

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING DIVISION

U.S. Application Serial No.: 86180679
Mark: SYNCHRONY
Applicant: Blue Trademark Holding, LLC

This is in response to the Office Action dated May 12, 2014. The Examiner has stated that registration of the applied-for mark is refused in class 36 because of a likelihood of confusion with the mark SYNCHRONY CAPITAL, in U.S. Registration No. 3354929, registered by an individual, Mark Renz (“Renz”) in class 36 for “investment management.” Applicant submits that no confusion is likely between applicant’s use of its mark and the cited registration because of (1) differences between the services for which the marks are used; (2) differences in the channels of trade of the services and targeted consumers; and (3) the differences between the marks themselves. For these reasons, Applicant requests that the refusal to register be withdrawn and that the subject application be passed to publication.

Further, since the date of the Office Action, the Registration for SYNCHRONY CAPITAL has been cancelled. The Registration was cancelled on July 25, 2014 because the registrant did not file an acceptable declaration under Section 8. As discussed in more detail below, there is no indication that Renz is currently using his mark either within or outside the state of Florida. There is no active SYNCHRONY CAPITAL entity in Florida and the telephone number on the SYNCHRONY CAPITAL registration is linked to an entity named Barclay Breland Family Office. Accordingly, this inactive mark should not be a bar to registration.

Differences Between the Services for Which the Marks are Used

Applicant notes that the Examiner has requested that the identification of goods and services for the applied-for mark in class 36 be clarified. As such, Blue Trademark Holding, LLC (“Blue”) has amended the identification of goods and services in class 36 to read:

Financial services, namely, credit card services, including private label credit cards and dual credit cards that serve as both private label credit cards and general purpose credit cards; Electronic credit card transaction services; Point of sale and point of transaction services, namely, credit application processing, payment transaction and account authorization services; Facilitating credit services through electronic means and mobile devices, namely, processing of credit card applications, authorizations, payments and account management services; Credit card and multi-tender loyalty programs, namely, programs that allow businesses to offer payments and/or rewards to customers; Promotional financing for purchases including through the use of private label, dual and general purpose credit cards and installment loans; Line of credit loans; Banking services, including retail and consumer deposit account services, certificates of deposit, money

market accounts, direct and mobile banking services, savings accounts and brokered deposits, IRAs, small business deposit accounts, checking, overdraft protection, debit, credit and ATM cards and offers of preferred pricing to certain defined groups; Providing financial information, marketing and data analytics services regarding credit card and merchant customer performance, including, without limitation, credit card and marketing data and programs, consumer research and reports; Financing for elective healthcare procedures or services, such as dental, veterinary, cosmetic, vision and audiology procedures or services; Providing services for processing credit card transactions for merchants; Servicing activities in connection with all of the foregoing, including but not limited to customer service, billing, collections and transaction settlement.

In stark contrast, the mark SYNCHRONY CAPITAL was registered by Renz in class 36 solely for “investment management.” While both the applied-for mark and the now-cancelled SYNCHRONY CAPITAL mark are for services within class 36, there is a clear difference in the services provided under those marks. Renz’s investment management services are described as “employ[ing] a mix of stocks, bonds, mutual funds and options to achieve the best risk adjusted return” for the individual client’s profile. *See* Specimen for SYNCHRONY CAPITAL mark, attached hereto as Exhibit 1. Blue’s proposed services do not include any such similar investments for Blue’s customers. Instead, they provide a functionality by which Blue’s consumers may offer credit cards and associated services. There is no overlap here. There also is no evidence that Renz is continuing to use the SYNCHRONY CAPITAL mark or that he intends to expand his investment management services into the realm of applicant Blue’s services.

It is well-settled that differences between the goods and services for which two marks are used greatly decrease or may eliminate any likelihood of confusion. In fact, numerous cases illustrate that even when two products or services fall within the same general field, such as financial services here, it does not mean that the two products or services are sufficiently similar to create a likelihood of confusion. *See Harlem Wizards Entm’t Basketball, Inc. v. NBA Props., Inc.*, 952 F. Supp. 1084, 1095 (D.N.J. 1997) (holding that the concurrent use of the mark WIZARDS between a “show” basketball team and a professional basketball team did not create a likelihood of confusion because there were meaningful differences between the products and services); *Berliner v. Recordcraft Sales Corp.*, No. 81 Civ. 4358–CSH, 1987 WL 5805, at *6 (S.D.N.Y. Jan 15., 1987) (HALL OF FAME MUSIC COMPANY for music publishing services is not likely to cause confusion with HALL OF FAME for music recording label).

Applicant submits that there are marked differences between applicant’s proposed services and the investment management services provided under the now-cancelled SYNCHRONY CAPITAL mark. Accordingly, it is unlikely that there will be confusion between Applicant’s mark and the Renz mark.

Differences in the Channels of Trade and Targeted Consumers

There is also no likelihood of confusion as the same consumers will not encounter Blue's credit card and associated services and Renz's investment management services. In fact, even identical marks can co-exist without confusion when the channels of trade and targeted consumers are not the same. *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 717-718 (Fed. Cir. 1992) (no likelihood of confusion between two EDS marks for goods and services sold to different consumers even within the same organization); *see also Astra Pharm. Prods. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206-1207 (1st Cir. 1983) (no likelihood of confusion between two ASTRA marks for products sold to different kinds of users within hospitals).

The individuals who would encounter Renz's now-cancelled mark, SYNCHRONY CAPITAL, exclusively seek investment management services or, as indicated in the specimen, "personal portfolio management" services from Renz, "an Independent Investment Advisor" in Jupiter, FL. *See* Ex. 1. There is no indication that Renz's services are targeted at any audience other than individual investors in Florida. Further, records from the Florida Secretary of State indicate that Renz is the managing member of SYNCHRONY RE VENTURES LLC, a limited liability company that is currently inactive in Florida. *See* Entity Search from Florida Secretary of State Website, attached hereto as Exhibit 2. There is no indication that Renz is currently using his mark either within or outside the state of Florida. This is further supported by Renz's failure to file an acceptable declaration under Section 8 to renew his mark.

In contrast, Blue's services are targeted at corporate clients, namely, banks, financial institutions, and retailers wishing to provide assorted credit card and associated services. Notably, Renz's specimen for the SYNCHRONY CAPITAL registration expressly states that his business is "an investment boutique not a department store", – department stores are in fact likely consumers of Blue's services. *See* Ex. 1. Therefore, there it is unlikely that consumers of Renz's services would even encounter, let alone be confused by, Blue's services.

Differences Between the Marks

The use of identical, even dominant, words in common does not automatically mean that two marks are similar. *Gen. Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 (8th Cir. 1987) (finding no likelihood of confusion between APPLE RAISIN CRISP and OATMEAL RAISIN CRISP for breakfast cereals). Instead, a mark must be considered as a whole in determining whether a likelihood of confusion exists and the commercial impression made by the marks in their entireties must be compared. *Mango's Tropical Café, Inc. v. Mango Martini Rest. & Lounge*, 844 F. Supp. 2d 1246, 1254-55 (S.D. Fla. 2011) (finding no likelihood of confusion between MANGO'S TROPICAL CAFÉ and MANGO MARTINI). Here, the full mark "SYNCHRONY CAPITAL" implies an investment structure, as capital is provided for an investment. There is no such commercial impression for SYNCHRONY on its own. The SYNCHRONY CAPITAL and SYNCHRONY marks, when compared in their entireties, look and sound different and convey different commercial impressions. Under the circumstances, their concurrent use and registration is not likely to cause confusion.

Conclusion

In addition to the recent cancellation of the SYNCHRONY CAPITAL mark, all of the factors discussed above compel the conclusion that the Applicant's use and registration of SYNCHRONY in class 36 is not likely to cause confusion with the now-cancelled mark SYNCHRONY CAPITAL. Accordingly, Applicant respectfully requests that the refusal of registration be withdrawn and that its application be passed to publication.

Exhibit 1

Fee Information

The fee is a simple, flat fee based on the assets under management. *There are no hidden or additional fees.*

In addition to receiving customized and consolidated monthly statements from the institution having custody of your assets, a customized SYNCHRONY statement will be presented to you during quarterly face-to-face review and reassessment sessions. This entire process is developed and maintained by Mark Renz.

Investment Philosophy

Diversification is of critical importance in reducing portfolio risk and achieving the optimum balance between risk and return. SYNCHRONY employs a mix of stocks, bonds, mutual funds and options to achieve the best risk adjusted return. We believe in creating investment portfolios, which are carefully tailored to the client's profile.



SYNCHRONY CAPITAL MANAGEMENT

Personal Portfolio Management

SYNCHRONY CAPITAL MANAGEMENT

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The Synchrony Capital Management Difference

Our goal is to help you get where you want to go ... comfortably.

As an Independent Investment Advisor, SYNCHRONY will provide the highest level of service to you. We answer only to you. You are #1. A simple flat fee structure is charged for assets under management, with no hidden fees from SYNCHRONY. We utilize large, national, discount, NYSE member brokerage firms to keep your additional trading costs and fees to an absolute minimum.

SYNCHRONY will take the time to assess your situation and help you determine if SYNCHRONY may be an asset to you. We will discuss your objectives, current situation and goals. SYNCHRONY will then go over your individual situation with regard to your financial portfolio. From there SYNCHRONY can begin to develop an investment policy statement and optimal portfolio. This 'blueprint' helps the investor to better understand their objectives and constraints and how they relate to the expected returns. It protects the strategy from being changed based on emotional or impulsive reactions and provides a basis for reasonable measurement and assessment relating to the achievement of the established goals.

Our Pledge to you

My answer to your financial success is SYNCHRONY. SYNCHRONY is an investment boutique not a department store. A hand tailored financial plan will be constructed for you. SYNCHRONY does not have an insatiable appetite for clients. Our ideal clients are willing to build a relationship, which will help create the financial bedrock for you to build the financial castle of your dreams...

This is our reason for being.

This is why I'm devoted to investment analysis.

SYNCHRONY holds regularly scheduled meetings with our clients to assure they are on track and update the investment policy statement accordingly. It is this emphasis which makes our advice superior in helping clients to attain objectives as rapidly and as cost effectively as possible. We provide a continuous relationship designed to make the investment process and individual goal attainment as simple and efficient as possible. We try to help you determine what is most important to you and map out an investment strategy to help you get where you want to be... *effortlessly*.

Synchrony Capital

SYNCHRONY CAPITAL provides objective, fee only advisory services to help you achieve your financial goals as efficiently as possible. A systematic approach is employed in developing a comprehensive investment program to address the portfolio management process. In maintaining a disciplined approach and an explicit investment policy statement the focus is continually on your personal financial objectives and goals.

Exhibit 2



Detail by Entity Name

Florida Limited Liability Company

SYNCHRONY RE VENTURES LLC

Filing Information

Document Number	L11000065847
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Address Changed: 08/08/2012

Authorized Person(s) Detail

Name & Address

Title MGRM

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Annual Reports

No Annual Reports Filed

Document Images

[08/08/2012 -- Reg. Agent Change](#)

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