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

Proceeding	91218431
Party	Defendant IGT
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Submission	Motion to Suspend for Civil Action
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Date	04/08/2016
Attachments	IGT Motion to Suspend Pending Federal Court Action.pdf(5190102 bytes)

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

<p>DOUBLE DOWN, INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>IGT,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No.: 91218431 (Parent)</p> <p>Mark: DOUBLE DOWN STUD (Ser. No. 86/244,094)</p> <p>Cancellation No.: 92059996</p> <p>Mark: DOUBLEDOWN CASINO (Reg. No. 3,885,409)</p>
<p>IGT,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>DOUBLE DOWN, INC.,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No.: 92060105</p> <p>Mark: DOUBLE DOWN SALOON (Reg. No. 3,754,434)</p>

**IGT’S MOTION TO SUSPEND PROCEEDINGS IN VIEW OF PENDING CIVIL
ACTION PURSUANT TO TRADEMARK RULE 2.117(a)**

IGT hereby moves for suspension of the above-captioned proceedings to await determination of a pending civil action, pursuant to Trademark Rules 2.117(a) and 2.127(a), and TBMP § 510.02(a).

IGT and Double Down, Inc. (“DDI”) are now involved in litigation before the United States District Court for the District of Nevada, entitled *Double Down, Inc. v. IGT*, Civil Action No. 2:16-cv-00068-JAD-CWH (the “Federal Action”). In support of this Motion, IGT submits a copy of the Complaint filed on January 12, 2016 (*see* Exhibit A). The Federal Action involves the same marks and the same issues as those involved in the instant opposition and cancellation

proceedings, and DDI also seeks to enjoin IGT's use of the DOUBLEDOWN CASINO mark. Determination of the issues in the Federal Action will be dispositive of these proceedings.

IGT attempted to obtain Double Down, Inc.'s consent to suspension but has not yet received a response. However, Double Down, Inc. requested consent from IGT to suspend these proceedings on March 30, 2016. IGT withheld consent at that time because it had not yet been served in the Federal Action. IGT has now been served and therefore agrees with DDI that suspension is appropriate.

Suspension will avoid the unnecessary expenditure of both the Board's and the parties' resources in litigating the same issue in two forums as well as the potential for inconsistent results. Where the parties to a proceeding before the Board are involved in a civil action, the final determination of which will have a bearing on the Board proceeding, the proceeding should be suspended until final determination of the civil action. *See* 37 C.F.R. § 2.117(a); *The Other Telephone Company v. Connecticut National Telephone Company, Inc.*, 181 U.S.P.Q. 125, 127 (T.T.A.B., Feb. 11, 1974).

Currently pending before the Board in this proceeding is IGT's partial motion for summary judgment, to which IGT's reply in support is due April 14, 2016. For the above reasons, as the party having moved for partial summary judgment, IGT respectfully requests that the Board grant this Motion and suspend the above-captioned proceedings (including IGT's deadline to reply) pending the final disposition of the Federal Action. In the event that the Board does not suspend, IGT respectfully requests that the Board extend IGT's reply deadline by fifteen (15) days from the date of the Board's order denying suspension.

April 8, 2016

Respectfully submitted,

s/ Hope Hamilton

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Attorneys for IGT

CERTIFICATE OF SERVICE

The undersigned certifies that on April 8, 2016, I caused to be served a true and correct copy of the forgoing Motion to Suspend Proceedings In View Of Pending Civil Action Pursuant To Trademark Rule 2.117(a) in the manner indicated below to the following attorneys of record:

- | | |
|-------------------------------------|----------------------------|
| <input type="checkbox"/> | U.S. Mail, postage prepaid |
| <input type="checkbox"/> | Hand Delivery |
| <input type="checkbox"/> | Fax |
| <input checked="" type="checkbox"/> | Electronic Service |

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/s/ Hope Hamilton
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EXHIBIT A

AO 440 (Rev. 06/12) Summons in a Civil Action

UNITED STATES DISTRICT COURT

for the

District of Nevada

Double Down, Inc., a Nevada corporation)

Plaintiff(s))

v.)

IGT, A Nevada corporation)

Defendant(s))

Civil Action No. 2:16-cv-00068-JAD-CWH

SUMMONS IN A CIVIL ACTION

To: (Defendant's name and address) IGT,
9295 PROTOTYPE DR
RENO, NV 89521

A lawsuit has been filed against you.

Within 21 days after service of this summons on you (not counting the day you received it) — or 60 days if you are the United States or a United States agency, or an officer or employee of the United States described in Fed. R. Civ. P. 12 (a)(2) or (3) — you must serve on the plaintiff an answer to the attached complaint or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff or plaintiff's attorney, whose name and address are:

NIKKI L. BAKER (NV Bar No. 6562)
LAURA BIELINSKI LANGBERG (NV Bar No. 10516)
EMILY A. ELLIS (NV Bar No. 11956)
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100 North City Parkway, Suite 1600
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If you fail to respond, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

CLERK OF COURT

4/7/16

LANCE S. WILSON

CLERK

Lance S. Wilson

(By) DEPUTY CLERK



DATE

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7 Attorneys for Plaintiff
 DOUBLE DOWN, INC.

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 9
 10 **UNITED STATES DISTRICT COURT**
 11 **DISTRICT OF NEVADA**

12 DOUBLE DOWN, INC., a Nevada
 corporation,

13 Plaintiff,

14 v.

15 IGT, a Nevada corporation,

16 Defendant.

Case No.

**COMPLAINT FOR DAMAGES AND
 INJUNCTIVE RELIEF**

- (1) Trademark Infringement under 15 U.S.C. § 1114
- (2) Unfair Competition under 15 U.S.C. § 1125(a)
- (3) State Trademark Infringement under NRS 600.420
- (4) State Trademark Dilution under NRS 600.435
- (5) Common Law Trademark Infringement
- (6) Cancellation and Abandonment under 15 U.S.C. §§ 1119, 1063(a), and 1064

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 23 For its complaint against Defendant IGT ("Defendant" or "IGT"), Plaintiff Double Down,
 24 Inc. ("DDI") alleges the following:

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NATURE OF THE CASE

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2 1. This is an action for trademark infringement and unfair competition under federal
3 statutes, with pendent state and common law claims for trademark infringement and dilution. This
4 action also seeks relief with respect to Defendant's federal trademark registration and pending
5 trademark application. DDI seeks damages, attorneys' fees, costs, and permanent injunctive
6 relief.

7 **JURISDICTION AND VENUE**

8 2. This Court has subject matter jurisdiction over this case pursuant to
9 28 U.S.C. §§ 1331 and 1338(a). This Court has supplemental jurisdiction over DDI's state and
10 common law claims pursuant to 28 U.S.C. § 1367(a).

11 3. This Court has personal jurisdiction over Defendant because Defendant is a
12 Nevada corporation.

13 4. Venue is proper in the unofficial Southern Division of the United States District
14 Court for the District of Nevada under 28 U.S.C. §§ 1391(b) and 1391(c).

15 **PARTIES**

16 5. Plaintiff DDI is a Nevada corporation that owns and operates the Double Down
17 Saloon in Las Vegas, Nevada.

18 6. DDI is informed and believes, and thereon alleges, that Defendant IGT is a Nevada
19 corporation doing business in Las Vegas, Nevada.

20 **DDI's RIGHTS IN DOUBLE DOWN**

21 7. For over two decades, DDI has owned and operated the Double Down Saloon in
22 Las Vegas, Nevada ("Double Down LV Property"), which offers, among other things, casino
23 services, bar and restaurant services, and live entertainment services.

24 8. In 1993, DDI secured a restricted gaming license, which authorized DDI to offer
25 casino services at the Double Down LV Property, including, but not limited to, video poker,
26 blackjack, keno and slots.

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1 9. Since at least as early as February 25, 1993, DDI has continuously offered casino
2 services at the Double Down LV Property under the trademarks DOUBLE DOWN SALOON and
3 DOUBLE DOWN ("DDI's Marks").

4 10. DDI owns the following federal trademark registrations and applications with the
5 United States Patent and Trademark Office ("USPTO"):

- 6 a. DOUBLE DOWN SALOON trademark for "[e]ntertainment in the nature
7 of casino services and live performances by musicians and musical groups"
8 in International Class 41 (Reg. No. 3,754,434);
- 9 b. DOUBLE DOWN for "[e]ntertainment in the nature of casino services and
10 live performances by musicians and musical groups" in International Class
11 41 (Ser. No. 86/205,273);
- 12 c. DOUBLE DOWN SALOON for "[r]estaurant and tavern services" in
13 International Class 43 (Registration No. 3,085,525); and
- 14 d. DOUBLE DOWN for "[b]ar services; [c]ocktail lounge services; [t]avern
15 services" in International Class 43 (Reg. No. 4,613,372).

16 11. DDI also owns state registrations with the Nevada Secretary of State for DOUBLE
17 DOWN for "entertainment, live musical performances, casino services" (Reg No. E0201392015-9)
18 and "bar services, cocktail lounge services, tavern services" (Reg. No. E0200182015-3).

19 12. DDI has expended money to advertise and promote the Double Down LV Property
20 and DDI's Marks in nationwide print and broadcast media, and on the Internet, including through
21 DDI's website located at www.doubledownsaloon.com and various social media outlets.

22 13. Additionally, the Double Down LV Property has received national media
23 coverage, including features on The Travel Channel as well as NBC's The Today Show.

24 14. Because of DDI's significant investment in DDI's Marks over the course of more
25 than two decades, DDI's Marks have acquired tremendous goodwill in the United States, and have
26 acquired fame in the State of Nevada.

27 15. DDI has protected its rights in DDI's Marks by, among other things, asserting such
28 rights against trademark infringers upon discovering infringing activity.

PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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2 24. On September 18, 2014, DDI filed a Petition for Cancellation with the Trademark
3 Trial and Appeal Board ("TTAB"), requesting that the CASINO Registration be cancelled. This
4 proceeding is currently pending before the TTAB, Proceeding No. 92059996.

5 25. On September 18, 2014, DDI filed a Notice of Opposition with the TTAB,
6 opposing Defendant's STUD Application. This proceeding is currently pending before the
7 TTAB, Proceeding No. 91218431.

8 26. On October 6, 2014, IGT filed a Petition for Cancellation with the TTAB,
9 requesting that the TTAB cancel DDI's registration for DOUBLE DOWN SALOON (Reg. No.
10 3,754,434). This proceeding is currently pending before the TTAB, Proceeding No. 92060105.

11 **FIRST CLAIM FOR RELIEF**

12 **(Federal Trademark Infringement – 15 U.S.C. § 1114)**

13 27. DDI incorporates the allegations in the preceding paragraphs as if fully set forth
14 herein.

15 28. By its use of the CASINO Mark, Defendant intentionally and knowingly used and
16 continues to use in commerce reproductions, counterfeits, copies and/or colorable imitations of
17 DDI's Marks in connection with the sale, offering for sale, or advertising of services in a manner
18 that is likely to cause confusion or mistake, or to deceive consumers as to an affiliation,
19 connection, or association with DDI.

20 29. Defendant's use of the CASINO Mark has created a likelihood of confusion among
21 consumers who will falsely believe that the Defendant is associated with DDI or that DDI has
22 sponsored or approved of Defendant's services or commercial activities.

23 30. Defendant's continued and knowing use of the CASINO Mark without DDI's
24 consent or authorization constitutes intentional infringement of DDI's federal registered
25 trademarks in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

26 31. As a direct and proximate result of Defendant's infringement, DDI has suffered,
27 and will continue to suffer, monetary loss and irreparable injury to its business, reputation, and
28 goodwill.

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1 the sale, offering for sale, or advertising of services in a manner that is likely to cause confusion
2 or mistake, or to deceive consumers as to an affiliation, connection or association with DDI.

3 42. Defendant's use of the CASINO Mark has created a likelihood of confusion among
4 consumers who will falsely believe that Defendants' goods and services are associated with the
5 goods and services of DDI, or that DDI has sponsored or approved Defendant's goods, services or
6 commercial activities.

7 43. Defendant's continued use of the CASINO Mark with knowledge of DDI's Marks
8 and without the consent or authorization of DDI constitutes intentional infringement of DDI's
9 registered state trademarks in violation of NRS § 600.420.

10 44. As a direct and proximate result of Defendant's infringement, DDI has suffered,
11 and will continue to suffer, monetary loss and irreparable injury to its business, reputation, and
12 goodwill.

13 45. In addition to monetary damages, DDI is entitled to permanent injunctive relief
14 preventing Defendant's continued infringement of DDI's rights in DDI's Marks.

15 **FOURTH CLAIM FOR RELIEF**

16 **(State Trademark Dilution—NRS 600.435)**

17 46. DDI incorporates the allegations in the preceding paragraphs as if fully set forth
18 herein.

19 47. DDI's Marks are inherently distinctive or have acquired distinctiveness through
20 DDI's extensive use.

21 48. Based on DDI's continuous and extensive use of DDI's Marks in the State of
22 Nevada, DDI's Marks are entitled to be recognized as famous under NRS 600.435(2).

23 49. DDI is informed and believes, and thereon alleges, that Defendant began using the
24 CASINO Mark in commerce and in the infringing manner described herein after DDI's Marks
25 became famous in the State of Nevada.

26 50. Defendant's unauthorized use of the CASINO Mark is likely to cause dilution of
27 the distinctive quality of DDI's Marks and the goodwill associated with them, in violation of NRS
28 600.435(1)(b).

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1 51. DDI is informed and believes, and thereon alleges, that Defendant's actions were
2 willful in nature, in that Defendant willfully intended to cause dilution of DDI's Marks, or
3 willfully intended to trade on DDI's reputation.

4 52. As a direct and proximate result of Defendant's infringement, DDI has suffered,
5 and will continue to suffer, monetary loss and irreparable injury to its business, reputation, and
6 goodwill.

7 53. In addition to monetary damages, DDI is entitled to permanent injunctive relief
8 preventing Defendant's continued infringement of DDI's rights in DDI's Marks.

9 **FIFTH CLAIM FOR RELIEF**

10 **(Common Law Trademark Infringement)**

11 54. DDI incorporates the allegations in the preceding paragraphs as if fully set forth
12 herein.

13 55. By virtue of having used and continuing to use DDI's Marks, DDI has acquired
14 common law trademark rights in the marks.

15 56. Defendant's use of the CASINO Mark infringes upon DDI's interest in common
16 law trademark rights in DDI's Marks and is likely to cause confusion, mistake, or deception
17 among consumers, who will believe that Defendant's services originate from, are affiliated with,
18 or are endorsed by DDI when, in fact, they are not.

19 57. As a direct and proximate result of Defendant's infringement, DDI has suffered,
20 and will continue to suffer, monetary loss and irreparable injury to its business, reputation, and
21 goodwill.

22 58. In addition to monetary damages, DDI is entitled to permanent injunctive relief
23 preventing Defendant's continued infringement of DDI's rights in DDI's Marks.

24 **SIXTH CLAIM FOR RELIEF**

25 **(Cancellation Of Registrations And Abandonment Of Applications**

26 **Pursuant to 15 U.S.C. §§ 1119, 1063(a), and 1064)**

27 59. DDI incorporates the allegations in the preceding paragraphs as if fully set forth
28 herein.

1 E. An award of interest, costs and attorneys' fees incurred by DDI in prosecuting this
2 action pursuant to 15 U.S.C. § 1117(a)(3) and NRS 600.430; and

3 F. All other relief to which DDI is entitled.

4 DATED this 12th day of January, 2016.

5 Respectfully submitted,

6 BROWNSTEIN HYATT FARBER
7 SCHRECK, LLP

8 By: /s/ Nikki L. Baker

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