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

Proceeding	91202675
Party	Defendant DC International LLC
Correspondence Address	DC INTERNATIONAL LLC DC INTERNATIONAL LLC 624 CYPRESS GREEN CIR WELLINGTON, FL 33414-6335 david@dcinter.com
Submission	Confidential Defendant's Motion To Dismiss; Rule 12(b)
Filer's Name	David Boegler
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Date	12/21/2011
Attachments	Trademarkanswer.pdf (9 pages)(2560919 bytes)



DC International LLC

In re Notice of Opposition No. 91202675 from Yeshiva University v. DC International marks EINSTEIN DL application No 85307764

Yeshiva University

v.

DC International LLC

Rachelle A. Dubow
Bingham McCuthen LLP
One Federal Street
Boston, MA 02110

Dear Mrs Dubow,

I am writing in response to the opposition action taken by Yeshiva University located 500 West 185th Street, New York, New York 10033, USA against the registration of the trademark EINSTEIN DL by DC International located 624 Cypress Green Cir, Wellington, FL-33414, USA.

The following factors demonstrate DC International's use of the mark EINSTEIN DL does not infringe or dilute the Yeshiva University's marks ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN.

FIRST USE

DC International is a LLC registered in October 6, 2010 in the state of Florida. DC International has been using the mark "EINSTEIN DL" since February 1, 2011. *See Exhibit A.* Additionally, DC International has registered the mark 'EINSTEIN DL' with the USPTO on April 28, 2011.

SIMILARITY OF MARK

DC International asserts that our mark, EINSTEIN DL, is not similar enough to ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN to cause confusion. While the marks are similar in some respects (using the word EINSTEIN), they differ in the following ways: the communication, publication, and advertising made by DC International mentions the full trademark EINSTEIN DL with the last two letters DL that stand for Diode Laser. *See Exhibit B.* The EINSTEIN DL logo is unique to DC International product and is very distinct to Yeshiva University's marks.

SIMILARITY OF GOODS/SIMILARITY OF TRADE CHANNELS

The Yeshiva University is in the business of education. The Yeshiva University registered their trademarks ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN (Registrations No 1216122, 2804138 and pending registration 77735069 (EINSTEIN)) as Class 41 "*educational services – namely a medical school*", class 42 *Medical research, namely, conducting clinical, scientific and animal trials*, and pending class 16,25.

They are educational services address to the general public. DC International, however, is in the dental business. As our mark EINSTEIN DL is used in connection with such different goods and services than those connected to ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN, consumers will not be confused as to the source of the goods and services in connection with either of our marks. EINSTEIN DL is addressed to dental and medical professional only. As it is unlikely DC International will offer goods in Yeshiva University's line of business, or vice versa, consumers will easily be able to identify from which source DC International and Yeshiva University's goods and services are coming from.

STRENGTH OF MARK

Yeshiva University operates its business within the city of New York. Yeshiva University's primary clientele are located within New York. DC International, however, operates directly within the USA and secondary within international markets. Yeshiva University does not

advertise directly their marks ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN. Yeshiva University ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN marks are not well known on a national and international level. Additionally, Yeshiva University's mark has limited distinctiveness.

Due ALBERT EINSTEIN COLLEGE OF MEDICINE – reference to college of medicine - and ALBERT EINSTEIN – reference to the theoretical physicist - descriptive nature, ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN is not a strong mark. The weakness of Yeshiva University's mark weighs in favor of DC International. Albert Einstein In 1917, established the theoretic foundations for the laser and EINSTEIN DL is an suitable name as an homage to the theoretical physicist for a laser device.

ACTUAL CONFUSION

As Yeshiva University is aware, the basis for a trademark infringement claim is consumer confusion. In your November 23, 2001 letter you did not provide any examples of actual confusion resulting from our concurrent use of the marks EINSTEIN DL and ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN. We demand that you provide examples of actual confusion relating from the use of the mark EINSTEIN DL.

There is a clear distinction between DC International activity and mark EINSTEIN DL addressed to dental and medical professionals compared to Yeshiva University marks ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN addressed to the education/ University market.

LENGTH OF TIME MARKS HAVE BEEN CONCURRENTLY USED

DC International began using the mark EINSTEIN DL on February 1, 2011. Yeshiva University began using the mark EINSTEIN in 2004 and ALBERT EINSTEIN in 1982. For 10 months both DC International and Yeshiva University have concurrently used their respective marks without issue. This factor suggests that the concurrent use of our marks EINSTEIN DL and ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN do not result in consumer confusion.

CONSUMER CARE IN MAKING A PURCHASING DECISION

Due to the expense and importance of DC International's goods and services, a consumer will take great care in choosing our product. As a result consumers will be less likely to be confused by the concurrent use of EINSTEIN DL and ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN. This factor weighs in DC International's favor.

NUMBER OF SIMILAR MARKS IN USE

ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN are only eligible for minimal, if any, protection as shown by the number of marks similar to ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN. A search on the USPTO revealed that the term EINSTEIN is used in 90 other marks. *See Exhibit C*. This demonstrates the weakness of Yeshiva University's mark and thus this factor favors DC International's right to use EINSTEIN DL.

DC INTERNATIONAL'S INTENT

DC International vehemently denies that we made any attempt to misappropriate Yeshiva University's good will or to cause consumer confusion. DC International was unaware of Yeshiva University's use of the mark ALBERT EINSTEIN COLLEGE OF MEDICINE and ALBERT EINSTEIN at the time DC International began using EINSTEIN DL.

DILUTION CLAIM

Additionally, DC International asserts that Yeshiva University does not have grounds for a dilution claim. In order to succeed on a dilution claim the plaintiff must show that their mark "is widely recognized by the general public of the United States" 15 USC §1125(c)(2)(A). Yeshiva University fails to meet this requirement because of Yeshiva University's lack of extensive national advertising, limited geographic reach of Yeshiva University's sales and lack

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