

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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GCP

Mailed: September 22, 2015

Opposition No. 91197504

*Omega SA (Omega AG) (Omega Ltd.)*

v.

*Alpha Phi Omega*

**By the Trademark Trial and Appeal Board:**

Pending before the Board is (1) Applicant's motion for summary judgment on Opposer's asserted claims of likelihood of confusion and dilution, and (2) Applicant's motion to supplement legal authority in support of its motion for summary judgment.

In reviewing Applicant's motion for summary judgment, the Board has determined that additional briefing is required regarding the claim of dilution. The Board notes that Section 43(c) of the Trademark Act provides that:

"[s]ubject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, **shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring** or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury."

15 U.S.C. § 1125(c) (emphasis added).

The Board requires the parties to further brief the following issue: whether a plaintiff, in order to prove a dilution claim under the Trademark Act in a Board proceeding where defendant's application/registration is based on use in commerce, must establish that its mark became famous prior to the defendant's use of its subject mark in commerce as to any goods or services or whether plaintiff must establish that its mark became famous prior to defendant's use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant's subject application or registration.

Accordingly, Applicant is allowed until **October 12, 2015** in which to submit supplemental briefing solely on the issue identified above. In turn, Opposer is allowed until **November 2, 2015** in which to submit its supplemental briefing. Applicant is then allowed until **November 22, 2015** in which to file a reply to Opposer's supplemental briefing.

Proceedings otherwise remain suspended pending the disposition of Applicant's motion for summary judgment and Applicant's motion to submit supplemental legal authority to support its motion for summary judgment.