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

Proceeding	91214449
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Attachments	Opposer's Reply In Support of Rule 56(D) Motion Seeking Discovery From Applicant.pdf(529392 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 OMEGA EPSILON, INC.,  
Applicant.

Mark:  $\text{A}\Omega\text{E}$   
Opp. No.: 91214449 (Parent)  
Serial No.: 85855823

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

Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: ALPHA OMEGA EPSILON  
Opp. No.: 91214454 (Child)  
Serial No.: 85855839

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

Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: ALPHA OMEGA EPSILON &  
Design  
Opp. No.: 91214452 (Child)  
Serial No.: 85857062

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

Opposer,

v.

ALPHA OMEGA EPSILON, INC.,  
Applicant.

Mark: ALPHA OMEGA EPSILON  
Opp. No.: 91214453 (Child)  
Serial No.: 85857065

**OPPOSER'S REPLY IN SUPPORT OF RULE 56(D) MOTION  
SEEKING DISCOVERY FROM APPLICANT**

## I. INTRODUCTION

The only thing Applicant manages to make clear in its Opposition to Opposer's Rule 56(d) Motion is that its arguments are hypocritical. Rather than explain or justify its efforts to avoid discovery, and rather than address the merits of Opposer's Rule 56(d) motion, Applicant says that its own evidence is "irrelevant" and in doing so, recasts the substance of its Motion for Summary Judgment.

Applicant overlooks the fact that Opposer has not yet submitted its Opposition to Applicant's Motion for Summary Judgment (D.E. 7). Opposer is unable to substantively and adequately respond to Applicant's Motion for Summary Judgment without the discovery sought in Opposer's Interrogatory Nos. 2-4, 8, 9, 13, 15, 17-21, 25 and 26, the Subpoenas issued to Wampler, Miraglia, and Smiley and the Notice of Deposition of Applicant's Rule 30(b)(6) witness, all of which were served and outstanding prior to the filing of Applicant's Motion for Summary Judgment. The discovery Opposer seeks pertains directly to points raised by Applicant in its Motion for Summary Judgment. Applicant may not now assert the intriguing argument that the points it raised in support of its motion for Summary Judgment are "irrelevant," in order to avoid providing Opposer with discovery.

Without the evidence Applicant claims is "irrelevant," Applicant's Motion for Summary Judgment would be relying upon little more than its conclusory, unverified statements. Rather than provide discovery on these points, Applicant chooses to contradict its entire Motion for Summary Judgment and its other on-record statements.

## II. ARGUMENT

### A. Opposer Seeks Discovery Pursuant to Rule 56(d) with Regard to Evidence Upon Which Applicant Relies in its Motion for Summary Judgment

Applicant's Motion for Summary Judgment relies on a number of *DuPont* likelihood of confusion factors, including, (1) the similarity of the trade channels, (2) conditions under which purchases are made, (3) number and nature of similar marks in use on similar goods, (4) nature and extent of actual confusion, and (5) length of time without evidence of actual confusion. D.E. 7 at page 13.

As a result, Omega's Rule 56(d) Motion seeks discovery relating to the above referenced factors.

See D.E. 11 at page 8-9 (citing relevant portions of Applicant's Motion for Summary Judgment).

Applicant's recitation of undisputed material facts relies predominantly on these likelihood of confusion factors. See D.E. 7 at pages 9-12. Over 250 pages of exhibits in support of the motion for summary judgment relate to these five factors. See generally D.E. 7. These exhibits filed by Applicant in support of its Motion for Summary Judgment related to the aforementioned factors include the declarations of Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley, which are cited no less than 24 times throughout Applicant's Motion for Summary Judgment. *Id.* Opposer is entitled to discovery upon these issues. "If the discovery sought is relevant to the issues presented in the motion for summary judgment, the opposing party should be allowed the opportunity to utilize the discovery process to gain access to the requested materials." *Kahama VI, LLC v. HJH, LLC*, 2014 U.S. Dist. LEXIS 16429, \*4 (M.D. Fla. Feb. 10, 2014) citing *Snook v. Trust Co. of Georgia Bank of Savannah, N.A.*, 859 F.2d 865, 870 (11th Cir. 1988).

The "likelihood of confusion determination under Section 2(d) is a legal conclusion, based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue." *Wal-Mart Stores, Inc. v. All Green Env't LLC*, 2013 TTAB LEXIS 102, \*10-11 (TTAB 2013) citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944 (Fed. Cir. 2006). Opposer is entitled to seek discovery from Applicant and to submit such discovered evidence on the record for the Board to consider on summary judgment. *Kahama*, 2014 U.S. Dist. LEXIS 16429, \*4 (M.D. Fla. Feb. 10, 2014).

**B. Applicant Claims its Own Evidence in Support of Summary Judgment is Irrelevant**

Applicant's Opposition to Opposer's Rule 56(d) Motion contradicts explicit statements in its own Motion for Summary Judgment and subsequent on-record statements.

Now that Opposer has identified that the issues Applicant raised in its Motion for Summary Judgment require discovery, Applicant responds that the majority of the facts asserted in its Motion for

Summary Judgment are simply irrelevant. Applicant claims that Opposer does not require discovery from Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley because these declarations do not touch upon similarity of the marks. The declarations of Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley address (1) trade channels, (2) the conditions under which purchases are made, (3) the number and nature of similar marks in use on similar goods, and the (4) nature and extent of actual confusion. The Declarations are cited in support of these factors no less than twenty-four times by Applicant. *See* D.E. 7.

This paradox of Applicant's position is all the more bewildering considering that fifteen days after the filing of its Opposition brief (D.E. 13), Applicant submitted a Reply brief in Support of Consolidation (D.E. 14) which framed the issue on summary judgment as "whether a consumer of fraternity or sorority affinity merchandise, primarily college students, will confuse fraternal affinity merchandise with Omega" products and "whether the insignia of Greek letter collegiate fraternities and sororities with the Greek letter "Omega" in their name are likely to be confused with the Omega marks." *See* D.E. 14 at pages 2-3. This issue implicates a number of likelihood of confusion factors, including (1) the similarity or dissimilarity and nature of the goods, (2) similarity or dissimilarity of trade channels, (3) the conditions under which purchases are made, (4) the length of time during which there is concurrent use without actual confusion, (5) third party use, dates of first use, and (6) sophistication of consumers; as well as the similarity or dissimilarity of the marks. Applicant's Reply in Support of Consolidation contradicts its arguments in opposition to Opposer's Rule 56(d) Motion with regard to the dispositive issues raised on summary judgment.

Applicant's position with regard to the Declarations is also contrary to the position of Alpha Phi Omega in Opposition No. 91197504 (the Alpha Phi Opposition)<sup>1</sup>, which strenuously opposed a Motion to Preclude these exact and identical Declarations from the record and from its Motion for Summary Judgment. In support of consolidation, the Applicant in this Opposition, Alpha Omega Epsilon, alleges

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<sup>1</sup> The Board will recall that Applicant in this proceeding is seeking to consolidate this Opposition with Opposition No. 91197504 for the limited purpose of Summary Judgment. *See* D.E. 10. Alpha Phi Omega, the Applicant in Opposition No. 91197504, and Alpha Omega Epsilon, the Applicant in this Opposition, are both represented by the same attorney

that the dispositive issue on summary judgment in the Alpha Phi Opposition and in this proceeding is identical and thus both Alpha Phi's Summary Judgment Motion and Applicant's Summary Judgment Motion should be determined together. *See* D.E. 10. Applicant's position in this proceeding that the Declarations are irrelevant on Summary Judgment runs counter to Alpha Phi's insistence that these documents must be considered on Summary Judgment in opposition to Opposer's Motion to Preclude and Compel in Opposition No. 91197054. With the Applicant in one proceeding alleging that these Declarations are irrelevant and the Applicant in the other insisting that they be permitted to use and rely upon this evidence, it is clear that these two oppositions differ with regard to the evidence that the Applicants assert should be considered.<sup>2</sup> Alternatively, if Applicant in this case is advocating that the Declarations are irrelevant to the Summary Judgment Motions pending in both opposition proceedings, then Alpha Phi Omega in Opposition No. 91197054 has wasted both the Board's time and Opposer's time in opposing preclusion of these documents.

Applicant presents no reason why it filed evidence it now considers "irrelevant" in support of its Motion for Summary Judgment.

C. Opposer is Seeking Discovery to Which it is Entitled

Opposer has satisfied the requirements of Fed. R. Civ. P. 56(d). Opposer has (1) identified with specificity the particular discovery the movant intends to seek; (2) provided an explanation of how that discovery would preclude the entry of summary judgment; and (3) provided a statement justifying why this discovery had not been or could not have been obtained earlier. *Doe v. Abington Friends Sch.*, 480 F.3d 252, 255 n. 3 (3d Cir. 2007). The Board should thus grant Opposer the discovery sought. *See inVzn Dev. Corp. v. Quanta Corp.*, 1996 TTAB LEXIS 477, \*6 (TTAB 1996) (granting petitioner's request under Rule 56(d) for additional discovery where its counsel submitted an affidavit in support of its discovery request which contained particularized assertions as to the discovery needed and asks for discovery of information and materials that are within respondent's knowledge or control, and which petitioner must have to allow it to respond to the motion for summary judgment).

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<sup>2</sup> This is just another reason why these two unrelated opposition proceedings should not be consolidated.

The discovery sought by Opposer is anticipated to yield relevant evidence on the topics of (1) the similarity or dissimilarity and nature of the goods, (2) similarity or dissimilarity of trade channels, (3) the conditions under which purchases are made, (4) the length of time during which there is concurrent use without actual confusion, (5) third party use, dates of first use, and (6) sophistication of consumers. This evidence will enable Opposer to disprove Applicant's position regarding these factors, thereby raising triable issues of fact in the Board's likelihood of confusion analysis which will preclude Summary Judgment. *See* D.E. 11 at pages 9-14).

Opposer diligently sought discovery on these points prior to the filing of Applicant's Motion for Summary Judgment. Opposer served Applicant with its First Set of Interrogatories, among other discovery requests, on June 2, 2014. D.E. 11 at page 3 and Exhibit 1 to D.E. 11. Opposer served upon Applicant a total of twenty-nine interrogatories. *Id.* at page 15 and Exhibit 1 to D.E. 11. Applicant refused to respond, making an unsupported general objection that the total number of interrogatories (including sub-parts) exceeded seventy-five. *Id.* at pages 4 and 15 and Exhibit 3 to D.E. 11. It was not a lack of diligence, but Applicant's unfounded objection which prevented Opposer from obtaining the information it seeks. Applicant cannot use these unfounded objections as a pretext for continuing to deprive Opposer of the discovery it requires to oppose Applicant's Motion for Summary Judgment.

Applicant's conduct also blocked Opposer from taking the depositions of Applicant's Rule 30(b)(6) witness and the Declarants, Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley. The Declarations of Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley were provided to Opposer on July 25, 2014, as a supplemental document production. D.E. 11 at page 4. Opposer contacted Applicant's counsel on August 28, 2014 seeking to depose the Declarants and asking Applicant's counsel, who represents 3 of the declarants' employers (Exhibit 8 to D.E. 13), whether the declarants would appear willingly. D.E. 11 at page 4 and Exhibit 5 to D.E. 11. Applicant's counsel did not respond to Opposer's inquiry. *Id.* Opposer issued subpoenas to each of the declarants on September 3, 2014, and Opposer timely sought to depose the Declarants. *Id.* Opposer was able to successfully serve Ms. Wampler, Ms. Miraglia, and Mr. Smiley with Subpoenas on September 4 and 5, 2014, but was unable to personally serve Mr. Shaver, as the address

provided in his Declaration was a post office box. *Id.* at pages 4-5 and Exhibit 7 to D.E. 11. Opposer also served upon Applicant's counsel a Notice of Deposition to Applicant pursuant to Rule 30(b)(6) on September 3, 2014. *Id.* at page 5 and Exhibit 6 to D.E. 11. Applicant's counsel acknowledged the service of the subpoenas and deposition notice in an email on September 8, 2014 and further sought to coordinate scheduling of the depositions with Opposer's counsel. *Id.* and Exhibit 9 to D.E. 11. Applicant is wrong and dishonest in alleging that Opposer delayed in seeking discovery until after the filing of the Motion for Summary Judgment. D.E. 13 at page 10.

Applicant further attempts to mischaracterize Opposer's 56(d) Motion as a motion to compel. The two requests for relief are distinct and governed by different standards. Opposer seeks discovery under Rule 56(d) in order to respond to Applicant's Motion for Summary Judgment. Applicant's contention with regard to a Motion to Compel is nothing more than a continued attempt to evade discovery.

In its last-ditch effort to avoid discovery, Applicant alleges that granting Opposer discovery would burden Applicant. Putting aside for the moment the fact that the burden upon Opposer is heavier in time, resources and cost in taking the requested depositions than any to the Applicant, Opposer also notes that accommodations can be made to ease any alleged burden upon Applicant with regard to the taking of the depositions, such as allowing Applicant's counsel to participate by telephone thereby avoiding the need for travel expenses.

Applicant created its own hardship. It chose not to respond to Interrogatories, it chose to file a Motion for Summary Judgment while Opposer's notice of deposition and subpoenas were pending and it chose to rely heavily upon the Declarations of Mr. Shaver, Ms. Wampler, Ms. Miraglia, and Mr. Smiley in support of its Motion for Summary Judgment. Applicant cannot now bemoan the circumstances of its own making.

Applicant accused Opposer of seeking delay and attempting to increase costs, but Applicant's actions reveals it has been the party to delay the production of discovery and drive up costs. For example, Applicant filed a baseless Motion for Consolidation of Unrelated Proceedings (D.E. 10), Applicant

asserted an unfounded objection to Opposer's Interrogatories (D.E. 11 at page 3), Applicant refused to respond to correspondence seeking to depose witnesses (D.E. 11 at page 4) and filed a Motion for Summary Judgment while Subpoenas and a Notice of Deposition were pending (D.E. 11 at pages 4-5). To the extent that Applicant is so concerned with hardships and cost burdens, the blame lays squarely with Applicant and its unsavory litigation tactics.

Applicant has failed to provide any valid basis for denying Opposer the discovery it seeks. Opposer's Rule 56(d) discovery should be granted.

C. Applicant's focus in its opposition is misplaced in re-arguing its Motion for Summary Judgment and not Omega's need for discovery

Despite filing evidence and making arguments for a number of *DuPont* factors, Applicant asks the Board to ignore the evidence (or lack thereof) filed in support of its Motion for Summary Judgment. Applicant now asserts that discovery on these likelihood of confusion factors are unnecessary, essentially rendering its own prior arguments in support of summary judgment irrelevant.

To the extent Applicant argues that discovery would not preclude the entry of summary judgment, this argument must fail. Applicant bears the initial burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). A factual dispute is genuine if, on the *evidence of record*, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

If, as Applicant suggests that the *evidence of record* for which Opposer sought discovery is irrelevant, then there is no evidence of record to establish there is no genuine issue of material fact.

Contrary to Applicant's argument in its opposition to Opposer's Rule 56(d) motion, the Board cannot take judicial notice of the facts alleged in the Declarations filed in support of its Motion for Summary Judgment. *See* D.E. 13 at page 6. (No party expends time and money to prepare and submit 4 declarations--especially when, like Applicant, that party is complaining about cost--on matters where judicial notice is appropriate.).

Applicant ignores axioms of law when it claims that discovery would be unnecessary to dispute Applicant's statement of material facts. Applicant tries to rely on case law to establish facts. *See e.g.*, D.E. 13 at page 4 (citing *Abraham* and *In re New Era Cap. Co., Inc.*). However, facts are only established by the evidence in each case.

The citation to *Abraham* is not a finding as a matter of law. It is not even a finding of fact. Applicant's selective editing hides the preface and context. The full sentence reads: "Paddle Tramps [Defendant, the non-moving party] is perhaps correct that the use of various combinations of Greek letters, in the mind of the public, generally refers to fraternities or sororities." *Abraham v. Alpha Chi Omega*, 781 F.Supp.2d 396, 410 (N.D.Tx. 2011) *aff'd* 708 F.3d 614 (5th Cir. 2013) *cert. denied*, 134 S.Ct. 88 (2013). This is simply dicta adulterated for the sake of fitting Applicant's modified arguments. In the *In re New Era* case, the Board reviewed the evidence of record in the case, it did not make a ruling as a matter of law. *In re New Era Cap Co., Inc.*, No. 85515684, at p.5 (TTAB July 7, 2014). ("The Examining Attorney contends that the marks are similar in appearance, meaning, sound and commercial impression...[t]his argument, however, is contradicted by the *evidence of record* showing...").<sup>3</sup> The Board made no ruling of law but based its decision on the facts in evidence in the case.

In its Motion for Summary Judgment, Applicant relies on declarants for third party use. Now, in its Opposition to the Rule 56(d) motion, Applicant claims the Board can rely on a simple internet search. D.E. 13 at pages 10 and 13-14. Applicant cannot use an internet search alone to establish use. *See Safer Inc. v. OMS Investments, Inc.*, 94 U.S.P.Q. 2d 1031, 1039-1040 (TTAB 2010). *See* D.E. 13 at pages 10 and 13-14. Even in framing the issue in opposition to the Rule 56(d) Motion, Applicant qualifies whether confusion will occur with consumers of Applicant's merchandise (which Applicant claims are college students) and, in part, based on a difference in price. *See* D.E. 13 at page 3. These are

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<sup>3</sup> Unlike the facts of *New Era Cap* with Greek letters and Roman letters, this opposition involves a likelihood of confusion between Greek letters and Greek letters.

exactly the types of materials for which Opposer is seeking discovery.<sup>4</sup>

### III. CONCLUSION

Applicant's filings on record display a cycle of contradiction. Applicant is unable to articulate any valid grounds for opposing Opposer's request under Rule 56(d). Although it opts to reargue and recast the arguments previously submitted in its Motion for Summary Judgment, this tactic succeeds only in establishing that Applicant is unconcerned about its contradictory prior statements submitted on the record. The discovery Opposer needs is the subject of discovery requests that predate the filing of Applicant's Motion for Summary Judgment Opposer. D.E. 11. The required discovery pertains directly to the express issues raised by Applicant in its Motion for Summary Judgment. Though Applicant now seems to claim that the evidence it submitted and the points it raised in support of Summary Judgment are "irrelevant," Applicant's Motion facially fails to meet the Summary Judgment burden of establishing that there is no genuine issue of material fact. In light of Applicant's brief (D.E. 13), Opposer should be granted its request under Rule 56(d) to obtain additional discovery.

Respectfully submitted,



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<sup>4</sup> Opposer notes that Applicant's reliance on the types of consumers for its goods and price of goods are not substantiated by the evidence that would be left in the record if the materials for which Opposer sought discovery were removed, and is belied by the identification of goods. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (where there is no limitations in the identification of goods, the goods and services are presumed to move in all normal channels of trade and be available to all classes of consumers). The same is true for pricing. *See Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937, 943, 16 USPQ2d 1783 (Fed. Cir. 1990).

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 ELECTRONICALLY WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE.

Date: November 24, 2014

Owen Gelber

**CERTIFICATE OF SERVICE**

I, Troy L. Jordan, hereby certify that a copy of the foregoing Opposer's Reply in Support of Rule 56(d) Motion Seeking Discovery From Applicant was served by First Class U.S. Mail, postage prepaid on this 24th Day of November, 2014 upon

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