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

Mailed: March 28, 2015

Opposition Nos. 91214449 (parent)
91214452
91214453
91214454

Omega SA (Omega AG) (Omega Ltd.)

v.

Alpha Omega Epsilon, Inc.

Robert H. Coggins,
Interlocutory Attorney:

Now before the Board are applicant's motion (filed October 9, 2014) to consolidate, and opposer's motion (filed October 14, 2014) for Fed. R. Civ. P. 56(d) discovery. The motions are fully briefed.

Background

Upon consented motion filed by opposer, these four cases were consolidated under parent Opposition No. 91214449. Five months later, applicant filed a motion for summary judgment and proceedings were suspended pending disposition of that motion. During the suspension, applicant filed the outstanding motion to consolidate and opposer filed the outstanding motion under Fed. R. Civ. P. 56(d) seeking discovery to respond to applicant's motion for summary judgment.

Motion to Consolidate

Applicant moves to consolidate these previously consolidated cases (i.e., the four proceedings under parent Opposition No. 91214449) with two other cases which have been previously consolidated under parent Opposition No. 91197504. Applicant moves for further consolidation for the limited purpose of the Board's determination of the outstanding motions for summary judgment filed in each consolidated parent case. Applicant argues that the co-pending motions for summary judgment are in all material respects essentially identical, opposer in each consolidated case is the same, and the applicant in each consolidated case is a collegiate Greek letter fraternal organization whose subject marks include the word OMEGA. Applicant states that further consolidating the cases for the limited purpose of uniform consideration of the co-pending motions for summary will serve the interests of efficiency and uniformity (i.e., judicial economy).

While the Board acknowledges that there may be common questions of law and fact raised in the co-pending motions for summary judgment, the Board finds it unorthodox to consolidate the separate lines of cases for the limited purpose of entertaining the differing motions for summary judgment in tandem, particularly since the defendants in the two lines of consolidated cases differ; the defendants' marks at issue in each line of consolidated cases differ; the goods/services at issue differ, in part; the consolidated lines of cases are at different stages of litigation; and the records presented with the motions for summary judgment are not identical. In addition, there is a risk

of differing dispositions based on each record. In view thereof, the Board does not find it appropriate to consolidate the two sets of previously consolidated cases for the purpose of determining the outstanding motions for summary judgment. Accordingly, applicant's motion to consolidate is **denied**.

Motion for Rule 56(d) Discovery

A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a motion with the Board pursuant to Fed. R. Civ. P. 56(d) for time to take the needed discovery. The motion must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion. *See* Fed. R. Civ. P. 56(d); TBMP § 528.06. Opposer submitted the declaration of Oren Gelber which complies with this requirement. Inasmuch as opposer's motion for Rule 56(d) discovery was filed October 14, 2014, it is timely and may be considered. Trademark Rules 2.119(c), 2.127(e)(1), and 2.196. Generally, if a party has demonstrated a need for discovery which is reasonably directed to facts essential to its opposition to the motion, discovery will be permitted. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

However, when a request for discovery under Rule 56(d) is granted by the Board, the discovery allowed is limited to that which the nonmoving

party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, requests for discovery outstanding, and those requests remain unanswered. See T. Jeffrey Quinn, *TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed*, 80 Trademark Rep. 413 (1990).

By way of its motion, opposer seeks to take the discovery deposition of Janine Wampler (of Alpha Chi Omega Fraternity, Inc.), Wynn Smiley (of Alpha Tau Omega Fraternity, Inc.), Daniel Shaver (of Affinity Marketing Consultants, Inc.), Carol Miraglia (of Chi Omega Fraternity), and applicant's Fed. R. Civ. P. 30(b)(6) designee; and to compel applicant's responses to opposer's First Set of Interrogatories Nos. 2-4, 8, 9, 13, 15, 17-21, 25-26. Applicant's summary judgment motion involves the grounds of likelihood of confusion and dilution. While pursuant to Rule 56(d) the only discovery which may now be permitted is that specifically directed to the issues raised by the motion for summary judgment, the Board finds that opposer's depositions and interrogatory requests (identified in the Rule 56(d) motion) mostly seek information that is essential to opposer's opposition to the summary judgment motion.

The Board presumes familiarity with the issues presented by way of opposer's Rule 56(d) motion and does not provide a complete recitation of the allegations and contentions of each party as presented in their respective

briefs. However, the Board notes that applicant's repeated cry in its brief in opposition to the Rule 56(d) motion that applicant's motion for summary judgment is merely about "the dissimilarity of the marks" is unhelpful and is plainly untrue. Even a cursory review of applicant's motion for summary judgment reveals that the motion is not based solely on the similarity or dissimilarity between the parties' marks alone (for example, under *Kellogg Co. v. Pack'em Enters., Inc.*, 951 F2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) ("We know of no reason why, in a particular case, a single du Pont factor may not be dispositive")). Applicant has argued in, and provided exhibits to, that motion for much more than merely "the dissimilarity of the marks."

Upon review of the motion for summary judgment and the briefs on the motion for Rule 56(d) discovery, the Board determines that opposer has sufficiently demonstrated a need to take the deposition of Ms. Miraglia, Ms. Wampler, Mr. Wynn, Mr. Smiley, and applicant's Rule 30(b)(6) designee, to the extent limited below. In addition, opposer has sufficiently demonstrated a need for substantive responses to Interrogatory Nos. 2-4, 8, 9, 13, 15, 17-21, and 26 to the extent limited below; but not to Interrogatory No. 25.

Applicant's theory of interrogatory counting is unsupported by any authority; indeed, applicant failed to cite a single rule or case in support thereof. Whether applicant's *response* to any particular interrogatory would require a listing of "many scores, if not hundreds of products" relates to the

truth of applicant's *answer* but not to the test for whether a single interrogatory itself may be counted as multiple questions. Under applicant's flawed argument, a defendant that has only a single good/product could count an interrogatory inquiring as to that party's goods as a single question while a defendant that has ten goods/products could count the same interrogatory as ten questions. Not only is applicant straining credibility, but applicant once again (as with its "dissimilarity of the marks" argument) is trying the patience of the Board. Courts have stated that a single question asking for several bits of information relating to the same topic counts as one interrogatory "if they are logically or factually subsumed within and necessarily related to the primary question." *See Safeco of America v. Rawstrom*, 181 F.R.D. 441, 445 (C.D. Cal. 1998); Fed. R. Civ. P. 33. Similarly, courts have held that an interrogatory directed at eliciting details concerning a common theme should not count as a multiple interrogatory. *See, e.g., New River Dry Dock, Inc. v. Falls at Marina Bay, L.P.*, 2008 WL 2620727 (S.D. Fla. 2008); *Federal Trade Commission v. Nationwide Connections, Inc.*, 2007 WL 2462015 (S.D. Fla. 2007); and *Cardenas v. Dorel Juvenile Group, Inc.*, 231 F.R.D. 616, 620 (D. Kan. 2005). In view of the nature of the question of registrability - which is the central issue in a Board proceeding - and the strong link between goods and services sold under a single mark or sold by a single entity, applicant's multiplication of an interrogatory that seeks information on its goods is misplaced; the inquiries

are whether the information sought is related to the primary theme (or question) and if the interrogatory is directed at eliciting details concerning that a common theme. Looking only at the two interrogatories applicant mentions in the brief in opposition, the Board finds that Interrogatory No. 2, which asks applicant to identify and describe each product applicant sells under applicant's marks, is a single question; and Interrogatory No. 3, which asks applicant to identify the earliest date of use (by sale) of each good identified in applicant's answer to Interrogatory No. 2, also constitutes a single question. Although applicant's objection to the number of interrogatories is unfounded, the Board need not so rule in this order which is merely for Rule 56(d) discovery; however, applicant is warned that if its continual clinging to the flawed theory necessitates opposer's filing of a motion to compel responses outside the context of the Rule 56(d) motion, should the motion for summary judgment not dispose of the case, the Board will be most displeased.

Opposer's motion for Rule 56(d) discovery is **granted**, in part, as to the depositions of Ms. Miraglia, Ms. Wampler, Mr. Wynn, Mr. Smiley, and applicant's Rule 30(b)(6) designee, as limited herein:

> 1. The Miraglia, Wampler, Wynn, and Smiley depositions must be limited to the topics raised in the deponent's respective declaration and may include testimony regarding any document attached to the respective declaration.

2. The Rule 30(b)(6) deposition is limited to the topics in the September 3, 2014 notice of deposition therefor, excluding topic No. 17 (applicant's use of other OMEGA or Ω marks), and further limited to the permitted topics only to the extent that those topics relate to the goods or services at issue in the proceeding: (A) the goods and services applicant has listed in the subject applications (i.e., jewelry, hats, jackets, shirts, sweat pants, sweat shirts, sweaters; and indicating membership in a(n) professional and social collegiate sorority for student and alumna members); and (B) the goods and services claimed by opposer in the Notice of Opposition (i.e., watches, clocks, chronometers, chronographs, and parts for all of the foregoing; wrist watch bracelets, bands, and straps; watch movements and watch cases [opposer's goods identified in the pleaded registrations], and watches, sports timing products, clothing, accessories, retail services, sponsorship of sports timing [opposer's common law goods and services[1]]. To be clear, applicant must be prepared to discuss its own use as to all of the goods at issue as listed above which include, for example,

[1] Opposer's additional allegation at common law as to "other goods and services" does not give applicant fair notice as to the nature of those other goods and services, and, in view thereof, applicant need not provide any information during its deposition (or in responding to interrogatories, *see infra*, as to any goods or services other than those listed above.

> watches, clocks, and clothing goods, which, although not listed in the subject applications, are goods pleaded by opposer and are therefore at issue in and relevant to these consolidated proceedings. *See* TBMP § 414(11). The deposition may not concern topic No. 17 (applicant's use of other OMEGA or Ω marks).

Opposer is allowed until **forty-five** days from the mailing date of this order in which to notice, take, and complete the discovery depositions. To the extent any non-party witness is not willing to testify voluntarily, opposer must secure the 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. *See* TBMP § 404.03(a)(2). Inasmuch as opposer was granted the opportunity under Rule 56(d) to take the depositions of Miraglia, Wampler, and Smiley as part of Opposition No. 91197504 (*see* Board's March 4, 2015 order in that case), opposer need not take separate depositions of those deponents for the two separate lines of consolidated proceedings. The order granted herein effectively extends the deposition deadline granted in Opposition No. 91197504 as to Miraglia, Wampler, and Smiley.

Opposer's motion for Rule 56(d) discovery is **granted**, in part, as to substantive responses by applicant to Interrogatory Nos. 2-4, 8, 9, 13, 15, 17-21, and 26 to the following limited extent:

1. Interrogatory No. 2 Applicant must respond, but only to the extent of listing those goods or services at issue in the proceeding: (A) the goods and services applicant has listed in the subject applications (i.e., jewelry, hats, jackets, shirts, sweat pants, sweat shirts, sweaters; and indicating membership in a(n) professional and social collegiate sorority for student and alumna members); and (B) the goods and services claimed by opposer in the Notice of Opposition (i.e., watches, clocks, chronometers, chronographs, and parts for all of the foregoing; wrist watch bracelets, bands, and straps; watch movements and watch cases [opposer's goods identified in the pleaded registrations], and watches, sports timing products, clothing, accessories, retail services, sponsorship of sports timing [opposer's common law goods and services]).

2. Interrogatory Nos. 3, 4, 8, 9, 13, 15, 17-20, 26 Applicant must respond, but only to the extent that each interrogatory relates to the goods or services identified in response to Interrogatory No. 2. Applicant need not, for purposes of the Rule 56(d) motion, answer as to any other goods or services.

3. Interrogatory No. 21 Applicant must respond fully.

Applicant is allowed **thirty days** from the mailing date of this order in which to serve its substantive responses to Interrogatory Nos. 2-4, 8, 9, 13, 15, 17-21, and 26 as limited above.

Opposer's motion for Rule 56(d) discovery is **denied**, in part, as to any substantive response by applicant the Interrogatory No. 25.

Schedule

Except as provided hereinabove, proceedings remain suspended pending disposition of the outstanding motion for summary judgment.

Opposer is allowed until **thirty days** from the expiration of the forty-five day deposition 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 brief in opposition to applicant's outstanding motion for summary judgment. Applicant's reply brief in support of the motion for summary judgment, if any, must be filed in accordance with Trademark Rule 2.127(e).