

ESTTA Tracking number: **ESTTA1155963**

Filing date: **08/27/2021**

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 SA		
Entity	Corporation	Citizenship	Switzerland
Address	16 ROUTE DE FRANCE LE CHENIT, LE BRASSUS, 0 SWITZERLAND		
Attorney information	JOHN A. GALBREATH GALBREATH LAW OFFICES, P.C. 2516 CHESTNUT WOODS CT. REISTERSTOWN, MD 21136 UNITED STATES Primary Email: jgalbreath@galbreath-law.com Secondary Email(s): jgalbreath@verizon.net 410-628-7770		
Docket Number			

**Applicant Information**

Application No.	90427008	Publication date	08/03/2021
Opposition Filing Date	08/27/2021	Opposition Period Ends	09/02/2021
Applicant	FUJIAN ROYAL INDUSTRY CO.,LTD. 68 SHITING EAST ROAD, SHITING TOWN, XIANGCHENG DISTRICT ZHANGZHOU, FUJIAN, 363000 CHINA		

**Goods/Services Affected by Opposition**

Class 014. First Use: 2020/12/22 First Use In Commerce: 2020/12/22 All goods and services in the class are opposed, namely: Boxes for timepieces; Fitted jewelry pouches; Jewellery boxes; Jewellery cases; Jewellery rolls; Jewelry boxes; Jewelryboxes not of metal; Jewelry cases; Jewelry organizer cases; Jewelry organizer rolls for travel; Jewelry rolls; Jewelry rolls for storage; Jewelry rolls for travel; Leather jewelry and accessory boxes; Presentation boxes for jewellery; Presentation boxes for jewelry; Presentationboxes for watches; Watch pouches; Watch-winders; Wooden jewellery boxes
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

## Marks Cited by Opposer as Basis for Opposition

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			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 WATCHES AND CLOCKS AND PARTS THEREOF		

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			
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 ]		

Attachments	72427461#TMSN.png( bytes ) 76508346#TMSN.png( bytes ) ROYALISOOAK mark-Notice of Opposition.pdf(1432107 bytes )
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Signature	/John A. Galbreath/
Name	JOHN A. GALBREATH
Date	08/27/2021

<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>Fujian Royal Industry Co., Ltd.</b>	)	<b>APPL. NO. 90/427,008</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 Fujian Royal Industry Co., Ltd.'s ("Fujian", "Defendant", or "Applicant") trademark application serial number 90/427,008, and states as follows:

1. On December 29, 2020, Applicant filed an application in the United States Trademark Office ("Office") to register the ROYALISOOAK mark ("Applicant's Mark") for use in connection with the following goods: Boxes for timepieces; Fitted jewelry pouches; Jewellery boxes; Jewellery cases; Jewellery rolls; Jewelry boxes; Jewelry boxes not of metal; Jewelry cases; Jewelry organizer cases; Jewelry organizer rolls for travel; Jewelry rolls; Jewelry rolls for storage; Jewelry rolls for travel; Leather jewelry and accessory boxes; Presentation boxes for jewellery; Presentation boxes for jewelry; Presentation boxes for watches; Watch pouches; Watch winders; Wooden jewellery boxes.

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 goods identified in Opposer's registrations.

4. Applicant claims a December 22, 2020 first use in commerce date for its above-referenced goods/services. Applicant's first use date is well after Opposer's first use dates, and thus, Opposer's marks have priority.

5. Applicant's ROYALISOOAK 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 confusingly similar to the goods and/or services in Opposer's Marks. Specifically, Applicant's various watch and jewelry-related goods are confusingly similar to the watch and other goods in Opposer's Reg. Nos. 965112 and 2885834. 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.

8. Opposer's marks have been famous in the United States since at least as early as January 2020, 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 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 at least as early as 1974 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 at least as early as 1974 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 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 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 sponsored the Time to Give Foundation charity auction in 2010. Famous participants, who signed Royal Oak watches for charity, 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 Audemars Piguet “among the leading prestige watch manufacturers”, in the same league with also-famous brands Rolex and Cartier. The Royal Oak watch is the mainstay of the Audemars Piguet line.

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. 90/427,008, and grant such other and further relief and damages to Opposer that the Office deems proper.

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 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.

27 August 2021

/John A. Galbreath/  
John A. Galbreath

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STATUS DOCUMENTS MAINTENANCE

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Mark: ROYAL OAK

Royal Oak

US Serial Number: 72427461

Application Filing Date: Jun. 16, 1973

US Registration Number: 965112

Registration Date: Jul. 31, 1973

Register: Principal

Mark Type: Trademark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with

Status: The registration has been renewed.

Status Date: Jul. 24, 2013

### Mark Information

Mark Literal Elements: ROYAL OAK

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

### Foreign Information

Priority Claimed: Yes

Foreign Application Number:

Foreign Application Filing Date: Dec. 23, 1973

Foreign Registration Number: 256609

Foreign Registration Date: Dec. 23, 1973

Foreign Application/Registration Country: SWITZERLAND

### Goods and Services

## Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- \* Brackets [ ] indicate deleted goods/services;
- \* Double parenthesis ( ( ) ) identify any goods/services not claimed in a Section 15 affidavit of incontestability, and
- \* Asterisks \* \* identify additional (new) wording in the goods/services.

For: WATCHES AND CLOCKS AND PARTS THEREOF

International Class(es): 014

U.S Class(es): 027 - Primar

Class Status: ACTIVE

Basis: 44(e)

### Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: No

Currently ITU: No

Filed 44D: Yes

Currently 44E: Yes

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis:

Filed No Basis: No

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### Current Owner(s) Information

Owner Name: AUDEMARS PIGUET HOLDING S.A.

Owner Address: 16 ROUTE DE FRANCE  
LE CHENIT, LE BRASSUS SWITZERLAND

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

### Attorney/Correspondence Information

#### Attorney of Record

Attorney Name: JOHN P. MURTAUGH

Docket Number: BRAQ-J3883

Attorney Primary Email: [tmddocket@pearne.com](mailto:tmddocket@pearne.com)

Attorney Email Authorized: Yes

Address:

#### Correspondent

Correspondent Name/Address: JOHN P. MURTAUGH

PEARNE & GORDON LLP  
1801 EAST 9TH STREET, SUITE 1200  
CLEVELAND, OHIO UNITED STATES 44114-3108

Phone: 216-579-1700

Fax: 216-579-607

Correspondent e-mail: [tmddocket@pearne.com](mailto:tmddocket@pearne.com)

Correspondent e-mail Authorized: Yes

**Domestic Representative - Not Found****Prosecution History**

<b>Date</b>	<b>Description</b>	<b>Proceeding Number</b>
Nov. 20, 2019	NOTICE OF SUIT	
Jul. 24, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jul. 24, 2013	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	76874
Jul. 24, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	76874
Jul. 24, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76874
Jul. 10, 2013	TEAS SECTION 8 & 9 RECEIVED	
Aug. 19, 2008	CASE FILE IN TICRS	
May 30, 2003	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
May 30, 2003	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jan. 09, 2003	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jan. 09, 2003	PAPER RECEIVED	
May 19, 1993	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Apr. 13, 1993	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Jan. 02, 1980	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	

**TM Staff and Location Information****TM Staff Information - None****File Location**

Current Location: GENERIC WEB UPDATE

Date in Location: Jul. 24, 2013

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Mark: ROYAL OAK

# ROYAL OAK

US Serial Number: 76508346

Application Filing Date: Apr. 18, 2003

US Registration Number: 2885834

Registration Date: Sep. 21, 2004

Register: Principal

Mark Type: Trademark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with

Status: The registration has been renewed.

Status Date: Jun. 27, 2014

Publication Date: Jun. 29, 2004

## Mark Information

Mark Literal Elements: ROYAL OAK

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

## Related Properties Information

Claimed Ownership of US [0965112](#), [1572003](#), [1979935](#)

Registrations:

## Goods and Services

### Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- \* Brackets [...] indicate deleted goods/services;
- \* Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- \* Asterisks \*..\* identify additional (new) wording in the goods/services.

For: Horological and chronometric instruments, namely, watch cases, watch bands, chronographs for  
clocks, watches, wristwatches [, jewelry, namely, rings, earrings, cuff links, bracelets, pendants,  
pins, pins for use as jewelry ]

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1974

Use in Commerce: Jan. 01, 1974

### Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

### Current Owner(s) Information

Owner Name: Audemars Piguet Holding S.A.

Owner Address: Route de France 16 Le Chenit  
Le Brassus SWITZERLAND

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Legal Entity Type: JOINT STOCK COMPANY

State or Country Where Organized: SWITZERLAND

### Attorney/Correspondence Information

#### Attorney of Record

Attorney Name: JOHN P. MURTAUGH

Docket Number: BRAQ-J3883

Attorney Primary Email: [tmocket@pearne.com](mailto:tmocket@pearne.com)

Attorney Email Authorized: Yes

Address:

#### Correspondent

Correspondent Name/Address: JOHN P. MURTAUGH

PEARNE & GORDON LLP

1801 EAST 9TH STREET, SUITE 1200

CLEVELAND, OHIO UNITED STATES 44114-3108

Phone: 216-579-1700

Fax: 216-579-607

Correspondent e-mail: [tmocket@pearne.com](mailto:tmocket@pearne.com)

Correspondent e-mail Authorized: Yes

#### Domestic Representative

**Domestic Representative** B. Parker Livingston, Jr.

Name:

**Prosecution History**

<b>Date</b>	<b>Description</b>	<b>Proceeding Number</b>
Jun. 27, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jun. 27, 2014	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75184
Jun. 27, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	75184
Jun. 27, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
Jun. 12, 2014	TEAS SECTION 8 & 9 RECEIVED	
Apr. 08, 2011	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	68335
Sep. 07, 2010	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	68335
Apr. 08, 2011	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	68335
Apr. 05, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Mar. 07, 2011	TEAS RESPONSE TO OFFICE ACTION-POST REG RECEIVED	
Sep. 07, 2010	POST REGISTRATION ACTION MAILED - SEC. 8 & 15	68335
Sep. 04, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Aug. 16, 2010	TEAS SECTION 8 & 15 RECEIVED	
Sep. 21, 2004	REGISTERED-PRINCIPAL REGISTER	
Jun. 29, 2004	PUBLISHED FOR OPPOSITION	
Jun. 09, 2004	NOTICE OF PUBLICATION	
Apr. 29, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 08, 2004	PAPER RECEIVED	
Mar. 16, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 16, 2004	PAPER RECEIVED	
Sep. 16, 2003	NON-FINAL ACTION MAILED	
Sep. 08, 2003	ASSIGNED TO EXAMINER	76834

**TM Staff and Location Information****TM Staff Information - None****File Location**

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Date in Location: Jun. 27, 2014

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