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

Proceeding	91115866
Party	Defendant TREASURE ISLAND CORPORATION ,
Correspondence Address	ROBERT RYAN MORISHITA QUIRK & TRATOS SUITE 500 NORTH 3773 HOWARD HUGHES PARKWAY LAS VEGAS, NV 89109
Submission	Motion to Strike
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Signature	/Laraine M.I. Burrell/
Date	10/19/2005
Attachments	Motion to Strike Opposers Notice under Rule 2.122.pdf (8 pages)

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Prairie Island Indian Community,
a federally recognized Indian tribe,

Plaintiff,

vs.

Treasure Island Corp.,

Defendant.

Opposition Nos. 91115866 and
91157981

Cancellation Nos. 92028126
92028127; 92028130; 92028133;
92028145; 92028155; 92028171;
92029174; 92028199; 92028248;
92028280; 92028294; 92028314;
92028319; 92029325; 92028342;
and 92028379 (as consolidated)

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O Box 1451
Alexandria, VA 22313-1451

**REGISTRANT/APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE
UNDER RULE 2.122**

Registrant/Applicant, Treasure Island Corp., ("Treasure Island") files this Motion To Strike Opposer's Notice of Reliance as it fails to comply with Trademark Rule 2.122.

INTRODUCTION

On October 5, 2005, Opposer, Prairie Island Indian Community ("Prairie Island") filed a Notice Under Rule 2.122 seeking to make of record in connection with this proceeding certain e-mail communications it states were allegedly retrieved from its business records on September 28, 2005, a mere week prior to filing its Notice of Reliance on these documents. These e-mails were not produced during discovery and were not introduced into evidence through the testimony of a person who could properly authenticate and identify the materials.¹ Further, these documents do not constitute printed publications or public records that may be permissibly made of record through the filing of a Notice of Reliance under Rule 2.122. Treasure Island moves to strike these e-mails from the record of this proceeding.

¹ See Affidavit of R. Richard Costello attached hereto.

Prairie Island further seeks to make of record in connection with this proceeding, a copy of a Minnesota State Trademark Registration. This registration is not an official record or a certified copy of an official record. Moreover, its claimed date of first use is invalid. Treasure Island moves to strike this registration from the record of this proceeding.

TRADEMARK RULE 2.120(j)(3)(ii)

Prairie Island seeks to make certain e-mails of record through a notice of reliance. These e-mails were not previously produced during discovery. In fact, based upon the alleged dates of these e-mails they may not have been in existence during the discovery period. Prairie Island seeks to unfairly and inequitably surprise Treasure Island by attempting to make of record documents that Treasure Island never knew existed before October 5, 2005. In fact, Prairie Island admits in its Notice of Reliance that it did not retrieve these records until September 28, 2005, a week before it filed its Notice Under Rule 2.122. Treasure Island was not afforded the opportunity to question witnesses on the veracity, source or authenticity of these e-mails. Treasure Island was not afforded the opportunity to contest the e-mails, their contents, or offer rebuttal documents or witness testimony.

Even if these e-mails had been produced during the discovery period, Prairie Island cannot make them of record by way of a notice of reliance. See Genesco, Inc. v. Martz, 66 USPQ2d 1260 (TTAB 2003) (citing Trademark Rule 2.120(j)(3)(ii)). A party producing documents responsive to Fed. R. Civ. P. 34, "may not make the documents of record by way of notice of reliance, except to the extent they are admissible by notice of reliance under Trademark Rule 2.122(e)(printed publications and official records). See id. at 1266. As stated below, these e-mails are neither printed publications nor official records and are not admissible under Trademark Rule 2.122(e). These e-mails filed should be stricken from the record.

TRADEMARK RULE 2.122

Under Trademark Rule 2.122, certain documents may be made of record by filing a

notice of reliance. Such documents include printed publications and official records. The documents submitted by Prairie Island under its Notice of Reliance do not meet the printed publications or official records requirements.

1 Printed Publications:

Under Trademark Rule 2.122(e):

Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, may be introduced into evidence by filing a notice of reliance on the material being offered.

The e-mails submitted by Prairie Island do not meet the definition of printed publications as they are not available to the general public nor are they of general circulation among members of the public. See Intrepreneurs, Inc. v. Borland Software Corporation, 2003 WL 21678429, FN 8 (Trademark Tr. & App. Bd.)

Under Rule 1.222(e), the e-mails can only be introduced into evidence through the testimony of a person who can properly authenticate and identify the materials. See id. These e-mails should be stricken from the record because Prairie Island has not offered the testimony of any such person who can properly authenticate the e-mails. Moreover, these e-mails were not produced during discovery and are surprise materials which the Respondent was not allowed to challenge or test during the pendency of the matter.

2. Official Records:

Under Trademark Rule 2.122(e) a party may file a notice of reliance on an official record if the notice is accompanied by the official record itself, or a copy of the official record whose authenticity is established by the Federal Rules of Evidence. Under F.R.E 902, authenticity of an official record is established by offering either the original record or a certified copy of that record. In contrast, Prairie Island seeks to enter a copy of its Minnesota State Trademark Registration. Since the registration offered does not meet the

requirements for inclusion in a notice of reliance under Rule 2.122, it should be stricken from the record.

PRAIRIE ISLAND'S MINNESOTA STATE REGISTRATION IS INVALID

Prairie Island attempts to enter into the record through its Notice Under Rule 2.122 a invalid Minnesota State Trademark Registration. The registration alleges a date of first use of the mark TREASURE ISLAND by Prairie Island of January 1, 1990. This alleged date of first use is invalid as evidenced by the testimony of multiple Prairie Island witnesses including its designated person most knowledgeable on the issue, Cindy Flemke. In fact, Cindy Flemke acknowledged that Prairie Island's Treasure Island facility was not even open on January 1, 1990 as follows:

Q. Okay. Now, you indicated that that was the state of things as of December 31st, 1989. Can you tell me, did something occur on January 1st, 1990?

A. January 1st, 1990, the facility was closed down, and the facility was renamed Treasure Island, and the reason they closed down as of December -- or on January 1st, 1990, and they closed down for a two-week period of time, and at that point, all the employees were terminated.

See September 27, 2005, deposition of Cindy Flemke, Pg: 16 Ln: 22 – Pg:17 Ln: 6 attached hereto as Exhibit A.

Prairie Island's own witnesses have testified that not only was Prairie Island's Treasure Island facility not yet open for business and the mark not in use on January 1, 1990, the facility was not open for business on January 2, 1990, or January 3, 1990, or January 4, 1990. In fact, Prairie Island's facility was not opened, and the mark TREASURE ISLAND not used until considerably later than January 1, 1990. Prairie Island's attempt to fabricate a date of first use of its mark is disingenuous because this invalid date is rebutted by its own witnesses. In the interests of fairness, Prairie Island's invalid Minnesota State Trademark Registration for TREASURE ISLAND must be stricken from the record.

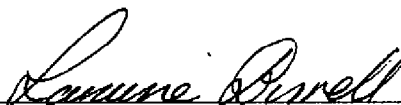
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CONCLUSION

For the foregoing reasons, Treasure Island respectfully requested that the Board strike Prairie Island's Notice of Reliance in its entirety Under Rule 2.122.

DATED: October 19, 2005

**GREENBERG TRAURIG
fka Quirk & Tratos**



Mark G. Tratos
R. Richard Costello (Of Counsel).
Laraine M. I. Burrell
3773 Howard Hughes Parkway, 500 North
Las Vegas, Nevada 89109
Counsel for Registrant/Applicant

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing **REGISTRANT/APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF RELIANCE UNDER RULE 2.122** on:

JACOBSON, BUFFALO, SCHOESSLER & MAGNUSON, Ltd.
Henry M. Buffalo, Jr., #236603
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Phone: 612.339.8300

Counsel for: Opposer

by causing a full, true, and correct copy thereof to be sent by the following indicated method or methods, on the date set forth below:

- by mailing in a sealed, first-class postage-prepaid envelope, addressed to the last-known office address of the attorney, and deposited with the United States Postal Service at Las Vegas, Nevada.
- by hand delivery.
- by sending via overnight courier in a sealed envelope.
- by faxing to the attorney at the fax number that is the last-known fax number.
- by electronic mail to the last known e-mail address.

DATED: October 19, 2005.


An employee of GREENBERG TRAURIG

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**AFFIDAVIT OF R. RICHARD COSTELLO IN SUPPORT OF
REGISTRANT/APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE
UNDER RULE 2.122**

STATE OF NEVADA)
)
COUNTY OF CLARK)

R. Richard Costello, being first duly sworn, deposes and says he has personal knowledge of, and is competent to testify to, the following facts:

1. I am an attorney licensed to practice law before the USPTO and in the State of Nevada. I am Of Counsel to the law firm of Greenberg Traurig, counsel for Registrant/Applicant. This Affidavit is submitted in support of Registrant/Applicant's Motion To Strike Opposer's Notice Of Reliance Under 2.122;

2. Registrant/Applicant received on or about October 5, 2005, a copy of Opposer's Notice of Reliance Under 2.122;

3. Attached to that Notice of Reliance and being offered on the record pursuant to the Notice of Reliance were numerous e-mails that opposer's counsel identifies as "retrieved from Plaintiff's business records on September 28, 2005." The emails are dated during the period of February 6, 2004 to July 12, 2005;

4. Opposer did not produce these e-mails during the discovery period of this proceeding.

5. During the discovery period of this proceeding, Opposer did not produce these e-mails in response to requests for production of documents.

6. During the discovery period of this proceeding, Opposer did not produce these e-mails in response to interrogatories propounded.

7. During its testimony period, Opposer did not introduce these e-mails into evidence through the testimony of any person who authenticated or identified the materials;

8. Registrant/Applicant has not had the opportunity to depose witnesses on the veracity, source or authenticity of these e-mails;

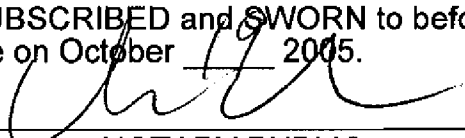
9. Registrant/Applicant has not had the opportunity to cross examine any witness offered by Opposer during its testimony period regarding any facts surrounding these emails.

10. Registrant/Applicant has not had the opportunity to contest the content of the e-mails or to offer rebuttal testimony or documents.



R. Richard Costello

SUBSCRIBED and SWORN to before me on October 20, 2005.



NOTARY PUBLIC

