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

Sylvan Learning, Inc.)
)
 Opposer,)
)
 v.)
)
 Channing Bete Company, Inc.)
)
 Applicant.)
)

Opposition No. _____
Application Serial No. 86/052572
SYNC

Attorney's Reference: 42328-373162

NOTICE OF OPPOSITION

In the matter of the application for registration of the trademark SYNC filed by Channing Bete Company, Inc. ("Applicant"), as shown in Application Serial No. 86/052572 published for opposition in the *Official Gazette* of June 17, 2014.

Sylvan Learning, Inc. ("Opposer"), a Delaware corporation with its address at 1001 Fleet Street, Baltimore, Maryland, 21202 believes that it will be damaged by registration of the mark shown in said Application Serial No. 86/052572 and hereby opposes the same:

As grounds for opposition it is alleged that:

1. Opposer, itself and through its subsidiaries and predecessors in interest, is now, and for many years has been, engaged in the business of providing educational services for children Pre-K- grade 12, and has provided electronic and print educational publications and materials, including books, in connection therewith.
2. Opposer has used the trademark SylvanSync in connection with and to identify its services and goods as described in Paragraph 1.

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3. Opposer, itself and through its subsidiaries and predecessors in interest has used trademarks incorporating the trademark SylvanSync in connection with and to identify various of its services and goods as described in Paragraph 1 since at least as early as October 2012.
4. Opposer is the owner of U.S. Trademark Registration No. 4467950 issued January 14, 2014 from an application filed August 17, 2011 for the mark SylvanSync covering “Educational services, namely, providing live and online classes and tutoring programs offered at the Pre-K through grade 12 level and at the entry level college course level; diagnostic and prescriptive, individualized and personalized instruction techniques offered to individuals, small groups or classes in the areas of reading, writing, mathematics, study skills, science, social studies, and foreign languages and test preparation services in the field of general Pre-K through grade 12 education; educational services and online educational services, namely, providing entry level college courses; non-downloadable electronic publications, namely, electronic educational textbooks and course material in the nature of journals, pamphlets, newsletters written articles, and informational brochures all in the field of general Pre-K through grade 12 education and entry level college courses and for use in assessing student abilities and performance; non-downloadable electronic publications, namely, electronic educational course books in the field of general Pre-K through grade 12 education and entry level college courses, books featuring teaching information in the area of general Pre-K through grade 12 education and entry level college courses, study guides for students and student workbooks in the field of general Pre-K through

grade 12 education and entry level college courses, books featuring student test materials in the field of general Pre-K through grade 12 education and entry level college courses, and online tests featuring materials for assessing student abilities and performance. educational services delivered via on-line programs, namely, in-classroom instruction or a combination of on-line and in-classroom instruction at the Pre-K through grade 12 levels, and at the entry level college course level; education services for students in Pre-kindergarten through college, namely, providing live and on-line tutoring and instruction, educational assessments, diagnostic reading, math, science, social studies, and foreign languages assessments, student progress monitoring, preparation for standardized testing, and preparation for school entrance exams; educational services, namely, conducting and monitoring interactive lessons and student tutorials via the Internet for grades K-12 and for entry level college courses; educational testing and monitoring, namely, tracking and assessment of student progress on interactive lessons and student tutorials via the Internet for grades K-12 and entry level college courses; consulting services to parents and teachers of students in the field of K-12 education and at the entry level college course level, namely, consulting regarding the development of individual educational needs; educational services, namely, developing, arranging, assessing and conducting educational programs in the field of general education at the K-12 grade levels and at the entry level college course level via a global computer network; educational services provided in person and via the Internet, namely, providing learning progress data and curriculum information to parents and caregivers regarding their children's

educational progress; providing an educational online web portal featuring educational services in the nature of courses of instruction and assessment of student abilities and performance at the Pre-K through entry level college course levels.”

5. Opposer is the owner of U.S. Trademark Application Serial No. 85/400268 filed August 17, 2011 for the mark SylvanSync covering ” Printed materials, namely, books in the field of general Pre-K through grade 12 education and entry level college courses and for use in assessing student abilities and performance; textbooks in the field of general Pre-K through grade 12 education and entry level college courses and for use in assessing student abilities and performance; printed teaching materials in the field of general Pre-K through grade 12 education and entry level college courses and for use in assessing student abilities and performance; study guides for students, student workbooks in the field of general Pre-K through grade 12 education and entry level college courses and for use in assessing student abilities and performance; workbooks featuring student test materials in the field of Pre-K through entry level college courses, and textbooks featuring materials for assessing student abilities and performance in the field of Pre-K through entry level college courses; printed educational publications, namely, books featuring educational texts, workbooks and instructional manuals in the field of general Pre-K through grade 12 education and entry level college courses, for diagnostic and prescriptive, individualized and personalized instruction offering supplemental education for individuals, small groups and classes; printed materials, namely, books, educational texts, textbooks, printed

tests and testing materials, all for children Pre-K through grade 12 and for entry level college courses, and all in the areas of reading, mathematics, writing, science, social studies, foreign languages, study skills and test preparation.”

6. Application Serial No. 86/052572 was filed by the applicant on August 30, 2013 alleging an intent to use the mark SYNC in connection with “educational publications for high school students, namely, magazines in the field of education, academic success, school transition, career planning, college planning, social media, bullying and cyberbullying, physical and emotional health, alcohol and other drugs, personal development, social issues, financial management, safety, interpersonal skills, time management skills, decision making, conflict resolution, organizational skills, studying, test taking and test anxiety.”
7. The filing date of the registration and application described in Paragraphs 4-5 predates the filing date for Application Serial No. 86/052572.
8. The filing date of the registration and application described in Paragraphs 4-5 predates any date of first use of the mark SYNC that may be relied upon by the applicant.
9. Opposer has used the term SylvanSync as a trademark in the United States since prior to any use of the mark SYNC in the United States that may be alleged or relied upon by applicant.
10. The applicant’s mark SYNC is confusingly similar to the Opposer’s mark SylvanSync.
11. The marks SylvanSync and SYNC are identical other than applicant’s omission of Opposer’s house mark Sylvan.

12. The applicant's goods are substantially related to those goods covered in Opposer's Application Serial No. 85/400268.
13. The applicant's goods are substantially related to those services listed in Opposer's Registration No. 4467950.
14. Consumers are likely to be confused and to mistakenly believe that applicant's goods offered under its SYNC mark either emanate from or are licensed by, sponsored by, or associated with Opposer, or that they incorporate Opposer's products and/or services.
15. If the applicant were permitted to use and register its mark for its services as specified in its application, confusion among consumers resulting in damage and injury to Opposer would be caused by virtue of the similarity between applicant's trademark and Opposer's trademark and the related nature of the services and/or goods covered by those marks. Any defect, objection or fault found with applicant's services would reflect upon, seriously injure the reputation and value that Opposer has established under its trademark.

WHEREFORE, Opposer prays that Application Serial No. 86/052572 be rejected, that no registration be issued thereon to applicant, and that this opposition be sustained in favor of the Opposer.

This Notice of Opposition is submitted together with the statutory filing fee of \$300.00 (Class 16). Should any additional fee be required, please charge the same to our Account No. 22-0261 and notify the undersigned accordingly.

Opposer appoints Mark B. Harrison, Rebecca Liebowitz, Linda Zirkelbach, Janet Satterthwaite, Jeremy Klass and Halle Markus along with the law firm of Venable LLP, P.O. Box 34385, Washington, D.C. 20043-9998 to transact all business on its behalf in connection with this Opposition.

Respectfully submitted,



Date: October 3, 2014

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served by U.S. Mail, first class, postage prepaid, on this 3rd day of October 2014 on the Applicant's attorney of record at the address listed in the current U.S. Trademark Office Records as follows:

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Mark Harrison