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Filing date: **04/13/2016**

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

Proceeding.	91218431
Applicant	Defendant IGT
Other Party	Plaintiff Double Down, Inc.
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	Yes

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, IGT hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

IGT has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

IGT has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Respectfully submitted,

/Hope Hamilton/

Hope Hamilton

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04/13/2016

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

DOUBLE DOWN, INC., Opposer, v. IGT, Applicant.	Opposition No.: 91218431 (Parent) Mark: DOUBLE DOWN STUD (Ser. No. 86/244,094) Cancellation No.: 92059996 Mark: DOUBLEDOWN CASINO (Reg. No. 3,885,409)
IGT, Petitioner, v. DOUBLE DOWN, INC., Registrant.	Cancellation No.: 92060105 Mark: DOUBLE DOWN SALOON (Reg. No. 3,754,434)

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

Double Down, Inc. (“DDI”) and IGT (collectively, “the parties”) hereby move 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).

The parties 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, the parties submit 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.

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).

For the above reasons, the parties respectfully request that the Board grant this Motion and suspend the above-captioned proceedings and all deadlines pending the final disposition of the Federal Action.

Respectfully submitted this 13 day of April 2016,

s/ Nikki L. Baker
Laura E. Bielinski
Nikki L. Baker
Emily A. Ellis
Erin E. Lewis
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Attorneys for IGT

CERTIFICATE OF SERVICE

The undersigned certifies that on April 13, 2016, I caused to be served a true and correct copy of the forgoing Stipulated 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

Hope Hamilton

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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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

1
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.

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

3 **SECOND CLAIM FOR RELIEF**

4 **(Unfair Competition: False Designation of Origin – 15 U.S.C. § 1125(a)(1)(A))**

5 33. DDI incorporates the allegations in the preceding paragraphs as if fully set forth
6 herein.

7 34. Defendant's use of the CASINO Mark constitutes intentional conduct by
8 Defendant to make false designations of origin and false descriptions about Defendant's services
9 and commercial activities, in violation of 15 U.S.C. § 1125(a)(1)(A).

10 35. Defendant's actions have created a likelihood of confusion among consumers who
11 will falsely believe that the services Defendant offers in connection with the CASINO Mark are
12 produced by, or affiliated or associated with, DDI, when in fact they are not.

13 36. DDI is informed and believes, and thereon alleges, that Defendant acted
14 knowingly, deliberately, and willfully with the intent to trade on DDI's reputation.

15 37. Defendant's conduct is willful, wanton and egregious.

16 38. As a direct and proximate result of Defendant's infringement, DDI has suffered,
17 and will continue to suffer, monetary loss and irreparable injury to its business, reputation, and
18 goodwill.

19 39. In addition to monetary damages, DDI is entitled to permanent injunctive relief
20 preventing Defendant's continued infringement of DDI's rights in DDI's Marks.

21 **THIRD CLAIM FOR RELIEF**

22 **(State Trademark Infringement—NRS 600.420)**

23 40. DDI incorporates the allegations in the preceding paragraphs as if fully set forth
24 herein.

25 41. By using the CASINO Mark in commerce in the manner described herein, without
26 the consent or authorization of DDI, Defendant intentionally and knowingly used in commerce
27 reproductions, counterfeits, copies and/or colorable imitations of DDI's Marks in connection with
28

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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 60. DDI seeks a determination from the Court that Defendant's registration obtained
2 for its CASINO Mark shall be cancelled.

3 61. IGT's STUD Mark is confusingly similar to DDI's Marks, and if used in
4 commerce and allowed to proceed to registration, is likely to create confusion among consumers,
5 who will falsely believe that IGT is associated with DDI or that DDI has sponsored or approved
6 of IGT's services or commercial activities.

7 62. DDI also seeks a determination from the Court to otherwise rectify the register
8 such that Defendant's applications for its STUD Mark do not proceed to registration.

9 **PRAYER FOR RELIEF**

10 WHEREFORE, DDI respectfully prays that the Court grant the following relief:

11 A. A permanent injunction prohibiting Defendant, Defendant's respective officers,
12 agents, servants, employees and/or all persons acting in concert or participation with Defendant,
13 from using the CASINO Mark, STUD Mark, confusingly similar variations thereof or any other
14 marks that infringe or dilute DDI's Marks, alone or in combination with any other letters, words,
15 letter strings, phrases or designs, in commerce or in connection with any business or for any
16 purpose whatsoever (including, but not limited to, on websites, in domain names, in hidden text
17 and metatags); and

18 B. A final order and permanent injunction:

- 19 1) directing cancellation of Defendant's CASINO Registration on the
20 USPTO's Principal or Supplemental Register; and
21 2) rectifying the register of the USPTO such that Defendant's applications for
22 its STUD Mark does not proceed to registration.

23 D. An award of compensatory, consequential, statutory, exemplary, and/or punitive
24 damages to DDI in an amount to be determined at trial;

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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
6 Respectfully submitted,

7 BROWNSTEIN HYATT FARBER
8 SCHRECK, LLP

9 By: /s/ Nikki L. Baker

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11 Laura Bielinski Langberg
12 Emily A. Ellis
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