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

Proceeding	91240520
Party	Defendant F.N.B. Corporation
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Submission	Opposition/Response to Motion
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Date	12/19/2018
Attachments	Applicants Response to Opposers Motion to Dismiss Counterclaim and Motion for Leave to Amend Counterclaim.pdf(192536 bytes )

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

**OMEGA CAPITAL MANAGEMENT, LLC**

Opposer,

Opposition No. 91240520

v.

**F.N.B. CORPORATION,**

Applicant.

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**APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO DISMISS  
COUNTERCLAIM AND  
APPLICANT’S MOTION FOR LEAVE TO AMEND COUNTERCLAIM**

Applicant/Counter-Plaintiff **F.N.B. CORPORATION** (hereinafter FNB), by and through the undersigned counsel, hereby files the following response to Opposer’s motion to dismiss the Applicant’s counterclaim, and motion for leave to amend counterclaim, and states as follows:

The Opposer has set forth certain arguments in its motion to dismiss which incorrectly claim that Applicant’s counterclaim herein “*is devoid of factual allegations*”. The Applicant has pleaded, among other factual allegations, the existence of longstanding prior trademark rights which the Opposer may have disregarded.

Nevertheless, in the spirit of cooperation and to conserve resources which would be devoted to the determination of Opposer’s motion, and even though Applicant has a highly meritorious response and believes that Applicant is likely to prevail, the Applicant has offered to amend the present counterclaim which the Opposer has consented to allow Applicant to amend.

Further to Applicant's briefs of July 17, 2018 [Doc. 8] and September 24, 2018 [Doc. 10], Applicant requests leave to file the proposed Amended Counterclaim of Exhibit 1, hereto.

WHEREFORE Opposer seeks leave to file the proposed Amended Counterclaim hereto.

**CONCLUSION**

WHEREFORE, for the foregoing reasons, Applicant's motion herein should be granted.

Respectfully submitted,

/Jennifer L. Whitelaw/  
JENNIFER L. WHITELOW  
WHITELOW LEGAL GROUP  
Attorney for Applicant/Counter-Plaintiff  
**F.N.B. CORPORATION**  
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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the foregoing in this matter is being provided to the Attorney for Opposer:

[Penina Michlin Chiu](#)  
Frederic Dorwart, Lawyers PLLC  
[pchiu@fdlaw.com](mailto:pchiu@fdlaw.com), [jburden@fdlaw.com](mailto:jburden@fdlaw.com)

via electronic transmission on December 19, 2018.

/JENNIFER L. WHITE LAW/  
JENNIFER L. WHITE LAW

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

**OMEGA CAPITAL MANAGEMENT, LLC**

Opposer,

Opposition No. 91240520

v.

**F.N.B. CORPORATION,**

Applicant.

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**APPLICANT'S ANSWER, AFFIRMATIVE DEFENSES  
AND FIRST AMENDED COUNTERCLAIM FOR CANCELLATION**

Applicant **F.N.B. CORPORATION** (hereinafter "Applicant"), by and through the undersigned counsel, hereby files its Answer and Affirmative Defenses and First Amended Counterclaim to the Notice of Opposition filed by Opposer **OMEGA CAPITAL MANAGEMENT, LLC**, (hereinafter "Opposer"), and states, all upon information and belief, as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1.
2. Applicant denies the allegations of paragraph 2.
3. Applicant states that the referenced federal public record speaks for itself and denies the remainder of paragraph 3.
4. Applicant states that the referenced federal public record speaks for itself and denies the remainder of paragraph 4.

5. Applicant reasserts its response to paragraphs 2-4 herein above and further states that the allegations of paragraph 5 do not require a response, and are otherwise denied.
6. Applicant denies the allegations of paragraph 6.
7. Applicant denies the allegations of paragraph 7.
8. Applicant denies the allegations of paragraph 8.
9. Applicant states that the public record of incorporation and of application herein speaks for itself and denies the remainder of the allegations of paragraph 9.
10. Applicant states that the referenced federal public record speaks for itself as to the allegations of paragraph 10.
11. Applicant denies the allegations of paragraph 11.
12. Applicant denies the allegations of paragraph 12.
13. Applicant denies the allegations of paragraph 13.
14. Applicant denies that any permission of Opposer was required, and otherwise denies the remainder of the allegations of paragraph 14.
15. Applicant denies the allegations of paragraph 15.
16. Applicant denies the allegations of paragraph 16.

#### **FIRST AFFIRMATIVE DEFENSE**

Applicant is the owner of the mark OMEGA and OMEGA BANK, and common law rights thereto, and Applicant's rights are prior to any alleged right of Opposer.

#### **SECOND AFFIRMATIVE DEFENSE**

As to the subject matter set forth in the Application, Applicant, not Opposer, has

priority, and is the senior user as between the parties hereto.

**THIRD AFFIRMATIVE DEFENSE**

Opposer's assertion of rights against Applicant is barred, in whole or in part, by the doctrine of laches.

**FOURTH AFFIRMATIVE DEFENSE**

Opposer's Opposition is barred, in whole or in part, by the doctrine of acquiescence.

**FIFTH AFFIRMATIVE DEFENSE**

Opposer's Opposition is barred, in whole or in part, by the doctrine of waiver.

**SIXTH AFFIRMATIVE DEFENSE**

Opposer's Opposition is barred, in whole or in part, by the doctrine of estoppel.

**SEVENTH AFFIRMATIVE DEFENSE**

Opposer is not the real party in interest, in whole or in part, to enforce all or some of the rights claimed in this action.

**EIGHTH AFFIRMATIVE DEFENSE**

Opposer lacks standing, in whole or in part, to bring this action.

**NINTH AFFIRMATIVE DEFENSE**

Opposer will not be harmed by the registration of the mark which is the subject of this action.

**TENTH AFFIRMATIVE DEFENSE**

The Notice of Opposition, in whole or in part, fails to state a claim against Applicant upon which relief can be granted.

**ADDITIONAL AFFIRMATIVE DEFENSES RESERVED**

Applicant reserves and asserts all other defenses which may be related in any way to any Affirmative Defense set forth herein above. Further, Applicant specifically reserves the right to assert such additional Affirmative Defenses as may hereafter be deemed or discovered by Applicant to be applicable.

**WHEREFORE**, having fully answered and set forth its Affirmative Defenses as required, Applicant **F.N.B. CORPORATION** requests that the Opposition herein be dismissed with prejudice at the cost of Opposer, and that registration of Applicant's mark be allowed.



**FIRST AMENDED COUNTERCLAIM**  
**Cancellation of U.S. Registration No. 4654265**

F.N.B. CORPORATION, a Pennsylvania corporation, with a principal place of business at One North Shore Center, 12 Federal Street, Pittsburgh, Pennsylvania 15212, believes that Registration No. 4654265 for the mark OMEGA CAPITAL, claimed by the Opposer herein, OMEGA CAPITAL MANAGEMENT, LLC, a Delaware limited liability company with a principal place of business at 4124 S. Rockford Ave., Suite 201, Tulsa, Oklahoma 74105, was issued in error and/or based on false or incorrect statements by Opposer, including without limitation those statements made in Opposer's Declaration filed with the application therefor, and should be cancelled.

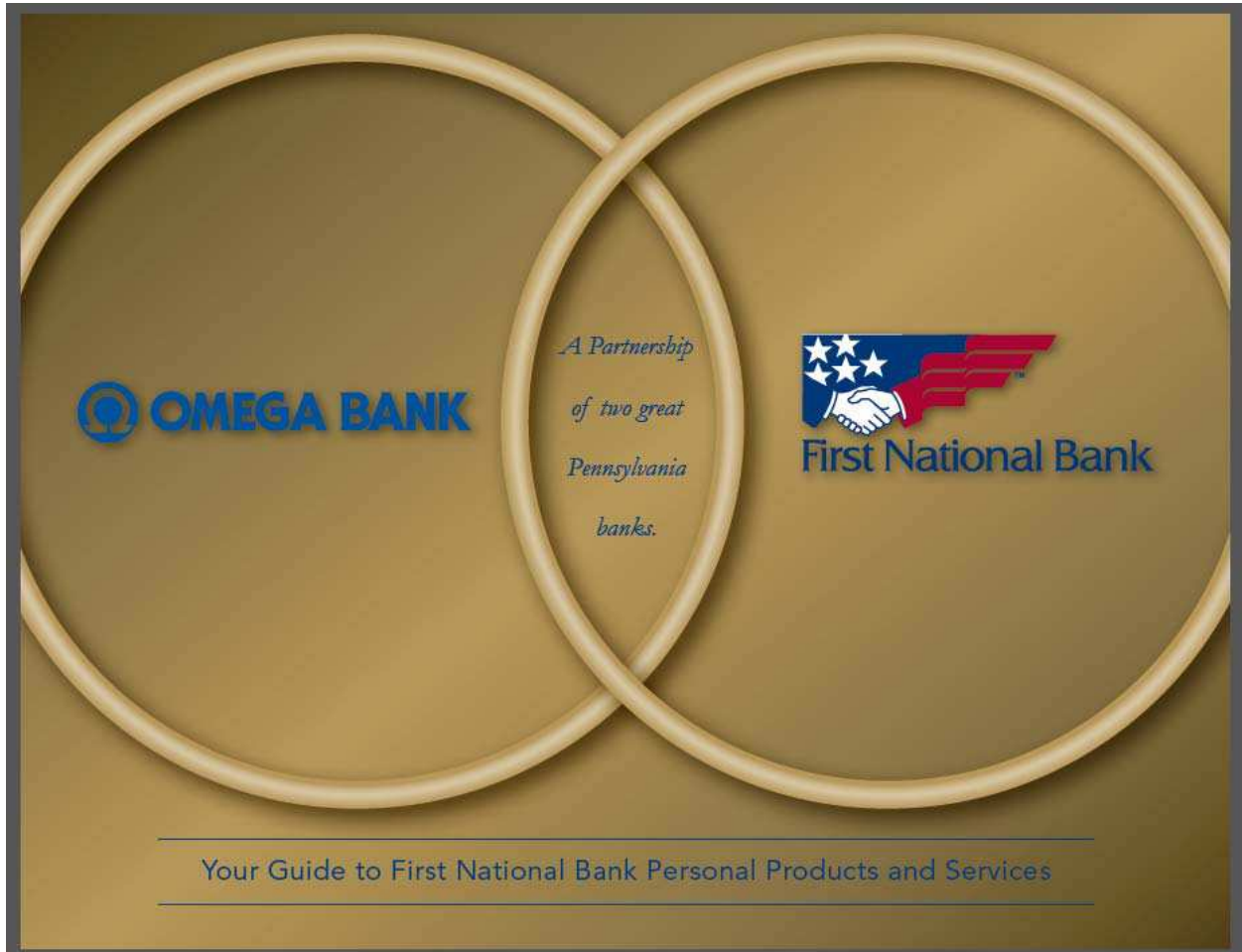
Opposer/Counter-defendant OMEGA CAPITAL MANAGEMENT, LLC's Trademark Registration No. 4654265 sets forth the following information:

Mark:	OMEGA CAPITAL
Goods/services:	Management of private equity funds; Private equity fund investment services; Providing venture capital, development capital, private equity and investment funding in Class 36.
Filed:	January 7, 2014
<b>Alleged First Use:</b>	<b>April 18, 2014</b>
Registered:	December 9, 2014

1. On or about April 2008, Applicant/Counterclaim Petitioner acquired longstanding rights in the mark OMEGA BANK, which, at the time of said acquisition, had been in use long prior to any first use date which has been or could be claimed by Opposer/Registrant.

The mark continues to be used by Applicant/Counterclaim Petitioner to the present.

Examples of Applicant/Counterclaim Petitioner's usage are set forth below:



and



2. F.N.B. CORPORATION has priority of right, title, interest, and use, including in the United States, and is first in time with respect to the mark OMEGA and OMEGA BANK and various iterations of same and as a result United States Trademark Registration No. 4654265 for the mark OMEGA CAPITAL (the “Subject Registration”) should not have issued.
3. As further grounds for this First Amended Counterclaim, the Subject Registration issued in error, and should not have proceeded to register over F.N.B. CORPORATION’s prior rights.
4. As a result of the facts set forth herein, OMEGA CAPITAL MANAGEMENT, LLC’s mark suggests a false connection with F.N.B. CORPORATION, and/or the Subject Registration was obtained contrary to the provisions of Section 1052 of the Trademark Act, and/or of subsection (a), (b), (c) or (d) therein.
5. In view of the above, OMEGA CAPITAL MANAGEMENT, LLC is not entitled to the Subject Registration pursuant to Section 14(3) of the Trademark Act, 15 U.S.C. Section 1064(3), and T.M.B.P. Section 307.02(a), and as such the Registration should be cancelled.

WHEREFORE, F.N.B. CORPORATION requests that Registration No. 4654265 be cancelled, and that this First Amended Counterclaim be sustained in favor of F.N.B. CORPORATION.

Respectfully submitted,

/JENNIFER L. WHITE LAW/  
JENNIFER L. WHITE LAW

WHITELAW LEGAL GROUP  
Attorney for Applicant  
**F.N.B. CORPORATION**  
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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the foregoing Answer, Affirmative Defenses and First Amended Counterclaim in this matter is being provided to the Attorney for Opposer:

[Penina Michlin Chiu](#)  
Frederic Dorwart, Lawyers PLLC  
[pchiu@fdlaw.com](mailto:pchiu@fdlaw.com); [jburden@fdlaw.com](mailto:jburden@fdlaw.com)

via electronic transmission on December 19, 2018.

/JENNIFER L. WHITELAW/  
JENNIFER L. WHITELAW