

ESTTA Tracking number: **ESTTA628492**

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	Other Motions/Papers
Filer's Name	Jack A. Wheat
Filer's e-mail	jwheat@stites.com
Signature	/jackawheat/
Date	09/22/2014
Attachments	AppX1 Dec 27, 2010 Corres.pdf(2111537 bytes)

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

Jess M. Collen
December 27, 2010
Page 2

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.

Further, Greek merchandise is purchased by sophisticated consumers in a very narrow niche channel of trade, namely, channels of trade featuring fraternity and sorority merchandise, markets uniquely directed to members of collegiate fraternities and sororities, and tightly controlled by a licensing official (Affinity Marketing Consultants, *see* <http://www.greeklicensing.com/about.asp>).

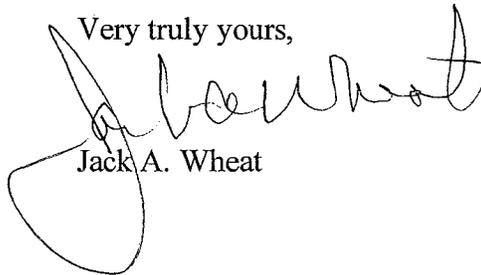
The target customers for Alpha Phi Omega merchandise, namely members of Alpha Phi Omega, are not at all likely to assume that clothing or jewelry bearing their organization's name or insignia is affiliated with your client. Joining a fraternity or sorority is not an impulsive spur of the moment decision. To join a collegiate fraternal organizations like Alpha Phi Omega, an individual must first identify the organization and express his or her interest therein. Then, the organizations must invite the individual to join. Finally, the individual is initiated into the organization and is required to fulfill certain obligations to maintain his or her membership status. These obligations often include paying dues and participating in events. Clearly, this process, and a member's continuing involvement in the organization, makes that member a sophisticated purchaser. Therefore, both the intimate familiarity created through membership and the narrow and tightly controlled channels of trade serve to preclude any confusion between Alpha Phi Omega and your client.

The simple solution is to amend our client's recitation of goods to note that the goods are "purchased by and for members of the Alpha Phi Omega collegiate fraternity through authorized vendors featuring fraternity and sorority affinity merchandise." We are willing to propose this solution to our client if you think it is workable.

We look forward to hearing from you.

Jess M. Collen
December 27, 2010
Page 3

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, sweeping initial "J".

Jack A. Wheat

cc: Alpha Phi Omega (w/encls.)

AL169:00AL1:815483:1:LOUISVILLE



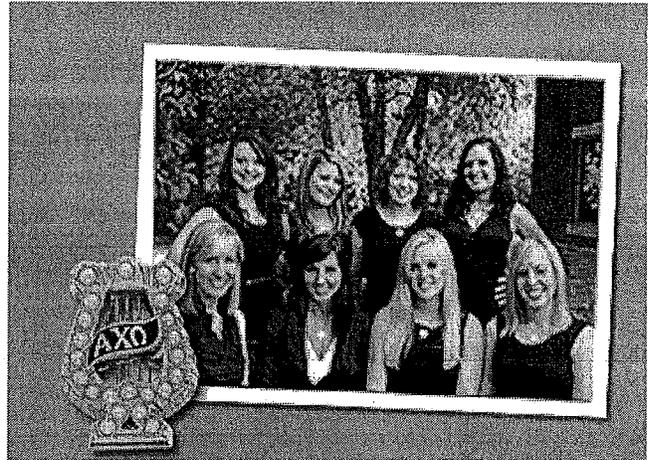
Home Shop Brochure About FAQs Contact Us Your Cart

Alpha Chi Omega Online Store

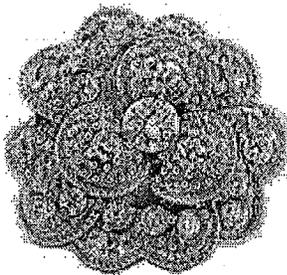
Search Alpha Chi Omega Products:

[Catalog](#) » Alpha Chi Omega

The Greek Division of Herff Jones serves as Official Jeweler to a majority of college fraternities, sororities, honor societies, professional, and local organizations. It is our constant goal not only to meet, but to exceed our customers' deservedly high expectations for the finest in Greek jewelry craftsmanship, exceptional quality, experienced personal service, and an enduring commitment to the Greek system. [View our movie](#) showing how we make your membership more meaningful!

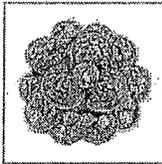


Featured Product

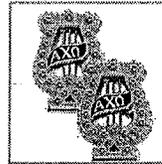


Carnation Brooch
Sterling silver and cubic zirconia.

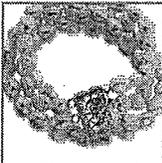
Products



Accessories



Badges & Pins



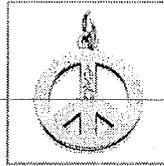
Bracelets



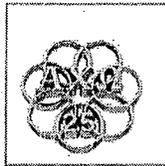
Earrings & Necklaces



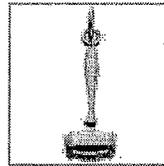
Guards



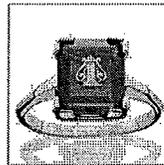
Lavalieres & Charms



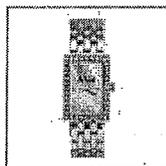
Milestone Pieces



Officer Dangles



Rings



Watches

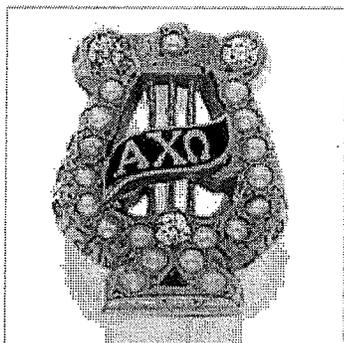
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Alpha Chi Omega Online Store

[Catalog](#) » [Alpha Chi Omega](#) » [Badges & Pins](#) » [Crown Pearl Badge with 3 Diamonds](#)



Crown Pearl Badge with 3 Diamonds J70010117

5/8" h. x 1/2" w.

This product is not available to purchase online.

This item must be ordered through your National Headquarters. Please contact them at 317.579.5050.

Product returns must be made within thirty (30) days of ship date for reasons unrelated to a quality defect or incorrect item. Products that are customarily stocked by Herff Jones and that are returned for reason(s) other than product quality are subject to a restocking fee of 25% of order value.

Custom-made products are not returnable; this includes all rings and any other non-stock jewelry items. Customer is responsible for any postal or shipping charges incurred in returning the product to the Greek Division of Herff Jones

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Keywords or Item #s

SEARCH

DESIGN YOUR OWN GREEK GEAR

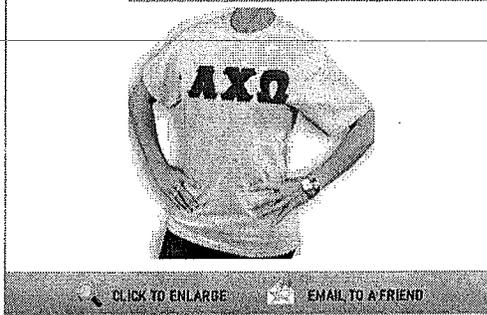
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--Select Sorority--

--Select Fraternity--

HOME · ALPHA CHI OMEGA MERCHANDISE & GIFTS · ALPHA CHI OMEGA LETTERED SHIRTS

IMAGE VIEW



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Alpha Chi Omega Lettered Shirts

IHO-Alpha IHO-Chi Omega Lettered Shirts

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Our Price: \$21.95

As Low As: \$13.50

Apparel: Size

Apparel Color: Choose

Foreground Letters: Choose
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Background Letters: None
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Production Time: Produced in 5 working days(+10.00)

Quantity: 1 SEE IT BEFORE YOU BUY! CLICK HERE

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ITEM DESCRIPTION CUSTOMER REVIEWS SIZING & COLOR INFO GREEK GEAR RECOMMENDS

The "Classic" Alpha Delta Pi sorority lettered T-Shirt. This Greek Tee is a must for every Alpha Della.Pi on campus! 100% heavyweight cotton T-shirts.. Our T-Shirts are "unisex" - Geared more towards men so order size accordingly. [View Color Swatches](#)

[View new patterned twill](#)

[Production Times And Policies](#)



Alpha Chi Omega Afghan Blanket Throw
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Alpha Chi Omega Sweatshirts Hoodie
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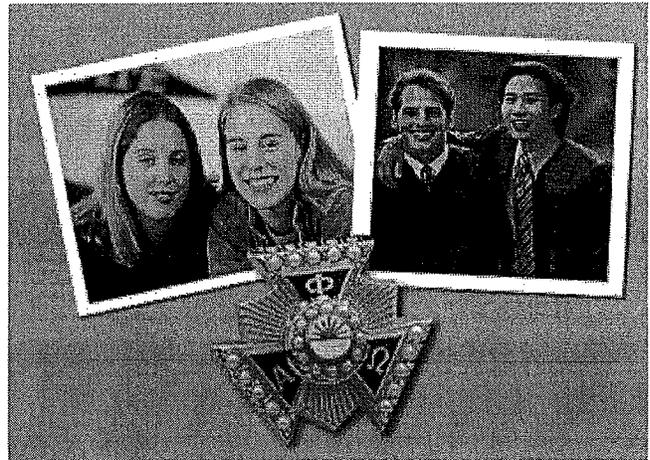
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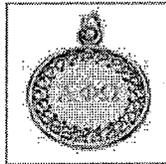


Featured Product

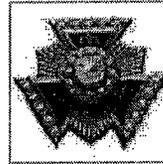


Small Round Filigree Charm with Engraving
3/4" Diameter.

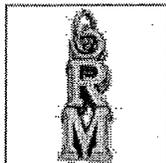
Products



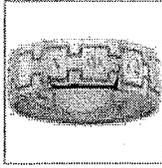
Accessories



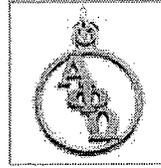
Official Jewelry



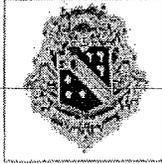
Officer Dangles



Rings



Charms



Lapel /
Recognition
Pins

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Alpha Phi Omega Online Store

[Catalog](#) » [Alpha Phi Omega](#) » [Accessories](#) » [Small Round Filigree Charm with Engraving](#)



Small Round Filigree Charm with Engraving J71040419E

3/4" Diameter.

Select Material:

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Custom-made products are not returnable; this includes all rings and any other non-stock jewelry items. Customer is responsible for any postal or shipping charges incurred in returning the product to the Greek Division of Herff Jones

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greek Items in Cart: 0 Subtotal: \$0.00 [VIEW CART](#) [CHECKOUT](#) [R.COM](#)

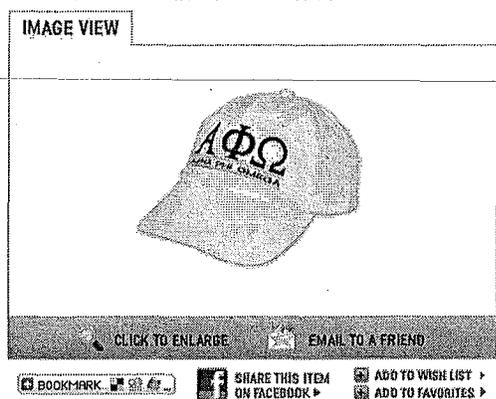
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Text Color: Choose

Text Below Bar:

Production Time: Produced in 1 working Day (+10.00)

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ITEM DESCRIPTION | **CUSTOMER REVIEWS** | **SIZING & COLOR INFO** | **GREEK GEAR RECOMMENDS**

Now you can customize your own Alpha Phi Omega fraternity hats! These Alpha Phi Omega fraternity hats are the best quality, low profile hats available! They are made from durable 100% cotton with a low profile, comfortable fit and adjustable closing band! Order more and save!

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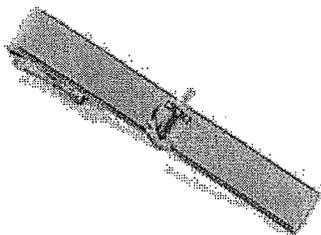
Go

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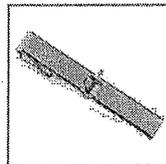


Featured Product

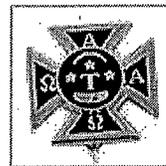


Tie Bar
Tie bar mounted with Alpha Tau Omega enameled crest in Gold Filled. 2" x 1/4"

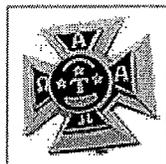
Products



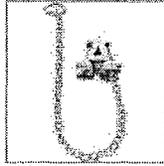
Accessories



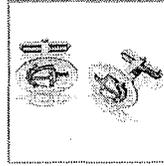
Sweetheart Jewelry / Gifts



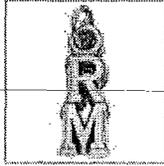
Official Badges



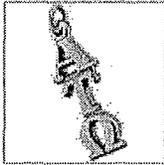
Chapter Guards



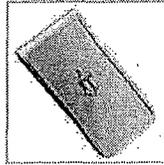
Cufflinks



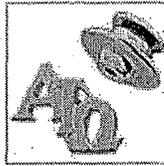
Officer Dangles



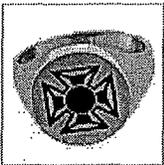
Lavalieres & Pendants



Money Clip



Lapel / Recognition Pins



Rings

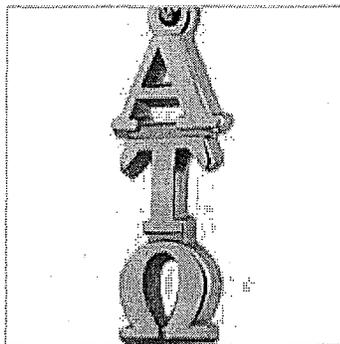
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Alpha Tau Omega Online Store

[Catalog](#) » [Alpha Tau Omega](#) » [Lavalieres & Pendants](#) » [Traditional Lavalier](#)



Traditional Lavalier L2647ALTAOM

The most popular lavalier in our line. This traditional lavalier or "drop" featuring ATO Greek letters is oriented vertically as a pendant. Finely polished on all surfaces. (Chain sold separately.) 3/4" L.

Select Metal Quality:

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Keywords or Item #s

SEARCH

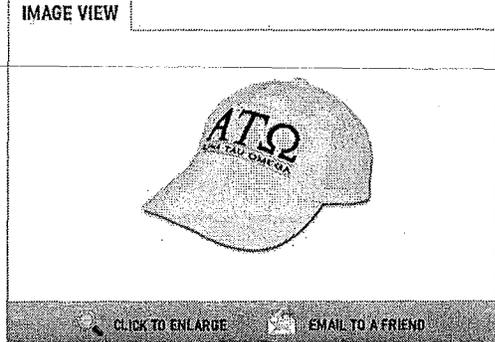
DESIGN YOUR OWN GREEK GEAR

FAST SHIP GUARANTEE
CLICK HERE

--Select Sorority--

--Select Fraternity--

HOME : ALPHA TAU OMEGA MERCHANDISE & GIFTS : ALPHA TAU OMEGA CLOTHING : ALPHA TAU OMEGA LINE HAT



Alpha Tau Omega Line Hat

IHO-Alpha Tau Omega Line Hat

[Rate and Review this Item](#)

Our Price: \$18.95

As Low As: \$10.00

Hat Color: Choose

Line Color: Choose

Text Color: Choose

Text Below Bar:

Production Time: Produced in 1 working Day (+10.00)

Quantity: 1

ADD TO CART

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ITEM DESCRIPTION CUSTOMER REVIEWS SIZING & COLOR INFO GREEK GEAR RECOMMENDS

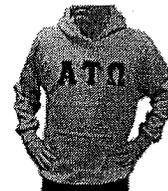
Now you can customize your own Alpha Tau Omega fraternity hats! These Alpha Tau Omega fraternity hats are the best quality, low profile hats available! They are made from durable 100% cotton with a low profile, comfortable fit and adjustable closing band! Order more and save!

View Thread Colors

Get optional embroidery on back by [clicking here!](#)

[Click here to see other Alpha Tau Omega hats & Caps](#)

[Production Times And Policies](#)



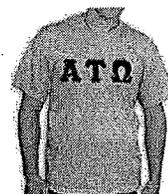
Alpha Tau Omega Sweatshirts Hoodie
Reg. Price: \$58.95
Sale Price: \$53.95

[VIEW DETAILS](#)



Alpha Tau Omega Line Hat
As Low As: \$10.00

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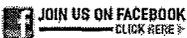
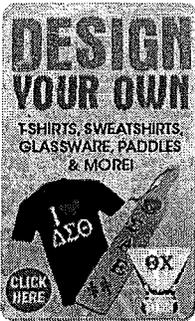
Alpha Tau Omega Lettered T-Shirt
As Low As: \$13.50

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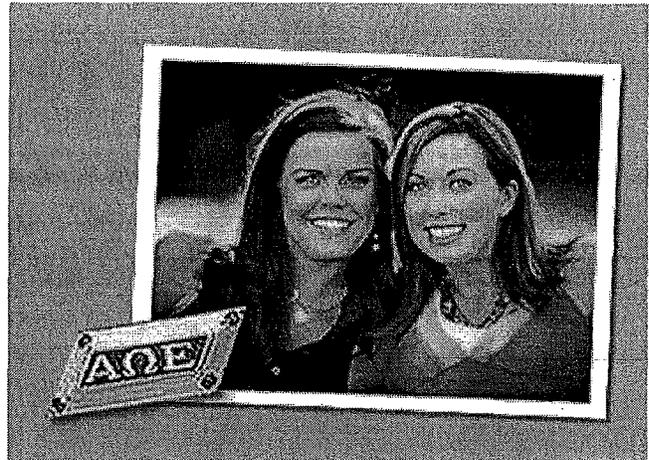
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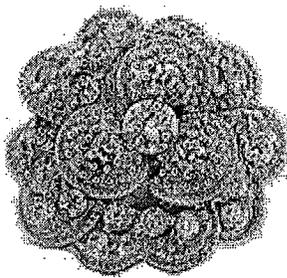
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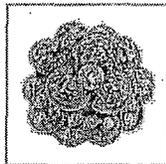


Featured Product

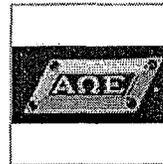


Carnation Brooch
Sterling silver and cubic zirconia.

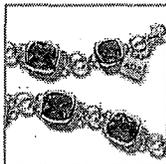
Products



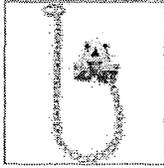
Accessories



Badges & Guards



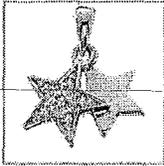
Bracelets



Chapter Guards



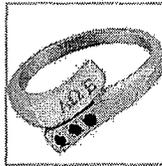
Dangles



Lavalieres & Charms



Pins & Buttons



Rings



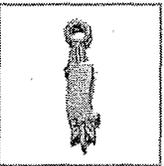
President Committees



Vice President Committees



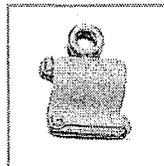
Treasurer Committees



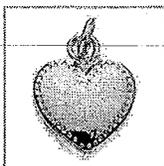
Secretary Committees



Interchapter
Relations
Committees



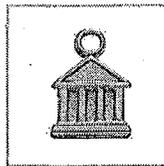
Director of
Publications
Committees



Alumnae
Relations Officer
Committees



Director of
Expansion
Committees



Chapter
Committees



Foundation



Necklaces

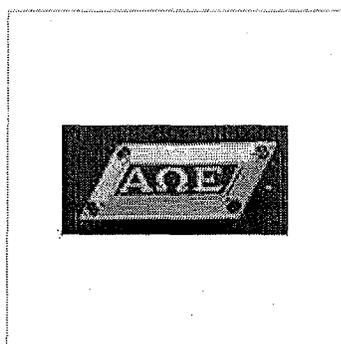
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[Catalog](#) » [Alpha Omega Epsilon](#) » [Badges & Guards](#) » Plain Badge w/4 *Sapphires



Plain Badge w/4 *Sapphires J70390101

*Sapphires are synthetic. 3/4" W x 5/16"
H.

Select Material:

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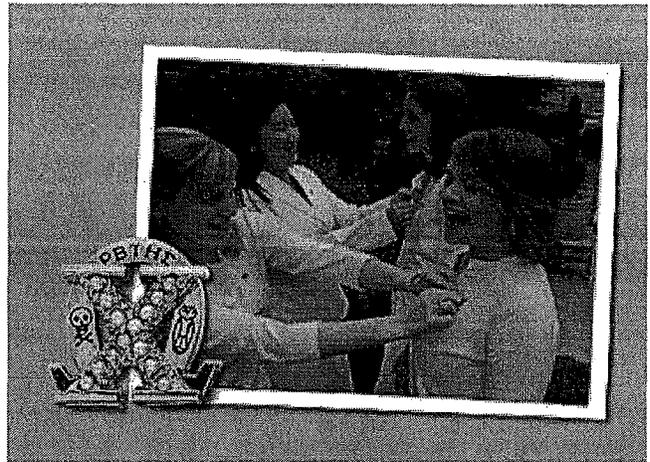
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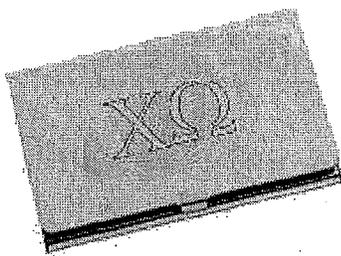
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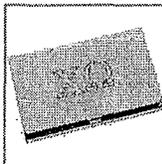


Featured Product

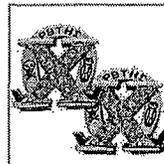


Business Card Case with Chi Omega Engraved
2 1/2" X 3 5/8".

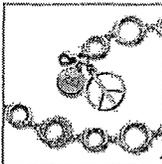
Products



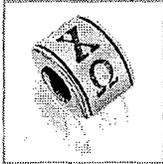
Accessories



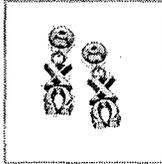
Badges & Guards



Bracelets



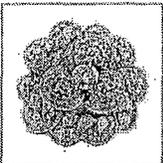
Charms



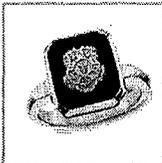
Earrings



Necklaces



Pins



Rings



Dangles

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Chi Omega Online Store

[Catalog](#) » [Chi Omega](#) » [Charms](#) » [Eternity Necklace](#)



Eternity Necklace J70133883CZ OR RUBY

18" L. Chain. Your choice of rubies or cz's. Colored stones are synthetic.

Select Metal Quality:

Select Stone Selection:

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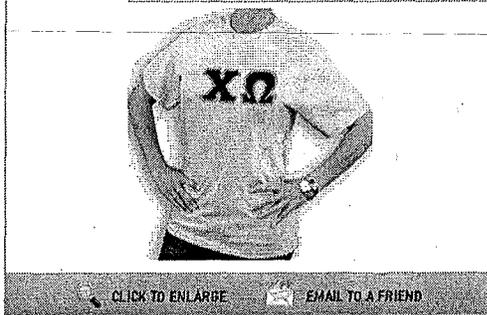
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--Select Sorority--

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HOME : CHI OMEGA MERCHANDISE & GIFTS : CHI OMEGA LETTERED SHIRTS

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(2 reviews)

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Size

Apparel Color:

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Foreground Letters:

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Background Letters:

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Production Time:

Produced in 5 working days(+10.00)

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ITEM DESCRIPTION | CUSTOMER REVIEWS | SIZING & COLOR INFO | GREEK GEAR RECOMMENDS

The "Classic" Chi Omega sorority lettered T-Shirt. This Greek Tee is a must for every Chi Omega on campus! 100% heavyweight cotton T-shirts.. Our T-Shirts are "unisex" - Geared more towards men so order size accordingly. [View Color Swatches](#)

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Chi Omega T-Shirts & Tees

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Chi Omega Line Hat

Our Price: \$18.95

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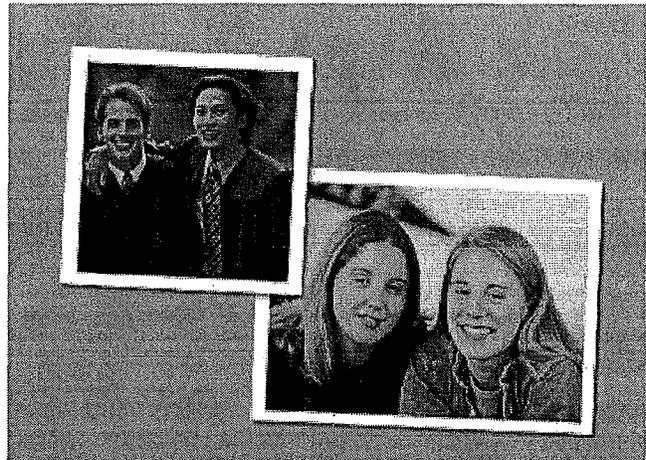
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Omega Tau Sigma Online Store

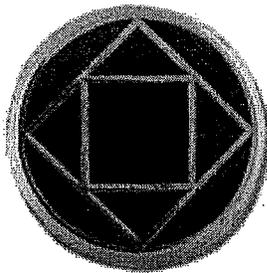
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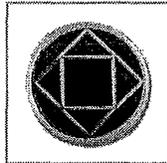


Featured Product

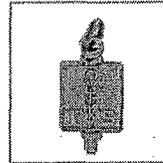


Pledge Button
Measures approximately 3/8".

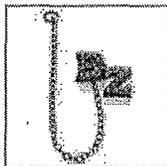
Products



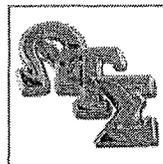
Badges



Charms



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Dangles

Lavalieres &
Buttons

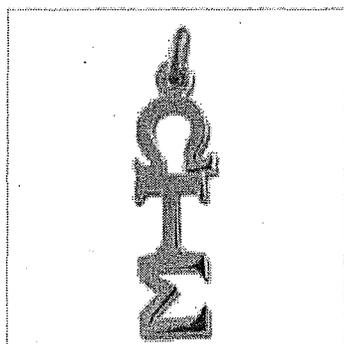
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Omega Tau Sigma Online Store

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Vertical Letter Lavalier L2647OMTASI

Select Metal Quality:

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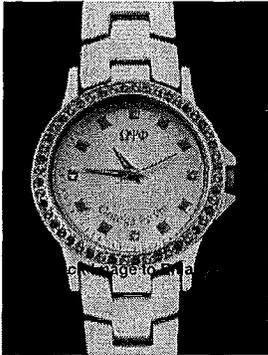
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Omega Psi Phi Watch

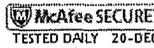
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Price: **\$39.99**

Quantity Desired:

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Description for Omega Psi Phi Watch

Here is a great looking Omega Psi Phi Watch. This watch features your organization's name and letters on the face of this custom greek watch.

Additional Information

[When Will I Get this Item ?](#)

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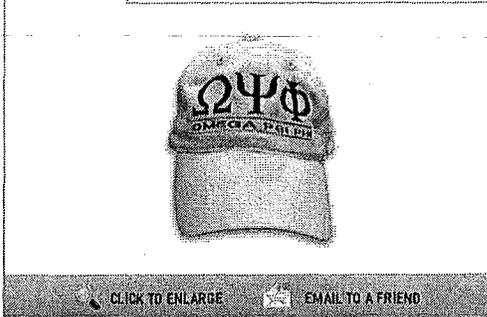
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HOME : SHOP BY SORORITY : DIVINE NINE GEAR : OMEGA PSI PHI MERCHANDISE & GIFTS : OMEGA PSI PHI GIFTS ITEMS : OMEGA PSI PHI LINE HAT

IMAGE VIEW



Omega Psi Phi Line Hat

IHO-Omega Psi Phi Line Hat-2

★★★★★ (1 review)

Our Price: \$18.95

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Hat Color:

Line Color:

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Quantity:

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ITEM DESCRIPTION **CUSTOMER REVIEWS** **SIZING & COLOR INFO** **GREEK GEAR RECOMMENDS**

Now you can customize your own Omega Psi Phi fraternity hats! These Omega Psi Phi fraternity hats are the best quality, low profile hats available! They are made from durable 100% cotton with a low profile, comfortable fit and adjustable closing band! Order more and save!

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Omega Psi Phi Afghan Blanket Throw
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Sale Price: \$49.95
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Omega Psi Phi Sweatshirts Hoodie
Our Price: \$53.95
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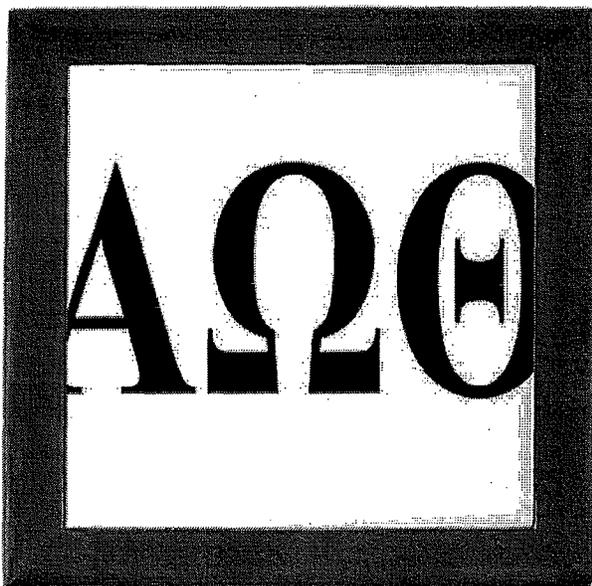
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CafePress > Keepsake Boxes > ALPHA OMEGA THETA Tile Box

\$22.00 ALPHA OMEGA THETA Tile Box



Keepsake Box

Perfect for stylishly storing jewelry and mementos, this hardwood box showcases a ceramic tile. Spring-loaded hinged lid stays open without tipping the box over and snaps closed securely.

- Made of solid hardwood with high-gloss lacquer finish
- Interior is fully lined in velvet; bottom is covered with felt
- Measures 5.5" x 5.5" x 2.25" with a 4.25" x 4.25" ceramic tile

Select Color: Mahogany

Product ID: 214682979



Quantity: 1

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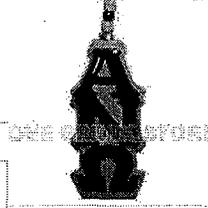
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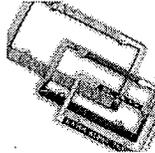
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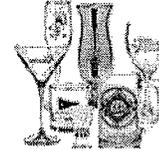
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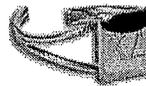
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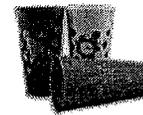
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