

ESTTA Tracking number: **ESTTA553499**

Filing date: **08/12/2013**

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	Reply in Support of Motion
Filer's Name	John A. Galbreath
Filer's e-mail	jgalbreath@galbreath-law.com
Signature	/John A. Galbreath/
Date	08/12/2013
Attachments	91210776-Reply in Motion to Amend.pdf(145381 bytes)

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

REPLY IN 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 replies in the motion to amend its notice of opposition to OAK73 LLC’s ("OAK73", "Defendant", or "Applicant") trademark application serial number 85/776,034, and states:

OAK73’s opposition to the motion to amend is flawed in several respects, including the following.

I. Audemars Piguet’s Original Opposition Notice Did Not Merely Allege “Niche” Fame.

OAK73 contends that Audemars Piguet’s original notice of opposition merely alleged “niche” fame, and that it said nothing about the mark’s degree of recognition among the general consuming public. Appl. ’s Resp. at 2. This is simply incorrect. The original notice alleges not only that Audemars Piguet’s marks are famous and distinctive in the relevant industry and trade, but also that Audemars Piguet’s marks are famous and distinctive with consumers. Opp. Not. at para. 7. “Consumer” is a general term meaning “one who consumes”, and “distinctive” means “serving to distinguish”. Merriam-Webster Online Dictionary, <http://www.merriam->

webster.com. Thus, Audemars Piguet's allegation is equivalent to stating that its marks are famous with the general consuming public as a source-indicator.

II. Even If Audemars Piguet's Original Opposition Notice Did Not Sufficiently State the Dilution Claim, Certainly the Amended Opposition Notice States It Sufficiently.

Even if, *arguendo*, the original opposition notice did not sufficiently make out a dilution claim, the amended opposition notice clearly makes out such a claim. The amended notice does not contradict the original notice, but instead alleges additional, non-contradictory facts. The facts supporting the dilution claim are that Audemars Piguet's marks are famous and distinctive in the relevant industry and trade, and with consumers (Amend. Not. at para. 7); that the marks are widely recognized by the general consuming public of the United States as a designation of source of Audemars Piguet's goods (*Id.*); that the marks have been used in commerce for the relevant goods since at least as early as January 1, 1974 (Amend. Not. at para. 3); that the marks have been extensively advertised, promoted, and publicized by Audemars in the United States and have achieved significant sales success (Amend. Not. at paras. 8-9); that the watch sold under the Royal Oak mark watch has been listed by the New York Times as one of only a few "truly classic watches" and a "timeless icon" (Amend. Not. at para. 8); and that OAK73's use and registration of its mark will cause dilution of Audemars Piguet's marks (Amend. Not. at para. 10).

These facts are certainly sufficient to support a dilution claim. The facts alleged meet the requirements of the dilution statute, 15 U.S.C. § 1125(c), and also include facts that are indicators of fame under the statute. Audemars Piguet is not required to go into exquisite detail

concerning the nature of the fame and distinctiveness or the reasons for it. Said another way, Audemars Piguet does not have to prove its dilution claim in the opposition notice.

It is black-letter law that a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought. TBMP 503.02 and Note 2 thereto: *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982); *et al.* Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. TBMP 503.02; *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

A claimant is not required to set out in detail the facts upon which he bases his claim. *Conley v. Gibson*, 355 U.S. 41, 47 (1957). To the contrary, all the Rules require is a short and plain statement that gives fair notice of what the claim is and the grounds upon which it rests. *Id.* Only averments of fraud or mistake require greater particularity. Fed. R. Civ. P. 9(b).

The Supreme Court has definitively spoken on this issue in *Swierkiewicz v. Sorema N.A.*, 534 U.S. 506 (2002):

"[The] simplified notice pleading standard relies on liberal discovery rules and summary judgment motions to define disputed facts and issues and to dispose of unmeritorious claims." *Swierkiewicz*, supra at 512.

"Given the Federal Rules' simplified standard for pleading, '[a] court may dismiss a complaint only if it is clear that no relief could be granted under any set of facts consistent with the allegations.' *Hishon v. King & Spalding*, 467 U.S. 69, 73 104 S.Ct. 2229, 81 L.Ed.2d 59 (1984). If a pleading fails to specify the allegations in a manner that provides sufficient notice, a defendant can move for a more definite

statement under Rule 12(e) before responding. Moreover, claims lacking merit may be dealt with through summary judgment under Rule 56. The liberal notice pleading standard of Rule 8(a) is the starting point of a simplified pleading system, which was adopted to focus litigation on the merits of a claim." *Swierkiewicz*, supra at 514 (emphasis supplied).

"Furthermore, Rule 8(a) establishes a pleading standard without regard to whether a claim will succeed on the merits. 'Indeed it may appear on the face of the pleadings that a recovery is very remote and unlikely but that is not the test'." *Swierkiewicz*, supra at 515.

Throughout its response, OAK73 argues the merits of Audemars Piguet's dilution claim, and this not the place for that. OAK73 will have ample opportunity to argue the merits of the dilution claim during the trial phase. Indeed, the fact that OAK73 is arguing the merits proves the point that it has fair notice of the dilution claim, and that the claim raises factual issues that should be determined at trial.

III. Leave to Amend a Pleading Should be Freely Given, and Thus Allowing Audemars Piguet to Amend Its Opposition Notice Is Proper.

OAK73 contends that Audemars Piguet must be held to the original opposition notice. Appl.'s Resp. at 3. However, this ignores the long-standing principle 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). Indeed, the Trademark Rules of Practice place no restrictions on amending the pleadings in an opposition, and specifically 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. Here, while the original opposition notice sufficiently made out a dilution claim, the amended opposition notice clarifies the dilution claim by stating additional supporting facts.

OAK73 will not be prejudiced by the amended opposition notice, because this proceeding has only just begun. OAK73 will have the same opportunity as it had originally to respond to the amended opposition notice. Thus, leave to amend should particularly be given in this case. *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).

CONCLUSION

For all the above reasons, Audemars Piguet's motion to amend its opposition notice should be granted.

Respectfully submitted,

/John A. Galbreath/

John A. Galbreath
Galbreath Law Offices
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523
TEL: 410-628-7770
FAX: 410-666-7274
EMAIL: jgalbreath@galbreath-law.com

Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Reply in 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

12 August 2013

/John A. Galbreath/
John A. Galbreath