

ESTTA Tracking number: **ESTTA350872**

Filing date: **06/03/2010**

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	Las Vegas Convention and Visitors Authority		
Entity	State Agency	Citizenship	Nevada
Address	3150 Paradise Road Las Vegas, NV 89109 UNITED STATES		

Attorney information	Kelley L. Nyquist Brownstein Hyatt Farber Schreck LLP 100 N. City Parkway, Suite 1600 Las Vegas, NV 89106 UNITED STATES lvpto@bhfs.com, knyquist@bhfs.com, jobermeyer@bhfs.com Phone:7023822101		
----------------------	---	--	--

Applicant Information

Application No	77373815	Publication date	06/01/2010
Opposition Filing Date	06/03/2010	Opposition Period Ends	07/01/2010
Applicant	DiBello, Brad 1560 Best Rd Rensselaer, NY 12144 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Advertising agencies

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3526119	Application Date	03/22/2004
Registration Date	11/04/2008	Foreign Priority Date	NONE
Word Mark	WHAT HAPPENS HERE STAYS HERE		

Design Mark	WHAT HAPPENS HERE STAYS HERE
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2002/12/00 First Use In Commerce: 2002/12/00 Advertising, public relations

U.S. Registration No.	3773529	Application Date	07/19/2004
Registration Date	04/06/2010	Foreign Priority Date	NONE

Word Mark	WHAT HAPPENS IN VEGAS STAYS IN VEGAS
Design Mark	WHAT HAPPENS IN VEGAS STAYS IN VEGAS
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2009/10/28 First Use In Commerce: 2009/10/28 ENTERTAINMENT SERVICES, NAMELY, ELECTRONIC GAMING INCLUDING SLOT MACHINE SERVICES

U.S. Registration No.	3613861	Application Date	04/07/2005
Registration Date	04/28/2009	Foreign Priority Date	NONE

Word Mark	WHAT HAPPENS HERE STAYS HERE
Design Mark	What Happens Here Stays Here
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2009/02/23 First Use In Commerce: 2009/02/23

	Gaming Machines		
U.S. Registration No.	3624680	Application Date	04/07/2005
Registration Date	05/19/2009	Foreign Priority Date	NONE
Word Mark	WHAT HAPPENS HERE STAYS HERE		
Design Mark	<p style="text-align: center;">What Happens Here Stays Here</p>		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Gaming Tables		

U.S. Registration No.	3735301	Application Date	04/07/2005
Registration Date	01/05/2010	Foreign Priority Date	NONE
Word Mark	WHAT HAPPENS IN VEGAS STAYS IN VEGAS		
Design Mark	<p style="text-align: center;">What Happens in Vegas Stays in Vegas</p>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2009/10/28 First Use In Commerce: 2009/10/28 Gaming Machines		

U.S. Registration No.	3743356	Application Date	04/07/2005
Registration Date	01/26/2010	Foreign Priority Date	NONE
Word Mark	WHAT HAPPENS IN VEGAS, STAYS IN VEGAS.		

Design Mark	WHAT HAPPENS IN VEGAS, STAYS IN VEGAS.
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 2009/10/25 First Use In Commerce: 2009/10/25 Gaming Tables

U.S. Registration No.	3668099	Application Date	12/06/2006
Registration Date	08/18/2009	Foreign Priority Date	NONE
Word Mark	WHAT HAPPENS HERE, STAYS HERE.		
Design Mark	WHAT HAPPENS HERE, STAYS HERE.		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/12/00 First Use In Commerce: 2002/12/00 Promoting the Las Vegas, Nevada area as a destination for leisure and business travelers		

U.S. Application No.	77370150	Application Date	01/11/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WHAT HAPPENS IN VEGAS STAYS IN VEGAS		
Design Mark	WHAT HAPPENS IN VEGAS STAYS IN VEGAS		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2010/01/01 First Use In Commerce: 2010/01/01 Promoting the Las Vegas, Nevada area as a destination for leisure and business		

	travelers
--	-----------

Attachments	76582191#TMSN.gif (1 page)(bytes) 78452892#TMSN.jpeg (1 page)(bytes) 78604224#TMSN.jpeg (1 page)(bytes) 78604239#TMSN.jpeg (1 page)(bytes) 78604249#TMSN.jpeg (1 page)(bytes) 78604257#TMSN.gif (1 page)(bytes) 77058510#TMSN.jpeg (1 page)(bytes) 77370150#TMSN.jpeg (1 page)(bytes) Notice of Opposition (DiBello - 77373815).pdf (8 pages)(261169 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kelley L. Nyquist/
Name	Kelley L. Nyquist
Date	06/03/2010

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

In the Matter of the Trademark Application Serial No. 77/373,815
For Trademark: WHAT HAPPENS HERE NEVER HAPPENED
Published in the Official Gazette on June 1, 2010

Las Vegas Convention and
Visitors Authority,
Opposer,

v.

Brad DiBello,
Applicant.

OPPOSITION NO. _____

NOTICE OF OPPOSITION

Las Vegas Convention and Visitors Authority ("LVCVA"), a Nevada government agency having its principal place of business at 3150 Paradise Road, Las Vegas, Nevada 89109, believes it will be damaged by the registration of U.S. Trademark Application Serial No. 77/373,815 for the mark WHAT HAPPENS HERE NEVER HAPPENED in International Class 35 for "advertising agencies," filed by Brad DiBello on January 17, 2008, and published for opposition in the Official Gazette on June 1, 2010. As grounds for the opposition, LVCVA alleges the following:

A. LVCVA and its Trademarks

1. LVCVA owns the trademark WHAT HAPPENS HERE, STAYS HERE. ("WHHSH Mark"). LVCVA began using the WHHSH Mark in commerce nationwide in December 2002 in conjunction with, among other things, the promotion of Las Vegas as a travel destination.

2. Since its first appearance on television in 2002, the WHHSH Mark and its connection to Las Vegas tourism has become widely known throughout the country.

3. Because of LVCVA's aggressive marketing campaign incorporating the WHHSH Mark, the WHHSH Mark has grown in national consumer recognition since 2002, especially via television commercials. By the end of 2004, commercials that included the WHHSH Mark had been aired 9,750 times on U.S. network and cable television stations. The advertisements ran during prime time on U.S. networks before a total of approximately 1,045,010,000 views by viewers. On the 21 national channels of cable television, the ads reached a total of about 1,978,220,000 views by viewers. In addition, the ads were broadcast on local network and cable affiliates in major markets nationwide including Chicago, New York, Dallas, Houston, Los Angeles, San Diego, San Francisco, and others.

4. LVCVA has also run full-page print ads, which used the WHHSH Mark prominently in nationally distributed magazines such as *People*, *Entertainment Weekly*, *Sports Illustrated*, *Vanity Fair*, *Elle*, *MAXIM*, and *Golf Magazine*. An estimated total of about 153,907,000 people viewed these advertisements.

5. As of December 2007, LVCVA had spent over \$135 million in connection with the marketing of the WHHSH Mark, which has become indelibly linked to Las Vegas tourism.

6. In the wake of LVCVA's tremendously successful marketing campaign establishing Las Vegas as a top tourist destination, LVCVA adopted a natural variation of the WHHSH mark, namely, WHAT HAPPENS IN VEGAS STAYS IN VEGAS ("WHVSV Mark").

7. Presently, LVCVA continues to use both the WHHSH and WHVSV Marks prominently in its promotion of Las Vegas tourism.

8. Because of LVCVA's significant investment in the WHHSH and WHVSV Marks, the WHHSH and WHVSV Marks have acquired fame, distinctiveness and tremendous goodwill in the United States.

9. On March 22, 2004, LVCVA's predecessor in interest filed an application with the U.S. Patent and Trademark Office ("USPTO") for the WHHSH Mark in International Class 35 for "advertising, public relations" (U.S. Ser. No. 76/582,191). That application, and the entire interest in and goodwill associated with the WHHSH Mark, was assigned to LVCVA on November 15, 2006. A registration issued to LVCVA on November 4, 2008.

10. On July 19, 2004, LVCVA's predecessor in interest filed an application for the WHVSV Mark with the USPTO in International Class 41 for "entertainment services, namely, electronic gaming including slot machine services" (U.S. Ser. No. 78/452,892). That application, and the entire interest in and goodwill associated with the WHVSV Mark, was assigned to LVCVA on February 22, 2008. A registration issued to LVCVA on April 6, 2010.

11. On April 7, 2005, LVCVA's predecessor in interest filed an application with the USPTO for the WHHSH Mark in International Class 9 for "gaming machines" (U.S. Ser. No. 78/604,224). That application, and the entire interest in and goodwill associated the WHHSH Mark, was assigned to LVCVA on February 22, 2008. A registration issued to LVCVA on April 28, 2009.

12. On April 7, 2005, LVCVA's predecessor in interest filed an application with the USPTO for the WHHSH Mark in International Class 28 for "gaming tables" (U.S. Ser. No. 78/604,239). That application, and the entire interest in and goodwill associated with the WHHSH Mark, was assigned to LVCVA on February 22, 2008. A registration issued to LVCVA on May 19, 2009.

13. On April 7, 2005, LVCVA's predecessor in interest filed an application for the WHVSV Mark with the USPTO in International Class 9 for use in connection with "gaming machines" (U.S. Ser. No. 78/604,249). That application, and the entire interest in and goodwill associated with the WHVSV Mark, was assigned to LVCVA on February 22, 2008. A registration issued to LVCVA on January 5, 2010.

14. On April 7, 2005, LVCVA's predecessor in interest filed an application for the WHVSV Mark with the USPTO in International Class 28 for use in connection with "gaming tables" (U.S. Ser. No. 78/604,257). That application, and the entire interest in and goodwill associated with the WHVSV Mark, was assigned to LVCVA on February 22, 2008. A registration issued to LVCVA on January 26, 2010.

15. On December 6, 2006, LVCVA filed an application for the WHHSH Mark with the USPTO in International Class 35 for use in connection with "promoting the Las Vegas, Nevada area as a destination for leisure and business travelers" (U.S. Ser. No. 77/058,510). A registration issued to LVCVA on August 18, 2009.

16. In addition to the foregoing registrations, LVCVA owns a pending federal application for the WHVSV Mark in International Class 35 for "promoting the Las Vegas, Nevada area as a destination for leisure and business travelers" (U.S. Ser. No.

77/370,150). This mark has been allowed for registration by the USPTO and is set to register in due course.

B. DiBello and His Trademark

17. Brad DiBello ("DiBello"), an individual residing at 1560 Best Road, Rensselaer, NY 12144, seeks to register the trademark WHAT HAPPENS HERE NEVER HAPPENED ("NEVER HAPPENED Mark") (U.S. Serial No. 77/373,815) for "advertising agencies," in International Class 35.

18. Upon information and belief, DiBello is deliberately seeking to profit from the goodwill and popularity of LVCVA's WHHSH and WHVSV Marks.

19. DiBello filed the opposed federal trademark application for the NEVER HAPPENED Mark on January 17, 2008, well after LVCVA's rights in the WHHSH and WHVSV Marks first arose in 2002.

20. DiBello's application for the NEVER HAPPENED Mark published for opposition on June 1, 2010.

C. LVCVA's Claim for Trademark Infringement

21. The services for which DiBello seeks registration of the NEVER HAPPENED Mark are competitive, complementary, and/or related to the goods and services offered by LVCVA under its WHHSH and WHVSV Marks.

22. The services described in the opposed application for the NEVER HAPPENED Mark and LVCVA's goods and services are marketed and sold in the same or similar channels of trade, and are purchased by the same or similar general classes of customers.

23. DiBello's NEVER HAPPENED Mark is similar to LVCVA's WHHSH and WHVSV Marks.

24. In light of the fact that LVCVA is the senior user; that DiBello's NEVER HAPPENED Mark is similar to LVCVA's WHHSH and WHVSV Marks; that the services for which DiBello seeks to register the NEVER HAPPENED Mark are competitive, complementary and/or related to LVCVA's goods and services; and that the channels of trade and customer base for LVCVA's goods and services and DiBello's services appear to be the same or overlapping; DiBello's NEVER HAPPENED Mark is likely to cause confusion, or to cause mistake, or to deceive consumers.

25. In view of the similarities between DiBello's NEVER HAPPENED Mark and LVCVA's WHHSH and WHVSV Marks, and the similarity of the uses thereof, DiBello's proposed mark consists of and comprises matter which falsely suggests a connection with LVCVA and therefore damages LVCVA.

D. LVCVA's Claim for Trademark Dilution

26. LVCVA's WHHSH and WHVSV Marks are famous. As a result of extensive use in interstate commerce in the United States and throughout the world, the public has come to associate goods and services bearing the WHHSH and WHVSV Marks with LVCVA alone.

27. Without LVCVA's consent, and after the WHHSH and WHVSV Marks became famous, DiBello plans to deliberately and willfully use in interstate commerce the NEVER HAPPENED Mark in connection with the identification and advertising of his business and the sale, and/or offering for sale and/or distribution of goods and services.

28. DiBello's use of the NEVER HAPPENED Mark in association with services over which LVCVA has no control will cause the WHHSH and WHVSV Marks to suffer negative associations and will undermine their capacity to identify and distinguish LVCVA's services.

29. DiBello willfully intends to trade on LVCVA's reputation and/or to cause dilution of the WHHSH and WHVSV Marks. As a result, DiBello's NEVER HAPPENED Mark also wrongfully dilutes and harms LVCVA's WHHSH and WHVSV Marks.

E. Conclusion

30. Because LVCVA's trademark rights are prior and senior to DiBello's rights in his mark, and a likelihood of confusion exists between these marks, and because DiBello's NEVER HAPPENED Mark will dilute the WHHSH and WHVSV Marks, the application to register DiBello's NEVER HAPPENED Mark should be denied.

WHEREFORE, LVCVA prays that DiBello's USPTO application (U.S. Serial No. 77/373,815) for the mark WHAT HAPPENED HERE NEVER HAPPENED be rejected, that no registration be issued thereon to DiBello, and that this opposition be sustained in favor of LVCVA.

Respectfully submitted,

Dated: June 3, 2010

By: /Kelley L. Nyquist/
Jason D. Firth
Kelley L. Nyquist
Erin E. Lewis
Brownstein Hyatt Farber Schreck, LLP
100 City Parkway
Suite 1600
Las Vegas, Nevada 89106-4614

Attorneys for Opposer
Las Vegas Convention and Visitors
Authority

Certificate of Service

I, Julie Obermeyer, hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Brad DiBello via first class mail on June 3, 2010 to:

Brad DiBello
1560 Best Road
Rensselaer, NY 12144

A handwritten signature in black ink, appearing to read "Julie Obermeyer", written over a horizontal line.

Julie Obermeyer, Paralegal
Brownstein Hyatt Farber Schreck, LLP
100 City Parkway, Ste 1600
Las Vegas, Nevada 89106