

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Heasley

Mailed: April 6, 2016

Opposition Nos. 91214449 (Parent)
91214452
91214453
91214454

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

v.

ALPHA OMEGA EPSILON, INC.

Before Wolfson, Lykos and Heasley, Administrative Trademark Judges.

By the Board:

These consolidated proceedings are before the Board for consideration of Alpha Omega Epsilon, Inc.'s ("Applicant's") motion for summary judgment under Fed. R. Civ. P. 56 on Opposer's claims of likelihood of confusion and dilution.

I. Background

Applicant seeks registration on the Principal Register of four marks--two of them collective membership marks and two of them trademarks.

The first collective membership mark is a design and word mark (the “crest”)¹ in Class 200, “Indicating membership in a professional and social collegiate sorority for student and alumna members”:



The second collective membership mark is a word mark in standard characters: ALPHA OMEGA EPSILON,² also in Class 200, “Indicating membership in a professional and social collegiate sorority for student and alumna members.”

The third application is for the same standard character word mark, ALPHA OMEGA EPSILON, in International Class 25 for “hats, jackets, shirts, sweat pants, sweat shirts, sweaters.”³

¹ Application Serial No. 85857062, filed February 22, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging 1983 as the date of first use anywhere and in commerce.

² Application Serial No. 85857065, filed February 22, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging 1983 as the date of first use anywhere and in commerce.

³ Application Serial No. 85855839, filed February 21, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging 1983 as the date of first use anywhere and in commerce.

And the fourth application is for the mark **AΩE** in International Class 14 for “jewelry” and in International Class 25 for “hats, jackets, shirts, sweat pants, sweat shirts, sweaters.”⁴

Omega, S.A. (Omega AG) (Omega Ltd.) (“Opposer” or “Omega”) has opposed these applications on the grounds of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and likelihood of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). In the notices of opposition to Applicant’s applied-for collective membership marks⁵ and trademarks,⁶ Omega has

⁴ Application Serial No. 85855823, filed February 21, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging 1983 as the first use anywhere and in commerce.

⁵ In Notices of Opposition Nos. 91214452 and 91214453 to Applicant’s two applications to register collective membership marks, Opposer pleaded ownership of Reg. No. 3318408, issued

October 23, 2007, for the mark  on the Principal Register for “timekeeping of sports events,” in International Class 41, registered under Section 66(a) of the Trademark Act, based on International Registration No. 0865357, claiming priority as of August 24, 2005, renewed October 15, 2015; and App. Ser. No. 85877912, which matured into Reg. No. 4520281 on April

29, 2014 (during the pendency of this proceeding) for the mark  on the Principal Register for “retail store services featuring perfumery, jewellery and chronometric instruments, fine leather goods” in International Class 35 and alleging first use in commerce as of March 23, 2006.

⁶ In Notice of Opposition No. 91214449 (Parent), Opposer pleaded ownership of Reg. No.


0025036, issued July 24, 1894 for the mark  on the Principal Register for “watch movements and watch cases” in International Class 14, alleging first use anywhere and in commerce as of March 10, 1894, renewed July 26, 2014; Reg. No. 0578041 issued July 28, 1953

for the mark  on the Principal Register for “watches (including pocket

pleaded ownership of registrations consisting of the marks “OMEGA” in stylized form or of the Omega letter of the Greek alphabet with the word “OMEGA” (collectively the “OMEGA” marks), including:

OMEGA

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OMEGA

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watches, wrist watches with or without straps, bands or bracelets, pendant watches, calendar watches, and stopwatches) either stem-wind or automatic, clocks, chronometers, chronographs, and parts for all of the foregoing,” in International Class 14, alleging 1894 as the date of first use anywhere and in commerce , renewed July 5, 2013; and Reg. No. 577415, issued July 14,

1953 for the mark  **OMEGA** on the Principal Register for “wrist watch bracelets, bands and straps” in International Class 14, alleging 1894 as the date of first use anywhere and in commerce, renewed August 31, 2003.

In Notice of Opposition No. 91214454, Opposer pleaded ownership of the same three aforementioned registrations as in Opp. No. 91214449, and Reg. No. 0566370, issued November

 **OMEGA**
4, 1952 for the mark on the Principal Register for “watches and parts thereof,” in International Class 14, alleging 1894 as the date of first use anywhere and in commerce, renewed November 4, 2012.

⁷ Reg. No. 0566370.

⁸ Reg. Nos. 3318408, 4520281, 0025036, and 0578041.



The four oppositions were consolidated under Opposition No. 91214449, the parent case.¹⁰

On September 8, 2014, twelve days before the close of discovery, Applicant filed the subject motion for summary judgment under Fed. R. Civ. P. 56. Applicant argues that there is no genuine dispute that Applicant's collegiate Greek letter marks, which indicate membership in the sorority, or are attached to "affinity merchandise," are not likely to cause confusion with or dilution of Opposer's OMEGA marks, which are used on high-end timepieces and related goods.¹¹ Under Fed. R. Civ. P. 56(d), Opposer was granted the opportunity to take discovery relating to Applicant's motion for summary judgment,¹² and the motion is now fully briefed.¹³

⁹ Reg. No. 0577415.

¹⁰ 6 TTABVUE.

¹¹ 7 TTABVUE.

¹² 16-17 TTABVUE.

¹³ On December 9, 2015, approximately four months after filing its reply brief, Applicant filed a submission entitled "Notice of Supplemental Legal Authority ..." regarding *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Company KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129 (Fed. Cir. 2015). Opposer has moved to strike the submission. See Trademark Rule 2.127(e)(1) (after a reply, if any, is filed, "The Board will consider no further papers in support of or in opposition to a motion for summary judgment."). See, e.g., *Pioneer Kabushiki Kaisha v. Hitachi High Technologies America Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005). The Board is already aware of that decision, as well as any other decisions recently issued, and has taken them into account, rendering the submission and motion moot.

II. Pleading Issues

At the outset, we note that Opposer failed to plead its dilution claim properly, as each notice of opposition is devoid of any allegation regarding when its pleaded marks became famous. *See Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000) (“...opposer’s allegation of dilution is legally insufficient inasmuch as there is no allegation as to when opposer’s mark became famous.”). *See also* 15 U.S.C. § 1125(c). Opposer must plead that any or all of its marks had become famous for dilution purposes prior to Applicant’s first use of its applied-for marks.¹⁴

¹⁴ The standards for pleading and proving dilution in opposition proceedings against applications based on Sections 1(a) and 1(b) of the Trademark Act are different. “In a use-based application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), the party alleging fame must show that the mark had become famous prior to the applicant’s use of the mark.” *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001). In an intent-to-use based application under Section 1(b), the party alleging fame must show that the mark had become famous prior to the applicant’s date of constructive use. *See, e.g., National Pork Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1495-96 (TTAB 2010) (finding renown of opposers’ slogan predated the involved Section 1(b) application filing date); *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010) (allegation that opposer’s marks became famous prior to the date applicant filed its applications was “sufficient to state a dilution claim against the intent-to-use applications”), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). *But see, Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2024 (TTAB 2014) (where record contains no evidence of applicant’s use, it is the filing date, *i.e.*, the constructive use date, that controls even though application based on Section 1(a): “In this case, because we have no evidence of applicant’s use we must determine if opposer’s 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.”).

If Opposer pleads that its marks had become famous for dilution purposes prior to Applicant’s use of its marks, that will be deemed to encompass both alternatives: Applicant’s actual use or constructive use. *See* Fed. R. Civ. P. 8(d)(2) and TBMP § 309.03(a)(2) (pleading in the alternative permitted). The evidence adduced at trial will determine which alternative is applicable.

Opposer’s suggestion, that in *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713 (Fed. Cir. 2012) the Federal Circuit overruled the distinction as set forth in *Toro*, constitutes a misreading of both cases. *See Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, Opposition No. 91197504 (parent case), ___ USPQ2d ___ (TTAB March 31, 2016) (discussing pleading standard).

Ordinarily, a party may not obtain summary judgment on an issue that has not been properly pleaded. *See, e.g., S. Industries, Inc. v. Lamb-Weston, Inc.*, 45 USPQ2d 1293 (TTAB 1997); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009). But because Applicant, not Opposer, is the moving party, and because the parties have treated Opposer's dilution claim on the merits in their briefs, the Board deems Opposer's dilution claim to be properly pleaded *solely for consideration of Applicant's motion for summary judgment*. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994). As explained further below, Opposer will be allowed time to properly plead each asserted dilution claim, failing which the claim(s) will be dismissed.

Similarly, in responding to Applicant's motion for summary judgment, Opposer has relied upon certain of its marks that were not pleaded, or which were only pleaded in some of the oppositions.¹⁵ For the same reasons articulated above, we again have deemed each notice of opposition to be amended to plead ownership of each of Opposer's registered marks *solely for consideration of Applicant's motion for summary judgment*. If Opposer intends to rely upon all seven of the OMEGA registrations it has identified in each opposition proceeding, it must file a motion for leave to amend each notice of opposition under Fed. R. Civ. P. 15(a). The parties are reminded that "[c]onsolidated cases do not lose their separate identity because of consolidation. Each proceeding

¹⁵ For example, Registration No. 1969071, filed on February 5, 1993 and registered on April 23, 1996 for the Greek letter and word OMEGA for *inter alia* "metal key rings" in International Class 6, "umbrellas and parasols" in International Class 18 and "clothing, namely scarves and neckties" in International Class 25.

retains its separate character and requires the filing of separate pleadings and entry of a separate judgment.” TBMP § 511 (2015).

III. Analysis

As detailed below, Applicant’s motion for summary judgment is **granted** as to Opposer’s Section 2(d) and dilution claims in Opposition No. 91214452 to Application Serial No. 85857062 for the “crest” collective membership mark, and **denied** as to the remaining three applications.

A. Summary Judgment Standards.

Under Fed R. Civ. P. 56, a party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). 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); *Olde Tyme Foods, Inc. v. Roundy’s, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd’s Food Products Inc. v. Eli’s Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472.

B. The Crest Collective Membership Mark.

Applying these standards to this case, and on consideration of the parties' briefs and evidence, we find an absence of any genuine dispute of material fact as to the "crest" collective membership mark:



1. Likelihood of Confusion.

Considering first Opposer's asserted Section 2(d) claim, we base our determination on an analysis of all of the probative evidence of record bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A single *DuPont* factor "may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460 (Fed Cir. 1998) quoted in *Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010).

Application Serial No. 85857062 describes the Alpha Omega Epsilon sorority's crest as follows:

The mark consists of a heraldic crest graphic design containing a shield bearing a rose with stem positioned in front of a cross positioned in front of three rings. Roses and vines are along the side and bottom edges of the shield. Above the shield is a representation of a rising sun and clouds and below the shield is a banner or ribbon bearing the words 'Alpha Omega Epsilon'.

There is no genuine dispute of material fact that the sorority's crest mark is dissimilar in appearance, sound, connotation and commercial impression from any of Opposer's OMEGA marks:

OMEGA

 ¹⁶



Applicant's crest mark consists of a prominent, ornate and highly distinctive design that catches the eye first, making the design the dominant element of the mark. *See In re Covalinski*, 113 USPQ2d 1166 (TTAB 2014) (design predominant in word and design mark) (citing *Ferro Corp. v. Ronco Labs, Inc.*, 356 F.2d 122, 148 USPQ 497, 498-99 (CCPA 1966) (confusion was unlikely between applicant's mark ... and several marks owned by opposer consisting of or containing FERRO, due to the dominance of the

¹⁶ This is the mark pleaded and relied upon by Opposer in Opposition No. 91214452, opposing registration of the crest mark. 1 TTABVUE. Opposer relied upon its other OMEGA marks in opposing Applicant's motion for summary judgment, and we have considered all of those OMEGA marks for purposes of this ruling.

design elements of applicant's mark and the relatively small typeface in which FERRO appeared)); *Parfums de Coeur Ltd v. Lazarus*, 83 USPQ2d 1012 (TTAB 2007). *See also In re Electrolyte Laboratories, Inc.*, 929 F.2d 645, 16 USPQ2d 1239 (Fed. Cir. 1990) (there is no general rule as to whether letters or design will dominate in composite marks).

Although the crest contains the word OMEGA, the similarity with Opposer's marks ends there. That single shared word is located in small script typeface on a ribbon at the very bottom of Applicant's ornate design mark, where it is nestled between ALPHA and EPSILON. Read from left to right, the three spelled-out Greek letters would naturally be pronounced "Alpha Omega Epsilon," the name of the sorority. Persons viewing the crest mark would tend to view it as a whole, and would have no reason to parse it into its elements, focusing only on the OMEGA element, which plays a relatively minor role in the overall commercial impression of this design and word collective membership mark. *See Jack Wolfskin Ausrustung Fur Draussen GmbH KGAA v. New Millenium Sports, S.L.U.*, 707 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015) (the "touchstone of this factor is consideration of the marks in total"); *China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007) ("It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue."). "It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion." *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234

(CCPA 1981) *quoted in Juice Generation, Inc. v. GS Enterprises LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1676 (Fed. Cir. 2015).

In terms of appearance, sound, connotation and overall commercial impression, Applicant's crest mark is indisputably dissimilar from Opposer's OMEGA marks. The circumstances here are similar to those in *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) where the Board found on summary judgment that despite a shared prefix, the opposer's FROOT LOOPS mark was indisputably dissimilar from the applicant's FROOTEE ICE mark with an elephant design. *Id.* In fact, the Board found that the marks were so dissimilar that it would grant summary judgment even if the opposer prevailed on other pertinent *DuPont* factors, such as relatedness of goods, channels of trade, classes of consumers, casual rather than careful purchases, and fame of the opposer's mark. "The first *DuPont* factor simply outweighs all of the others which might be pertinent to this case." *Id.* at 1550.

Here, as in that instructive case, the single *DuPont* factor of dissimilarity of the marks in their entirety is dispositive of the issue of likelihood of confusion. For purposes of this motion, we have treated the other relevant *DuPont* factors, such as the fame of Opposer's marks, as being in Opposer's favor. Nonetheless, we find no genuine dispute of material fact that the dissimilarities of the marks are so great as to avoid likelihood of confusion. *See Odom's Tennessee Pride Sausage Inc. v. FF Acquisition*, 93 USPQ2d at 2032.

2. Dilution

Similarly, even if we were to assume *arguendo* that Opposer's OMEGA marks were famous for purposes of protection against dilution under 15 U.S.C. § 1125(c)(2)(A), and became famous before Applicant's first use in 1983, there is no genuine dispute of material fact that Applicant's crest collective membership mark is not likely to dilute Opposer's marks by blurring. "Dilution by blurring" is defined as "association arising from the similarity between a mark ... and a famous mark that impairs the distinctiveness of the famous mark." Trademark Act, Section 43(c)(2)(B), 15 U.S.C. § 1125(c)(2)(B). See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1372, 101 USPQ2d 1713, 1724 (Fed. Cir. 2012); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1250 (TTAB 2015); *McDonald's Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1286 (TTAB 2014); *Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014). Blurring may occur regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury. 15 U.S.C. § 1125(c)(1). See *Chanel, Inc. v. Makarczyk*, 110 USPQ2d at 2018. Dilution by blurring occurs when "a substantial percentage of consumers, on seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner." *N.Y. Yankees Partnership v. IET Prods. & Servs. Inc.*, 114 USPQ2d 1497, 1506 (TTAB 2015).

In determining whether a mark or trade name is likely to cause dilution by blurring, the Board may consider the following six non-exhaustive factors:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi). Some statutory dilution factors may be given more weight than others, depending on the evidence of record. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1667 (TTAB 2010), *aff'd on other grounds*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). We consider these factors in turn.

- (i) *The degree of similarity between the Applicant's crest collective membership mark and Opposer's OMEGA marks.*

On consideration of this dilution factor, the Board has explained that:

While we are not conducting a Section 2(d) likelihood of confusion analysis under this factor for dilution by blurring, we still consider the degree of similarity or dissimilarity of the marks in their entirety as to appearance, connotation, and commercial impression. ... We consider the marks in terms of whether they are sufficiently similar in their overall commercial impressions that the required association exists.

N.Y. Yankees Partnership, 114 USPQ2d at 1506 (citing *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1198 (TTAB 2012)). See also 15 U.S.C. § 1125(c)(2)(B).

There is no genuine dispute of material fact that Applicant’s crest collective membership mark is manifestly dissimilar from Opposer’s OMEGA marks. It is design-dominant, with a distinctly different appearance:



The script on the ribbon at the bottom displays “Alpha Omega Epsilon.” The word “Omega” is no more prominent than the rest of the words; and Opposer has adduced no evidence that a substantial percentage of consumers would focus on the “Omega” element alone, and thereby associate the mark with Opposer. The marks are so dissimilar that this dilution factor strongly favors Applicant. Thus, even if we assume *arguendo* that there are no genuine disputes of material fact that factors (ii) through (iv) favor Opposer—i.e., that its OMEGA marks are highly distinctive, that it has engaged in substantially exclusive use of its OMEGA marks, and that the OMEGA marks enjoy a high degree of recognition—there is no genuine dispute as to the first dilution factor, which we find is entitled to greater weight in this particular case: the lack of similarity.

(v) Whether Applicant intended to create an association with the famous mark.

The Board has described the purpose of a collective membership mark:

The sole purpose of a collective membership mark is to indicate membership in an organization. While goods or services may be provided by the members of an organization, a collective membership mark, as used or displayed by the members of an organization, serves only to identify the fact that such members belong to the collective organization and to inform relevant persons of the members' association with the organization.

In re Code Consultants, Inc., 60 USPQ2d 1699, 1700 (TTAB 2001). See 15 U.S.C. § 1127 (“collective mark” defined); Trademark Manual of Examining Procedure (“TMEP”) § 1304.01 (Oct. 2015) (“The sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization.”); 37 C.F.R. § 2.56(4) (“A collective membership mark specimen must show use by members to indicate membership in the collective organization.”). Consistent with this purpose, Applicant’s crest mark is displayed on items such as sorority membership certificates.¹⁷

There is no record evidence of any purpose or intent on Applicant’s part to use its crest mark to create an association with Opposer or its marks. Consequently, we treat this factor as neutral.

(vi) Any actual association between Applicant’s crest mark and Opposer’s OMEGA marks.

It is undisputed that the record is devoid of any evidence of actual association between Applicant’s crest mark and Opposer’s OMEGA marks. Consequently, we treat this factor as neutral.

On consideration of all the above relevant dilution factors, “we must determine not only whether there is an ‘association’ arising from the similarity of the marks, but

¹⁷ See testimony of Amy Devine, International Executive Board president of Alpha Omega Epsilon, 23 TTABVUE 97-98.

whether such association is likely to ‘impair’ the distinctiveness of the famous mark.” *Chanel*, 110 USPQ2d at 2024 (citing *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011)). Here, because there is no similarity between the marks, there is no “association,” and there is no impairment of distinctiveness.

In view of these findings, as to which there is no genuine dispute of material fact, Applicant Alpha Omega Epsilon Inc.’s motion for summary judgment is granted in Opposition No. 91214452 as to Application Serial No. 85857062 on both claims—Section 2(d) and dilution, and the opposition is dismissed.

C. The Remaining Proceedings.

The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding material facts exists. *See Lloyd’s Food Products*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. In this case, on the record presented, we find that there are genuine disputes of material fact remaining for trial as to the three other applications that preclude granting summary judgment in Applicant’s favor. For example:

With respect to the Section 2(d) likelihood of confusion claims, genuine disputes of material fact remain with regard to each opposed application, including, but not limited to, the similarity of the marks and the relatedness of the parties’ goods and services.¹⁸

¹⁸ Application Serial No. 85857065 is for a collective membership mark, **ALPHA OMEGA EPSILON**. But Application Serial No. 85855839, for the same **ALPHA OMEGA EPSILON** mark for apparel, does not limit its classes of consumers or channels of trade, nor does Application Serial No. 85855823, for the Greek letter design plus word mark **ΑΩΕ**. Applicant asserts that it is willing to amend its trademark applications to limit the channels of trade and classes of customers, but it has not yet filed a motion to amend. *See* Trademark Rule 2.133; *see also* TBMP § 514.

As to the dilution claim asserted in each proceeding, Opposer argues that because Applicant failed to corroborate its alleged date of first use of 1983 by direct evidence for each applied-for mark, Opposer is entitled to rely on the filing date of each application as Applicant's constructive use date, and need only show the absence of a genuine dispute of material fact that Opposer's marks were famous for dilution purposes prior to those dates -- February 21 and 22, 2013.¹⁹ In support of this argument, Opposer submitted portions of the discovery deposition transcript of Amy Devine, Applicant's International Executive Board president, which in Opposer's view do not substantiate Applicant's date of first use.²⁰ Applicant, in turn, offered other portions of the Devine deposition as evidence that Applicant has indeed used its mark in commerce as of 1983.²¹ In those excerpts, Devine testified that Applicant's mark has been in continuous use since 1983 and that there was documentary evidence to corroborate this date of first use. No documentary evidence (e.g. invoices) was submitted with the transcript. Absent this documentary evidence, and absent the entire deposition transcript, there exists a genuine dispute of material fact as to whether Applicant commenced use of each of its involved marks in connection with the identified goods as of 1983. This remains to be proven at trial. There is, moreover, a genuine dispute of material fact as to whether its OMEGA marks became famous prior to Applicant's first use of its marks, actual or

¹⁹ Opposer's Response in Opposition to motion for summary judgment, pp. 14-15, 23 TTABVUE 16-17.

²⁰ Opposer's Response in Opposition to motion for summary judgment, Exhibit 9, Devine Deposition 103:25-104:4, 23 TTABVUE 101-102.

²¹ Applicant's Reply in support of motion for summary judgment, Devine Deposition 32, 38, 39, 41, 42, 47, 89, 90, 26 TTABVUE 40-48.

constructive. Therefore Applicant's motion for summary judgment on Opposer's dilution claim is denied in each remaining proceeding.

This listing of outstanding issues is illustrative, not exhaustive, but it suffices to indicate why summary judgment cannot be granted as to the remaining applications: such issues are the stuff of which trials are made.²²

D. Conclusion.

In summary, Applicant's motion for summary judgment is **granted** on both Opposer's Section 2(d) and dilution claims in Opposition No. 91214452 as to Application Serial No. 85857062; judgment is entered in Applicant's favor as to Opposition No. 91214452, which is dismissed. Applicant's motion for summary judgment is **denied** as to the remaining three proceedings.

IV. Further Proceedings.

"Where a final disposition has been entered as to some, but not all, of the cases in a consolidated proceeding, the remaining cases will no longer be considered consolidated with the case[] for which a final disposition has been entered." TBMP § 511. Consequently, Opposition Nos. 91214449 (parent), 91214453 and 91214454 will no longer be considered consolidated with Opposition No. 91214452, but

²² The parties are reminded that evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence may not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate testimony period. *See Levi Strauss & Co. v. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). However, the parties may stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. *See* TBMP § 528.05(a)(1) (2015).

will remain consolidated with one another.

For the remaining three opposition proceedings, Opposer is allowed until TWENTY (20) DAYS from the mailing date of this order to serve on Applicant and file an amended notice of opposition in each proceeding stating a proper claim of dilution, failing which, each opposition will go forward solely on the Section 2(d) claim. If Opposer intends to rely on any other marks or registrations not previously pleaded, Opposer's amended notices of opposition should include these allegations and be accompanied by a motion for leave to amend under Fed. R. Civ. P. 15(a). In the event Opposer serves and files an amended notice of opposition in accordance with this order, Applicant is allowed until TWENTY (20) days from the date of service thereof to serve and file an amended answer to each amended notice of opposition or otherwise move with respect to the amended notices of opposition. The parties are precluded from filing any further motions for summary judgment in the three remaining opposition proceedings.

Proceedings are otherwise suspended until the issues are joined in accordance with this Order. At that time, another scheduling order shall issue, resetting discovery and remaining trial dates.