

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARDPrairie Island Indian Community,
a Federally Recognized Indian Tribe,Opposition Nos. 91115866
and 91157981

Plaintiff,

v.

Treasure Island Corp.,

Defendant.

Cancellation Nos. 92028126;
92028127; 92028130; 92028133;
92028145; 92028155; 92028171;
92028174; 92028199; 92028248;
92028280; 92028294; 92028314;
92028319; 92028325; 92028342;
and 92028379 (as consolidated)

Note: the enclosed materials are to be filed in the parent case relevant to these proceedings, namely Opposition No. 91115866

TRADEMARK TRIAL AND APPEAL BOARD
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451LETTER

Dear Trademark Trial and Appeal Board:

Enclosed herewith for filing in the above-referenced proceedings please find PLAINTIFF'S/OPPOSER'S REPLY BRIEF and CERTIFICATE OF SERVICE on Treasure Island Corp.

Respectfully submitted,

JACOBSON, BUFFALO, SCHOESSLER
& MAGNUSON, LTD.

Date: July 7, 2006

By: Eric O. Haugen, Of Counsel
1360 Energy Park Drive
Suite 210
St. Paul, MN 55108
Phone: (651) 644-4710
FAX: (651) 644-5904Attorneys for Plaintiff,
Prairie Island Indian Community,
a Federally Recognized Indian Tribe

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PLAINTIFF'S/OPPOSER'S REPLY BRIEF

Eric O. Haugen, Of Counsel
JACOBSON, BUFFALO, SCHOESSLER
& MAGNUSON, LTD.
1360 Energy Park Drive
Suite 210
St. Paul, MN 55108
Phone: (651) 644-4710
FAX: (651) 644-5904

Attorneys for Plaintiff,
Prairie Island Indian Community,
a Federally Recognized Indian Tribe

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National Cable Television Association, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1582; 19 U.S.P.Q. 2d 1424, 1431 (Fed. Cir. 1991).

Pro-Cuts v. Schliz-Price Enterprises, Inc., 27 U.S.P.Q.2d 1224, 1227 (T.T.A.B. 1993)

Van Dyne Crotty, Inc. v. Wear-Guard Corp., 17 U.S.P.Q.2d 1866, 1868 (Fed. Cir. 1991)

I. INTRODUCTION

Opposer/Petitioner Prairie Island Indian Community
(hereinafter "Prairie Island" or "Plaintiff") hereby submits this Reply Brief in connection with the above-captioned consolidated proceeding, and respectfully requests that this honorable Board consider the same. This Reply Brief will focus solely on issues raised by Registrant/Applicant Treasure Island Corp. (hereinafter "TIC" or "Defendant").

To a degree, Defendant, in the opening paragraph of its Brief, properly states the issue that makes up the heart of this matter when it states that "[t]he crux of this matter is the issue of the priority of use between Treasure Island's mark for casino and related services and a TREASURE ISLAND mark owned by Plaintiff. . . also used for casino services." Plaintiff respectfully contends that what this Board must focus on as it considers this matter, however, is that what is at issue here are a variety of specific registrations and an application "owned" by Defendant, not a single broad-based TREASURE ISLAND mark used by Defendant.

It is also not disputed, and in fact admitted by Defendant, that Plaintiff's first use of the TREASURE ISLAND mark was on January 19, 1990 when it first opened the doors of its establishment and began offering casino services under that mark. Also, "[i]t is undisputed that the Los Angeles Times reported that Mr. Winn announced the development of the Treasure Island Hotel and

Casino on October 31, 1991". See Plaintiff's Main Trial Brief at pg. 10, and Defendant's Trial Brief at pg. 11.

In effect, there is no dispute with regard to the fact that Plaintiff's use of the TREASURE ISLAND mark predates any use of any of the marks at issue in Defendant's registrations and application. For the reasons set forth below, judgment in Plaintiff's favor is mandated.

II. DISCUSSION

A. Defendant's Tacking Argument

The first 23 pages of Defendant's Brief are devoted to assertions by Defendant not that it has priority of use over Plaintiff in connection with any of the marks at issue in the applications and registrations at issue in these proceedings, but rather that it, Defendant, has some sort of priority over Plaintiff in connection with its use of the designation TREASURE ISLAND in connection with casino services. This Board cannot lose sight of the fact that at issue in this proceeding are specific registrations and an application.

Defendant's attempt to formulate a priority is based entirely on an effort to tack its alleged use of a fanciful TREASURE ISLAND design incorporated into the "belly glass" portion of slot machines on to each and every casino-based registration at issue in this proceeding. Defendant's slot machine usage is set forth in materials submitted to the Board by Defendant.

Defendant does not allege that it offered any casino services under any of the marks at issue in these proceedings prior to Plaintiff's first use. Rather, the Defendant attempts to allege an earlier date of first use by tacking its registrations to a designation that it used on and in connection with so-called "slot machine merchandizing". For the following reasons the Defendant's through-the-back-door tacking argument must be rejected.

The standard for tacking is strict and has been met only in rare instances. See, e.g. Brookfield Communications Inc. v. West Coast Entertainment Corp., 50 U.S.P.Q.2d 1545, 1552 (9th Cir. 1999), citing Van Dyne Crotty, Inc. v. Wear-Guard Corp., 17 U.S.P.Q.2d 1866, 1868 (Fed. Cir. 1991) and Baroid Drilling Fluids, Inc. v. Sun Drilling Products, 24 U.S.P.Q.2d 1048, 1053 (T.T.A.B. 1992). It is not sufficient that the marks be confusingly similar; rather, they must be legal equivalents, creating the same, continuing commercial impression. Van Dyne-Crotty, 926 F.2d 1156, 1159, 17 U.S.P.Q.2d 1866, 1868. See also, Pro-Cuts v. Schliz-Price Enterprises, Inc., 27 U.S.P.Q.2d 1224, 1227 (T.T.A.B. 1993) ("In short, although we agree that these marks are confusingly similar, they clearly are not legal equivalents. Under the circumstances, applicant cannot tack onto its use of the mark PRO-CUTS and design the earlier use of PRO-KUT and design.") and Baroid Drilling, 24 U.S.P.Q.2d at 1053 ("For purposes of tacking, two marks are not necessarily legal equivalents merely because they are considered to be confusingly similar."). With the above rule in mind, Plaintiff respectfully

requests that this Board review the slot machine based TREASURE ISLAND materials relied upon by Defendant to determine whether the belly glass use is the legal equivalent of any of the registrations at issue in these proceedings (see Shadler, Russell, Mikulich, and Pascal testimony exhibits).

In addition to demonstrating the legal equivalence of the marks, a party seeking to tack to an earlier mark in order to obtain or maintain trademark rights must also demonstrate that the two sets of goods or services offered under the two marks are "substantially identical". Big Blue Products, Inc. v. IBM, 19 U.S.P.Q.2d 1072, 1075 (T.T.A.B. 1991). See also, Pro-Cuts v. Schliz-Price Enters, Inc., 27 U.S.P.Q.2d 1224, 1226-27 (T.T.A.B. 1993) ("A party seeking to 'tack' its use of an earlier mark onto its use of a later mark for the *same goods* or services may so do so only if the earlier and the later marks are legal equivalents, or are indistinguishable from one another.") (emphasis supplied).

Irrespective of how Defendant designates its attempt to tack its alleged use of TREASURE ISLAND on slot machines on to the casino-related marks at issue in these consolidated proceedings, what Defendant is attempting to do is, in fact, just that: tacking. That Defendant does not designate its attempt to tack as such is not surprising. The marks used by, registered to, and being applied for by Defendant, at issue here, are not the legal equivalents of the slot machine-based design marks. The marks are

used for wholly different goods and services, to wit coin-operated slot machines vs. casino services.

The best evidence of the date of first use by Defendant of the marks in connection with the relevant services are Defendant's own sworn applications for registration and the ultimate registrations that issued thereon. In those applications, Defendant acknowledges that its first use of any of the casino-related marks at issue in this proceeding was, at the earliest, in 1993. See Exhibit 2 to Defendant's Main Brief. In connection with those casino-related registrations applied for under the intent-to-use provisions of the Lanham Act, the earliest constructive date of first use Defendant can assert is July 23, 1993. See Exhibits 3 and 5 to Plaintiff's Main Brief.

Defendant did not even announce the idea of a future casino to be known as TREASURE ISLAND to the public until October 1991, nearly two years after Plaintiff started using the TREASURE ISLAND mark in connection with casino services. It was not until a year later, in 1992, that any of the marks at issue in these proceedings were even used by the Defendant to promote the future casino. Defendant has acknowledged that it was aware of Plaintiff's use of the TREASURE ISLAND mark for casino service even during this pre-application period and as early as 1991.

Despite its best hindsight-based efforts to convince the Board otherwise in this proceeding, Defendant has acknowledged its view of the dissimilarity between "slot machine merchandizing" and

casino services. On March 24, 1994 Defendant submitted a response to an Office Action lodged by the Trademark Office relative to the Registrant's application to register TREASURE ISLAND AT THE MIRAGE (issued as Reg. No. 2,010,396, Exhibit 1 to Plaintiff's Main Brief). See Russell testimony Exhibit 1. This Office Action cited a pending application on the mark TREASURE ISLAND as used in connection with "coin-operated amusement machines and parts therefore.", the very goods at issue in Defendant's tacking attempt. In its response, the Defendant distinguished slot machines and casino services in this way:

Applicant's mark is for use in conjunction with the casino services offered at Treasure Island. The mark in the cited application is for use in conjunction with goods, namely, coin operated amusement machines and poker machines. *Clearly, coin operated machines are much different than the services offered by the applicant under the TREASURE ISLAND AT THE MIRAGE mark, and consumers are unlikely to be confused given the difference between these goods and services.*

Russell Exhibit 1 at pg. 2 (emphasis added).

In that same response, the Defendant elaborated on its position:

The examining attorney's assertion that the goods of the cited application are likely to be found in hotel/casinos, while true, is of no moment. Resort hotels are like small cities; they offer many hundreds of different products and services to guests. However, it is fundamental that these guests understand that not all of the products used or sold within the hotel are manufactured by the hotel. It is not realistic to hypothesize that an amusement machine which is sold to a casino would appear to be manufactured by the casino, even if the brand name of the machine (which may not ever be visible to al player) were the same as the trade name of the casino. Casino operators do not customarily

manufacture machines, and manufacturers of machines do not operate casinos.

Given the differences in the goods and services, and in the trade channels, it is clear that the mark noted by the examining attorney, even if it turned into a registered mark, would clearly not pose a likelihood of confusion with applicant's mark.

Russell Exhibit 1 at pg. 3 (emphasis added).

Defendant has represented to the Trademark Office its belief that slot machines "are much different than the services offered by the applicant under the TREASURE ISLAND AT THE MIRAGE mark", that "consumers are unlikely to be confused given the difference between these goods and services", and that "it is not realistic to hypothesize that an amusement machine which is sold to a casino would appear to be manufactured by the casino." Defendant specifically represented to the Trademark Office that there could be no likelihood of confusion as between casino services and slot machines: the very goods it now attempts to utilize in its tacking attempt.

Plaintiff is not suggesting that the Defendant is estopped from asserting an argument contrary to that taken during the prosecution of the application that resulted in the '396 Registration. See International Wholesalers, Inc. v. Saxons Sandwich Shoppes, Inc., 170 U.S.P.Q.2d 107, 109 (T.T.A.B. 1971). In the instant proceeding, however, Defendant, through Mark Russell, Vice President and General Counsel for Defendant, specifically reaffirmed that the statements at issue in the Russell

Exhibit 1 Office Action, asserted by Defendant, were and remain accurate. See Russell Testimony at pgs. 81-85.

In spite of Defendant's presently asserted claim that TREASURE ISLAND slot machines and TREASURE ISLAND casino services are somehow related, Defendant, in sworn testimony, has specifically confirmed its position and belief that they are not.

On another level, Plaintiff is at somewhat of a loss as to what Defendant is attempting to establish through its arguments to the effect that it was using the TREASURE ISLAND design on and in connection with slot machines before Plaintiff began using the mark in connection with its casino services. Defendant has done nothing more than argue that it used the designation TREASURE ISLAND on slot machines before Plaintiff used TREASURE ISLAND in connection with casino services. No attempt whatsoever has been undertaken by Defendant to address the legal requirements for tacking. The slot machine-based TREASURE ISLAND design mark must be shown by Defendant to be the legal equivalent of the casino services-based marks at issue in the registrations and application before the Board. Not only must coin operated slot machines be shown to be substantially identical to casino services but, as well, the marks themselves must be shown to be substantially identical. These, of course, are requirements under the Doctrine of Tacking. See Van Dyne Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 U.S.P.Q.2d 1866, 1868 (Fed. Cir. 1991).

Defendant's attempt to tack use of the TREASURE ISLAND design mark used in connection with slot machines on to its casino-based application and registrations must be rejected by this Board in its entirety. The casino services marks used by Defendant and the slot machine mark it seeks to tack to are not legal equivalents. For the purposes of a tacking analysis, the slot machine marks are clearly distinguishable from the marks at issue here and are used on goods which, by Defendant's own admission, are not substantially identical. It is clear that the Plaintiff has a priority of use as concerns the mark TREASURE ISLAND as used in connection with casino services. Judgment should therefore be entered in the Plaintiff's favor as concerns U.S. Reg. Nos. 1,949,380; 2,010,396; 2,024,221; and 2,040,770.

Two final points regarding Defendant's tacking attempt are in order. First, throughout its Brief, Defendant asserts that its predecessor in interest utilized the TREASURE ISLAND mark in connection with what it refers to as "slot tournaments". Defendant then attempts to lull this Board into believing that "slot tournaments" were promoted by Defendant under the TREASURE ISLAND mark prior to Plaintiff's use of TREASURE ISLAND on and in connection with casino services. In truth, there is *nothing* in the record that indicates that any "slot tournaments" relevant to slot machines utilizing the TREASURE ISLAND designation occurred at any time before 1993. In other words, no such "tournaments" took place

until three years after Plaintiff first used its mark on and in connection with casino services.

Additionally, Plaintiff objects to Defendant's attempt to rely on the registrations discussed at pgs. 20-21 of its Trial Brief. The discussed registrations are not part of the record in this matter, and in order to be part of the record Defendant was required to submit these registrations to the Board pursuant to a notice of reliance, by introducing copies as an exhibit to testimony, or by stipulation of the parties. None of these factors are present in the instant situation, and therefore these materials are not properly before the Board. See generally TBMP § 704.03(b)(1). While Defendant indicates that "[t]he Board should take judicial notice of this (alleged) evidence" (see pg. 21 of Defendant's Brief) TBMP 704.03(b)(1) specifically states that "the Board does not take judicial notice of registrations in the (Trademark) Office".

B. Hotel Services

In its Brief, Defendant correctly states as follows: "Treasure Island first announced its intent to use the TREASURE ISLAND mark for a three hundred million dollar (\$300,000,000.00) resort hotel in Las Vegas on October 29, 1991." Defendant's Brief at 23. Defendant inaccurately states, however, that "[a]t that time, Prairie Island did not have a hotel, or offer hotel services." Defendant began offering its hotel services, at the earliest, on October 27, 1993. See Exhibit 9 to Plaintiff's Main

Brief. Defendant has a constructive date of first use of, at the earliest, July 23, 1993, as concerns its hotel services-based marks. See Exhibits 4 and 9 to Plaintiff's Main Brief. Relevant to its hotel services-based application and registrations, and unlike its casino services-based registrations, Defendant does not attempt to back-date or tack on as concerns hotel services.

The un rebutted evidence in this matter establishes that beginning in 1990, over three years before Defendant applied for any of its hotel services-based registrations, Plaintiff was offering lodging services to its casino patrons under the mark TREASURE ISLAND. Plaintiff's Exhibit 34 to its Main Brief specifically sets forth use of the TREASURE ISLAND mark in connection with, for example, a lodging package offered by Plaintiff which included "Three Days And Two Nights At A Fine Local Hotel" as well as "Round-Trip Transportation". Clearly, Plaintiff was offering its lodging services for years before Defendant offered such services.

Additionally, as discussed in its Main Brief, hotel services and casino services are directly related, one to the other. In fact, the two sets of services "compliment" each other in that casinos traditionally offer lodging services of one sort or another to its patrons. Therefore, and as further grounds for judgment in Plaintiff's favor, Plaintiff specifically notes that Defendant's hotel services-based application and registrations not only directly conflict with Plaintiff's use of the TREASURE ISLAND mark

on and in connection with lodging services, but, as well, conflict with Plaintiff's use of TREASURE ISLAND on and in connection with its casino services in general.

Defendant does not seriously question Plaintiff's assertion of likelihood of confusion as between Plaintiff's TREASURE ISLAND mark and Defendant's hotel services-based registrations. Furthermore, Plaintiff has a priority in the lodging services area. Based on these facts, judgment should be rendered in Plaintiff's favor relevant to the hotel services-based marks.

C. Souvenir Items

In its discussion of souvenir items, Defendant appears to revert back to its tacking argument. While this argument fails for the exact reasons it fails relevant to casino services, Plaintiff notes additional facts which establish that it, Plaintiff, clearly has a priority with regard to these goods.

As concerns souvenir items, Defendant is unable to assert any sort of assignment rights relevant to the designation TREASURE ISLAND. This Board knows that, as concerns casino services, Defendant relies heavily on an assignment from GNLV to it, Defendant, relevant to the TREASURE ISLAND designation as used in connection with slot machine merchandizing. As concerns souvenir items, there is no such assignment, meaning that Defendant cannot even attempt to tack. Plaintiff believes that it is extremely important that this Board not lose sight of the fact that

Defendant's attempt to tack, under any circumstances, is improper given the facts present in the instant proceedings.

Another key fact for this Board to consider is that nowhere in the record is there any evidence whatsoever of any use of the souvenir-goods related marks at issue in this proceeding by Defendant which predates Plaintiff's uncontested evidence showing that it has been using the mark on souvenir-based goods since 1990. See Exhibit 35 to Plaintiff's Main Brief. The earliest date set forth in any of the registrations at issue concerning souvenir items is October 7, 1992. See U.S. Reg. No. 1,918,033, Exhibit 7 to Plaintiff's Main Brief. The earliest filing date for any of the registrations at issue concerning souvenir items is July of 1993. As can be seen in Exhibit 35 to Plaintiff's Main Brief, Plaintiff was already using the TREASURE ISLAND mark on a multitude of items by these dates.

For all of the above reasons, judgment should be entered in Plaintiff's favor as concerns those marks which involve souvenir items.

D. Actual Confusion

Defendant attempts to minimize the undisputed existence of actual confusion not by denying that such actual confusion exists, but rather by putting the blame for such confusion on Plaintiff. Incredibly, Defendant suggests that Plaintiff is fostering some sort of actual confusion by not identifying the physical location of its property, and by not having its toll-free number listed in a

master directory. Defendant takes the position that Plaintiff, a resort and casino, should not refer to itself generically as a resort and casino. Defendant suggests that Plaintiff should alter its web site so as to contain more geographic information relevant to Plaintiff, irrespective of how those alterations would affect Plaintiff's web site aesthetically and otherwise.

Defendant's suggestion that Plaintiff "reform its conduct" is disingenuous at best. Why should Plaintiff, a resort and casino, be put in the position of not referring to itself as a resort and casino? Why should Plaintiff be put in the position of asserting "Red Wing, Minnesota" in all customer-based conversations? Defendant's "suggestions", however, do establish that there is clearly actual confusion present in the instant situation, and establishes that such confusion is rampant. Plaintiff's evidence of actual confusion is before the Board, and, as can be seen, is substantial.

Plaintiff is the senior user of the mark TREASURE ISLAND on and in connection with casino services, and on and in connection with all other goods and services at issue in these proceedings. It is *Defendant*, not Plaintiff, that is under a duty to initiate actions necessary to avoid confusion.

Plaintiff stands by its evidence of actual confusion. This Board has in its possession documentation showing misdirected phone calls, criticism of Defendant and its facilities directed toward Plaintiff, individuals showing up at Treasure Island (Minnesota)

only to find that they had inadvertently booked their stay at Treasure Island (Nevada), and individuals showing up at Treasure Island (Nevada) only to find that they had inadvertently booked their stay at Treasure Island (Minnesota). Actual confusion is rampant and actual confusion is the best evidence of a likelihood of confusion.

E. Likelihood of Confusion

Defendant gives short shrift to the *Du Pont* Factors discussed extensively in Plaintiff's Main Brief. In essence, Plaintiff's analysis of this matter, as concerns these factors, stands un rebutted. Plaintiff does note, however, that Defendant's attempt to distinguish its marks from Plaintiff's TREASURE ISLAND mark wholly contradicts its earlier position that tacking should be allowed in this situation. That is, on the one hand Defendant insists that tacking is proper relevant to all of its marks at issue in the instant proceeding while, on the other hand, Defendant argues that the geographically descriptive "at the Mirage" phrase present in some of its marks distinguishes itself from Plaintiff. The Defendant cannot have it both ways. Defendant, both in its Brief and throughout this entire proceeding, has fully admitted that the words TREASURE ISLAND dominate all of the marks at issue in this proceeding. In fact, the Board need not look beyond the layout of Defendant's Brief in order to conclude that this fact is established. Throughout its Brief, Defendant continually refers to

its marks as "TREASURE ISLAND marks" or, in the singular, "TREASURE ISLAND mark".

The marks at issue in these proceedings are, beyond a doubt, confusingly similar under the relevant *Du Pont* analysis. As such, judgment should be entered in Plaintiff's favor.

F. Defendant's Estoppel by Acquiescence Argument

Much of Defendant's "Estoppel by Acquiescence" argument is based on a theory that Plaintiff knew of Defendant's use of the TREASURE ISLAND mark in 1991 or 1992, and that for purposes of estoppel by acquiescence that is the critical "start date". Defendant's assertion is flawed on several fronts. First off, the Federal Circuit has specifically held that it is not possible for laches to start prior to the date upon which an application for registration is published for opposition. See National Cable Television Association, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1582; 19 U.S.P.Q. 2d 1424, 1431 (Fed. Cir. 1991).

As for the '734 application at issue in the opposition proceeding, Plaintiff again notes the National Cable Television Association, Inc. holding. In that case, the defense of laches relevant to an opposition proceeding was effectively eliminated. See National Cable Television Association, Inc., 937 F.2d 1572, 1581, 19 U.S.P.Q.2d 1424, 1432.

Thus, Defendant's laches argument is wholly flawed to the extent that it argues that laches began to run at any time prior to a given mark at issue in this proceeding being published for

opposition. None of Defendant's marks at issue in this proceeding were published before the middle of 1994, and two of them, the '770 Registration and the '756 Registration did not publish until December of 1996.

Defendant also alleges that Plaintiff's supposed "delay" in filing "its cancellation and opposition petitions" has somehow caused Defendant to suffer substantial economic prejudice. Nowhere in Defendant's Brief or in any of the evidence before this Board is there an indication of what this supposed "economic harm" is. In this section of its Brief, as throughout its entire Brief, Defendant speaks only of the "TREASURE ISLAND" marks. Plaintiff and the Board are left to wonder how much economic prejudice would befall Defendant if the *specific* marks at issue in these proceedings were cancelled and successfully opposed. It is telling that since the first cancellation proceedings were filed in these consolidated proceedings, Defendant has let several of its registrations lapse. Further, Defendant has re-themed its casino/hotel complex since the filing of these proceedings. In truth, Defendant has not and cannot show any sort of "economic prejudice" in connection with this matter.

Defendant also takes the position that Plaintiff somehow "acquiesced" to its use of the marks at issue in this proceeding by "knowingly availing itself of the hotel and casino services offered under those marks". See Defendant's Brief at pgs. 33-34. Defendant appears to be arguing that the mere fact representatives

from Plaintiff stayed at Defendant's casino/hotel property that Plaintiff is now somehow estopped from objecting to Defendant's use and registration of the relevant marks at issue in these proceedings. In other words, Defendant appears to be arguing that Plaintiff was put to the choice of boycotting Defendant completely or losing rights to complain in the future about Defendant's use of the confusingly similar designations at issue here. Defendant is unable to cite any cases, nor could it, indicating that some sort of estoppel arises through the mere fact that a party in the position of Plaintiff took advantage of services offered by Defendant.

Defendant's argument of estoppel by acquiescence must be rejected by this Board. Acquiescence requires active consent on the part of a party in the position of Plaintiff. See Coach House Restaurant, Inc. v. Coach and Six Restaurants, Inc., 934 F.2d 1551, 1558; 19 U.S.P.Q.2d 1401, 1404 (11th Cir. 1991). In order to prove up an acquiescence defense, Defendant must show that (1) Plaintiff actively represented that it would not assert a right or claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused the Registrant undue prejudice. Coach House Restaurant, Inc., did. Here, far from "actively representing that it would not assert a right or claim", representatives of Plaintiff, in particular Delores Knapp, specifically met with representatives of Defendant while staying at Defendant's place of business in order to discuss

the issue of likelihood of confusion. This meeting occurred before the filing of any of the proceedings at issue here. See generally Knapp testimony at pgs. 26-30.

For the above-stated reasons, Defendant's acquiescence defense must be rejected in its entirety.

G. Res Judicata

Plaintiff maintains its contention that the doctrine of res judicata applies in this situation for the reasons set forth in its Main Brief and that judgment should be entered against Defendant accordingly. Plaintiff does point out to the Board, however, that Defendant's discussion of Plaintiff's res judicata claim absolutely supports a rejection of its attempt to tack, discussed in detail earlier in this Brief. In particular, Defendant, in its res judicata discussion, specifically indicates that under the tacking doctrine the marks at issue must be the legal equivalent of one another. See generally Defendant's Brief at pgs. 38-42. Defendant argues that none of "Treasure Island's current marks are the legal equivalent of any of the previously cancelled marks". Defendant's Brief at pg. 38. This Board should take this particular statement into effect when determining whether Defendant's tacking attempt, discussed extensively earlier in this Brief, should succeed. In particular, if Defendant believes that none of its "current marks" are the legal equivalent of any of the "previously cancelled marks", how can Defendant reasonably argue that the depiction used

on the slot machine belly glass is the "legal equivalent" of any of the marks at issue in the instant proceedings?

H. Defendant's Objections to Plaintiff's Evidence

The following discussion rebuts the objections contained at pgs. 45-47 of Defendant's Brief. Plaintiff will simply go through the objections in the same order raised by the Defendant.

1. Exhibit 28: this document is admissible to show actual confusion. It is offered simply to show as a fact that individuals specifically contacted Plaintiff believing that they were contacting Defendant.

2. Exhibits 28, 29, and 30: the documents at issue concern misdirected phone calls recorded by employees of Plaintiff. The Board will observe from these documents that they are specifically broken down by the name of the individual who fielded the call. Therefore, there is no overlap. Just because two or three misdirected calls came in on January 15th of a given year does not render the reports overlapping: different individuals took these calls at different times of the day. The documents speak for themselves and prove up actual confusion. Additionally, irrespective of whether Prairie Island had an 800 directory assistance listing, individuals were still phoning Plaintiff believing they were contacting Defendant. This is further evidence of actual confusion.

3. There is no Exhibit 40. Plaintiff's Exhibits end at 37.

4. The basis for this objection is not known. Irrespective of whether it "was generated by a source outside the United States", it evidences actual confusion.

5. During the course of these consolidated proceedings, tens of thousands of documents, if not more, were exchanged as between the parties. Defendant is well aware that the parties specifically agreed to respect the others wishes as concerns confidential documents produced back and forth. Defendant has absolutely no reason whatsoever to want the noted documents to be divorced from the protective order other than to harass Plaintiff. As the Board can see, each and every one of these documents is rightfully designated in a reasonable fashion pursuant to the protective order. One is left to wonder just what Defendant is hoping to achieve by revealing the documents publicly. Publicly revealing bank or credit card account numbers or confidential business information? Defendant has absolutely no reason whatsoever to divorce the noted documents from the protective order. Additionally, Defendant is wrong when it asserts that none of the exhibits were marked as "confidential". See, for example, Flemke Exhibit B. This document is clearly marked confidential, never the less Defendant wrongly asserts to this Board that it is not.

6-7. Plaintiff contends that all such objections are unfounded.

III. CONCLUSION

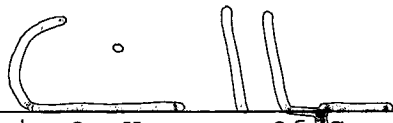
For all of the above-stated reasons, Plaintiff respectfully contends that judgment in its favor is mandated with regard to all of the cancellation proceedings and the opposition proceeding at issue in this proceeding. Orders to this effect are respectfully requested.

Respectfully submitted,

JACOBSON, BUFFALO, SCHOESSLER
& MAGNUSON, LTD.

Date: July 7, 2006

By:


Eric O. Haugen, Of Counsel
1360 Energy Park Drive
Suite 210
St. Paul, MN 55108
Phone: (651) 644-4710
FAX: (651) 644-5904

Attorneys for Plaintiff,
Prairie Island Indian Community,
a Federally Recognized Indian Tribe

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Prairie Island Indian Community, Opposition Nos. 91115866
a Federally Recognized Indian Tribe, and 91157981

Plaintiff,

v.

Treasure Island Corp.,

Defendant. Cancellation Nos. 92028126;
 92028127; 92028130; 92028133;
 92028145; 92028155; 92028171;
 92028174; 92028199; 92028248;
 92028280; 92028294; 92028314;
 92028319; 92028325; 92028342;
 and 92028379 (as consolidated)

***Note: the enclosed materials are to be filed in the parent case relevant to these
proceedings, namely Opposition No. 91115866***

TRADEMARK TRIAL AND APPEAL BOARD
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

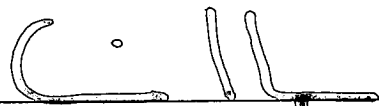
CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing
PLAINTIFF'S/OPPOSER'S REPLY BRIEF was served on Treasure Island
Corp., c/o R. Richard Costello, Mark G. Tratos and Laraine M.I.
Burrell, of Greenberg Traurig, 3773 Howard Hughes Parkway, Suite
500 North, Las Vegas, NV 89109, Attorneys for Defendant, by first
class mail postage prepaid, on July 7, 2006.

JACOBSON, BUFFALO, SCHOESSLER
& MAGNUSON, LTD.

Date: July 7, 2006

By:


Eric O. Haugen, Of Counsel
1360 Energy Park Drive
Suite 210
St. Paul, MN 55108
Phone: (651) 644-4710
FAX: (651) 644-5904

Attorneys for Plaintiff,
Prairie Island Indian Community,
a Federally Recognized Indian Tribe

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Prairie Island Indian Community,
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92028280; 92028294; 92028314;
92028319; 92028325; 92028342;
and 92028379 (as consolidated)

CERTIFICATE OF MAILING VIA EXPRESS MAIL

***Note: the enclosed materials are to be filed in the parent case
relevant to these proceedings, namely Opposition No. 91115866***

TRADEMARK TRIAL AND APPEAL BOARD
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA VA 22313-1451

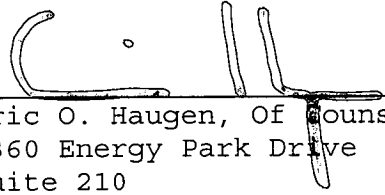
Sir:

I hereby certify that the attached PLAINTIFF'S/OPPOSER'S REPLY BRIEF and CERTIFICATE OF MAILING in connection with the above-identified matter are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to TRADEMARK TRIAL AND APPEAL BOARD, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, under Express Mail Label No. EV058592324US on July 7, 2006.

JACOBSON, BUFFALO, SCHOESSLER
& MAGNUSON, LTD.

Date: July 7, 2006

By:


Eric O. Haugen, Of Counsel
1360 Energy Park Drive
Suite 210
St. Paul, MN 55108
Phone: (651) 644-4710
FAX: (651) 644-5904

Attorneys for Plaintiff,
Prairie Island Indian Community,
a Federally Recognized Indian Tribe