

TTAB

Attorney Docket No. 017673-000101US

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, BOX TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3514, on October 1, 2003.

TOWNSEND and TOWNSEND and CREW LLP

By Billie C. Raney  
Billie C. Raney

10-06-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

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

In re Application No. 78/177,544  
Filed: October 23, 2002  
Published: June 3, 2003  
For: VOICEPLAY

10/14/2003 ZCLIFT01 00000082 201430 78177544  
01 FC:6402 300.00 DA  
Void date: 10/14/2003 ZCLIFT01  
10/14/2003 ZCLIFT01 00000082 201430 78177544  
01 FC:6402 300.00 CR

DANIEL A. MENDOZA,  
  
Opposer,  
  
vs.  
  
SCIENTIFIC GAMES CORPORATION,  
  
Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

10/14/2003 ZCLIFT01 00000083 201430 78177544  
01 FC:6402 1200.00 DA

Commissioner for Trademarks  
Box TTAB FEE  
2900 Crystal Drive  
Arlington, VA 22202-3514

Dear Madam:

Daniel A. Mendoza ("Opposer"), a United States citizen, doing business at P.O. Box 193156, San Francisco, California 94111, believes that he will be damaged by registration of the mark shown in U.S. Trademark Application Serial No. 78/177,544, and hereby opposes the

10/16/2003 TTAB

registration of the same with respect to the services in International Class 9, 36, 38, and 42 as set forth in the Application. As grounds for opposition, Opposer alleges:

1. On January 25, 1988, Opposer's predecessor-in-interest filed U.S. Trademark Application Serial No. 73/707,267 for the mark **VOICE PLAY** for promoting goods and services of others through the distribution of printed material and prerecorded messages in International Class 35. On May 16, 1989, the mark **VOICE PLAY** registered as U.S. Trademark Reg. No. 1,539,511. A copy from the U.S.P.T.O.'s TARR database verifying the above registration is attached as Exhibit 1. Since at least as early as January 24, 1987, Opposer and his predecessor have used the mark **VOICE PLAY** for "promoting goods and services of others through the distribution of printed material and prerecorded messages" in International Class 35. The registration is incontestable pursuant to 15 U.S.C. § 1065.

2. Since 1989, Opposer's use of the mark has expanded to channels and mediums beyond those listed in the registration.

3. By virtue of such use, Opposer has established valuable goodwill in the mark, and the public has come to associate the **VOICE PLAY** Mark with Opposer and to know **VOICE PLAY** as an indication of services that emanate from Opposer.

4. Applicant filed U.S. Trademark Application Serial No. 78/177,544 (the "Application"), which is the subject of this Opposition, on October 23, 2002, for the mark "VOICEPLAY" for use in connection with: voice recognition computer software that allows players to place wagers or make purchases by telephone or the Internet in International Class 9; betting services; telephone and Internet-based wagering services in International Class 36; telecommunications gateway services that allow players to place wagers or make purchases via voice recognition software in International Class 38; and providing temporary use of on-line non-downloadable software for wagering and making on-line purchases in International Class 42.

5. The Application was filed on an Intent-to-Use basis.

6. Opposer began use of its **VOICE PLAY** mark, the subject of Registration No. 1,539,511, well prior to Applicant's filing date.

7. The goods and services identified in the Application are substantially similar or related to Opposer's services offered under his **VOICE PLAY** Mark.

8. As a result of the public association of the **VOICE PLAY** Mark with Opposer, consumers are likely to consider Applicant's goods and services sold or offered under the mark **VOICEPLAY** as emanating from Opposer, and to confuse these goods and services with those of Opposer.

9. Registration of the mark in the Application and use of Applicant's mark are likely to cause confusion, or to cause mistake, or to deceive, particularly as to the source or origin of the goods and services with which Applicant uses its mark, to induce consumers to believe that the goods and services of Applicant are those of Opposer, or are endorsed by, or are in some way affiliated or associated with Opposer.

10. If the Application is permitted to register, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the mark **VOICEPLAY** and would, therefore, cause confusion among consumers as to the separate and distinct sources of Applicant's goods and services and Opposer's services and the relationship of Opposer to Applicant, thereby damaging Opposer's goodwill in his **VOICE PLAY** Mark, diluting the value thereof and causing Opposer's business and reputation irreparable harm, all to the detriment of Opposer who has expended considerable sums and effort in promoting his **VOICE PLAY** Mark.

Wherefore, Opposer prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 78/177,544 for **VOICEPLAY** be denied.

Please charge any necessary fee regarding this Opposition to the Deposit Account of Townsend and Townsend and Crew LLP, No. 20-1430, and credit any overpayment to such deposit account.


Pursuant to the Trademark Rules, this Notice is being submitted in triplicate.

Please direct all notices, pleadings and process regarding this matter to:

Marc M. Gorelnik, Esq.  
TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, CA 94111-3834  
Telephone: (415) 576-0200  
Facsimile: (415) 576-0300

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

By   
\_\_\_\_\_  
Marc M. Gorelnik  
*Attorneys for Opposer*

Dated: October 1, 2003.

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04/10/2001/01/01

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-10-01 17:47:10 ET

Serial Number: 73707267

Registration Number: 1539511

Mark

# “VOICE◇PLAY”

(words only): "VOICE PLAY"

**Current Status:** Section 8 and 15 affidavits have been accepted and acknowledged.

**Date of Status:** 1996-08-21

**Filing Date:** 1988-01-25

**Registration Date:** 1989-05-16

**Law Office Assigned:** TMEO Law Office # 7

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

**Current Location:** 900 -Warehouse (Newington)

**Date In Location:** 1997-01-06

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## LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. MENDOZA, DANIEL A.

**Address:**

MENDOZA, DANIEL A.  
P.O. BOX 193156  
SAN FRANCISCO, CA 941193156  
United States

**Legal Entity Type:** OTHER

**State or Country Where Organized:** United States

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**GOODS AND/OR SERVICES**

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PROMOTING GOODS AND SERVICES OF OTHERS THROUGH THE DISTRIBUTION OF  
PRINTED MATERIAL AND PRERECORDED MESSAGES

**International Class:** 035

**First Use Date:** 1987-01-24

**First Use in Commerce Date:** 1987-01-26

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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1996-08-21 - Section 8 (6-year) accepted & Section 15 acknowledged

1996-03-18 - Response received for Post Registration action

1996-03-18 - Section 15 affidavit received

1995-09-19 - Post Registration action mailed - Section 8

1995-01-24 - Section 8 (6-year) filed

1989-05-16 - Registered - Principal Register

1989-02-21 - Published for opposition

1989-01-20 - Notice of publication

1988-11-21 - Approved for Pub - Principal Register (Initial exam)

1988-11-07 - Examiner's amendment mailed

1988-08-12 - Communication received from applicant

1988-05-18 - Non-final action mailed

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**CONTACT INFORMATION**

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**Correspondent (Owner)**

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