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

Proceeding	91197504
Party	Plaintiff Omega SA (Omega AG) (Omega Ltd.)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),  
Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: ALPHA PHI OMEGA and design  
Opp. No.: 91197504 (Parent)  
Serial No.: 77950436

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),  
Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: AΦΩ  
Opp. No.: 91197505 (Child)  
Serial No.: 77905236

**OPPOSER'S MOTION:**

**(1) FOR THE BOARD'S CONSIDERATION OF MOTIONS TO PRECLUDE AND COMPEL PRIOR TO CONSIDERING SUMMARY JUDGMENT MOTION; AND**

**(2) TO SUSPEND TIME FOR OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT; OR IN THE ALTERNATIVE,**

**(3) MOTION UNDER RULE 56(D) TO TAKE DISCOVERY**

Opposer hereby requests that (1) the Board consider and decide its Motion to Preclude and Compel, filed on July 29, 2014, prior to deciding Applicant's Motion for Summary Judgment filed on the same day, and (2) extend Opposer's time to oppose Applicant's Motion for Summary Judgment until Opposer's motion to Preclude and Compel is decided. In the alternative, Opposer seeks an order permitting it to take the depositions of Wampler, Smiley,

Shaver and Miraglia (referred to collectively as the “Declarants”) relating to their declarations and corresponding exhibits filed in support of Applicant’s Motion for Summary Judgment.

**I. Introduction**

Opposer requests that the Board decide its Motion to Preclude and Compel prior to deciding Applicant’s Motion for Summary Judgment. In addition to the reasons already set forth in Opposer’s Motion to Preclude and Compel itself, a decision on that motion may resolve evidentiary issues and Opposer’s need for additional discovery before responding substantively to Applicant’s Motion for Summary Judgment. Opposer further requests that the Board extend Opposer’s time to oppose Applicant’s Motion for Summary Judgment until Opposer’s motion to Preclude and Compel is decided. In the alternative, should the Board decide to hear Applicant’s Motion for Summary Judgment first (or deny Opposer’s Motion to Preclude and Compel), Opposer requests additional discovery pursuant to Fed. R. Civ. P 56(d). Specifically, Opposer seeks an order permitting it to take the depositions of Wampler, Smiley, Shaver and Miraglia.

**II. Factual Background**

On July 29, 2014, Opposer filed its Motion to Preclude Unjustifiably Delayed Discovery Production and to Compel Discovery (hereinafter “Motion to Preclude and Compel”). D.E. 59. This motion was necessitated because on July 25, 2014 - the eve of Opposer’s testimony period and over fourteen months after Applicant’s initial service of discovery responses - Applicant served, for the first time, discovery production that approximately doubled the documents previously produced. The 134-page document production included declarations from three individuals reportedly associated with third parties Alpha Tau Omega, Alpha Chi Omega and Chi Omega, as well as a declaration from Applicant’s licensee, Affinity Marketing Consultants. It also included exhibits relating to third parties Alpha Tau Omega, Alpha Chi Omega, and Chi

Omega products, printouts from third party websites, and copies of third party U.S. Trademark Registrations. The prejudice caused by Applicant's delay was entirely avoidable as these materials were available to Applicant well before production. Furthermore, Applicant had caused Opposer to rely upon its previous representations to Opposer, on multiple occasions, that it was not withholding any information or documents. D.E. 59, p. 2-3, 4, 7 and Declaration of Oren Gelber in Support of Motion to Compel at ¶ 20; Declaration of Oren Gelber in Support of Rule 56(d) Motion at ¶ 4.

In response to Applicant's actions, Opposer filed its Motion to Preclude and Compel, seeking an order : (1) precluding Applicant's July 25, 2014 document production as prejudicial to Opposer; (2)(a) precluding Applicant from introducing responsive information and documents currently in existence but not produced by Applicant in response to Opposer's discovery requests, including those seeking information related to witnesses, evidence of first use and documents relevant to these proceedings; and (2)(b) in the alternative, compelling Applicant to fully respond to all document production requests by providing all responsive documents and including a statement that all documents have been produced or there are no responsive documents, as appropriate. D.E. 59.

On July 29, 2014 – just four days after providing Opposer with the dilatory discovery production and on the same day Opposer filed its Motion to Preclude and Compel - Applicant filed a Motion for Summary Judgment. D.E. 58. Applicant's Motion for Summary Judgment relies upon the document production it had provided to Opposer just a few days earlier. Such actions on the part of Applicant are clearly prejudicial to Opposer. Applicant has unilaterally delayed discussion of how information of which it sought to rely such as the identity of the specific declarants (with the exception of Shaver), the scope or content of their testimony, or the

exhibits to the testimony. Because Applicant waited until long after the close of discovery to provide such evidence, Opposer is being asked to defend against a record which was largely hidden from it. The Opposer was left without the opportunity to obtain discovery regarding these individuals and the contents of their declarations, and accordingly, Opposer properly moved for their exclusion.

On July 30, 2014, upon receipt and review of Applicant's Motion for Summary Judgment, Opposer filed a Supplement to its Motion to Preclude and Compel, addressing how Applicant's Motion for Summary Judgment represented exactly the type of prejudicial action that Opposer sought to prevent with its Motion to Preclude and Compel. D.E. 60. Opposer further reiterated its request that Applicant's July 25, 2014 document production be excluded from this proceeding.

**III. Opposer's Motion to Preclude and Compel Should be Decided Before Opposer's Motion for Summary Judgment**

Opposer's Motion to Preclude and Compel seeks, inter alia, an order precluding Applicant's July 25, 2014 document production as prejudicial to Opposer. More specifically, the July 25, 2014 document production refers to the declarations of Wampler, Smiley, Shaver and Miraglia (referred to collectively as the "Declarants") and the exhibits thereto.

As explained in greater detail in Opposer's Motion to Preclude and Compel, this dilatory document production was produced over fourteen months after Applicant's initial service of discovery, more than seven months after the conclusion of discovery, and after multiple meet and confer conferences during which Applicant assured Opposer that all information and document were provided and there were no withheld materials. Then, just four days later, Applicant filed its Motion for Summary Judgment in what can only be explained as an effort to preclude

Opposer from filing a Motion to Preclude or Compel based upon this unjustifiably delayed production.

Applicant's disregard for the Rules and their purpose is on full display in the form of its Motion for Summary Judgment, which also fails to follow the governing rules which require it to properly label its evidence and exhibits. The Rules contemplate the refusal of improperly marked exhibits. See e.g. 37 C.F.R. § 2.126(a)(5). This section of the code requires exhibits to be identified as prescribed in § 2.123(g)(2) ("Exhibits must be numbered or lettered consecutive and each must be marked with...the name of the party offering the exhibit.") While these rules are applicable to paper submissions, the same rule should apply to all submissions to avoid confusion and a search through a morass of documents which are haphazardly appended to a motion. Applicant failed to number or mark the exhibits. See D.E. 58. Further, the exhibits are labeled in a number of different conventions. See D.E. 58 at 8 (referring to exhibits as Defendant's Exhibit 2, Misc 010-016, and Applicant's response to Opposers' First Set of Interrogatories). Some of the exhibits are labeled in a misleading way as "Plaintiff's exhibits" when being offered by Defendants. See D.E. 58 at page 9 (Referring to Plaintiff's Exhibits 12, 13, 17 & 21). Applicant's disorganized submission fails to comply with the rules and will cause Opposer and the Board to search through an entire record of exhibits and attempt to identify and find the location of each document. Applicant's failure to follow the rules and provide an organized set of exhibits to its Motion for Summary Judgment allows the Board to refuse entry and consideration. See 37 C.F.R. § 2.126(a)(5).

If the Board decides Opposer's Motion to Preclude and Compel before taking up summary judgment and precludes the declarations and exhibits thereto, the need for Opposer's 56(d) motion will be mooted. Thus, it is in the interest of efficiency and judicial economy that

Opposer seeks the Board's consideration of its Motion to Preclude and Compel before Opposer's Motion for Summary Judgment.

#### **IV. Opposer's Request for Additional Discovery Pursuant to Fed. R. Civ. P. 56(d)**

Opposer urges the only efficient means for addressing the co-pending motions is to strike the untimely documents and testimony which is reliant upon it. Should the Board decline to strike such evidence and instead decide that Opposer may take discovery, the result undoubtedly will be to further multiply motion practice. Should the Board resolve this motion by granting Opposer leave to depose the Declarants, it is the inevitable result that Applicant will then seek to elicit testimony and attempt to cure its foundation defects and other evidentiary deficiencies. Opposer will strongly object to any efforts by Applicant to introduce cross-examination as additional evidence to support its motion for summary judgment. These potential conflicts can be best and most efficiently addressed by ruling upon and rejecting this dilatory information.

In the event the Board should decide not to hear Opposer's Motion to Preclude and Compel first, Opposer seeks further discovery under 37 C.F.R. § 2.127(e)(1) and F.R.C.P. 56(d).<sup>1</sup>

Opposer does not seek to address the substance of Applicant's motion for summary judgment, but reserves the right to its arguments on summary judgment following a ruling on this motion. Similarly, Opposer reserves the right to assert and objections – procedural or substantive – to Applicant's evidence.

The Board generally requires a description of the discovery movant intends to seek and an explanation on how the discovery may preclude summary judgment with an affidavit in

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<sup>1</sup> The Trademark Rule pursuant to which Opposer seeks discovery, Rule 2.127e)(1), refers to Fed. R. Civ. P. 56(f) rather than Fed. R. Civ. P. 56(d). The 2010 amendments to the Federal Rules of Civil Procedure moved the contents of what had been subdivision (f) into subdivision (d). Therefore, "the reference to Fed. R. Civ. P. 56(f) in 37 C.F.R. § 2.127(e)(1) is to be read as a reference to present Fed. R. Civ. P. 56(d)." TMBP § 528.06. See *McDonald's Corp. v. Cambridge Overseas Development Inc.*, 2013 TTAB LEXIS 75, \*2 n.3 (TTAB Mar. 22, 2013).

support thereof. *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

A. Opposer Seeks to Depose Third Party Declarants

Opposer seeks an order permitting it to take the depositions of Wampler, Smiley, Shaver and Miraglia relating to their declarations and corresponding exhibits filed in support of Applicant's Motion for Summary Judgment.

The declarations of the Declarants and exhibits thereto relied on by Applicant in its Motion for Summary Judgment pertain to the following factual inquiries:

- Channels of Trade (D.E. 58 at page at 9) (Declarations of Wampler, Miraglia and Smiley at ¶7 and Shaver at ¶ 11-12).
- Target Market (D.E. 58 at page 9) (Declarations of Wampler, Miraglia, and Smiley at ¶ 6).
- Third Party Uses of Marks and the goods that such Marks are applied to (D.E. 58 at page 9.) (Declarations of Wampler, Smiley, and Miraglia at ¶4 and Shaver at ¶ 7, 10).
- Third Party Dates of First Use (D.E. 58 at pages 7 and 17) (Declaration of Smiley and Wampler at ¶ 8).
- Sophistication of Consumers and Conditions of Use (D.E. 58 at page 8) (Declarations of Wampler, Smiley and Miraglia at ¶ 8 and Shaver at ¶5-7, and 9).

Such information directly correlates to the following *DuPont* likelihood of confusion factors:

- Factor 3 - The similarity or dissimilarity of established, likely-to-continue trade

channels,

- Factor 4 - The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing
- Factor 6 - The number and nature of similar marks in use on similar goods.

See D.E. 58 at page 11. Third party use, to the extent it may exist, is pertinent to dilution and the “substantially exclusive use of the mark.” *Id.* at 17 (citing 15 U.S.C. § 1125(c)(2)(B)(iii)) and potentially the strength of the mark for the likelihood of confusion claim.

B. Information Obtained From Additional Discovery May Preclude Summary Judgment

Even though Opposer is confident that the declarations and their exhibits should be entitled to no weight based on the Opposer’s Motion to Preclude, and the fact that they lack foundation and other substantive evidence rules (such as hearsay), If the Board declines to preclude the declarations and exhibits, Opposer should be able to depose the Declarants as to the substance of their declarations and exhibits.

Depositions of the Declarants may uncover facts that will preclude summary judgment by raising a triable issue of fact, or discount the weight or admissibility of the evidence presented by Applicant or its Declarants. First and foremost, the Declarants’ declarations do not provide a foundation to establish the qualifications of the declarants to make the statements contained therein. There is nothing in the declarations regarding how the declarants are knowledgeable about the statements they made or why they have such knowledge. Similarly, there is no foundation for any of the declarants as to their knowledge regarding the exhibits provided in association with their declarations.

Though Opposer believes the declarations and exhibits must be excluded (see *infra*), it is entitled to discovery if such declarations and exhibits are not excluded. For example, in the

Smiley declaration, there is nothing to indicate whether Smiley has personal knowledge of the material to which he testified. As another example, there is nothing to qualify Shaver to declare that *prior* to his involvement in fraternity and sorority merchandising, a niche market for Greek letter organizations existed. See Shaver Decl. at ¶11. The broad and unsubstantiated statements made by the declarants should be subject to cross-examination in the form of depositions of these witnesses to determine whether they are qualified to make such statements in the first place. See *Ikossi v. Dep't of Navy*, 516 F.3d 1037, 1046 (D.C. Cir. 2008)

Second, Applicant relies upon the Smiley and Wampler declarations to claim that third parties have used Omega (either Greek letter or word marks) as early as 1865. See D.E. 58 at page 17. Opposer is entitled to know how the declarants could know this information. Opposer therefore has the right to cross-examine declarants as to the basis for such statements and why they believe this information to be true. Furthermore, Opposer should be permitted to cross-examine the declarants to determine whether the alleged use is continuous, the geographic scope of such use, the form of the marks as they were used, and/or the goods used in association with the marks. Such additional information can only be learned through a deposition of these witnesses (assuming they are qualified to testify to such facts and have knowledge of such matters).

Third, to the extent Applicant relies on the Declarants to establish the Applicant's trade channels, Opposer is entitled to cross-examine. For example, Shaver claims that the fraternity and sorority products are sold to members or as gifts for members. Declarations of Smiley, Miraglia, and Wampler at ¶6.

Finally, Applicant relies on the declarations to broadly describe a "typical" consumer and condition of sale. Again, Opposer is entitled, thought cross-examination to question the basis for

what the declarant believes makes a sale or use “typical” or whether the members of Greek letter organizations are sophisticated when purchasing items.

**V. Conclusion**

For the sake of judicial efficiency, Opposer’s Motion to Preclude and Compel should be taken up by the Board prior to any consideration of Applicant’s Motion for Summary Judgment. A resolution of Opposer’s Motion to Preclude and Compel could eliminate Opposer’s need for additional discovery pursuant to Fed. R. Civ. P 56(d) and otherwise resolve possible evidentiary issues. Accordingly, Opposer requests that the Board extend its time to oppose Applicant’s Motion for Summary Judgment until after its Motion to Preclude and Compel is decided. In the alternative, Opposer requests an order permitting it to take the depositions of Wampler, Smiley, Shaver and Miraglia relating to their declarations and corresponding exhibits filed in support of Applicant’s Motion for Summary Judgment. While Opposer believes all of the declarations and other supporting documents must be precluded, Opposer – in the alternative – would otherwise be entitled to take discovery.

Respectfully Submitted,

By: Thomas Gulick

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JMCTPG/OG/KAM:  
Encl. – Declaration of Oren Gelber

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED THROUGH THE ELECTRONIC SYSTEM FOR TRADEMARK TRIAL AND APPEALS IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

COLLEN *IP*

By: \_\_\_\_\_

Peter Mulhern

Date: September 2, 2014

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

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),

Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: ALPHA PHI OMEGA and design  
Opp. No.: 91197504 (Parent)  
Serial No.: 77950436

OMEGA S.A. (OMEGA AG)  
(OMEGA LTD),

Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

Mark: AΦΩ  
Opp. No.: 91197505 (Child)  
Serial No.: 77905236

**DECLARATION OF OREN GELBER  
IN SUPPORT OF OPPOSER'S RULE 56(D) MOTION**

I, Oren Gelber, declare and state, under penalty of perjury, as follows:

1. I am an attorney at Collen IP, attorneys for Omega S.A. (Omega AG) (Omega Ltd.), (“Opposer”) in the above referenced action. The facts set forth in this declaration are personally known to me and I have first hand knowledge thereof. If called as a witness, I could and would competently testify to all the following facts that are within my personal knowledge.

2. On July 29, 2014, Opposer filed a Motion to Preclude Unjustifiably Delayed Discovery Production and Motion to Compel.

3. Prior to filing its Motion to Compel on July 29, 2014, Opposer's counsel and Applicant's counsel held three meet and confer conferences to discuss outstanding discovery issues. These meet and confer conferences were held on July 12, 2013, October 16, 2013, and July 9, 2014.

4. At each of these conferences, Opposer sought assurances from Applicant's counsel that no documents or information were being withheld. Applicant's counsel repeatedly attested to the fact that it was not withholding any documents and information and that what it had produced was what it had. D.E. 59, p. 2-3, 4, 7 and Declaration of Oren Gelber in Support of Motion to Compel at ¶ 20. However, Applicant's counsel repeatedly resisted making such statements in writing. *Id.*

5. It was thus necessary for Opposer to file a Motion to Preclude Unjustifiably Delayed Discovery and Motion to Compel on July 29, 2014, in order to obtain an Order to avoid undue prejudice and surprise to Opposer.

6. On July 29, 2014, Applicant filed a Motion for Summary Judgment.

7. Applicant's Motion seeks judgment on Opposer's claim of a likelihood of confusion and dilution.

8. Applicant's Motion contains statements with respect to Applicant's channels of trade.

9. Applicant's Motion contains statements with respect to the sophistication of Applicant's customers.

10. Applicant's Motion contains statements with respect to third party use of marks containing  $\Omega$  and/or OMEGA.

11. Applicant's Motion contains statements with the conditions of Applicant's sales.

12. Applicant's Motion contains statements with respect to the target market of Applicant's goods.

13. Applicant's authorized licensee, Daniel Shaver, makes statements in his declaration and provides exhibits relating to the trade channels, conditions of sales, licensing, target market and sophistication of the consumers of fraternities and sororities that use an Omega symbol.

14. Applicant's declarant, Carol Miraglia, makes statements in her declaration and provides exhibits relating to third party use of  $\Omega$  and/or OMEGA, conditions of sales for fraternities and sororities, licensing, types of goods sold by fraternities and sororities, target markets and trade channels.

15. Applicant's declarant, Janine Wampler, makes statements in her declaration and provides exhibits relating to third party use of  $\Omega$  and/or OMEGA, conditions of sales for fraternities, licensing, types of goods sold by fraternities, target markets and trade channels.

16. Applicant's declarant, Wynn Smiley, makes statements in his declaration and provides exhibits relating to third party use of  $\Omega$  and/or OMEGA, conditions of sales for fraternities and sororities, licensing, types of goods sold by fraternities and sororities, target markets and trade channels.

17. The mere fact that Applicant relies on statements relating to material within the declarations (such as use of the OMEGA or  $\Omega$  mark by third parties, consumers, sales, channels of trade, and conditions of sales) in its Motion indicates that the facts are essential and that

Opposer is entitled to discovery as outlined in the accompanying Rule 56(d) Motion. Specifically, Applicant claims the dispositive factors include the dissimilarity of trade channels, sophistication of consumers, and the number and nature of similar marks in use on similar goods. See D.E. 58 at page 11. Applicant further claims that third party use is an important element in the dilution claim. See D.E. 58 at page 17.

18. Opposer requires discovery, to know if there are genuine issues of material fact with respect to Applicant's statements and the statements of Wampler, Smiley, Shaver, and Miraglia about third party use, consumers, sales conditions, and channels of trade. If Applicant were to have timely produced these materials during discovery, Opposer may have had the proper information to be able to oppose Applicant's Motion for Summary Judgment.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed September 2, 2014 at Ossining, New York.



Oren Gelber  
Oren Gelber

**CERTIFICATE OF SERVICE**

I, Peter Mulhern, hereby certifies that a copy of the OPPOSER'S MOTION:

- (1) FOR THE BOARD'S CONSIDERATION OF MOTIONS TO PRECLUDE AND COMPEL PRIOR TO CONSIDERING SUMMARY JUDGMENT MOTION; AND
- (2) TO SUSPEND TIME FOR OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT; OR IN THE ALTERNATIVE,
- (3) MOTION UNDER RULE 56(D) TO TAKE DISCOVERY

was served by First Class U.S. Mail, postage prepaid on this 2<sup>nd</sup> Day of September, 2014

upon

Jack A. Wheat  
Stites & Harbison PLLC  
400 W Market St Ste 1800  
Louisville, KY 40202-3352



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Peter Mulhern