

ESTTA Tracking number: **ESTTA625863**

Filing date: **09/08/2014**

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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Attachments	K655_Opposers Reply in Support of Motion to Preclude_140908.pdf(931531 bytes)

**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 REPLY IN SUPPORT OF MOTION TO PRECLUDE UNJUSTIFIABLY
DELAYED DISCOVERY PRODUCTION AND TO COMPEL DISCOVERY**

I. INTRODUCTION

Opposer notes that its Motion to Preclude Unjustifiably Delayed Discovery Production and to Compel Discovery (D.E. 59) and Applicant's Motion for Summary Judgment (D.E. 58) were both filed on the same day—July 29, 2014. Opposer previously requested and hereby reiterates its request that the Board consider and decide its Motion to Preclude/Compel (D.E. 59) first, before reaching Applicant's Motion for Summary Judgment (D.E. 58). *See* D.E. 63. With the submission of this Reply Brief, the Motion to Compel is fully briefed and ready for Board determination. The Board's decision on Opposer's Motion to Preclude/Compel (D.E. 59) would

resolve evidentiary issues raised by Applicant's Motion for Summary Judgment (D.E. 58) and would further address Opposer's need for additional discovery, if the evidence is not precluded, as requested in Opposer's recently filed Motion to Decide the Motion to Preclude First and, in the Alternative, Motion for Additional Discovery Under Rule 56(d) Suspend. *See* D.E. 63.

Applicant attempts desperately to distract the Board from its conduct and litigation tactics. Applicant's counsel appears to have previously attempted this same tactic to no avail in *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396 (N.D. Tex. 2011). Applicant's dilatory production should be excluded, just as it was in the *Abraham* case.

Applicant's discovery abuse is not limited to surprise production on the eve of testimony. Applicant has continually evaded calls to supplement or submit statements in writing that no further documents exist. Despite multiple requests by Opposer's counsel, Applicant's counsel continually represented that Applicant was not withholding documents. Yet, on the eve of the Opposer's testimony period, Applicant nearly doubled its previous production. Only after making this last minute production did Applicant submit a statement in writing, in its Opposition to the Motion to Compel, that it has no further documents with regard to two of the discovery requests Opposer seeks to compel. As to the remaining requests, Applicant still refuses to provide any definitive statements. Such actions are not in compliance with Applicant's discovery obligations and as a result, any responsive information and documents currently in existence but not produced by Applicant in response to these Requests should not be admitted into evidence at trial. Alternatively, Applicant should be compelled to provide supplemental responses and/or document production in response to Opposer's Requests for Production of Documents and Things and/or submit a statement that no (further) responsive documents are available (as applicable).

II. ARGUMENT

A. Applicant's counsel is aware of the consequences of Attempting to Circumvent Discovery Rules Using Late Production

As noted in Opposer's Motion to Compel, Applicant's counsel represents various Greek organizations, including the Applicant, Alpha Chi Omega, Alpha Tau Omega and Chi Omega. See D.E. 59 pp. 7-8 and Gelber Decl. thereto at ¶ 22 and 23 and Exhibit 7.

Applicant's counsel in these proceedings was among the attorneys defending a group of Greek organizations in *Abraham v. Alpha Chi Omega* before the Northern District of Texas. In that case, defendants' counsel attempted to submit third party sworn statements in support of their Motion for Summary Judgment. *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396, 425 (N.D. Tex. 2011). The plaintiff in the case objected to the Greek organizations' submission of these sworn statements "due to the untimeliness of their disclosure and [plaintiff's] inability to cross-examine those who made the statements." *Id.* The plaintiff also noted that due to the untimeliness of the disclosure, it would not be able to cross-examine the declarants given a shortage of available time. *Id.* The Court granted the plaintiff's request and refused to consider defendants' untimely declarations noting the potential prejudice to the plaintiff. *Id.* at 426

Applicant should not be permitted to withhold responsive documents and information and then surprise its adversary at the very last minute. To allow Applicant to undertake such a practice would condone gamesmanship and render the Federal and Trademark Rules related to discovery completely useless. Applicant's July 25, 2014 production should be excluded.

B. Applicant Withheld Discovery and Production in Violation of the Federal and Trademark Rules.

Applicant knew of information and documents to be produced but withheld production of

such evidence, despite its alleged availability in 2010 and 2011, as Applicant itself notes (D.E. 62 at pp. 4-7), until the eve of the opening of Opposer's testimony period, in violation of the Federal and Trademark Rules.

On July 25, 2014 - over fourteen months after Applicant's initial responses and production 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 documents were provided and there were no withheld materials - Applicant's counsel served document production that approximately doubled the documents previously produced. The documents produced were not ones that were newly discovered, as Applicant itself concedes in its opposition brief. D.E. 62 at pp. 4-7.

The late produced materials are responsive to Opposer's discovery requests and have been responsive since the beginning of discovery in these proceedings. D.E. 59 at pp. 11-15 and Exhibit 1. It is clear from the record and from Applicant's opposition brief that it had no reasonable or good faith basis for withholding these documents until the very last possible minute. Applicant's withholding of relevant, responsive documents and information in violation of disclosure and discovery rules was clearly intended to cause prejudice, undue delay and unfair surprise. *See* TBMP §§ 408.01(a) and (b); Fed. R. Civ. P. 26(g) and TMBP § 408.01(c).

Opposer's discovery requests specifically sought the information that Applicant produced on the eve of Opposer's testimony period. For example, Opposer's Request Nos. 35, 36, and 42. See D.E. 59 pp. 11-15

Applicant's counsel signed discovery responses pursuant to TBMP § 408.01(c) and Fed. R. Civ. P. 26(g) certifying that he "has made a reasonable effort to assure that all available information and documents responsive to the discovery demand have been provided." The July

25, 2014 production establishes that Applicant's counsel's certification was false. As noted previously, the documents produced were known and available to Applicant and its counsel prior to the commencement of discovery in these proceedings. However, this document and information was not among the discovery response and production provided to Opposer despite the fact that such information and documents were clearly relevant and response to Opposer's discovery requests.

Applicant claims that it has previously disclosed the totality July 25, 2014 production in writing, but the declarations were never previously produced to Opposer. Furthermore, some of the documents are new and others provided by Applicant in 2010 and 2011 are not identical to the ones produced on July 25, 2014, which include new materials. While it is true that supplementation is not required for information otherwise made known to the propounding party during the discovery process, the Trademark Rules clearly state that "[t]his is not an invitation, however, to hold back material items and disclose them at the last minute." TBMP § 408.03; see also *Galaxy Metal Gear, Inc. v. Direct Access Tech., Inc.*, 2009 TTAB LEXIS 529, *7, 91 USPQ2d 1859, 1861 (TTAB 2009) *citing* Wright, Miller & Marcus, 8 Fed. Prac. & Pro. Civ. 2d § 2049.1 (2009).

Applicant knowingly withheld responsive documents until the very last minute and then produced such documents with only two business days remaining until Opposer's testimony period. Such conduct is in violation of the Trademark and Federal Rules governing discovery.

C. The Board Should Apply the Estoppel Sanction

Applicant's July 25, 2014 production should be excluded from the record in this proceeding pursuant to Fed. R. Civ. P. 26(e). Trademark Rules 2.116(a) and 2.120(a)(1); TBMP

§ 408.02. *See also Great Seats, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011); *Galaxy Metal Gear Inc. v. Direct Access Technology Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009); *Panda Travel, Inc. v. Resort Option Enterprises, Inc.*, 94 USPQ2d 1789, 1791 (TTAB 2009); *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718, 1720 (TTAB 1987). A party failing to provide information or supplement its responses or identify a witness as required by Rule 26(a) or (e) is not permitted to use that information or witness to supply evidence on a motion, at a hearing or at trial.

“Under the estoppel sanction, a party that fails to provide information may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, ‘unless the failure was substantially justified or is harmless.’” *Great Seats*, 2011 TTAB LEXIS 365 at *10-11 (quoting Fed. R. Civ. P. 37(c)(1)); See also TBMP § 527.01(e).

Just as in *Great Seats*, Applicant in the instant proceeding failed to supplement information relating to the identity of its witnesses in response to a specific discovery request (Opposer’s Request for Production No. 36) until well after the close of discovery. Just as in *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396, 425-426 (N.D. Tex. 2011), Applicant’s counsel once again attempts to deprive an opponent of the opportunity to cross-examine declarants. As such, Applicant’s submission of declarations from such witnesses on the eve of Opposer’s testimony period merits the estoppel sanction as applied in *Great Seats* and in *Abraham*.

Applicant’s counsel clearly knew of and had access to these declarants prior to July 25, 2014. Rather than disclose their identities and their declarations in a timely fashion as required by the Trademark and Federal Rules, Applicant chose to withhold these documents and disclosures until two business days prior to the opening of Opposer’s testimony period. As a

result, by submitting the declarations of these individuals nearly eight months after the close of discovery, Applicant sought to deprive Opposer of an opportunity to cross-examine these declarants or ascertain the provenance of documents incorporated by reference into their declarations. In so doing, Applicant attempts to secure for itself an unfair advantage in this proceeding. Opposer is damaged by such conduct and the prejudice to Opposer cannot be cured as discovery is closed. To reopen discovery would be to reward Applicant's dilatory conduct. These activities have caused the current motion practice and may only lead to further motion practice if such actions are allowed by the Board.

The Board should apply the estoppel sanction and should strike all documents from the July 25, 2014 production from these oppositions.

D. Applicant Continually Resisted Calls for Definite Statements and Continues its Attempts to Evade its Discovery Obligations

Applicant has provided incomplete production responses to Opposer's discovery requests. All the while, Applicant's counsel assured Opposer that it was not withholding any documents or information and that it was abiding by its discovery obligations. D.E. 59, p. 7. Applicant's last minute production of over 100 pages of documents including declarations from third parties is evidence to the contrary.

Even now, in response to Opposer's Motion to Compel, Applicant has resisted making definitive statements with regard to what it has and has not produced. Only now, after three meet and confers and its eleventh hour production, is Applicant willing to make a statement in writing—although in its brief and not in the proper format for discovery responses—that it has provided all responsive documents. However, even such a statement is limited to only two of Opposer's discovery responses. *See* D.E. 62, p. 14. With regard to all other discovery requests,

Applicant attests that it has no obligation to supplement information previously disclosed in writing. *See Id.* at pp. 14-16.

Applicant may not hide behind this statement as a cure-all for its underhanded tactics. The Trademark Rules state that although supplementation is not required for information otherwise made known to the propounding party during the discovery process, “[t]his is not an invitation, however, to hold back material items and disclose them at the last minute.” TBMP § 408.03; see also *Galaxy Metal Gear, Inc. v. Direct Access Tech., Inc.*, 2009 TTAB LEXIS 529, *7, 91 USPQ2d 1859, 1861 (TTAB 2009) *citing* Wright, Miller & Marcus, 8 Fed. Prac. & Pro. Civ. 2d § 2049.1 (2009). Given its continual refusal to submit definitive statements about the completeness of its discovery responses and production, it is certain the Applicant purposefully held back material items and disclosed them at the very last minute.

In light of Applicant’s conduct, the Board should exclude the July 25, 2014 production and further order that any responsive documents currently in existence but not produced in response to Opposer’s discovery requests will not be admitted into evidence at trial. In the alternative, Opposer requests Applicant be ordered to produce all responsive documents or, in the alternative state that there are no further responsive documents in response (as applicable).

III. CONCLUSION

Applicant has knowingly withheld responsive and relevant documents and information in response to Opposer’s discovery requests. Applicant’s production of documents which nearly double the existing production a mere two business days prior the opening of Opposer’s testimony period is plain evidence of this fact. Not only did Applicant withhold discovery and then spring it upon Opposer at the very last minute, it also attempts to use this late production to

support its Motion for Summary Judgment, thinking wrongly that doing so will secure some sort of advantage for the Applicant. Opposer has further established and Applicant has not challenged or contradicted the fact that it could have produced such documents during the discovery period.

Applicant continues to resist calls for supplementation or definite statements relating to the completeness of its discovery responses and production. Applicant's open and obviously deliberate disregard for the discovery rules, history of such tactics and continual evasion of discovery should not be tolerated by this Board. Accordingly, Opposer seeks an Order (1) precluding Applicant's recent supplemental document production pursuant to Fed. R. Civ. P. 37(c)(1) and TBMP § 527.01(e); (2(a)) stating that responsive information and documents currently in existence but not produced by Applicant in response to these Requests will not be admitted into evidence at trial; and, (2(b)) in the alternative, compelling Applicant to provide supplemental responses and document production in response to its Request for Production of Documents and Things or submit a statement that no (further) responsive documents are available (as applicable).

Respectfully Submitted,

By: 

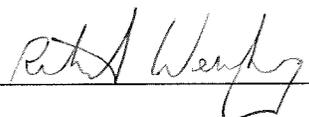
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Date: September 8, 2014
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SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

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:  Date: September 8, 2014

CERTIFICATE OF SERVICE

I, Richard Weinberg, hereby certifies that a copy of the foregoing **Opposer's Reply in Support of Motion To Preclude Unjustifiably Delayed Discovery and To Compel Discovery Responses** was served by First Class U.S. Mail, postage prepaid on this 8th Day of September, 2014 upon

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