

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: May 31, 2014

Opposition No. 91197504
(Parent Case)
Opposition No. 91197505

Omega SA (Omega AG) (Omega Ltd.)

v.

Alpha Phi Omega

**George C. Pologeorgis,
Interlocutory Attorney:**

These consolidated proceedings now come before the Board for consideration of applicant's combined motion (filed January 10, 2014) to (1) compel responses to certain written discovery, and (2) test the sufficiency of responses to certain requests for admission. Applicant's motion is fully briefed.

The Board carefully considered the arguments raised by the parties in their respective motion papers, as well as the supporting correspondence and the record of this case, in coming to a determination regarding applicant's combined motion. Based on the foregoing, the Board makes the following findings and determinations:

Applicant's Motion to Compel Written Discovery

Initially, the Board finds that applicant has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention, except to the extent indicated below, and that applicant's motion to compel is timely. *See* Trademark Rule 2.120(e)(1).

As to the merits of applicant's motion to compel responses to the interrogatory and document requests at issue, the motion is **GRANTED**, in its entirety, to the extent set forth below:

Interrogatory Requests

Interrogatory Request No. 6

Motion is **GRANTED** to the extent that opposer must (1) identify by name, address, occupation, and telephone number of any person who has knowledge of , or any fact witness who may be call upon to testify regarding, any information that that supports the allegations of Paragraph 9 of the notices of opposition that, upon information and belief, use of the mark OMEGA by applicant for the goods identified in its involved applications will cause confusion, mistake and deception by virtue of opposer's prior use its pleaded marks used in association its goods and services identified in its pleadings (the identification of witnesses for trial is discoverable – *see* TBMP § 414(7) (3d ed. rev. 2 2013)), and (2) state the factual basis(es) which supports its contention that applicant's products bearing the mark sought to be registered

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will cause confusion, mistake and deception by virtue of opposer's prior use of its pleaded marks. Motion is **DENIED** to the extent that it requires opposer to identify or disclose, prior to trial, each document, exhibit or any other evidence it plans to introduce at trial which would support the above contention. *See* TBMP § 414(7) (3d ed. rev. 2 2013)(a party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce at trial). Further, opposer's objections to this interrogatory are overruled. Accordingly, to the extent opposer has withheld any information responsive to the above-identified interrogatory based upon its now overruled objections, opposer must supplement its responses and provide the withheld information in accordance with the above guidelines.

Interrogatory No. 12

Motion is **GRANTED** to the extent that opposer must (1) identify by name, address, occupation, and telephone number of any person who has knowledge of , or any fact witness who may be call upon to testify regarding, any information that that supports the contention that the commercial impression generated by use of applicant's crest on products in the market which those products pass is likely to be recognized as an identification or association with opposer or its products, and (2) state the factual basis(es) which supports its contention that the commercial impression generated by use of applicant's crest on products in the market which those products travel is likely to be recognized as an identification or association with opposer or its

products. Motion is **DENIED** to the extent that the request requires opposer to identify or disclose, prior to trial, each document, exhibit or any other evidence it plans to introduce at trial to support the above contention. Further, opposer's objections to this interrogatory are overruled. Accordingly, to the extent opposer has withheld any information responsive to the above-identified interrogatory based upon its now overruled objections, opposer must supplement its response and provide the withheld information in accordance with the above guidelines.

Further, the Board finds that the information sought by the above interrogatory requests is relevant to the issues in this proceeding. Moreover, to the extent opposer has fully and completely responded to the above two interrogatories pursuant to the guidelines set forth above, then opposer must so state in its response to each interrogatory.

Interrogatory No. 15

The Board notes that allowing service of an interrogatory which requests disclosure of all the information which the denials of each request for admission is based essentially transforms each request for admission into an interrogatory. This is not the purpose requests for admissions were intended to serve, and because Fed. R. Civ. P. 36 imposes no numerical limit on the number of requests for admissions that may be served, condoning such a practice would circumvent the numerical limit of interrogatories permitted in Board proceedings. *See generally, Colony Insurance Co. v. Harold Kuehn,*

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2011 U.S. Dist. LEXIS 06884 (D.C. Nev. September 20, 2011). In view of the foregoing, the motion is **DENIED** in regard to this interrogatory request.

Document Requests

Document Request No. 21

Motion is **GRANTED** to the extent that opposer must produce non-privileged responsive document to the above document request. Furthermore, opposer's objections to the above-identified document requests are overruled. Accordingly, to the extent opposer has not produced responsive documents to the above-identified document request based upon its now overruled objection, opposer must produce such responsive documents. The Board finds that the above document request concerns issues that are relevant to this proceeding.

Applicant's Motion To Test The Sufficiency Of Responses To Admission Requests

Admission Request Nos. 1, 3, 4, 7-12, 14, 16-48

Motion is **GRANTED** to the extent opposer must provide an unqualified admission or denial to each of the above-identified admission requests. To the extent opposer lacks information or knowledge as a reason for failure to provide an unqualified admission or denial to any of the above-identified admission requests, opposer, for each admission request in which that is the case, must affirmatively state that it has made a reasonable inquiry and the information known or readily obtainable by opposer is insufficient to enable opposer to admit or deny the particular admission request. Fed. R. Civ. P.

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36(a). Furthermore, opposer's objections to each of the above-identified admission requests are overruled. Additionally, the Board finds that the above-identified admission requests are relevant to the issues in this proceeding.

Summary

In view of the foregoing, applicant's motion to compel is **GRANTED**, in part, and **DENIED**, in part. Additionally, applicant's motion to test the sufficiency of responses to admission requests is **GRANTED** to the extent noted above.

Opposer is allowed until **thirty (30) days** from the mailing date set forth in the caption of this order to serve upon applicant responses to applicant's **Interrogatory Request Nos. 6 and 12**, to the extent indicated herein. Opposer is also allowed until **thirty (30) days** from the mailing date of this order to produce non-privileged documents responsive to applicant's **Document Request No. 21**, to the extent indicated herein. To the extent opposer has failed to produce non-privileged responsive documents to Document Request No. 21 and/or refused to respond to this request based upon its objections to the request (which have now been overruled by this order, except for objections based upon privilege), opposer is ordered to produce such withheld documents within the same **thirty days** provided above.

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If there are no responsive, non-privileged documents in opposer's possession, custody or control which are responsive to Document Request No. 21, opposer must so state affirmatively in its response to this request. To the extent opposer has already produced documents responsive to Document Request No. 21, opposer must so state in its response to this particular document request and identify, by bates number, the documents which are responsive to the request.

Additionally, opposer is required to provide applicant a privilege log within the same **thirty (30) days** provided above to the extent that opposer claims privilege to any of applicant's discovery requests, if it has not already done so.

Opposer is also allowed **thirty (30) days** from the mailing date of this order in which to provide responses to applicant's Admission Request Nos. **1, 3, 4, 7-12, 14, and 16-48**, pursuant to the guidelines set forth above.

In the event opposer fails to provide applicant with full and complete responses to the outstanding discovery, as required by this order, opposer will be barred from relying upon or later producing documents or facts at trial withheld from such discovery. *See* Fed. R. Civ. P. 37(c)(1).¹

¹ If opposer fails to comply with this order, applicant's remedy lies in a motion for sanctions, pursuant to Trademark Rule 2.120(g)(1). Furthermore, the parties are reminded that a party that has responded to a discovery request has a duty to supplement or correct that response. *See* Fed. R. Civ. P. 26(e).

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Trial Schedule

These consolidated proceedings are hereby resumed. Discovery is **closed**.

Remaining trial dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	7/15/2014
Plaintiff's 30-day Trial Period Ends	8/29/2014
Defendant's Pretrial Disclosures Due	9/13/2014
Defendant's 30-day Trial Period Ends	10/28/2014
Plaintiff's Rebuttal Disclosures Due	11/12/2014
Plaintiff's 15-day Rebuttal Period Ends	12/12/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademarks Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.