

ESTTA Tracking number: **ESTTA628486**

Filing date: **09/22/2014**

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

| | |
|------------------------|---|
| Proceeding | 91197504 |
| Party | Defendant Alpha Phi Omega |
| Correspondence Address | JACK A WHEAT STITES HARBISON PLLC 400 WEST MARKET STREET, SUITE 1800 LOUISVILLE, KY 40202-3352 UNITED STATES jwheat@stites.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | Jack A. Wheat |
| Filer's e-mail | jwheat@stites.com |
| Signature | /jackawheat/ |
| Date | 09/22/2014 |
| Attachments | Resp2MFDisc.pdf(159700 bytes) AppX1 Dec 27, 2010 Corres.pdf(3447778 bytes) AppX2 May 5, 2011 Corres.pdf(71127 bytes) AppX3 Initial Disclosures.pdf(132200 bytes) AppX4 Opposers Rogs.PDF(76174 bytes) AppX5 Opposers Req For Admiss.PDF(50379 bytes) ApX6 opposers 1st Req for Prod.PDF(63884 bytes) ApX7 Opposers 2dReq for Prod.PDF(60530 bytes) ApX8 WheatDecl.PDF(29139 bytes) |

**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

**ALPHA PHI OMEGA’S OPPOSITION TO MOTION TO DELAY
CONSIDERATION OF MOTION FOR SUMMARY JUDGMENT &
FOR DISCOVERY**

It is a baseless insult for Omega to accuse Alpha Phi Omega of “holding back” evidence of third-party merchandising by fraternities and sororities of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and its phonetic equivalent, the word, Omega. The utterly unwarranted attacks are especially egregious for at least two reasons.

One reason Omega’s insulting position is so egregious is because *three times* prior to the commencement of discovery we disclosed the information for which Omega now feigns “surprise” and sandbagging. At the very outset of these Oppositions, nearly four years ago, we corresponded with Omega’s counsel proving multiple examples of third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega. *See* Applicant’s Exhibit 1 (December 27, 2010 correspondence with enclosures). Again we did so prior to the commencement of discovery. *See* Applicant’s Exhibit 2 (May 5, 2011 correspondence).

With both of these items, we informed Omega’s counsel that the Alpha Tau Omega Fraternity has been in operation since, 1865, the Alpha Chi Omega Sorority has been in

operation since 1885, and the Chi Omega Sorority has been in operation since 1895.

Then – a third time – in our initial disclosures, (1) we identified these organizations as witnesses and (2) identified the documentary evidence to which Omega now feigns “surprise” disclosing as follows:

Categories of documents and tangible things within the possession, custody or control of Applicant, which it may use to support its claims and defenses in this action:

2. Examples of widespread use of the Omega word and symbol, Ω, on fraternity and sorority jewelry and other merchandise dating back to the 1800s.

See Applicant’s Exhibit 3 (Initial Disclosures).

The second reason Omega’s insulting position is so egregious is that even though the evidence to which it now feigns surprise was actually disclosed prior to formal discovery requests, and then formally disclosed in our Initial Disclosures, ***Omega never followed up in discovery inquiring further about any of this information.*** The reason the readily available examples of third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega were not yet again produced in discovery is simply because ***none of Opposer’s numerous discovery requests*** inquired about the previously disclosed third party use of similar marks dating back to the 1800s. *See Applicant’s Exhibits 4, 5, 6, and 7 (Opposer’s Requests for Admissions, Interrogatories and 2 sets of Request for Production).* Instead, Opposer wrongly focused all its discovery attention on Applicant, its commercial history, and its knowledge of Opposer. For whatever peculiar strategy reason, it avoided this information even though we early on emphasized that widespread third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega is likely dispositive in these Oppositions. In addition to the detailed early disclosures of our contention a major problem with the Oppositions is the

widespread third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega, in both Applicant's Exhibits 1 and 2, we specifically pointed out the Alpha Tau Omega Fraternity has been doing so since, 1865, the Alpha Chi Omega Sorority has been doing so since 1885, and the Chi Omega Sorority has been doing so since 1895. Yet, Omega never followed up with any discovery requests directed to any of this information.

Whether Omega has been in psychological denial behaving like an ostrich trying to ignore information destructive to its claim, or was simply "negligent" in its failure to propound any discovery relating to the information so destructive to its Opposition is not credible grounds to further delay these nearly four year old Opposition proceedings. Nor is it credible grounds to reopen discovery to allow it to now take additional depositions.

There have been too many delays. 19 times Opposer's counsel requested and procured our consent to suspensions "pending settlement discussions" by telling us they were awaiting settlement authority from Opposer. Typically many, many months would pass, and then Omega would issue an overreaching proposal. The first such overreaching proposal was rejected following which the same suspension cycle would continue for many more months before Opposer would then issue a proposal typically nothing more than a re-wording of the essence of the previously rejected overreaching proposal(s). These delays, of course, are at least temporarily as successful as prevailing in Opposition, they keep the registry clear of the opposed marks.¹

The persistent delays of this proceeding have continued too long. Discovery is long closed. Twice prior to discovery we emphasized to Opposer (1) the ongoing use by the Alpha

¹ One must wonder if Omega is using the same tactics in its consolidated Oppositions to the Omega Psi Phi Fraternity applications of the to register its marks (TTAB Proceeding 91183834; continuing ongoing "suspensions pending settlement discussions" *for nearly 6 years*, since March, 2008) , and Omega's consolidated Oppositions to the Lambda Tau Omega Sorority applications of the to register its marks (TTAB Proceeding 91208652; continuing ongoing "suspensions pending settlement discussions" since March, 2013)

Tau Omega Fraternity of the Greek alphabet letter, Ω, and the word, Omega, since 1865, (2) the ongoing use by the Alpha Chi Omega Sorority of the Greek alphabet letter, Ω, and the word, Omega, since 1885, and (3) the ongoing use by the Chi Omega Sorority of the Greek alphabet letter, Ω, and the word, Omega, since 1895. In our Initial Disclosures, we listed Designees of each of these organizations as witnesses and further disclosed the existence of “documents and tangible things within the possession, custody or control of Applicant, which it may use to support its claims and defenses in this action” including “[e]xamples of widespread use of the Omega word and symbol, Ω, on fraternity and sorority jewelry and other merchandise dating back to the 1800s.” Whether intentional or the result of carelessness, inattention, or other negligence, Opposer failed to propound any discovery requests directed to this information, nor did it seek to depose the Designees. Whether intentional or the result of carelessness, inattention, or other negligence, Opposer failed to propound any discovery relating to *any* third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega, a controlling issue in these Oppositions.

We are not here dealing with a procedural situation where Opposer is seeking to *extend* discovery which would require merely a showing of “good cause.” What we are here dealing with is a procedural situation in which Opposer is seeking to *reopen* discovery which requires a showing of “excusable neglect.” FED. R. CIV. P. 6(b).

Even if discovery were not closed, Opposer is lacking the lesser “good cause” requisite to *extend*. Although the Board “liberally” grants extensions, good cause is lacking when a party has been negligent in pursuing discovery. *See American Vitamin Prods., Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (“the Board is liberal in granting extensions of time before the period to act has elapsed, so long as the moving party has not been guilty of negligence”).

Delay in seeking discovery though counters against a claim of good cause to extend. *See Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303, 1305 (TTAB 1987) (“mere delay in initiating discovery does not constitute good cause for an extension of the discovery periodTo allow an extension . . . would be to reward petitioner for its delay in initiating discovery”); *see also* TBMP § 403.04 and *Nat’l Football League v. DNH Mgmt., LLC*, 2008 TTAB LEXIS 3, at *4 (TTAB, Jan 29, 2008) (“When . . . a party does not serve written discovery requests until the final day of discovery . . . a motion to extend discovery will ordinarily be denied”). And here, we are not dealing with mere delay until late in the discovery period to propound discovery. Rather, here we are dealing with a case where Opposer *never propounded any discovery* relating to third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega, a controlling issue in these Oppositions. Even under the Board’s “liberal” good cause standard to allow an extension of discovery, an extension would be inappropriate.

So Opposer certainly can not satisfy the more rigorous “excusable neglect” standard to *reopen* the closed discovery period. As noted by Federal Circuit agreeing with the Board’s application of this standard, excusable neglect is lacking when a party’s “failure to take the proper steps at the proper time” is the “consequence of the party’s own carelessness, inattention, or willful disregard.” *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 1552-53 (Fed. Cir. 1991). This is precisely the situation we have here, Omega is seeking to unnecessarily further delay these proceeding by reopening discovery to allow it to force Applicant, a non-profit organization, to jet it counsel to Memphis and San Diego, as well as travel to Indianapolis for depositions relating to information repeatedly disclosed in these proceeding, information Opposer never sought to follow-up on in discovery. Its failure to seek discovery relating to third-

party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega, is the “consequence of the party’s own carelessness, inattention, or willful disregard.” *Id.*

This is not a case of sandbagging. “Disingenuous” is a nice word describing Omega’s feigned claim of “surprise” associated with the information it pleads justifies reopening discovery for various depositions across the country. A better word to describe Omega’s approach and demeanor is “denial,” denial in the sense of the psychological deficiency in which Omega refuses to acknowledge the information repeatedly brought to its attention. Ignoring our correspondence where we brought the pertinent information to the attention of Omega’s counsel is one thing. Most striking though – no, most shocking – is Omega’s mistaken claim the information was never disclosed in discovery. The witnesses and exhibits were ***actually disclosed*** to Omega in Applicant’s Initial Disclosures. It is not our fault Omega ignored this information rather than specifically address it with discovery requests. Like the metaphorical ostrich hiding it’s head in the sand, Omega ignores the pertinent facts every time they are brought to Omega’s attention. It is no one’s fault other than Omega that it never sought discovery relating to the key information brought to its attention in detail at the outset of this litigation, again brought its attention prior to discovery, and again formally brought to its attention in our Initial Disclosures. It is a misrepresentation to the Board when Omega asserts this information was not brought to its attention until just prior to the filing of the pending Motion for Summary Judgment. What Omega ignores in its refusal to acknowledge reality is that this precise information was brought to its attention *at the very outset of these Oppositions*. In a December 27, 2010 cover letter to Omega’s counsel provided with our Answers, we pointed out to them –

We assume you understand that there are numerous Greek letter collegiate fraternal organizations, and that each one typically uses a combination of two to three Greek alphabet letters as its name. Many of these utilize the Greek alphabet letter “Omega” in their name. Perhaps you were unaware that there is a well-established niche market through which Greek letter collegiate fraternal organizations make available for purchase by their members various affinity products, including clothing, badges, jewelry and so forth containing their Greek names and letters, including various of those organizations that use the Greek alphabet letter “Omega” in their name.

Our brief research reveals an extensive amount of third-party use of the Greek letter “Omega” by Greek organizations. For example, the website of just one Greek jewelry vendor, <http://www.hjgreek.com/index.cfm?event=Products.showOrganizations>, displays jewelry for six Greek organizations which include the word “Omega,” namely, Alpha Chi Omega, Alpha Omega Epsilon, Alpha Phi Omega, Alpha Tau Omega, Chi Omega and Omega Tau Sigma. ***Printouts for each of these organizations prominently displaying clothing and jewelry with the word “Omega” are enclosed for your review.*** It is worth noting that at least two of these, Alpha Chi Omega and Alpha Tau Omega, founded respectively in 1885 and 1865, predate your client. Further, a simple online Google search reveals an additional four Greek organizations which include the word “Omega,” namely, Omega Psi Phi, Alpha Omega Theta, Alpha Nu Omega and Gamma Phi Omega. Enclosures demonstrating advertisement of clothing and jewelry bearing these organizations’ names are also attached for your review. Given the widespread use within the Greek community of the Greek letter “Omega” in connection with clothing and jewelry, we hope you will agree that the pending oppositions are not good candidates for successful dilution claims.

See Applicant’s Exhibit 1 (emphasis added). With this correspondence, we included many of the documents of which Omega now feigns “surprise.” Further, the internet website link provided to Omega’s counsel in that letter, <http://www.hjgreek.com/index.cfm?event=Products.showOrganizations>, is the website from which numerous of the pages are found which were included with the Declarations for which Omega now feigns “surprise.” It is disingenuous for Omega to claim it was unaware of this information *until the end of July, 2014.*

Not only was all of this information brought to the attention of Omega's counsel in 2010 (Applicant's Exhibit 1), it was again brought to their attention in a letter dated May 5, 2011 –

Alpha Phi Omega has been in existence for over 85 years, since 1925. Jewelry bearing the Alpha Phi Omega name or Greek Alphabet letters has been produced for that entire time period. For however long Omega SA has been doing business in the United States markets, the parties have coexisted without any instances of confusion known to us. Are you aware of any? We expect there has been none. Considering that Alpha Phi Omega is a collegiate fraternal organization, just like numerous other collegiate Greek letter fraternities and sororities who utilize the Greek Alphabet letter "Omega" in their name, we would be quite surprised if anyone ever confuses Omega SA's commercial endeavors and products with fraternities and sororities or their Greek affinity merchandise.

This firm and Alpha Phi Omega's merchandising company also represent the *Alpha Tau Omega Fraternity, founded in 1865, and the Alpha Chi Omega Sorority, founded in 1885. Jewelry bearing both of these organizations names or Greek Alphabet letters has been produced for them ever since their founding dates, dates which predate any first use of the Omega SA marks anywhere, much less here in the States.*

This firm and Alpha Phi Omega's merchandising company also represent the *Chi Omega Sorority, founded in the spring of 1895 apparently about simultaneous with the first use of the Omega SA marks. Chi Omega is the largest collegiate sorority and like all fraternities and sororities, jewelry bearing it name or Greek Alphabet letters has been produced for it since its founding. See Trademark Registration No. 1,361,759.*

See Applicant's Exhibit 2 (emphasis added).

We provided this information to Omega's counsel's in the 2010 correspondence, again in the 2011 correspondence, and again formally in our Initial Disclosures. *See Applicant's Exhibit 3.* Notwithstanding having this information at least three times brought to their attention, Omega here seeks to further delay disposition of this proceeding and to reopen discovery to allow it to now take depositions in Indianapolis, Memphis and San Diego relating to the following:

Dan Shaver Declaration: It is disingenuous for Omega to claim “surprise” relating to the Declaration of Dan Shaver in which he describes how fraternities and sororities typically merchandise their names and Greek alphabet letters on jewelry and other affinity merchandise to note membership in their respective fraternity or sorority. In our Initial Disclosures, this was clearly brought to their attention. We identified him and disclosed his “[g]eneral knowledge relating to the history of the fraternity and sorority system in the United States; the Greek affinity products market and common usage by fraternities and sororities of their names and initials on jewelry and other merchandise.”

Alpha Tau Omega Declaration: It is disingenuous for Omega to claim “surprise” relating to the Declaration the Alpha Tau Omega Fraternity which notes the founding of that fraternity in 1865 and the common use of the fraternity name and Greek letter insignia, ATΩ, on merchandise used by members to indicate their membership in the organization, including use of the ATΩ insignia on jewelry continuously since 1865. *In addition to* bringing this information to the attention of Omega’s counsel in the 2010 correspondence and again in the 2011 correspondence, this information was also formally disclosed in our Initial Disclosures. In our Initial Disclosures, we identified Alpha Tau Omega Fraternity and disclosed that its Designees could provide information relating to “[t]he history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise.”

Alpha Chi Omega Declaration: It is disingenuous for Omega to claim “surprise” relating to the Declaration the Alpha Chi Omega Fraternity, a fraternity for women commonly referred to as a sorority. This Declaration notes the founding of the sorority in 1885 and the common use of the sorority name and Greek letter insignia, AXΩ, on merchandise used by members to indicate their membership in the organization, including use of the AXΩ insignia on

jewelry continuously since 1885. *In addition to* bringing this information to the attention of Omega's counsel in the 2010 correspondence and again in the 2011 correspondence, this information was also formally disclosed in our Initial Disclosures. In our Initial Disclosures, we identified Alpha Chi Omega and disclosed that its Designees could provide information relating to "[t]he history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise."

Chi Omega Declaration: It is disingenuous for Omega to claim "surprise" relating to the Declaration the Chi Omega Fraternity, a fraternity for women commonly referred to as a sorority. This Declaration notes the founding of that sorority in 1895 and the common use of the sorority name and Greek letter insignia, XΩ on merchandise used by members to indicate their membership in the organization, including use of the XΩ insignia on jewelry continuously since 1895. *In addition to* bringing this information to the attention of Omega's counsel in the 2010 correspondence and in the 2011 correspondence, this information was also formally disclosed in our Initial Disclosures. In our Initial Disclosures, we identified Chi Omega and disclosed that its Designees could provide information relating to "[t]he history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise."

Omega cannot candidly state it was "surprised" by the Shaver, Alpha Tau Omega, Alpha Chi Omega, and Chi Omega Declarations, nor can it complain about the documentary materials included therewith. All of this information was repeatedly brought to its attention, by correspondence dated December 27, 2010, (Applicant's Exhibit 1), by correspondence dated May 5, 2011, (Applicant's Exhibit 2), and formally in our Initial Disclosures, (Applicant's Exhibit 3).

If indeed the Initial Disclosures were inadequate, Omega was freely able to bring a motion so claiming. *See* TBMP § 523.01, However, such a motion is untimely unless brought prior to the close of discovery. *See* TBMP § 523.03. Regardless, there was nothing deficient about the Initial Disclosures, the Initial disclosures plainly put Omega on notice of the information relating to which it now feigns “surprise.”

The truth remains, dating back to 2010, and repeatedly thereafter, it was brought to the attention of Opposer and its counsel that numerous fraternities and sororities have “Omega” in their name, fraternities and sororities commonly utilize their insignia on jewelry and other items, and Alpha Tau Omega has done so since 1865, Alpha Chi Omega has done so since 1885, and Chi Omega has done so since 1895. In our Initial Disclosures, we listed Dan Shaver, and Designees of Alpha Tau Omega, Alpha Chi Omega, and Chi Omega as witnesses.

For Omega to claim it is now “surprised” by this information is ludicrous. It is not our fault Omega for some peculiar reason never sought any follow up discovery relating to this information. That strategy decision is Omega’s self-inflicted problem, it is the “consequence of the party’s own carelessness, inattention, or willful disregard.” *Hewlett-Packard Co.* , 931 F.2d at 1552-53 (Fed. Cir. 1991). It is not excusable neglect warranting further delays and the reopening of discover to allow Omega to force Applicant’s counsel to jet across the country to defend depositions never sought during the discovery period.

Omega cannot candidly claim to be surprised by the Declarations. It is not our fault Omega propounded no discovery requests specifically relating to this information. It is not our fault Omega did not take Dan Shaver’s deposition during the discovery period. Both he and the information he authenticates were disclosed and described in our Initial Disclosures. And many of the documentary items appended to his Declaration were earlier provided to Omega’s counsel

back on December 27, 2010, (Applicant's Exhibit 1). It is not our fault Omega did not take depositions of the Designees of Alpha Tau Omega, Alpha Chi Omega, and Chi Omega. Each of them, and the information they authenticate was disclosed and described in our Initial Disclosures. And many of the documentary items appended to the Declarations were earlier provided to Omega's counsel back on December 27, 2010, (Applicant's Exhibit 1).

It's not our fault Omega became like an ostrich. Those identified in Initial Disclosures should "reasonably be viewed as possible witnesses." *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 2009 TTAB LEXIS 472 (TTAB, July 6, 2009); *see also Spier Wines (PTY) Ltd. v. Shepher*, 2012 TTAB LEXIS 218, at *9 (TTAB, June 12, 2012) ("persons identified in initial disclosures may reasonably be viewed as possible trial witnesses"). One such as Omega "will not now be heard to complain. *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1656-57 (TTAB 2002) Omega had "the opportunity to notice and take discovery depositions . . . of persons with knowledge of relevant facts. In these circumstances, [Opposer's] claim that [it] was deprived of the opportunity to obtain discovery . . . is not persuasive." *Id.*

This is not a situation where neither the witness nor the documents were identified until our pre-trial disclosures, but even if it were, Omega would be hard-pressed to claim prejudicial surprise.

[A]pplicant's attempt to present evidence of third-party use . . . should not have come as a surprise because it is common practice to introduce third-party use to demonstrate that a mark is weak and, therefore, entitled to only a narrow scope of protection. The documents . . . were equally accessible to opposer, i.e., they were publicly available via the internet.

Mfrs. Tech. Insts., Inc. v. Pinnacle College, LLC, 2013 TTAB LEXIS 478, 6-7 (TTAB Sept. 4, 2013) quoting *Rocket Trademark Pty Ltd. V. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011).

For Omega to claim surprise simply because persons with knowledgeable information were not *re-identified* in response to an interrogatory inquiry about which witnesses we may have decided to present at trial misses the point. Omega cannot candidly claim surprise.

In identifying individuals through initial disclosures, a party need not identify all those that may be called at trial as potential "trial witnesses" However, because individuals identified through initial disclosures have knowledge that the disclosing party may use to support its claims or defenses, the *persons identified in initial disclosures may reasonably be viewed as possible trial witnesses*.

Spier Wines (PTY) Ltd. v. Shepher, 2012 TTAB LEXIS 218, 8-9 (Trademark Trial & App. Bd. June 12, 2012) (quoting *Jules Jurgensen/Rhapsody, Inc. v. Baumberger*, 91 USPQ2d 1443, 1443 n.1 (TTAB 2009)) (emphasis added).

This is not a case of failure to supplement, or prejudicially late supplementation. There is no "obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process. Fed. R. Civ. P. 26(a)(1)(A)(i); *see also Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) and TBMP § 414 (7) (same). "There is no *real* surprise for applicant to cure." *Sheetz of Dela., Inc., v. Doctor's Assocs. Inc.*, 2013 TTAB LEXIS 468, at *10.

Omega propounded 53 Request for Production, 22 Request for Admissions, and 29 Interrogatories. *See* Applicant's Exhibits 4, 5, 6, and 7. For some reason though, none of those discovery requests specifically addressed the key defenses brought to Omega's attention in detail with the cover letter to our Answers, information brought to Omega's attention in detail in later correspondence, and then again brought to Omega's attention in our Initial Disclosures. Although we cannot fathom the strategic reason short of a refusal to recognize reality, for some reason Omega never saw the need to propound any discovery requests specifically directed to investigating the information so many times brought to its attention. Dan Shaver and the other

Declarant's were formally brought to Omega's attention in our initial disclosures. The link to the website of the jeweler specializing in fraternity and sorority jewelry from which many of the attachments to the Declarations were taken was provided to Omega's counsel back December 27, 2010, (Applicant's Exhibit 1), along with an assortment of multiple representative point of purchase displays showing fraternity and sorority merchandise. "There is no *real* surprise for applicant to cure." *Sheetz of Dela., Inc.*, 2013 TTAB LEXIS 468, at *10.

The fact that Opposer did not propound *any* discovery requests relating to the oft previously disclosed third party use of similar marks dating back to the 1800s demonstrates how insulting it is to accuse Applicant's counsel of "holding back" information.

Granted the undersigned informed Opposer's counsel it is impossible to review Applicant's records dating back over 90 years to locate any records relating to "the date of the first" clothing bearing any of Applicant's insignia or "the date of the first" watches bearing any of Applicant's insignia or even the initial decision to allow the production of watches bearing any of the insignia, and therefore was not holding back anything responsive to those requests. But that does not warrant the utterances of insults we misled counsel about the evidentiary basis of our defenses in this proceeding. In our initial disclosures we explicitly put Opposer on notice of our witnesses and –

Categories of documents and tangible things within the possession, custody or control of Applicant, which it may use to support its claims and defenses in this action:

2. Examples of widespread use of the Omega word and symbol, Ω, on fraternity and sorority jewelry and other merchandise dating back to the 1800s.

See Applicant's Exhibit 3. And, prior to our initial disclosures, we even provided multiple examples of third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega. See Applicant's Exhibit 1.

None of the 104 discovery requests propounded by Omega specifically address the information Omega now claims should justify further delaying these proceeding and reopening discovery. Perhaps the closest general request is the invalid and properly objected to Request for Production No. 42 which requested “all documents that applicant contends are relevant to this proceeding.” Such a request is properly objectionable as vague and overbroad in violation of the rule that a Request for Production “must describe with *reasonable particularity*” what is sought. *See* Fed. R. Civ. P. 34(b)(1)(A). Indeed, as the Board itself notes, such an overly broad request “may be disregarded.” *Kegan v. Lane*, 1998 TTAB LEXIS 276 at *3 (TTAB, Apr. 15, 1998) (“document request which requires applicant to produce documents ‘relevant to our interrogatory requests or to our admissions requests’ is overbroad and vague and may be disregarded”). Indeed rather than assuring Omega’s counsel anything and everything relevant to this case had been produced, we did just the opposite, in the meet and confer, we informed Opposer’s counsel we have not yet begun trial preparation, are standing by this objection to the overly broad request for production of “anything and everything relevant” to this proceeding. *See* Applicant’s Exhibit 8 (Declaration of Jack A. Wheat).

None of the proper discovery requests have anything at all to do with the Declarations Omega objects to with feigned cries of “prejudicial surprise.” There is no “obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process. FED. R. CIV. P. 26(a)(1)(A)(i); *see also Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) and TBMP § 414 (7) (same).

Whether intentional or the result of carelessness, inattention, or other negligence, Opposer did not propound any discovery relating to **any** third-party fraternity and sorority

merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega. Likewise, Omega's failure to take the third party depositions during discovery is the "consequence of the party's own carelessness, inattention, or willful disregard." *Hewlett-Packard Co.* , 931 F.2d at 1552-53 (Fed. Cir. 1991). It is not excusable neglect warranting further delays and the reopening of discovery to allow Omega to force Applicant's counsel to jet across the country to defend depositions never sought during the discovery period.

CONCLUSION

At the very outset of these Oppositions, nearly four years ago, we corresponded with Omega's counsel proving multiple representative examples of third-party fraternity and sorority merchandising of affinity goods bearing insignia containing the Greek alphabet letter, Ω, and the word, Omega. *See* Applicant's Exhibit 1. Again we emphasized this to Omega's counsel prior to the commencement of discovery. *See* Applicant's Exhibit 2 . In both of these items, we informed Omega's counsel that the Alpha Tau Omega Fraternity has been in operation since, 1865, the Alpha Chi Omega Sorority has been in operation since 1885, and the Chi Omega Sorority has been in operation since 1895. Then – a third time – in our initial disclosures, we identified these organizations as witnesses and further identified the documentary evidence to which Omega now feigns "surprise" by disclosing as follows:

Categories of documents and tangible things within the possession, custody or control of Applicant, which it may use to support its claims and defenses in this action:

2. Examples of widespread use of the Omega word and symbol, Ω, on fraternity and sorority jewelry and other merchandise dating back to the 1800s.

See Applicant's Exhibit 3.

For whatever strategic reason, Omega never followed up with any discovery requests directed to this information. That strategy decision is Omega's self-inflicted problem, it is the

“consequence of the party’s own carelessness, inattention, or willful disregard.” *Hewlett-Packard Co.* , 931 F.2d at 1552-53 (Fed. Cir. 1991). So it is not “excusable neglect” warranting further delays and the reopening of discovery.

ACCORDINGLY, Opposer’s motion to delay consideration of the Applicant’s Motion for Summary and to reopen discovery to allow the taking of depositions should be OVERRULED.

Respectfully requested,

/jackawheat/

Jack A. Wheat
Mari-Elise Taube
STITES & HARBISON PLLC
400 West Market Street, Suite 1800
Louisville, Kentucky 40202-3352
Telephone: (502) 587-3400

Counsel for Alpha Phi Omega

CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION

I hereby certify that a true copy of this item, ALPHA PHI OMEGA’S OPPOSITION TO MOTION TO DELAY CONSIDERATION OF MOTION FOR SUMMARY JUDGMENT & FOR 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 this 22nd day of September, 2014, via First Class Mail, postage prepaid, to:

Jess M. Collen
Thomas P. Gulick
Oren Gelber
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Ave.
Ossining, New York 10562

/jackawheat/
Jack A. Wheat

AL169:00AL1:995544:1:LOUISVILLE

Applicant's Exhibit 1

STITES & HARBIS JN PLLC

ATTORNEYS

400 West Market Street
Suite 1800
Louisville, KY 40202-3352
[502] 587-3400
[502] 587-6391 Fax
www.stites.com

December 27, 2010

Jess M. Collen
Oren Gelber
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Ave
Ossining, NY 10562

Jack A. Wheat
(502) 681-0323
(502) 779-8273 FAX
jwheat@stites.com

RE: Alpha Phi Omega/Omega SA Oppositions
C/M Code: AL169/00AL1

Dear Mr. Collen and Ms. Gelber:

Enclosed you will find Alpha Phi Omega's Answers to your client's, Omega SA, Notices of Opposition, specifically Opposition Nos. 91197504 and 91197505.

Our client, Alpha Phi Omega, is a Greek letter collegiate fraternal organization. We do not believe the Oppositions are necessary, and we are hopeful that when you consider the market realities you will agree that the use by Alpha Phi Omega of its insignia on fraternal merchandise does not present any dilution of or likelihood of confusion with your client's trademarks.

We assume you understand that there are numerous Greek letter collegiate fraternal organizations, and that each one typically uses a combination of two to three Greek alphabet letters as its name. Many of these utilize the Greek alphabet letter "Omega" in their name. Perhaps you were unaware that there is a well-established niche market through which Greek letter collegiate fraternal organizations make available for purchase by their members various affinity products, including clothing, badges, jewelry and so forth containing their Greek names and letters, including various of those organizations that use the Greek alphabet letter "Omega" in their name.

Our brief research reveals an extensive amount of third-party use of the Greek letter "Omega" by Greek organizations. For example, the website of just one Greek jewelry vendor, <http://www.hjgreek.com/index.cfm?event=Products.showOrganizations>, displays jewelry for six Greek organizations which include the word "Omega," namely, Alpha Chi Omega, Alpha Omega Epsilon, Alpha Phi Omega, Alpha Tau Omega, Chi Omega and Omega Tau Sigma. Printouts for each of these organizations prominently displaying clothing and jewelry with the word "Omega" are enclosed for your review. It is worth noting that at least two of these, Alpha Chi Omega and Alpha Tau Omega, founded respectively in 1885 and 1865, predate your client. Further, a simple online Google search reveals an additional *four* Greek organizations which

Applicant's Exhibit 2

STITES & HARBISON PLLC

ATTORNEYS

400 West Market Street
Suite 1800
Louisville, KY 40202-3352
(502) 587-3400
(502) 587-6391 Fax
www.stites.com

May 5, 2011

Ms. Oren Gelber
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Avenue
Ossining, New York 10562

Jack A. Wheat
(502) 681-0323
(502) 779-8273 FAX
jwheat@stites.com

RE: Omega SA v. Alpha Phi Omega
Your Refs. : K654 and K655
C/M Code: AL169/00AL1

Dear Oren:

The Omega SA offer set forth in your letter of April 19, 2011 has been reviewed with our client. We understand the reference in your letter to application Serial No. 77/905,236 was in error. Although the request was that we withdraw that application for registration "in Class 14," as you realize, that application does not relate to Class 14. Thus we understand that this was actually intended to be a reference to application Serial No. 77/950,436, our pending application to register the Alpha Phi Omega coat-of-arms design as a trademark for jewelry in Class 14.

Although the proposal set forth in your letter is not quite acceptable, I believe we should be able to achieve a meaningful and fair resolution of this dispute.

The pending application of concern is not an application to register the Alpha Phi Omega coat-of-arms for clocks, watches, timepieces or any other horological or chronometric instruments, it is an application for registration for jewelry. If ever we do seek to register for any such devices, you would certainly right to oppose such an application, but here we are not dealing with such a product line.

Alpha Phi Omega has been in existence for over 85 years, since 1925. Jewelry bearing the Alpha Phi Omega name or Greek Alphabet letters has been produced for that entire time period. For however long Omega SA has been doing business in the United States markets, the parties have coexisted without any instances of confusion known to us. Are you aware of any? We expect there has been none. Considering that Alpha Phi Omega is a collegiate fraternal organization, just like numerous other collegiate Greek letter fraternities and sororities who utilize the Greek Alphabet letter "Omega" in their name, we would be quite surprised if anyone ever confuses Omega SA's commercial endeavors and products with fraternities and sororities or their Greek affinity merchandise.

Ms. Oren Gelber

May 5, 2011

Page 2

This firm and Alpha Phi Omega's merchandising company also represent the Alpha Tau Omega Fraternity, founded in 1865, and the Alpha Chi Omega Sorority, founded in 1885. Jewelry bearing both of these organizations names or Greek Alphabet letters has been produced for them ever since their founding dates, dates which predate any first use of the Omega SA marks anywhere, much less here in the states.

This firm and Alpha Phi Omega's merchandising company also represent the Chi Omega Sorority, founded in the spring of 1895 apparently about simultaneous with the first use of the Omega SA marks. Chi Omega is the largest collegiate sorority and like all fraternities and sororities, jewelry bearing it name or Greek Alphabet letters has been produced for it since its founding. See Trademark Registration No. 1,361,759.

Omega watches have coexisted with fraternity and sorority merchandise, including jewelry, bearing the word Omega or the Greek Alphabet letter, Ω , for over 100 years. We are unaware of even a single instance of confusion of a potential customer and doubt if there has been any.

Both the Courts and the PTO have held that uses of two and three Greek Alphabet letter combinations in a mark are recognized as references to collegiate fraternities and sororities, and in the channels of trade, the commonality of one or two Greek Alphabet letters does not cause confusion. For example, as recently noted by the United States District Court for the Northern District of Texas, "A member of Alpha Omicron Pi could certainly distinguish the mark of her organization from the mark of Alpha Delta Pi, despite the fact they both contain two of the same letters." *Abraham v. Alpha Chi Omega et al*, Civil Action No. 3:08-cv-570-F (Memorandum Opinion entered April 26, 2011 at pps. 23 & 24).

Omega SA has a likely insurmountable burden to overcome to prevail in these Oppositions. We doubt that Omega SA has considered the self-destructive, indeed suicidal consequences of prevailing in the unlikely event it could do so. To prevail, it must show that a two or three Greek letter combination containing the Greek Alphabet word "Omega" or letter, Ω is likely to be confused with Omega and its products. The consequence of prevailing is self-destructive. To prevail in this action would be binding and **usable against** Omega SA in any actions brought against Omega SA by any of our other fraternity and sorority clients with "Omega" in their name which were founded prior to Omega SA's expansion into the United States markets. Simply stated, if the name Alpha Phi Omega is likely to be confused with Omega SA and its products simply by virtue of the non-emphasized use of "Omega" in the name, then, as a matter of law, Omega SA and its products are likely to be confused with other of our clients including Alpha Tau Omega, founded in 1865, and Alpha Chi Omega, founded in 1885. Surely Omega SA does not wish to merely win this battle, but then lose the war when it is asked to account to fraternities and sororities with rights senior to Omega SA.

Ms. Oren Gelber
May 5, 2011
Page 3

As we assume you are aware, the Doctrine of Judicial Estoppel would prevent Omega SA from contending that one is an infringement, and then to turn about and argue the opposite in the other situation. As the United States Supreme Court notes, "Where a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position. . . . The doctrine of judicial estoppel prevents a party from asserting a claim in a legal proceeding that is inconsistent with a claim taken by that party in a previous proceeding." *State of New Hampshire v. State of Maine*, 532 U.S. 742, 749 (2001). "[J]udicial estoppel forbids use of 'intentional self-contradiction . . . as a means of obtaining unfair advantage.'" *Id.* at 751 (2001).

[I]ts purpose is 'to protect the integrity of the judicial process . . .'
by 'prohibiting parties from deliberately changing positions
according to the exigencies of the moment' 'Judicial Estoppel
'protects the essential integrity of the judicial process' . . .
[J]udicial estoppel prevents parties from 'playing fast and loose
with the courts.'

Id. at 749 & 50 (citations omitted).

This rule is just as applicable to quasi-judicial proceeding such as the current Oppositions. For instance, as noted by the United States Court of Appeals for the Federal Circuit, the Court which governs proceedings of the United States Patent and Trademark Office,

[T]he doctrine of judicial estoppel is an equitable concept that prevents a party who prevails on one ground in a lawsuit from then repudiating that ground in order to prevail in another lawsuit
The doctrine also applies to administrative proceedings in which a party obtains a favorable order by making an argument that it seeks to repudiate in a subsequent judicial proceeding. . . . The estoppel applies where intentional self-contradiction is being used as a means of obtaining an unfair advantage.

Lampi Corp. v. American Power Products, Inc., 228 F.3d 1365, 1377 (Fed.Cir. 2000) (citations omitted; emphasis added).

The pending Oppositions against the Alpha Phi Omega applications are the wrong "test case" for Omega SA. None of this firm's numerous fraternity or sorority clients with "Omega" in their name emphasize "Omega" over the other Greek Alphabet letters in their names and in resolution of the pending Oppositions against its applications, Alpha Phi Omega is willing to contractually commit it will never do so in the future.

Ms. Oren Gelber
May 5, 2011
Page 4

Perhaps if Alpha Phi Omega was emphasizing the word "Omega" or the Greek Alphabet letter Ω , as compared with the other Greek Alphabet letters in its name, it might be a good test case, but to assert that a fraternity or sorority name which merely contains "Omega," without emphasis of that letter will likely cause confusion brings to mind the apropos metaphor, "a bridge to far." It is a self-destructive, suicidal position to take.

Asserting a dilution argument against nearly 100 year old fraternities and sororities is just as ill-advised. Again, Alpha Phi Omega has been using its name and Greek letters on jewelry since 1925. To prevail on a dilution theory in this context, Omega SA would be required to prove that its marks were generally famous throughout the U.S. since prior to 1925, prior to when Alpha Phi Omega commenced its use. See 15 U.S.C. § 1125(c). Further, any effort to show fame in this context would make relevant the fact that *numerous* fraternities and sororities with "Omega" in their name actually predate the entry of the Omega SA products into the U.S.

If indeed Omega SA wants to assert that the fraternity and sorority market is pertinent for a dilution approach, it certainly risk an adjudication that in that context its marks *are not famous for dilution purposes*. Again, this is the wrong test case, Omega SA is heading towards "a bridge too far."

The realistic solution of the pending Oppositions against Alpha Phi Omega is, as we have already suggested, as follows:

1. In exchange for dismissal of the Oppositions, Alpha Phi Omega is willing to contractually commit that use of its name on merchandise will never emphasize the "Omega" or " Ω " portion in comparison with the "Alpha" and "Phi" components; and
2. As for the pending application to register the mark in class 014, Alpha Phi Omega is willing to restrict the recitation of goods to read, "jewelry for members of the Alpha Phi Omega Fraternity marketed through authorized vendors featuring fraternity and sorority affinity merchandise."

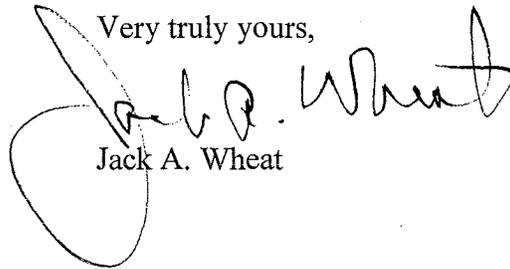
We have not sought to register ALPHA PHI OMEGA or the letters for timepieces of any sort and are not suggesting you agree we may do so. If ever we do, you would certainly retain the right to oppose such an application for registration.

We are satisfied this is the sensible solution of the Opposition to the pending Alpha Phi Omega applications. This is not a situation where we emphasize the Omega component of the fraternity name, nor is this a non-fraternity/non-sorority commercial endeavor engaged in under the Omega name. Those situations might be the appropriate test cases for your client. Conversely, our situation does not appear to be a good test case.

Ms. Oren Gelber
May 5, 2011
Page 5

Thus, we hope Omega SA will consider its real interests and be comfortable with our proposal.

Very truly yours,

A handwritten signature in black ink, appearing to read "Jack A. Wheat". The signature is written in a cursive style with a large, looping initial "J".

Jack A. Wheat

AL169:00AL1:382646:1:LEXINGTON

Applicant's Exhibit 3

**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.

Opposition No. 91197504

Serial No. 77950436

APPLICANT'S INITIAL DISCLOSURES

Alpha Phi Omega (hereinafter "Applicant") submits these Initial Disclosures in accordance with the revised Trademark Trial and Appeal Board Manual of Procedure. The Initial Disclosures are based on the information reasonably available to Applicant at this time.

A. Witnesses:

The following persons are likely to have discoverable information that Applicant may use to support its claims and defenses in this action:

| Name | Contact Information | Subjects |
|--|--|---|
| Various current and prior employees of Applicant, including but not necessarily limited to Robert London | C/o Counsel for Applicant | The history of Applicant and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Dan Shaver, Affinity Marketing Consultants, Inc. | 3231-C Business Park Drive #300 Vista, CA 92083 (706) 734-6764 | General knowledge relating to the history of the fraternity and sorority system in the United States; the Greek affinity products market and common usage by fraternities and sororities of their names and initials on jewelry and other merchandise |

| Name | Contact Information | Subjects |
|---|---|---|
| Designees of Affinity Marketing Consultants, Inc. | 3231-C Business Park Drive #300 Vista, CA 92083 (706) 734-6764 | General knowledge relating to the history of the fraternity and sorority system in the United States; the Greek affinity products market and common usage by fraternities and sororities of their names and initials on jewelry and other merchandise |
| Designees of Alpha Tau Omega | C/o Counsel for Applicant | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Chi Omega | C/o Counsel for Applicant | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Chi Omega | C/o Counsel for Applicant | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Psi Phi | 3951 Snapdragon Parkway Decatur, GA 30035 (404) 284-5533 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Gamma Omega | 28000 Meadow Drive, Suite 104 Evergreen, CO 80439 (303) 674-3561 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Chi | Ursinus College 601 E Main St. Collegeville, PA 19426 (610) 409-3000 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |

| Name | Contact Information | Subjects |
|----------------------------------|---|---|
| Designees of Sigma Phi Omega | PO Box 52738 Irvine, CA 92619 (949) 654-4111 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Kappa Omega Tau | 1808 S. 9 th St. Waco, TX 76706 (214) 886-4373 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Gamma Epsilon Omega | 2627 Magnolia Ave. Los Angeles, CA 90007 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Beta Omega Phi | 624 W. 28 th Street Los Angeles, CA 90007 (626) 244-5551 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Sigma Phi Omega | 1220 L Street NW, Suite 901 Washington, DC 20005 (336) 370-0457 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Omega Epsilon | C/o Counsel for Applicant | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Delta Phi | PO Box 590358 Houston, TX 77259 (281) 282-0034 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Nu Omega | PO Box 39033 Baltimore, MD 21212 (866) 337-1988 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |

| Name | Contact Information | Subjects |
|----------------------------------|--|---|
| Designees of Lambda Tau Omega | 2436 W. Haddon, 1 st Floor Chicago, IL 60622 (773) 517-8028 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Phi Chi | PO Box 11684 New Brunswick, NJ 08906 (602) 579-3638 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Gamma Omega Delta | 200 Water St., Apt. 510 New York, New York 10038 (212) 896-0918 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Phi Beta | Grand Central Station PO Box 3352 New York, NY 10163 (917) 673-0365 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Gamma Phi Omega | PO Box 4680 Chicago, Illinois 60680 (773) 218-2553 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Sigma Omega Epsilon | 2 Main Street Delhi, NY 13753 (607) 746-4565 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Pi Omega | 5035 E. 7 th Tulsa, OK 74112 (918) 629-5505 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Phi Gamma | 600 West 28 th #209 Austin, TX 78705 (512) 555-5555 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |

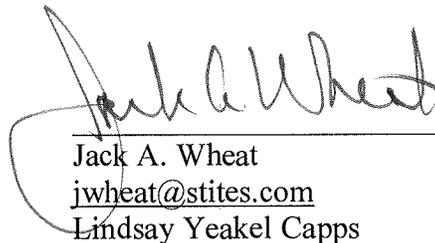
| Name | Contact Information | Subjects |
|--------------------------------|---|---|
| Designees of Sigma Omega Nu | 3059 Rosemont Drive Sacramento, CA 95826 (408) 416-1522 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Sigma Omega | 1717 11 th Street Waukegan, IL 60085 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Delta Phi Omega | 2420 Yorktown Apt. 490 Houston, TX 77056 (713) 840-8380 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Delta Pi Omega | 285 Old Westport Rd. North Dartmouth, MA 02747 (508) 999-8000 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Omega Chi Psi | 600 South 43 rd Street Philadelphia, PA 19104 (215) 596-8800 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Sigma Kappa Omega | PO Box 352 Huntsville, TX 77342 (713) 859-1320 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Sigma Omega Phi | 638 Waynes Ct. SE Atlanta, GA 30329 (678) 973-8088 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |
| Designees of Alpha Omega Sigma | PO Box 170354 Spartanburg, SC 29301 (678) 805-7476 | The history of their organization and the use of the Omega word and symbol, Ω, on jewelry and other merchandise |

B. Documents and Things:

Categories of documents and tangible things within the possession, custody or control of Applicant, which it may use to support its claims and defenses in this action:

1. Documentation relating to the history of Applicant and use of the Omega word and symbol, Ω , dating back to 1925.
2. Examples of widespread use of the Omega word and symbol, Ω , on fraternity and sorority jewelry and other merchandise dating back to the 1800s.

Applicant reserves the right to supplement this disclosure should it become aware of additional pertinent information or documents.



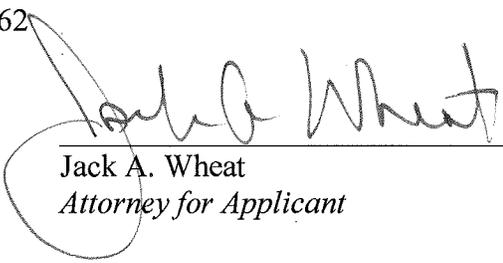
Jack A. Wheat
jwheat@stites.com
Lindsay Yeakel Capps
lcapps@stites.com
STITES & HARBISON PLLC
400 West Market Street, Suite 1800
Louisville, Kentucky 40202
Phone: (502) 587-3400
Facsimile (502) 587-6391

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the forgoing **APPLICANT'S RULE 26 DISCLOSURES** has been served on counsel for Opposer by mailing said copy this 28th day of February, 2013, via First Class Mail, postage prepaid, to:

Jess M. Collen
Oren Gelber
COLLEN IP
The Holyoke-Manhattan Building
80 South Highland Ave.
Ossining, New York 10562



Jack A. Wheat
Attorney for Applicant

AL169:00AL1:919504:1:LOUISVILLE

Applicant's Exhibit 4

**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: AΦΩ

Opp. No.: 91197505 (Parent)

Serial No.: 77905236

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

Opposer,

v.

ALPHA PHI OMEGA,

Applicant.

Mark: ALPHA PHI OMEGA and design

Opp. No.: 91197504 (Child)

Serial No.: 77950436

OPPOSER'S FIRST SET OF INTERROGATORIES

Pursuant to Rule 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice for the United States Patent and Trademark Office, Opposer Omega S.A. (Omega AG) (Omega Ltd.) (hereafter, "Opposer") hereby requests that Applicant Alpha Phi Omega ("Applicant") respond under oath or by affirmation to the following Interrogatories within thirty (30) days after service of these requests. These Interrogatories shall be deemed continuing and Applicant is requested to serve upon Opposer, in the form of supplementary Answers, any additional information requested herein that may be known to Applicant after the date of its Answers to these Interrogatories.

INSTRUCTIONS AND DEFINITIONS

The following definitions and instructions are applicable to Opposer's First Set of Interrogatories, Opposer's First Request for Production of Document and Opposer's First Request for Admissions:

A. "Opposer" means the named Opposer in this action, Omega S.A. (Omega AG) (Omega Ltd.), including its divisions, departments, subsidiaries, parents, partners, joint venture partners, officers, directors, owners, agents, employees, accountants, attorneys, any predecessor or successor in interest thereof, and all other persons acting on behalf of or for the benefit of Omega S.A. (Omega AG) (Omega Ltd.).

B. "Applicant" or "you" shall mean the named Applicant, Alpha Phi Omega, including all partners, joint venture partners, agents, employees, accountants, attorneys, any predecessor or successor in interest thereof, and all other persons acting on behalf of or for the benefit Alpha Phi Omega.

C. The term "Opposer's Marks" means the trademarks identified in the following U.S. trademark registrations:

| | | |
|--------------------|----------|-----------|
| 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 |

D. The term "Applications" means United States Trademark Application Serial Nos. 77905236 and 77950436.

E. The term "Applicant's Marks" means the trademark identified in United States Trademark Application Serial Nos. 77905236 and 77950436.

F. The terms "Goods" and "Products" means the items marketed and distributed or intended to be marketed and distributed by Applicant and/or the services provided.

G. The terms "data", "document" and "documents" means any writing of any kind, in any form or format, including all originals, copies, non-identical copies of all correspondence, papers, books, messages, publications, recordings, literature, letters, email communications, photographs, price lists, brochures, memoranda, notes, reports, drawings, diaries, graphic, aural, mechanical or electronic records, or any information that is stored electronically or otherwise and is capable of being retrieved, and any other writings whether in final or draft form and whether or not such draft was actually used or completed, or any "document" as otherwise described in Federal Rule of Civil Procedure 34 which is in your actual or constructive possession, custody or control.

H. "Person" means any individual, firm, corporation, partnership, proprietorship, cooperative, association, joint venture, organization, governmental body, group of natural persons, or any other entity.

I. The term "identify" or "specify" and "state the identity of" shall mean a complete identification to the full extent known or ascertainable by Applicant, whether or not in possession of Applicant, and whether or not alleged to be privileged, including the following information:

- 1) The present depository or depositories and the name and address of the person or persons having custody of any item to be identified unless the item is a patent, public document or person;
- 2) If the item to be identified is a person, his or her full name, address, job title, and present employers;
- 3) If the item to be identified is a document or paper, its character, title, date, addressee or recipient and author, signatory, or sender;
- 4) If the item to be identified is printed material, its title, author, publication date, volume and relevant page numbers;
- 5) If the identity sought is information about a situation or set of circumstances, all of the facts relating to or relevant to such a situation including the identity of persons with knowledge of such situation and the identity of all documents relating to, referring to, or otherwise pertinent to such a situation.
- 6) If the person to be identified is a corporation, or other legal entity, the laws under which it is organized, and the date of organization.

J. The term "mark(s)" means and includes trademarks, service marks, trade names, corporation names, and any other symbol or device used to identify the source, affiliation, or identity of any product, service or person.

K. The term "advertisement" means and includes all communications to third parties fixed in a tangible medium of expression and intended to promote or encourage the purchase or sale of goods or services in the United States.

L. The term “advertising” means and includes all advertisement and all other communications to third parties intended to promote or encourage the purchase or sale of goods or services in the United States.

M. The term “media outlet” is defined as any individual printed publication such as a newspaper or magazine; broadcast television or radio station; cable channel; or Internet website.

N. If in the following Interrogatories, Document Requests and Requests for Admission, privilege is alleged as to information or materials, or if an Interrogatory, Document Request or Request for Admission is otherwise not answered in full, state the specific grounds for not answering in full, and answer said Interrogatory, Document Request or Request for Admission to the extent to which it is not objected, including the identification of all information or material for which privilege may be claimed.

O. All questions are to be read so as to give the question the broadest possible meaning, so that, for example, when either of the terms "and" or "or" is used, it is to be construed as "and/or". Similarly use of the singular also includes the plural, use of any female pronouns also includes the male, and so forth.

P. Unless otherwise noted, the terms “sell,” “advertise,” “market,” and “promote” are to be interpreted as encompassing both the present act and the future intended act (e.g., “sell” shall also mean “intend to sell”).

Q. Unless otherwise noted, the geographic scope of these discovery requests is limited to the United States.

INTERROGATORIES

1. Identify each place of business which Applicant presently maintains in connection with trademark usage or trademark licensing in the United States, and describe the type of business activities in each place of business.

2. Identify and describe each Product Applicant sells under Applicant’s Marks.

3. For each Product identified in response to Interrogatory No. 2, above, identify the earliest date susceptible to proof when Applicant made such sales of that Product in the United States.

4. Identify the date that Applicant first used Applicant’s Marks in commerce in the United States.

5. Identify each person having knowledge of the dates and circumstances surrounding Applicant's first use and/or alleged trademark use of Applicant's Marks in connection with each Product identified in response to Interrogatory No. 2.

6. Identify three individuals most knowledgeable about the nature of the Applicant's business including the advertising, marketing, manufacturing, sales and/or licensing of Products bearing Applicant's Marks. For each individual identified provide:

7. Identify each person having knowledge of the dates and/or circumstances surrounding Applicant's creation, adoption, and/or acquisition of Applicant's Marks.

8. For each Product identified by Applicant in response to Interrogatory No. 2 as being sold under Applicant's Marks, set forth the amount of sales in dollars in the United States since the date of first use, broken down on a yearly basis.

9. Identify the total amount of marketing and/or advertising expenditures for Products bearing Applicant's Marks in the United States incurred by Applicant.

10. Describe in detail the reasons for the selection, adoption or creation of Applicant's Marks, including any connotations or meanings underlying or intended to be conveyed by Applicant's Marks.

11. Explain the significance of the term "OMEGA" or symbol "Ω" to Applicant or Applicant's Marks.

12. Identify any uses of Applicant's Marks in which the OMEGA portion of Applicant's Marks is emphasized, isolated or otherwise distinguished from the other elements of Applicant's Marks.

13. Describe in detail the channels of trade through which Applicant's Products under the Applicant's Marks are sold.

14. Identify all third party uses, through license agreements or otherwise, of Applicant's Marks in the United States of which Applicant is aware, including but not limited to uses of Applicant's Marks in the singular, plural, or uses in combination with other words, phrases or designs.

15. Identify all outlets through which third parties sell Products under Applicant's Marks.

16. Identify any assignment, license, royalty or other permitted use agreements with respect to any Products bearing Applicant's Marks.

17. Identify the target market and target consumers to whom Products bearing Applicant's Marks are sold.

18. Indicate the price range for each Product Applicant sells under Applicant's Marks.

19. Identify the specific media outlets through which Applicant advertises Products bearing Applicant's Marks in the United States.

20. Identify any websites through which Applicant currently advertises or sells Products bearing Applicant's Marks.

21. Identify, as precisely as you can, the date on which Applicant first became aware of Opposer's Marks, and describe how Applicant first became aware of them.

22. Identify any other marks incorporating the term "OMEGA" or symbol "Ω" which Applicants have used in connection with the sale, advertisement, or promotion of goods or services.

23. For each mark identified in response to the preceding Interrogatory, identify the products and services sold, advertised and/or marketed by Applicant under that mark.

24. Identify all applications filed by, or on behalf of, Applicant for federal or state registration of a mark incorporating the term "OMEGA" or symbol "Ω".

25. Identify all other uses by Applicant of term "OMEGA", the symbol "Ω", and/or Applicant's Marks, alone or in combination with other elements.

26. Identify any communication or instance where a person has contacted or communicated with Applicant believing that Applicant or Products sold under Applicant's Marks are related to, sponsored by, affiliated with, or controlled by Opposer.

27. State whether Applicant has conducted, caused to be conducted or obtained any trademark search, survey, poll, investigation, consumer perception study, market research study, focus group study or other study relating to any issue in this proceeding, including without limitation, whether any likelihood of confusion may exist between Opposer's Marks and Applicant's Mark prior to the adoption and use of Applicant's Mark.

28. Identify the results and contents of any searches as described in the answer to the preceding Interrogatory.

29. Identify all persons who have participated in any way in the preparation of the answer or responses to these Interrogatories. If more than one individual is identified, state specifically, with reference to Interrogatory numbers, the areas of participation of each such person.

Respectfully Submitted,

By: _____


Jess M. Collen
Thomas P. Gulick
Oren Gelber
COLLEN IP
THE HOLYOKE-MANHATTAN BUILDING
80 South Highland Avenue
Ossining, NY 10562
(914) 941-5668 Tel.
(914) 941-6091 Fax
Counsel for Opposer Omega SA (Omega AG)
(Omega Ltd.)

Date: March 27, 2013

Applicant's Exhibit 5

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: AΦΩ

Opp. No.: 91197505 (Parent)

Serial No.: 77905236

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

Opposer,

v.

ALPHA PHI OMEGA,

Applicant.

Mark: ALPHA PHI OMEGA and design

Opp. No.: 91197504 (Child)

Serial No.: 77950436

OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSION

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, and Rule 2.120(h) of the Trademark Rules of Practice for the United States Patent and Trademark Office, Opposer Omega SA (Omega AG) (Omega Ltd.) (hereafter, "Opposer"), through its undersigned counsel, hereby requests that Applicant Alpha Phi Omega ("Applicant") make the following admissions within thirty (30) days after service of these requests.

In answering these requests for admission, Applicant is required to admit or deny each request based on information as is available to Applicant and its agents, including information in the possession of Applicant's attorneys, investigators and other representatives. For each of

these requests for admission to which Applicant responds by asserting that it lacks sufficient information and/or knowledge, Applicant must state in detail the information required to answer said admission, and the steps taken by Applicant to investigate and/or obtain information in order to answer said request. These requests are deemed continuing and, to the extent that the answers may be enlarged, diminished or otherwise modified by information acquired by Applicant subsequent to the service of answers hereto, Applicant is requested promptly thereafter to serve supplemental answers reflecting such changes, where required by the Federal Rules of Civil Procedure.

Please note the instructions and definitions included in the Opposer's First Set of Interrogatories, served contemporaneously herewith, which are incorporated by reference and made a part hereof, as if fully stated herein.

REQUESTS

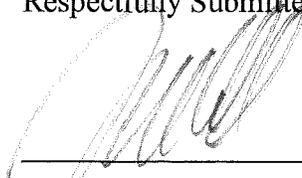
1. All documents produced by Applicant in response to Opposer's First Set of Requests for the Production of Documents and Things in this proceeding are genuine pursuant to the Federal Rules of Evidence.
2. All documents produced by Applicant in response to Opposer's First Set of Requests for the Production of Documents and Things in this proceeding are part of the business records of Applicant kept in the normal course of Applicant's business.
3. All documents produced by Applicant in response to Opposer's First Set of Requests for the Production of Documents and Things in this proceeding are admissible as evidence in this proceeding under the Federal Rules of Evidence, subject to any objections of Applicant on the grounds of relevance.

4. Applicant offers Products under Applicant's Marks in the United States through the internet.
5. Applicant offers Products under Applicant's Marks in the United States through jewelry stores.
6. Applicant offers Products under Applicant's Marks in the United States through stores that sell, among other things, watches.
7. Applicant was aware of the existence of Opposer's Marks prior to its adoption and use of Applicant's Marks.
8. Applicant was aware of the existence of one or more of Opposer's Marks prior to adoption and use of Applicant's Marks.
9. Prior to Applicant's filing of the Application, Applicant was aware of Opposer.
10. Prior to Applicant's filing of the Applications, Applicant was aware of one or more of Opposer's Marks.
11. Prior to Applicant's filing of the Applications, Applicant was aware that Opposer sold watches under one or more Opposer's Marks.
12. Prior to Applicant's filing of the Applications, Applicant was aware that Opposer sold jewelry under the marks OMEGA, Ω , and/or Ω + OMEGA.
13. The goods listed in the Applications for Applicant's Marks are highly similar to the goods and services Opposer offers under Opposer's Marks.

14. The date of first use of Opposer's Marks pre-dates the date of first use of Applicant's Marks.
15. Applicant applied to register Applicant's Marks in connection with goods listed in International Class 25, with knowledge of the Opposer's Marks
16. Applicant applied to register Applicant's Marks in connection with goods listed in International Class 14, with knowledge of the Opposer's Marks.
17. Opposer's Marks are well-known in the United States.
18. Opposer's Marks are famous marks.
19. Registration of Applicant's Marks is likely to dilute the distinctiveness of Opposer's Marks.
20. Registration of Applicant's Marks is likely to confuse consumers as to the source, sponsorship and/or affiliation of Applicant's goods.
21. Opposer's Marks are highly distinctive.
22. Opposer will be damaged by registration of Applicant's Marks.

Respectfully Submitted,

By:



Jess M. Collen
Thomas P. Gulick
Oren Gelber

COLLEN IP
THE HOLYOKE-MANHATTAN BUILDING
80 South Highland Avenue
Ossining, NY 10562
(914) 941-5668 Tel.
(914) 941-6091 Fax
Counsel for Opposer Omega SA (Omega AG)
(Omega Ltd.)

Dated: March 27, 2013

CERTIFICATE OF SERVICE

I, Richard Weinberg, hereby certify that on March 27, 2013, I caused true and correct copies of "Opposer's First Set of Interrogatories", "Opposer's First Requests for the Production of Documents and Things", and "Opposer's First Request for Admissions" to be served upon Applicant's Attorney of Record at the following addresses:

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

Via first-class mail, postage pre-paid.

Said service having taken place this 27 day of March, 2013



Applicant's Exhibit 6

**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: AΦΩ
Opp. No.: 91197505 (Parent)
Serial No.: 77905236

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

v.

ALPHA PHI OMEGA,
Applicant.

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

**OPPOSER'S FIRST SET OF REQUESTS FOR THE PRODUCTION
OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice for the United States Patent and Trademark Office, Opposer Omega SA (Omega AG) (Omega Ltd.) (“Opposer”) submits herewith for production by Applicant Alpha Phi Omega (“Applicant”) these Requests for the Production of Documents and Things.

Opposer hereby requests that Applicant produce the following documents and tangible things to the attention and at the address of the Opposer’s undersigned counsel’s offices at Collen *IP*, THE HOLYOKE-MANHATTAN BUILDING, 80 South Highland Avenue, Ossining,

New York, 10562 within thirty (30) days after service of these requests. These requests shall be deemed continuing, and require production of any documents called for herein or any such documents which shall come within the custody or control of Applicant, or its agents or representatives at any time between Applicant's initial production and the further prosecution of this action.

Please note the instructions and definitions included in the Opposer's First Set of Interrogatories, served contemporaneously herewith, which are incorporated by reference and made a part hereof, as if fully stated herein.

DOCUMENTS TO BE PRODUCED

1. All documents which refer to, relate to, or evidence the first use in interstate commerce of Applicant's Marks by Applicant.
2. Documents evidencing any corporations, companies, partnerships, joint ventures or like organizations, registered or unregistered, through which Applicant sells, advertises and/or markets Products bearing Applicant's Marks.
3. All documents relating to any application ever filed in the United States for federal or state registration of Applicant's Marks.
4. All documents that evidence, reflect, describe, refer to, or relate to the selection or creation of Applicant's Mark or any reason why you selected, adopted or applied to register this mark.
5. All documents evidencing, reflecting, or referring to the selection, availability, adoption, creation, design, use or proposed use of Applicant's Mark, including without limitation, any notes from any meetings or any telephone or video conferences at which such topics were discussed.

6. Documents relating to the manufacturing or developing of Products to be used with Applicant's Marks in the United States.

7. All licenses, agreements, consents or other documents concerning third-party use of Applicant's Marks in the United States.

8. All documents concerning third-party use of Applicant's Marks, whether authorized or unauthorized, in the United States.

9. All documents evidencing each Product with which Applicant's Marks are used in the United States.

10. Samples of actual Products sold in the United States under Applicant's Marks, with the mark clearly affixed in the ordinary manner in which the mark is affixed to goods for sale by Applicant, or by others authorized by, or in conjunction with, Applicant, in the ordinary course of business.

11. A sample of the complete packaging in which each and every Product sold or distributed by Applicant in the United States under the Applicant's Marks is:

- a. shipped from Applicant to Applicant's customers;
- b. displayed at the point of sale to the ultimate users; and/or
- c. contained when sold or distributed to the ultimate users.

12. Representative invoices evidencing Applicant's yearly sales (in dollars) in the United States, of Products bearing Applicant's Marks.

13. Representative documents identifying the number of Products bearing Applicant's Marks sold by Applicant in the United States.

14. Representative documents identifying Products bearing Applicant's Marks that are, or were, sold or advertised by Applicants in the United States.

15. All documents identifying Products Applicant plans to sell, market or develop in the United States under Applicant's Marks in the future.

16. Any tags or labels used by Applicants in connection with the sale of Products under the Applicant's Marks in the United States.

17. Samples promotional and advertising materials, created by or on behalf of Applicant, on which the term OMEGA or symbol "Ω" (alone or in connection with other elements) is printed, embossed, stamped, or otherwise affixed, whether or not such materials have been published or used in commerce.

18. A representative sample of documents showing all Products and promotional and advertising materials used or sold by Applicant in the United States, on which the term OMEGA or symbol "Ω" is emphasized, isolated or otherwise distinguished from the other elements of Applicant's Marks.

19. All communications concerning the significance of the term OMEGA or symbol "Ω" to Applicant and/or Applicant's Marks.

20. A representative sample of documents relating to the advertising in the United States of any Products sold by Applicant under Applicant's Marks, including invoices for advertising services, for each year the mark has been used.

21. A representative sample of documents relating to the promotion and marketing, including, but not limited to, point of sale and point of purchase materials, of any Products sold by Applicant in the United States under Applicant's Marks, for each year the mark has been used.

22. All documents identifying the channels of trade of the Products sold in the United States under the Applicant's Marks.

23. All documents relating or referring to the target consumers for any Products bearing the Applicant's Marks.

24. A listing of the Applicant's customers in the United States for Products sold under the Applicant's Marks.

25. Samples of all marketing and promotional materials, including, without limitation, labels, tags, packaging, brochures, advertisements, pamphlets, manuals, product information sheets, and any other promotional merchandise or literature, on which Applicant's Marks have been printed, embossed, stamped, or otherwise affixed, whether or not such materials have been published or used in commerce.

26. All documents that refer or relate to Opposer or to Opposer's Marks.

27. All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that Applicant conducted, caused to be conducted, or obtained in connection with the selection of the Applicant's Marks.

28. All trademark searches, surveys, polls, consumer perception studies, focus group studies, market research studies, or other investigations, searches, studies, or reports that include any reference to Opposer, Opposer's Marks, Applicant, or Applicant's Marks, and all documents that refer or relate to any such search, survey, poll, study, investigation or report.

29. All communications with any person other than Opposer concerning a dispute or potential dispute between Applicant and Opposer regarding trademark ownership rights in the United States.

30. All documents that constitute, evidence, reflect, describe, refer to, or relate to any investigation, trademark search, inquiry, survey, poll, consumer perception study, focus group

study, market research study, or other search, survey, poll, study, or investigation that relates to any mark that includes or consists of the term OMEGA or symbol “Ω”.

31. All documents that constitute, evidence, reflect, describe, refer to, or relate to any confusion expressed or experienced by any person between Applicant’s Mark and Opposer’s Marks, or between any Product offered for sale under Applicant’s Mark and any product offered for sale under Opposer’s Marks.

32. All documents identifying any domain names or websites owned or operated by Applicant that include the Applicant’s Mark, or the term OMEGA, alone or in combination with other words or elements.

33. All documents identifying domain names or websites through which Applicant sells or advertises Products bearing Applicant’s Mark.

34. Documents evidencing all other uses by Applicant of the term OMEGA, the symbol “Ω”, and/or the symbol that constitutes Applicant’s Mark, alone or in combination with other elements.

35. All documents on which Applicant intends to rely in this proceeding, including all documents that Applicant intends to offer into evidence in this proceeding.

36. All documents identifying, referring to or relating to any person whom Applicant intends to call as a fact or expert witness in this proceeding.

37. All documents Applicant has provided or shown to any person whom Applicant intends to call as a fact or expert witness in this proceeding.

38. All documents relied upon, either in whole or in part, as a basis for any opinion rendered or to be rendered by an expert witness whom Applicant may call to testify in this proceeding.

39. All statements, affidavits, declarations, reports and communications you have received from any person who is expected to give expert testimony as an expert witness on behalf of Applicant in this proceeding.

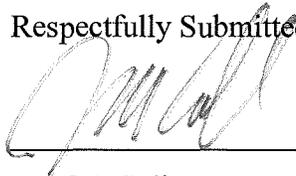
40. All documents identified by Applicant in response to Opposer's First Set of Interrogatories served contemporaneously herewith.

41. All documents that Applicant was required to identify, or from which Applicant obtained information, in responding to Opposer's First Set of Interrogatories, served contemporaneously with these Requests, and which documents have not been otherwise produced in response to these Requests.

42. All documents that Applicant contends are relevant to this proceeding.

Respectfully Submitted,

By:



Jess M. Collen
Thomas P. Gulick
Oren Gelber
COLLEN IP
THE HOLYOKE-MANHATTAN BUILDING
80 South Highland Avenue
Ossining, NY 10562
(914) 941-5668 Tel.
(914) 941-6091 Fax
Counsel for Opposer Omega SA (Omega AG)
(Omega Ltd.)

Date: March 27, 2013

Applicant's Exhibit 7

**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: AΦΩ

Opp. No.: 91197505 (Parent)

Serial No.: 77905236

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

Opposer,

v.

ALPHA PHI OMEGA,
Applicant.

Mark: ALPHA PHI OMEGA and design

Opp. No.: 91197504 (Child)

Serial No.: 77950436

**OPPOSER'S SECOND SET OF REQUESTS FOR THE PRODUCTION
OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice for the United States Patent and Trademark Office, Opposer Omega SA (Omega AG) (Omega Ltd.) ("Opposer") submits herewith for production by Applicant Alpha Phi Omega ("Applicant") these Requests for the Production of Documents and Things.

Opposer hereby requests that Applicant produce the following documents and tangible things to the attention and at the address of the Opposer's undersigned counsel's offices at Collen IP, THE HOLYOKE-MANHATTAN BUILDING, 80 South Highland Avenue, Ossining,

New York, 10562 within thirty (30) days after service of these requests. These requests shall be deemed continuing, and require production of any documents called for herein or any such documents which shall come within the custody or control of Applicant, or its agents or representatives at any time between Applicant's initial production and the further prosecution of this action.

Please note the instructions and definitions included in the Opposer's First Set of Interrogatories, served contemporaneously herewith, which are incorporated by reference and made a part hereof, as if fully stated herein.

DOCUMENTS TO BE PRODUCED

43. All documents that evidence, reflect, describe, refer to or relate to oral contracts or agreements Applicant has made with regards to Applicant's Marks.

44. All documents that evidence, reflect, describe, refer to or relate to the first time Applicant used Applicant's Marks on jewelry.

45. All documents that evidence, reflect, describe, refer to or relate to the first time Applicant used Applicant's Marks on watches.

46. All documents that evidence, reflect, describe, refer to or relate to the first time Applicant used Applicant's Marks on goods in Class 25.

47. All communications concerning the decision to place Applicant's Marks on watches.

48. All documents that evidence, reflect, describe, refer to or relate to the licensees that are allowed to sell goods bearing Applicant's Marks.

49. All documents that evidence, reflect, describe, refer to or relate to any time period between 1925 and present during which Applicant did not sell jewelry bearing Applicant's

Marks.

50. All documents that evidence, reflect, describe, refer to or relate to any time period between 1925 and present during which Applicant's licensees did not sell jewelry bearing Applicant's Marks

51. All communications concerning the decision by Applicant to cease selling jewelry bearing Applicant's Marks for any time period between 1925 and present.

52. All documents that evidence, reflect, describe, refer to or relate to yearly revenues that Applicant received from licensees who sell Products bearing Applicant's Mark.

53. All communications regarding, concerning or referencing the date Applicant's Trademark Registration No. 265,052 was cancelled.

54. All documents supporting Applicant's use(s) of the mark embodied in Trademark Registration No. 265,052 prior to its cancellation.

55. All documents that describe, refer to or relate to the reason Trademark Registration No. 265,052 was cancelled.

56. All documents that evidence, reflect, describe, refer to or relate to the yearly revenue from Applicant's direct sale of products affixed with Applicant's Marks between 1925 and present.

57. All documents that evidence, reflect, describe, refer to or relate to the date Applicant first sold products bearing Applicant's Marks through their website.

58. All documents that evidence, reflect, describe, refer to or relate to yearly revenues from Applicant's direct sale of products bearing Applicant's Marks through Applicant's website www.apo.org.

59. All documents that evidence, reflect, describe, refer to or relate to the first time

Applicant sold product(s) bearing Applicants Marks at the Applicant's National Convention.

60. All documents that evidence, reflect, describe, refer to or relate to the number of times between 1925 and present that Applicant has sold products bearing Applicant's Marks at Applicant's National Convention.

61. All licenses, agreements, consents or other documents granting third-parties the right to use Applicant's Marks.

62. Any licenses, agreements, consents or other documents granting third-parties the right to use Applicant's Marks on watches.

63. Any licenses, agreements, consents or other documents granting third-parties the right to use Applicant's Marks on jewelry.

64. All documents which refer to, relate to, or evidence Applicant's right to inspect its licensee's use of Applicant's Marks.

65. All documents which refer to, relate to, or evidence the procedure by which Applicant monitors licensees' use(s) of Applicant's Marks.

66. All documents which refer to, relate to, or evidence the frequency with which Applicant monitors licensees' use(s) of Applicant's Marks.

67. All communications concerning the licensees' use(s) of the Applicant's Marks as it relates to Applicant's quality control standards.

68. All documents provided by Affinity Consultants to Applicant regarding licensees' use(s) of Applicant's Marks.

69. All agreements between Applicant and Affinity Consultants relating to or referencing Applicant's Marks.

70. All quarterly reports Applicant has received from Affinity Consultants relating to

or referencing Applicant's Marks.

71. All recommendations made by Affinity Consultants to Applicant relating to Applicant's Marks.

72. All documents relevant to Affinity Consultants' policing of Applicant's Marks.

73. All documents relevant to Affinity Consultants' monitoring of Applicant's Marks.

74. All documents relevant to Affinity Consultants' quality control standards with regard to products bearing Applicant's Marks.

75. All documents which refer to, relate to, or evidence any oral agreements concerning Applicant's Marks between Applicant and any third party.

76. All documents that evidence, reflect, describe, refer to or relate to any contracts or agreements made on behalf of Applicant with Jostens regarding use of Applicant's Marks on watches.

77. All documents that evidence, reflect, describe, refer to or relate to any contracts or agreements made on behalf of Applicant with Greek Life regarding use of Applicant's Marks on watches.

78. All documents that evidence, reflect, describe, refer to or relate to any contracts or agreements made on behalf of Applicant with any third party regarding use of Applicant's Marks on watches.

79. All documents that evidence, reflect, describe, refer to or relate to any contracts or agreements between Applicant and Jostens regarding use of Applicant's Marks on watches.

80. All documents that evidence, reflect, describe, refer to or relate to any contracts or agreements between Applicant and Greek Life regarding use of Applicant's Marks on watches.

81. All documents that evidence, reflect, describe, refer to or relate to any contracts or

agreements between Applicant and any third party regarding use of Applicant's Marks on watches.

82. All documents that evidence, reflect, describe, refer to or relate to the termination of any licensee authorized by Applicant to use Applicant's Marks.

83. All documents that evidence, reflect, describe, refer to or relate to the termination of any licensee authorized by Affinity Consultants to use Applicant's Marks.

84. All documents that evidence, reflect, describe, refer to or relate to any audit reports of Applicant's licensees' use of Applicant's Marks.

Respectfully Submitted,

By: Oren Gelber

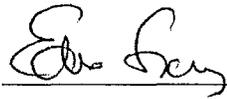
Jess M. Collen
Oren Gelber
COLLEN IP
THE HOLYOKE-MANHATTAN BUILDING
80 South Highland Avenue
Ossining, NY 10562
(914) 941-5668 Tel.
(914) 941-6091 Fax
Counsel for Opposer Omega SA (Omega AG)
(Omega Ltd.)

Date: June 17, 2013

CERTIFICATE OF SERVICE

I, Edie Garvey, hereby certify that I caused a true and correct copy of Opposer's Second Set of Requests For the Production of Documents and Things to be served upon the following, via first class mail, postage prepaid this 17th Day of June, 2013.

Stites & Harbison PLLC
400 W Market Street, Suite 1800
Louisville, KY 40202-3352
Attention: Jack A. Wheat, Esq.



Applicant's Exhibit 8

**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

**DECLARATION OF JACK A. WHEAT IN SUPPORT OF ALPHA PHI OMEGA'S
OPPOSITION TO MOTION TO DELAY CONSIDERATION OF MOTION FOR
SUMMARY JUDGMENT & FOR DISCOVERY**

Comes the Declarant, Jack A. Wheat, and acknowledging that all statements submitted herein are believed to be true and correct and are offered under penalty of perjury, I hereby submit the following;

1. I am lead counsel for applicant, Alpha Phi Omega, in this proceeding.
2. In the "meet & confer discussion" described in the pending motion, I recall informing Omega's counsel it is impossible to review Applicants records dating back over 90 years to locate any records relating to determine "the date of the first" clothing bearing any of Applicant's insignia or "the date of the first" watches bearing any of Applicant's insignia as well as the impossibility of locating any records relating to the initial decision to allow the production of watches bearing any of the insignia, and therefore was not "holding back" anything responsive to those requests.

3. It is an exaggeration though for Omega to contend that in our “meet & confer” discussion I assured Omega’s counsel everything relevant to this proceeding has been produced. Quite to the contrary, I specifically recall reminding her Alpha Phi Omega has used the name, ALPHA PHI OMEGA, and the Greek letter symbols, ΑΦΩ, since 1925 and numerous other fraternities and sororities also use marks containing the word “Omega” or the Greek alphabet letter, Ω, informing her we stand by our objection to the overbroad improper Request for Production No. 42, the request for “all documents that applicant contends are relevant to this proceeding.”

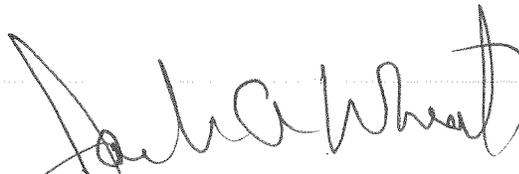
4. I further specifically recall telling her that Applicant’s pre-trial disclosures are not yet due, *we have not begun trial preparation*, we have not determined who our trial witnesses will be, and we have not decided which exhibits to utilize at trial. I specifically informed her we cannot and will not provide assurances anything and everything relevant to this proceeding has been produced, although we have proceeded to produce at least representative examples of non-objectionable material responsive to the reasonably particular document requests, as opposed to the overly broad Request for Production No. 42, the request for “all documents that applicant contends are relevant to this proceeding.”

5. I further specifically recall telling her that if we do proceed with any witnesses or exhibits *not already disclosed*, we will promptly supplement our disclosures.

6. The Designees for the Alpha Tau Omega Fraternity, the Alpha Chi Omega Fraternity for women, and the Chi Omega Fraternity for women were disclosed in our Initial Disclosures. Also, Daniel Shaver who manages the merchandising programs for nearly a hundred fraternities and sororities was disclosed in our Initial Disclosures. And, the day we received Declarations from them, we provided the Declarations to Omega’s counsel.

7. Further, multiple representative examples of the same types of examples provided with their Declarations were previously produced to Opposer's counsel at the outset of this proceeding. *See* Applicant's Exhibit 1.

I HEREBY DECLARE UNDER PENALTY OF PERJURY THE FOREGOING IS BELIEVED TO BE TRUE AND CORRECT.



Jack A. Wheat

Date: September 22, 2014

AL169:00AL1:996005:1:LOUISVILLE