ESTTA Tracking number: **ESTTA774640**
Filing date: **10/04/2016**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	SYNOPTEK, LLC		
Entity	Limited Liability Company	Citizenship	California
Address	19520 Jamboree Rd., Suite 110 Irvine, CA 92612 UNITED STATES		

Attorney information	Douglas Q. Hahn, Esq. Stradling Yocca Carlson & Rauth 660 Newport Center Drive, Suite 1600 Newport Beach, CA 92660 UNITED STATES dhahn@sycr.com Phone:9497254000

Registration Subject to Cancellation

Registration No	4015160	Registration date	08/23/2011
Registrant	SYNAPTEK CORPORATION 1818 LIBRARY STREET RESTON, VA 20190 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2010/10/10 First Use In Commerce: 2010/10/10 All goods and services in the class are cancelled, namely: INFORMATION TECHNOLOGY CONSULTING AND INFORMATION TECHNOLOGY PROJECT MANAGEMENTSERVICES, NAMELY, COMPUTER SOFTWARE DEVELOPMENT AND DESIGN, WEB SITE DEVELOPMENT FOR OTHERS, COMPUTER SYSTEMS INTEGRATION SERVICES, TECHNICAL SUPPORT, NAMELY, MONITORING OF NETWORK SYSTEMS, DESIGN AND DEVELOPMENT OF WIRELESS COMMUNICATION SYSTEMS FOR TRANSMISSION AND RECEPTION OF VOICE, AND PLANNING, DESIGN AND MANAGEMENT OF INFORMATION TECHNOLOGY SYSTEMS

Grounds for Cancellation

Deceptiveness	Trademark Act Sections 14(3) and 2(a)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used	Trademark Act Section 14(3)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration	3424720	Application Date	08/07/2006

No.			
Registration Date	05/06/2008	Foreign Priority Date	NONE
Word Mark	SYNOPTEK		
Design Mark	SYNOPTEK		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/01/01 First Use In Commerce: 2007/01/01 Advertising and business management consultancy; Advisory services relating to business management and business operations; Assistance with business managementand planning; Business consulting, management, planning and supervision; Business information management; Business management; Business management consultancy as well as development of processes for the analysis and the implementation of strategy plans and management projects; Business management consultation; Business organizational consultation; Business process re-engineering services; Consultancy services regarding business strategies; Database management; Development ofmarketing strategies and concepts; Information and data compiling and analyzingrelating to business management; Information, advisory and consultancy servicesrelating to business and management or business administration, including such services provided on line or via the internet; Marketing consulting; Organizational services for business purposes; Outsourcing in the field of business processes and information technology; Providingbusiness management information in connection with consulting and advisory services in the field of strategic planning Class 037. First use: First Use: 2007/01/01 First Use In Commerce: 2007/01/01 Installation of computer networks; Maintenance and repair of computer networks Class 042. First use: First Use: 2007/01/01 First Use In Commerce: 2007/01/01 Computer consultation; Computer disaster recovery planning; Computer network design for others; Computer software consultation; Consulting services in the field of design, selection, implementation and use of computer hardware and softwaresystems for others; Customization of computer hardware and software; Database development services; Design, developmentand implementation of software; Information technology consultation; Installation of computer software; Technical support services, namely, troubleshooting of computer hardware and software problems;Technical writing for others		

Attachments	78946325#TMSN.png(bytes) Petition to Cancel - SYNAPTEK.pdf(1357936 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Arnold V.Mina/
Name	Arnold V. Mina
Date	10/04/2016

Douglas Q. Hahn, Esq.
Arnold V. Mina, Esq.
STRADLING YOCCA CARLSON & RAUTH
660 Newport Center Drive, Suite 1600
Newport Beach, CA 92660
Telephone: (949) 725-4000
Facsimile: (949) 725-4100

Attorneys for Synoptek, LLC, Petitioner.

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

SYNOPTEK, LLC,	)	Cancellation No.:
	)	
Petitioner,	)	Mark: SYNAPTEK (word mark)
	)	(Formerly SYNAPTYK)
v.	)	Registration No. 4,015,160
	)	
SYNAPTEK CORPORATION,	)	Interlocutory Atty:
	)	
Registrant.	)	
	)	

CERTIFICATE OF DEPOSIT

I hereby certify that this correspondence is being deposited electronically with the Trademark Trial and Appeal Board on the date shown below.

Dated: October 4, 2016

/s/ Arnold Mina
Arnold Mina

PETITION FOR CANCELLATION

Synoptek, LLC, a California limited liability company, having a place of business at 19520 Jamboree Rd., Suite 110, Irvine, California 92612, believes that it is being damaged by Registration No. 4015160 for the mark SYNAPTEK (formerly SYNAPTYK), and hereby petitions to cancel the same.

As grounds therefor, it is alleged that:

1. Petitioner is the owner of United States Trademark Registration No. 3,424,720, registered on May 6, 2008, on the Principal Register for the trademark SYNOPTEK ("Petitioner's Mark"), covering "Advertising and business management consultancy; Advisory services relating to business management and business operations; Assistance with business management and planning; Business consulting, management, planning and supervision; Business information management; Business management; Business management consultancy as well as development of processes for the analysis and the implementation of strategy plans and management projects; Business management consultation; Business organizational consultation; Business process re-engineering services; Consultancy services regarding business strategies; Database management; Development of marketing strategies and concepts; Information and data compiling and analyzing relating to business management; Information, advisory and consultancy services relating to business and management or business administration, including such services provided on line or via the internet; Marketing consulting; Organizational services for business purposes; Outsourcing in the field of business processes and information technology; Providing business management information in connection with consulting and advisory services in the field of strategic planning," in International Class 35; "Installation of computer networks; Maintenance and repair of computer networks," in International Class 37; and "Computer consultation; Computer disaster recovery planning; Computer network design for others; Computer software consultation; Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Customization of computer hardware and software; Database development services; Design, development and implementation of software; Information technology consultation; Installation of computer software; Technical support services, namely, troubleshooting of computer hardware and

software problems; Technical writing for others," in International Class 42 (hereinafter "Petitioner's Services"). See **Exhibit A** – copy of Certificate of Registration; U.S. Trademark Registration No. 3,424,720.

2. On March 14, 2014, the United States Patent and Trademark Office ("USPTO') has accepted and acknowledged the Combined Sections 8 & 15 Declaration filed for the Petitioner's Mark. See **Exhibit B** – copy of Notice of Acceptance and Acknowledgment of Sections 8 & 15 Declaration.

3. Petitioner has, for many years, since at least as early as January 1, 2007, and prior to any date of first use upon which Registrant can rely, adopted and used, continuously and exclusively, SYNOPTEK in interstate commerce and in commerce regulated by Congress, in connection with Petitioner's Services.

4. Registrant is the owner of record of the SYNAPTEK mark (formerly SYNAPTYK), U.S. Registration No. 4,015,160, in International Class 42, for "Information technology consulting and information technology project management services, namely, computer software development and design, web site development for others, computer systems integration services, technical support, namely, monitoring of network systems, design and development of wireless communication systems for transmission and reception of voice, and planning, design and management of information technology systems," (hereinafter "Registrant's Services").

5. Registrant filed similar trademark applications for the SYNAPTEK mark with the USPTO, *e.g.*, SYNAPTEK – U.S. Trademark Application Nos. 86/088, 595 and 86/088,536, which are currently rejected for potential likelihood of confusion with Petitioner's SYNOPTEK mark, SYNOPTYK mark owned by Synaptyk, Inc, and other similar registered and pending

marks. See **Exhibit C** – copy of USPTO Office Action for U.S. Trademark Appl. No. 86/088,536.

6. On or about March 3, 2015, Registrant filed a cancellation action against SYNAPTYK mark, then owned by Synaptyk, Inc., which was subsequently terminated on August 4, 2015, following acquisition by Registrant of the SYNAPTYK mark from Synaptyk, Inc. – See **Exhibit D** – copy of TTAB Docket for Cancellation No. 92061023.

7. On or about July 9, 2015, Registrant recorded a trademark assignment of the SYNAPTYK mark with the USPTO, which may be found on Reel/Frame 5573/0258. See **Exhibit E** – Copy of Synaptyk-Synaptek trademark assignment.

8. Registrant filed a Section 7 Amendment with the USPTO on July 15, 2015, to amend the SYNAPTYK mark to the previously rejected SYNAPTEK mark. The USPTO approved the Section 7 amendment of the SYNAPTYK mark to its current form, SYNAPTEK, on September 27, 2016. Petitioner contends that the amendment of the SYNAPTYK mark was improper because the amendment from SYNAPTYK to SYNAPTEK was a material change (see 15 U.S.C. §1057(e)), and created or worsened a likelihood of confusion with Petitoner's SYNOPTEK mark.

9. Petitioner's date of first use and date of first use in commerce of the SYNOPTEK trademark (*i.e.*, January 1, 2007), in conjunction with Petitioner's Services, is well before Registrant's claimed dates of use of its SYNAPTEK (or SYNAPTYK) trademark (*i.e.*, October 10, 2010) in conjunction with Registrant's Services.

10. Petitioner's substantially exclusive and continuous long-term use of its SYNOPTEK trademark in interstate commerce in connection with Petitioner's Services, combined with significant expenditures in promoting its trademark, has resulted in said trademark acquiring extensive goodwill, developing a high degree of distinctiveness, and being

well known and recognized by consumers and the trade as identifying services emanating from Petitioner.

11. Registrant's SYNAPTEK trademark is confusingly similar to the SYNOPTEK trademark and is likely to cause confusion, deception, or mistake to Petitioner's irreparable damage and injury, in violation of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

12. Registrant's Services as identified in the SYNAPTEK registration are closely related to Petitioner's Services offered under its SYNOPTEK trademark.

13. Petitioner is damaged and will continue to be damaged because Registrant's continued use and registration of SYNAPTEK mark causes likelihood of confusion with and dilutes the distinctive quality of Petitioner's trademark.

14. Petitioner is damaged and will continue to be damaged by the use and registration of Registrant's SYNAPTEK trademark within the meaning of 15 U.S.C. § 1064.

WHEREFORE, Petitioner prays that this Petition for Cancellation be granted, that judgment be entered against Registrant, and that United States Trademark Registration No. 4,015,160 be cancelled.

Dated: October 4, 2016

Respectfully submitted,

Douglas Q. Hahn, Esq.

Attorneys for Petitioner
STRADLING YOCCA CARLSON & RAUTH
660 Newport Center Drive, Suite 1600
Newport Beach, CA 92660

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petition for Cancellation was served upon Registrant's address by depositing a copy thereof in the United States Mail on October 4, 2016, first-class mail, postage prepaid, in an envelope addressed as follows:

SYNAPTEK CORPORATION
1818 LIBRARY STREET
RESTON VIRGINIA 20190

Date: 10/04/2016

Name: ARNOLD V. MINA

EXHIBIT A

Int. Cls.: 35, 37, and 42

Prior U.S. Cls.: 100, 101, 102, 103, and 106

United States Patent and Trademark Office

Reg. No. 3,424,720

Registered May 6, 2008

SERVICE MARK
PRINCIPAL REGISTER

SYNOPTEK

INFORMATION CONSULTING GROUP WEST, LLC (CALIFORNIA LTD LIAB CO)
1932 DEERE AVENUE, SUITE 150
SANTA ANA, CA 92705

FOR: ADVERTISING AND BUSINESS MANAGEMENT CONSULTANCY; ADVISORY SERVICES RELATING TO BUSINESS MANAGEMENT AND BUSINESS OPERATIONS; ASSISTANCE WITH BUSINESS MANAGEMENT AND PLANNING; BUSINESS CONSULTING, MANAGEMENT, PLANNING AND SUPERVISION; BUSINESS INFORMATION MANAGEMENT; BUSINESS MANAGEMENT; BUSINESS MANAGEMENT CONSULTANCY AS WELL AS DEVELOPMENT OF PROCESSES FOR THE ANALYSIS AND THE IMPLEMENTATION OF STRATEGY PLANS AND MANAGEMENT PROJECTS; BUSINESS MANAGEMENT CONSULTATION; BUSINESS ORGANIZATIONAL CONSULTATION; BUSINESS PROCESS RE-ENGINEERING SERVICES; CONSULTANCY SERVICES REGARDING BUSINESS STRATEGIES; DATABASE MANAGEMENT; DEVELOPMENT OF MARKETING STRATEGIES AND CONCEPTS; INFORMATION AND DATA COMPILING AND ANALYZING RELATING TO BUSINESS MANAGEMENT; INFORMATION, ADVISORY AND CONSULTANCY SERVICES RELATING TO BUSINESS AND MANAGEMENT OR BUSINESS ADMINISTRATION, INCLUDING SUCH SERVICES PROVIDED ON LINE OR VIA THE INTERNET; MARKETING CONSULTING; ORGANIZATIONAL SERVICES FOR BUSINESS PURPOSES; OUTSOURCING IN THE FIELD OF BUSINESS PROCESSES AND INFORMATION TECHNOLOGY; PROVIDING BUSINESS MANAGEMENT INFORMATION IN CONNECTION WITH CONSULTING AND ADVISORY SERVICES IN THE FIELD OF STRATEGIC PLANNING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 1-1-2007; IN COMMERCE 1-1-2007.

FOR: INSTALLATION OF COMPUTER NETWORKS; MAINTENANCE AND REPAIR OF COMPUTER NETWORKS, IN CLASS 37 (U.S. CLS. 100, 103 AND 106).

FIRST USE 1-1-2007; IN COMMERCE 1-1-2007.

FOR: COMPUTER CONSULTATION; COMPUTER DISASTER RECOVERY PLANNING; COMPUTER NETWORK DESIGN FOR OTHERS; COMPUTER SOFTWARE CONSULTATION; CONSULTING SERVICES IN THE FIELD OF DESIGN, SELECTION, IMPLEMENTATION AND USE OF COMPUTER HARDWARE AND SOFTWARE SYSTEMS FOR OTHERS; CUSTOMIZATION OF COMPUTER HARDWARE AND SOFTWARE; DATABASE DEVELOPMENT SERVICES; DESIGN, DEVELOPMENT AND IMPLEMENTATION OF SOFTWARE; INFORMATION TECHNOLOGY CONSULTATION; INSTALLATION OF COMPUTER SOFTWARE; TECHNICAL SUPPORT SERVICES, NAMELY, TROUBLESHOOTING OF COMPUTER HARDWARE AND SOFTWARE PROBLEMS; TECHNICAL WRITING FOR OTHERS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 1-1-2 007; IN COMMERCE 1-1-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 78-946,325, FILED 8-7-2006.

ARETHA SOMERVILLE, EXAMINING ATTORNEY

EXHIBIT B

From: TMOfficialNotices@USPTO.GOV
Sent: Friday, March 14, 2014 11:00 PM
To: sbrooks@sycr.com
Subject: Official USPTO Notice of Acceptance/Acknowledgement Sections 8 and 15: U.S. Trademark RN 3424720: SYNOPTEK: Docket/Reference No. 102759-0000

Serial Number: 78946325
Registration Number: 3424720
Registration Date: May 6, 2008
Mark: SYNOPTEK
Owner: SYNOPTEK, LLC

Mar 14, 2014

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15

The declaration of incontestability filed for the above-identified registration meets the requirements of Section 15 of the Trademark Act, 15 U.S.C. §1065. **The Section 15 declaration is acknowledged.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
035, 037, 042

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

Requirements in the First Ten Years

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between the 9th and 10th years after the registration date. See 15 U.S.C. §§1058, 1059.

Requirements in Successive Ten-Year Periods

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to http://tdr.uspto.gov/search.action?sn=78946325. NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

EXHIBIT C

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86088536

MARK: SYNAPTEK

86088536

CORRESPONDENT ADDRESS:
MARK HARRISON
VENABLE LLP
PO BOX 34385
WASHINGTON, DC 20043-4385

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Synaptek Corporation

CORRESPONDENT'S REFERENCE/DOCKET NO:
98062-356785
CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE:

The referenced application has been reviewed by the assigned trademark examining attorney. Please note, the applicant's signed declaration and specimen submitted on October 22, 2013 is accepted and entered into the record. However, applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SECTION 2(d) REFUSALS – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in ***U.S. Registration Nos. 3424720, 3910887, 3910886, 4015160 and 4015163***. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

The following factors are the most relevant: similarity of the marks, similarity of the services, and similarity of trade channels of the services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.* , 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of the Marks

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.* , 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

For a composite mark containing both words and a design, the word portion may be more likely to be impressed upon a purchaser's memory

and to be used when requesting the goods and/or services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.* , 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii); *see In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)). Thus, although such marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterra Inc.*, 671 F.3d at 1366, 101 USPQ2d at 1911 (Fed. Cir. 2012) (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.* , 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

In the instant case, applicant's mark is " **SYNAPTEK**" for "information technology consulting services; Planning, design and management of information technology systems; Integration of computer systems and networks; computer software development; Computer technical support services, namely, service desk or help desk services for IT infrastructure, operating systems, database systems, and web applications; Computer programming services for others in the field of software configuration management; Computer services, namely, remote and on-site management of the information technology (IT) systems and the software applications of others; consulting services concerning design and development of computer software programs and architecture and computer hardware architecture" in Class 042

The registrants' marks are:

Registrant #1

US Registration No. 3424720 (**SYNOPTEK**) for (in part) "Computer consultation; Computer disaster recovery planning; Computer network design for others; Computer software consultation; Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Customization of computer hardware and software; Database development services; Design, development and implementation of software; Information technology consultation; Installation of computer software; Technical support services, namely, troubleshooting of computer hardware and software problems; Technical writing for others" in Class 042

Registrant #2

US Registration No. 3910887 ("**SYNETEK SOLUTIONS**" with "solutions" disclaimed) for "Computer services, namely, remote and on-site management of the information technology (IT) systems of others" in Class 042.

US Registration No. 3910886 ("**SYNETEK SOLUTIONS**" with design and "solutions" disclaimed) for "Computer services, namely, remote and on-site management of the information technology (IT) systems of others" in Class 042.

Registrant #3

US Registration No. 4015160 (**SYNAPTYK**) for "INFORMATION TECHNOLOGY CONSULTING AND INFORMATION TECHNOLOGY PROJECT MANAGEMENT SERVICES, NAMELY, COMPUTER SOFTWARE DEVELOPMENT AND DESIGN, WEB SITE DEVELOPMENT FOR OTHERS, COMPUTER SYSTEMS INTEGRATION SERVICES, TECHNICAL SUPPORT, NAMELY, MONITORING OF NETWORK SYSTEMS, DESIGN AND DEVELOPMENT OF WIRELESS COMMUNICATION SYSTEMS FOR TRANSMISSION AND RECEPTION OF VOICE, AND PLANNING, DESIGN AND MANAGEMENT OF INFORMATION TECHNOLOGY SYSTEMS" in Class 042

US Registration No. 4015163 ("**SYNAPTYK**" with design) for "INFORMATION TECHNOLOGY CONSULTING AND INFORMATION TECHNOLOGY PROJECT MANAGEMENT SERVICES, NAMELY, COMPUTER SOFTWARE DEVELOPMENT AND DESIGN, WEB SITE DEVELOPMENT FOR OTHERS, COMPUTER SYSTEMS INTEGRATION SERVICES, TECHNICAL SUPPORT, NAMELY, MONITORING OF NETWORK SYSTEMS, DESIGN AND DEVELOPMENT OF WIRELESS COMMUNICATION SYSTEMS FOR TRANSMISSION AND RECEPTION OF VOICE, AND PLANNING, DESIGN AND MANAGEMENT OF INFORMATION TECHNOLOGY SYSTEMS" in Class 042

The marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.* , 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b)(iv).

Furthermore, marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce* , 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n* , 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii). Here, the applicant's mark contains wording similar to the registrants' marks. Indeed, in the case of '720, the only difference is that

applicant's mark contains an "A" and the registrant's mark contains an "O". In the case of '886 and '887, both applicant's and registrant's marks begin with "SYN" and end with "TEK". And in the case of '160, the only difference is that applicant's mark end with "TEK" and registrant's mark ends with the phonetic equivalent "TKY".

Lastly, although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.* , 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Disclaimed matter that is descriptive of or generic for an applicant's goods and/or services is typically less significant or less dominant when comparing marks. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.* , 753 F.2d at 1060, 224 USPQ at 752 ; TMEP §1207.01(b)(viii), (c)(ii). Therefore, the dominant feature in registrant's marks for '886 and '887 is "SYNETEK".

Thus, the marks are so similar in their appearance, sound, connotation and commercial impression, that there is a likelihood of confusion. Therefore, the similarity prong of the test to determine likelihood of confusion is satisfied.

Comparison of the Services

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.* , 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Analyzing the applicant's and registrant's services for similarity and relatedness is based on the description of the services set forth in the application and registration at issue, not on extrinsic evidence of actual use. *See Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *see also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp. Inc.*, 648 F.2d 1335, 1337, 209 USPQ 986, 988 (C.C.P.A. 1981).

Absent restrictions in an application and/or registration, the identified services are presumed to travel in the same channels of trade to the same class of purchasers. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d at 1268, 62 USPQ2d at 1005. Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. *See In re Jump Designs*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the application uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in registrants' identification.

Specifically, with regard to '720, '160 and '163, the applicant and registrants provide IT consulting, design and development of software, technical support and other computer services. Indeed, the services are identical in part, and otherwise closely related.

With regard to '886 and '887, both parties' provide remote and on-site management of IT systems. Here again, the identification is essentially identical.

Where the services of an applicant and registrant are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b). Since the parties' services are identical in part, and otherwise closely related, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as in the case of diverse services.

Accordingly, because confusion as to source is likely, registration is refused under Trademark Act Section 2(d) based on a likelihood of confusion.

Although applicant's mark has been refused registration, applicant may respond to the refusals by submitting evidence and arguments in support of registration.

Conclusion

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney.

/tfrazier/
Tamara Frazier
Trademark Attorney
Law Office 116
(571) 272-8256
tamara.frazier@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

EXHIBIT D

Cancellation

Number: 92061023 **Filing Date:** 03/03/2015
Status: Terminated **Status Date:** 08/04/2015
General Contact Number: 571-272-8500
Interlocutory Attorney: BENJAMIN U OKEKE
Paralegal Name: KARL S KOCHERSPERGER

Defendant

Name: Synaptyk, Inc.
Correspondence: DARIN M KLEMCHUK
KLEMCHUK LLP
8150 N CENTRAL EXPRESSWAY, 10TH FLOOR
DALLAS, TX 75206
UNITED STATES
james. creedon@kk-llp.com

Serial #: 85167462 Application File Assignment **Registration #:** 4015160
Application Status: Registered
Mark: SYNAPTYK

Serial #: 85167507 Application File Assignment **Registration #:** 4015163
Application Status: Cancellation Terminated - See TTAB Records
Mark: SYNAPTYK

Plaintiff

Name: Synaptek Corporation
Correspondence: MARK B HARRISON
VENABLE LLP
575 7TH ST NW
WASHINGTON, DC 20004
UNITED STATES
mbharrison@venable.com, trademarkdocket@venable.com
Phone: 202-344-4019

Serial #: 86088536 Application File Assignment
Application Status: Ex Parte Appeal Pending
Mark: SYNAPTEK

Prosecution History

#	Date	History Text	Due Date
7	08/04/2015	TERMINATED	
6	08/04/2015	BD DECISION: DISMISSED AS MOOT	
5	07/26/2015	W/DRAW OF PET FOR CANCELLATION	
4	04/20/2015	ANSWER	
3	03/10/2015	PENDING, INSTITUTED	
2	03/10/2015	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	04/19/2015

Prosecution History

#	Date	History Text	Due Date
1	03/03/2015	FILED AND FEE	

Results as of 10/04/2016 07:12 PM

Search:

EXHIBIT E

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM347486

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
Synaptyk, Inc.		07/01/2015	CORPORATION: DELAWARE

RECEIVING PARTY DATA

Name:	Synaptek Corporation
Street Address:	1818 Library Street
City:	Reston
State/Country:	VIRGINIA
Postal Code:	20190
Entity Type:	CORPORATION: VIRGINIA

PROPERTY NUMBERS Total: 2

Property Type	Number	Word Mark
Registration Number:	4015160	SYNAPTYK
Registration Number:	4015163	SYNAPTYK

CORRESPONDENCE DATA

Fax Number: 2023444019

Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.

Phone: 202-344-4019
Email: mbharrison@venable.com
Correspondent Name: MARK HARRISON
Address Line 1: P.O. Box 34385
Address Line 4: WASHINGTON, D.C. 20043-9998

CH $65.00 4015160

ATTORNEY DOCKET NUMBER:	98062-380034
NAME OF SUBMITTER:	Mark Harrison
SIGNATURE:	/Mark Harrison/
DATE SIGNED:	07/09/2015

Total Attachments: 1
source=SYNAPTYK assignment#page1.tif

ASSIGNMENT

WHEREAS, Synaptyk, Inc. ("Assignor"), a Delaware corporation with an address at 5700 Granite Parkway, Plano, Texas 75024 is the owner of record of

U.S. Trademark Registrations No. 4015163 for the mark synaptyk

U.S. Trademark Registrations Nos. 4015160 for the mark SYNAPTYK;

and of the common-law rights in said trademarks, and the goodwill of the business symbolized by said marks;

AND WHEREAS, Synaptek Corporation ("Assignee"), a Virginia corporation with an address at 1818 Library Street, Reston, Virginia 20190 is desirous of acquiring the entire right, title and interest in and to the aforementioned marks and registrations, the goodwill of the business symbolized by said marks, and the right to sue for past infringements;

NOW THEREFORE, for One Dollar and other good and valuable consideration, the receipt of which is hereby acknowledged, Assignor does hereby assign, sell, and transfer unto the said Assignee the entire right, title and interest in and to the said registrations and marks, together with the goodwill of the business symbolized by said marks, the right of Assignor to conduct business under said trademarks, and the right to sue for past infringements of said marks.

Dated this 1st day of July, 2015

Synaptyk, Inc.

By (signature): _____

Name: Jeff Raymond

Title: EXECUTIVE VICE PRES.