

### **Affirmative Defense 3:**

Opposer has filed a trademark application for the mark HEIDELBERG knowing that Opposer does not use the mark HEIDELBERG in this format and with full knowledge that Applicant has superior rights to the mark HEIDELBERG UNIVERSITY.

WHEREFORE, Applicant requests that the opposition be dismissed in its entirety.

RESPECTFULLY SUBMITTED this 24<sup>th</sup> day of February, 2012.

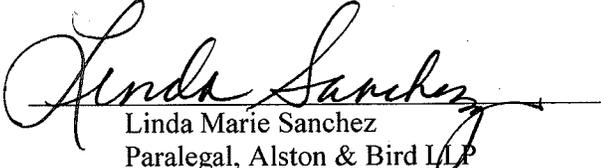
By: 

Lara A. Holzman  
ALSTON & BIRD LLP  
90 Park Avenue  
New York, NY 10016  
(212) 210-9400  
(212) 210-9444 (facsimile)  
*Attorneys for Applicant*

**CERTIFICATE OF SERVICE**

I hereby certify that on February 24, 2012, a copy of the foregoing APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION was served on Opposer by via email and first-class mail through the United States Postal Service, with sufficient postage, as follows:

Gregg W. Emch  
One Maritime Plaza, 5<sup>th</sup> Fl.  
720 Water Street  
Toledo, OH 43604-1853  
Email: emch@mstfirm.com

  
Linda Marie Sanchez  
Paralegal, Alston & Bird LLP