

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: March 4, 2015

Opposition No. 91197504
(**Parent Case**)
Opposition No. 91197505

Omega SA (Omega AG) (Omega Ltd.)

v.

Alpha Phi Omega

**George C. Pologeorgis,
Interlocutory Attorney:**

These consolidated proceedings now come before the Board for consideration of the following motions:

1. Opposer's motion (filed June 30, 2014) for reconsideration of the Board's May 31, 2014, discovery order;
2. Applicant's motion (filed July 29, 2014) for summary judgment;
3. Opposer's motion (filed July 29, 2014) to preclude unjustifiably delayed discovery or, in the alternative, to compel discovery;
4. Opposer's motion (filed September 2, 2014) requesting that the Board consider Opposer's motion to preclude delayed discovery prior to entertaining Applicant's motion for summary judgment and for Rule 56(d) discovery; and
5. Applicant's motion (filed October 9, 2014) to consolidate.

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All the motions are fully briefed, except for Applicant's motion for summary judgment.

Opposer's Motion for Reconsideration

The Board first turns to Opposer's motion for reconsideration. By way of its motion, Opposer seeks reconsideration of a portion of the Board's May 31, 2014, discovery order regarding certain requests for admission propounded by Applicant. Specifically, Opposer seeks reconsideration of the Board's ruling that Opposer provide an unqualified admission or denial to each of the following three admission requests:

Admission Request No. 3

Admit that Opposer has no evidentiary basis to dispute that the word "Omega" has been continuously used in the United States as part of the of the name of various Greek letter social, professional, or honorary fraternities or sororities since prior to the introduction into the United States by or on behalf of Opposer or Opposer's predecessor(s) in the interest of any product bearing any of the marks upon which the Opposition is based.

Admission Request No. 4

Admit that Opposer has no evidentiary basis to dispute that the Greek Alphabet letter, Ω, has been continuously used in the United States as part of the of the Greek letter designation of Greek letter social, professional, or honorary fraternities or sororities since prior to the introduction into the United States by or on behalf of Opposer or Opposer's predecessor(s) in the interest of any product bearing any of the marks upon which the Opposition is based.

Admission Request No. 14

Admit that Opposer has no evidentiary basis to dispute that various Greek letter social, professional, or honorary fraternities or sororities with the word "Omega" in their name have continuously marketed and/or approved others to marked on their behalf products bearing insignia

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containing the word “Omega” or the Greek Alphabet letter, Ω , dating back prior to the introduction into the United States by or on behalf of Opposer or Opposer’s predecessor(s) in the interest of any product bearing any of the marks upon which the Opposition is based.

In support of its motion, Opposer maintains that the wording “evidentiary basis” included in the above admission requests is “problematic” because Applicant appears to be insisting on the equivalent reading of its phrase “evidentiary basis” and the simple word “evidence.” Opposer interprets the wording “evidentiary basis” to include both the existence of evidence and a lack of other documents. Further, Opposer contends that because of the compound nature of the admission requests at issue, it is nearly impossible to discern a proper response to the requests.

The Board is not persuaded by Opposer’s interpretation of the phrase “evidentiary basis” or any of its other arguments. The Board does not find the admission requests at issue to be ambiguous or vague or impossible to answer. Either Opposer has evidence to dispute the contentions in the admission requests at issue or it does not.

In view thereof, Opposer’s motion for reconsideration is **DENIED** to the extent noted below.

Opposer is allowed until **thirty (30) days** from the mailing date of this order to provide Applicant an unqualified admission or denial to Applicant’s Admission Request Nos. 3, 4, and 14. To the extent Opposer provides an unqualified denial to any of these requests, Opposer is allowed the same **thirty (30) days** to produce documents to support the denial pursuant to

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Applicant's Document Request No. 21. Alternatively, if Opposer lacks information or knowledge as a reason for failing to admit or deny any of the subject admission requests, Opposer must state in response to the admission request that it has made a reasonable inquiry and that the information known or readily obtainable by Opposer is insufficient to enable Opposer to admit or deny. Fed. R. Civ. P. 36(a)(4); TBMP § 407.03(b).

Opposer's Motion To Preclude Delayed Discovery Responses And To Compel Written Discovery

The Board next turns to Opposer's motion to preclude delayed discovery responses from being considered in this consolidated case and to compel written discovery. The Board initially addresses the portion of Opposer's motion to preclude certain "alleged" discovery responses.

In support of its motion, Opposer maintains that, on July 25, 2014, Applicant produced 134 pages of supplemental documents. Opposer further contends that the document production included declarations from three individuals reportedly associated with three non-party fraternities/sororities, namely, Alpha Tau Omega, Alpha Chi Omega and Chi Omega, as well as a declaration from Applicant's licensee, Affinity Marketing Consultants. Opposer additionally states that the July 25, 2014 production included Internet printouts relating to Alpha Tau Omega, Alpha Chi Omega and Chi Omega's products, printouts from third party websites regarding Opposer's products, and copies of third party U.S. Trademark Registrations. Opposer argues that Applicant had access to this information and documents well

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prior to July 25, 2014 and Applicant's unjustifiably late disclosure of these documents on the eve of Opposer's testimony period and so long after the close of discovery has deprived Opposer an opportunity to examine these declarants, ascertain the provenance of the documents, and/or seek any follow-up discovery and therefore has given Applicant an unfair advantage in this consolidated case. Accordingly, Opposer requests that the Board give no consideration to Applicant's July 25, 2014, supplemental production.

The Board does not construe Applicant's July 25, 2014 service of the four declarations and accompanying exhibits, as well as the other identified documentation, as a delayed supplementation of discovery responses by Applicant. The Board notes that Applicant has submitted the declarations and documents as exhibits to its motion for summary judgment filed on July 29, 2014. As such, the Board views Applicant's service of these declarations, accompanying exhibits and documents on Opposer prior to filing its motion for summary judgment as a mere courtesy. Notwithstanding the foregoing, the Board does not find the service of the declaration of Applicant's licensee and accompanying exhibits thereto at this juncture in these consolidated proceedings to be unfair or prejudicial to Opposer. The Board notes that Applicant clearly identified Applicant's licensee in its initial disclosures as a party who would have discoverable information regarding Applicant's defenses in this matter. Opposer could have taken the discovery deposition of Applicant's licensee or propounded discovery requests directed to the

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information Applicant's licensee may possess, as set forth in Applicant's initial disclosures, during discovery but chose not to do so. Accordingly, Opposer cannot now complain that it will be prejudiced in any manner if the Board considers the declaration of Applicant's licensee or the exhibits attached thereto. With regard to the remaining declarations, as discussed more fully below, the Board will provide Opposer an opportunity to cure any prejudice these declarations and attached exhibits may impose on Opposer in these consolidated proceedings.

In view thereof, Opposer's motion to preclude Applicant's July 25, 2014 service of declarations and documents from being considered in these consolidated proceedings is **DENIED**.

The Board next turns to the portion of Opposer's motion requesting the Board to compel responses to certain document requests propounded by Opposer. Initially, the Board notes that Opposer filed its combined motion to preclude delayed discovery responses and to compel written discovery on the same day Applicant filed its motion for summary judgment, i.e., July 29, 2014. The Board notes, however, that Applicant's motion was filed earlier in the day than Opposer's motion. Under such circumstances, the Board would generally find that Opposer's motion to compel is not germane to Applicant's motion for summary judgment and give it no consideration. However, in this instance and in the interest of thoroughness, the Board, in its discretion, will entertain Opposer's motion to compel.

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Initially, the Board finds that Opposer has made a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention. *See* Trademark Rule 2.120(e)(1).

As to the merits of Opposer's motion to compel, the motion is **GRANTED**, in part, and **DENIED**, in part, to the extent noted below:

Document Request No. 1

This document requests seeks documents which demonstrate first use of Applicant's involved marks in commerce. Applicant's involved marks are as follows:



1.  for "jewelry" in International Class 14 (application Serial No. 77950436 subject to Opposition No. 91197504); and
2. ΑΦΩ for "headwear, jackets, shirts, and sweatshirts" in International Class 25 (application Serial No. 77905236 subject to Opposition No. 91197505).

In response to this request, Applicant produced what appears to be a trademark application executed in June of 1929 solely for the letters ΑΦΩ for use on fraternity badges, lapel buttons, scarf lapel and breast pins, cuff links, tie clasps, charms, finger rings, belt buckles, and ornamental shields, all of precious metal which states that the mark has been continuously used since December 15, 1925. Applicant further stated it did not have any further documents referencing Applicant's dates of first use.

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The Board has reviewed the documents produced by Applicant and finds that these documents are not responsive to Document Request No. 1.

Applicant's production does not demonstrate its first use of the its



mark used in association with jewelry nor do the documents produced demonstrate Applicant's first use of the mark ΑΦΩ used in connection with headwear, jackets, shirts, and sweatshirts. Applicant's production only demonstrates use the lettering ΑΦΩ (without the shield design element) for fraternity badges, lapel buttons, scarf lapel and breast pins, cuff links, tie clasps, charms, finger rings, belt buckles, and ornamental shields, all of precious metal.

In view of the foregoing, the motion is **GRANTED** to the extent that Applicant must produce documents which demonstrate Applicant's first use of each of Applicant's subject marks for the goods identified, as set forth in each of Applicant's involved applications.

Document Request 35

The motion is **DENIED** inasmuch as the above document request impermissibly seeks documents upon which Applicant intends to rely upon in connection with this proceeding. A party is not required, in advance of trial, to disclose each document or other exhibit it plans to introduce into evidence to support either its claims or defense. *See* TBMP § 414(7).

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Document Request No. 36

Motion is **GRANTED** to the extent that Applicant must produce documents which the identify of each person Applicant is currently intending to call to testify on its behalf in this consolidated case. The identity of trial witnesses is discoverable information. TBMP § 414(7).

Document Request No. 44

This document request seeks all documents Applicant contends are relevant to this proceeding. For essentially the same reasons the Board denied Opposer's motion with regard to Document Request No. 35, the Board similarly finds this request inappropriate. In view thereof, the motion is **DENIED** with regard to this document request.

Document Request No. 45

The above-identified document request seeks production of documents concerning Applicant's first use of its involved marks on watches. The Board notes that the goods identified in Applicant's involved applications are solely for jewelry and clothing items. Accordingly, the Board finds this request is not relevant to the issues in this proceeding. In view thereof, Opposer's motion to compel is **DENIED** with regard to this requests.

Document Request No. 46

The above-identified document request seeks production of documents concerning Applicant's first use of its involved marks on goods identified in International Class 25. The Board finds this document request appropriate based upon the claims asserted in this matter. TBMP § 414(5). In view

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thereof, the motion to compel is **GRANTED** with regard to this request to the extent that Applicant must produce documents which demonstrate its first use of its subject mark in Application Serial No. 77905236 on the goods identified in the application, i.e., headwear, jackets, shirts, and sweatshirts.¹

Document Request No. 47

The above-identified document request seeks production of documents regarding Applicant's decision to place Applicant's involved mark on watches. While the Board finds that Applicant's use of its subject marks on watches may be relevant to the claims asserted in this consolidated case, the reason why Applicant decided to place its subject marks on watches is not. Accordingly, the motion is **DENIED** with regard to this request.

Document Request No. 56

The above-identified document request seeks documents that evidence the yearly revenue from Applicant's direct sales of products affixed with Applicant's involved marks between 1925 and the present. The Board finds that documents responsive to this request are relevant to the issues in this consolidated case and therefore Applicant's objection on relevancy is overruled. *See* TBMP § 414(18). Notwithstanding its relevancy objection to this document request, Applicant nonetheless produced a representative sampling of documents reflecting sales totals for the last five years. Applicant explained that it could not provide sales information since 1925

¹ The Board notes that Applicant's involved application Serial No. 77950436 (subject to Opposition No. 91197504) does not identify any goods in International Class 25.

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because it does not have access to any records relating to such sales dating back to that date and that such documentation is not the type a non-profit fraternity should be expected to retain.

In view of Applicant's response, Applicant is **precluded** from relying upon or introducing any other evidence reflecting revenue from sales of products affixed with Applicant's involved marks other than sale records for the last five years it has already produced. In light of this ruling, the motion to compel as it pertains to this document request is **DENIED**.

Opposer's Motion for Rule 56(d) Discovery

The Board next turns to Opposer's motion for Rule 56(d) discovery. In support of its motion, Opposer contends that in order to respond properly to Applicant's motion for summary judgment it requests an order permitting it to take the depositions of Dan Shaver, Carol Miraglia, Janine Wampler, and Wynn Smiley, as to the substance of their declarations and exhibits, submitted in support of Applicant's motion for summary judgment.

Rule 56(d) provides, in pertinent part, that a party that believes it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit or declaration showing that the nonmoving party cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion. See Fed. R. Civ. P. 56(f); *Opryland U.S.A. Inc. v. Great American Music Show Inc.*, 970

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F.2d 847, 23 USPQ 2d 1471 (Fed. Cir. 1992); and *Keebler Co. v. Murray Bakery Products*, 866 F2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

As the movant in the Rule 56(d) motion, Opposer bears the burden of persuasion in establishing why the Board should grant it the opportunity to seek specifically identified information in order to respond to Applicant's summary judgment motion. The party seeking to conduct additional discovery must put forth sufficient facts to show that such evidence exists and is not pure speculation. *See e.g., Vold v. D.A. Davison & Co.*, 816 F2d 1406, 1416 (9th Cir. 1987). Rule 56(d) discovery is not a substitute for full-blown pre-trial discovery. Under Rule 56(d), Opposer is limited to discovery it must have in order to respond to the motion for summary judgment. *See T. Jeffrey Quinn, TIPS FROM THE TTAB; Discovery Safeguards in Motions for Summary Judgment; No Fishing Allowed*, 80 Trademark Rep. 413 (1990). *Cf. Fleming Companies v. Thriftway Inc.*, 21 USPQ2d 1451 (TTAB 1991), *Aff'd* 26 USPQ2d 1551 (S.D. Ohio 1992).

Opposer's motion for Rule 56(d) discovery, is **GRANTED**, in part, and **DENIED**, in part, for the reasons set forth below.

The Board finds that Opposer has sufficiently demonstrated a need to take the deposition of the declarants from the non-party fraternities/sororities, namely, Carol Miraglia, Janine Wampler, and Wynn Smiley. The Board notes that Applicant, in its initial disclosures, identified **thirty designees** of various non-party fraternities/sororities who would have

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discoverable information regarding use of the term OMEGA or the Greek Alphabet letter Ω used in association with their respective Greek organizations, as well as on collateral goods such as jewelry. Applicant, however, did not identify these designees by name. Additionally, Applicant, in response to Opposer's document request seeking the identity of Applicant's intended witnesses, stated that it has not yet selected persons it intends to call as witnesses in this proceeding, but will timely identify its witness(es).

Obviously, Opposer could not have taken the discovery depositions of all thirty non-party fraternity/sorority representatives during discovery since that would exceed the number of depositions permitted under Board rules.² Moreover, in light of Applicant's failure to identify which persons it intended to call as witnesses, Opposer could not ascertain which of the thirty designees Applicant intended to rely upon as potential witnesses. In view of the foregoing, the Board finds that Opposer has sufficiently demonstrated a need to take the depositions of Carol Miraglia, Janine Wampler, and Wynn Smiley, particularly since Applicant relies upon these individual's declarations in support of its motion for summary judgment. The depositions of Carol Miraglia, Janine Wampler, and Wynn Smiley, however, must be limited to the topics raised in their respective declarations, and may include testimony regarding any documents attached to their declarations.

² Absent leave of court or stipulation of the parties, Fed. R. Civ. P. 30(a)(2)(A)(i) limits the amount of depositions in a civil proceeding to only ten. Fed. R. Civ. P. 30(a)(2)(A)(i) is made applicable to this proceeding by Trademark Rule 2.116(a).

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With regard to Opposer's request to permit the deposition of Applicant's licensee, Dan Shaver, the Board finds that Opposer has failed to demonstrate the need to take his deposition. As explained above, Mr. Shaver was clearly identified in Applicant's initial disclosures. As such, Opposer should have reasonably viewed Mr. Shaver as a possible witness. *See Spier Wines (PTY) Ltd. V. Shepherd*, 105 USPQ2d 1239, 1242 (TTAB 2012) ("persons identified in initial disclosures may reasonably viewed as possible trial witnesses"). Opposer could have taken Mr. Shaver's deposition during the discovery period but chose not to do so. Opposer cannot now complain that it will be prejudiced by Mr. Shaver's declaration or any testimony Mr. Shaver may provide during Applicant's assigned testimony period. *See Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). Accordingly, Opposer's Rule 56(d) motion as it pertains to Mr. Shaver is **DENIED**.

Applicant's Motion To Consolidate

The Board finally turns to Applicant's motion to consolidate. Applicant seeks to consolidate this consolidated case with consolidated proceedings No. 91214449 (Parent) for the limited purpose of entertaining the motions for summary judgment filed in each consolidated case. Applicant maintains that because (1) the co-pending motions for summary judgment are in all material respects essentially identical and both present the identical dispositive issues, (2) the plaintiff in both consolidated cases is the same, and (3) the defendants in both consolidated cases are fraternities whose subject marks

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include the term OMEGA, consolidating the cases for the limited purpose of uniform consideration of the co-pending motions for summary will serve the interest of efficiency and judicial economy.

While the Board acknowledges that there are common issues of fact and law raised in the motions for summary judgment filed in both consolidated cases, the Board finds it unorthodox to consolidate both consolidated cases for the limited purpose of entertaining both motions for summary judgment in tandem, particularly since (1) the defendants in each consolidated case differ, (2) the defendants' marks at issue in each consolidated case differ, (3) the goods/services at issue differ, in part, (4) each consolidated proceeding is at a different stage in the litigation, and (5) the record presented by each motion for summary judgment is not identical. There is also a risk of differing dispositions based on each record. Accordingly, the Board does not find it appropriate to consolidate this consolidated case with consolidated proceedings 91214449 for the limited purpose of entertaining simultaneously the co-pending motions for summary judgment filed in each case. In view thereof, Applicant's motion to consolidate is **DENIED**.

Summary

1. Opposer's motion for reconsideration is **DENIED** to the extent indicated herein;

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2. Opposer's motion to preclude any consideration of the documentation provided by Applicant on Opposer on July 25, 2014 is **DENIED**;
3. Opposer's motion to compel is **GRANTED**, in part, **DENIED**, in part. Applicant is allowed until **thirty (30) days** from the mailing date of this order to copy and produce non-privileged documents responsive to Opposer's Document Request Nos. 1, 36, and 46, to the extent indicated herein. If there are no responsive, non-privileged documents in Applicant's possession, custody or control which are responsive to any of the above-identified document requests, Applicant must so state affirmatively in its response to the corresponding document request. To the extent Applicant has already fully produced documents responsive to any of the above-identified document requests, Applicant must so state in its response to the particular document request and identify, by bates number, the documents which are responsive to each request;
4. Applicant's motion to consolidate is **DENIED**;
5. Opposer's motion for Rule 56(d) discovery is **GRANTED**, in part, and **DENIED**, in part. Opposer is allowed until **forty-five (45) days** from the mailing date of this order in which to notice, take, and complete the discovery depositions of Carol Miraglia, Janine Wampler, and Wynn Smiley only. To the extent any of the

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foregoing non-party witnesses is not willing to testify voluntarily, Opposer must secure their attendance by obtaining a subpoena issued from the United States district court in the federal judicial district where the deponent resides or is regularly employed. TBMP § 404.03(a)(2).³

Opposer is allowed until **thirty (30) days** from the expiration of the forty-five day period provided above or the date the last deposition is taken permitted by this order, whichever is earlier, in which to file and serve its response to Applicant's motion for summary judgment.

A reply brief in support of Applicant's motion for summary judgment, if filed, must be filed in accordance with Trademark Rule 2.127(e).

Proceedings are otherwise suspended pending the disposition of Applicant's motion for summary judgment.

As a final matter, the Board finds that the parties to this consolidated case have been quite litigious. Accordingly, to the extent a party wishes to file an unconsented motion in this consolidated case, such party must first obtain prior Board approval by contacting the interlocutory attorney assigned to this case telephonically with opposing counsel on the line. In the event

³ The Board notes that Opposer has also filed a motion for Rule 56(d) discovery in consolidated proceedings No. 91214449 which seeks permission to take the depositions of Carol Miraglia, Janine Wampler, and Wynn Smiley, among others. In the event Opposer's motion for Rule 56(d) is granted with regard to Ms. Miraglia, Ms. Wampler, and Mr. Smiley in consolidated proceedings No. 91214449, Opposer will not be required to take separate depositions for each of the aforementioned individuals for this consolidated case and for consolidated proceedings No. 91214449.

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either party files an unconsented motion without prior Board approval, said motion will be summarily denied.