

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

Serial No. 78/253,725
For the Mark VEGAS

TTAB

THE UNITED STATES)
PLAYING CARD COMPANY)
)
Opposer,)
)
v.)
)
HARBRO, LLC,)
)
Applicant.)

Opposition No. 91162078

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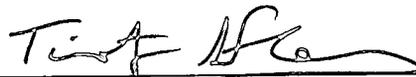
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04-11-2006

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APPLICANT'S TRIAL BRIEF

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I. PRELIMINARY STATEMENT

Applicant, Harbro, LLC ("Harbro"), has applied to register its mark VEGAS for "playing cards" (Serial No. 78/253,725). Opposer, The United States Playing Card Company ("USPC"), filed a notice of opposition alleging the mark VEGAS to be: (a) deceptive under the Trademark Act Section 2(a), (b) primarily geographically misdescriptive within the meaning of Section 2(e), or (c) primarily geographically descriptive within the meaning of Section 2(e). Opposer restricted its arguments and proofs solely to the issue of geographic misdescriptiveness and thus waived its allegations regarding deceptiveness under Section 2(a) or primarily geographically descriptiveness under Section 2(e). Even as to the primarily geographically misdescriptiveness issue Opposer did not, and could not, establish VEGAS to be barred under Section 2(e) and Applicant is entitled to registration.

It was Opposer's burden to prove: (1) the primary significance of the VEGAS mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the VEGAS mark indicates the origin of the "playing cards" goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation was a material factor in the consumer's decision. A term that has popular significance apart from its otherwise geographical meaning is not, in most cases, 'primarily' geographical. Opposer did not even attempt to prove elements (3) and (2), and failed in its proofs of (1).

By its own admission Opposer did not submit evidence as to element (3), materiality in the consumer decision, but instead relied upon an outdated pre-NAFTA "presumption" that was overturned by *In re California Innovations, Inc.*, 329 F.3d 1334, 1340, 66 USPQ2d 1853, 1857 (Fed. Cir. 2003), a case cited by Opposer itself. Opposer likewise failed to submit evidence as to element (2), mistaken belief as to origin of playing cards, and in fact Opposer's own witness

admitted no cards are manufactured in or originate from Las Vegas, Nevada. Rather, Opposer limited its efforts to establishing that Las Vegas is known for gambling, and among other things playing games with cards. Finally, as to element (1), the primary significance is a well-known geographic location, Opposer submitted a mixed collection of objectionable materials limited to a narrow time window that reflect the term "VEGAS" is used in some instances to refer to Las Vegas but in many instances refers to something other than a geographic location. The term "Vegas" has popular significance apart from any alleged geographic meaning and is not primarily geographical.

Not only did Opposer fail in its burden, but the evidence which is of record establishes that the mark VEGAS is entitled to registration. First, Opposer's own evidence establishes the term VEGAS is not primarily geographic, but refers to the aura life style, nightlife or gambling activities, such as the lifestyle and activities that take place in upscale casinos, such as casinos of the types found in the city of Las Vegas, Nevada. Second, the evidence establishes that no playing cards are manufactured or produced or otherwise originated in the city of Las Vegas, Nevada. Finally, because playing cards do not originate in Las Vegas, Nevada, such an origination cannot be a material factor in a consumer's decision to purchase playing cards. Regardless, Opposer has established no evidence of materiality.

Applicant objects to most of Opposer's purported "evidence." During its testimony period Opposer took, but failed to promptly file, the testimony of one of its employees, Daniel Espenscheid, who offered incompetent speculation and rank hearsay based on printouts of websites he had no involvement with, most of which sites Mr. Espenscheid had never visited or even looked at. Opposer took, and again failed to promptly file, testimony of an employee of the Las Vegas Convention and Visitors Authority who testified as to promotional campaigns in the

last three years involving a limited number of brochures and maps, copies of which were distributed during that period numbering only in the thousands. Opposer filed a document purporting to be a notice of reliance listing press clippings that are not admissible by notice of reliance, virtually all of which are limited to the months of May - July 2005, and Applicant has now learned that Opposer did not file the publications as is required under the rules. During the rebuttal period Opposer took testimony of two witnesses and filed a notice of reliance, none of which was proper rebuttal, but rather were unrelated to evidence of Applicant and should have been filed during Opposer's case in chief, if at all, since these materials were hearsay and lacked competence.

The mark VEGAS for playing cards is neither deceptive nor primarily geographically misdescriptive. The Board should deny the opposition and allow registration of the mark VEGAS for playing cards.

II. PROCEDURAL HISTORY

As supplement to the procedural history noted in Opposer's Brief, in Applicant's application to register on the principal register the mark VEGAS for playing cards in class 28, filed May 23, 2003, an Amendment to Allege Use was filed on October 6, 2003, identifying June 13, 2003, as the date of first use and first use in commerce. The Examining Attorney issued an Office Action on November 26, 2003, refusing registration of the mark because the mark VEGAS was argued by the Examining Attorney to be geographically deceptively misdescriptive in relation to the identified goods. Applicant filed a response on April 2, 2004. In the Response, Applicant discussed the three part test set forth in *In re California Innovations, Inc., supra*, and indicated why the mark VEGAS is not primarily geographically misdescriptive or deceptive and

is thus registerable on the principal register. The Examining Attorney then approved registration of the mark which was published in the Official Gazette on August 10, 2004.

Opposer filed an opposition to Applicant's VEGAS application on September 9, 2004, alleging that the mark was either deceptive or primarily geographically descriptive or misdescriptive. Opposer has not, however, attempted to present a case for unregistrability based on either deceptiveness or primarily geographically descriptiveness.

III. DESCRIPTION OF THE RECORD

A. Opposer's Case In Chief

Kevin Bagger - Las Vegas Convention and Visitors' Authority employee. As noted herein, Applicant objects to this testimony as not having been promptly filed as required under 37 C.F.R. § 2.123(f)(2), and as to leading questioning interposed by Opposer.

Dan Espenscheid - USPC employee. As noted herein, Applicant objects to Mr. Espenscheid's testimony on grounds of hearsay and lack of competence, as well as not having been promptly filed as required under 37 C.F.R. § 2.123(f)(2).

Opposer's purported July 29, 2005 Notice of Reliance. Applicant objects to Opposer's purported July 29, 2005 Notice of Reliance as not filing the referenced materials during Opposer's testimony period and failing to comply with other applicable rules as required under 37 C.F.R. § 2.122(e). Applicant further objects to Opposer's Notice of Reliance in that the listed press clippings and other materials cannot be made of record by notice of reliance.

B. Applicant's Case In Chief

Applicant's evidence of record comprises:

The testimonial deposition of Applicant's witness Karl Ondersma – Van Dyke, Gardner Linn and Burkhart, LLP employee. Mr. Ondersma testified as to his own personal knowledge on

limited subjects, involving the purchase of playing cards from a company located in the Detroit Michigan area identified in Opposer's exhibit, and the logging onto of certain Internet websites to determine if any information was carried thereon that would identify an address or location.

Those Applicant Exhibits identified by Mr. Ondersma are:

- A. Gameland Sports website pages;
- B. Deck of Playing cards with Las Vegas, Nevada sign (Front of Pack and Card);
- C. Bottom of Deck of Playing Cards;
- D. The Game Saloon website pages;
- E. Dollar Days website pages;
- F. Touch of Ginger website pages;
- G. Pokerchip Wholesale website pages;

Applicant's Notice of Reliance dated November 28, 2005, identified and made of record four registrations, all of which are owned by Opposer that are registrations of the names of geographic locations in which gambling is practiced or other entertainment is provided. Those Exhibits are:

- H. "TAHOE" Trademark, Reg. No. 1,189,273;
- I. "NEVADA" Trademark, Reg. No. 726,940;
- J. "CLUB RENO" Trademark, Reg. No. 401,715;
- K. "BROADWAY" Trademark, Reg. No. 172,312.

C. Opposer's Rebuttal Case

Joseph Robinette – USPC employee. Mr. Robinette testified regarding a promotional campaign that was not in any sense responsive or rebuttal to Applicant's evidence. As part of that testimony Mr. Robinette offered hearsay speculation about the content of a website of which Mr. Robinette had no knowledge other than to simply read what he saw there.

Kathryn Przywara – Dinsmore & Shohl LLP employee, counsel for Opposer USPC. Ms. Przywara testified regarding Internet websites and the purchase of a bracelet that were not in any

sense responsive or rebuttal to Applicant's evidence. Ms. Pryzwara offered hearsay speculation about materials of which she had no personal knowledge.

A Notice of Reliance was filed by Opposer during its rebuttal period that attached publications that were in no sense responsive or rebuttal to Applicant's evidence and Applicant objects to these materials as is noted herein. These documents are likewise of a type that cannot be made of record by notice of reliance.

IV. RECITATION OF THE FACTS

A. Opposer's Case In Chief

Las Vegas, Nevada is admittedly a geographic location. Opposer relies on the testimony of Mr. Kevin Bagger of the Las Vegas Convention and Visitors Authority (the "Authority"). Although the Authority has an advertising budget of 75 to 80 million dollars annually (Bagger at 10), it is the effort of the Authority to "market" Las Vegas as a tourism destination that provides entertainment "as a broader term in terms of general vacation entertainment, whether that's playing golf, whether that's going to fine dining, whether that's going to spas, whether that's spending time in the casinos." (Bagger at 7-8.) No testimony ties that annual budget to the term "vegas" or playing cards, or even to gambling as an activity. To the contrary, it was Mr. Bagger's testimony that the intent of the Authority's marketing effort was to establish Las Vegas as a broader entertainment destination, "not merely just a gaming destination." (Bagger at 9.) "Gaming" includes games that do not utilize cards, including roulette, sports book, slot machines, keno, craps and other dice games. (Bagger at 25.)

Mr. Bagger's testimony regarding the term "vegas" dealt with three items distributed by the Authority: a 2005 Visitors Guide of indeterminate scope of distribution (Exhibit 26; Bagger at 12 -13), a show guide of indeterminate date and scope of distribution (Exhibit 27; Bagger at

15), and a March 2005 area map and visitor's guide that had been distributed for "several" years (Exhibit 28; Bagger at 17-18, 24.) The extent of testimony on the annual distribution of the area map and visitor's guide was "thousands." (Bagger at 18.) Those three pieces include somewhere in their text a logo "Only Vegas," which had been a promotional program in use "three years or more." (Bagger at 13.) Opposer elicited other testimony regarding "Las Vegas," but no reference to "vegas" was made. (Bagger at 18-19.) Opposer's brief at page 8 references the phrase "What happens in Vegas stays in Vegas," but the cited testimony of Mr. Bagger (cited as Bagger at 17) makes no such reference and there is no competent evidence supporting this allegation.

In his testimony, Mr. Bagger testified that the word "vegas" is Spanish for "meadows" (Bagger at 24), and that he was aware of a Las Vegas, New Mexico (Bagger at 26.) Mr. Bagger candidly testified to the overall meaning and connotation of the term "VEGAS," and that meaning and connotation was not that of a geographic term or even linked to the name "Las Vegas." Rather, the meaning is:

The Vegas term connotes a variety of positive experiences that you noted. [Hip, in-the-know lifestyle, entertainment, high roller] It means a lot of things to a lot of other people. (Bagger at 26.)

Upon Opposer's leading redirect examination in which Opposer's counsel tried to get Mr. Bagger to say that "Only Vegas" refers to a "geographical location," Mr. Bagger instead testified:

The slogan "Only Vegas" is "a reference to the destination and all that it means to a potential visitor." (Bagger at 26.)

That answer meant "the entertainment and the, all the entertainment and the golf and all these other activities that [Mr. Bagger] earlier referred to":

Yeah. Everything that it means, the activities as well as the emotional experience that they associate with Las Vegas. (Bagger at 27.)

Opposer also relies on the testimony of Mr. Daniel Espenscheid, the casino sales manager of USPC. Mr. Espenscheid testified that there are about 350 casinos in the country, with about 100 casinos being located in Las Vegas. (Espenscheid at 26.) Mr. Espenscheid testified that Opposer sells casino playing cards to casinos all over the country, including Atlantic City casinos and other casinos that are not located in Las Vegas, Nevada. (Espenscheid at 46-48.) Mr. Espenscheid further testified that the casino cards that USPC makes are manufactured for casinos located anywhere in the country. (Espenscheid at 47.) Competitors' playing cards are likewise manufactured for use throughout the United States, such as in casinos in Atlantic City or Detroit. (Espenscheid at 48, 54-55.)

Mr. Espenscheid testified that *all* of the playing cards used in Las Vegas, Nevada are manufactured somewhere else. (Espenscheid at 45.) USPC does not manufacture playing cards anywhere in Nevada, and neither does the playing card company GPI, which has all its manufacturing facilities in Mexico, or Gemaco Playing Card Company, which Mr. Espenscheid believes manufactures its playing cards in Missouri. (Espenscheid at 45, 54 and 56.) Gemaco, a company that manufactures all of its cards outside of Las Vegas, is USPC's largest competitor and does not maintain a warehouse in Las Vegas. (Espenscheid at 55-56.) Kem cards and Stud King cards are manufactured overseas. (Espenscheid at 46.) Mr. Espenscheid further testified that USPC does not own any facilities in Las Vegas, Nevada (Espenscheid at 52.) Mr. Espenscheid works out of his home and is the only employee of Opposer in Las Vegas, Nevada (Espenscheid at 51).

With respect to used casino playing cards, the used decks either have the corners cut or are drilled, and then the tuck box is sealed to indicate that the deck of cards was used in play in a casino. (Espenscheid at 67.) A company separate from the casino reconstitutes the drilled decks,

with half of the decks being returned to the casino and half distributed throughout the United States for sale. (Espenscheid at 74, 76-77.) If someone is interested in buying a used deck of cards that has actually been used in a casino, they need to look for the seal that designates the cards as having been used in a casino. (Espenscheid at 66-67.) If a person is buying a brand new unopened deck, they know that it was not used in a casino. (Espenscheid at 67.) The used casino decks are canceled and then distributed to the casinos, and may be distributed to and sold in Atlantic City or other locations throughout the country. (Espenscheid at 71, 74.)

Mr. Espenscheid testified that the Arco Playing Card Company and USPC are one and the same company, since USPC bought the Arco Playing Card Company over twenty years ago. (Espenscheid at 51.) Mr. Espenscheid further testified that casinos are located at Reno, Nevada and Tahoe, Nevada. (Espenscheid at 49.) Although USPC itself owns registrations of TAHOE, NEVADA, and CLUB RENO for playing cards (Applicant's Notice of Reliance), Mr. Espenscheid testified that USPC does not sell and has not sold for many years Nevada brand playing cards, Tahoe brand playing cards, Club Reno brand playing cards or Broadway brand playing cards. (Espenscheid at 49-50.)

Mr. Espenscheid was asked a number of questions regarding websites of which he had no personal knowledge, most of which he had never visited. No competent evidence was elicited from Mr. Espenscheid on these subjects, which are the subject of Applicant's objections herein. No competent evidence was introduced to authenticate or otherwise support Opposer's Exhibits 2-6, and 10-19. Most troubling are Opposer's efforts to now surreptitiously introduce Opposer's Exhibit 11, notwithstanding the fact that Opposer's counsel herself stated on the record that Opposer's exhibit 11 was not going to be offered or attempted to be introduced and thus foreclosed cross examination on that document. (Espenscheid at 25, 61.)

Opposer also submitted a document purporting to be a Notice of Reliance. Applicant has now learned that Opposer did not, however, file the listed publications as is required under the rules and is objectionable for that as well as other reasons, such as the materials comprise press clippings not properly made of record by way of a notice of reliance. That notice purported to attach various publications, but almost uniformly these documents were indicated as bearing dates between May and July 2005, and do not reflect the use of any terms for an extensive period of time or for any particular circulation.

B. Applicant's Case in Chief

Applicant submitted the testimony of Mr. Karl T. Ondersma, an attorney with Van Dyke, Gardner, Linn & Burkhart, LLP. Mr. Ondersma testified that he visited both the GameLand Sports website and the actual GameLand Sports store which is located in Clinton Township, Michigan, near Detroit, Michigan. (Ondersma at 5-8.) Gameland Sports is the company referenced in the website shown in Opposer's Exhibit 10, and that website carries a map and other information identifying the location of GameLand Sports as being in Clinton Township in the vicinity of Detroit, Michigan. (Ondersma at 5-7; Applicant's Exhibit A.) Mr. Ondersma purchased playing cards from the GameLand Sports store in Clinton Township, Michigan. (Ondersma at 7-9; Applicant's Exhibits B and C.) The packaging bears labeling that indicate the cards were made in China and the cards bear the reference "Las Vegas". (Ondersma at 9; Applicant's Exhibit C.)

Mr. Ondersma did not testify that he, in fact, knew where the entities behind these websites were located. Mr. Ondersma testified, however, that he logged onto certain Internet websites and that the "gamesaloon.com" website shown in Opposer's Exhibit 12 lists a California address as a place of business for TheGameSaloon.com (Ondersma at 11; Applicant's Exhibit D),

and the "dollarDays.com" website of Opposer's Exhibit 12 listed an address for DollarDays as being in Scottsdale, Arizona (Ondersma at 11-12; Applicant's Exhibit E); the "touchofginger.com" website of Opposer's Exhibit 12 listed an address for Touch of Ginger being in Cambridge, England (Ondersma at 12-14; Applicant's Exhibit F) and the "pokerchipwholesale.com" website of Opposer's Exhibit 15 lists a California address as a place of business for PokerChip Wholesale. (Ondersma at 15; Applicant's Exhibit G.)

Applicant also submitted Applicant's Notice of Reliance on November 28, 2005. Applicant's Notice of Reliance makes of record four trademark registrations: TAHOE for playing cards (Applicant's Exhibit H); NEVADA for playing cards (Applicant's Exhibit I); CLUB RENO for playing cards (Applicant's Exhibit J); and BROADWAY for playing cards (Applicant's Exhibit K.) Opposer improperly denigrates these registrations with the argument that "third party registrations are not evidence that the marks were in use and that the relevant purchasing public is familiar with them." All of these registrations are owned by Opposer itself. Applicant has not cited those registrations as evidence of *third* party use.

The registrations owned by Opposer, show that Opposer has heretofore felt that it is perfectly appropriate to register for playing cards a trademark that may be argued to have an association with known gambling areas (e.g. Tahoe, Nevada and Reno), or with entertainment (e.g. Broadway). It is interesting to note that both the NEVADA Registration No. 726,940 and the BROADWAY Registration No. 172,312 which are owned by Opposer were recently renewed, yet Mrs. Espenscheid, who testified as being with USPC for thirty-five years (Espenscheid at 6), further testified that Opposer has not and does not sell NEVADA brand playing cards, has not and does not sell TAHOE brand playing cards, has not and does not sell

CLUB RENO brand playing cards, and has not and does not sell BROADWAY brand playing cards. (Espenscheid at 49-50.)

In Opposer's Trial Brief, Opposer notes that these cited registrations were all granted prior to the enactment of NAFTA, and thus were granted when there was a different standard governing primarily geographically misdescriptive marks. However, Applicant notes that the prior test was more strict and the Board more readily refused registration under the prior test, since trademarks filed under the prior test could eventually still be registered upon a showing of acquired distinctiveness under §2(f). Thus, if anything, Opposer's point supports the registrability of such marks under the present law.

C. Opposer's Rebuttal Testimony

Opposer also relies on the rebuttal testimony of Ms. Kathryn Przywara, an employee of Opposer's counsel Dinsmore & Shohl LLP, and Mr. Joseph Robinette, general counsel for Opposer, USPC. Ms. Przywara's and Mr. Robinette's testimony and their associated exhibits were beyond the scope of rebuttal, having no connection to the testimony by Mr. Ondersma, the Exhibits testified to by Mr. Ondersma, or to the Notice of Reliance filed by Applicant. That improper rebuttal was objected to by Mr. Linn throughout the testimony, and should be struck from the record as is subsequently requested herein. Mr. Ondersma provided testimony limited to the purchase of cards from a location in the vicinity of Detroit, and the presence on several websites of address information that identified locations other than Las Vegas. Opposer's rebuttal testimony did not rebut in any regard Applicant's evidence but instead was directed to matters that should have been offered, if at all, during Opposer's case in chief.

Ms. Przywara discussed several website printouts that were prepared in anticipation of her testimony, and was in no way competent to discuss the websites. For example, Ms. Przywara

testified that she had printed off pages from the GPI USA website (Przywara at 6-7), and later testified that she did not know where Gaming Partners International Corporation (GPI) manufactures its playing cards. (Przywara at 17.) Page 4 of the GPI website printout (Opposer's Przywara Exhibit 2) states, however, that the playing cards have been manufactured in Mexico for over 15 years, and that the cards are supplied to major casinos throughout the United States and around the world. As another example, Ms. Przywara testified that she purchased a charm bracelet (Opposer Przywara Exhibit 4) and keychain (Opposer Przywara Exhibit 5) through an Internet website, but that she did not know where those products were manufactured, warehoused, shipped from or the company that made or shipped the products. (Przywara at 9-10, 20-22.)

Mr. Robinette discussed a promotional campaign and the World Series of Poker, which were likewise wholly unrelated to any rebuttal of Applicant's evidence. Finally, Opposer filed a purported Rebuttal Notice of Reliance which was similarly improper as not rebuttal evidence.

V. ARGUMENT

A. Vegas is Not Geographically Deceptively Misdescriptive

A mark may be considered to be primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3) if "(1) the primary significance of the mark is a generally known geographic location, (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation was a material factor in the consumer's decision." *In re California Innovations, Inc.*, 329 F.3d 1334, 1341, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003). It is important to note that a mark or term "that has a popular significance apart from its geographical meaning is not, in most cases, 'primarily' geographical". *In re International Taste*,

Inc., 53 USPQ2d 1604, 1605 (TTAB 2000), citing 2 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 14:28 (4th Ed. 2005). Moreover, a term may not be primarily geographical if the term suggests or hints at some desirable aura of the product. 2 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 14:36 (4th Ed. 2005). A mark or term thus may indicate that a product is stylish or of high quality or has some other characteristic and may not indicate the geographic origin of the product. *In re Jacques Bernier, Inc.*, 894 F.2d 389, 391, 13 USPQ2d 1725, 1727 (Fed. Cir. 1990). In order for a mark to be "primarily geographically deceptively misdescriptive", the term itself must be associated with the product in such a way that the consuming public would be likely to assume that the geographic location was the place in which the product originated. *Jacques Bernier*, 13 USPQ2d at 1727.

The mark "Vegas" does not primarily denote a geographic meaning to the consuming public. To the contrary, the term "Vegas" is different than "Las Vegas" and, when used alone, connotes a different commercial impression and denotes the aura, life style, nightlife, entertainment and/or gambling activities, such as the lifestyle and activities that typically take place in upscale casinos, such as may be found in the city of Las Vegas, Nevada. Moreover, the term "Vegas" alone is different from the name Las Vegas, which is a city in Nevada. The primary significance of the mark VEGAS is not the geographic location, but rather the aura that Applicant desires to be associated with the playing cards sold under the mark VEGAS.

Moreover, the consuming public is not likely to believe that playing cards sold under the mark VEGAS originate from or are manufactured or produced in the city of Las Vegas, Nevada. Opposer has submitted no evidence to establish that *any* playing cards originate or are manufactured or produced in Las Vegas, Nevada, or that the public considers Las Vegas, Nevada to be a place where any playing cards are manufactured or produced or otherwise originate.

Further, Opposer has presented absolutely no evidence as to whether such an alleged misrepresentation of the origin of the goods would be a material factor in a consumer's decision as to whether or not to purchase playing cards. As set forth by the Court of Appeals for the Federal Circuit, to "ensure a showing of deceptiveness and misleading before imposing the penalty of non-registrability, the PTO may not deny registration without a showing that the goods-place association made by the consumer is material to the consumer's decision to purchase those goods." *California Innovations*, 66 USPQ2d at 1857. Since the adoption of NAFTA and amendment of the Lanham Act, this element is a mandatory predicate to any finding of primarily geographic misdescriptiveness. Consumers would not decide whether or not to purchase a deck of playing cards by considering the origin of the playing cards as a material factor in their purchase decision. As is subsequently discussed herein, Opposer has misquoted and misconstrued case authorities in an effort to skip over this mandatory element which Opposer admittedly made no attempt to prove.

B. VEGAS is Not Primarily Geographical.

The term "Vegas" is different than "Las Vegas" and, when used alone, connotes a different commercial impression and primarily refers to the gambling life style and/or entertainment aura, such as the gambling and entertainment at many upscale casinos, such as at some of the casinos found in the city of Las Vegas, Nevada. A mark or term "that has a popular significance apart from its geographical meaning is not, in most cases, 'primarily' geographical". *In re International Taste, Inc.*, 53 USPQ2d 1604, 1605 (TTAB 2000), citing 2 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 14:28 (4th Ed. 2005). The term may not be primarily geographical if the term suggests or hints at some desirable aura of the

product. 2 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 14:36 (4th Ed. 2005).

As stated by Mr. Bagger, "the Vegas term connotes a variety of positive experiences that you noted. It means a lot of things to a lot of other people" (Bagger at 26), and "everything that it means, the activities as well as the emotional experience that they associate with Las Vegas" (Bagger at 27). Mr. Bagger also indicated that the term "vegas" is Spanish for meadows (Bagger at 24) and that there is a city of Las Vegas, New Mexico (Bagger at 26). Thus, the term "Vegas" is not primarily geographical as referring primarily to the city of Las Vegas, Nevada.

Opposer cites a few of the many articles listed in their Notice of Reliance and provided in the four 3-ring binders submitted with their Notice of Filing to show the term "Vegas" is sometimes used to refer to the geographic location of Las Vegas, Nevada. Opposer also references the 641 articles that comprise the Opposer's Notice of Reliance as also supporting their argument that the term "Vegas" is primarily geographical. Rather than submitting competent evidence, Opposer's entire case consists essentially of sitting an unidentified lawyer in front of a computer to run searches and generate reams of paper that have little, if any, relevance to this proceeding.

A number of the articles cited by Opposer itself use the term "Vegas" as referring to something other than the geographic location of Las Vegas, Nevada.¹ For example, the Palm Beach Post of Florida, in an article (Opposer's Exhibit 237) describing an adult arcade "Slots of Fun" in Palm Beach County, states "[s]ome towns across the state have blocked the arcades from opening, saying they're too much like Vegas – style gambling machines." Likewise, the Akron

¹ Applicant objects to all of these articles for the reasons set out herein. Without waiving those objections, however, Applicant discusses these materials under protest, since in the event the Board admits these documents Applicant would be likewise entitled to rely on these documents to the extent they have some relevance. If the Notice of Reliance is struck, Applicant's discussion of those materials should be struck as well.

Beacon Journal of Ohio, in an article (Opposer's Exhibit 267) about the Soaring Eagle Casino of Mount Pleasant, Michigan, quotes a visitor of the casino as stating "[t]his place has a Vegas feel to it; we really like coming here." In an article (Opposer's Exhibit 301²) in Time Magazine, the new hotel Wynn Las Vegas is described as exuding "an anti-Vegas, almost Buddhist quietude." The hotel is further described as being "understated, in Vegas terms." Also, an article (Opposer's Exhibit 302) in The Times (London) refers to "the Vegas Spirit". All of these articles, along with several other articles and references in Opposer's exhibits, use the term "Vegas" in a manner that is not at all geographic. Thus, Opposer's exhibits themselves clearly demonstrate that the term "Vegas" has a primary significance as a reference to a life style or gaming/gambling activity or entertainment or aura, or otherwise referring to the aura and lifestyle associated with or typically found in the city of Las Vegas, Nevada, and in other similar entertainment/gambling attractions or locals, such as Reno, Nevada, Atlantic City, New Jersey, Detroit, Michigan and the like.

Opposer struggles to cite several *non-precedential* decisions that are expressly designated as "not citable as precedent of the TTAB", to show that certain terms were found to have a primary geographical significance. However, when a term has an aura of a particular status or prestige or lifestyle, the term is not primarily geographical. 2 J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 14:36 (4th Ed. 2005). Examples of terms that exude or suggest such an aura, and thus were found not to be primarily geographical, are discussed in various *precedential* cases of the Trademark Trial and Appeal Board. For example, see *In re International Taste Inc.*, 53 USPQ2d 1604 (TTAB 2000), where "Hollywood" was admittedly a geographic location, but the term HOLLYWOOD was found to have a prominent, significant

² Applicant notes that the tab numbering in Opposer's bound Exhibits is incorrect for much of the Exhibits, so that it is difficult to track down the correct Exhibit reference in the Notice of Reliance.

meaning referring to the entertainment industry in general, and not to the section of Los Angeles, California, so that the term HOLLYWOOD did not have its primary significance as that of a geographic location in California. *International Taste*, 53 USPQ2d at 1605. Also, see *In re Cotter and Company*, 228 USPQ 202 (TTAB 1985) (West Point is a town or city in New York, but the primary significance of WEST POINT is not the town or city in New York, but rather the name of the United States Military Academy); *Phillip Morris, Inc. v. Reemtsma Cigarettenfabriken GMBH*, 14 USPQ2d 1487 (TTAB 1990) (although "Park Avenue" is a geographic designation, the term PARK AVENUE is used to suggest a sophisticated aura often linked to a street in New York City associated with fashionable living and high society and is thus not geographically deceptively misdescriptive).

This is precisely the case at hand. The mark VEGAS refers to the aura and lifestyle/entertainment/gaming that may be found in the city of Las Vegas, Nevada, but does not refer to the actual geographic location of that city in Nevada. In the HOLLYWOOD case, the Board found that the star design feature that formed part of the applicant's mark increased the commercial impression of the term as connoting the entertainment industry and decreased the connection with the town of Hollywood, California. *In re International Taste Inc.*, 53 USPQ2d at 1605. Again, this is on point with the case at hand, since the subject mark is VEGAS, not Las Vegas, and refers to the aura of entertainment/lifestyle/gaming.

Opposer also states that the Las Vegas Convention and Visitors Authority advertised and uses the term "Vegas" alone to identify the city. This is not the case. Mr. Bagger testified that the term is used for a different reason:

Q. Hold on a minute. I'll see if I've got any more here. When the convention bureau utilizes the "Only Vegas" promotional campaign, do they use that because the Vegas term connotes or

suggests some type of hip, in-the-know lifestyle, entertainment, high roller type of suggestion.

A. The Vegas term connotes a variety of positive experiences that you noted. It means a lot of things to a lot of other people. Yes, we do use the term Vegas as in "Only Vegas" because we believe there is a lot of value in that term in our advertising. (Bagger at 26.)

Thus, not only does the evidence provided by Opposer fail to demonstrate that the primary significance of the term "Vegas" is that of a geographical location, but Opposer's evidence itself actually demonstrates that the term "Vegas" has a primary significance of something other than the geographical location of the city of Las Vegas, Nevada, namely, the aura of the entertainment/lifestyle/gaming. Thus, the mark VEGAS does not have its primary significance as the geographic location of the city of Las Vegas, Nevada.

C. Consumers are Not Likely to Believe that the City of Las Vegas, Nevada is the Origin of Applicant's Playing Cards.

The city of Las Vegas, Nevada, is not a place of origin of playing cards and is not known as the origin of playing cards. There is no evidence of record that there is any entity in the city of Las Vegas, Nevada that manufactures or produces playing cards in Las Vegas, Nevada. In fact, there is substantial evidence of record that no entity manufactures or produces playing cards in the city of Las Vegas, Nevada, and that most, if not all, playing cards are manufactured in either Mexico, China, Taiwan, Japan, Missouri or Ohio (Espenscheid at 44, 46, 54 and 56). Further, Opposer itself, the largest manufacturer of playing cards in the world (Notice of Opposition, ¶ 2), not only does not manufacture or produce any playing cards in Las Vegas, Nevada (Espenscheid at 45), but does not own any facility in Las Vegas, Nevada (Espenscheid at 52), and only employs a single person, Mr. Espenscheid, in Las Vegas, Nevada who works out of

his home (Espenscheid at 51). Thus, consumers are not likely to believe that the city of Las Vegas, Nevada is the origin of Applicant's playing cards or any other playing cards.

Opposer cites *In re Hiromichi Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) as supporting its argument that playing cards originate in Las Vegas, Nevada. However, and as stated in Opposer's Brief, the record in the *Wada* case showed that various leather goods and hand bag *manufacturers* were located in New York. *Wada*, 52 USPQ2d at 1541. Opposer also cites others of the press clippings referenced in its Notice of Reliance to indicate that certain casino specific types of playing cards are used in casinos in the city of Las Vegas, Nevada. Again, however, none of the references cited by Opposer demonstrates or even suggests that any of the playing cards discussed in those articles actually originated in the city of Las Vegas, Nevada.

Opposer also cites *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) and states that there the court found that consumers may be deceived "even though the goods were only **related to** the types of goods manufactured and sold in Venice, Italy." (Opposer's Brief at 18, emphasis added.) Opposer thus relies on the *relationship* of goods manufactured, yet has provided no evidence of manufacturing or producing playing cards in Las Vegas, Nevada, or for that matter, manufacturing or producing any goods related to playing cards in Las Vegas, Nevada.

Opposer cites still more *non-precedential* cases in an attempt to support its position, and even compares the "presence of" a card manufacturer (Gaming Partners International Corp.- "GPI") in Las Vegas, Nevada as evidence of manufacturing in Las Vegas, Nevada. However, the record clearly shows that GPI manufactures its playing cards in Mexico (Espenscheid at 45; see Opposer's Przywara Exhibit 2), and Opposer has provided no evidence that any other playing

cards are manufactured or otherwise produced or originated in Las Vegas, Nevada. In fact, Mr. Espenscheid testified that there are no playing cards companies that manufacture playing cards in Las Vegas, Nevada. (Espenscheid at 45.) Opposer also argues that "there is evidence in the record that the United States Playing Card Company maintains a warehouse in Las Vegas for its casino business." However, Mr. Espenscheid specifically testified that the USPC does not own any facilities in Las Vegas (Espenscheid at 52), and that Opposer manufactures its playing cards in Ohio and Spain (Espenscheid at 44-45).

Thus, Opposer has provided no evidence that playing cards are manufactured or produced or otherwise originated in Las Vegas, Nevada. Further, no evidence of record indicates consumers believe playing cards are manufactured or originate from Las Vegas, Nevada. Whether or not the evidence may reflect a belief that gambling takes place in Las Vegas, Nevada, does not qualify as proof that consumers believe playing cards originate from there. In the cases cited by Opposer, the decisions were based on a finding that the products in question were in fact manufactured or produced in the geographic location. Mere use of certain casino specific playing cards does not constitute an origination of the playing cards in Las Vegas, Nevada. Therefore, the consuming public is not likely to believe that Las Vegas, Nevada is the origin of Applicant's playing cards.

With respect to the market for used casino cards, these cards do not originate in Las Vegas, Nevada. Moreover, Opposer has not provided any evidence that the canceling of these cards is even performed in Las Vegas, Nevada. Based on the testimony of Mr. Espenscheid, the canceling of these cards appears to be performed at a centralized location, since the canceled cards are distributed to various locations throughout the country, and to different casino locations, such as Atlantic City. (Espenscheid at 71.) Also, the canceled casino cards are sold

via website companies, many of which are not located in Nevada. (Ondersma at 11 and 15.)

There is no evidence as to the volume of this activity in the realm of playing cards, or that it represents anything more than a *de minimis* event.

D. The Origin of the Playing Cards Would Not Materially Affect the Public's Decision to Purchase the Goods.

In *In re California Innovations, Inc.*, 66 USPQ2d 1853, 1857 (Fed. Cir. 2003), the Court of Appeals for the Federal Circuit established a dramatic change in the law with regard to establishing primarily geographically misdescriptive marks:

Therefore, the relatively easy burden of showing a naked goods – place association without proof that the association is material to the consumer's decision is no longer justified, because marks rejected under §1052(e)(3) can no longer obtain registration through acquired distinctiveness under §1052(f). To ensure a showing of deceptiveness and misleading before imposing the penalty of non-registrability, the PTO may not deny registration without a showing that the goods – place association made by the consumer is material to the consumer's decision to purchase those goods. This addition of a materiality inquiry equates this test with the elevated standard applied under §1052(a).

Opposer itself acknowledged this change in the rule, and expressly cited this heightened mandatory element that was prompted by NAFTA and amendment to the Lanham Act.

(Opposer's brief page 5.) However, Opposer subsequently argues in its brief that recent case law authorizes the Board to *assume* that the geographical misrepresentation plays a material part in the decision to buy VEGAS playing cards when the goods place association is heightened. For that argument Opposer doctors a quote from *In re Consolidated Specialty Restaurants*, 71 USPQ2d 1921 (TTAB 2004), which it represents as holding that "an inference of materiality arises where there is a showing of a 'heightened association' between the [goods] and the geographic place."

(Opposer's brief page 21.) That is not, however, what the Board ruled. *In re Consolidated Specialty Restaurants*, 71 USPQ2d 1921 (TTAB 2004) involved an application for COLORADO

STEAK HOUSE for restaurant services. In *Consolidated Specialty* the Board distinguished between cases in which a mark is applied to services as opposed to a mark applied to goods. In *Consolidated Specialty* the Board cited the *California Innovations* decision and the heightened burden on the third element of materiality in the decision to purchase goods. The Board continued and discussed the subsequent decision of *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 67 USPQ2d 1539 (Fed. Cir. 2003), which distinguished a goods-place test from a services-place test. In *Consolidated Specialty* the Board therefore allowed an inference to be drawn in that services case, and the Board actually stated in the quote altered by Opposer "an inference of materiality arises where there is a showing of a 'heightened association' between the *services* and the geographic place." *In re Consolidated Specialties Restaurants, Inc.*, 71 USPQ2d at 1928 (emphasis added). Opposer's alteration improperly negates the express ruling of *California Innovations, supra*.

Opposer also cites several other cases to support its argument. *In re Hiromichi Wada*, 52 USPQ2d 1539, *In re House of Windsor, Inc.*, 221 USPQ 53 (TTAB 1983), *In re Loew's Theatres*, 226 USPQ 865 (Fed. Cir. 1985), *superseded by statute*. However, all of these cases predate the *California Innovations* decision by several years, and thus were implicitly overruled by NAFTA, the amendment to the Lanham Act and *California Innovations*, and are no longer relevant to the third prong materiality test for primarily geographically misdescriptiveness.

Even if it were still permissible to employ a presumption of materiality to the purchase decision from a "heightened association" between goods and a geographic place, Opposer has made no such showing of a "heightened association." There is no competent evidence that consumers associate playing cards as originating with Las Vegas, as opposed to nightlife, etc., let

alone an association with the term "Vegas." In no event has there been a showing that such an association is "heightened."

With respect to Opposer's reliance on the "robust market for canceled casino cards", such cards again do not originate in Las Vegas, Nevada, nor has Opposer provided any evidence that even the canceling of the cards is performed in Las Vegas, Nevada, or that the canceled cards are distributed from Las Vegas, Nevada. Also, Opposer acknowledges that such cards are not purchased as "playing cards", but rather are purchased "as a souvenir or as a novelty item." (Opposer's Brief at 9.) The "cache" of such cancelled card decks is not that the cards originate from Las Vegas, Nevada, but that the cards were used in a casino. This is reflected by the fact that the cards are sold throughout the country regardless of the actual location of the casino. Such canceled casino cards are marked, either by drilling a hole through the deck of cards or clipping a corner of the cards, and then are repackaged and marked as being used with a seal on the tuck box. (Espenscheid at 66-67.) Thus, when someone is interested in purchasing a used deck of casino cards that have actually been used in a casino, they look for the seal that designates the cards as having been used in a casino. (Espenscheid at 67.) However, if the deck of playing cards was not used in a casino, the tuck box would not be opened and would not have the seal on it. Moreover, there is no evidence of the magnitude of this activity or whether it represents anything more than a *de minimis* event.

Opposer makes playing cards for several casinos. The cards that they make for casinos, the Bee brand, are sold to casinos all over the country. (Espenscheid at 47.) The cards are thus manufactured in Ohio or Spain and sent to particular casinos anywhere in the country where the particular casinos are located at, such as in Atlantic City, New Jersey; Las Vegas, Nevada; Reno, Nevada; Tahoe, Nevada, and other cities throughout the United States. (Espenscheid at 47.)

Therefore, the casino cards manufactured by Opposer and used in casinos are the same cards for casinos in Las Vegas and Atlantic City and anywhere else where there are casinos. (Espenscheid at 47-48.) The used casino cards are sold with the seal on the tuck box, and, in most cases, without any indication as to which city the casino at which the cards were used is located. (See Espenscheid Exhibits 21-26.)

Applicant's playing cards sold under the mark VEGAS are sold in a tuck box without any seal or any indication that the cards are used or have been used in a casino. (See Espenscheid Exhibits 8 and 9.) The third prong of the test for a primarily geographically misdescriptive mark requires a showing of deceptiveness and misleading. *In re California Innovations, Inc.*, 66 USPQ2d at 1857. Thus, Opposer must make the more difficult showing of public deception. *Id.* There is absolutely nothing misleading or deceiving about the use of the mark VEGAS in connection with playing cards, and Opposer has not provided any evidence of such. When a consumer looks at a box of VEGAS playing cards, not only will the place of origin of those cards not be a material factor in their decision on whether or not to purchase the playing cards, but there will be no deception by the playing cards to lead the consumer to believe that the tuck box contains used casino cards as used in a casino in Las Vegas, Nevada, or for that matter, in any other casino located in any other city in the United States or throughout the world.

E. Opposer Waived Any Argument For Deceptiveness Under Section 2(a) and Geographic Descriptiveness Under Section 2(e)

Although Opposer pled in its Notice of Opposition deceptiveness under § 2(a) and primarily geographic descriptiveness under § 2(e), Opposer did not submit a case on either of those bases. Having failed to make such arguments in its opening brief, Opposer cannot now come back in reply and raise new arguments as to which Applicant has had no opportunity to respond.

VI. APPLICANT'S OBJECTIONS TO OPPOSER'S EVIDENCE

A. Opposer's Exhibits 2 – 6, 10, 12 – 19 and Related Testimony are Inadmissible Hearsay.

Mr. Espenscheid was not competent to testify about the purported internet printouts and documents that comprise Opposer's Exhibits 2 – 6, 10, 12 – 19, and those documents and Mr. Espenscheid's reading of words printed on those pieces of paper are inadmissible hearsay. Regarding the following exhibits, Mr. Espenscheid testified that he was not involved in printing out or creating the exhibit, did not know when or who generated and printed the materials, when the content was placed on the purported website, and had not even been to these websites: Opposer's Exhibit 2 (Espenscheid at 52 – 53), Opposer's Exhibit 3 (Espenscheid at 53 – 54), Opposer's Exhibit 4 (Espenscheid at 54), Opposer's Exhibit 5 (Espenscheid at 56 – 57), Opposer's Exhibit 10 (Espenscheid at 59 – 61), Opposer's Exhibit 12 (Espenscheid at 62 – 63), Opposer's Exhibit 13 (Espenscheid at 63 – 64), Opposer's Exhibit 14 (Espenscheid at 64 – 65), Opposer's Exhibit 15 (Espenscheid at 65 – 66), Opposer's Exhibit 16 (Espenscheid at 68 – 69), Opposer's Exhibit 17 (Espenscheid at 69). Mr. Espenscheid likewise testified that he did not print out or was involved in the generation of the materials of Opposer's Exhibit 6, did not know who or when the materials were printed, did not know when the content was added to the purported website, and although he had visited that website at some point in time he did not see these particular materials that make up Exhibit 6 on the website at that time (Espenscheid at 75 – 76). Espenscheid testified that his company had no involvement with the publications reflected in Exhibits 18 and 19 (Espenscheid at 69 – 70) and there was no evidence establishing the volume or zone of distribution of these materials. All these materials and testimony are hearsay and inadmissible. Fed.R.Evid. 802.

B. Opposer's Exhibit 11 was Withdrawn by Opposer and is Hearsay

Opposer's counsel stated on the record that she did not use Opposer's Exhibit 11 and that Opposer did not intend to introduce Opposer Exhibit 11 or otherwise offer Exhibit 11 into evidence. (Espenscheid at 25, 61). No testimony or other authentication of Opposer's Exhibit 11 was ever undertaken. Opposer's Exhibit 11 is inadmissible hearsay. Fed.R.Evid. at 802. Moreover, it is fundamentally unfair for Opposer's counsel to represent that this exhibit was being withdrawn in order to preclude any cross examination regarding that document and then Opposer attempt to introduce that exhibit into the record.

C. Mr. Espenscheid's Testimony was Inadmissible Hearsay, Incompetent, and Lacked Foundation

Mr. Espenscheid offered unsubstantiated hearsay testimony regarding all the above exhibits and their content. That hearsay testimony is inadmissible. Fed.R.Evid 802. Moreover, Mr. Espenscheid was not competent to testify with regard to these materials of which he had no personal knowledge or involvement. Fed.R.Evid 701 and 702. That testimony should be stricken which appears at Espenscheid deposition pages 8 – 10, 13 – 20, 22, 24 - 26, 27 – 32. Additionally, no foundation was established for Mr. Espenscheid's testimony as appears at pages 20 – 22 which is likewise inadmissible due to lack of competence and lack of foundation.

D. The Espenscheid Testimony was Not Promptly Filed.

37 C.F.R. § 2.123 (f)(2) requires that the officer or the party taking a testimonial deposition, or its attorney or other authorized representative, shall promptly forward the testimony and exhibits to the Trademark Trial and Appeal Board. Opposer did not promptly file the Espenscheid testimonial deposition or exhibits, which therefore should be stricken.

E. Mr. Bagger's Testimony was Inadmissible Due to Leading Questions.

During the testimony of Kevin Bagger by Opposer, the party noticing that deposition, Opposer's counsel asked improper leading questions which appear at Bagger page 9, lines 9 – 25 and page 26 lines 18 – 24. Leading questions unfairly suggest the answer the witness is prompted to give, and a question soliciting a "yes-no" answer is the hallmark of a leading question. Opposer was not conducting discovery, but rather was undertaking trial testimony, and leading direct interrogation is improper. Applicant's counsel entered objections at the time of that improper questioning. That testimony should be stricken as inadmissible.

F. The Bagger Testimony was Not Promptly Filed.

37 C.F.R. § 2.123 (f)(2) requires that the officer or the party taking a testimonial deposition, or its attorney or other authorized representative, shall promptly forward the testimony and exhibits to the Trademark Trial and Appeal Board. Opposer did not promptly file the Bagger testimonial deposition or exhibits, which therefore should be stricken.

G. Opposer's Purported Notice of Reliance Mailed July 29, 2005 Did Not Include Copies of the Purported Publications, is Not in Conformity with Regulations, References Materials Not Admissible by Way of Notice of Reliance, and was Untimely.

A notice of reliance is required to be accompanied by a copy of the printed publication intended to be made of record. 37 C.F.R. § 2.122 (e). Further, a notice of reliance must be filed during the testimony period of the party that files the notice. 37 C.F.R. § 2.122(e). Applicant has now learned that Opposer did not submit copies of publications with its notice of reliance, which was purportedly filed on July 29, 2005. Attempts by Opposer to now submit copies of the publications with its brief long after close of Opposer's testimony period is untimely and not in compliance with regulations and should be stricken. *Questor Corp. v. Dan Robbins & Associates, Inc.*, 199 USPQ 358, 361 n3 (TTAB 1978), *aff'd*, 202 USPQ 100 (CCPA 1979); *Miss*

Nude Florida, Inc. v. Drost, 193 USPQ 729, 731 (TTAB 1976); *pet. to comm'r denied*, 198 USPQ 485 (COMM'R 1977). It will be noted that the extended period for Opposer's trial period closed on July 31, 2005. The document purporting to be Opposer's Notice of Reliance but which does not include copies of the publications bears a Certificate of First Class Mailing indicating that it was placed in the mail on Friday, July 29, 2005, one business day prior to the close of Opposer's trial period on Monday, August 1, 2005. This posting was far shorter a time prior to close of Opposer's testimony period than the five day mailing period provided under the rules (37 C.F.R. § 2.119(c)), and Applicant's counsel received that document after the close of Opposer's trial period. Opposer did not submit its evidence during the trial. Only after the record was closed and trial concluded did Opposer submit these materials during the post-trial briefing period. These materials are not of record and must be struck.

Applicant further objects to Opposer's purported Notice of Reliance and materials attached thereto as being improper documents for submission by way a Notice of Reliance. Virtually all of the documents recently submitted for the first time with Opposer's brief that were listed on the purported July 29th Notice of Reliance are some form of press clippings, and apparently a printout of some electronic form of press clippings and other internet materials. Only the first listed item would appear not to be of this type. These types of materials may not be placed in evidence by Notice of Reliance and therefore must be stricken. *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 – 04 (TTAB 1998).

Moreover, the copies of the purported publications provided to Applicant by Opposer with Opposer's trial brief would be in violation of 37 C.F.R. § 2.126(a)(1), (3) and (4), if the copies provided to the TTAB are in the same tabbed fashion, bound in three ring binders and in the incorrect font size. Further, these tabs are not correctly numbered to the Exhibits.

H. Opposer's Przywara's Exhibits 2 – 8 and Testimony of Kathryn Przywara are Improper Rebuttal, Hearsay, and Lack Foundation.

During Applicant's testimony period, Applicant took the testimony of Karl Ondersma who testified that he purchased playing cards (Applicant's Exhibits B – C) at Gameland Sports in Clinton Township near Detroit, Michigan. Mr. Ondersma also testified as to looking at the following websites to determine whether any address information was included on those sites: gamelandsports.com (Applicant's Exhibit A), thegamesaloon.com (Applicant's Exhibit D), dollardays.com (Applicant's Exhibit E), touchofginger.com (Applicant's Exhibit F), and pokerchipwholesale.com (Applicant's Exhibit G). Applicant also submitted a Notice of Reliance that included four trademark registrations of the marks TAHOE (Applicant's Exhibit H), NEVADA (Applicant's Exhibit I), CLUB RENO (Applicant's Exhibit J), and BROADWAY (Applicant's Exhibit K).

During the rebuttal period, Opposer introduced the testimony of Katherine Przywara, and exhibits, none of which relates to or rebuts the websites referenced by Mr. Ondersma, the store visited by Mr. Ondersma or cards there purchased, the testimony of Mr. Ondersma, or the four trademark registrations made of record with the Notice of Reliance. All of this testimony of Ms. Przywara and associated exhibits are improper rebuttal that should have been made of record, if at all, during Opposer's case in chief. Opposer argued that the reason for Opposer's rebuttal evidence was "to rebut Applicant's argument that the term VEGAS is not primarily geographic and to rebut Applicant's argument that playing cards are not associated with Las Vegas because playing cards may be manufactured and purchased in other geographic locations." Whether or not VEGAS is primarily geographic and whether or not playing cards are associated with Las Vegas are affirmative elements of Opposer's case in chief. All of Ms. Przywara's testimony and exhibits should be stricken. *DEG Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d

1910, 1911 n3 (TTAB 2000); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1508 (TTAB 2000); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ 2d 1600, 1604 (TTAB 1999); *Ritz Hotel Ltd. v. Ritz Closets Corp.*, 17 USPQ2d 1466, 1468 – 69 (TTAB 1990); *Societe Civile des Domaines Dourthe Freres v. S.A. Consortium Vinicole de Beorrdeaux etde la Gironde*, 6 USPQ2d 1205, 1207 n7 (TTAB 1988); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n5 (TTAB 1977). It would be fundamentally unfair to permit Opposer to introduce evidence during its rebuttal testimony that should have been introduced during its case in chief and thus affectively preclude Applicant from rebutting that evidence should Applicant have chosen to do so.

Additionally, all the Przywara Exhibits and Ms. Przywara's testimony relating thereto is hearsay and Ms. Przywara was incompetent to testify regarding those materials. Regarding the websites reflected in the following Przywara Exhibits, Ms. Przywara had never been to any physical location or facility of that entity, did not know where the entity that hosted the website was located, did not know where any of the materials shown in the website were manufactured, warehoused or shipped from or even what company manufactured the products shown therein: Przywara Exhibit 3 (Przywara at 18 – 19), Przywara Exhibit 6 (Przywara at 22 – 25), Przywara Exhibit 7 (Przywara at 25 – 27), Przywara Exhibit 8 (Przywara at 27 – 29). Regarding the bracelet of Przywara Exhibit 4 and the keychain of Przywara Exhibit 5, Ms. Przywara did not know where in the United States the products were manufactured, where they were shipped from or warehoused prior to being shipped, what company manufactured the product or what company shipped the product (Przywara at 19 – 22). These exhibits and testimony should be stricken.

I. Joseph Robinette Testimony and Exhibits are Improper Rebuttal and Hearsay

As previously noted during Applicant's testimony period, Applicant took the testimony of Karl Ondersma who testified that he purchased playing cards (current Applicant's B – C) at Gameland Sports in Clinton Township near Detroit, Michigan. Mr. Ondersma also testified as to looking at the following websites to determine whether any address information was included on those sites: gamelandsports.com (Applicant's Exhibit A), thegamesaloon.com (Applicant's Exhibit D), dollardays.com (Applicant's Exhibit E), touchofginger.com (Applicant's Exhibit F), and pokerchipwholesale.com (Applicant's Exhibit G). Applicant also submitted a Notice of Reliance that included four trademark registrations of the marks TAHOE (Applicant's Exhibit H), NEVADA (Applicant's Exhibit I), CLUB RENO (Applicant's Exhibit J), and BROADWAY (Applicant's Exhibit K).

During the rebuttal period, Opposer introduced the testimony of Joseph Robinette, and exhibits, none of which relates to or rebuts the websites referenced by Mr. Ondersma, the store visited by Mr. Ondersma or cards there purchased, the testimony of Mr. Ondersma, or the four trademark registrations made of record with the Notice of Reliance. All of this testimony of Mr. Robinette and associated exhibits are improper rebuttal that should have been made of record, if at all, during Opposer's case in chief. Opposer argued that the reason for Opposer's rebuttal evidence was "to rebut Applicant's argument that the term VEGAS is not primarily geographic and to rebut Applicant's argument that playing cards are not associated with Las Vegas because playing cards may be manufactured and purchased in other geographic locations." Whether or not VEGAS is primarily geographic and whether or not playing cards are associated with Las Vegas are affirmative elements of Opposer's case in chief. All of Mr. Robinette's testimony and

exhibits should be stricken. *DEG Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1911 n3 (TTAB 2000); *Hard Rock Café International (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1508 (TTAB 2000); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ 2d 1600, 1604 (TTAB 1999); *Ritz Hotel Ltd. v. Ritz Closets Corp.*, 17 USPQ2d 1466, 1468 – 69 (TTAB 1990); *Societe Civile des Domaines Dourthe Freres v. S.A. Consortium Vinicole de Beorrdeaux etde la Gironde*, 6 USPQ2d 1205, 1207 n7 (TTAB 1988); *General Electric Co. v. Graham Magnetics Inc.*, 197 USPQ 690, 692 n5 (TTAB 1977). It would be fundamentally unfair to permit Opposer to introduce evidence during its rebuttal testimony that should have been introduced during its case in chief and thus affectively preclude Applicant from rebutting that evidence should Applicant have chosen to do so.

The promotional materials of Opposer's Robinette Exhibit 2 and website of Opposer's Robinette Exhibit 3 are wholly unrelated to and do not rebut the websites referenced by Mr. Ondersma, the store visited or cards purchased by Mr. Ondersma, or the trademark registrations with Applicant's Notice of Reliance. Additionally, Opposer's Robinette Exhibit 3 and Mr. Robinette's testimony regarding that exhibit is improper hearsay and incompetent. Mr. Robinette did not have involvement in creation of the website information contained in Exhibit 3, does not know where the company identified in Exhibit 3 in fact has stores or facilities or any personal information relating to the content of that website. (Robinette at 12 – 14.)

J. Opposer's January 12th Notice of Reliance and Attachments are Improper Rebuttal, and are Materials Not Properly Submitted by a Notice of Reliance.

Opposer submitted a Notice of Reliance submitted in rebuttal dated January 12, 2006. That Notice of Reliance and attachments is an improper rebuttal. All of the materials submitted with that January 12th Notice of Reliance are characterized by Opposer as "the materials above are relevant to demonstrate that the term "vegas" is used primarily to refer to the city of Las

Vegas, Nevada, a well-known geographical location." "These articles are also relevant to illustrate a connection between playing cards and the city of Las Vegas, NV." These are issues necessary for Opposer to have established during its case in chief. None of these materials relate to or rebut the websites referenced by Mr. Ondersma, the store visited or the cards purchased by Mr. Ondersma, or the four trademark registrations filed with Applicant's Notice of Reliance. It is fundamentally unfair for Opposer to submit materials during its rebuttal period that should have been submitted, if at all, during Opposer's case in chief and thus preclude Applicant from responding to that evidence should Applicant have chosen to do so.

Applicant further objects to Opposer's purported Notice of Reliance and materials attached thereto as being improper documents for submission by way a Notice of Reliance. Virtually all of the documents recently submitted with Opposer's brief that were listed on the Notice of Reliance are some form of press clippings, and apparently a printout of some electronic form of press clippings. These types of materials may not be placed in evidence by Notice of Reliance and therefore must be stricken. *Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 – 04 (TTAB 1998).

VII. CONCLUSION

The mark VEGAS for playing cards is not primarily geographically deceptively misdescriptive as used in connection with the associated goods, namely, playing cards. Opposer has failed to carry its burden, and has not even attempted to prove all of the elements of that determination. The evidence establishes directly to the contrary. The primary significance of the mark VEGAS is the desired aura of that term and not the specific city of Las Vegas, Nevada. The consuming public is not likely to believe that the playing cards associated with the mark VEGAS originate in Las Vegas, Nevada. Moreover, the actual city or state or country of origin

of the playing cards would not be a material factor in a consumer's decision as to whether or not to purchase playing cards under the mark VEGAS. Accordingly, the Opposition should be denied.

Respectfully submitted,

HARBRO, LLC

Date: April 11, 2006



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