

ESTTA Tracking number: **ESTTA390328**

Filing date: **01/26/2011**

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	Ameristar Casinos, Inc.
Granted to Date of previous extension	01/26/2011
Address	3773 Howard Hughes Parkway, Suite 490S Las Vegas, NV 89109 UNITED STATES
Attorney information	Lester K. Essig Ray Quinney & Nebeker P.C. 36 South State Street, Suite 1400 Salt Lake City, UT 84111 UNITED STATES lessig@rqn.com

### Applicant Information

Application No	77783874	Publication date	09/28/2010
Opposition Filing Date	01/26/2011	Opposition Period Ends	01/26/2011
International Registration No.	NONE	International Registration Date	NONE
Applicant	Groupe AmÃ©rispa Inc. 345, 120e rue #1 Shawinigan-Sud, Quebec, G9P3J8 CANADA		

### Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Body and beauty care cosmetics
Class 044. All goods and services in the class are opposed, namely: Health and beauty spa services, namely, providing massage, facial and body treatment services, cosmetic body care services

### Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
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.	2687230	Application Date	01/30/2001
Registration Date	02/11/2003	Foreign Priority Date	NONE
Word Mark	GUTTER GRABBER		
Design Mark	<b>GUTTER GRABBER</b>		
Description of Mark	NONE		
Goods/Services	Class 008. First use: First Use: 2001/09/01 First Use In Commerce: 2001/09/01 gutter-cleaning hand tool		

U.S. Registration No.	2697230	Application Date	06/28/2001
Registration Date	03/18/2003	Foreign Priority Date	NONE
Word Mark	AMERISTAR		
Design Mark	AMERISTAR		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1996/11/25 First Use In Commerce: 1996/11/25 Retail gift shop services</p> <p>Class 041. First use: First Use: 1994/02/27 First Use In Commerce: 1994/02/27 Casino services; gambling services; and entertainment services, namely providing and presenting stage show, band, vocal, instrumental, music, dance and comic performances</p> <p>Class 042. First use: First Use: 1994/02/27 First Use In Commerce: 1994/02/27 Resort hotel services; hotel services; lodging services; hotel concierge services; restaurant services; snack bar services; bar services; night club services; and providing banquet and social function facilities for special occasions</p>		

Attachments	76203149#TMSN.gif ( 1 page )( bytes ) 76277911#TMSN.gif ( 1 page )( bytes ) oppos.pdf ( 12 pages )(1073060 bytes )
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## 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	/Lester K. Essig/
Name	Lester K. Essig
Date	01/26/2011

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

AMERISTAR CASINOS, INC.,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
vs.	)	
	)	
GROUPE AMERISPA INC.,	)	Mark: AMERISPA
	)	Application Serial No.: 77/783,874
	)	Filed: July 17, 2009
Applicant.	)	Published: September 28, 2010
	)	

**NOTICE OF OPPOSITION**

Ameristar Casinos, Inc., a Nevada corporation doing business at 3773 Howard Hughes Parkway, Suite 490S, Las Vegas, Nevada 89109 (hereinafter "Opposer"), believes that it will be damaged by registration of the mark AMERISPA shown in application Serial No. 77/783,874, filed on an intent to use basis under Section 1B and based on a prior Canadian registration under Section 44E, for use in connection with "[h]ealth and beauty spa services, namely, providing massage, facial and body treatment services, [and] cosmetic body care services" in International Class 44 and "[b]ody and beauty care cosmetics" in International Class 3 by Groupe Amerispa Inc. (hereinafter "Applicant"), and hereby opposes the same. Said mark was published in the Official Gazette on September 28, 2010, with a request to extend the time to oppose filed and granted thereafter, giving Opposer until January 26, 2011, in which to file a Notice of Opposition.

As grounds for opposition, it is alleged that:

1. Opposer is owner of the service marks and trademarks AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, ARA SPA and other similar marks. As owner, Opposer has licensed use of the marks to its wholly owned subsidiaries, including, without limitation, Ameristar Casino Vicksburg, Inc., Ameristar Casino Council Bluffs, Inc., Ameristar Casino Kansas City, Inc., Ameristar Casino St. Charles, Inc., Ameristar Casino Black Hawk, Inc. and Ameristar Casino East Chicago, LLC (said subsidiaries are hereinafter sometimes collectively referred to as "Subsidiaries"). The Subsidiaries are in privity with Opposer. Opposer has retained control over the nature and quality of services and goods offered by the Subsidiaries in connection with the marks.

2. Opposer, through its Subsidiaries, is and has been actively engaged in offering health and beauty spa services, including without limitation, providing massage, facial and body treatment services, cosmetic body care services, and body and beauty care cosmetics, as well as other spa and day spa services, including, without limitation, hydrotherapy, facials, manicures, pedicures, beauty care services, beauty care for the face and body, sauna, steam room, hot tub, bath and whirlpool bath facilities, providing information in the foregoing fields, as well as hotel services, lodging services, and related services and goods, at many locations in the United States.

3. Based on information and belief, Applicant is or will be engaged in offering health and beauty spa services, namely, providing massage, facial and body treatment services, and cosmetic body care services, as well as body and beauty care cosmetics.

4. Opposer, through its Subsidiaries, has acquired extensive common law rights in the service marks AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, ARA SPA and other similar marks, and is the exclusive owner of said marks. Opposer, through its Subsidiaries, has actively and continuously used the AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, AMERISTAR CASINO HOTEL and ARA SPA marks in the United States since on or before 2008 through the present in connection with health and beauty spa services, including without limitation, providing massage, facial and body treatment services, cosmetic body care services, and body and beauty care cosmetics, as well as other spa and day spa services, has actively and continuously used the AMERISTAR and AMERISTAR CASINO marks with resort hotel, hotel and lodging services since on or before 1994, and has actively and continuously used the AMERISTAR CASINO HOTEL mark with resort hotel, hotel and lodging services since on or before 1996. Opposer's use of its marks directly and/or through its Subsidiaries extends to all fifty states and beyond.

5. Based on information and belief, Applicant has no common law rights in its mark in the United States. Applicant's application for the mark AMERISPA was submitted under 15 U.S.C. § 1051(b) on an "intent to use" basis, and under Section 44E, with no Amendment to Allege Use or Statement of Use filed to date, and no other filings evidencing use in the United States to date, to the best of Opposer's knowledge. Based on information and belief, Applicant has yet to submit any evidence that it has used the AMERISPA mark in commerce in the United States. Even if it has used the mark, its use is presumably recent and limited geographically, with

such use constituting infringement of Opposer's mark. Applicant's application for and use of the AMERISPA mark are without Opposer's consent.

6. Opposer has acquired registration rights with the United States Patent and Trademark Office for the service mark AMERISTAR in typed drawing form on the Principal Register in, among others, International Class 42 in connection with "resort hotel services; hotel services; lodging services; hotel concierge services; restaurant services; snack bar services; bar services; night club services; and providing banquet and social function facilities for special occasions." The mark is identified as registration No. 2,697,230. Opposer has acquired registration rights with the United States Patent and Trademark Office for the service mark AMERISTAR CASINO in typed drawing form on the Principal Register in, among others, International Class 42 in connection with "resort hotels, hotels, and making reservations and booking for temporary lodging." The mark is identified as registration No. 2,132,916.

7. Opposer has acquired registration rights with the United States Patent and Trademark Office for the service mark ARA SPA in typed drawing form on the Principal Register in International Class 42 in connection with "health spa and day spa services offered as part of a casino establishment, namely, hydrotherapy, facials, manicures, pedicures, beauty care services, and beauty care for the face and body; providing health and day spa, sauna, steam room, hot tub, bath and whirlpool bath facilities as part of a casino establishment; and providing information as part of a casino establishment in the fields of hydrotherapy, facials, manicures, pedicures, beauty care services and beauty care for the face and body." The mark is identified as registration No. 3,699,609.

8. Based on information and belief, Applicant has no registration rights for the AMERISPA mark with the United States Patent and Trademark Office. Applicant's only application for said mark in the United States is the subject of the current opposition proceeding, namely an application seeking registration of the mark AMERISPA in stylized form in International Class Nos. 3 and 44 in connection with "[b]ody and beauty care cosmetics" and "[h]ealth and beauty spa services, namely, providing massage, facial and body treatment services, cosmetic body care services." The application, identified as No. 77/783,874, was filed on July 17, 2009.

9. There is no issue as to priority, with first use by Opposer, acting through its Subsidiaries, substantially predating Applicant's application filing date or first use. Opposer, acting through its subsidiaries, first used its AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, AMERISTAR CASINO HOTEL and ARA SPA marks in commerce and interstate commerce in connection with health and beauty spa services, and retail sale of body and beauty care cosmetics on or before 2008. Opposer, acting through its subsidiaries, first used its AMERISTAR and AMERISTAR CASINO marks in commerce and interstate commerce with hotel and other services on or before February 27, 1994,. Opposer, acting through its Subsidiaries, first used its AMERISTAR CASINO HOTEL mark in commerce and interstate commerce with hotel and other services on or before November 3, 1996. Based on information and belief, Applicant has never used its proposed AMERISPA mark in commerce or interstate commerce in the United States, or has not used such mark earlier than July 17, 2009. Opposer's first use predates Applicant's first use, making Opposer the prior user of its marks in the United States.

10. Opposer has developed substantial goodwill, a most valuable reputation, and a large and profitable national business identified by its AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, AMERISTAR CASINO HOTEL and ARA SPA marks. Customers, the general public and others throughout the United States have come to know, rely upon, and recognize Opposer's health and beauty spa services and retail sale of body and beauty care products, resort hotel services, hotel services and related services, by its marks.

11. Opposer has expended significant money, effort, and personnel resources over a period of years advertising, promoting, and selling its services and goods in connection with its marks and developing a reputation for excellence in connection with its health and beauty spa services and retail sale of body and beauty care products, resort hotel services, hotel services and related services, at many locations in the United States.

12. The trademark Applicant proposes to register is very similar to Opposer's AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, AMERISTAR CASINO HOTEL and ARA SPA marks. Applicant's proposed AMERISPA mark is variously similar in appearance, sound, meaning and commercial impression to Opposer's marks. Applicant's mark consists of the dominant portion of Opposer's AMERISTAR, AMERISTAR CASINO, and AMERISTAR CASINO HOTEL marks, namely the identical first three syllables and the first letter of the fourth syllable. Applicant's mark also consists of Opposer's ARA SPA mark, adding only an additional syllable, namely an unstressed syllable.

13. Applicant's services offered with its mark as set forth in its application for registration are related to Opposer's services as offered through its Subsidiaries. Applicant's application covers "[b]ody and beauty care cosmetics" and "[h]ealth and beauty spa services, namely, providing massage, facial and body treatment services, cosmetic body care services" and are offered at or through hotels and resort hotels. Opposer's health and beauty spa services as well, including massage, facial and body treatment services, cosmetic body care services, and retail sale of body and beauty care cosmetics, that are the same or closely related to Applicant's services. Customers of Opposer's services, or similar services provided by other third parties, are likely to believe that Applicant's services, also provided in connection with hotels and resort hotels, originate from and/or are approved by Opposer, resulting in confusion, deception, and mistake. Alternatively, the public would readily expect that Opposer may expand its services to include Applicant's services.

14. The types of trade channels, advertising venues, and customers of the parties are similar or otherwise overlapping. Opposer advertises through the internet, direct mail, brochures, and other printed materials in connection with its mark. Based on information and belief, Applicant also promotes its goods through many of the same trade channels and advertising venues in connection with its mark. In this regard, Opposer, either directly or through its Subsidiaries, advertises in all fifty states in the United States. Moreover, for purposes of this opposition proceeding, the parties are deemed to operate in immediate geographic proximity. *See, e.g., In re Appetito Provisions Co.*, 3 U.S.P.Q. 2d 1553, 1554 n.4 (TTAB 1987); J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:78, at 23-168.2 (4<sup>th</sup> ed. 1999). Moreover, even if advertising venues were to differ, the same type of end-user customers will

view the respective marks, namely those interested in health and beauty spa services, and related services. Furthermore, the fame of Opposer's marks after their long period of extensive and exclusive use, and Opposer's extensive and exclusive common law rights, further demonstrates likelihood of confusion, damaging Opposer's rights and interests.

15. The highly similar nature of Applicant's AMERISPA mark, and the related nature of Applicant's services, trade channels, advertising venues, customers, and other factors, as set forth above, to those of Opposer, as offered through its Subsidiaries, will be likely to cause confusion, or to cause mistake, or to deceive. Confusion, mistake, and/or deception as to the source or origin of the goods and services, and the ownership, affiliation, and related party status of each business, among customers, potential customers, the general public, and the business community, is likely. Many familiar with Opposer's marks, as used with health and beauty spa services, and retail sale of body and beauty care cosmetics, as well as resort hotel services, hotel services, and related services and goods, will be likely to conclude that Applicant's body and beauty care cosmetics, and health and beauty spa services, namely providing massage, facial, and body treatment services, and cosmetic body care services, particularly as they are advertised to resort hotel, hotel, and lodging customers, are provided by or originate from Opposer. Even if some should notice a difference between Opposer's marks and Applicant's mark, they will nevertheless be likely to believe that Opposer's marks and Applicant's mark are companion marks, originating from the same source or origin. Confusion will increase as Applicant begins and/or expands sales of its goods and use of its mark in interstate commerce. The resulting confusion, mistake, and/or deception will be to the detriment of Opposer and its Subsidiaries as the prior users of Opposer's marks.

16. Approval of Applicant's application for registration and use of Applicant's mark would further constitute a false designation of origin and a false and misleading representation of fact likely to cause confusion, mistake, or deception as to the affiliation, connection, or association of the parties, or as to the origin, sponsorship, or approval of Applicant's goods by Opposer directly and through Subsidiaries. *See* 15 U.S.C. § 1125(a).

17. Approval of Applicant's application for registration and use of Applicant's mark would further damage Opposer, directly and through Subsidiaries, because third parties, upon examining the registration, would reach incorrect conclusions regarding, and Applicant would be in a position to raise doubts as to, the extent and nature of Opposer's right to use its service marks and trademarks in connection with its services and goods, now and in the future, on its own behalf and through Subsidiaries.

18. Approval of Applicant's application for registration and use of Applicant's mark would eventually deprive Opposer's marks of distinctiveness, blurring identification of Opposer's marks with its services and goods and those of its Subsidiaries, and tarnishing Opposer's goodwill, value, and reputation as associated with its marks, directly and through Subsidiaries, through association with Applicant's mark, goods, and services. Adverse conditions, business failures, defects, or defaults on the part of Applicant's goods, services, or business would reflect upon and seriously injure Opposer's marks, reputation, and business, directly and through Subsidiaries.

19. If Applicant is granted the registration herein opposed, it will obtain a *prima facie* exclusive right to use its mark in commerce with its goods, its mark will likely be deemed incontestable five (5) years from the date of registration, and Applicant will thereby obtain an

incontestable right to use the mark in commerce. As a consequence, Opposer's common law rights will be greatly impaired, Applicant will be able to trade on Opposer's goodwill, substantial confusion, deception, and mistake will continue, and great damage and injury will result to Opposer as the prior user of the AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, AMERISTAR CASINO HOTEL and ARA SPA marks, on its own behalf and through its Subsidiaries.

20. Based on the foregoing, issuance of a federal registration by the United States Patent and Trademark Office for the AMERISPA mark to Applicant would be in violation of Opposer's rights to the AMERISTAR, AMERISTAR HOTEL & SPA, THE SPA AT AMERISTAR, AMERISTAR CASINO, AMERISTAR CASINO RESORT SPA, AMERISTAR CASINO HOTEL and ARA SPA marks, causing Opposer, as owner, and Subsidiaries, as related parties and licensees, substantial damage and injury.

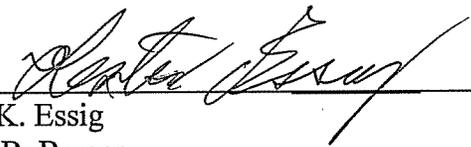
WHEREFORE, Opposer prays that the present opposition be sustained and that the registration sought by Applicant identified as Serial No. 77/783,874 be refused.

Please recognize Lester K. Essig and Arthur B. Berger, members of the Bar of the State of Utah, and the law firm of Ray Quinney & Nebeker, whose mailing address is 36 South State Street, Suite 1400, P.O. Box 45385, Salt Lake City, Utah 84145-0385, with telephone number (801) 532-1500, as attorneys for Opposer in the above-captioned opposition. Please address all correspondence to them.

DATED this 26th day of January, 2011.

Respectfully submitted,

AMERISTAR CASINOS, INC.

/s/ 

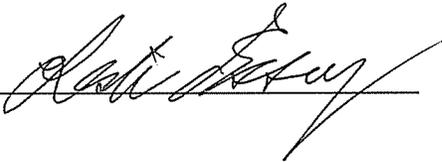
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*Attorneys for Opposer*

CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of January, 2011, a true and correct copy of the foregoing NOTICE OF OPPOSITION was mailed by first-class mail, postage prepaid, to the following:

Brent E. Routman  
Merchant & Gould P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910

/s/ 

1121504