

ESTTA Tracking number: **ESTTA500430**

Filing date: **10/16/2012**

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

| | |
|------------------------|--|
| Proceeding | 91205228 |
| Party | Defendant Randolph Saint Martin |
| Correspondence Address | PAULO A DE ALMEIDA PATEL & ALMEIDA PC 16830 VENTURA BLVD, SUITE 360 ENCINO, CA 91436 UNITED STATES Paulo@PatelAlmeida.com |
| Submission | Answer and Counterclaim |
| Filer's Name | Paulo A. de Almeida |
| Filer's e-mail | Paulo@PatelAlmeida.com |
| Signature | /Paulo A. de Almeida/ |
| Date | 10/16/2012 |
| Attachments | APPLICANT'S AMENDED ANSWER AND COUNTERCLAIM FOR CANCELLATION_Parent_91205228_Oct_16_2012.pdf (14 pages)(52980 bytes) |

Registration Subject to the filing

| | | | |
|--------------------|--|-------------------|------------|
| Registration No | 1216122 | Registration date | 11/09/1982 |
| Registrant | Yeshiva University 500 W. 185th Street New York, NY 10033-320 UNITED STATES | | |
| Grounds for filing | The registration was obtained fraudulently. | | |

Goods/Services Subject to the filing

Class 041. First Use: 1955/00/00 First Use In Commerce: 1955/00/00

All goods and services in the class are requested, namely: Educational Services-Namely, Conducting a Medical School [and Hospital]

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

| | | |
|------------------------|---|---------------------------------------|
| YESHIVA UNIVERSITY, |) | |
| |) | |
| Opposer, |) | Opposition No. 91205500 |
| |) | Opposition No. 91205228 (Parent Case) |
| v. |) | Serial No. 76/710,178 |
| |) | Mark: EINSTEINHEAD ATHLETE |
| RANDOLPH SAINT MARTIN, |) | E=MC2 and Design |
| |) | |
| Applicant. |) | |
| |) | |
| |) | |
| |) | |
| |) | |
| |) | |

**APPLICANT'S AMENDED ANSWER TO OPPOSER'S AMENDED NOTICE OF
OPPOSITION AND COUNTERCLAIM FOR CANCELLATION**

On May 17, 2012, Opposer filed two Notices of Opposition against Applicant's U.S. Trademark Application Ser. Nos. 76/709,668 and 76/710,178. On August 9, 2012, the Board consolidated Opposition Nos. 91205228 and 91205500. The Board designated Opposition No. 91205228 as the "Parent" case in this consolidated proceeding. On August 9, 2012, and on August 16, 2012, Opposer filed Amended Notices of Opposition in this consolidated proceeding. On September 17, 2012, the Board accepted both Amended Notices of Opposition and allowed Applicant 30 days to file its Amended Answers. Applicant hereby submits (1) its Amended Answers to each Notice of Opposition, filed separately in each proceeding, and (2) a Counterclaim for Cancellation of Opposer's U.S. Trademark Registration No. 1216122 for the mark ALBERT EINSTEIN. Applicant's Counterclaim for Cancellation is pleaded below in the Amended Answer filed in this Parent Case (91205228), and is referred to (but not separately pleaded) in Applicant's Amended Answer filed in the "Child" case (91205500).

Applicant, Randolph Saint Martin, an individual, by his attorneys hereby responds to the allegations set forth in the Amended Notice of Opposition filed by Yeshiva University, as follows:

1. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 1 of the Amended Notice of Opposition, and therefore, denies such allegations.
2. Applicant admits the truth of the allegations set forth in Paragraph 2 of the Amended Notice of Opposition.
3. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 3 of the Amended Notice of Opposition, and therefore, denies such allegations.
4. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 4 of the Amended Notice of Opposition, and therefore, denies such allegations.
5. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 5 of the Amended Notice of Opposition, and therefore, denies such allegations.
6. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 6 of the Amended Notice of Opposition, and therefore, denies such allegations.
7. Applicant admits that the United States Patent and Trademark Office's TESS database indicates that Opposer is the owner of the trademark registrations identified in Paragraph 7 of the Amended Notice of Opposition. Applicant has insufficient knowledge or

information as to the truth of the remaining allegations set forth in Paragraph 7 of the Amended Notice of Opposition, and therefore, denies such allegations.

8. Applicant admits that the United States Patent and Trademark Office's TESS database indicates that Opposer is the owner of the U.S. trademark application identified in Paragraph 8 of the Amended Notice of Opposition.
9. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 9 of the Amended Notice of Opposition, and therefore, denies such allegations.
10. Applicant admits that it filed an intent-to-use application with the United States Patent and Trademark Office ("USPTO") for the mark E=MC² EINSTEINHEAD ATHLETE and Design ("Applicant's Mark") for use in connection with "Education services in the nature of childhood instruction in the fields of math, science and physical fitness at the k-12 level" as alleged in Paragraph 10 of the Amended Notice of Opposition. Applicant has insufficient knowledge or information as to the truth of the remaining allegations set forth in Paragraph 10 of the Amended Notice of Opposition, and therefore, denies such allegations.
11. Applicant denies the allegations set forth in Paragraph 11 of the Amended Notice of Opposition.
12. Applicant denies the allegations set forth in Paragraph 12 of the Amended Notice of Opposition.
13. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 13 of the Amended Notice of Opposition, and therefore, denies such allegations.

14. Applicant denies the allegations set forth in Paragraph 14 of the Amended Notice of Opposition.
15. Applicant has insufficient knowledge or information as to the truth of the allegation that "'EINSTEIN' is a term widely understood to be a surname" as set forth in Paragraph 15 of the Amended Notice of Opposition, and therefore denies the allegation. Applicant denies the remaining allegations set forth in Paragraph 15 of the Amended Notice of Opposition.
16. Applicant denies the allegations set forth in Paragraph 16 of the Amended Notice of Opposition.
17. Applicant denies the allegations set forth in Paragraph 17 of the Amended Notice of Opposition.
18. Applicant denies the allegations set forth in Paragraph 18 of the Amended Notice of Opposition.
19. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 19 of the Amended Notice of Opposition, and therefore, denies such allegations.
20. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 20 of the Amended Notice of Opposition, and therefore, denies such allegations.
21. Applicant denies the allegations set forth in Paragraph 21 of the Amended Notice of Opposition.
22. Applicant denies the allegations set forth in Paragraph 22 of the Amended Notice of Opposition.

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