

ESTTA Tracking number: **ESTTA950967**

Filing date: **01/30/2019**

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

Proceeding	91245118
Party	Plaintiff Audemars Piguet Holding SA
Correspondence Address	JOHN GALBREATH GALBREATH LAW OFFICES PC 2516 CHESTNUT WOODS CT REISTERSTOWN, MD 21136 UNITED STATES jgalbreath@galbreath-law.com, jgalbreath@verizon.net 410-628-7770
Submission	Motion to Strike Pleading/Affirmative Defense
Filer's Name	John A. Galbreath
Filer's email	jgalbreath@galbreath-law.com, jgalbreath@verizon.net
Signature	/John A. Galbreath/
Date	01/30/2019
Attachments	91245118-OAKCOINS Opposition-Motion to Strike Answer.pdf(102299 bytes ) 91245118-Exhibit 1-OAKCOINS Opposition-Motion to Strike Answer.pdf(420795 bytes ) 91245118-Exhibit 2-OAKCOINS Opposition-Motion to Strike Answer.pdf(110046 bytes ) 91245118-Exhibit 3-OAKCOINS Opposition-Motion to Strike Answer.pdf(110215 bytes ) 91245118-Exhibit 4-OAKCOINS Opposition-Motion to Strike Answer.pdf(111998 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>Oakcoins</b>	)	<b>APPL. NO. 87/838,976</b>
	)	
<b>Defendant/Applicant</b>	)	<b>OPPOSITION NO. 91245118</b>
_____	)	

**OPPOSER’S MOTION TO STRIKE APPLICANT’S “ANSWER”**

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Sections 506.01 and 506.02 of the Trademark Trial and Appeal Board Manual of Procedure, Audemars Piguet Holding S.A. ("Audemars Piguet", "Plaintiff", or "Opposer"), respectfully asks the Board to strike Oakcoins’s (“Oakcoins”, “Defendant”, or “Applicant”) answer, and in support thereof states:

**INTRODUCTION**

On December 4, 2018, Audemars Piguet filed an opposition to the OAKCOINS mark. Ex. 1. On January 10, 2019, Oakcoins filed a motion to dismiss the opposition under Rule 12(b). Exs. 2 and 3. On January 19, 2019, the paralegal for the opposition notified the parties that Oakcoins’s motion to dismiss would instead be considered an answer. Ex. 4.

**ARGUMENT**

**I. OAKCOINS’S JANUARY 10, 2019 FILING DOES NOT MEET THE REQUIREMENTS FOR AN ANSWER.**

Oakcoins’s January 10, 2019 filing does not meet the requirements for an answer, either in form or substance. This is not surprising, because it was filed as a motion to

dismiss under Rule 12(b), and not as an answer. The filing itself clearly states “Submission: Motion to Dismiss, Rule 12(b)” (Ex. 2, p. 1); and the ESSTA filing receipt issued by the Office also states “Submission: Motion to Dismiss, Rule 12(b)” (Ex. 3, p. 1). Moreover, it is not unusual for a defendant to file a 12(b) motion to dismiss in lieu of an answer – this is commonly done in oppositions as well as U.S. District Court proceedings.

Oakcoins’s answer simply does not meet the requirements of Fed. R. Civ. P. 8(b): “In responding to a pleading, a party must: (A) state in short and plain terms its defenses to each claim asserted against it; and (B) admit or deny the allegations asserted against it by an opposing party.” These requirements are also set forth in 37 CFR 2.106(b)(2) and TMBP 311.01(a), respectively: “An answer shall state in short and plain terms the applicant’s defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies”, and “Substance of answer: The answer must contain admissions and/or denials of the allegations in the complaint and may include any defenses to those allegations.”

The answer contains only an oblique reference to confusion, accompanied by some immaterial drawings of coins. Neither the opposer, nor opposer’s marks, nor any other entity is identified – instead, the text merely refers to “XXXXX name” and “XXXX Company”. The answer does not contain an admission or denial of the various allegations in the Notice of Opposition – it does not even contain the words “admit” or “deny” anywhere, nor any synonyms for these terms.

Importantly, the answer does not function as a general denial under Fed. R. Civ. P. 8(b), because it contains no statement generally denying all the averments in the Notice of Opposition. The answer cannot even be considered to be an implied general denial, because it does not deny each claim asserted in the Notice of Opposition. Specifically, Audemars Piguet claims not only likelihood of confusion, but also dilution by blurring and dilution by tarnishment. Ex. 1, para. 26. The answer contains absolutely no reference to these dilution claims.

Further, even if such a general denial had been made, it would not meet the “good faith” requirement of Fed. R. Civ. P. 8(b)(3), because there are averments in the Notice of Opposition which cannot be denied in good faith – for example, the averments in paragraphs 1 and 2.

## **II. AUDEMARS PIGUET WILL BE PREJUDICED IF OAKCOINS’S “ANSWER” IS NOT AMENDED TO MEET THE REQUIREMENTS OF THE RULES.**

If Oakcoins’s answer is not amended to meet the requirements of the rules, Audemars Piguet will be prejudiced because it will not know whether Oakcoins admits or denies the various averments in the Notice of Opposition. Indeed, the very purpose of the answer requirements is to give the plaintiff fair notice of the defenses to each claim in the action, and provide a definitive admission or denial of each allegation in the complaint. The plaintiff is prejudiced without such fair notice and definitive admission or denial.

## CONCLUSION

For all the above reasons, Applicant's answer should be stricken, and Applicant should be required to submit an amended answer which meets all the requirements in the rules, both for form and substance.

Respectfully submitted,

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Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Motion to Strike and referenced attachments, if any, were served by e-mail on the applicant OAKCOINS at the following correspondence email address:

coins@oakcoins.com

30 January 2019

/John A. Galbreath/  
John A. Galbreath

# EXHIBIT 1

<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>Oakcoins</b>	)	<b>APPL. NO. 87/838,976</b>
	)	
<b>Defendant/Applicant</b>	)	<b>OPPOSITION NO.</b>
_____	)	

## NOTICE OF OPPOSITION

Audemars Piguet Holding S.A. ("Audemars Piguet", "Plaintiff", or "Opposer"), by and through its below-identified attorneys, hereby opposes Oakcoins's ("Oakcoins", "Defendant", or "Applicant") trademark application serial number 87/838,976, and states as follows:

1. On Mar. 18, 2018, Applicant filed an application in the United States Trademark Office ("Office") to register the OAKCOINS mark ("Applicant's Mark") for use in connection with key chains; lapel badges of precious metal; lapel pins; medals; medals and medallions; medals coated with precious metals; medals for use as awards; collectible coins; commemorative coins; commemorative medals; metal key chains; and ornamental lapel pins.
2. Opposer owns United States Registration No. 965112 for ROYAL OAK and United States Registration No. 2885834 for ROYAL OAK (collectively, "Opposer's Marks"). Copies of the TSDR entries for these registrations are attached to this opposition notice.
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 claims an August 8, 2005 first use date for its above-referenced goods. Applicant's first use date is well after Opposer's first use dates, and thus, Opposer's marks have priority.

5. Applicant's OAKCOINS 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 opposed goods are similar to the goods and/or services in Opposer's Marks. Applicant's opposed goods are types of jewelry, which are similar to the watches and other goods in Opposer's Reg. Nos. 965112 and 2885834. Indeed, watches and timepieces are typically considered to be jewelry, and often contain jewels/gemstones. Jewelry is often sold side-by-side with watches, in the same retail stores and through the same on-line websites. In addition, Opposer is using its marks in U.S. commerce for cufflinks, which are jewelry, and such use predates any priority which may be claimed by Applicant.

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 July 2005, and thus, such fame occurred prior to the first use dates of Applicant's Mark.

9. Opposer first introduced the Royal Oak watch in the early 1970's. Due to its unique name and 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 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 a top-grossing Terminator movie); 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. 87/838,976, 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 Filing and Service: This Notice of Opposition is being filed electronically via the ESTTA system. Pursuant to 37 C.F.R. § 2.105(a) and TBMP § 310.01, the notice of institution issued by the Board functions as service on Applicant of this Notice of Opposition.

04 December 2018

/John A. Galbreath/  
John A. Galbreath

# EXHIBIT 2

Trademark Trial and Appeal Board Electronic Filing System. <http://esta.uspto.gov>

ESTTA Tracking number: **ESTTA946854**

Filing date: **01/10/2019**

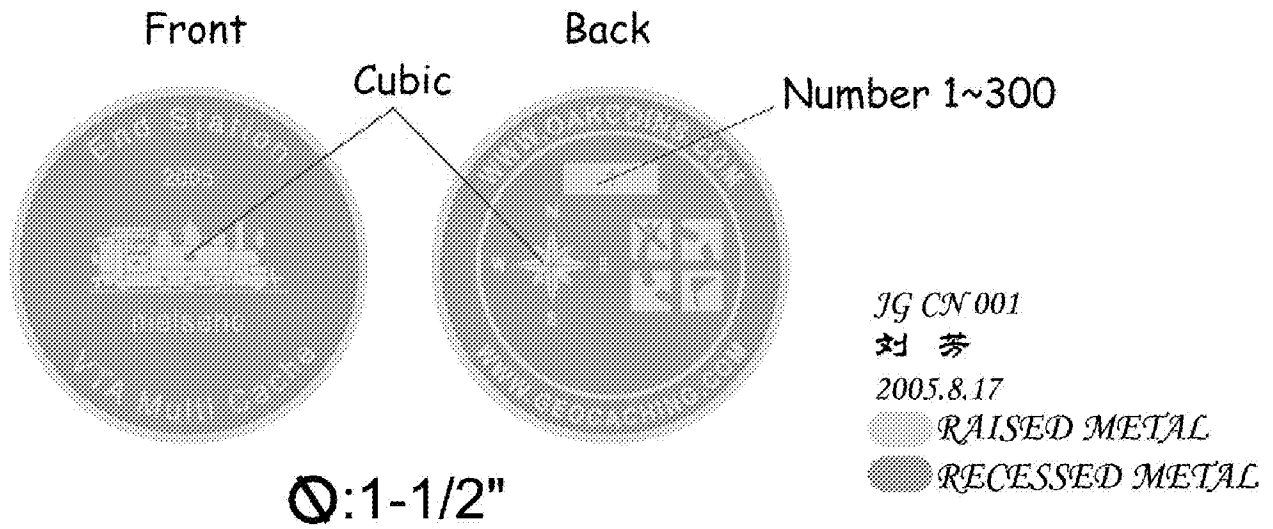
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91245118
Party	Defendant Oakcoins
Correspondence Address	OAKCOINS OAKCOINS 348 S MAIN ST KAYSVILLE, UT 84037 coins@oakcoins.com no phone number provided
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Hans Nielsen
Filer's email	hnielsen@oakcoins.com
Signature	E.g.: /Hans Nielsen/
Date	01/10/2019
Attachments	Trademark.pdf(135612 bytes )

Oakcoins has been operating with the name Oakcoins since we registered the domain name Aug 8, 2005. In the past 13 years, we have never had any person contact us about or confuse us with XXXXX name. XXXX Company never contact us, either via Mail, Email or by phone to let us know there is confusion.

We have enclosed a drawing of our first coin which was first given out Aug 13, 2005.

[https://www.geocaching.com/geocache/GCQ4DG\\_end-station-vta-mystery-cache](https://www.geocaching.com/geocache/GCQ4DG_end-station-vta-mystery-cache)



## **EXHIBIT 3**

estta\_autoreply@uspto.gov

1/10/2019 8:12 PM

### ESTTA Filing Receipt: Proceeding or Serial or Registration No. 91245118 Motion to Dismiss - Rule 12(b) Filing Receipt for ESTTA Tracking No: ESTTA946854

To jgalbreath@galbreath-law.com • jgalbreath@verizon.net • hnielsen@oakcoins.com

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#### ESTTA Filing Receipt

This ESTTA Filing Receipt confirms receipt of your filing associated with the above-identified ESTTA Tracking Number.

Your filing may be viewed on TTABVUE at <http://ttabvue.uspto.gov/ttabvue/> . If you don't see your filing on TTABVUE a week after you file, or if you received an error message or experienced a technical issue while submitting your filing on ESTTA, please send an email to [estta@uspto.gov](mailto:estta@uspto.gov) and provide the ESTTA Tracking Number and the Serial, Registration or Proceeding Number identified above, and a brief description of the error message or technical issue you encountered.

For non-technical status or information inquiries, please contact the TTAB Assistance Center at [ttabinfo@uspto.gov](mailto:ttabinfo@uspto.gov) or 571-272-8500 Monday through Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET).

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Tracking No.: ESTTA946854  
Filing date: 01/10/2019

Proceeding No.: 91245118  
Filing Party: Defendant  
Oakcoins

Filing Party's Correspondence Address: OAKCOINS  
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no phone number provided

Submission: Motion to Dismiss - Rule 12(b)

Filer's Name: Hans Nielsen  
Filer's email: [hnielsen@oakcoins.com](mailto:hnielsen@oakcoins.com)  
Signature: E.g.: /Hans Nielsen/  
Date: 01/10/2019

Attachments: Trademark.pdf

# EXHIBIT 4

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
TTAB Assistance Center: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

January 19, 2019

Opposition No. 91245118

*Audemars Piguet Holding SA*

*v.*

*Oakcoins*

**Karl Kochersperger, Paralegal Specialist:**

Applicant's answer to the notice of opposition, filed January 10, 2019 is noted.

The answer fails to include proof of service on the other party or parties, as required by Trademark Rule 2.119(a). The Board notes the answer. However, any future submission that does not include proof of service may be denied consideration.

Copies of all submissions filed in this proceeding must be served upon the other party or parties, and accompanied by a statement signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made. *See* Trademark Rule 2.119(a); TBMP § 113.03. The statement will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by



forwarding said copy on (insert date of mailing), via email (or insert other appropriate method of delivery) to: (set out name, and address or email address of opposing counsel or party).

Signature \_\_\_\_\_

Date \_\_\_\_\_

At the following link to TTABVUE, the parties may view all submissions in this proceeding: <http://ttabvue.uspto.gov>.

Conferencing, disclosure, discovery and testimony dates remain as previously set forth in the Board's order dated December 4, 2018.