

ESTTA Tracking number: **ESTTA742589**

Filing date: **04/27/2016**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Audemars Piguet Holding S.A.		
Entity	Societe anonyme	Citizenship	Switzerland
Address	Route de France 16 Le Brassus, CH-1348 SWITZERLAND		

Attorney information	John A. Galbreath Galbreath Law Offices, P.C. 2516 Chestnut Woods Ct. Reisterstown, MD 21136 UNITED STATES jgalbreath@galbreath-law.com, jgalbreath@verizon.net Phone:410-628-7770		
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Applicant Information

Application No	86720380	Publication date	03/29/2016
Opposition Filing Date	04/27/2016	Opposition Period Ends	04/28/2016
Applicant	Groupon, Inc. 600 West Chicago Avenue Chicago, IL 60654 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. First Use: 2015/06/19 First Use In Commerce: 2015/06/19
All goods and services in the class are opposed, namely: Watches

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2885834	Application Date	04/18/2003
Registration Date	09/21/2004	Foreign Priority Date	NONE
Word Mark	ROYAL OAK		

Design Mark	ROYAL OAK
Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 1974/01/01 First Use In Commerce: 1974/01/01 Horological and chronometric instruments, namely, watch cases, watch bands, chronographs for use as watches, [chronometers,] clocks, watches, wrist-watches [, jewelry, namely, rings, earrings, cufflinks, bracelets, pendants, brooches, chains, necklaces, tie pins, pins for use as jewelry]

U.S. Registration No.	965112	Application Date	06/16/1972
Registration Date	07/31/1973	Foreign Priority Date	NONE
Word Mark	ROYAL OAK		
Design Mark	Royal Oak		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 WATCHES AND CLOCKS AND PARTS THEREOF		

Attachments	76508346#TMSN.png(bytes) 72427461#TMSN.png(bytes) Audemars Piguet-Groupon-OAK and RUSH mark-Notice of Opposition.pdf(130639 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John A. Galbreath/
Name	John A. Galbreath
Date	04/27/2016

Audemars Piguet Holding S.A.)	IN THE UNITED STATES
)	PATENT AND TRADEMARK OFFICE
Plaintiff/Opposer)	
)	TRADEMARK TRIAL AND APPEAL BOARD
v.)	
)	
Groupon, Inc.)	APPL. NO. 86/720,380
)	
Defendant/Applicant)	OPPOSITION NO.
_____)	

NOTICE OF OPPOSITION

Audemars Piguet Holding S.A. ("Audemars Piguet", "Plaintiff", or "Opposer"), by and through its below-identified attorneys, hereby opposes Groupon, Inc.'s ("Groupon", "Defendant", or "Applicant") trademark application serial number 86/720,380, and states as follows:

1. On Aug. 10, 2015, Applicant filed an application in the United States Trademark Office ("Office") to register the OAK & RUSH mark ("Applicant's Mark") for use in connection with watches.
2. Opposer owns United States Registration No. 965112 for ROYAL OAK and United States Registration No. 2885834 for ROYAL OAK (collectively, "Opposer's Marks").
3. Opposer has used its marks in commerce since at least as early as 1974, in connection with at least the goods identified in Opposer's registrations.
4. Applicant's Mark claims a first use date of June 19, 2015. The filing dates and first use dates for Opposer's Marks are before both the filing date and the claimed first use date for Applicant's Mark. Thus, Opposer's Marks have priority.

5. Applicant's OAK & RUSH mark is confusingly similar to Opposer's ROYAL OAK 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. 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 watches. Such goods are identical to the watch goods in Opposer's Marks.

7. Opposer's Marks are famous and distinctive in the relevant industry and trade, and with United States consumers. 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 Aug. 15, 2015 filing date and claimed June 19, 2015 first use 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, who has been the top-ranked golfer in the world. 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 sponsored the Tony Awards, the well-known award ceremony watched across the United States, from 2009 through 2014.

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 has sponsored New York City's highly-trafficked East 34th Street Heliport. The sponsorship included 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 have been 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. 86/720,380, 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 Notice of Opposition and referenced attachments, if any, were deposited as first-class mail addressed to:

Groupon, Inc.
600 West Chicago Avenue
Chicago IL 60654

27 April 2016

/John A. Galbreath/
John A. Galbreath