

ESTTA Tracking number: **ESTTA998864**

Filing date: **08/30/2019**

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	Yeshiva University
Granted to Date of previous extension	09/01/2019
Address	500 West 185th Street New York, NY 100333201 UNITED STATES

Attorney information	DAVID O. JOHANSON, ESQ. MORGAN, LEWIS & BOCKIUS LLP ONE FEDERAL STREET BOSTON, MA 02110 UNITED STATES trademarks@morganlewis.com, david.johanson@morganlewis.com, rachel.dubow@morganlewis.com 6179518304
----------------------	--

Applicant Information

Application No	88140137	Publication date	03/05/2019
Opposition Filing Date	08/30/2019	Opposition Period Ends	09/01/2019
Applicant	JHO Intellectual Property Holdings, LLC 1600 North Park Drive Weston, FL 33326 UNITED STATES		

Goods/Services Affected by Opposition

Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Dietary supplemental drinks; Dietary supplements; Dietary and nutritional supplements; Nutritional supplements; Nutritional and dietary supplements formed and packaged as bars; Powdered nutritional supplement drink mix; Dietary supplement drink mixes; Liquid nutritional supplement; Nutritional supplement energy bars
Class 032. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Isotonic drinks; Water beverages; Bottled water; Drinking water; Energy drinks; Sports drinks


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1216122	Application Date	05/30/1979
Registration Date	11/09/1982	Foreign Priority Date	NONE
Word Mark	ALBERT EINSTEIN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1955/00/00 First Use In Commerce: 1955/00/00 Educational Services-Namely, Conductinga Medical School [and Hospital]		

U.S. Registration No.	2804138	Application Date	05/13/2002
Registration Date	01/13/2004	Foreign Priority Date	NONE
Word Mark	ALBERT EINSTEIN COLLEGE OF MEDICINE		
Design Mark	ALBERT EINSTEIN COLLEGE OF MEDICINE		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1955/12/31 First Use In Commerce: 1955/12/31 Educational services, namely, providingcourses of instruction and training in the field of medicine and biological science at the graduate and professional levels and distributing course material inconnection therewith Class 042. First use: First Use: 1955/12/31 First Use In Commerce: 1955/12/31 Medical research, namely, conducting clinical, scientific and animal trials		

U.S. Application No.	77735069	Application Date	05/12/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EINSTEIN		
Design Mark			
Description of Mark	The mark consists of the word "EINSTEIN" in white against a shaded rectangle indark blue, to the right of a highly stylized letter "E" formed by a helix design in white and dark blue against a shaded rectangle in light blue		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Educational services, namely, providingcourses of instruction and training in the nature of courses, lectures and clinical clerkships in the field of medicineand biological science at the graduate and professional levels and distributingcourse material in connection therewith Class 042. First use: First Use: 0 First Use In Commerce: 0 Medical research, namely, conducting clinical, scientific and animal trials		

Attachments	76406614#TMSN.png(bytes) 77735069#TMSN.png(bytes) Notice of Opposition EINSTEIN KETO.pdf(175279 bytes)
-------------	---

Signature	/David O. Johanson/
Name	DAVID O. JOHANSON, ESQ.
Date	08/30/2019

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

In re Application Serial No. 88/140,137)
Published in the Official Gazette of March 5, 2019)
Mark: EINSTEIN KETO)
Application Filing Date: October 2, 2018)
Yeshiva University,)
Opposer,)
v.)
JHO Intellectual Property Holdings, LLC,)
Applicant.)

NOTICE OF OPPOSITION

Opposer, Yeshiva University (“Opposer”) believes that it will be damaged by the issuance of a registration for the mark EINSTEIN KETO (“Applicant’s Mark”), with respect to the goods in international classes 5 and 32, as applied for in Application Serial No. 88/140,137, as filed by JHO Intellectual Property Holdings, LLC (“Applicant”), and hereby opposes the same.

As grounds for this Opposition, Opposer alleges as follows:

1. Opposer is a not-for-profit education corporation organized and existing under the laws of the State of New York, with a principal place of business at 500 West 185th Street, New York, New York 10033.

2. Applicant is, upon information and belief, a limited liability company organized and existing under the laws of the State of New York, with a principal place of business at 445 Hamilton Avenue, Suite 1102, White Plains, NY 10601.

3. Opposer is an institute of higher learning that was established in or about 1929. Since at least as early as 1955, Opposer has operated a medical school at the graduate and professional level under the trade names and trademarks ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN (the “ALBERT EINSTEIN Marks”).

4. Since at least as early as 1980, Opposer has used the name and mark EINSTEIN to promote and reference its medical school and the collateral goods and services associated therewith (the “EINSTEIN Mark”).

5. Since its initial use of the Opposer’s ALBERT EINSTEIN Marks and EINSTEIN Mark (collectively, the “Marks”), Opposer has made very substantial investments in advertising and promoting the educational and research services and the collateral goods and services it provides under its Marks, with the result that consumers have come to know and recognize Opposer’s Marks, and associate the same with Opposer and/or the goods and services provided by Opposer. Opposer has built up extensive goodwill in connection with the provision of medical and biological science educational and medical research services under its Marks.

6. Opposer is the owner of the following United States Trademark Registrations, both of which are for marks that have been in use since 1955:

- Reg. No. 1216122 for the mark ALBERT EINSTEIN, for use in connection with “*educational services - namely, conducting a medical school*”; and
- Reg. No. 2804138 for the mark ALBERT EINSTEIN COLLEGE OF MEDICINE, for use in connection with “*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 “*medical research, namely, conducting clinical, scientific and animal trials.*”

7. Opposer is also the owner of the pending U.S. Application Serial No. 77/735,069 for the mark EINSTEIN (and Design) for use in connection with “*educational services, namely, providing courses of instruction and training in the nature of courses, lectures and clinical clerkships in the field of medicine and biological science at the graduate and professional levels and distributing course material in connection therewith,*” and “*medical research, namely, conducting clinical, scientific and animal trials.*”

8. Moreover, Opposer’s Albert Einstein College of Medicine has commonly been referred to as EINSTEIN by the Opposer, its staff, students, alumni, and the public at large since at least as early as 1980, resulting in certain common law rights in the EINSTEIN Mark.

9. Notwithstanding Opposer’s prior rights in and to the Marks, on or about October 2, 2018, Applicant filed a federal intended use based registration application with the U.S. Patent and Trademark Office (the “PTO”) for the mark EINSTEIN

KETO, for “*Dietary supplemental drinks; Dietary supplements; Dietary and nutritional supplements; Nutritional supplements; Nutritional and dietary supplements formed and packaged as bars; Powdered nutritional supplement drink mix; Dietary supplement drink mixes; Liquid nutritional supplement; Nutritional supplement energy bars*” in class 5, and “*Isotonic drinks; Water beverages; Bottled water; Drinking water; Energy drinks; Sports drinks,*” in class 32 (the “Applicant’s Goods”). The PTO assigned Serial No. 88/140,137 to this filing and the Application was published for opposition in the PTO’s Official Gazette on March 5, 2019.

10. On or about April 4, 2019, Opposer timely filed a 90-day Request for Extension of Time to Oppose the Application. A further 60-day Request for Extension of Time to Oppose the Application with consent was filed on June 28, 2019. Both extensions were granted by the PTO.

11. Upon information and belief, Applicant’s EINSTEIN KETO application was filed with the PTO with knowledge of Opposer’s prior use of and rights in the ALBERT EINSTEIN Marks and the EINSTEIN Mark with similar or related goods and services.

12. Applicant’s use of a confusingly similar mark in connection with the same or similar or related goods or services is likely to cause significant confusion as to source, sponsorship, and affiliation and will falsely suggest a connection with Opposer.

GROUND I – LIKELIHOOD OF CONFUSION

13. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 12 hereof as if fully set forth herein.

14. Registration by Applicant of the Applicant's Mark for use in connection with the Applicant's Goods would seriously damage Opposer and should be refused because use and/or registration of the Applicant's Mark is likely to cause confusion in the minds of the public and deceive actual and potential purchasers, customers and others. The public, upon seeing Applicant's Mark in connection with Applicant's Goods, will believe that such goods originate with, or have some connection with, the Opposer. Opposer avers that Applicant's use of said mark interferes with Opposer's use of its Marks, and impedes Opposer in the free use of said Marks, and that registration of the Applicant's Mark by Applicant for use in connection with the Applicant's Goods will seriously damage the Opposer under 15 U.S.C. §1052(d).

15. Applicant's Mark, when used in connection with the Applicant's Goods, is also likely to cause confusion, deception, and mistake with Opposer's Marks because Applicant's Mark is very visually and audibly similar to Opposer's Marks. Specifically, Applicant's Mark, "EINSTEIN KETO," includes the identical distinctive "EINSTEIN" portion of the Opposer's ALBERT EINSTEIN trade name and trademark and encompasses Opposer's EINSTEIN Mark in its entirety, adding only the common non-distinctive word KETO.

16. Applicant's Mark, when used in connection with the Applicant's Goods, is also likely to cause confusion, deception, and mistake with Opposer's Marks because Applicant's Mark is allegedly used with goods (namely, "*Dietary supplemental drinks; Dietary supplements; Dietary and nutritional supplements; Nutritional supplements; Nutritional and dietary supplements formed and packaged as bars; Powdered nutritional supplement drink mix; Dietary supplement drink mixes; Liquid nutritional*

supplement; Nutritional supplement energy bars” in class 5, and “*Isotonic drinks; Water beverages; Bottled water; Drinking water; Energy drinks; Sports drinks,*” in class 32”) that are similar or related to certain of the services provided under Opposer’s ALBERT EINSTEIN and EINSTEIN trade names and trademarks, namely, “*educational services, namely, conducting a medical school; 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; medical research, namely, conducting clinical, scientific and animal trials; educational services, namely, providing courses of instruction and training in the nature of courses, lectures and clinical clerkships in the field of medicine and biological science at the graduate and professional levels and distributing course material in connection therewith*” (collectively, the “Opposer’s Services”), as well as with the collateral goods and services provided in association with the Opposer’s Services.

17. The Applicant allegedly provides or intends to provide a variety of goods under Applicant’s Mark that are commonly used and/or provided in connection with the Opposer’s Services. Specifically, “*Dietary supplemental drinks; Dietary supplements; Dietary and nutritional supplements; Nutritional supplements; Nutritional and dietary supplements formed and packaged as bars; Powdered nutritional supplement drink mix; Dietary supplement drink mixes; Liquid nutritional supplement; Nutritional supplement energy bars*” in class 5, and “*Isotonic drinks; Water beverages; Bottled water; Drinking water; Energy drinks; Sports drinks,*” in class 32” are commonly used in and associated with educational and medical services in the fields of medicine, medical and biological research and science, such as provided by Opposer. Moreover,

colleges, universities and higher education institutions (such as the Opposer) regularly provide ancillary goods in the nature of those identified in the Applicant's EINSTEIN KETO application. The goods and services provided by the parties in connection with their respective marks are both likely to be offered in the same and/or similar or related channels of trade, and to the same and/or similar or related customers, and therefore are likely to be mistakenly viewed by Opposer's customers and potential customers as related to and/or a natural expansion of Opposer's products and services.

18. Registration of Applicant's Mark for use in connection with the Applicant's Goods would be prima facie evidence of rights of Applicant under 15 U.S.C. § 1057(b), to the detriment of Opposer's rights in its ALBERT EINSTEIN and EINSTEIN trade names and trademarks.

19. Pursuant to 15 U.S.C. §1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing use of the Applicant's Mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

GROUND II - DILUTION

20. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 19 hereof as if fully set forth herein.

21. Because of the high degree of distinctiveness of Opposer's ALBERT EINSTEIN and EINSTEIN trade names and trademarks, the length of time and extent to which Opposer has used its ALBERT EINSTEIN and EINSTEIN trade names and trademarks, the extensive advertising and publicity Opposer's ALBERT EINSTEIN and

EINSTEIN trade names and trademarks have received, the nationwide trading area in which the Opposer's ALBERT EINSTEIN and EINSTEIN trade names and trademarks are used, and the high degree of recognition of the Opposer's ALBERT EINSTEIN and EINSTEIN trade names and trademarks in the education, medical and research industries, Opposer's ALBERT EINSTEIN and EINSTEIN trade names and trademarks are famous trade names and marks pursuant to 15 U.S.C. §1125(c)(1).

22. Registration of Applicant's Mark for use in connection with Applicant's Goods would lessen the capacity of Opposer's famous Marks to identify and distinguish Opposer's Services under its EINSTEIN mark and, as such, would cause dilution of the Marks in violation of 15 U.S.C. §§ 1125(c) and 1127.

23. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant for use in connection with the Applicant's Goods because such registration will support and assist Applicant in the infringing and diluting use of its EINSTEIN KETO mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

24. For the reasons set forth herein, pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes that registration by Applicant of the Applicant's Mark for use in connection with the Applicant's Goods would seriously damage Opposer and should be refused because use and/or registration of the Applicant's Mark is likely to cause dilution of Opposer's famous ALBERT EINSTEIN and EINSTEIN trade names and trademarks and customer confusion as to source, origin, affiliation, or sponsorship between Applicant and Opposer and/or their respective goods and services.

WHEREFORE, Opposer, Yeshiva University, believes and avers that it will be damaged by said registration and prays that registration of the EINSTEIN KETO mark for use in connection with the goods shown in Application Serial No. 88/140,137, filed by Applicant, be refused, and that this Opposition be sustained.

The filing fee for this Notice of Opposition in the amount of \$800.00 is enclosed, for Opposer's opposition to registration of the mark EINSTEIN KETO in two class.

Please recognize as attorneys for Opposer in this proceeding David O. Johanson and Rachelle A. Dubow, members of the Bar of the Commonwealth of Massachusetts and the firm of Morgan, Lewis & Bockius LLP, One Federal Street, Boston, Massachusetts 02110.

All correspondence should be addressed to David O. Johanson, Esq., of Morgan, Lewis & Bockius LLP, One Federal Street, Boston, Massachusetts 02110.

Respectfully submitted,

/David Johanson/
David O. Johanson, Esq.
Rachelle A. Dubow, Esq.
Morgan, Lewis & Bockius LLP
One Federal Street
Boston, MA 02110
(617) 951-8000

Dated: August 30, 2019

Attorneys for Opposer,
YESHIVA UNIVERSITY

CERTIFICATE OF SERVICE

This is to certify that a copy of the Notice of Opposition, was mailed on August 30, 2019 by first-class mail, postage prepaid to Marc J. Kesten, Attorney for JHO Intellectual Property Holdings, LLC, in an envelope addressed as follows:

MARC J. KESTEN

Attorney for JHO Intellectual Property Holdings, LLC

1600 NORTH PARK DRIVE

WESTON, FLORIDA UNITED STATES 33326

Dated: August 30, 2019

/David Johanson/

David O. Johanson
Attorney for Opposer,
YESHIVA UNIVERSITY