

ESTTA Tracking number: **ESTTA632693**

Filing date: **10/14/2014**

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

Proceeding	91197504
Party	Plaintiff Omega SA (Omega AG) (Omega Ltd.)
Correspondence Address	JESS M COLLEN COLLEN IP THE HOLYOKE-MANHATTAN BUILDING, 80 SOUTH HIGHLAND AVENUE OSSINING, NY 10562 UNITED STATES ogelber@collenip.com, tgulick@collenip.com, docket@collenip.com
Submission	Reply in Support of Motion
Filer's Name	Thomas P. Gulick
Filer's e-mail	tgulick@collenip.com, ogelber@collenip.com, docket@collenip.com
Signature	/Thomas P. Gulick/
Date	10/14/2014
Attachments	k655 reply motion - 56d.pdf(398537 bytes )

ATTORNEY DOCKET NO. K655, K654

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

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

Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

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

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

Opposer,

v.

ALPHA PHI OMEGA,  
Applicant.

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

**OPPOSER'S REPLY IN SUPPORT OF MOTION:**

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

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

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

A. INTRODUCTION

Applicant mischaracterizes Opposer's Motion. Regardless of whether Applicant's mischaracterization is a purposeful attempt to distract attention from the issues before the Board, or whether it is the misunderstanding of the applicable law and rules, the Applicant's Opposition fails to address Opposer's Rule 56(d) Motion (D.E. 63). Applicant's Opposition brief advocates improper and inapplicable standards under Trademark and Federal Rules.

## B. ARGUMENT

### 1. *Applicant Mischaracterizes Opposer's Requested Relief and the Applicable Legal Standard*

In response to Applicant's Motion for Summary Judgment, Opposer filed a Motion seeking (1) the Board's Consideration of Motion to Preclude and Compel Prior to Considering Summary Judgment Motion; and (2) Suspend Time for Opposer's Opposition to Applicant's Motion for Summary Judgment; or, in the alternative, (3) Motion Under Rule 56(d) to Take Discovery. D.E. 63. The relief sought was clearly articulated in bold lettering at the top of Opposer's Motion, in headings within Opposer's Motion, and was repeated a number of times in the body of Opposer's Motion. *Id.* at pp. 1, 4, 5, 9-10. Given the numerous instances in which Opposer refers to the relief requested, and the concise nature of Opposer's Motion, it is surprising that Applicant could or would misconstrue Opposer's Motion so drastically. Whether purposeful or inadvertent, Applicant's misstatement of Opposer's position renders Applicant's Opposition Brief (D.E. 65 & 66) unresponsive and inapplicable to the instant motion.

Applicant incorrectly labels Opposer's Motion as an attempt to delay and reopen discovery. *Id.* 65 at p. 1, 3 and 17.<sup>1</sup> Opposer seeks neither, as is clear from its Motion. D.E. 63. Rather, Opposer asks the Board to decide Opposer's Motion to Preclude and Compel (D.E. 59) prior to deciding Applicant's Motion for Summary Judgment (D.E. 58). If the Board decides Opposer's Motion to Preclude and Compel (D.E. 59) before taking up summary judgment and precludes the declarations and exhibits thereto, significant evidence in support of Applicant's Motion for Summary Judgment is removed.

Alternatively, Opposer has requested the opportunity to take additional discovery under Rule 56(d) which will permit Opposer to respond to Applicant's Motion for Summary Judgment. *See* D.E. 63. Applicant has opted to interpret Opposer's very clear request for additional discovery under Rule 56(d) as a demand for re-opening discovery under Fed. R. Civ. P. 6(b). D.E. 65, p. 4. Not only has Applicant cited the wrong Rule, it has also advocated the wrong standard. (The "excusable neglect" standard asserted by Applicant is inapplicable to Opposer's Motion (D.E. 63) because Opposer seeks discovery

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<sup>1</sup> Applicant claims undue delay relying on a number of consented suspensions in these proceedings.

under Rule 56(d).) Clearly, the Rule 56(d) standard governs this portion of Opposer's Motion.

Under Fed. R. Civ. P. 56(d) and TBMP § 528.06, if a nonmoving party has demonstrated a need for discovery that is reasonably directed to obtaining facts essential to its opposition to the motion for summary judgment, discovery will be permitted, especially if the information sought is largely within the control of the party moving for summary judgment. *Orion Group Inc. v. Orion Insurance Co.*, 12 USPQ2d 1923, 1925-26 (TTAB 1989).

Timely and properly filed Rule 56(d) motions for discovery are generally granted as a matter of course. *Doe v. Abington Friends Sch.*, 480 F.3d 252, 257 (3d Cir. 2007). Courts generally require a Rule 56(d) movant to establish three things: (i) a description of the particular discovery the movant intends to seek; (ii) an explanation showing how that discovery would preclude the entry of summary judgment; and (iii) a statement justifying why this discovery had not been or could not have been obtained earlier. *Id.* at 255 n. 3 (3d Cir. 2007). Opposer has done that in its opening brief. See D.E. p. 1-3; 7-9.

Regarding Opposer's Motion seeking consideration of its Motion to Preclude and Compel (D.E. 59) prior to consideration of Applicant's Motion for Summary Judgment (D.E. 58) and alternatively requesting the opportunity to take necessary discovery under Rule 56(d). D.E. 63. Applicant advocates the wrong standard of review and cites inapplicable case law.

Given Applicant's failure to address the subject matter of Opposer's Motion, the Applicant's Opposition Brief does not set forth any basis for denial of Opposer's Motion. Opposer again asks the Board to grant Opposer's Motion seeking (1) the Board's Consideration of Motion to Preclude and Compel Prior to Considering Summary Judgment Motion; and (2) Suspend Time for Opposer's Opposition to Applicant's Motion for Summary Judgment; or, in the alternative, (3) Motion Under Rule 56(d) to Take Discovery. D.E. 63.

2. *The Facts Clearly Establish that Applicant's Litigation Tactics Prevented Opposer from Taking the Needed Discovery*

Applicant's evasive discovery tactics prevented Opposer from obtaining needed discovery. To

the extent that the Board does not decide Opposer's Motion to Preclude and Compel first, discovery under Rule 56(d) is warranted.

Purely as a result of Applicant's conduct, Opposer was precluded from taking discovery, including discovery depositions, with regard to third party uses. Applicant knew of information and documents to be produced but withheld production of such evidence, despite its alleged availability in 2010 and 2011, as Applicant itself notes (D.E. 62 at pp. 4-7). Not until the eve of the opening of Opposer's testimony period, did Applicant choose to stop withholding certain documents. Applicant's Opposition brief ignores this four (4) year delay and seeks to shift the blame for Applicant's conduct to Opposer. D.E. 65 at pp. 3-5.

While Applicant may have disclosed the existence of documents and potential witnesses, it never produced such documents during discovery. The Trademark Rules clearly state that mere disclosure "is not an invitation, however, to hold back material items" until the last minute. TBMP § 408.03; see also *Galaxy Metal Gear, Inc. v. Direct Access Tech., Inc.*, 2009 TTAB LEXIS 529, \*7, 91 USPQ2d 1859, 1861 (TTAB 2009)(citing Wright, Miller & Marcus, 8 Fed. Prac. & Pro. Civ. 2d § 2049.1 (2009)).

Just over two (2) weeks before Applicant's dilatory and prejudicial document production (on July 9, 2014), Applicant's counsel again represented to Opposer that Applicant had previously produced all responsive documents. See Declaration of Oren Gelber in support of Opposer's Motion to Compel, D.E. 59 at Declaration ¶ 20. Furthermore, from its experience in *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396 (N.D. Tex. 2011), Applicant's counsel is well aware that such last minute production of witness statements is objectionable. In that case, Applicant's counsel was among the attorneys defending a group of Greek organizations in the Northern District of Texas; similar to this case, defense counsel in the *Abraham* case attempted to submit third party sworn statements in support of their Motion for Summary Judgment. *Abraham*, 781 F. Supp. 2d at 425 (N.D. Tex. 2011). The *Abraham* Court granted the plaintiff's request to strike the third party declarations "due to the untimeliness of their disclosure and [plaintiff's] inability to cross-examine those who made the statements," also noting the potential prejudice to the plaintiff. *Id.* at 426.

Among other things, Opposer specifically requested from Applicant all documents which Applicant intended to rely upon, documents which identified fact or expert witnesses, and documents which Applicant contends are relevant to these proceedings in Document Request Nos. 35, 36, and 42. D.E. 59, pp. 11-15. Opposer sought supplementation from Applicant of these discovery requests on multiple occasions. *Id.* at pp. 4-7 and Declaration of Oren Gelber in Support of Motion to Compel (Gelber Decl.) at ¶ 8 12, 13, 15, 17, 20 and Exhibits 2, 5. Opposer issued deficiency letters to Applicant and held three (3) meet and confer telephone conferences with Applicant's counsel. *Id.* At each of these conferences, Opposer sought assurances from Applicant's counsel that no documents or information were being withheld. Applicant's counsel repeatedly attested to the fact that it was not withholding any documents and information and that what it had produced was what it had. *Id.* pp. 2-3, 4, 7, Gelber Decl. ¶ 20. However, Applicant's counsel repeatedly resisted making such statements in writing. *Id.* Opposer was constrained to move to compel Applicant's production as a result of Applicant's actions. D.E. 59.

Applicant's evasive tactics prevented Opposer from obtaining the discovery necessary to rebut Applicant's Summary Judgment Motion and required the filing of Opposer's Motion to Preclude and Compel. For these reasons, if the Board does not address Opposer's Motion to Preclude and Compel (D.E. 59) prior to Applicant's Motion for Summary Judgment (D.E. 58), the Board should grant Opposer's request for additional discovery under Rule 56(d).

3. *The July 25, 2014 Document Production Was and Is Responsive to Opposer's Discovery Requests*

Applicant knowingly withheld documents until the very last minute. During discovery, Opposer sought documents from Applicant upon which Applicant intended to rely and documents related to witnesses. D.E. 59, pp. 11-12 and Exhibit 1. Specifically, Opposer's Document Request No. 35 seeks<sup>2</sup> all documents on which Applicant intends to rely in this proceeding, including all documents that

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<sup>2</sup> Applicant incorrectly opts to focus its arguments on Document Request No. 42. D.E. 65, p. 15-16. The pertinent Document Requests at issue are Request Nos. 35 and 36.

Applicant intends to offer into evidence in this proceeding. *Id.* Applicant responded that “other than the documents being produced [in] response to all of these requests, documents Applicant has not yet selected any other documents upon which it intends to rely, but will timely identify and produce same.” *Id.* Opposer’s Request No. 36 seeks all documents identifying, referring to or relating to any person whom Applicant intends to call as a fact or expert witness in this proceeding. *Id.* Applicant responded that it “has not yet selected persons it intends to call as witnesses in this proceeding, but will timely identify its witness(es).” *Id.* Applicant made no objections to this Request and submitted only these single sentence responses vowing to produce responsive documents. As such, Applicant waived all other objections to these Requests. *See Gov’t Benefits Analysts, Inc. v. Gradient Ins. Brokerage Inc.*, 2012 U.S. Dist. LEXIS 110154, \*16 (D. Kan. Aug. 7, 2012).

Applicant has articulated no basis for not supplementing its production to these Requests in a timely manner, although Applicant admits knowledge and access to these documents and information prior to discovery. D.E. 62 at pp. 4-7, D.E. 65 at p. 8. Opposer pursued supplemental discovery with regard to these Document Requests to no avail. *See generally*, D.E. 59 pp. 5-9. In one of its prior submissions, Applicant crudely called for a time to “put up or shut up.” D.E. 52 at 3, 4. If that is the case, Applicant refuses to follow its own rule.

Allegations that materials were previously disclosed as early as 2010 are disingenuous. The declarations for the four (4) third-party witnesses were never previously produced to Opposer, and some of the documents are new and others are similar but are not the same as those produced on July 25, 2014.

Absent documentary evidence upon which Applicant intended to rely in response to Document Request No. 35, there was little basis for Opposer, to take discovery or testimonial depositions with respect to the declarants. Given Applicant’s failure to produce documents during discovery, Applicant would have no evidentiary basis to support any arguments relating to third parties in its Motion for Summary Judgment. Additionally, absent the last minute production of the third party documents on July 25 2014, Applicant would have no basis for taking the depositions of the declarants during the testimony period.

It is evident that the documents and declarants were available to Applicant dating back to, at the latest, 2013. Applicant could have produced this material in response to Document Request Nos. 35 and 36. If Applicant had no intention of sandbagging Opposer, it could have produced the documents over a year ago, not wait until discovery was closed and just days before filing summary judgment. Applicant's heavy reliance on the July 25, 2014 production for its Motion for Summary Judgment demonstrates Applicant's clear intention to prejudice Opposer.

It is clear from the record and from Applicant's opposition brief that it had no reasonable or good faith basis for withholding these documents. Applicant's withholding of relevant, responsive documents is the very definition of prejudice, undue delay, and unfair surprise. See TBMP §§ 408.01(a) and (b); Fed. R. Civ. P. 26(g) and TMBP § 408.01(c). Accordingly, the Board should decide Opposer's Motion to Preclude and Compel (D.E. 59) prior to consideration of Applicant's Motion for Summary Judgment. In the alternative, Opposer respectfully requests that its Rule 56(d) Motion for additional discovery be granted. *See* D.E. 63 pp. 6-10.

### **C. CONCLUSION**

Because Applicant opted to misconstrue Opposer's Motion, it advocates the wrong standard in opposition to Opposer's requested relief. Applicant has also failed to articulate any valid reason for depriving Opposer of additional discovery necessary to respond to Applicant's Summary Judgment Motion. Accordingly, Opposer requests that the Board decide its Motion to Preclude and Compel prior to deciding Applicant's Motion for Summary Judgment. A decision on Opposer's Motion to Preclude and Compel would be in the interest of judicial efficiency and may resolve evidentiary issues and Opposer's need for additional discovery before responding substantively to Applicant's Motion for Summary Judgment. If the Board decides to determine the Motion to Preclude and Compel first, Opposer seeks a suspension of time in order to respond to Applicant's Motion for Summary Judgment.

In the alternative, Opposer requests an order permitting it to take the depositions of Wampler, Smiley, Shaver and Miraglia relating to their declarations and corresponding exhibits filed in support of

Applicant's Motion for Summary Judgment. While Opposer believes all of the declarations and other supporting documents must be precluded in light of Applicant's decisions about how to carry out its litigation obligations, Opposer – in the alternative – would otherwise be entitled to take discovery. For these reasons, Opposer's instant Motion should be granted.

Respectfully Submitted,

By: Thomas Gulick

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: October 14, 2014  
JMC/TPG/OG/KAM:

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

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

COLLEN IP

By: Peter Mulhern Date: October 14, 2014

**CERTIFICATE OF SERVICE**

I, Peter Mulhern, hereby certify that a copy of the OPPOSER'S REPLY IN SUPPORT OF MOTION:

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

was served by First Class U.S. Mail, postage prepaid on this 14th Day of October 2014 upon

Jack A. Wheat

Stites & Harbison PLLC

400 W Market St Ste 1800

Louisville, KY 40202-3352



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Peter Mulhern