

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

Goodman

Mailed: November 7, 2013

Opposition No. 91210776

Audemars Piguet Holding S.A.

v.

Oak73, LLC

Before the Trademark Trial and Appeal Board:

As background, on June 14, 2013, applicant filed an answer and a motion to dismiss based on the dilution claim being insufficiently pleaded. Opposer opposed the motion and filed an amended pleading to "more clearly state the dilution claim." Applicant has now objected to the amended pleading to which opposer has filed a reply.

A party may file an amended pleading in response to a motion to dismiss so as to correct the defects identified in the motion to dismiss. TBMP § 503.03 (3d ed. rev. 2013). In the event that the defects are corrected, the motion to dismiss will be deemed moot. *Id.*

In the motion to dismiss, applicant argued that opposer's dilution claim in the original notice of opposition was insufficient, and the single sentence

relating to fame, in particular niche fame, was "inadequate as a matter of law."

Opposer argues that its amended pleading alleges fame with consumers and provides a "factual predicate" to support its allegations of fame and distinctiveness. Opposer submits it does not have to "prove its dilution claim in the opposition notice" and a short and plain statement, without additional factual detail, is all that is required, namely its general allegations of extensive advertising, promotion and publicity in the United States and "significant sales success."

In opposition to the leave to amend, applicant argues that opposer has made judicial admissions in the initial pleading of niche fame which cannot be disallowed and that the amended pleading conflicts with the original pleading. Applicant further argues that the allegations in the amended pleading are "conclusory," the allegation of "worldwide fame . . . fails to allege widespread recognition among the general consuming public of the United States" and that the other allegations merely "parrot the statutory language."

In reply, opposer argues that the original notice of opposition did not allege niche fame, but that even if the dilution claim was insufficient, "the amended opposition

notice clearly makes out such a claim" by alleging "additional, non-contradictory facts." Opposer further argues that applicant is improperly arguing the merits of the claim.

Applicant has pointed to certain allegations in the original complaint as judicial admissions which contradict the amended notice of opposition. However, the amended notice of opposition supersedes the original notice of opposition and therefore, any allegations in the original complaint may not be relied on as judicial admissions for purposes of dismissing the claim. *Gary v. U.S.* 67 Fed.Cl. 202 (Fed.Cl. 2005); see also *West Run Student Housing Associates, LLC v. Huntington Nat. Bank*, 712 F.3d 165 (3d Cir. 2013) (even if allegations in original complaint constituted judicial admissions, it does not follow that they may not amend them); *Giannone v. U.S. Steel Corp.*, 238 F.2d 544, 547 (3d Cir.1956) (recognizing that "withdrawn or superseded pleadings" do not constitute judicial admissions); *InterGen N.V. v. Grina*, 344 F.3d 134, 144-45 (1st Cir.2003) ("An amended complaint supersedes the original complaint, and facts that are neither repeated nor otherwise incorporated into the amended complaint no longer bind the pleader."); *188 LLC v. Trinity Indus., Inc.*, 300 F.3d 730, 736 (7th Cir.2002) ("When a party has amended a

pleading, allegations and statements in earlier pleadings are not considered judicial admissions."); *Huey v. Honeywell, Inc.*, 82 F.3d 327, 333 (9th Cir.1996) ("When a pleading is amended or withdrawn, the superseded portion ceases to be a conclusive judicial admission...." (citation and internal quotation marks omitted)); *172 Hibernia Nat'l Bank v. Carner*, 997 F.2d 94, 101 (5th Cir.1993) ("To the extent that Hibernia did make a 'judicial confession[ ]' [in its original complaint,] that confession was amended away." (citations omitted)).

When determining whether leave to amend a complaint should be granted, the Board applies the same legal standard as applied on a motion to dismiss for failure to state a claim pursuant to Rule 12(b)(6). See e.g., *MacEntee v. IBM (Int'l Bus. Machs.)*, 783 F.Supp.2d 434, 446 (SDNY 2011), aff'd, 471 F. App'x 49 (2d Cir.2012) (applying same standard to Rule 15(a) motion for leave to amend and Rule 12(b)(6) motion to dismiss).

To avoid dismissal at this stage of the proceeding, opposer need only allege such facts as would, if proved, establish that opposer is entitled to the relief sought. Therefore, opposer must allege that (1) it has standing to bring the proceeding, and (2) a valid ground exists for

denying the registration sought. See TBMP § 503.02 (3d ed. rev. 2013).

Standing

Applicant has not argued that opposer has not sufficiently alleged its standing, and the Board finds that opposer has sufficiently alleged standing by its allegation of priority and likelihood of confusion and use and ownership of Royal Oak marks. *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1873 n.2 (TTAB 1994) (opposer's allegations of priority and likelihood of confusion "constitute a legally sufficient pleading" of opposer's real interest in the proceeding for purposes of standing). *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985) (finding standing to oppose mark Intelsat based on opposer's pleading of use and ownership of the mark Intersat).

Likelihood of confusion

Applicant has not argued that the likelihood of confusion claim is insufficient, and the Board finds that opposer has sufficiently alleged likelihood of confusion by its allegations of priority, confusingly similar marks, and identical or similar goods. *Intersat Corp.*, 226 USPQ at 154 (for a likelihood of confusion claim, opposer must

plead both priority of use and allegations either directly or hypothetically, that applicant's mark as applied to its goods or services so resembles the marks previously used by opposer as to be likely to cause confusion or mistake).

Dilution

With regard to a dilution claim, a party must plead and prove that its mark is famous; that its mark became famous prior to the date of applicant's use or constructive use date, and that applicant's mark is likely to cause dilution by blurring the distinctiveness of opposer's mark or by tarnishing the reputation of opposer's mark. *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001).

Opposer's amended notice of opposition is insufficient as it fails to allege when opposer's marks became famous and that such fame occurred prior to the filing date of applicant's application. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1164; *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). In addition, the allegations with respect to dilution are either a conclusory recitation of the elements of the claim, or fail to allege sufficient facts to support a plausible claim for relief on the face of the complaint with respect to fame. *Bell Atl. Corp v. Twombly*, 550 U.S. 544, 570 (2007); *Ashcroft v. Iqbal*, 556

U.S. 662, 678 (2009); see *Luv N' Care Ltd. v. Regent Baby Products Corp.*, 103 USPQ2d 1243 (SDNY 2012) (finding dilution claim which alleges elements of dilution in a conclusory fashion insufficiently pleaded); *TechnoMarine SA v. Jacob Time, Inc.*, 905 F.Supp.2d 482 (SDNY 2012) (same). See also *Fiat Group Automobiles S.p.A. v. ISM Inc.*, 94 USPQ2d 1111 (TTAB 2010) (pleading insufficient because opposer failed to allege any particular use or specific facts to demonstrate widespread recognition of mark in U.S. when asserting fame of well known mark).

Accordingly, the motion to dismiss the dilution claim is granted.

Nonetheless, it is the policy of the Board to allow a party to amend an insufficient pleading. See, e.g., *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997); and TBMP § 503.03.

Accordingly, opposer is allowed until November 27, 2013 to submit an amended notice of opposition which sufficiently alleges dilution, failing which the dilution claim will stand dismissed, and the opposition will go forward on the priority and likelihood of confusion claim.

Proceedings are resumed.

Dates are reset as follows:

Time to Answer second amended complaint

**12/17/2013**

Deadline for Discovery Conference	1/16/2014
Discovery Opens	1/16/2014
Initial Disclosures Due	2/15/2014
Expert Disclosures Due	6/15/2014
Discovery Closes	7/15/2014
Plaintiff's Pretrial Disclosures	8/29/2014
Plaintiff's 30-day Trial Period Ends	10/13/2014
Defendant's Pretrial Disclosures	10/28/2014
Defendant's 30-day Trial Period Ends	12/12/2014
Plaintiff's Rebuttal Disclosures	12/27/2014
Plaintiff's 15-day Rebuttal Period Ends	1/26/2015

Proceedings are resumed.

Dates are reset as follows:

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

***By the Trademark Trial  
and Appeal Board***