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

Proceeding	91192796
Party	Defendant Omega Psi Phi Fraternity, Inc.
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Attachments	Answer 2 Opposition Centennial Mark Dec 20 2009.pdf ( 7 pages )(397940 bytes )



2. Opposer is and has been engaged in the sale and marketing of goods under the registered trademarks  $\Omega$  and OMEGA, since at least as early as 1894.

**Answer:** Applicant is without sufficient information to answer the allegations contained in Paragraph # 2.

3. Opposer is the owner of the following valid and subsisting U.S. trademark registrations, including:

OMEGA (AND DESIGN)	REG. NO.	25,036
OMEGA	REG. NO.	566,370
OMEGA (AND DESIGN)	REG. NO.	577,415
OMEGA (AND DESIGN)	REG. NO.	578,041
OMEGA (AND DESIGN)	REG. NO.	660,541
OMEGA (AND DESIGN)	REG. NO.	1,290,661
OMEGA (AND DESIGN)	REG. NO.	1,969,071
Design	REG. NO.	2,912,918
OMEGA (AND DESIGN)	REG. NO.	3,146,117
OMEGA (AND DESIGN)	REG. NO.	3,318,408

and others.

**Answer:** The allegations contained in Paragraph # 3 is admitted to the extent it is supported by the U.S. Trademark Office records and that the rights therein have not been otherwise transferred, cancelled or abandoned.

4. Opposer has used its OMEGA marks in commerce extensively and has acquired a considerable and valuable goodwill and wide scale recognition for its mark. The public has come to associate the OMEGA symbol and its spoken equivalent "OMEGA" word marks, with Opposer and Opposer's goods and services, which include not only watches, sports timing products, but accessories and services as well.

**Answer:** Applicant is without sufficient information to answer the allegations contained in Paragraph # 4 concerning its use in commerce or the alleged acquired goodwill; however, Applicant denies that the public associates the Omega symbol or the spoken word equivalent "Omega" with Opposer or Opposer's goods, services or accessories .

5. OMEGA's registrations are *prima facie* proof of ownership and use of the mark from the original date of filing of the application, pursuant to 15 USC 1057(b), and of Opposer's exclusive right to use the registered mark in commerce. Furthermore, Registration Numbers 25,036; 566,370; 578,041; 660,541 and 1,969,071 are incontestable, pursuant to section 15 of the Trademark Act.

**Answer:** Applicant is without sufficient information to answer the allegations contained in Paragraph # 5 but do admit them to the extent it is supported by the U.S. Trademark Office records, U.S. laws and that the registrations for the marks have not been abandoned, cancelled or transferred.

6. Applicant's mark is confusingly similar to OMEGA's registered trademark and is likely, when applied to the goods of the Applicant, to cause confusion, or to cause mistake or to deceive.

15 USC 1052(d). Applicant's mark makes a highly similar commercial impression to Opposer's marks OMEGA and Ω. Thus, Applicant's mark, when applied to the same or similar goods, would cause confusion or be likely to cause confusion, mistake, or deception, leading consumers to believe that Opposer is the source of Applicant's goods.

**Answer:** The allegations contained in Paragraph # 6 is denied.

7. The Opposer has a long history of sale and offering for sale of devices in Class 014, including jewelry and watches. Further, Opposer has used its mark in advertising and marketing of its goods, and sponsorships and endorsements, which form a major component of the Opposer's brand marketing efforts in the US and abroad.

**Answer:** Applicant is without sufficient information to answer the allegations contained in Paragraph # 7.

8. Upon information and belief, use by the Applicant for goods in Class 14 will cause confusion, mistake and deception with respect to those goods and services, by virtue of the Opposer's prior use and fame of its OMEGA marks.

**Answer:** The allegations contained in Paragraph # 8 is denied.

9. On information and belief, both the Applicant's mark and OMEGA's mark are applied to highly related goods and services are likely to be sold to the same or similar channels of distribution. Applicant's OMEGA mark so resembles Opposer's OMEGA registrations and well known trademark, as used in the United States and not abandoned, as to be likely to cause confusion,, or to cause mistake or to deceive.

**Answer:** The allegations contained in Paragraph # 9 is denied.

10. Applicant has incorporated Opposer's entire word mark, and has also incorporated Opposer's Ω mark and employed it as a prominent feature of Applicant's mark.

**Answer:** While Applicant admits that its mark does include the Greek Letter Ω and the word Omega in its composite mark, it denies the remainder of Opposer's allegation in paragraph # 10.

11. Upon information and belief, Applicant does not use the mark, as shown in the application, on the goods for which it seeks registration.

**Answer:** The allegations contained in Paragraph # 11 is denied.

12. Upon information and believe, Applicant's actions would substantially harm Opposer, by permitting registration in favor of Applicant for a mark which Opposer used on its goods from an earlier date and further.

**Answer:** The allegations contained in Paragraph # 12 is denied.

13. Opposer's OMEGA mark is a famous mark.

**Answer:** Applicant denies the allegation in Paragraph # 13 with respect to the goods Applicant seeks to register its mark.

14. Applicant's mark dilutes or is likely to dilute the distinctive character of the Opposer's mark.

**Answer:** The allegations contained in Paragraph # 14 is denied.

#### **AFFIRMATIVE DEFENSES**

15. Opposer cannot demonstrate that it will be damaged as a result of the registration of Applicant's 1Ω0 OMEGA PSI PHI 1911-2011 ("Centennial") trademark.

16. Opposer will not be harmed by the registration of the Centennial trademark, as there is no likelihood of confusion on the part of the public because (1) the Applicant's mark and Opposer's registered marks are visually and aurally dissimilar and distinct when examined in their totality; (2) the entities make use of different channels of trade in their effort to attract dissimilar classes of customers, particularly because Applicant's class of customers is restricted primarily to Applicant's constituent membership; (3) Applicant's Centennial trademark includes its Omega Psi Phi mark, which has been used a long time in association with Applicant, and in which the Applicant has developed secondary meaning; (5) there are no known instances of actual confusion between products bearing Applicant's OPPF and any offerings to the public originating from Opposer.

17. Applicant's mark is not likely to cause consumer confusion or dilution and is entitled to registration on the Principal Register.

WHEREFORE, Applicant respectfully requests that the Trademark Trial and Appeal Board reject Opposer's arguments and relief prayed for, dismiss this Opposition action with prejudice, and proceed to grant Applicant's mark 1Ω0 OMEGA PSI PHI 1911-2011 full and proper registration on the Principal Register as requested in Application Serial # 77/786,143.

By: \_\_\_/John S. Kendall/\_\_\_\_\_

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