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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.)
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**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 OPPOSITION TO APPLICANT'S
SUPPLEMENTAL BRIEFING ON SUMMARY JUDGEMENT**

I. INTRODUCTION

The Federal Circuit has held that in a challenge to a use based application on the grounds of dilution, the proper date at which to consider the fame of Opposer's mark is the application filing date (even if there is evidence of earlier use by the Applicant). *See generally, Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012). The Federal Circuit's decision is binding precedent on the Board. Similarly, the analysis should be limited to Applicant's use of the challenged mark in association with the specific goods listed in the challenged applications. It is well-settled that in proceedings before the Board the analysis is limited to the "four corners" of the subject application. Applicant cannot rely on its existing registrations for different marks and different goods to try to get an earlier date of first use.

This proceeding is limited to the narrow question of registrability of the specific marks and goods in the challenged applications. The Board's analysis should reflect this by considering only the filing date of the challenged applications and the goods recited therein.

Nonetheless, should the Board decide to stray from the Federal Circuit's decision in *Coach*, Applicant has provided no evidence to support its claim that it has been using the marks that are the subject of these opposition proceedings continuously since 1925. In fact, there is no evidence besides the uncorroborated testimony of Applicant's 30(b)(6) witness to support any use of these marks by Applicant prior to the application filing dates. Applicant's witness has only been employed by Applicant since 2002 and therefore lacks personal knowledge of any use prior to that date. Even if the Board were to assess Opposer's fame as of 2002, Opposer has raised a triable issue of fact which precludes the entry of summary judgment.

II. ARGUMENT

A. When opposing a use based application, the filing date of the trademark application is the date before which Opposer must prove its mark became famous.

“Importantly, the owner of the allegedly famous mark must show that its mark became famous prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding.” *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1373 (Fed. Cir. 2012) (“*Coach*”). This ruling from the Federal Circuit specifically addressed a use based application. Applicant attempts to rely on dicta from an earlier Trademark Trial and Appeal Board decision involving an intent to use based application. See DE 58 at pages 17-18; DE 81 at page 5 citing *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d 1164, 1165, and 1174 n. 9 (TTAB 2001) (“*Toro*”).

Clearly, the Federal Circuit was aware of the *Toro* decision and in fact cited to the decision in its opinion. However, when confronted with a use based application (see 668 F.3d at 1360) and evidence of Applicant’s use prior to the application filing date (see e.g. *id.* at 1379-1380) (discussing Triumph’s use of the COACH mark), the Federal Circuit held that it was the filing date of the application by which Opposer must prove fame, noting:

[L]ooking at the media attention in the record, there is certainly evidence that CSI’s COACH mark has achieved a substantial degree of recognition. That said, many of the articles submitted are dated **after Triumph filed its registration applications** and thus do not show that CSI’s mark was famous **prior to the filing date**.

Id. at 1375 (citing *Toro*, 61 U.S.P.Q.2d at 1174 (“an owner of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application” which it opposes)) (emphasis added).

Applicant also cites to the *Chanel, Inc. v. Makarczyk*, 110 U.S.P.Q.2d 1013 (TTAB May 27, 2014) case in further support of its reliance on *Toro*. See DE 58 at pages 17-18 and DE 81 at page 5. However, in *Chanel*, the Board relied on the filing date of the application. 110 U.S.P.Q.

2d at 2024 (“Therefore, we find that the fame of the CHANEL mark was well-established **prior to applicant's filing date** i.e. applicant's constructive use date.”) (Emphasis added). This is in spite of the fact that the parties had agreed by stipulation:

- (1) "Applicant does not claim rights in or use of CHANEL in connection with any goods or services including real estate development and construction of commercial, residential and hotel property in the U.S. prior to May 15, 2008";
- (2) "Opposer used and registered CHANEL for retail store services, clothing, jewelry, fragrances and beauty items prior to May 15, 2008";

See id. at 2016-2017. *Cf. Autobytel Inc. v. Auto by Rent, Inc.*, 2011 TTAB LEXIS 225, *1 n.1, *21 (TTAB July 28, 2011) (citing as one of the elements of dilution whether the opposer's mark became famous prior to the date of the application to register the applicant's mark for a use based application)(non-precedential); *Virgin Enters. v. Moore*, 2012 TTAB LEXIS 334, *1, *46 (TTAB August 31, 2012) (same) (non-precedential).

The Federal Circuit’s decision in *Coach* deems the Applicant’s date of first use to be the filing date of its applications. Unlike either *Toro* or *Chanel*, the *Coach* decision directly addressed a use based application where the Applicant showed use prior to the application filing date (*see e.g. Coach*, 668 F.3d at 1379-1380) (discussing Triumph’s use of the COACH mark).¹ Following the precedent in *Coach*, the Board should deem the Applicant’s filing date as the date by which Opposer must establish its fame.

This makes more sense in the context of a Motion for Summary Judgment.

B. Summary Judgment should be denied because Opposer has raised triable issues of fact as to Opposer’s prior fame.

On a motion for summary judgment, the moving party must prove that there is no triable issue of fact and the party is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 100 S. Ct. 2548, 91 L.Ed.2d 265 (1986). For purposes of overcoming

¹ Notably, the *Nissan*, *Network Network*, and *Rosetta Stone* cases cited by Applicant (D.E. 88 at 5-6.) did not involve junior users that were seeking trademark applications or registrations.

a motion for summary judgment on a dilution claim, Opposer must only show that there is a triable issue of fact as to the fame of its mark as of the filing date of the challenged application. *See Coach*, 668 F.3d at 1373 (citing *Toro*, 61 U.S.P.Q.2d at 1174 (the owner of a famous mark must demonstrate that its mark became famous "prior to the filing date of the trademark application or registration against which it intends to file an opposition or cancellation proceeding")). The application filing date is the Applicant's constructive date of first use as a matter of law (*see id.*); any use by Applicant prior to the filing date is a question of fact to be resolved at trial. This is particularly true in this case as Applicant has produced extremely limited probative evidence of use.

Even were the Board to look at Applicant's date of first use (as opposed to the application filing date) as determining the point by which Opposer must show fame, Applicant's Rule 30(b)(6) witness, Robert London's testimony does not evidence use prior to his employment with the Applicant in 2002.

Mr. London testified that he has no knowledge of when Applicant's marks were first used in commerce. Declaration of Oren Gelber ("Gelber Dec.") at ¶ 2, Ex. 1 (111:18-113:4). Mr. London was employed by Applicant in 2002 and therefore has no personal knowledge of Applicant's trademark use prior to that date. *Id.* at 7:4-11. His unsupported and uncorroborated testimony that the Applicant's marks have been in use since 1925 is the only evidence Applicant has submitted on this point. Applicant has not offered any documents or business records which would support Mr. London's testimony.² Because of his lack of personal knowledge, Applicant

² In its Reply Brief in Support of its Motion for Summary Judgment, Applicant offers an unauthenticated document which purports to show Applicant's use of the marks as of March 1929. *See* DE 81 at Ex. 5. (Opposer notes that Exhibit 6 to Applicant's Reply in Support of its Motion for Summary Judgment is similarly unauthenticated). This document does not suffice to show continuous use back to this date, nor does it evidence use of the challenged Greek letter mark and crest mark at issue in this proceeding. Further, Applicant attempted to introduce Exhibits 5 and 6 for the first time on reply. By filing such evidence on reply, Applicant deprives Opposer, as the opposing party, of the opportunity to respond to this newly introduced evidence *See e.g. Provenz v. Miller*, 102 F.3d 1478,

cannot rely solely on Mr. London's testimony to establish continuous use back to 1925. *See Coach Services, Inc. v. Triumph Learning LLC*, 2010 TTAB LEXIS 383, *3 (TTAB 2010) (testimony of Applicant's witness about matters occurring prior to employment with Applicant given no weight except for the purpose of authenticating documents).

Applicant also cannot rely on its previous registrations for the ALPHA PHI OMEGA mark to establish use of the Greek letter mark and crest mark challenged in this proceeding. *See* DE 58 at 2-3 and DE 88 at 1-2. The marks are not legal equivalents. *Pro-Cuts v. Schilz-Price Enters.*, 27 U.S.P.Q.2d 1224, 1226 (TTAB 1993) (non-precedential) ("A party seeking to 'tack' its use of an earlier mark onto its use of a later mark for the same goods or services may do so only if the earlier and later marks are legal equivalents. . .") (emphasis added). The word mark ALPHA PHI OMEGA is significantly differentiated from the Greek letter mark and crest design. *See Georges Marciano v. Guess? IP Holder L.P.*, Opp. No. 91219046, DE 18 (TTAB Sept. 29, 2015) (non-precedential)(MARCIANO in stylized form is not the legal equivalent of standard character mark for MARCIANO). Similarly, Applicant's Registration No. 3,835,075 is for a crest design that does not incorporate any shading; the crest in Application Serial No. 77/950,436 features heavy shading. Due to these material differences, these two crest designs are not legal equivalents. Because none of Applicant's existing registrations are for legally equivalent marks, Applicant cannot rely on them to establish prior use of the challenged marks prior to the application filing date.

Applicant is also precluded from relying on its cancelled registrations as evidence of use. It is a well-settled matter of trademark law that "an expired or cancelled registration is not evidence of use of the mark, either as of the application filing date or as of the date of use alleged

1483 (9th Cir. 1996). Opposer contacted the Board regarding a Motion to Strike Exhibits 5 and 6 but was advised that it should not file a Motion to Strike because the Board would scrutinize such matters when reviewing the Motion for Summary Judgment. *See* Gelber Dec. at ¶¶4-12.

therein. Nor is it evidence of any presently existing rights.” *Bell, Inc. v. Bell Packaging Corp.*, 2004 TTAB LEXIS 633, *10 n. 7 (TTAB 2004) (internal citations omitted). Similarly, Applicant cannot rely on its claimed dates of first use in the challenged Applications. Applicant’s scant evidence regarding its use of the mark, and whether such use was continuous, raises its own triable issues of fact.

Opposer has presented evidence of its fame sufficient to raise a triable issue of fact which would preclude summary judgment. Opposer has provided evidence that it has used its OMEGA Marks in commerce since 1894, has been the official timekeeper of the Olympic Games many times since 1932 (including the 1996 games in Atlanta), and its OMEGA brand watches have been featured in numerous motion pictures, including the James Bond movies (beginning with 1995’s *GoldenEye*). See Dec. of Gelber, ¶ 3, Ex. 2; DE 78 at 4-6. Given the long and storied history of Opposer’s OMEGA brand in the United States there is certainly a triable issue of fact.

C. In a Board proceeding based on a use based application, a plaintiff must show that its mark became famous prior to the defendant’s use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant’s subject application.

1. Statutory Language

Where a challenged application is based on use in commerce, the opposer must establish that its mark became famous prior to the constructive use date of the challenged mark in connection with the goods and/or services specifically identified in the subject application. This is borne out by the plain language of Sections 1125(c) and 1127.

Where, as here, the statutory terms are unambiguous, “judicial inquiry is complete, except ‘in rare and exceptional circumstances.’” *Rubin v. United States*, 449 U.S. 424, 430, 101 S. Ct. 698, 66 L. Ed. 2d 633 (1981) (quoting *TVA v. Hill*, 437 U.S. 153, 187 n.33, 98 S. Ct. 2279, 57 L. Ed. 2d 117 (1978)). A statute’s plain language must be given effect, unless the record

provides a “clearly expressed legislative intention to the contrary.” *Consumer Product Safety Commission v. GTE Sylvania, Inc.*, 447 U.S. 102, 108, 100 S. Ct. 2051, 64 L. Ed. 2d 766 (1980).

Here, the Lanham Act is clear and there is scant legislative history touching upon the subject at issue. Accordingly, the plain reading of the statute is required.

Section 1125(c) provides:

*Subject 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.*

(Emphasis added).

For the purposes of the Lanham Act, a trademark is deemed to be used in commerce when

it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce ...

15 U.S.C. §1127.

As the plain language of the statute provides, use of a mark in commerce requires that the mark is used on or in connection with “**the goods**”—not all goods or any goods. Accordingly, for the purposes of dilution before the Trademark Trial and Appeal Board, the proper fame inquiry begins as of the defendant’s first use in commerce in connection with the specific goods listed in the applications.

If Congress had intended otherwise, it could have and would have adopted different language in Section 1125(c) reflecting a desire to measure fame as of the date of any use of the

second mark. Congressional intent is apparent from the clear language of the statute it chose to enact and the “Board must apply and enforce the statute as written.” *Acad. of Motion Picture Arts & Scis. v. Alliance of Professionals & Consultants, Inc.*, 104 U.S.P.Q.2d 1234, 1237 (TTAB 2012).³

Dilution is the lessening of the capacity of a famous mark to identify and distinguish goods or services. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 421, 123 S. Ct. 1115, 155 L. Ed. 2d 1 (2003). It is similar to an infection -which if allowed to spread, will inevitably harm the advertising value of the mark. *See id.* at 427 citing H.R. Rep. No. 104374 p. 1030 (1995). Applicant’s attempt to register the crest and Greek letter marks to do just that – diminish the capacity for Opposer to identify and distinguish its famous OMEGA mark.

2. Board proceedings are limited to the applications at issue and their registrability

The Trademark Trial and Appeal Board is an administrative tribunal of limited jurisdiction. TBMP § 102.01. The Board is only empowered to determine the statutory right to register. *Conolty v. Conolty O’Connor NYC LLC*, 111U.S.P.Q.2d 1302, 1309 (TTAB 2014); *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1082-83 (TTAB 2014); TBMP § 102.01. Oppositions before the Trademark Trial and Appeal Board address only the “right of an applicant to register the mark depicted in the application for the goods identified therein...” *Octocom Sys. v. Houston Computer Servs.*, 918 F.2d 937, 942 (Fed. Cir. 1990); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1232 (Fed. Cir. 2005) (“an opposition to registration is based on the content of the registration application.”). “The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods

³ Post-decision, the language at issue in the cited case was amended to reflect the intended result, but the Board decision stood until the “correctional amendment” was adopted.

set forth in the application.” *Id.* (citing *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1042, 216 U.S.P.Q. 937, 940 (Fed. Cir. 1983)); *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1337, 209 U.S.P.Q. 986, 988 (CCPA 1981); *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 684-85, 196 U.S.P.Q. 1, 2 (CCPA 1977); *Broderick & Bascom Rope Co. v. Goodyear Tire & Rubber Co.*, 531 F.2d 1068, 1070, 189 U.S.P.Q. 412, 413 (CCPA 1976); *Pennwalt Corp. v. Center Laboratories, Inc.*, 524 F.2d 235, 236, 187 U.S.P.Q. 599, 601 (CCPA 1975); *Paula Payne Prods. Co. v. Johnson Publishing Co.*, 473 F.2d 901, 902, 177 U.S.P.Q. 76, 77 (CCPA 1973); *International Paper Co. v. Valley Paper Co.*, 468 F.2d 937, 938, 175 U.S.P.Q. 704, 705 (CCPA 1972); *Vornado, Inc. v. Breuer Elec. Mfg. Co.*, 55 C.C.P.A. 858, 390 F.2d 724, 726, 156 U.S.P.Q. 340, 342 (CCPA 1968); *Kalart Co. v. Camera-Mart, Inc.*, 46 C.C.P.A. 711, 258 F.2d 956, 957, 119 U.S.P.Q. 139, 140 (CCPA 1958); and *Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc.*, 1 U.S.P.Q.2d 1445, 1450 (TTAB 1986) (amended 1987). Even the Supreme Court recognized, when contrasting federal infringement litigations and oppositions and cancellations presented to the Board, that infringement actions before the federal district courts include consideration of “the full range of a mark’s usages,” whereas Board proceedings are limited to “just those in the application.” *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1301 (2015).

This principal is universally applied in the context of likelihood of confusion inquiries by Trademark Office Examiners and the Board. See TMEP § 1207.01(a)(iii) and *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1323 (Fed. Cir. 2014). An inquiry as to descriptiveness is similarly limited to the goods for which registration is sought. *Kellogg Co. v. Earthgrains Co.*, 2003 TTAB LEXIS 505, *7 (TTAB 2003); *In re Tower Tech, Inc.*, 64 U.S.P.Q.2d 1314, 1316 (TTAB 2002). In addition, Board proceedings alleging fraud and

cancellations on the basis of nonuse or abandonment are also considered solely in relation to the goods and services recited in the application or registration. *See Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 2013 TTAB LEXIS 308, *50-51 (TTAB 2013); *Wet Seal, Inc. v. FD Mgmt.*, 82 U.S.P.Q.2d 1629, 1633 (TTAB 2007); *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 1697 (TTAB 2006) (fraud and nonuse considered in the context of the goods and services listed in the application); *City Nat'l Bank v. OPGI Mgmt. GP Inc.*, 106 U.S.P.Q.2d 1668, 1678 (TTAB 2013)(abandonment inquiry centered upon use of the mark on recited services).

Just as with likelihood of confusion, descriptiveness, fraud, nonuse and abandonment, dilution offers a separate basis for challenging the registrability of an applicant's mark. It thus follows that the Board's inquiry with regard to dilution should similarly be framed by the application at issue and the identification of goods recited in the subject application.

Therefore, in the context of an opposition, the party in the position of the plaintiff must establish that its mark became famous prior to the constructive use date of defendant's subject mark in connection with the goods and/or services specifically identified in defendant's subject application.

In the *Toro* case, relied upon heavily upon by the Applicant, the Board has recognized, "Board cancellation and opposition proceedings are not exactly parallel to federal district court trademark infringement proceedings inasmuch as there are no alleged infringers and frequently no use by the applicants in Board proceedings." *Toro*, 61 U.S.P.Q.2d at 1173 (TTAB 2001). Owing to the differences between federal court and TTAB trademark proceedings, the dilution analysis before the Board must be adjusted accordingly. For instance, Section 1125(c) provides:

Subject 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.

However, the Board is not empowered to grant or enforce injunctions. As noted above, the Board's authority is limited to matters of registrability and thus the only remedy for dilution before the Board is refusal of registration or cancellation. *See General Mills, Inc. v. Fage Dairy Processing Industry S.A.*, 100 U.S.P.Q.2d 1584 (TTAB 2011) ("The Board has no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief.").

The Board recognized that the dilution analysis may need to be reconsidered when presented in the context of an opposition proceeding in *Toro Co.*, 61 U.S.P.Q.2d at 1173. Given these considerations, federal case law, such as that presented by Applicant, may not be applicable to the instant proceeding.

Not only is the federal dilution case law cited by Applicant distinguishable from Board proceedings due to the difference in available remedies, but the relevant facts also make such case law inapplicable to the Board's dilution analysis here.

In *Network Network v. CBS, Inc.*, 54 U.S.P.Q.2d 1150 and *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, the court held that for dilution, the asserting party must establish that the mark was famous prior to the second comer's first commercial use in commerce. However, in both *Network Network* and *Nissan*, the junior users relied solely upon common law usage of their marks to establish the first dates of use. Furthermore, the junior users submitted evidence substantiating their first use of the TNN and NISSAN marks in

commerce. Common law usage is a triable issue of fact. Here, the Applicant has yet to provide evidence substantiating its alleged date of first use. Absent affirmative evidence of Applicant's continuous use since its alleged date of first use, the pertinent date for the Board's purpose must be Applicant's constructive use dates with regard to the goods in question. Indeed, given Applicant's cancelled registrations, there is a looming question regarding Applicant's allegations of first use and whether such use has been continuous. Applicant has provided no evidence as to its first use or the continuity of its use.

D. Applicant's Untimely and Unfounded *Morehouse* Defense Should Be Given No Consideration

For the very first time in its Supplemental Brief, Applicant seeks judgment in its favor based on the *Morehouse* Defense. DE 88 at 2. Registrant did not raise the *Morehouse* Defense in its Motion for Summary Judgment, nor did it recite it as an affirmative defense in its Answer. See DE 4 and DE 58. It is only now, in its Supplemental Brief, that it asks the Board to grant summary judgment on this narrow defense. DE 88. Given its failure to assert this defense in its Answer and in its Summary Judgment Motion, Applicant's reference to the *Morehouse* Defense is waived and must be stricken. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 U.S.P.Q.2d 1750, 1753 n.6 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 U.S.P.Q.2d 1224, 1225 n.2 (TTAB 2012).

Notwithstanding its untimeliness, the *Morehouse* Defense is inapplicable here. For the *Morehouse* Defense to apply, the mark in the incontestable registration must be identical to the mark sought to be registered. *Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holdings Ltd.*, 86 U.S.P.Q.2d 1283 (TTAB 2008). The challenged marks in this Opposition proceeding are the crest and the Greek letter mark. The Applicant premises its *Morehouse* Defense on its

registration for the ALPHA PHI OMEGA word mark. The ALPHA PHI OMEGA word mark is not the legal equivalent of the challenged marks. See *infra* at 6. Therefore, Applicant's attempts to assert a *Morehouse* Defense fail as a matter of law.

III. CONCLUSION

For purposes of dilution, the Board should consider Opposer's fame at the time the challenged applications were filed as this is the constructive first use date to which Applicant is entitled as a matter of law. Moreover, given the narrow scope of an Opposition proceeding, the Board should only look to the goods and services recited in the challenged application. The question before the Board pertains specifically to the registration of the challenged applications, which are directed to a specific identification of goods. Opposer has raised a triable issue of fact as to the fame of its mark on the date the challenged applications were filed. As a result, Applicant's motion for summary judgment on Opposer's claim of dilution should be denied.

*

Respectfully Submitted,

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Date: November 13, 2015
JMC/TPG/rmw

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: Alvan Wheat Date: November 13, 2015

CERTIFICATE OF SERVICE

I, Carina Scorgia, hereby certify that a copy of the foregoing **Opposer's Opposition to Applicant's Supplemental Briefing on Motion for Summary Judgment** was served by First Class U.S. Mail, postage prepaid on this 13th Day of November, 2015 upon

Jack A. Wheat
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Carina Scorgia

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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

DECLARATION OF OREN GELBER
IN SUPPORT OF OPPOSER'S OPPOSITION TO APPLICANT'S
SUPPLEMENTAL BRIEFING ON SUMMARY JUDGEMENT

I, Oren Gelber, declare and state, under penalty of perjury, as follows:

1. I am an attorney at Collen IP, counsel for Omega S.A. (Omega AG) (Omega Ltd.) ("Opposer") in the above referenced oppositions. The facts set forth in this declaration are personally known to me and I have first-hand knowledge thereof. If called as a witness, I could and would competently testify to all the following facts that are within my personal knowledge.

2. Opposer deposed Applicant's Rule 30(b)(6) witness, Mr. Robert London, on June 5, 2015. A true and correct copy of the relevant portion Mr. London's deposition transcript is attached hereto as Exhibit 1.

3. Attached as Exhibit 2 is a true and correct copy of OSA00712 produced by Opposer in response to Applicant's Request for Production of Documents and Things.

4. On March 4, 2015, the Board issued an order requiring the parties contact the Board and request a pre-motion conference prior to filing any unconsented motions. DE 72.

5. On June 10, 2015, Applicant filed its Reply in Support of its Motion for Summary Judgment. Exhibits 5 and 6 to Applicant's Reply brief and arguments related thereto were submitted for the first time on Reply. DE 81.

6. On July 14, 2015, Opposer sent Applicant's counsel a letter objecting to Exhibits 5 and 6 of Applicant's Reply brief and declaring Opposer's intention to move to strike.

7. On July 21, 2015 Opposer sent Applicant's counsel an email with case law supporting Opposer's position that materials submitted for the first time on reply should be given no consideration and should be stricken.

8. On August 3, 2015, Applicant's counsel advised Opposer's counsel that it would not consent to a Motion to Strike.

9. On September 15, 2015, I contacted the Interlocutory Attorney in accordance with the Board's March 4, 2015 Order.

10. I advised the Interlocutory Attorney of Opposer's request for a pre-motion conference relating to its desire to file a Motion to Strike Exhibits 5 and 6 from

Applicant's Reply brief on the grounds that these Exhibits amounted to new matter impermissibly introduced on Reply.

11. The Interlocutory Attorney advised that no conference was necessary and that Opposer should not file a Motion to Strike as the Board would scrutinize the Reply and would be aware of the impermissible filing of new materials for the first time on Reply when reviewing these materials and making its ruling.

12. Opposer did not file a Motion to Strike in accordance with the Interlocutory Attorney's directions.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed November 13, 2015 at Ossining, New York.

Oren Gelber

Oren Gelber

EXHIBIT 1

In the Matter Of:

OMEGA S.A. vs. ALPHA PHI OMEGA

ROBERT LONDON

June 05, 2013

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UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

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

OPPOSER

V.

ALPHA PHI OMEGA

APPLICANT

DEPONENT: ROBERT LONDON

DATE: JUNE 05, 2013

REPORTER: VANESSA SCOTT

1 APPEARANCES

2

3 ON BEHALF OF THE OPPOSER, OMEGA S.A. (OMEGA AG)

4 (OMEGA LTD):

5 THOMAS P. GULICK

6 COLLEN IP

7 INTELLECTUAL PROPERTY LAW, P.C.

8 THE HOLYOKE-MANHATTAN BUILDING

9 80 SOUTH HIGHLAND AVENUE, OSSINING-ON-HUDSON

10 WESTCHESTER COUNTY, NEW YORK 10562 USA

11 EMAIL: TGULICK@COLLENIP.COM

12 TELEPHONE: 914-941-5668

13 FACSIMILE: 914-941-6091

14

15 ON BEHALF OF THE APPLICANT, ALPHA PHI OMEGA:

16 JACK A. WHEAT

17 STITES & HARBISON PLLC

18 400 WEST MARKET STREET, SUITE 1800

19 LOUISVILLE, KENTUCKY 40202-3352

20

21 ALSO PRESENT: HANNAH BROTHERS, REGGIE BENTLEY

22

23

24

25

1 time. We'll try to finish the question that we're
2 working on, and -- and we'll be able to go on from
3 there. Can you tell me where are you employed?

4 A Alpha Phi Omega, Incorporated.

5 Q And what is your position there?

6 A Executive Director.

7 Q And how long have you held that position?

8 A Since April of 2002.

9 Q And were you employed by Alpha Phi Omega
10 before April of 2002?

11 A No.

12 Q And can you tell me where Alpha Phi Omega is
13 located? *

14 A In Independence, Missouri is where the
15 headquarters is located.

16 Q Do you have offices in other places in the
17 United States?

18 A We have no other offices.

19 Q Are all of the officers for Alpha Phi Omega
20 in Missouri?

21 A No.

22 Q Can you tell me where they are located?

23 A Can you clarify who you're asking about?

24 Q The -- the -- the officers of Alpha Phi
25 Omega.

1 Q Being sold.

2 A Yes.

3 Q Yes. Okay. Do you know about approximately
4 how long ago was it when you first became aware?

5 A No idea.

6 Q Do you know if it was before you became aware
7 of the fraternal organization, Alpha Phi Omega?

8 A What -- again, have no idea. I knew of Alpha
9 Phi Omega when I was a student in college so I have no
10 idea which came first.

11 Q Are you aware that the opposer sells jewelry
12 under the name or under the mark, Omega? When I say
13 mark, I mean the Greek symbol, Omega.

14 A Watches.

15 Q Sorry. Other than watches, I mean, jewelry
16 and other than watches?

17 A No.

18 Q Your applications for the two marks that are

19

20 A Um-hmm.

21 Q -- at issue in this case, do you know when
22 you alleged the first use of that particular mark was?

23 A I believe it was 1925.

24 Q Do you know -- do you have documents to show
25 that these particular goods were used with those marks

1 at that time?

2 A It -- what -- what -- I'm not sure what goods
3 you're referencing.

4 Q The goods that are listed in your
5 application. So in other words, for the crest, it
6 would be jewelry.

7 A Okay. When a fraternity is started, the
8 first thing they do is create their name, their
9 letters, their coat of arms and their member pin. So it
10 would have been 1925.

11 Q But at that time, were the goods sold?

12 A Have no way --

13 Q In 1925.

14 A -- of knowing what happened at -- at that
15 time.

16 Q Okay. And how about for the apparel in
17 1925?

18 A Again, back in those days, it was very common
19 to have an embroidered crest on your sport coat as all
20 college males were wearing coat and ties and -- and so
21 again, I would --

22 Q Okay. In this instance -- I'm -- I'm sorry,
23 I'm referring to the Greek letters, not the crest.

24 A Do not know, specifically, when those first -
25

1 Q Were first sold.

2 A First sold.

3 Q Okay. Then I thank you for your time.

4 A Okay.

5 Q I appreciate it. And I'll leave it to Mr.

6 Wheat to see if he has any cross questions.

7 CROSS EXAMINATION

8 BY MR. WHEAT:

9 Q So the founding was in 1925.

10 A Yes.

11 Q And one of the first things done would have

12 been the design of a member badge?

13 A Yes.

14 Q And the member badge today is essentially the

15 same one that was designed in 1925.

16 A Yes.

17 Q And it has the Alpha and Phi and Omega Greek

18 letters on it?

19 A Yes.

20 Q This has been continuously in use on jewelry

21 since 1925?

22 A Yes.

23 Q Okay. When a chapter is given a charter --

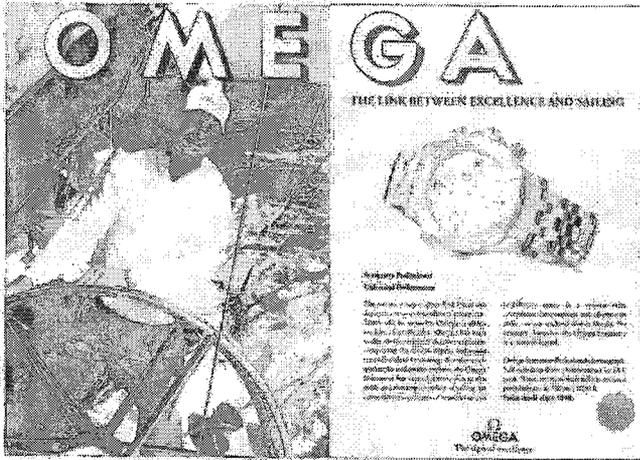
24 or when a group is given a charter, that's their

25 founding as a chapter of the Fraternity, correct?

EXHIBIT 2

OMEGA

THE LINK BETWEEN EXCELLENCE AND SAILING

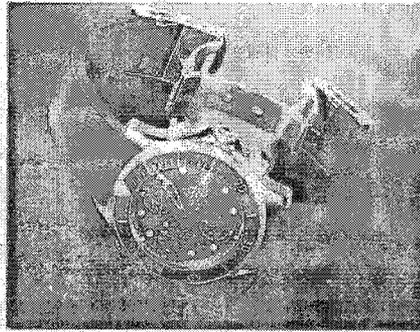


Seamaster Professional
 Maritime Performance

The watch is made from 18K gold and is equipped with a sapphire crystal lens. The dial is white with a date window at 3 o'clock and a moon phase indicator at 6 o'clock. The watch is water-resistant to 300 meters and has a stainless steel case and bracelet.

Reference: SU 178.0564, PIC 2190.20

OMEGA
 The sign of excellence



3017 Omega Seamaster Professional Chrono Diver 300m 1993. The steel version of the automatic chronograph chronometer of the calibre 1153, with a rubber strap equipped here with the brand new "butterfly" clasp. (ref: SU 178.0564, PIC 2190.20.91)

Advertisement with *Red Dawn*, skipper of Peter Blake's "Team New Zealand", 1993. Pictured here is the Seamaster Professional Chrono Diver 300m in

solid gold with a white dial. (ref. BA 378.0304, PIC 2190.20)

OMEGA

SELECTED BY JAMES BOND



My name is Seamaster. Omega Seamaster.

The legendary secret agent James Bond is back. He is back in London, England, and he is back in the Omega Seamaster Professional chronograph watch. The watch is made from 18K gold and is equipped with a sapphire crystal lens. The dial is white with a date window at 3 o'clock and a moon phase indicator at 6 o'clock. The watch is water-resistant to 300 meters and has a stainless steel case and bracelet.

Reference: SU 178.0564, PIC 2190.20

OMEGA
 The sign of excellence

COMING TO A CINEMA NEAR YOU SOON.

Advertisement "James Bond", 1995. Pictured is the Seamaster Diver 300m with a blue dial, reference SU 368.1503, PIC 2334.83. Combined with the release of the film *GoldenEye* in December 1995, this model achieved massive success and sales increased tenfold in 1996. It is true that, in the film, 007's watch does more than give exact time: it saved Bond's

life thanks to its incorporation of a (fake) laser that allowed him to cut through the bottom of a carriage where he was kept prisoner, thus granting certain details... This model spectacularly returned in December 1997's *Tomorrow Never Dies*, in which the watch was equipped with a handy detonator. Two years later Omega was again a key

part of Bond's equipment in *The World Is Not Enough*, which was followed by *Die Another Day* in 2002 and *Casino Royale* in 2006. No wonder that this watch is known as the "Bond Watch" by collectors.