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

Proceeding	91197504
Party	Defendant Alpha Phi Omega
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**OMEGA, S.A.,**

**OPPOSER,**

v.

**ALPHA PHI OMEGA,**

**APPLICANT.**

**Opposition Nos.  
91197504 (Parent) &  
91197505 (Child)**

**Serial Nos.  
77950436 & 77905236**

**RESPONSE TO OPPOSER’S MOTION FOR RECONSIDERATION OF ORDER  
COMPELLING DISCOVERY**

Through this motion, Omega continues to stubbornly avoid its discovery obligations. The time has come for Opposer, the Omega Watch Company to either “put up, or shut up.”

The Applicant here, Alpha Phi Omega is an 89 year old fraternity. It provides its members with a wide array of affinity products including jewelry and clothing bearing its name for the members to display to proudly proclaim their membership in the fraternity. The parties have coexisted for 89 years without a single known instance of confusion. Nonetheless now, after all these years, Omega Watch contends the Alpha Phi Omega affinity merchandise infringes and dilutes Opposer’s marks.

The likely insurmountable obstacle Omega faces to prove infringement and dilution is the fact that will not go away, no matter how much Omega tries to ignore it: dozens of Greek letter fraternities and sororities have the Greek letter “Omega” in their name including (1) Alpha Tau **Omega**, (2) Alpha Chi **Omega**, (3) Chi **Omega**, (4) Alpha Gamma **Omega**, (5) **Omega** Chi, (6) Sigma Phi **Omega**, (7) Kappa **Omega** Tau, (8) Gamma Epsilon **Omega**, (9) Beta **Omega** Phi, (10) Sigma Phi **Omega**, (11) Alpha **Omega** Epsilon, (12) **Omega** Delta Phi, (13) Alpha Nu **Omega**, (14) Lambda Tau **Omega**, (15) **Omega** Chi, (16) **Omega** Phi Beta, (17) Gamma Phi

**Omega**, (18) Sigma **Omega** Epsilon, (19) Alpha Pi **Omega**, (20) **Omega** Phi Gamma, (21) Sigma **Omega** Nu, (22) Alpha Sigma **Omega**, (23) Delta Phi **Omega**, (24) Delta Pi **Omega**, (25) **Omega** Chi Psi, (26) Sigma Kappa **Omega**, (27) Sigma **Omega** Phi, and (28) Alpha **Omega** Sigma.

Indeed, indications are that after all these years of coexistence with dozens of fraternities and sororities with “Omega” in their name, Opposer has now decided to bully any collegiate fraternity or sorority with the word, Omega in its name; it has similar proceedings pending in the TTAB against the Lambda Tau Omega Sorority (Proceeding No. 91208652), the Omega Psi Phi Fraternity (Proceeding No. 91197082), and the Alpha Omega Epsilon Fraternity (Consolidated Proceeding Nos. 91214449 (Parent), 91214452, 91214453, and 91214454); it has unsuccessfully sought an extension to oppose a filing of the Psi Sigma Omega Service Fraternity (Serial No. 78739642); and it has successfully bullied Omega Delta Phi into abandoning the application to register its name (Proceeding No. 91186613).

In light of 89 years coexistence here without a known instance of confusion, and the irrefutable fact there are dozens of other fraternities and sororities with “Omega” in their name, the paradoxical bind Omega finds itself in is practical difficulty – if not impossibility – of proving its claim that Alpha Phi Omega, clearly a fraternity name, infringes the watch companies marks, marks which are most commonly used with high end timepieces costing thousands of dollars. The possibility of proving Omega’s claim of fame for dilution purposes is just as inconceivable.

The lack of any viability to the Omega Watch claims is especially complicated by the fact that at least three major national fraternities and sororities, Alpha Tau Omega, Alpha Chi Omega and Chi Omega, have been in operation since the 1800s, since prior to the entrée of the Omega

Watch brand into the United States. This is what Omega tries to obfuscate with the pending motion. Omega attempts to obscure the irrefutable fact that Greek letter fraternities and sororities with “Omega” in their name precede Opposer’s adoption of its marks.

The simple requests for admission Omega *is ordered* to answer merely ask it to admit it can not dispute that various fraternities or sororities with Omega in their name have existed in the United States continuously since prior to Opposer’s introduction of the Omega brand in the United States (Request for Admission No. 3); to admit it can not dispute that various fraternities or sororities have used the Greek letter, Ω, as part of the Greek letter version of their names continuously since prior to Opposer’s introduction of the Omega brand in the United States (Request for Admission No. 4); and to admit it can not dispute that various fraternities or sororities with Omega in their name have marketed, and/or approved others to market merchandise bearing the respective fraternity or sorority name continuously since prior to Opposer’s introduction of the Omega brand in the United States (Request for Admission No. 14).

Rather than admit the irrefutable, Opposer obfuscates. There is nothing tricky, ambiguous, or to use Opposer’s word, “problematic,” about these requests. From the outset in this litigation it has been pointed out to Opposer’s counsel that Alpha Tau Omega, Alpha Chi Omega, and Chi Omega each appear to have been operation since prior to the entrée of the Omega Watch brand into the United States. If Opposer had any bases for contending that none of these fraternities and sororities have been continuously in existence since prior to the Omega Watch entree, it could easily have denied request nos. 3 and 4 and produced the evidentiary basis supporting such a denial. If Opposer had any bases for contending that none of these fraternities and sororities have produced and/or licensed affinity merchandise bearing their names continuously since prior to the Omega Watch entree, it could easily have denied request no. 14.

Rather than respond to the requests as ordered, Opposer offers convoluted conjecture about the “problematic” wording of these requests. For instance, Opposer complains that the requests as worded relate to “Greek letter *social, professional, or honorary* fraternities or sororities” (emphasis added). For some unarticulated reason, Opposer asserts the “social, professional, or honorary” adjectives somehow complicate Opposer’s ability to respond to these requests. Counsel discussed this telephonically on July 9 and the undersigned advised opposing counsel the inclusion of these adjectives was intended to clarify the requests were not limited to “social” fraternities or sororities, “professional” fraternities or sororities, or “honorary” fraternities or sororities. Opposing counsel was further advised that we are willing to clarify the requests to delete the language they claim is “problematic,” an offer Opposer rejects. Regardless, there is nothing “problematic” about this language. If Opposer had any bases for contending that none of these fraternities and sororities, namely Alpha Tau Omega, Alpha Chi Omega, and Chi Omega have been continuously in existence since prior to the Omega Watch entree, it could easily have denied request nos. 3 and 4 and produced the evidentiary basis supporting such denials. If Opposer had any bases for contending that none of these fraternities and sororities have produced and/or licensed affinity merchandise bearing their names continuously since prior to the Omega Watch entree, it could easily have denied request no. 14.

Omega further argues about the “problematic” nature of the requests citing concern about whether the older fraternities and sororities with “Omega’ in their name used their respective names “with other elements, other terms or designs.” See Motion at p.4. Frankly, this concern is incomprehensible to us. What difference does it make whether Alpha Tau Omega, Alpha Chi Omega, or Chi Omega from time to time may have made any use of their names in conjunction with assorted graphic designs, “elements, other terms or designs”? Plainly and simply, all the

requests relate to is whether some fraternities with “Omega” or the Greek alphabet letter, Ω, in their names have continuously used those **names** since prior to the Omega Watch entrée into the United States. Whether the names from time to time may have been used with assorted graphic designs does nothing to complicate the straight-forward request for admissions.

The only thing “problematic” about these requests is Omega’s refusal to acknowledge that fraternities and sororities with “Omega” in their names have continuously been in existence in the United States since prior to the Omega Watch entrée into the United States.

That is the problem – the paradoxical fix – in which Omega Watch finds itself. It wants to contend its marks are famous and diluted by the Alpha Phi Omega Fraternity which has continuously been in existence since 1925. When Omega Watch is called upon to acknowledge facts which go to the question of whether the Omega term has enjoyed the exclusivity of use requisite to proving the fame necessary to support a dilution claim, it cannot ignore the fact that dozens of fraternities have the “Omega” word in their name including at least three major national fraternities and sororities, Alpha Tau Omega, Alpha Chi Omega, and Chi Omega which have been in operation since the 1800s, since prior to the adoption of various of the marks upon which the Opposition is based.

The time has come for Opposer, the Omega Watch Company to either “put up, or shut up.” From the outset in this litigation it has been pointed out to Opposer’s counsel that Alpha Tau Omega, Alpha Chi Omega, and Chi Omega appear to have been in operation since prior to the entrée of the Omega Watch brand into the United States. If Opposer had any bases for contending that none of these fraternities and sororities have continuously been in existence since prior to the Omega Watch entree, it could easily have denied request nos. 3 and 4 and produced the evidentiary basis supporting the denial of either of the requests. If Opposer had any

bases for contending that none of these fraternities and sororities have produced and/or licensed affinity merchandise bearing their names continuously since prior to the Omega Watch entree, it could easily have denied request no. 14 and produced the evidentiary basis supporting such a denial.

### **CONCLUSION**

The Board has compelled Opposer to respond to request for admissions nos. 3, 4, and 14. That order need not be reconsidered.

Respectfully requested,

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**CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION**

I hereby certify that a true copy of this RESPONSE TO OPPOSER'S MOTION FOR RECONSIDERATION OF ORDER COMPELLING DISCOVERY is being filed electronically with the U.S. Patent and Trademark Office using the ESTTA service, and a copy has been served on counsel for Opposer by mailing a copy hereof this 21st day of July, 2014, via First Class Mail, postage prepaid, to:

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