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Filing date: **07/05/2013**

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

Proceeding	91210776
Party	Plaintiff Audemars Piguet Holding S.A.
Correspondence Address	JOHN A GALBREATH GALBREATH LAW OFFICES PC 2516 CHESTNUT WOODS CT REISTERSTOWN, MD 21136-5523 UNITED STATES jgalbreath@galbreath-law.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	John A. Galbreath
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Signature	/John A. Galbreath/
Date	07/05/2013
Attachments	91210776-Motion to Amend Opposition Notice.pdf(127143 bytes) 91210776-Amended Notice of Opposition.pdf(122984 bytes)

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

OPPOSER’S MOTION TO AMEND NOTICE OF OPPOSITION

Audemars Piguet Holding S.A. ("Audemars Piguet", "Plaintiff", or "Opposer"), by and through its below-identified attorneys, hereby moves 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 Has Amended Its Notice of Opposition to Even More Clearly State the Dilution Claim.

As further discussed in Audemars Piguet’s opposition to OAK73’s motion to dismiss, filed contemporaneously with this motion to amend, Audemars Piguet’s amended notice of opposition is sufficient to state the dilution claim and give OAK73 fair notice of the basis for it. Audemars Piguet’s amended notice of opposition is included with this motion.

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 Motion to Amend Notice of Opposition and referenced attachments, if any, were sent by first-class mail to:

JAMES E. GRIFFITH
FOLEY & LARDNER LLP
321 N CLARK STREET
CHICAGO, IL 60654

05 July 2013

/John A. Galbreath/
John A. Galbreath

Audemars Piguet Holding S.A.)	IN THE UNITED STATES
)	PATENT AND TRADEMARK OFFICE
Plaintiff/Opposer)	
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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 at least as early as January 1, 1974, 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 the 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 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 goods.

8. 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. Indeed, 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."

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

10. Applicant's use and registration of its mark will cause dilution of Opposer's Marks, and Applicant's mark is thus unregistrable under the United States Trademark Act, 15 U.S.C. § 1125(c).

11. Opposer will 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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