

ESTTA Tracking number: **ESTTA340859**

Filing date: **04/05/2010**

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	Shuffle Master, Inc.
Granted to Date of previous extension	04/03/2010
Address	1106 Palms Airport Drive Las Vegas, NV 89119-3730 UNITED STATES
Attorney information	Robert L. Sherman/Bradford E. Young Paul, Hastings, Janofsky & Walker 75 East 55th Street New York, NY 10022 UNITED STATES rls@paulhastings.com Phone:212-318-6037

### Applicant Information

Application No	77711644	Publication date	02/02/2010
Opposition Filing Date	04/05/2010	Opposition Period Ends	04/03/2010
International Registration No.	NONE	International Registration Date	NONE
Applicants	Webb, Derek John 16 Park Lane Littleover, Derby, DE236FX UNITED KINGDOM  O'Donnell, Hannah Sarah 16 Park Lane Littleover, Derby, DE236FX UNITED KINGDOM		

### Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: GAMING MACHINES; GAMBLING MACHINES
Class 016. All goods and services in the class are opposed, namely: PRINTED MATTER, NAMELY, TRAINING MANUALS AND PRINTED TRAINING MATERIALS IN THE FIELD OF PLAYING AND OPERATING CASINO GAMES AND GAMBLING GAMES; PROCEDURE MANUALS FOR PLAYING CASINO GAMES AND GAMBLING GAMES; PLAYER ADVICE CARDS FOR PLAYING CASINO GAMES AND GAMBLING GAMES
Class 028.

All goods and services in the class are opposed, namely: CASINO CARD GAMES; GAMBLING GAMES; EQUIPMENT FOR USE IN PLAYING CASINO GAMES AND GAMBLING GAMES, NAMELY, LAYOUT CLOTHS AND DEALER BUTTONS; CASINO CARD GAMES

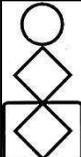
Class 041.

All goods and services in the class are opposed, namely: ENTERTAINMENT SERVICES IN THE NATURE OF CASINO GAMES; RENTAL AND LEASING OF CASINO GAMES, CASINO GAME APPARATUS, GAMBLING GAMES, GAMBLING GAME APPARATUS, GAMING MACHINES, CASINO MACHINES AND GAMBLING MACHINES; PROVIDING ON-LINE CASINO GAMES AND GAMES OF CHANCE; PROVIDING ON-LINE CASINO-TYPE COMPUTER GAMES; TRAINING IN THE FIELD OF CASINO GAMES, GAMBLING, ON-LINE GAMBLING, OPERATION OF GAMING ROOMS, USE AND OPERATION OF GAMING MACHINES AND GAMBLING MACHINES

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	lack of a bona fide intention to use the Subject Mark under circumstances showing good faith under 15 U.S.C. Â§ 1126(e)

### Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	casino and gambling games; entertainment services, namely, providing games of chance in gambling and gaming establishments		

Attachments	COIN SPOT mark.JPG Notice of Opposition.pdf ( 13 pages )(540656 bytes )
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### **Certificate of Service**

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

Signature	/bey/
Name	Bradford E. Young
Date	04/05/2010

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

In the Matter of Application Serial No. 77/711,644

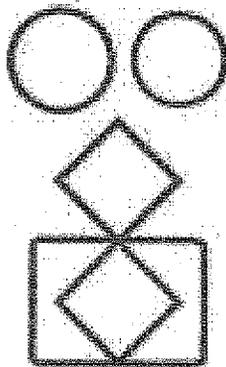
Published in the Official Gazette on February 2, 2010

Mark: Miscellaneous design mark consisting of circles, diamonds and a rectangle

_____	)	
Shuffle Master, Inc.,	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
John Derek Webb and Hannah Sarah	)	
O'Donnell,	)	Opposition No. _____
	)	
Applicants.	)	
_____	)	

**NOTICE OF OPPOSITION**

Shuffle Master, Inc. (hereafter, "Shuffle Master" or "Opposer") believes it will be damaged by registration of the mark:



(hereafter, "Subject Mark") by Applicants John Derek Webb and Hannah Sarah O'Donnell (together, "Applicants") for "gaming machines, gambling machines" in International Class 9, "printed matter, namely, training manuals and printed training materials in the field of playing and operating casino games and gambling games; procedure manuals for playing casino games

and gambling games; player advice cards for playing casino games and gambling games” in International Class 16, “casino card games; gambling games; equipment for use in playing casino games and gambling games, namely, layout cloths and dealer buttons; casino card games” in International Class 28 and “entertainment services in the nature of casino games; rental and leasing of casino games, casino game apparatus, gambling games, gambling game apparatus, gambling machines, casino machines and gambling machines; providing on-line casino games and games of chance; providing on-line casino-type computer games; training in the field of casino games, gambling, on-line gambling, operations of gaming rooms, use and operation of gaming machines and gambling machines” in International Class 41, as shown in Application Serial No. 77/711,644, and hereby opposes same, by and through its undersigned attorneys, on the following grounds:

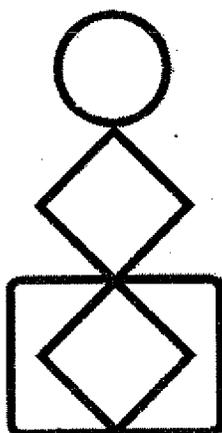
1. Opposer is a Minnesota corporation with a principal place of business at 1106 Palms Airport Drive, Las Vegas, Nevada.

2. Opposer is now and for many years past has been engaged in the development, creation, manufacture, distribution, marketing and sale of nearly all categories of casino and gaming instruments and equipment. Specifically, Opposer specializes in providing casinos with popular cutting-edge gaming entertainment content in a number of distinct categories, including proprietary table games which include live table games, their rules, their table formats, their table structures and tournaments based upon those games.

3. Opposer’s products are marketed to, sold to and displayed in a large number of casinos throughout the United States and the world.

4. One of Opposer's most popular and successful products is Three Card Poker, a poker game played in casinos where players match their individual three card poker hands against the hand dealt to the dealer/house and against a pay table.

5. Goods produced and sold by Opposer that are used in connection with Three Card Poker contain a number of distinctive trademarks. One of those design marks is the following (hereafter, "Coin Spot Mark"):



6. Opposer is the owner of common law trademark rights in Three Card Poker and the trademarks displayed in connection therewith, which include Opposer's Coin Spot Mark. Opposer uses its Coin Spot Mark in connection with casino and gambling games, as well as entertainment services, namely, providing games of chance in gambling and gaming establishments.

7. Opposer owns a federal copyright registration for the Three Card Poker board, which prominently displays Opposer's Coin Spot Mark. A copy of the copyright registration certificate for Reg. No. VA 1-680-816, registered July 28, 2009, is attached hereto as **Exhibit A**.

8. Upon information and belief, Applicants began using the Three Card Poker marks, including the Coin Spot Mark, in commerce in connection with casino and gambling games at least as early as 1996.

9. In May 1999, Applicants and Opposer entered into a purchase and license agreement in which Opposer purchased and assumed all rights and responsibilities in Three Card Poker from Applicants in the United States and a number of other countries, including all trademarks, copyrights, patents and other forms of intellectual property in Three Card Poker in the United States.

10. Since acquiring all trademark and other intellectual property rights to Three Card Poker in 1999, Opposer has prominently displayed the distinctive Coin Spot Mark throughout the United States in connection with casino and gambling goods and services. By following strict, uniform guidelines concerning its product designs, including guidelines relating to use and display of the distinctive Coin Spot Mark, Opposer ensures that each of its Three Card Poker products offered for sale in the United States is recognizable as emanating from Shuffle Master.

11. Opposer's trademark rights in the Coin Spot Mark are valid and subsisting.

12. Opposer's rights in the Coin Spot Mark predate and are superior to any rights that are or could be asserted by Applicants in the application for Subject Mark, due to Applicants' assignment of all rights to all intellectual property in the Three Card Poker game in the United States.

13. Since as early as 1999, Opposer has continuously used and continues to use the Coin Spot Mark in connection with a well-known line of goods and services relating to Three Card Poker. As a result, Opposer has developed substantial consumer recognition and exceedingly valuable goodwill in the Coin Spot Mark.

14. Opposer has exercised great care, skill and diligence in providing high quality goods and services in connection with the Coin Spot Mark.

15. Opposer has expended substantial sums of money for more than ten years marketing and otherwise promoting goods sold and services rendered bearing the Coin Spot Mark.

16. The extensive use and promotion of the Coin Spot Mark by Opposer have resulted in the Coin Spot Mark achieving great popularity and recognition with the public. Casino personnel, as well as casino customers, have come to know the Coin Spot Mark and identify it with Opposer's Three Card Poker game.

17. On information and belief, Applicants are individuals residing or working at 16 Park Lane, Littleover, Derby in the United Kingdom, and in the State of Nevada.

18. On April 10, 2009, Applicants filed the application at issue herein, Serial No. 77/711,644, seeking to register the Subject Mark under Section 44(e) of the Trademark Act for goods and services similar to those in connection with which the Coin Spot Mark is used, including "casino card games; gambling games; equipment for use in playing casino games and gambling games, namely, layout cloths and dealer buttons; casino card games."

19. Upon information and belief, the products identified in Serial No. 77/711,644 are or would be marketed and sold in connection with the Subject Mark to the same class of consumers to which Opposer's goods and services are sold in connection with the Coin Spot Mark, namely, casinos. The parties' goods are competitive.

20. The design set forth in the Subject Mark is substantially identical to the design portion of the Coin Spot Mark that Applicants assigned to Opposer and which Opposer has been continuously using in commerce, with the exception of an additional circle.

21. When applied to Applicants' goods, Applicants' Mark is likely to cause confusion or mistake or to deceive.

22. Applicants' Mark so closely resembles the design portion of Opposer's Coin Spot Mark as to cause a likelihood of confusion or mistake or to deceive. As a result, Opposer believes it will be damaged by registration of Applicants' Mark within the meaning of 15 U.S.C. § 1063(a).

23. Because of the similarity of the Subject Mark to Opposer's Coin Spot Mark, and because of the related nature of the parties' respective goods and services, Applicants' registration and use of the Subject Mark for the goods identified in the subject application likely will cause consumer confusion as to source, permission, affiliation, connection or association with Opposer. As such, Applicants are not entitled to registration of the Subject Mark pursuant to 15 U.S.C. § 1052(d).

24. Considering the fame of Opposer's Coin Spot Mark and the similarity of the Subject Mark to Opposer's Mark, Applicants' use of the Subject Mark would dilute the

ability of Opposer's famous Coin Spot Mark to identify Shuffle Master's goods and service. As such, the Subject Mark is not entitled to registration under 15 U.S.C. § 1063(a).

25. When they filed their Application, Applicants signed a declaration stating that they had a bona fide intent to use the mark in commerce and that "to the best of [their] knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true." In view of Applicants' knowledge of Opposer's rights in the Coin Spot Mark, Applicants do not have a bona fide intention to use the Subject Mark under circumstances showing good faith. Thus, Applicants are not entitled to register the Subject Mark under 15 U.S.C. § 1126(e).

26. Applicants assigned and licensed to Opposer all trademarks and other intellectual property related to Three Card Poker in the United States. Accordingly, the Subject Mark is not entitled to registration in view of Applicants' lack of ownership thereof.

27. At the time when Applicants filed their application, upon information and belief, Applicants were aware of Opposer's rights in the Coin Spot Mark, and had no reasonable basis to believe that a likelihood of confusion would not result from Applicants' use and registration of the Subject Mark. Thus, Applicants committed fraud on the United States Patent and Trademark Office when they knowingly made false claims in the declaration regarding their bona fide intention to use the Subject Mark and by attempting to obtain a registration to which they knew they were not entitled. Accordingly, the Subject Mark is not subject to registration

based on Applicants' lack of a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, as required for registration based on a foreign registration by 15 U.S.C. § 1126(e).

28. This opposition is timely filed. The filing fee of \$300.00 may be withdrawn from the deposit account of the undersigned, Account No. 502670.

WHEREFORE, Shuffle Master, Inc. requests that the registration sought by Applicants be refused, that the Notice of Opposition be sustained, and that the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Dated: April 5, 2010

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY  
& WALKER LLP

By: 

Bradford E. Young, Esq.

Lisa M. Willis, Esq.

75 East 55th Street

New York, New York 10022

212-318-6000

Attorneys for Opposer  
Shuffle Master, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing NOTICE OF OPPOSITION was served this 5th day of April 2010 by overnight courier upon attorney of record for Applicants, Donna J. Button, Nixon & Vanderhye P.C., 901 North Glebe Road, 11th Floor, Arlington, Virginia 22203.

  
Edith Lopez

LEGAL\_US\_E # 87410195.4

# EXHIBIT A

# Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

*Marybeth Peters*

Register of Copyrights, United States of America

Registration Number:  
**VA 1-680-816**

Effective date of  
registration:  
July 28, 2009

Title \_\_\_\_\_

Title of Work: Three Card Poker

Completion/ Publication \_\_\_\_\_

Year of Completion: 1995

Date of 1st Publication: January 1, 1996

Nation of 1st Publication: United States

Author \_\_\_\_\_

Author: Derek Webb

Author Created: 2-D artwork

Citizen of: United Kingdom

Year Born: 1950

Copyright claimant \_\_\_\_\_

Copyright Claimant: Shuffle Master, Inc.

1106 Palms Airport Drive, Las Vegas, NV, 89119

Transfer Statement: By written agreement

Rights and Permissions \_\_\_\_\_

Organization Name: Weide & Miller, Ltd.

Name: Ryan Gile

Email: rgile@weidemiller.com

Telephone: 702-382-4804

Address: 7251 W. Lake Mead Blvd.

Ste. 530

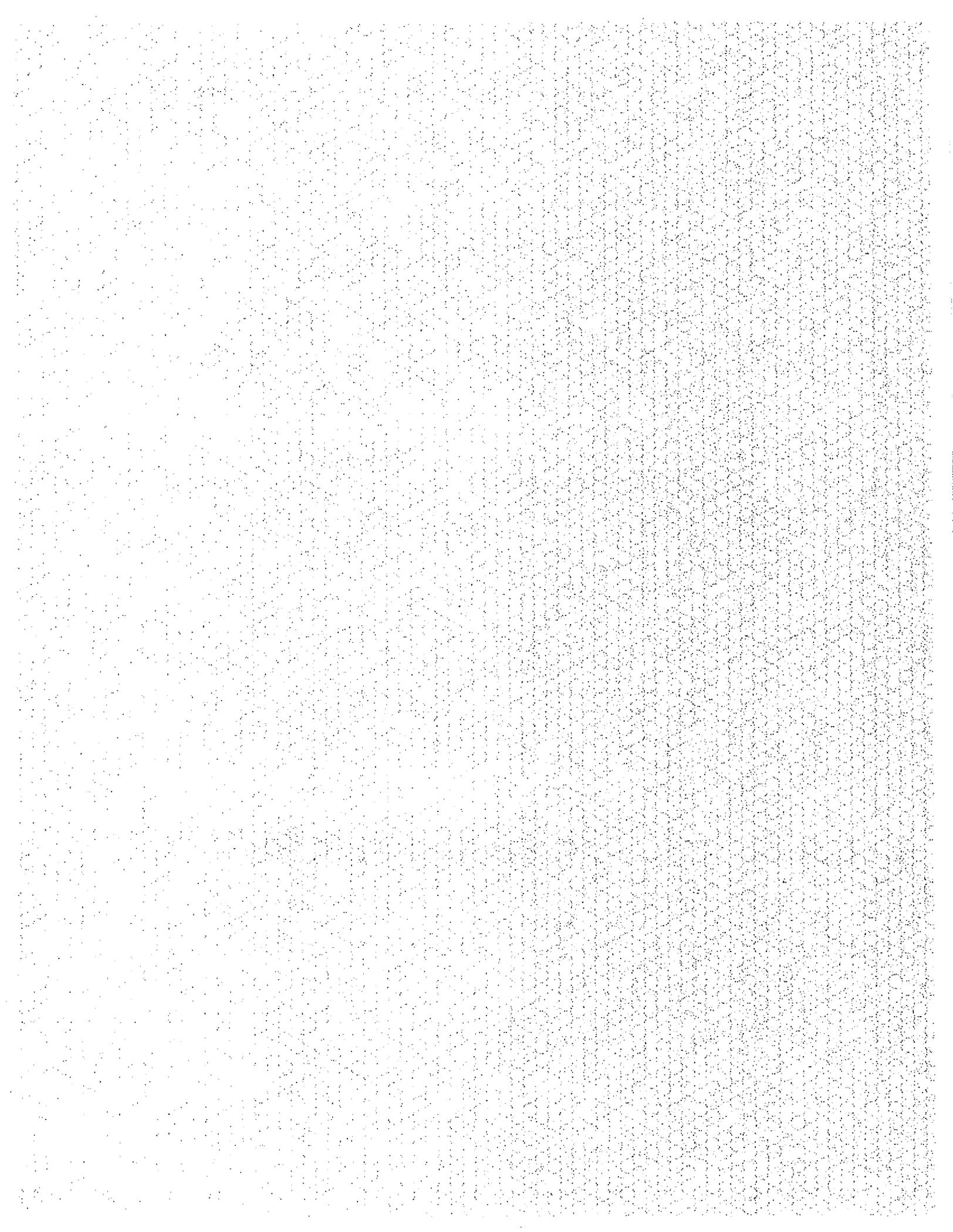
Las Vegas, NV 89128

Certification \_\_\_\_\_

Name: Ryan Gile

Date: July 28, 2009

Applicant's Tracking Number: SHUFLE.0113C



# THREE CARD POKER

