

US: TRADE MARK

TTAB clarifies allegation time period for dilution claims

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Recently, in *Omega SA v Alpha Phi Omega*, the Trademark Trial and Appeal Board (TTAB) issued a precedential decision which provided clarification concerning at what point in time a plaintiff must establish fame of its mark in order to support a claim of dilution by blurring in a TTAB proceeding. The case is significant because it may affect the ability of a prospective plaintiff to succeed on a claim of dilution by blurring in an opposition or cancellation proceeding.

In *Omega SA*, the plaintiff pleaded ownership of several registrations consisting of the term Omega in support of an opposition against two use-based trademark applications filed by Alpha Phi Omega for marks which included either the word Omega or the Omega letter of the Greek alphabet, one covering jewelry and one covering apparel. Omega SA asserted two bases for its opposition, namely, a likelihood of confusion and likelihood of dilution by blurring.

In responding to a motion for summary judgment filed by the applicant, Omega SA contended that it was required only to establish that its mark became famous prior to the filing date of the applicant's application. However, since the application was based on use of the mark, the TTAB determined that plaintiff was required to establish that its mark was famous prior to the date of first use by the applicant (rather than the filing date). The TTAB noted, however, that in those circumstances where an applicant is unable to establish a date of first use for the applied-for marks, then an opposer need only demonstrate that fame existed prior to the filing date of the application.

The TTAB further clarified that a plaintiff asserting a claim of dilution by blurring must "establish that its mark became

famous prior to any established, continuing use of the defendant's involved mark as a trademark or trade name, and not merely prior to use in association with the specific identified goods or services set forth in a defendant's subject application or registration". The TTAB noted that, unlike in other sections of the Lanham Act, applicable language of the Trademark Dilution Revision Act of 2006 does not limit use of a mark to any specific goods or services such that, for purposes of a dilution claim, the focus should be on any use of the mark at issue.

The result was that, for purposes of defending against a claim of dilution, the applicant could rely on its historical use of the applied-for mark in connection with goods or services other than those identified in the application. In the case at hand, the effect of the decision was to require Omega SA to claim fame over 80 years earlier, all but extinguishing the opposer's ability to sustain such a claim. Since the opposer had failed to state in its initial pleadings the date on which it alleged its mark became famous, the TTAB gave the opposer 20 days to properly plead dilution, albeit with the difficult evidentiary task of proving fame before the applicant's early first use date.