

ESTTA Tracking number: **ESTTA422559**

Filing date: **07/29/2011**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	The Hebrew University of Jerusalem
Granted to Date of previous extension	07/31/2011
Address	P.O. Box 34165, Givat Ram Jerusalem, 91341 ISRAEL

Domestic Representative	Anthony V. Lupo and Sarah E. Bruno Arent Fox LLP 1050 Connecticut Ave., NW Washington, DC 20036 UNITED STATES pulliam.eva@arentfox.com, bruno.sarah@arentfox.com, mclorren.anseleme@arentfox.com, mansilla.johanna@arentfox.com, tmdocket@arentfox.com Phone:202-857-6000
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**Applicant Information**

Application No	79068154	Publication date	02/01/2011
Opposition Filing Date	07/29/2011	Opposition Period Ends	07/31/2011
International Registration No.	1000974	International Registration Date	09/11/2008
Applicant	Albert Einstein Gesellschaft Bern Einsteinhaus, Kramgasse 49, Postfach 638 CH-3000 Bern 8, SWITZERLAND		

**Goods/Services Affected by Opposition**

<p>Class 009. All goods and services in the class are opposed, namely: Pre-recorded CDs, CD-ROMs, DVDs, audio and video cassettes featuring topics related to the scientist Albert Einstein; downloadable electronic publications in the nature of scientific articles in the field of the scientist Albert Einstein; computer games software; computer software for use in data base management in relation to the scientist Albert Einstein</p>
<p>Class 016. All goods and services in the class are opposed, namely: Printed matter, namely, books, magazines, pamphlets and informational flyers in relation to the scientist Albert Einstein; stickers; postcards; stationary; printed instructional and teaching material relating to the scientist Albert Einstein</p>
<p>Class 041. All goods and services in the class are opposed, namely: Arranging and conducting of conventions, symposiums, lectures and seminars, readings, discussions not for business purposes, relating to the</p>

scientist Albert Einstein; video and film productions; arranging and conducting of cultural or educational exhibitions, theatre performances and concerts; periodical awarding of the Einstein medal and of other honors, namely, honorary memberships relating to the scientist Albert Einstein; publication of texts, except advertising texts, and publication of printed matter, namely, scientific articles relating to the scientist Albert Einstein and photographs; electronic publishing services, namely, publication of text and graphic works of others on CD, DVD, On-Line relating to the scientist Albert Einstein; providing an interactive web site featuring educational information relating to scientific, cultural and entertainment activities and events namely, theatres, concerts, readings, discussions relating to the scientist Albert Einstein

Class 042.

All goods and services in the class are opposed, namely: Scientific and research services for others relating to the scientist Albert Einstein

## Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3591305	Application Date	07/11/2003
Registration Date	03/17/2009	Foreign Priority Date	NONE
Word Mark	ALBERT EINSTEIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 014. First use: Clocks, watches, non-monetary coins, jewelry, pens and mechanical pencils of precious metal</p> <p>Class 016. First use: Address books, prints, agendas, decals, stickers, appointment books, art paper, art prints, bookmarks, blank journals, pens, pencils, writing instruments, book covers, printed instructional, educational, and teaching materials and paper teaching materials, all in the fields of entertainment, mathematics, science and software; printed invitations, series of fiction books; series of non-fiction books in the field of science, math, physics, and self-help; bumper stickers, calendars, check books, check book covers, pencil cases, wire bound notebooks, crayons, drawing instruments, drawing paper; educational books in the field of entertainment, mathematics, science and software; gift cards, globes, greeting cards, folders, document folders in the form of wallets, three ring binders, writing pads, insect habitats, note paper, paper weights, photograph albums, stationery, photographs, postcards, posters, study guides, trading cards, wrapping paper, paper bags, paper and cardboard cut-out figures for use as wall decorations, life-size standup cardboard cutouts, pen and pencil holders, three dimensional models for educational purposes</p> <p>Class 018. First use: luggage; umbrellas; all purpose sports bags, backpacks, bookbags, handbags, school bags, shoulder bags, wallets, and credit card cases, all made of leather or imitation leather</p> <p>Class 020. First use: Non-metal key chains; busts, figurines, sculptures, ornaments and desktop</p>		

	<p>statuary of bone, plaster, plastic, wax and wood; mirrors, handheld mirrors</p> <p>Class 021. First use: Busts, figurines, sculptures, ornaments and desktop statuary of crystal, china, earthenware, glass, porcelain and terra cotta; mugs, cups, containers for household or kitchen use, cookie jars, dinnerware, flower pots, glass beverage ware, non-metal decorative boxes, salt and pepper shakers, vases</p> <p>Class 025. First use: Clothing, namely, t-shirts, sweatshirts, shorts, pants, shirts, dresses, suits, socks, footwear, headwear, pants, bandanas, neckwear, coats, jackets, beachwear, undergarments</p> <p>Class 028. First use: Games, playthings and toys, namely, action figures, bobble head dolls, card games, board games, action skill games, arcade games, baby multiple activity toys, bathtub toys, bubble making wand and solution sets, pet toys, chess sets, children's multiple activity toys; educational products in the nature of learning toys and games, namely, multiple activity toys for children and babies, action figures, and puzzles; athletic sporting goods, namely, athletic wrist and joint supports; Christmas tree decorations, costume masks, crib mobiles, electronic educational game machines for children, exercise equipment, namely, manually operated jogging machines, powered treadmills, stair-stepping machines, rowing machines, abdominal boards, stationary cycles, equipment for chest pulls, weight lifting machines, exercise platforms, exercise tables, trampolines, treadmills, weight cuffs, weights, wrist weights, weight lifting benches and accessories therefor, exercising pulleys, aerobic step machines, aerobic steps, weight lifting gloves, yoga mats, ankle and wrist weights; flying discs, golf clubs, infant development toys, infant toys, kaleidoscopes, kites, magic tricks, marbles, mechanical toys, musical toys, party games, party favors in the nature of small toys, play figures, playing cards, puppets, puzzles, sand toys, skateboards, snow globes, stuffed toys, sport balls, toy models, namely, toy model cars, toy butterfly nets, toy rockets, toy vehicles, toy watches, toy model hobby craft kits, water squirting toys, wind socks, wind-up toys, yo-yos</p>
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U.S. Registration No.	1479104	Application Date	12/04/1986
Registration Date	03/01/1988	Foreign Priority Date	NONE
Word Mark	EINSTEIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1986/10/22 First Use In Commerce: 1986/10/22 PROVIDING ACCESS TO AN ON-LINE COMPUTER DATA BASE FOR USE BY HIGH SCHOOL STUDENTS AND TEACHERS		

U.S. Application No.	78273219	Application Date	07/11/2003
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EINSTEIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use:		

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; video games, 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; audio tape recorders and players; video tape recorders and players; calculators; 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; telephones; telescopes; electronic testers for testing voltage, light, sounds, pH and temperature; cameras

Class 014. First use:

Clocks, watches, non-monetary coins, jewelry, pen and mechanical pencils of precious metal

Class 016. First use:

Address books, prints, agendas, decals, stickers, appointment books, art paper, art prints, bookmarks, blank journals, pens, pencils, writing instruments, book covers, printed instructional, educational, and teaching materials in the fields of math, science, reading and test preparation at the primary and secondary level, printed invitations, books, bumper stickers, calendars, check books, check book covers, pencil cases, spiral notebooks, crayons, drawing instruments, drawing paper, educational books in the fields of math, science, reading and test preparation at the primary and secondary level, gift cards, globes, greeting cards, folders, three ring binders, writing pads, insect habitats, note paper, paper weights, photograph albums, stationery, photographs, postcards, posters, study guides, trading cards, wrapping paper, paper bags, paper and cardboard cut-out figures for use as wall decorations, life-size standup cardboard cutouts, pen and pencil holders, three dimensional models for educational purposes

Class 018. First use:

All purpose sports bags, backpacks, bookbags, handbags, luggage, school bags, shoulder bags, umbrellas, wallets, credit card cases

Class 020. First use:

Non-metal key chains; busts, figurines, sculptures, ornaments and desktop statuary of bone, plaster, plastic, wax and wood; mirrors, handheld mirrors

Class 021. First use:

Busts, figurines, sculptures, ornaments and desktop statuary of crystal, china, earthenware, glass, porcelain and terra cotta; mugs, cups, containers for household or kitchen use, cookie jars, dinnerware, flower pots, glass beverage ware, non-metal decorative boxes, salt and pepper shakers, vases

Class 025. First use:

Clothing, namely, t-shirts, sweatshirts, shorts, pants, shirts, dresses, suits, socks, footwear, headwear, pants, bandanas, neckwear, coats, jackets, beachwear, undergarments

Class 028. First use:

Games and playthings, namely, action figures, bobble head dolls, card games, board games, action skill games, arcade games, bubble making wand and solution sets, pet toys, chess sets, Christmas tree decorations, costume masks, electronic educational game machines, kaleidoscopes, kites, magic tricks, marbles, mechanical toys, musical toys, party games, party favors in the nature of small toys, play figures, playing cards, puppets, puzzles, sand toys, skateboards, snow globes, stuffed toys, toy butterfly nets, toy rockets, toy vehicles, toy watches, toy model hobbycraft kits, water squirting toys, wind socks for decorative purposes, wind-up toys, yo-yos, sporting articles, namely, flying discs, golf clubs, sport balls

Class 041. First use:

	Educational services, namely, providing classroom instruction and educational demonstrations 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
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Attachments	HUJ - IAES - Notice of Opposition.pdf ( 8 pages )(97056 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Eva J. Pulliam/
Name	Eva J. Pulliam
Date	07/29/2011

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

In re Application No. 79/068154 for the mark INTERNATIONAL ALBERT EINSTEIN SOCIETY IAES, filed September 11, 2008 and published February 1, 2011

THE HEBREW UNIVERSITY OF JERUSALEM	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
ALBERT EINSTEIN GESELLSCHAFT BERN	)	
	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

The Hebrew University of Jerusalem (“Opposer”), is a not-for-profit corporation organized and existing under the laws of Israel, with an address at Givat Ram, P.O. Box 34165, Jerusalem 91341, Israel, and believes that it is or will be damaged by the issuance to registration of INTERNATIONAL ALBERT EINSTEIN SOCIETY IAES Application No. 79/068154 (“Applicant’s Mark”) and hereby opposes registration of Applicant’s Mark under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title and interest in, to and of the late, famous scientist and genius, Albert Einstein, including the publicity rights in his name and likeness, service marks and trademarks. Opposer is also the owner of numerous archives for Dr. Albert Einstein’s work that are used for research and historical reference.

2. The name and mark ALBERT EINSTEIN and EINSTEIN have been used by those licensed or otherwise authorized by Opposer on or in connection with a broad variety of goods and services prior to Applicant’s filing date, including, but not limited to printed materials, TECH/1013579.1

educational CD-ROMs with books sold as a unit, providing access to an on-line computer data base to students, computers, software applications, video games, tee-shirts, hats, mugs, and posters.

3. Opposer owns numerous ALBERT EINSTEIN and EINSTEIN marks, including, *inter alia*, incontestable U.S. Registration No. 3,591,305 for ALBERT EINSTEIN in connection with goods in International Classes 14, 16, 18, 20, 21, 25 and 28; U.S. Registration No. 1,479,104 for EINSTEIN in connection with services in International Class 42; as well as pending U.S. Application Serial No. 78/273,219 for EINSTEIN in connection with goods and services in International Classes 9, 14, 16, 18, 20, 21, 25, 28, and 41; and others (hereinafter collectively referred to as “EINSTEIN Marks”). Opposer’s exclusive right to use the EINSTEIN Marks is evidenced by these applications and registrations. Further, the referenced registrations are valid, subsisting and provide prima facie evidence of Opposer’s exclusive right to use the marks in commerce on its own and through its authorized licensees.

4. Applicant has applied, to register Applicant’s Mark in connection with recordings, printed materials, educational and informational seminars, and research services. Applicant’s Mark is confusingly similar to the EINSTEIN Marks and the applied-for goods and services are related to goods and services of Opposer and/or its licensees, or to goods and services into which Opposer intends to expand into, or in connection with which consumers will believe Opposer has expanded.

5. Applicant’s Mark is similar to the EINSTEIN Marks and Applicant’s incorporation of the name “ALBERT EINSTEIN” is likely to conjure up an association with Dr. Albert Einstein, who is well known as the preeminent genius of the twentieth century.

6. Applicant’s Mark is intended to be used in association with recordings, printed materials, educational and informational seminars, and research services related to Dr. Albert Einstein, which overlap with and are related to Opposer’s.

7. Due to the enormous and longstanding fame of the late scientist and genius named Dr. Albert Einstein and Opposer's ownership and use of the names and marks ALBERT EINSTEIN and EINSTEIN in connection with a broad variety of goods and services, Applicant's Mark falsely suggests a connection, affiliation, association or sponsorship with Opposer.

8. Upon information and belief, Applicant is well aware of and seeks to foster that false connection with the late, well known scientist and genius, Dr. Albert Einstein.

9. Since prior to Applicant's filing date and Applicant's use, if any, of Applicant's Mark, the names and marks ALBERT EINSTEIN and EINSTEIN have become associated with Opposer, such that Applicant's Mark, when used in connection with the applied-for goods and services is likely to confuse the consuming public to believe that Applicant's goods and services are authorized, sponsored, licensed or controlled by Opposer, or are in some way related to Opposer.

10. Since long prior to the filing date of Applicant's application, Opposer and its licensees have used the EINSTEIN Marks in connection with the sale and advertising of its goods and/or services.

11. Opposer and its licensees have used and advertised the EINSTEIN Marks over a period of many years and, thus, these marks have become well known and famous among prospective purchasers as a distinctive indicator of the origin of Opposer's goods and services.

12. Notwithstanding Opposer's prior established rights in the EINSTEIN Marks, Applicant, Albert Einstein Gesellschaft Bern, a corporation with an address of Einsteinhaus, Kramgasse 49, Postfach 638, CH-3000 Bern 8, Switzerland, filed Application No. 79/068154, INTERNATIONAL ALBERT EINSTEIN SOCIETY IAES for:

- International Class 9 covering "Pre-recorded CDs, CD-ROMs, DVDs, audio and video cassettes featuring topics related to the scientist Albert Einstein; downloadable electronic publications in the nature of scientific articles in the field of the scientist Albert Einstein;

computer games software; computer software for use in data base management in relation to the scientist Albert Einstein;”

- International Class 16 covering “Printed matter, namely, books, magazines, pamphlets and informational flyers in relation to the scientist Albert Einstein; stickers; postcards; stationary; printed instructional and teaching material relating to the scientist Albert Einstein;”
- International Class 41 covering “Arranging and conducting of conventions, symposiums, lectures and seminars, readings, discussions not for business purposes, relating to the scientist Albert Einstein; video and film productions; arranging and conducting of cultural or educational exhibitions, theatre performances and concerts; periodical awarding of the Einstein medal and of other honors, namely, honorary memberships relating to the scientist Albert Einstein; publication of texts, except advertising texts, and publication of printed matter, namely, scientific articles relating to the scientist Albert Einstein and photographs; electronic publishing services, namely, publication of text and graphic works of others on CD, DVD, On-Line relating to the scientist Albert Einstein; providing an interactive web site featuring educational information relating to scientific, cultural and entertainment activities and events namely, theatres, concerts, readings, discussions relating to the scientist Albert Einstein;” and
- International Class 42 covering “Scientific and research services for others relating to the scientist Albert Einstein.”

#### **LIKELIHOOD OF CONFUSION - §2(d)**

13. Paragraphs 1 through 12 above are incorporated by reference as part of this Count.

14. The mark which Applicant seeks to register is identical to or so closely resembles the EINSTEIN Marks that the use and registration thereof is likely to cause confusion, mistake and/or deception as to the source or origin of Applicant's goods and services in violation of Section 2(d) of the Trademark Act, and will injure and damage Opposer and the goodwill and reputation symbolized by the EINSTEIN Marks.

15. Applicant's goods and services are so closely related to Opposer's goods and services that the public is likely to be confused, or deceived, or to assume erroneously that Applicant's goods and services are those of Opposer or that Applicant is in some way connected with, sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

16. Likelihood of confusion is enhanced by the fact that Applicant's Mark and the EINSTEIN Marks all contain the name "ALBERT EINSTEIN" and/or "EINSTEIN," which is the dominant portion of the marks, thus consumers will assume that goods and services offered under Applicant's Mark originate with or are sponsored by Opposer.

17. Applicant is not affiliated or connected with or sponsored by Opposer, nor has Opposer approved of the goods and services offered by Applicant in connection with the applied-for mark, nor has Opposer granted Applicant permission to use the applied-for mark in the United States.

**DECEPTION/FALSE SUGGESTION OF CONNECTION - § 2(a)**

18. Paragraphs 1 through 17 above are incorporated by reference as part of this Count.

19. Applicant's Mark is identical to or so closely resembles the EINSTEIN Marks that Applicant's Mark is likely to cause deception in violation of Section 2(a) of the Trademark Act in that the mark misdescribes the nature or origin of the goods and services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods and services, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods and services.

20. Applicant's Mark is identical to or so closely resembles the EINSTEIN Marks that it falsely suggests a connection with Opposer and implies an association with Dr. Albert Einstein in violation of Section 2(a) of the Trademark Act, because Applicant's Mark points uniquely to Opposer, and purchasers will assume that goods and services offered under Applicant's alleged mark are connected with Opposer.

21. The dominant part of Applicant's Mark is "ALBERT EINSTEIN," thus the Applicant's Mark is clearly drawing a connection between the goods and services listed in the application and the genius of Dr. Albert Einstein.

22. When Applicant's Mark is used in connection with the goods and services described in its application, said mark will cause purchasers to mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods and services by permitting Applicant's Mark to be used in connection with such goods and services.

23. Applicant's Mark is deceptive in that it falsely suggests a connection with or approval by Opposer, all to Opposer's irreparable damage.

#### **DILUTION - § 43(c)**

24. Paragraphs 1 through 23 above are incorporated by reference as part of this Count.

25. For many years, many of the EINSTEIN Marks have been widely used and extensively advertised in the United States and, therefore, the EINSTEIN Marks have become well known and famous as a distinctive symbol of Opposer's goodwill.

26. The EINSTEIN Marks became well known and famous before Applicant made any use of or applied for registration of Applicant's Mark.

27. Applicant's Mark will cause dilution of the distinctive quality of Opposer's famous EINSTEIN Marks.

28. Use and registration of Applicant's Mark will lessen the capacity of Opposer's famous EINSTEIN Marks to identify and distinguish Opposer's goods and services.

29. Use and registration of Applicant's Mark will tarnish the goodwill symbolized by Opposer's famous EINSTEIN Marks.

30. Likelihood of dilution and damage to Opposer's goodwill is enhanced by the fact that Opposer will have no control over the nature and quality of the goods and services offered under Applicant's Mark; and prospective customers who encounter defects in the quality of Applicant's goods and services will attribute those defects to Opposer, and this will tarnish Opposer's goodwill.

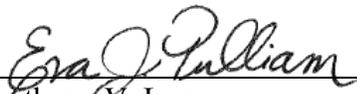
31. Use and registration of Applicant's Mark will cause dilution by blurring, thus diluting or weakening the unique and distinctive significance of Opposer's famous EINSTEIN Marks to identify and distinguish one source.

32. By reason of all of the foregoing, Opposer will be damaged by the registration of Applicant's Mark and registration should be refused.

WHEREFORE, Opposer respectfully requests that Application No. 79/068154 be refused registration.

Dated: July 29, 2011

Respectfully submitted,  
ARENT FOX LLP

  
\_\_\_\_\_  
Anthony V. Lupo  
Sarah L. Bruno  
Eva J. Pulliam  
*Attorneys for Opposer*

Arent Fox LLP  
1050 Connecticut Avenue NW  
Washington, DC 20036  
Tel: (202) 857-6000

**CERTIFICATE OF SERVICE**

I hereby certify, pursuant to 28 U.S.C. § 1746, that on this 29<sup>th</sup> day of July, I caused the foregoing NOTICE OF OPPOSITION to be served electronically, by facsimile, and/or first-class mail upon the following:

Albert Einstein Gesellschaft Bern  
Einsteinhaus, Kramgasse 49, Postfach 638  
CH-3000 Bern 8  
SWITZERLAND

  
\_\_\_\_\_  
Eva J. Puffiam