

ESTTA Tracking number: **ESTTA944347**

Filing date: **12/28/2018**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Oneida Nation
Granted to Date of previous extension	12/29/2018
Address	N7210 Seminary Road PO Box 365 Oneida, WI 54155 UNITED STATES
Attorney information	Christopher R. Liro Andrus Intellectual Property Law, LLP 100 E Wisconsin Ave Suite 1100 Milwaukee, WI 53202 UNITED STATES chris.liro@andruslaw.com, aaron@andruslaw.com, mariem@andruslaw.com, cathym@andruslaw.com 4142717590

Applicant Information

Application No	87945397	Publication date	10/30/2018
Opposition Filing Date	12/28/2018	Opposition Period Ends	12/29/2018
Applicant	Planet Bingo, Inc. 75190 Gerald Ford Dr. Palm Desert, CA 92211 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2002/06/01 First Use In Commerce: 2002/06/01 All goods and services in the class are opposed, namely: Bingo cards; Bingo game playing equipment
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Applicant Information

Application No	88036911	Publication date	10/30/2018
Opposition Filing Date	12/28/2018	Opposition Period Ends	
Applicant	Planet Bingo, Inc. 75190 Gerald Ford Dr. Palm Desert, CA 92211 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2001/06/01 First Use In Commerce: 2001/06/01
All goods and services in the class are opposed, namely: Bingo cards; Bingo game playing equipment

Applicant Information

Application No	87945338	Publication date	10/30/2018
Opposition Filing Date	12/28/2018	Opposition Period Ends	
Applicant	Planet Bingo, Inc. 75190 Gerald Ford Dr. Palm Desert, CA 92211 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2002/06/01 First Use In Commerce: 2002/06/01
All goods and services in the class are opposed, namely: Bingo cards; Bingo game playing equipment

Applicant Information

Application No	87945357	Publication date	10/30/2018
Opposition Filing Date	12/28/2018	Opposition Period Ends	
Applicant	Planet Bingo, Inc. 75190 Gerald Ford Dr. Palm Desert, CA 92211 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 1992/06/01 First Use In Commerce: 1992/06/01
All goods and services in the class are opposed, namely: Bingo cards; Bingo game playing equipment

Applicant Information

Application No	87945380	Publication date	10/30/2018
Opposition Filing Date	12/28/2018	Opposition Period Ends	
Applicant	Planet Bingo, Inc. 75190 Gerald Ford Dr. Palm Desert, CA 92211 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2002/06/01 First Use In Commerce: 2002/06/01
All goods and services in the class are opposed, namely: Bingo cards; Bingo game playing equipment


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	88129417	Application Date	09/24/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SUPER X-TRA KASH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1994/12/31 First Use In Commerce: 1994/12/31 Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming		

U.S. Application No.	88129435	Application Date	09/24/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THREE SISTERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1996/01/15 First Use In Commerce: 1996/01/15 Bingo parlor services; Gaming services in the nature of bingo; Entertainment		

	services, namely, casino gaming; Gaming services in the nature of casino gaming
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U.S. Application No.	88129451	Application Date	09/24/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BINGO OR BETTER		
Design Mark	<p style="text-align: center;">BINGO OR BETTER</p>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1997/12/13 First Use In Commerce: 1997/12/13 Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming		

Attachments	88129417#TMSN.png(bytes) 88129435#TMSN.png(bytes) 88129451#TMSN.png(bytes) 2018-12-28 Notice of Opposition.pdf(724050 bytes)
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Signature	/Christopher R. Liro/
Name	Christopher R. Liro
Date	12/28/2018

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

In the matter of trademark application Serial No. 87/945,397
For the mark SUPER X-TRA KASH

In the matter of trademark application Serial No. 88/036,911
For the mark THREE SISTERS

In the matter of trademark application Serial No. 87/945,338
For the mark BINGO OR BETTER

In the matter of trademark application Serial No. 87/945,357
For the mark JUMBO7

In the matter of trademark application Serial No. 87/945,380
For the mark PLANETDOWNS

ONEIDA NATION,)	
)	
Opposer,)	OPPOSITION NO. _____
)	
v.)	
)	
PLANET BINGO, INC.,)	
)	
Applicant.)	
)	

CONSOLIDATED NOTICE OF OPPOSITION

Oneida Nation (“Opposer”), a federally recognized sovereign Indian nation, having a reservation located within the borders of the State of Wisconsin, and doing business at N7210 Seminary Road, PO Box 365, Oneida, WI 54155, believes that it will be damaged by registrations of the trademarks shown in U.S. Trademark Application No. 87/945,397 (“the ’397 Application”) for SUPER X-TRA KASH, Application No. 88/036,911 (“the ’911 Application”) for THREE SISTERS, Application No. 87/945,338 (“the ’338 Application”) for BINGO OR BETTER, Application No. 87/945,357 (“the ’357 Application”) for JUMBO7, and Application

No. 87/945,380 (“the ’380 Application”) for PLANETDOWNS, all filed by Planet Bingo, Inc. (“Applicant”) and all published for opposition on October 30, 2018. Opposer hereby opposes the ’397 Application, the ’911 Application, the ’338 Application, the ’357 Application, and the ’380 Application. The grounds for this opposition are as follows:

Introduction and Parties

1. Opposer is a federally recognized sovereign Indian nation, whose operations include offering casino and gaming services in the Green Bay, Wisconsin area under the name Oneida Casino.

2. Opposer’s casino and gaming services include offering and administering a variety of Bingo games to the public, and Opposer has offered Bingo services to residents of Wisconsin and travelers from across the United States and around the globe since 1976.¹

3. Opposer’s Bingo services are currently offered at its 700-plus-seat Bingo Hall located at its casino facility, which opened in 1994, across the street from the Green Bay, Wisconsin airport.

4. Upon information and belief, Applicant, Planet Bingo, Inc. is a California corporation located and doing business at 75190 Gerald Ford Dr., Palm Desert, California.

5. In 1989, Opposer and Applicant entered into the first of a series of contracts under which Applicant would provide software and hardware services, and related printing services, for certain Bingo games.²

¹ The history of the Oneida’s bingo and gaming operations is told in Mike Heoft, *The Bingo Queens of Oneida: How Two Moms Started Tribal Gaming in Wisconsin* (Wisconsin Historical Society Press 2014).

² The named parties to the 1989 contract were Oneida Tribe of Indians of Wisconsin, Oneida Nation’s former name, and Melange Computer Services, Inc., a corporate predecessor of Applicant.

6. By at least October 6, 1990, Opposer began to offer a Bingo game under the brand JUMBONEIDA at its Bingo Hall. The name JUMBOENDA was selected by Oneida Casino staff as a brand for a new bingo game that the Casino would offer.

7. Pursuant to its support contracts with Opposer, Applicant printed bingo cards for the JUMBONEIDA Bingo game and provided hardware and software support services to implement the JUMBONEIDA Bingo game on the computer system at the Oneida Bingo Hall.³

8. By at least December 31, 1994, Opposer began to offer a Bingo game under the brand SUPER X-TRA KASH at its Bingo Hall. The name SUPER X-TRA KASH was selected by Oneida Casino staff as a brand for a new bingo game that the Casino would offer.

9. Pursuant to its support contracts with Opposer, Applicant printed bingo cards for the SUPER X-TRA KASH Bingo game and provided hardware and software support services to implement the SUPER X-TRA KASH Bingo game on the computer system at the Oneida Bingo Hall.

10. By at least January 15, 1996, Opposer began to offer a Bingo game under the brand THREE SISTERS at its Bingo Hall. THREE SISTERS is an Oneida cultural reference, and the name was selected by Oneida Casino staff as a brand for a new bingo game that the Casino would offer.

11. Pursuant to its support contracts with Opposer, Applicant printed bingo cards for the THREE SISTERS Bingo game and provided hardware and software support services to implement the THREE SISTERS Bingo game on the computer system at the Oneida Bingo Hall.

³ The computer system, for example, includes software that, depending on the game, may present game results on a display monitor, maintain game records, electronically verify winning cards, and allow game play on a handheld electronic Bingo device.

12. By at least December 13, 1997, Opposer began to offer a Bingo game under the brand BINGO OR BETTER at its Bingo Hall. The name BINGO OR BETTER was selected by Oneida Casino staff as a brand for a new bingo game that the Casino would offer.

13. Pursuant to its support contracts with Opposer, Applicant printed bingo cards for the BINGO OR BETTER Bingo game and provided hardware and software support services to electronically verify winning BINGO OR BETTER Bingo game cards using the computer system at the Oneida Bingo Hall.

14. By at least October 2, 1999, Opposer began to offer a Bingo game under the brand ONEIDA DOWNS at its Bingo Hall. The name ONEIDA DOWNS was selected by Oneida Casino staff as a brand for a new bingo game that the Casino would offer.

15. Pursuant to its support contracts with Opposer, Applicant printed bingo cards for the ONEIDA DOWNS Bingo game and provided hardware and software support services to electronically verify winning ONEIDA DOWNS Bingo game cards using the computer system at the Oneida Bingo Hall.

16. In 2018, the services contract between Opposer and Applicant reached the end of its term. In the course of discussions related to a request for proposals to provide support services, Applicant represented to Opposer in June 2018 that it has “trademarks and copyrights on the Oneida Games artwork and playability.”

17. In an apparent effort to create leverage in contract negotiations or to try to limit Opposer’s use of its game names and brands, in June and July 2018, Applicant filed trademark registration applications for the five marks at issue in this proceeding, which are all identical or similar to Opposer’s marks used to identify Opposer’s Bingo games.

18. A consolidated proceeding involving these five applications is appropriate because Opposer's claims against each application involve common questions of law and fact.

19. Opposer has a real interest in the proceeding, and in the outcome of each of the five subject registrations, because there is a likelihood of confusion with Opposer's prior rights in identical marks with respect to three of the applications, all five of the subject applications involve marks that are identical or similar to marks in which Opposer has prior rights, and Opposer believes that Applicant sought registration of the five subject applications in order to interfere with or limit Opposer's use of its prior marks.

Applicant's Five Applications at Issue

Applicant's '397 Application – SUPER X-TRA KASH

20. Upon information and belief, Applicant filed the '397 Application on June 1, 2018 under Section 1(a) for SUPER X-TRA KASH.

21. The '397 Application asserts first use and first use in commerce by June 1, 2002 in IC 028 / US 022, 023, 038, and 050 for goods and services: Bingo cards; Bingo game playing equipment.

22. The specimen that Applicant submitted with its '397 Application is essentially identical to one of the specimens for Opposer's Application No. 88/129,417, with the exception that Opposer's "Oneida Bingo" house mark and logo has been removed by Applicant and replaced with a "your logo here" graphic:

Applicant Specimen



Opposer Specimen



23. On information and belief, Applicant’s specimen with the “your logo here” graphic is not in actual use, but was instead created for the purpose of submission to the U.S. Patent and Trademark Office as a specimen by altering a sample of a Bingo card printed for Opposer.

24. On information and belief, Applicant has not created, sold, or offered for sale in commerce “Super X-Tra Kash” bingo cards except in the course of providing printing services to Applicant.

25. When Applicant filed the ’397 Application, it was aware of Opposer’s use of SUPER X-TRA KASH as a trademark to designate the source of Opposer’s Bingo services.

26. The ’397 Application included a certification by Applicant’s counsel Mr. Farley I. Weiss swearing that the “mark is in use in commerce on or in connection with the goods/services in the application,” that the “specimen(s) shows the mark as used on or in connection with the goods/services in the application,” that “no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near

resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.”

Applicant’s ’911 Application – THREE SISTERS

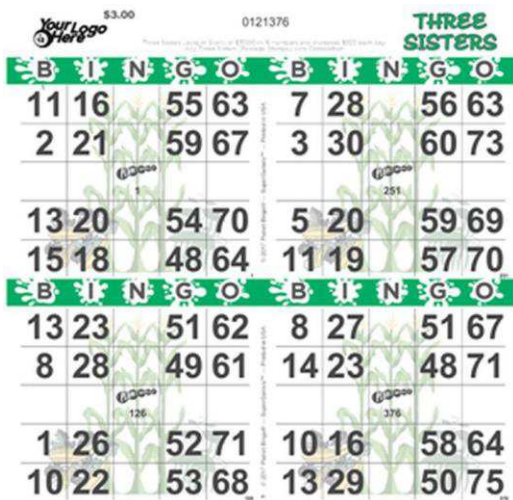
27. Upon information and belief, Applicant filed the ’911 Application on July 13, 2018 under Section 1(a) for THREE SISTERS.

28. The ’911 Application asserts first use and first use in commerce by June 1, 2001 in IC 028 / US 022, 023, 038, and 050 for goods and services: Bingo cards; Bingo game playing equipment.

29. The specimen that Applicant submitted with its ’911 Application is essentially identical to one of the specimens for Opposer’s Application No. 88/129,435, with the exception that Opposer’s “Oneida Bingo” house mark and logo has been removed by Applicant and replaced with a “your logo here” graphic:

Applicant Specimen

Opposer Specimen



30. On information and belief, Applicant’s specimen with the “your logo here” graphic is not in actual use, but was instead created for the purpose of submission to the U.S.

Patent and Trademark Office as a specimen by altering a sample of a Bingo card printed for Opposer.

31. On information and belief, Applicant has not created, sold, or offered for sale in commerce “Three Sisters” bingo cards except in the course of providing printing services to Applicant.

32. When Applicant filed the ’911 Application, it was aware of Opposer’s use of THREE SISTERS as a trademark to designate the source of Opposer’s Bingo services.

33. The ’911 Application included a certification by Applicant’s counsel Mr. Farley I. Weiss swearing that the “mark is in use in commerce on or in connection with the goods/services in the application,” that the “specimen(s) shows the mark as used on or in connection with the goods/services in the application,” that “no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.”

Applicant’s ’338 Application – BINGO OR BETTER

34. Upon information and belief, Applicant filed the ’338 Application on June 1, 2018 under Section 1(a) for BINGO OR BETTER.

35. The ’338 Application asserts first use and first use in commerce by June 1, 2002 in IC 028 / US 022, 023, 038, and 050 for goods and services: Bingo cards; Bingo game playing equipment.

36. On information and belief, Applicant’s specimen with the “your logo here” graphic is not in actual use, but was instead created for the purpose of submission to the U.S. Patent and Trademark Office as a specimen.

37. On information and belief, Applicant has not created, sold, or offered for sale in commerce “Bingo or Better” bingo cards except in the course of providing printing services to Applicant.

38. When Applicant filed the '338 Application, it was aware of Opposer's use of BINGO OR BETTER as a trademark to designate the source of Opposer's Bingo services.

39. The '338 Application included a certification by Applicant's counsel Mr. Farley I. Weiss swearing that the “mark is in use in commerce on or in connection with the goods/services in the application,” that the “specimen(s) shows the mark as used on or in connection with the goods/services in the application,” that “no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.”

Applicant's '357 Application – JUMBO7

40. Upon information and belief, Applicant filed the '357 Application on June 1, 2018 under Section 1(a) for JUMBO7.

41. The '357 Application asserts first use and first use in commerce by June 1, 1992 in IC 028 / US 022, 023, 038, and 050 for goods and services: Bingo cards; Bingo game playing equipment.

42. The specimen that Applicant submitted with its '357 Application is similar to one of the specimens for Opposer's Application No. 88/129,395, with differences that Opposer's “Oneida Bingo” house mark and logo has been removed by Applicant and replaced with a “your logo here” graphic, and the letters “neida” have been removed from inside the numeral 7:

Applicant Specimen



Opposer Specimen



43. On information and belief, Applicant’s specimen with the “your logo here” graphic is not in actual use, but was instead created for the purpose of submission to the U.S. Patent and Trademark Office as a specimen by altering a sample of a Bingo card printed for Opposer.

44. On information and belief, Applicant has not created, sold, or offered for sale in commerce “Jumbo7” bingo cards.

45. When Applicant filed the ’357 Application, it was aware of Opposer’s use of JUMBONEIDA as a trademark to designate the source of Opposer’s Bingo services.

46. The ’357 Application included a certification by Applicant’s counsel Mr. Farley I. Weiss swearing that the “mark is in use in commerce on or in connection with the goods/services in the application,” and that the “specimen(s) shows the mark as used on or in connection with the goods/services in the application.”

Applicant’s ’380 Application – PLANETDOWNS

47. Upon information and belief, Applicant filed the ’380 Application on June 1, 2018 under Section 1(a) for PLANETDOWNS.

48. The '380 Application asserts first use and first use in commerce by June 1, 2002 in IC 028 / US 022, 023, 038, and 050 for goods and services: Bingo cards; Bingo game playing equipment.

49. On information and belief, Applicant's specimen with the "your logo here" graphic is not in actual use, but was instead created for the purpose of submission to the U.S. Patent and Trademark Office as a specimen.

50. On information and belief, Applicant has not created, sold, or offered for sale in commerce "PlanetDowns" bingo cards.

51. When Applicant filed the '380 Application, it was aware of Opposer's use of ONEIDA DOWNS as a trademark to designate the source of Opposer's Bingo services.

52. The '380 Application included a certification by Applicant's counsel Mr. Farley I. Weiss swearing that the "mark is in use in commerce on or in connection with the goods/services in the application," and that the "specimen(s) shows the mark as used on or in connection with the goods/services in the application."

Opposer's Trademarks and Registration Applications

Opposer's SUPER X-TRA KASH Trademark

53. Opposer's SUPER X-TRA KASH trademark is symbolic of goodwill and consumer recognition built by Opposer through substantial time, money, and other resources to market, promote, and advertise its services under its SUPER X-TRA KASH trademark.

54. Opposer filed U.S. Trademark App. No. 88/129,417 ("the '417 Application") for the word trademark SUPER X-TRA KASH on September 24, 2018.

55. Opposer filed the '417 Application for IC 041 / US 100, 101, and 107 for goods and services: Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming.

56. Opposer first used the SUPER X-TRA KASH mark and first used the SUPER X-TRA KASH mark in commerce at least by December 31, 1994.

57. The '417 Application states that Opposer first used the SUPER X-TRA KASH mark and first used the SUPER X-TRA KASH mark in commerce at least by December 31, 1994.

58. Opposer's use of the trademark SUPER X-TRA KASH predates any use of SUPER X-TRA KASH by Applicant and, therefore, Opposer has superior rights.

59. Applicant's trademark SUPER X-TRA KASH is identical to Opposer's SUPER X-TRA KASH trademark in appearance, sound, connotation and commercial impression.

60. The goods on which Applicant has applied for registration of SUPER X-TRA KASH are goods associated with Opposer's services designated by its SUPER X-TRA KASH trademark.

61. The goods on which Applicant has applied for registration of SUPER X-TRA KASH are goods that are advertised and sold in channels of trade that are associated with and similar to the channels of trade of Opposer's services designated by its SUPER X-TRA KASH trademark.

Opposer's THREE SISTERS Trademark

62. Opposer's THREE SISTERS trademark is symbolic of goodwill and consumer recognition built by Opposer through substantial time, money, and other resources to market, promote, and advertise its services under its THREE SISTERS trademark.

63. Opposer filed U.S. Trademark App. No. 88/129,435 (“the ’435 Application”) for the word trademark THREE SISTERS on September 24, 2018.

64. Opposer filed the ’435 Application for IC 041 / US 100, 101, and 107 for goods and services: Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming.

65. Opposer first used the THREE SISTERS mark and first used the THREE SISTERS mark in commerce at least by January 15, 1996.

66. The ’435 Application states that Opposer first used the THREE SISTERS mark and first used the THREE SISTERS mark in commerce at least by January 15, 1996.

67. Opposer’s use of the trademark THREE SISTERS predates any use of THREE SISTERS by Applicant and, therefore, Opposer has superior rights.

68. Applicant’s trademark THREE SISTERS is identical to Opposer’s THREE SISTERS trademark in appearance, sound, connotation and commercial impression.

69. The goods on which Applicant has applied for registration of THREE SISTERS are goods associated with Opposer’s services designated by its THREE SISTERS trademark.

70. The goods on which Applicant has applied for registration of THREE SISTERS are goods that are advertised and sold in channels of trade that are associated with and similar to the channels of trade of Opposer’s services designated by its THREE SISTERS trademark.

Opposer’s BINGO OR BETTER Trademark

71. Opposer’s BINGO OR BETTER trademark is symbolic of goodwill and consumer recognition built by Opposer through substantial time, money, and other resources to market, promote, and advertise its services under its BINGO OR BETTER trademark.

72. Opposer filed U.S. Trademark App. No. 88/129,451 (“the ’451 Application”) for the word trademark BINGO OR BETTER on September 24, 2018.

73. Opposer filed the ’451 Application for IC 041 / US 100, 101, and 107 for goods and services: Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming.

74. Opposer first used the BINGO OR BETTER mark and first used the BINGO OR BETTER mark in commerce at least by December 13, 1997.

75. The ’451 Application states that Opposer first used the BINGO OR BETTER mark and first used the BINGO OR BETTER mark in commerce at least by December 13, 1997.

76. Opposer’s use of the trademark BINGO OR BETTER predates any use of BINGO OR BETTER by Applicant and, therefore, Opposer has superior rights.

77. Applicant’s trademark BINGO OR BETTER is identical to Opposer’s BINGO OR BETTER trademark in appearance, sound, connotation and commercial impression.

78. The goods on which Applicant has applied for registration of BINGO OR BETTER are goods associated with Opposer’s services designated by its BINGO OR BETTER trademark.

79. The goods on which Applicant has applied for registration of BINGO OR BETTER are goods that are advertised and sold in channels of trade that are associated with and similar to the channels of trade of Opposer’s services designated by its BINGO OR BETTER trademark.

Opposer's JUMBONEIDA Trademark

80. Opposer's JUMBONEIDA trademark is symbolic of goodwill and consumer recognition built by Opposer through substantial time, money, and other resources to market, promote, and advertise its services under its JUMBONEIDA trademark.

81. Opposer filed U.S. Trademark App. No. 88/129,395 ("the '395 Application") for the word trademark JUMBONEIDA on September 24, 2018.

82. Opposer filed the '395 Application for IC 041 / US 100, 101, and 107 for goods and services: Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming.

83. Opposer first used the JUMBONEIDA mark and first used the JUMBONEIDA mark in commerce at least by October 6, 1990.

84. The '395 Application states that Opposer first used the JUMBONEIDA mark and first used the JUMBONEIDA mark in commerce at least by October 6, 1990.

85. Opposer's use of the trademark JUMBONEIDA predates any use of JUMBO7 by Applicant and, therefore, Opposer has superior rights.

86. The goods on which Applicant has applied for registration of JUMBO7 are goods associated with Opposer's services designated by its JUMBONEIDA trademark.

87. The goods on which Applicant has applied for registration of JUMBO7 are goods that are advertised and sold in channels of trade that are associated with and similar to the channels of trade of Opposer's services designated by its JUMBONEIDA trademark.

Opposer's ONEIDA DOWNS Trademark

88. Opposer's ONEIDA DOWNS trademark is symbolic of goodwill and consumer recognition built by Opposer through substantial time, money, and other resources to market, promote, and advertise its services under its ONEIDA DOWNS trademark.

89. Opposer filed U.S. Trademark App. No. 88/129,469 ("the '469 Application") for the word trademark ONEIDA DOWNS on September 24, 2018.

90. Opposer filed the '469 Application for IC 041 / US 100, 101, and 107 for goods and services: Bingo parlor services; Gaming services in the nature of bingo; Entertainment services, namely, casino gaming; Gaming services in the nature of casino gaming.

91. Opposer first used the ONEIDA DOWNS mark and first used the ONEIDA DOWNS mark in commerce at least by October 2, 1999.

92. The '469 Application states that Opposer first used the ONEIDA DOWNS mark and first used the ONEIDA DOWNS mark in commerce at least by October 2, 1999.

93. Opposer's use of the trademark ONEIDA DOWNS predates any use of PLANETDOWNS by Applicant and, therefore, Opposer has superior rights.

94. The goods on which Applicant has applied for registration of PLANETDOWNS are goods associated with Opposer's services designated by its ONEIDA DOWNS trademark.

95. The goods on which Applicant has applied for registration of PLANETDOWNS are goods that are advertised and sold in channels of trade that are associated with and similar to the channels of trade of Opposer's services designated by its ONEIDA DOWNS trademark.

Grounds for Opposition to Applicant's '397 Application – SUPER X-TRA KASH

96. The allegations of paragraphs 1-95 are incorporated by reference as if stated in full herein.

Likelihood of Confusion

97. Applicant's SUPER X-TRA KASH trademark so resembles Opposer's SUPER X-TRA KASH trademark as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive purchasers as to the source of the goods, resulting in damage to Opposer.

98. Applicant's SUPER X-TRA KASH trademark so resembles Opposer's SUPER X-TRA KASH trademark as to be likely, when applied to the goods of Applicant, to deceive purchasers or potential purchasers of the parties' goods and services into believing that Applicant's goods emanate from, are licensed by, or are in some way directly or indirectly associated with, approved by, or sponsored by Opposer, resulting in damage to Opposer.

99. Accordingly, the Board should refuse registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

No Bona Fide Use

100. Applicant had no bona fide use of the mark SUPER X-TRA KASH in commerce when it filed the '397 Application as a trademark for Bingo cards and/or Bingo game playing equipment.

101. Accordingly, the Board should refuse registration under Section 1(a) and 1(c) of the Lanham Act, 15 U.S.C. § 1051(a), (c).

Not Rightful Owner

102. Opposer, not Applicant, is the rightful owner of the SUPER X-TRA KASH mark as used by Opposer in the course of providing services and as printed by Applicant on Bingo cards in the course of providing printing services for Opposer.

103. Accordingly, the Board should refuse registration under Section 1 of the Lanham Act, 15 U.S.C. § 1051.

Failure to Function as Mark

104. Applicant has not used SUPER X-TRA KASH as a trademark to designate the source of its Bingo cards and/or Bingo game playing equipment, because it was printed at Opposer's instructions to designate the source of Opposer's Bingo services.

105. Accordingly, the Board should refuse registration under Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1127.

Fraud

106. On information and belief, when the '397 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware of rights by others, namely Opposer, to use SUPER X-TRA KASH in a manner that would cause confusion or mistake, or to deceive, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the SUPER X-TRA KASH mark.

107. On information and belief, when the '397 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware that Applicant was not using the mark SUPER X-TRA KASH in commerce with the goods in the application and were aware that the submitted specimen was created for the purpose of submitting to the United States Patent and Trademark Office by altering Bingo cards printed exclusively for Opposer and were not genuine specimens depicting the mark as used by Applicant on or in connection with the goods in the application, and the statements contained therein to the contrary were false, were known to be false, were

material misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the SUPER X-TRA KASH mark.

108. Applicant would not have received allowance of the '397 Application but for the willful material misrepresentations in the declaration.

109. Opposer accordingly alleges that the '397 Application declaration that resulted in allowance of the '397 Application constituted fraud on the U.S. Patent and Trademark Office and, accordingly, the Board should refuse registration.

Grounds for Opposition to Applicant's '911 Application – THREE SISTERS

110. The allegations of paragraphs 1-109 are incorporated by reference as if stated in full herein.

Likelihood of Confusion

111. Applicant's THREE SISTERS trademark so resembles Opposer's THREE SISTERS trademark as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive purchasers as to the source of the goods, resulting in damage to Opposer.

112. Applicant's THREE SISTERS trademark so resembles Opposer's THREE SISTERS trademark as to be likely, when applied to the goods of Applicant, to deceive purchasers or potential purchasers of the parties' goods and services into believing that Applicant's goods emanate from, are licensed by, or are in some way directly or indirectly associated with, approved by, or sponsored by Opposer, resulting in damage to Opposer.

113. Accordingly, the Board should refuse registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

No Bona Fide Use

114. Applicant had no bona fide use of the mark THREE SISTERS in commerce when it filed the '911 Application as a trademark for Bingo cards and/or Bingo game playing equipment.

115. Accordingly, the Board should refuse registration under Section 1(a) and 1(c) of the Lanham Act, 15 U.S.C. § 1051(a), (c).

Not Rightful Owner

116. Opposer, not Applicant, is the rightful owner of the THREE SISTERS mark as used by Opposer in the course of providing services and as printed by Applicant on Bingo cards in the course of providing printing services for Opposer.

117. Accordingly, the Board should refuse registration under Section 1 of the Lanham Act, 15 U.S.C. § 1051.

Failure to Function as Mark

118. Applicant has not used THREE SISTERS as a trademark to designate the source of its Bingo cards and/or Bingo game playing equipment, because it was printed at Opposer's instructions to designate the source of Opposer's Bingo services.

119. Accordingly, the Board should refuse registration under Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1127.

Fraud

120. On information and belief, when the '911 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware of rights by others, namely Opposer, to use THREE SISTERS in a manner that would cause confusion or mistake, or to deceive, and the statements contained therein to the contrary were false, were known to be false, were material

misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the THREE SISTERS mark.

121. On information and belief, when the '911 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware that Applicant was not using the mark THREE SISTERS in commerce with the goods in the application and were aware that the submitted specimen was created for the purpose of submitting to the United States Patent and Trademark Office by altering Bingo cards printed exclusively for Opposer and were not genuine specimens depicting the mark as used by Applicant on or in connection with the goods in the application, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the THREE SISTERS mark.

122. Applicant would not have received allowance of the '911 Application but for the willful material misrepresentations in the declaration.

123. Opposer accordingly alleges that the '911 Application declaration that resulted in allowance of the '911 Application constituted fraud on the U.S. Patent and Trademark Office and, accordingly, the Board should refuse registration.

Grounds for Opposition to Applicant's '338 Application – BINGO OR BETTER

124. The allegations of paragraphs 1-123 are incorporated by reference as if stated in full herein.

Likelihood of Confusion

125. Applicant's BINGO OR BETTER trademark so resembles Opposer's BINGO OR BETTER trademark as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive purchasers as to the source of the goods, resulting in damage to Opposer.

126. Applicant's BINGO OR BETTER trademark so resembles Opposer's BINGO OR BETTER trademark as to be likely, when applied to the goods of Applicant, to deceive purchasers or potential purchasers of the parties' goods and services into believing that Applicant's goods emanate from, are licensed by, or are in some way directly or indirectly associated with, approved by, or sponsored by Opposer, resulting in damage to Opposer.

127. Accordingly, the Board should refuse registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

No Bona Fide Use

128. Applicant had no bona fide use of the mark BINGO OR BETTER in commerce when it filed the '338 Application as a trademark for Bingo cards and/or Bingo game playing equipment.

129. Accordingly, the Board should refuse registration under Section 1(a) and 1(c) of the Lanham Act, 15 U.S.C. § 1051(a), (c).

Not Rightful Owner

130. Opposer, not Applicant, is the rightful owner of the BINGO OR BETTER mark as used by Opposer in the course of providing services and as printed by Applicant on Bingo cards in the course of providing printing services for Opposer.

131. Accordingly, the Board should refuse registration under Section 1 of the Lanham Act, 15 U.S.C. § 1051.

Failure to Function as Mark

132. Applicant has not used BINGO OR BETTER as a trademark to designate the source of its Bingo cards and/or Bingo game playing equipment, because it was printed at Opposer's instructions to designate the source of Opposer's Bingo services.

133. Accordingly, the Board should refuse registration under Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1127.

Fraud

134. On information and belief, when the '338 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware of rights by others, namely Opposer, to use BINGO OR BETTER in a manner that would cause confusion or mistake, or to deceive, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the BINGO OR BETTER mark.

135. On information and belief, when the '338 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware that Applicant was not using the mark BINGO OR BETTER in commerce with the goods in the application and were aware that the submitted specimen was created for the purpose of submitting to the United States Patent and Trademark Office and were not genuine specimens depicting the mark as used by Applicant on or in connection with the goods in the application, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for

the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the BINGO OR BETTER mark.

136. Applicant would not have received allowance of the '338 Application but for the willful material misrepresentations in the declaration.

137. Opposer accordingly alleges that the '338 Application declaration that resulted in allowance of the '338 Application constituted fraud on the U.S. Patent and Trademark Office and, accordingly, the Board should refuse registration.

Grounds for Opposition to Applicant's '357 Application – JUMBO7

138. The allegations of paragraphs 1-137 are incorporated by reference as if stated in full herein.

No Bona Fide Use

139. Applicant had no bona fide use of the mark JUMBO7 in commerce when it filed the '357 Application as a trademark for Bingo cards and/or Bingo game playing equipment.

140. Accordingly, the Board should refuse registration under Section 1(a) and 1(c) of the Lanham Act, 15 U.S.C. § 1051(a), (c).

Not Rightful Owner

141. Opposer, not Applicant, is the rightful owner of the JUMBO7 mark as used by Opposer in the course of providing services and as printed by Applicant on Bingo cards in the course of providing printing services for Opposer.

142. Accordingly, the Board should refuse registration under Section 1 of the Lanham Act, 15 U.S.C. § 1051.

Failure to Function as Mark

143. Applicant has not used JUMBO7 as a trademark to designate the source of its Bingo cards and/or Bingo game playing equipment.

144. Accordingly, the Board should refuse registration under Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1127.

Fraud

145. On information and belief, when the '357 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware that Applicant was not using the mark JUMBO7 in commerce with the goods in the application and were aware that the submitted specimen was created for the purpose of submitting to the United States Patent and Trademark Office by altering Bingo cards printed exclusively for Opposer and were not genuine specimens depicting the mark as used by Applicant on or in connection with the goods in the application, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the JUMBO7 mark.

146. Applicant would not have received allowance of the '357 Application but for the willful material misrepresentations in the declaration.

147. Opposer accordingly alleges that the '357 Application declaration that resulted in allowance of the '357 Application constituted fraud on the U.S. Patent and Trademark Office and, accordingly, the Board should refuse registration.

Grounds for Opposition to Applicant's '380 Application – PLANETDOWNS

148. The allegations of paragraphs 1-147 are incorporated by reference as if stated in full herein.

No Bona Fide Use

149. Applicant had no bona fide use of the mark PLANETDOWNS in commerce when it filed the '380 Application as a trademark for Bingo cards and/or Bingo game playing equipment.

150. Accordingly, the Board should refuse registration under Section 1(a) and 1(c) of the Lanham Act, 15 U.S.C. § 1051(a), (c).

Not Rightful Owner

151. Opposer, not Applicant, is the rightful owner of the PLANETDOWNS mark to the extent Opposer claims ownership based on use of ONEIDA DOWNS in the course of providing services and as printed by Applicant on Bingo cards in the course of providing printing services for Opposer.

152. Accordingly, the Board should refuse registration under Section 1 of the Lanham Act, 15 U.S.C. § 1051.

Failure to Function as Mark

153. Applicant has not used PLANETDOWNS as a trademark to designate the source of its Bingo cards and/or Bingo game playing equipment.

154. Accordingly, the Board should refuse registration under Sections 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, 1127.

Fraud

155. On information and belief, when the '380 Application and declaration were filed, Applicant and its declarant Mr. Weiss were aware that Applicant was not using the mark PLANETDOWNS in commerce with the goods in the application and were aware that the submitted specimen was created for the purpose of submitting to the United States Patent and Trademark Office and were not genuine specimens depicting the mark as used by Applicant on or in connection with the goods in the application, and the statements contained therein to the contrary were false, were known to be false, were material misrepresentations of fact, and were made for the purpose of obtaining rights to which Applicant was not entitled, and therefore were intended to deceive the U.S. Patent and Trademark Office when applying to register the PLANETDOWNS mark.

156. Applicant would not have received allowance of the '380 Application but for the willful material misrepresentations in the declaration.

157. Opposer accordingly alleges that the '380 Application declaration that resulted in allowance of the '380 Application constituted fraud on the U.S. Patent and Trademark Office and, accordingly, the Board should refuse registration.

WHEREFORE:

Opposer believes and avers that it is being damaged and will continue to be damaged by registration of the proposed SUPER X-TRA KASH trademark, and therefore prays that Applicant's Trademark Application No. 87/945,397 be rejected in accordance with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer believes and avers that it is being damaged and will continue to be damaged by registration of the proposed THREE SISTERS trademark, and therefore prays that Applicant's Trademark Application No. 88/036,911 be rejected in accordance with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer believes and avers that it is being damaged and will continue to be damaged by registration of the proposed BINGO OR BETTER trademark, and therefore prays that Applicant's Trademark Application No. 87/945,338 be rejected in accordance with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer believes and avers that it is being damaged and will continue to be damaged by registration of the proposed JUMBO7 trademark, and therefore prays that Applicant's Trademark Application No. 87/945,357 be rejected in accordance with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer believes and avers that it is being damaged and will continue to be damaged by registration of the proposed PLANETDOWNS trademark, and therefore prays that Applicant's Trademark Application No. 87/945,380 be rejected in accordance with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

The required fee is submitted herewith; however, please charge any additional fees that may be due in this opposition proceeding or credit any overpayments to Deposit Account No. 01.2000.

Respectfully submitted,

Date: December 28, 2018

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