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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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Date	12/29/2015
Attachments	K655 Opposition to Applicant's Notice of Supplemental Authority.pdf(208570 bytes )

**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 SECOND NOTICE OF  
SUPPLEMENTAL LEGAL AUTHORITY**

I. Applicant's Submission Should be Stricken as an Impermissible Surreply

Surreply briefs are impermissible in proceedings before the Board, pursuant to TBMP § 502.02(b). *See also* 37 CFR § 2.127(a), (e)(1); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies*, 73 USPQ2d 1672, 1677 (TTAB 2005) (because 37 CFR§ 2.127(a) prohibits the filing of surreply briefs, opposer's surreply to applicant's motion was not considered); *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000). To the extent that Applicant presents new arguments in its submission regarding the applicability of the Federal Circuit's decision, as opposed to simply bringing the decision to the Board's attention, it constitutes a surreply in

support of its Motion for Summary Judgment (D.E. 58) or an unconsented motion. As a result, Applicant's December 9, 2015 submission should be stricken and given no consideration.

II. Applicant's Submission Should be Stricken as it violates the Board's March 4, 2015 Order (D.E. 72) as an Impermissibly Filed Unconsented Motion

On March 4, 2015, the Board issued an Order prohibiting the parties from filing any unconsented motion without prior permission. D.E. 72 at 17-18. This is the *second* time that Applicant has filed an unconsented motion in blatant violation of the Board's Order. Applicant previously filed a Notice of Supplemental Authority on August 11, 2015, and Opposer similarly objected to the submission on the basis that it violated the Board's March 4, 2015 Order.

Whatever the cause of Applicant's actions in disregard of the Board's Order, the Applicant cannot be rewarded and Applicant's Notice should be stricken and given no consideration.

III. Applicant's Notice of Supplemental Legal Authority is Untimely

The briefing on Applicant's pending Motion for Summary judgment was completed on June 10, 2015. The Federal Circuit's decision in *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGGA v. New Millennium Sports S.L.U* was issued on August 19, 2015. Now, over six months after briefing was completed and almost four months after the *Jack Wolfskin* decision, Applicant comes forth with this "relevant" case law. Notably, the principles articulated in the *Jack Wolfskin* decision are supported by case law existing prior to the primary briefing of the Motion for Summary Judgment. Applicant has not established why such legal points could not have been raised during the briefing of its Motion for Summary Judgment.

To the extent that the Applicant would believe this case law to be "relevant, Applicant had two additional opportunities to bring this to the Board's attention: in its opening

Supplemental Brief on the Motion for Summary Judgment (D.E. 88) and its Reply Brief (D.E. 90). Applicant should not be permitted to rectify its lack of diligence by an extraneous and unconsented submission to the Board. Consistent with the Board's prohibition of surreplies, there must be an end to briefing at some point.<sup>1</sup> Applicant cannot submit a notice of supplemental authority every time it comes across a case which contains a phrase which it thinks might support a point in its pending motion. This is particularly true, where, as here, the authority neither addresses any new point of law nor represents any change in existing law.

IV. Applicant's Supplemental Legal Authority Does Not Present Any New Points of Law

Applicant's Notice of Supplemental Legal Authority is unnecessary and should be given no consideration because the case to which Applicant cites does not present any new or novel point of law that may inform the Board's decision in the pending motions for summary judgment. Applicant cites to *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGGA v. New Millennium Sports S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015), for three points. See D.E.27. These points, among many others, are merely considerations in the fact intensive inquiry in the likelihood of confusion analysis. These are not new considerations. As established by the *Jack Wolfskin* case, these points have been considered in existing authority which was readily available to Applicant during the initial summary judgment briefing and the supplemental briefing. See *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGGA v. New Millennium Sports S.L.U.*, 797 F.3d 1363 (Fed. Cir. 2015) citing to *In re Viterra Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*,

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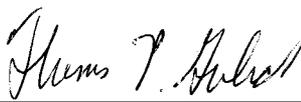
<sup>1</sup> Additionally, surreplies are disfavored because they can be used to circumvent the Board's set page limits. Applicant's continuing supplemental authority filings, when taken in the aggregate, exceed the page limit for summary judgment briefing.

396 F.3d 1369, 1373 (Fed. Cir. 2005); and *Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 1338 (Fed. Cir. 2015) (quoting *Standard Brands, Inc. v. RJR Foods, Inc.*, 192 U.S.P.Q. 383 (TTAB 1976)).

V. Applicant Mischaracterizes the Federal Circuit's Decision in *Jack Wolfskin*

Applicant's Notice includes excerpts from the *Jack Wolfskin* opinion that do not accurately reflect the Court's holding. For example, Applicant's Notice includes a quote pertaining to the Board's error in failing to compare the marks as a whole. D.E. 91 at 1 (citing *Jack Wolfskin*, 797 F.3d at 1366). Applicant fails to mention that the Federal Circuit also states "more or less weight [may be] given to a particular feature of the mark." *Jack Wolfskin*, 797 F.3d at 1371. The Court's decision is an explicit recognition that certain components of a mark may be given heightened consideration for appropriate reasons, so long as all components and the marks in their entirety are accounted for in the analysis. *Id.*

Respectfully Submitted,

By: 

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Date: December 29, 2015

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: Owen Gelber Date: December 29, 2015

**CERTIFICATE OF SERVICE**

I, Nicole M. Kelly, hereby certify that a copy of the foregoing **Opposer's Opposition to Applicant's Second Notice Of Supplemental Legal Authority** was served by First Class U.S. Mail, postage prepaid on this 29th Day of December, 2015 upon

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