

ESTTA Tracking number: **ESTTA573454**

Filing date: **11/27/2013**

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

Proceeding	91210776
Party	Plaintiff Audemars Piguet Holding S.A.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	11/27/2013
Attachments	91210776-Second Motion to Amend Opposition Notice.pdf(128135 bytes ) 91210776-Second Amended Notice of Opposition.pdf(131148 bytes )

<b>Audemars Piguet Holding S.A.</b>	)	<b>IN THE UNITED STATES</b>
	)	<b>PATENT AND TRADEMARK OFFICE</b>
<b>Plaintiff/Opposer</b>	)	
	)	<b>TRADEMARK TRIAL AND APPEAL BOARD</b>
<b>v.</b>	)	
	)	
<b>OAK73, LLC</b>	)	<b>APPL. NO. 85/776,034</b>
	)	
<b>Defendant/Applicant</b>	)	<b>OPPOSITION NO. 91210776</b>
_____	)	

**OPPOSER’S SECOND MOTION TO AMEND NOTICE OF OPPOSITION**

Audemars Piguet Holding S.A. ("Audemars Piguet", "Plaintiff", or "Opposer"), by and through its below-identified attorneys, hereby renews its motion to amend its notice of opposition to OAK73 LLC’s ("OAK73", "Defendant", or "Applicant") trademark application serial number 85/776,034, and states as follows:

**I. Audemars Piguet’s Amended Notice of Opposition Clearly States the Dilution Claim.**

Audemars Piguet’s amended notice of opposition is sufficient to state the dilution claim and give OAK73 fair notice of the basis for it. The amended notice of opposition is included with this motion.

Specifically, Audemars Piguet alleges that its marks are famous with the general public in the U.S., that they became famous prior to the filing date of OAK73’s application, and that OAK73’s mark will cause dilution by blurring the distinctiveness of Audemars Piguet’s marks and tarnishing the reputation of those marks.

Moreover, Audemars Piguet provides a comprehensive factual predicate that supports its allegation of fame, and dilution claim. The factual predicate includes well-known, nationally-distributed publications in which Royal Oak watches have been advertised for 40 years; significant U.S. advertising and sales figures for the Royal Oak watch; numerous people famous

in the U.S. who have served as spokespeople and endorsers for the Royal Oak watch; Royal Oak sponsorship of nationally-known events and promotions; Royal Oak signage in prominent U.S. locations with significant traffic, including numerous airport terminals, hotels, etc.; and articles in well-known U.S. publications attesting to the iconic nature of the Royal Oak watch.

## **II. Leave to Amend a Pleading Should be Freely Given.**

It is a long-standing principle, embodied both in the Federal Rules of Civil Procedure and in the Trademark Trial and Appeal Board Manual of Procedure, that pleadings may be amended by leave of court, and that “such leave shall be freely given”. Fed. R. Civ. P. 15(a), TBMP § 507.01(2). The Trademark Rules of Practice place no restrictions on amending the pleadings in an opposition, and state that “such pleadings may be amended in the same manner and to the same extent as in a civil action in a United States district court”. 37 C.F.R. § 2.107. Indeed, amended pleadings serve an important purpose because they allow parties to clarify their claims and defenses, and ensure that the other party has fair notice of what those claims and defenses are.

Leave should be particularly given in the absence of any showing of prejudice. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Smith v. Angelone*, 111 F.3d 1126, 1134 (4th Cir. 1997); *Davis v. Piper Aircraft Corp.*, 615 F.2d 606, 613 (4th Cir. 1980).

Here, OAK73 will not be prejudiced, because this proceeding is at a very early stage, and OAK73 will have a full and fair opportunity to respond to the amended opposition notice – indeed, the same opportunity as it had originally.

Respectfully submitted,

/John A. Galbreath/

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Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Second Motion to Amend Notice of Opposition and referenced attachments, if any, were sent by first-class mail to:

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321 N CLARK STREET  
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27 November 2013

/John A. Galbreath/  
John A. Galbreath

<b>Audemars Piguet Holding S.A.</b>	)	<b>IN THE UNITED STATES</b>
	)	<b>PATENT AND TRADEMARK OFFICE</b>
<b>Plaintiff/Opposer</b>	)	
	)	<b>TRADEMARK TRIAL AND APPEAL BOARD</b>
<b>v.</b>	)	
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<b>OAK73, LLC</b>	)	<b>APPL. NO. 85/776,034</b>
	)	
<b>Defendant/Applicant</b>	)	<b>OPPOSITION NO. 91210776</b>
_____	)	

**SECOND AMENDED NOTICE OF OPPOSITION**

Audemars Piguet Holding S.A. ("Audemars Piguet", "Plaintiff", or "Opposer"), by and through its below-identified attorneys, hereby opposes OAK73 LLC's ("OAK73", "Defendant", or "Applicant") trademark application serial number 85/776,034, and states as follows:

1. On November 9, 2012, Applicant filed an application in the United States Trademark Office ("Office") to register the OAK73 mark for use in connection with jewelry.

2. Opposer owns United States Registration No. 965112 for ROYAL OAK and United States Registration No. 2885834 for ROYAL OAK (collectively, "Opposer's Marks"). The filing dates for Opposer's Marks all predate Applicant's November 9, 2012 filing date.

3. Opposer has used its marks in commerce since 1972, in connection with at least the goods identified in the above-referenced registrations.

4. Applicant's mark was filed on an intent-to-use basis, and presumably was not in use as of its November 9, 2012 filing date. Thus, Opposer's priority in its marks predates any priority which may be claimed by Applicant.

5. Applicant's mark is confusingly similar to Opposer's Marks and is likely, when used on or in connection with the goods identified in the Opposed Application, to cause confusion, to

cause mistake, or to deceive, and Applicant's mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

6. Applicant's goods are identical or very similar to the goods in Opposer's Marks. Indeed, Applicant's applied-for goods are jewelry. This is identical to the jewelry goods in Opposer's Reg. No. 2885834 and very similar to the watches, etc. goods in Opposer's Reg. Nos. 965112 and 2885834.

7. Opposer's Marks are famous and distinctive in the relevant industry and trade, and with United States consumers. To be clear, Opposer's Marks are famous within the meaning of 15 U.S.C. § 1125(c) – that is, they are widely recognized by the general consuming public of the United States as a designation of source of Opposer's registered goods.

8. Opposer's marks have been famous in the United States since at least as early as March 2012, and thus, such fame occurred prior to the November 9, 2012 filing date of Applicant's mark.

9. Opposer first introduced the Royal Oak watch in the early 1970's. Due to its specific and unique design, the Royal Oak became an instant hit, and in the subsequent 40 years has become one of the most famous watches in the world.

10. Goods offered under Opposer's Marks have been extensively advertised, promoted, and publicized by Opposer in the United States since 1972 to the present, and have achieved significant sales success. The public has come to recognize Opposer's Marks as distinctive of its registered goods and as an indication of source of such goods.

11. Opposer's goods have been advertised using Opposer's Marks since 1972 to the present, in well-known newspapers and magazines that are widely distributed in the United States, including Time Magazine, The New York Times, Vanity Fair, Elle, The New Yorker, Los Angeles Magazine,

Miami Herald, Harper's Bazaar, Forbes, The Wall Street Journal, W Magazine, Departures Magazine, Barron's, Esquire, Golf Digest, and LA Confidential. Audemars Piguet has spent millions of dollars over the years just in advertising Royal Oak watches – advertising spending in 2012 alone was about \$750,000.

12. From 2006 to 2012 alone, Opposer's sales of the Royal Oak watch in the United States totaled \$339 million dollars.

13. In 2012, Chronos Magazine ranked the Royal Oak Offshore model as No. 6 in the United States and the Royal Oak model as No. 10 in the United States, and placed the Royal Oak in the same league as the also-famous Rolex watch.

14. Numerous people, famous across the United States, have served as spokespeople and endorsers for the Royal Oak watch. These spokespeople and endorsers include former President Bill Clinton; famous basketball player LeBron James; famous musician Jay-Z; famous basketball player Shaquille O'Neill; actor and former California governor Arnold Schwarzenegger (who wore the Royal Oak watch in the top-grossing 1984 movie "The Terminator"); and famous golfer Rory McIlroy, former No. 1 in the world and currently ranked No. 6. These people are followed by the general public in the United States, and their endorsements of the Royal Oak watch have contributed significantly to its fame.

15. Opposer and its Royal Oak watches have sponsored the Tony Awards, the well-known award ceremony watched across the United States, annually since 2009.

16. Opposer and its Royal Oak watches have sponsored the Time to Give Foundation charity auction annually since 2010. Famous participants, who sign Royal Oak watches for charity, have included the stars of stage and screen Meryl Streep, Hugh Jackman, Scarlett Johansson, Whoopi Goldberg, Jay-Z, Antonio Banderas, Kristin Chenoweth, Alan Cumming, Edie Falco, Kelsey

Grammer, Sean Hayes, Neil Patrick Harris, David Hyde Pierce, Catherine Zeta-Jones, Jane Krakowski, Nathan Lane, Angela Lansbury, Cyndi Lauper, John Lithgow, Sienna Miller, Bebe Neuwirth, Cynthia Nixon, Chita Rivera, Anika Noni Rose, Liev Schreiber, Vanessa Williams, Nick Cannon, and Daniel Radcliffe. These people are followed by the general public in the United States, and their connections to the Royal Oak watch have contributed significantly to its fame.

17. The Royal Oak watch was promoted in a large event and exhibition in Miami on November 8, 2007, celebrating the watch and its famous spokesperson Shaquille O’Neill.

18. Opposer and its Royal Oak watches sponsored Arnold Schwarzenegger’s After-School All-Stars charity event on June 17, 2010. The event included the auctioning of Mr. Schwarzenegger’s Royal Oak watch for charity.

19. The Royal Oak watch was promoted in a large event and exhibition in New York on March 21 - 24, 2012, celebrating the 40th anniversary of the watch in the United States.

20. Opposer sponsors New York City's highly-trafficked East 34th Street Heliport. The sponsorship includes prominent Royal Oak watch signage on the exterior and interior of the heliport, as well as Royal Oak images visible from the air and Royal Oak clocks inside the heliport.

21. Royal Oak clocks are located in 36 Delta Air Lines terminals throughout the United States and internationally; at 72 other aviation facilities nationwide; at NetJets headquarters in Columbus, Ohio; and in the Loews Regency Hotel in New York City.

22. The March 4, 1994 Los Angeles Times called the Royal Oak “among the leading prestige watch manufacturers”, in the same league with also-famous brands Rolex and Cartier.

23. In May 2005, Vanity Fair Magazine called the Royal Oak “one of the greatest classic steel watches”, “the watch that started it all”, and “the world’s first luxury steel sports watch”.

24. In December 2011 the New York Times, a leading newspaper widely distributed across the United States, listed the Royal Oak as one of only a few "truly classic watches" and a "timeless icon."

25. The November 22, 2013 Wall Street Journal, in an article about the history of elegant sports watches, stated that "Audemars created the category 40 years ago" and that "a new genre was born, sired by Audemars Piguet's Royal Oak".

26. Applicant's use and registration of its mark will cause dilution of Opposer's Marks, by blurring the distinctiveness of those marks and by tarnishing the reputation of those marks, and Applicant's mark is thus unregistrable under the United States Trademark Act, 15 U.S.C. § 1125(c).

27. Opposer will also be damaged by Applicant's registration of the mark shown in the Opposed Application because registration would give Applicant *prima facie* evidence of its ownership of an exclusive right to use a mark that is confusingly similar to Opposer's Marks, which rights would interfere with Opposer's continued use of its marks.

WHEREFORE, Opposer requests that the Office deny Applicant's application for registration of the mark shown in Application No. 85/776,034, and grant such other and further relief and damages to Opposer that the Office deems proper.

Respectfully submitted,

/John A. Galbreath/

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Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Second Amended Notice of Opposition and referenced attachments, if any, were sent by first-class mail to:

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27 November 2013

/John A. Galbreath/  
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