

ESTTA Tracking number: **ESTTA167831**

Filing date: **10/10/2007**

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	10/10/2007
Address	P.O. Box 34165 Givat Ram, 91341 ISRAEL

Attorney information	Anthony V. Lupo and Randall Brater Arent Fox LLP 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES lupo.anthony@arentfox.com, brater.randall@arentfox.com, bruno.sarah@arentfox.com, walker.christina@arentfox.com, tmdocket@arentfox.com
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Applicant Information

Application No	78844895	Publication date	06/12/2007
Opposition Filing Date	10/10/2007	Opposition Period Ends	10/10/2007
Applicant	Einstein Cosmetics Ltd 3699 Wilshire Blvd., Suite 1290 Los Angeles, CA 90010 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 2004/12/31 First Use In Commerce: 2004/12/31 All goods and services in the class are opposed, namely: Lip balm; Lip cream
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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.	2599880	Application Date	03/16/1998
Registration Date	07/30/2002	Foreign Priority	NONE

		Date	
Word Mark	THE ULTIMATE EINSTEIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1995/11/00 First Use In Commerce: 1995/11/00 Interactive educational CD-ROMs in the field of history, sold individually and together as a unit with history books and instructional manuals therefor		

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. Registration No.	2497731	Application Date	12/30/1999
Registration Date	10/16/2001	Foreign Priority Date	NONE
Word Mark	EINSTEINET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1999/06/01 First Use In Commerce: 1999/06/01 Providing electronic data storage to subscribers Class 042. First use: First Use: 1999/06/00 First Use In Commerce: 1999/06/00 providing temporary use of on-line non-downloadable software to subscribers for use in word-processing, database management, accounting, and inventory control in the field of business management		

Attachments	75883344#TMSN.gif (1 page)(bytes) HUJ v. Einstein Cosmetics Ltd. - Notice of Opposition (EINSTEIN).pdf (5 pages)(199132 bytes) HUJ v. Einstein Cosmetics Ltd. - Certificate of Service (EINSTEIN).pdf (1 page)(17069 bytes)
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Signature	/Randall Brater/
Name	Anthony V. Lupo and Randall Brater
Date	10/10/2007

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

THE HEBREW UNIVERSITY OF JERUSUALEM)
)
Opposer,)
)
v.)
)
EINSTEIN COSMETICS LTD.)
)
Applicant.)
)

Commissioner of Patent and Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

In the matter of the application filed by Einstein Cosmetics Ltd, a corporation under the laws of California with an address of 3699 Wilshire Blvd., Suite 1290 Los Angeles, California 90010, namely, Application No. 78/844,895 for EINSTEIN in International Class 03 covering “lip balm; lip cream,” with extensions of time to file a Notice of Opposition granted up to, and including, October 10, 2007. Registration of the mark is opposed under the provisions of Section 13 of the Trademark Act, 15 U.S.C. 1063.

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 EINSTEIN Application No. 78/844,895 and hereby opposes registration of EINSTEIN to Applicant.

The grounds for opposing the registration for EINSTEIN are as follows:

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. Albert Einstein is also known, and commonly referred to as EINSTEIN.

2. The name and mark ALBERT EINSTEIN has 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.

3. Opposer owns numerous EINSTEIN and EINSTEIN formative marks, including, *inter alia*, incontestable U.S. Registration No. 2,599,880 for THE ULTIMATE EINSTEIN in connection with "interactive educational CD-ROMs, in the field of history, sold individually and together as a unit with history books and instructional manuals therefore" in International Class 9; U.S. Registration No. 1,479,104 for EINSTEIN in connection with "providing access to an online computer database for use by high school students and teachers" in International Class 42; and U.S. Registration No. 2,497,731 for EINSTEINET in connection with "providing temporary use of on-line non-downloadable software to subscribers for use in word-processing, database management, accounting, and inventory control, in the field of business management" in International Classes 39 and 42. Opposer's exclusive right to use its marks is evidenced by these registrations. The registrations are valid, subsisting and provide prima facie evidence of Opposer's exclusive right to use the marks in commerce.

4. Applicant has applied, under Serial No. 78/844,895, to register EINSTEIN in connection with "lip balm; lip cream." Applicant's EINSTEIN is confusingly similar to Opposer's EINSTEIN and ALBERT EINSTEIN marks and the applied-for 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 applied-for mark wholly incorporates Opposer's EINSTEIN mark and connotes an affiliation or connection to Albert Einstein.

6. Due to the enormous and longstanding fame of the late scientist and genius named ALBERT EINSTEIN, including the licensed and otherwise authorized use of the names and marks ALBERT EINSTEIN and EINSTEIN in connection with a broad variety of goods and services, Applicant's EINSTEIN falsely suggests a connection, association or sponsorship with The Hebrew University of Jerusalem.

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

8. Since long prior to the filing date of Applicant's application, Opposer has used its marks in connection with the sale and advertising of its goods and/or services.

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

LIKELIHOOD OF CONFUSION - §2(d)

10. The mark which Applicant seeks to register is identical to or so resembles Opposer's marks that use and registration by Applicant is likely to cause confusion, mistake

and/or deception within the meaning of Section 2(d) of the Trademark Act, and such use or registration will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's marks.

11. Applicant is not affiliated or connected with or endorsed or sponsored by Opposer, nor has Opposer approved any of the services offered or sold by Applicant under the mark EINSTEIN, nor has Opposer granted Applicant permission to use said mark.

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

12. Applicant's alleged mark so closely resembles Opposer's 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 origin of the services, purchasers are likely to believe that the misdescription actually describes the origin of the services, and this is likely to materially alter purchaser's decisions to acquire Applicant's services.

13. Applicant's alleged mark so closely resembles Opposer's marks that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, since Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that services offered under Applicant's alleged mark are connected with Opposer.

DILUTION - § 43(d)

14. Opposer's marks became well known and famous prior to the filing date of Applicant's application.

15. Applicant's use or registration of the mark EINSTEIN will cause dilution of the distinctive quality of Opposer's marks.

16. Applicant's use or registration of EINSTEIN will lessen the capacity of Opposer's famous marks to identify and distinguish Opposer's goods and services.

17. Applicant's use or registration of the mark EINSTEIN for the goods listed in its application will tarnish the goodwill symbolized by Opposer's marks.

18. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by the fact that Opposer will have no control over the nature and quality of the services sold under Applicant's alleged mark; and prospective customers who encounter defects in the quality of Applicant's services will attribute those defects to Opposer, and this will tarnish Opposer's goodwill.

19. Likelihood of confusion, dilution and deception is enhanced by the fact Applicant's alleged mark EINSTEIN and Opposer's marks are virtually identical in sound and pronunciation, and consumers will assume that services sold under Applicant's alleged mark originate with or are sponsored by Opposer.

WHEREFORE, Opposer respectfully requests that Application No. 78/844,895 be refused registration.

Dated: October 10, 2007

Respectfully submitted,
ARENT FOX LLP




Anthony V. Lupo
Sarah Bruno
Randall Brater
Attorneys for Applicant

Atty. Docket No.: 028000.00284
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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 28 U.S.C. § 1746, that on this 10th day of October 2007, I caused the foregoing NOTICE OF OPPOSITION to be served electronically, by facsimile, and/or regular U.S. mail upon the following:

Kelly W. Cunningham, Esq.
Cislo & Thomas LLP
233 Wilshire Blvd., Suite 900
Santa Monica, CA 90401



Randall A. Brater