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

Proceeding	91251601
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Date	08/31/2021
Attachments	American Motion for Leave to Amend.pdf(214138 bytes) Ex A - American First Amended Consolidated Notice of Opposition.pdf(224313 bytes) Ex B - Redline.pdf(193650 bytes)

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

AMERICAN AIRLINES, INC.,)	
)	Opposition No. 91251601
Opposer,)	U.S. Serial No. 88/417283
)	U.S. Serial No. 88/417301
)	
v.)	
)	
)	
HSP EPI ACQUISITION, LLC,)	
)	
Applicant.)	
)	
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)	
)	

**OPPOSER AMERICAN AIRLINES, INC.’S MOTION FOR LEAVE TO AMEND
CONSOLIDATED NOTICE OF OPPOSITION**

Pursuant to Rules 2.107 and 2.127 of the Trademark Rules of Practice, 37 C.F.R. §§ 2.107 and 2.127, Trademark Board Manual of Procedure (“TBMP”) §§ 315 and 507, and Rule 15(a) of the Federal Rules of Civil Procedure, Opposer American Airlines, Inc. (“American” or “Opposer”) respectfully moves the Board for leave to Amend its Consolidated Notice of Opposition against HSP EPI Acquisition, LLC (“HSP” or “Applicant”) to further clarify its allegations that Applicant is contractually estopped from applying for United States Application Serial Nos. 88/417283 and 88/417301, (collectively, the “Opposed Applications” or “Opposed Marks”) as well as to narrow the specific goods and services that Opposer is challenging.

More specifically, Opposer seeks leave to amend for the purpose of amplifying allegations made in its Consolidated Notice of Opposition (*see* Dkt. 1 ¶ 11) concerning the parties’ prior 1994 and 1996 Agreements (“Prior Agreements”) related to the AADVANTAGE Marks between Opposer, Applicant’s wholly-owned subsidiary, Entertainment Publications, Inc. (“Entertainment”), and Entertainment’s prior parent company, CUC International, Inc. Opposer

further seeks to limit this Opposition to the specific goods and services of the Opposed Marks that pertain to travel-related goods and services. Applicant opposes this Motion.

Pursuant to TBMP § 507.01, a signed copy of the proposed First Amended Notice of Consolidated Opposition is attached as Exhibit A, and a redlined copy of the First Amended Consolidated Notice of Opposition, showing the proposed changes from the original Consolidated Notice of Opposition, is attached as Exhibit B.

I. FACTUAL AND PROCEDURAL BACKGROUND

Applicant filed the Opposed Marks on May 6, 2019. These applications cover “Advertising and promotional services, namely, promoting the goods and services of others through the distribution of coupons, and discount offers which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities; Providing advertising service through the distribution of advertisements, coupons and discount offers for display on Internet, namely, in websites, e-mails and multimedia messages; Providing via on-line computer services a membership program entitling the participants to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities, and providing in connection therewith an on-line directory of information about the discount program and participating businesses” in Class 35, and further cover “Non-magnetically encoded printed coupon and discount cards all which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater, and other leisure activities sold separately or as part of a unit” in Class 16. Opposer timely filed a Consolidated Notice of Opposition against the Opposed Applications on October 10, 2019, requesting that such registrations be refused on the grounds of likelihood of confusion as well as Applicant’s express covenant not to use the Opposed Marks in connection with frequent

flyer miles or points or other travel-related offerings based on the parties' Prior Agreements. *See, e.g.,* Dkt. 1 ¶ 11. Specifically, Opposer alleged that pursuant to the parties' Prior Agreements, Applicant "expressly covenanted not to use or allow to be used DINING ADVANTAGE in association with the provision of frequent flyer miles or points." *Id.*

Based on the same Prior Agreements, Applicant asserted the affirmative defense equitable doctrine of estoppel in its Answer:

Based upon a series of prior agreements related to the AADVANTAGE Marks between Opposer and Applicant; Opposer's February 7, 2000 application for registration of 'AAdvantage Dining' mark, Serial No. 75/911,404 with the USPTO and the USPTO subsequent denial of the application on the ground that it would likely be confused with prior Entertainment dining advantage marks (Entertainment prior U.S. Registration Number(s) 1608460 and 4286631) ("Prior DA Marks"); and Opposer's 2003 Withdrawal with Prejudice of its Petition for Cancellation of Prior DA Marks, under the equitable doctrine of estoppel, Opposer is barred from taking this contradictory, inconsistent position.

See Dkt. 4 at 3 (Second Affirmative Defense). Following the parties' December 18, 2019 discovery and settlement conference, the Board issued an Order addressing Applicant's affirmative defenses. *See* Dkt. 8. With respect to Affirmative Defense No. 2, copied above, the Board stated that it was "unclear from Applicant's pleading whether it is attempting to assert equitable estoppel, contractual estoppel, or both." *Id.* at 8. The Board found that Applicant had not alleged facts sufficient to provide notice of the basis for the defense and held that "to the extent Applicant is attempting to assert the affirmative defense of contractual estoppel, the defense is **stricken**." *Id.* at 9. The Board further stated that it would afford Applicant the opportunity to re-plead the affirmative defenses of equitable estoppel and/or contractual estoppel assuming there were legal and factual bases for doing so. *Id.*

Applicant then filed its First Amended Affirmative Defenses on January 20, 2020. There, Applicant asserted the affirmative defenses of equitable and contractual estoppel. *See* Dkt. 9 ¶¶ 33-41. Applicant conceded that as part of the parties' Prior Agreements, it agreed not to use the mark AAdvantage Dining in connection with "frequent flyer miles or points, air travel rewards, upgrades or other air travel benefits." *Id.* ¶ 34.

On March 23, 2020, in light of the ongoing global pandemic and its reduction to a skeletal workforce, Opposer moved to suspend the proceeding. *See* Dkt. 10. Applicant did not consent to the Motion. On June 26, 2020, the Board retroactively suspended the proceeding for six months. *See* Dkt. 15. The proceeding resumed on September 23, 2020. *Id.* Applicant re-filed its Motion for Summary Judgment a few days later on September 29, 2020. *See* Dkt. 16. Opposer filed its Opposition to Applicant's Motion for Summary Judgment and its Cross-Motion for Summary Judgment on October 29, 2020. *See* Dkt. 17. Briefing on the parties' Cross-Motions for Summary Judgment was completed on December 3, 2020. *See* Dkts. 16-19. The Board issued an Order suspending the instant proceeding on August 3, 2021. *See* Dkt. 20.

II. LEGAL STANDARD

Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action. *See* 37 C.F.R. § 2.107; TBMP §§ 315 & 507. Federal Rule of Civil Procedure 15(a) provides that a party may amend its pleading by leave of court, which should be freely given when justice so requires. *See* FED. R. CIV. P. 15(a). Pursuant to the TBMP "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02; *see also, e.g., A&H Sportswear Co. v. Yedor*, No. 91235843, 2019 TTAB LEXIS 75, at *2-3 (TTAB Mar. 29, 2019); *Am. Univ. v. Van Niekerk*,

No. 92040938, 2003 TTAB LEXIS 586, at *3-4 (TTAB Dec. 15, 2003); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505-06 (TTAB 1993).

“The timing of the motion for leave to amend plays a large role in the Board’s determination of whether the adverse party would be prejudiced by allowance of the proposed amendment.” *See PRL USA Holdings, Inc. v. Young*, No. 91206799, 2013 TTAB LEXIS 551, at *3 (TTAB Oct. 16, 2013) (citing *U.S. Olympic Comm. v. O-M Bread Inc.*, 26 USPQ2d 1221, 1222 (TTAB 1993)).

In addition, “[o]ther amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this Rule.” *See* 37 C.F.R. § 2.107; TBMP § 507.01 (citing RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT, 68 Fed. Reg. 55748, 55757 (Sept. 26, 2003)). In the instant proceeding, entry of the proposed First Amended Consolidated Notice of Opposition would neither violate settled law nor be prejudicial to Applicant’s rights and would serve to further clarify Opposer’s allegations and grounds for opposition.

Finally, although this proceeding is currently suspended pending a decision on the parties’ Cross-Motions for Summary Judgment, the instant Motion is germane to those Motions because it clarifies Opposer’s allegations and narrows the Opposition to the specific goods and services of the Opposed Marks pertaining to travel-related goods and services. *See* TBMP § 528.03; *U.S. Olympic Comm. v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221, 1223 (TTAB 1993) (granting motion to amend and finding motion “germane to applicant’s motion for summary judgment”); *Jimmy Buffett v. Chi-Chi’s, Inc.*, No. 68,462, 1985 TTAB LEXIS 80, at *11 n.8 (TTAB June 13, 1985) (same).

III. ARGUMENT

a. Justice Requires that Opposer's Motion for Leave to Amend its Consolidated Notice of Opposition be Granted

Motions for leave to clarify allegations and claims at issue have routinely been granted under Federal Rule of Civil Procedure 15. *See, e.g., Tequila Cazadores, S.A. de C.V. v. Tequila Centinela, S.A. de C.V.*, No. 91125436, 2004 TTAB LEXIS 109, at *5-7 (TTAB Feb. 24, 2004) (granting leave to amend notice of opposition in order to amplify and clarify allegations); *Guardian Life Ins. Co. of Am. v. Gordian Health Sols., Inc.*, No. 111,017, 2001 TTAB LEXIS 60, at *2-5 (TTAB Jan. 30, 2001) (granting Opposer's motion to amend its pleading to "clarify the record"); *Alvin v. Suzuki*, 227 F.3d 107, 121 (3d Cir. 2000) (finding district court abused its discretion in denying leave to amend where plaintiff sought to amend complaint to clarify the basis of plaintiff's claim); *Greenberg v. Life Ins. Co.*, 177 F.3d 507, 522 (6th Cir. 1999) (finding the district court erred when it denied plaintiff's motion to amend its complaint for the purpose of articulating plaintiff's legal theory with greater clarity); *Estate of Gaither v. District of Columbia*, 272 F.R.D. 248, 252 (D.D.C. 2011) (citing *Harrison v. Rubin*, 174 F.3d 249, 253 (D.C. Cir. 1999) (granting motion to amend complaint to clarify legal theories and explaining that the "proposed amendment would merely clarify the theories upon which [plaintiff] relies without expanding or otherwise altering the scope of this action in any meaningful manner"). Further, "courts generally consider the relation of the proposed amended complaint to the original complaint, favoring proposed complaints that do not 'radically alter the scope and nature of the case.'" *Sodexo Operations, LLC v. Not-For-Profit Hosp. Corp.*, 210 F. Supp. 3d 138, 143 (D.D.C. 2016) (citing *Smith v. Café Asia*, 598 F. Supp. 2d 45, 48 (D.D.C. 2009)); *see also Estate of Gaither*, 272 F.R.D. at 252 (same).

Opposer's Motion seeks to further clarify allegations in its Consolidated Notice of Opposition and include contractual estoppel as a ground for relief. Notably, Opposer's proposed Amended Consolidated Notice of Opposition relates back to the allegations made in its initial Consolidated Notice of Opposition regarding the parties' Prior Agreements. Furthermore, Opposer does not change the scope of the issues as it seeks to limit the proceeding to the particular goods and services of the Opposed Marks to those regarding travel-related goods and services. Indeed, Applicant has been on notice of Opposer's contract-based arguments since the proceeding was initiated. Moreover, Applicant has also raised the affirmative defenses equitable estoppel and contractual estoppel, which stem from the parties' Prior Agreements, and has relied on these defenses in connection with its Motion for Summary Judgment. *See* Dkts. 9, 16, 18. Thus, Applicant opened the door and waived any objections to a claim of contractual estoppel. For these reasons, consistent with the practice of granting amendments liberally, justice requires that Opposer's Motion be granted to allow Opposer to further clarify the allegations and legal theories it will set forth in the instant proceeding.

b. Applicant will not Suffer Any Prejudice as a Result of the Amended Consolidated Notice of Opposition

Applicant will not suffer any prejudice based on Opposer's proposed amendment. Applicant has been on notice of the contract-related arguments and issues in this proceeding related to the parties' Prior Agreements since Opposer's initial filing. Further, Applicant has relied on the parties' Prior Agreements to develop its own defenses. *See* Dkts. 4, 9, 16, 18. Here, Opposer is merely clarifying the allegations and claims it has already asserted, while narrowing this Opposition to the specific goods and services of the Opposed Marks pertaining to travel-related goods and services, which will further focus the parties' efforts as the proceeding progresses.

In addition, once resumed, this proceeding will still be in the discovery phase. Timing is an important factor in determining whether the proposed amendment is prejudicial, and the Board typically considers motions for leave as timely if they are filed prior to the opposer's testimony period. *See* TBMP § 507.02; *PRL USA Holdings*, 2013 TTAB LEXIS 551, at *3 (granting motion to amend and finding no prejudice to applicant when the trial period had not yet begun); *O-M Bread Inc.*, 26 U.S.P.Q.2d 1221 at 1223 (granting opposer's motion to amend notice of opposition when proceeding was still in pre-trial stage); *Focus 21 Int'l, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (finding motion to amend filed prior to opening of petitioner's testimony period permitted and not prejudicial).

Here, Opposer's Motion is being filed well before discovery could close and well before Opposer's pre-trial disclosures could be due. *See* Dkts. 15, 20. Moreover, there has been no undue delay in Opposer's filing this Motion. The proceeding has been suspended for the past eleven months and all trial dates will be reset due to the suspension. Accordingly, Opposer sought Applicant's position on this Motion prior to proceedings resuming and is bringing this Motion presently such that the parties will have ample time to develop contractual estoppel arguments—an issue that Applicant itself has already raised. In summary, because Opposer timely seeks to amend its Consolidated Notice of Opposition to further clarify its allegations and legal theories long before the close of discovery, Opposer's Motion is not prejudicial to Applicant and should be granted to best serve the interests of justice.

IV. CONCLUSION

For the aforementioned reasons, Opposer respectfully requests that the Board grant its Motion so that Opposer may amplify its allegations regarding the parties' Prior Agreements, further clarify its claims and legal theories related to contractual estoppel, and narrow the scope of

this Opposition to the specific goods and services of the Opposed Marks that pertain to travel-related goods and services.

Dated: August 31, 2021

Respectfully submitted,

/s/ Eric J. Maiers

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*Attorneys for Opposer American
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CERTIFICATE OF SERVICE

This is to certify that a copy of the attached AMERICAN AIRLINES, INC.'S MOTION FOR LEAVE TO AMEND CONSOLIDATED NOTICE OF OPPOSITION was served on Applicant's counsel of record on August 31, 2021 via electronic mail, addressed to:

Andrew J. Goldberg
General Counsel
HSP EPI Acquisition, LLC dba Entertainment
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Troy, MI 48084
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/s/ Eric J. Maiers

Eric J. Maiers

*Attorney for Opposer American Airlines,
Inc.*

Exhibit A

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

IN THE MATTER OF (1) Application Serial No. 88/417283 for the trademark DINING ADVANTAGE; and (2) Application Serial No. 88/417301 for the trademark DINING ADVANTAGE BY ENTERTAINMENT, published September 10, 2019.

AMERICAN AIRLINES, INC.,)	
Opposer,)	
)	
v.)	OPPOSITION NO. 91251601
)	
HSP EPI ACQUISITION, LLC,)	U.S. Serial No. 88/417283
Applicant.)	U.S. Serial No. 88/417301
)	
)	
)	

FIRST AMENDED CONSOLIDATED NOTICE OF OPPOSITION

Opposer American Airlines, Inc. (“American” or “Opposer”) hereby files its First Amended Notice of Opposition. American, a corporation duly organized and existing under the laws of the State of Delaware, with its principal place of business in Fort Worth, Texas, believes that it will be damaged by the registration of the marks DINING ADVANTAGE and DINING ADVANTAGE BY ENTERTAINMENT (the “Dining Advantage Marks”) that are subject to United States Application Serial Nos. 88/417283 and 88/417301, (collectively, the “Opposed Applications” or “Opposed Marks”), filed in the name of HSP EPI Acquisition, LLC (“Applicant”). Therefore, American hereby opposes such registrations. The grounds for the opposition are as follows:

1. Opposer is the largest air carrier in the world and enjoys a reputation in the United States and internationally as a premier airline. Together with its affiliates, Opposer serves over 350 destinations in over fifty countries, with nearly 7,000 daily flights.

2. During its more than 90-year history, Opposer has developed global name-recognition and goodwill, and has become a household name. It has used and continues to use the trade name American Airlines.

3. In 1981, American launched its loyalty program named “AAAdvantage.” Since that time, American has extensively used, and continues to use, the trademark and/or service mark AADVANTAGE, alone and in connection with other words and designs (the “AADVANTAGE Marks”) in connection with loyalty programs, discount programs, incentive award programs, transportation services, and travel related goods and services, in interstate commerce.

4. As set forth in more detail below, Opposer owns both registered and common law trademark rights in marks incorporating the term AADVANTAGE, and such rights predate Applicant’s application dates of the Opposed Marks.

5. Opposer owns several federal registrations for trademarks, service marks and design marks, including the following marks incorporating the term AADVANTAGE:

MARK	REG. NO	REG. DATE	GOODS / SERVICES
AADVANTAGE and Design	1228737	February 22, 1983	(Int’l Class 39) Providing a program of bonus flights for frequent travelers
AADVANTAGE and Design	2006172	October 8, 1996	(Int’l Class 35) promoting travel services, credit card use, long-distance service car rentals, and hotel accommodations through the administration of award programs
AADVANTAGE	2187483	September 8, 1998	(Int’l Class: 35) promoting the goods and services of others by means of an incentive awards programs, whereby purchase points are awarded for purchase made from vendor subscribers, which can then be redeemed for merchandise and travel

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>(Int'l Class: 39) providing air transportation services featuring a program of bonus flights for frequent travelers</p>
AADVANTAGE	4897372	February 9, 2016	<p>(Int'l Class 35) sales promotion; promoting the goods and services of others by means of loyalty program, discount program, and an incentive awards program whereby purchase points are earned or awarded for purchases made from vendor subscribers or travel conducted by member subscribers which can then be redeemed for merchandise and travel; retail store services featuring gift cards and private club membership services; promoting the goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise</p> <p>(Int'l Class 39) air transport of passengers, cargo, and freight; providing travel agency services, namely, providing travel reservation services, namely, coordinating travel arrangements for individuals, providing air transportation reservation services, providing cruise reservation services, and providing vacation reservation services, namely, coordinating vacation travel arrangements for individuals, by means of an incentive rewards program</p> <p>(Int'l Class 43) providing food and beverage services for others and hotel accommodation services for others by means of an incentive</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			rewards program, namely, providing hotel accommodation reservation services for others and providing restaurant reservation services for others
AADVANTAGE	5640441	January 1, 2019	<p>(Int'l Class: 35) Promoting goods and services of others by means of loyalty program, discount program, promotional program and an incentive awards program whereby points are earned or awarded for purchases made by members which can then be redeemed for merchandise, services and travel; promoting goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, gift cards, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise; a loyalty program, a discount program, a promotional program and an incentive awards program whereby points are earned for purchases made via credit cards which can be redeemed for merchandise, services and travel; managing and tracking the transfer and redemption of points that are earned or awarded for purchases made by members; customer incentive loyalty, discount, and reward programs featuring information on and access to special events offered to members; promotion of special events of others</p> <p>(Int'l Class: 36) issuance of points of value; issuance of award miles of value; issuance of credit cards through a licensee; electronic commerce payment service that enables consumers to use loyalty points, reward points and miles to make online purchases,</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			in whole or in part, of goods and services; electronic commerce payment service that enables consumers to use loyalty points, reward points, and miles
AADVANTAGE EXECUTIVE PLATINUM	5730804	April 23, 2019	<p>(Int'l Class: 35) promoting goods and services of others by means of a loyalty program, discount program, promotional program and an incentive awards program whereby points are earned or awarded for purchases made by members which can then be redeemed for merchandise, services and travel; promoting goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, gift cards, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise; provision, organization, operation, and administration of a loyalty program, a discount program, a promotional program and an incentive awards program whereby points are earned for purchases made via credit cards which can be redeemed for merchandise, services and travel; provision, organization, operation, and administration of loyalty, discount, promotional, and incentive award programs, namely, managing and tracking the transfer and redemption of points that are earned or awarded for purchases made by members; customer incentive loyalty, discount, and reward programs featuring information on and access to special events offered to members; promotion of special events of others</p> <p>(Int'l Class: 39) air transport of passengers, cargo, and</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>freight; providing travel agency services, namely, providing travel reservation services for others, air transportation reservation services for others, vehicle reservation services for others, cruise reservation services for others and vacation reservation services in the nature of coordinating travel arrangements for individuals and groups; providing information in the field of travel; ground support services in the field of air transportation, namely, transfer and transport of passengers' luggage; providing information concerning passengers' luggage in transit and delivery; air travel passenger ticketing and check-in services; transportation services, namely, checking of baggage; airport services featuring transit lounge facilities for passengers; booking and providing ancillary travel services, namely, making reservations in the nature of seat selection; airport ramp services, namely, transfer of checked baggage to aircraft; airport ramp services, namely, transfer of carry-on baggage to aircraft; airline services, namely, providing priority boarding for customers, and access to airport lounge facilities</p> <p>(Int'l Class: 45) facilitating expedited passenger screening, namely, providing priority access to airline passenger and baggage security screening</p>
AADVANTAGE GOLD	5559147	September 11, 2018	<p>(Int'l Class: 35) promoting goods and services of others by means of a loyalty program, discount program, promotional program and an incentive awards program whereby points are earned or awarded for purchases made by members which can then be redeemed for merchandise, services and travel; promoting goods and services of others by means of providing an on-line shopping</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, gift cards, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise; provision, organization, operation, and administration of a loyalty program, a discount program, a promotional program and an incentive awards program whereby points are earned for purchases made via credit cards which can be redeemed for merchandise, services and travel; provision, organization, operation, and administration of loyalty, discount, promotional, and incentive award programs, namely, managing and tracking the transfer and redemption of points that are earned or awarded for purchases made by members; customer incentive loyalty, discount, and reward programs featuring information on and access to special events offered to members; promotion of special events of others</p> <p>(Int'l Class: 39)</p> <p>air transport of passengers, cargo, and freight; providing travel agency services, namely, providing travel reservation services for others, air transportation reservation services for others, vehicle reservation services for others, cruise reservation services for others and vacation reservation services in the nature of coordinating travel arrangements for individuals and groups; providing information in the field of travel; ground support services in the field of air transportation, namely, transfer and transport of passengers' luggage; providing information concerning passengers' luggage in transit and delivery; air travel</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>passenger ticketing and check-in services; transportation services, namely, checking of baggage; airport services featuring transit lounge facilities for passengers; booking and providing ancillary travel services, namely, making reservations in the nature of seat selection; airport ramp services, namely, transfer of checked baggage to aircraft; airport ramp services, namely, transfer of carry-on baggage to aircraft; airline services, namely, providing priority boarding for customers, and access to airport lounge facilities</p> <p>(Int'l Class: 45) facilitating expedited passenger screening, namely, providing priority access to airline passenger and baggage security screening</p>
<p>AMERICAN AIRLINES AADVANTAGE</p>	<p>5360206</p>	<p>December 19, 2017</p>	<p>(Int'l Class: 35) promoting the goods and services of others by means of discount program and an incentive awards program whereby purchase points are awarded for purchases made by vendor subscribers or travel made conducted by member subscribers which can then be redeemed for merchandise and travel; online retail stores services featuring gift cards and private club membership; promoting the goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise</p> <p>(Int'l Class: 39) air transport of passengers, cargo, and freight; providing travel agency services,</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p data-bbox="854 254 1412 506">namely, providing travel reservation services for others, air transportation reservation services for others, vehicle reservation services for others, cruise reservation services for others and vacation travel reservation services for others by means of an incentive rewards program</p> <p data-bbox="854 541 1398 684">(Int'l Class: 41) providing online electronic publications, namely, an online magazine and an online newsletter</p> <p data-bbox="854 726 1406 1016">(Int'l Class: 43) providing food and beverage services for others and hotel accommodation services for others by means of an incentive rewards program, namely, providing hotel accommodation reservation services for others and providing restaurant reservation services for others</p>

Copies of the federal registration certificates and TSDR status information for the above referenced registrations are attached as **Exhibit 1**. These federal registrations are valid, subsisting and in full force and effect.

6. American's federal registrations are *prima facie* evidence of validity of these marks as well as American's ownership and exclusive right to use these marks in connection with the identified services. 15 U.S.C. § 1057(b). Indeed, Opposer's right to use many of the above marks is incontestable pursuant to 15 U.S.C. § 1065.

7. The AADVANTAGE Marks are strong and have achieved a substantial level of consumer recognition in the United States and worldwide as a result of American's exclusive and long-standing use of the AADVANTAGE Marks in association with air transportation of passengers, cargo and freight, and providing reservation services for air transportation, cruises and vacations.

8. The AADVANTAGE Marks are inherently distinctive and have acquired significant distinctiveness and fame among the consuming public through the extensive, exclusive and continuous use and promotion of the AADVANTAGE Marks for more than 40 years.

9. Notwithstanding Opposer's prior rights in and to the AADVANTAGE Marks, Applicant filed U.S. Trademark Application Serial No. 88/417283 for the trademark DINING ADVANTAGE on May 6, 2019 and U.S. Trademark Application Serial No. 88/417301 for the trademark DINING ADVANTAGE BY ENTERTAINMENT on May 6, 2019. These applications cover "Advertising and promotional services, namely, promoting the goods and services of others through the distribution of coupons, and discount offers which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities; Providing advertising service through the distribution of advertisements, coupons and discount offers for display on Internet, namely, in websites, e-mails and multimedia messages; Providing via on-line computer services a membership program entitling the participants to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities, and providing in connection therewith an on-line directory of information about the discount program and participating businesses" in Class 35, and "Non-magnetically encoded printed coupon and discount cards all which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater, and other leisure activities sold separately or as part of a unit" in Class 16 (collectively, "Applicant's Goods and Services").

10. At the time it filed its applications, Applicant had constructive knowledge of Opposer's rights in the AADVANTAGE Marks.

11. At the time it filed its applications, Applicant had actual knowledge of Opposer's rights in the AADVANTAGE Marks in view of a series of prior agreements from 1994 and 1996 related to the AADVANTAGE Marks between Opposer, Applicant's wholly-owned subsidiary, Entertainment Publications, Inc. ("Entertainment"), and Entertainment's prior parent company, CUC International, Inc. (the "Agreements").

12. As a result of the Agreements, Applicant is contractually estopped from applying for the Opposed Marks in association with at least some of Applicant's Goods and Services. Specifically, Applicant's use and attempted registration of the Opposed Marks violates the terms of the Agreements. More specifically, pursuant to those agreements, among other things, Applicant agreed to "not use or allow to be used the mark 'Dining Advantage' in association with the provision of frequent flyer miles or points, air travel rewards, upgrades or other air travel benefits." *See* Exhibit 2 at 15. Thus, Applicant has contracted away its right to register the Opposed Marks at least in connection with "Advertising and promotional services, namely, promoting the goods and services of others through the distribution of coupons, and discount offers which entitle the holder to receive discounts on ... travel," "Providing via on-line computer services a membership program entitling the participants to receive discounts on ... travel ... and providing in connection therewith an on-line directory of information about the discount program and participating businesses," and "Non-magnetically encoded printed coupon and discount cards all which entitle the holder to receive discounts on ... travel ... sold separately or as part of a unit" (collectively, the "Opposed Goods and Services"), insofar as "travel" broadly encompasses frequent flyer miles or points, air travel awards, upgrades or other air travel benefits, and the Opposed Marks are therefore in direct conflict with the parties' prior agreements and violate Opposer's express rights under those agreements. For example, Applicant uses the Opposed Marks

in connection with the Opposed Goods and Services in association with co-branding partnerships involving Opposer's direct competitors. Because Applicant contracted away its rights in the Opposed Marks in association with the Opposed Goods and Services, it therefore is not the owner of, and lacks any real interest in, the Opposed Marks in association with the Opposed Goods and Services, in violation of 15 U.S.C. § 1051(a)(1).

13. The Opposed Marks are confusingly similar to Opposer's AADVANTAGE Marks, and the registration and use of the Opposed Marks by Applicant in association with the Opposed Goods and Services are likely to cause confusion as to the source or origin of the Opposed Goods and Services, and are likely to mislead consumers, all to Opposer's damage.

14. The Opposed Goods and Services are the same as or closely related to American's services provided under the AADVANTAGE Marks. In particular, the Opposed Goods and Services directly overlap with American's services.

15. Consumers encountering Applicant's Opposed Goods and Services provided under the Opposed Marks would be likely to believe that Applicant is affiliated, connected or associated with American, and/or that Applicant's Opposed Goods and Services originate from or are sponsored or approved by American.

16. American will be damaged by the registration of the Opposed Marks in association with the Opposed Goods and Services, which would cause the public to be confused or mistakenly believe that the Opposed Goods and Services provided by Applicant are associated with, endorsed or sponsored by American. Registration of the Opposed Marks in association with the Opposed Goods and Services is likely to damage American because the Opposed Marks are likely to cause confusion, cause mistake, or deceive consumers. Thus, the Opposed Marks are unregistrable for

the Opposed Goods and Services under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and should be refused registration.

WHEREFORE, Opposer, believes that it will be damaged by registration of the marks that are the subject of United States Trademark Application Serial Nos. 88/417283 and 88/417301, and therefore respectfully requests that this opposition be sustained and such registrations be refused in relation to the Opposed Goods and Services on the grounds of likelihood of confusion and violation of Opposer's rights pursuant to the parties' 1994 and 1996 Agreements related to the Dining Advantage Marks.

The Director hereby is authorized to charge the filing fee for this First Amended Notice of Opposition to Deposit Account No. 50-2428.

Dated: August 31, 2021

Respectfully submitted,

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Inc.

CERTIFICATE OF SERVICE

This is to certify that a copy of the attached FIRST AMENDED CONSOLIDATED NOTICE OF OPPOSITION was served on Applicant's counsel of record on August 31, 2021 via electronic mail, addressed to:

Andrew J. Goldberg
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/s/ Eric J. Maiers

Eric J. Maiers

*Attorney for Opposer American Airlines,
Inc.*

Exhibit B

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

IN THE MATTER OF (1) Application Serial No. 88/417283 for the trademark DINING ADVANTAGE; and (2) Application Serial No. 88/417301 for the trademark DINING ADVANTAGE BY ENTERTAINMENT, published September 10, 2019.

AMERICAN AIRLINES, INC.,)	
Opposer,)	
)	
v.)	OPPOSITION NO. <u> 91251601</u>
)	
HSP EPI ACQUISITION, LLC,)	U.S. Serial No. 88/417283
Applicant.)	U.S. Serial No. 88/417301
)	
)	
)	

FIRST AMENDED CONSOLIDATED NOTICE OF OPPOSITION

Opposer American Airlines, Inc. (“American” or “Opposer²,”) hereby files its First Amended Notice of Opposition. American, a corporation duly organized and existing under the laws of the State of Delaware, with its principal place of business in Fort Worth, Texas, believes that it will be damaged by the registration of the marks DINING ADVANTAGE and DINING ADVANTAGE BY ENTERTAINMENT (the “Dining Advantage Marks”) that are subject to United States Application Serial Nos. 88/417283 and 88/417301, (collectively, the “Opposed Applications” or “Opposed Marks”), filed in the name of HSP EPI Acquisition, LLC (“Applicant”). Therefore, American hereby opposes such registrations. The grounds for the opposition are as follows:

1. Opposer is the largest air carrier in the world and enjoys a reputation in the United States and internationally as a premier airline. Together with its affiliates, Opposer serves over 350 destinations in over fifty countries, with nearly 7,000 daily flights.

2. During its more than 90-year history, Opposer has developed global name-recognition and goodwill, and has become a household name. It has used and continues to use the trade name American Airlines.

3. In 1981, American launched its loyalty program named “AAdvantage.” Since that time, American has extensively used, and continues to use, the trademark and/or service mark AADVANTAGE, alone and in connection with other words and designs (the “AADVANTAGE Marks”) in connection with loyalty programs, discount programs, incentive award programs, transportation services, and travel related goods and services, in interstate commerce.

4. As set forth in more detail below, Opposer owns both registered and common law trademark rights in marks incorporating the term AADVANTAGE, and such rights predate Applicant’s application dates of the Opposed Marks.

5. Opposer owns several federal registrations for trademarks, service marks and design marks, including the following marks incorporating the term AADVANTAGE:

MARK	REG. NO	REG. DATE	GOODS / SERVICES
AADVANTAGE and Design	1228737	February 22, 1983	(Int’l Class 39) Providing a program of bonus flights for frequent travelers
AADVANTAGE and Design	2006172	October 8, 1996	(Int’l Class 35) promoting travel services, credit card use, long-distance service car rentals, and hotel accommodations through the administration of award programs
AADVANTAGE	2187483	September 8, 1998	(Int’l Class: 35) promoting the goods and services of others by means of an incentive awards programs, whereby purchase points are awarded for purchase made from vendor subscribers, which can then be redeemed for merchandise and travel

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			(Int'l Class: 39) providing air transportation services featuring a program of bonus flights for frequent travelers
AADVANTAGE	4897372	February 9, 2016	<p>(Int'l Class 35) sales promotion; promoting the goods and services of others by means of loyalty program, discount program, and an incentive awards program whereby purchase points are earned or awarded for purchases made from vendor subscribers or travel conducted by member subscribers which can then be redeemed for merchandise and travel; retail store services featuring gift cards and private club membership services; promoting the goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise</p> <p>(Int'l Class 39) air transport of passengers, cargo, and freight; providing travel agency services, namely, providing travel reservation services, namely, coordinating travel arrangements for individuals, providing air transportation reservation services, providing cruise reservation services, and providing vacation reservation services, namely, coordinating vacation travel arrangements for individuals, by means of an incentive rewards program</p> <p>(Int'l Class 43) providing food and beverage services for others and hotel accommodation services for others by means of an incentive</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			rewards program, namely, providing hotel accommodation reservation services for others and providing restaurant reservation services for others
AADVANTAGE	5640441	January 1, 2019	<p>(Int'l Class: 35) Promoting goods and services of others by means of loyalty program, discount program, promotional program and an incentive awards program whereby points are earned or awarded for purchases made by members which can then be redeemed for merchandise, services and travel; promoting goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, gift cards, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise; a loyalty program, a discount program, a promotional program and an incentive awards program whereby points are earned for purchases made via credit cards which can be redeemed for merchandise, services and travel; managing and tracking the transfer and redemption of points that are earned or awarded for purchases made by members; customer incentive loyalty, discount, and reward programs featuring information on and access to special events offered to members; promotion of special events of others</p> <p>(Int'l Class: 36) issuance of points of value; issuance of award miles of value; issuance of credit cards through a licensee; electronic commerce payment service that enables consumers to use loyalty points, reward points and miles to make online purchases,</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			in whole or in part, of goods and services; electronic commerce payment service that enables consumers to use loyalty points, reward points, and miles
AADVANTAGE EXECUTIVE PLATINUM	5730804	April 23, 2019	<p>(Int'l Class: 35) promoting goods and services of others by means of a loyalty program, discount program, promotional program and an incentive awards program whereby points are earned or awarded for purchases made by members which can then be redeemed for merchandise, services and travel; promoting goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, gift cards, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise; provision, organization, operation, and administration of a loyalty program, a discount program, a promotional program and an incentive awards program whereby points are earned for purchases made via credit cards which can be redeemed for merchandise, services and travel; provision, organization, operation, and administration of loyalty, discount, promotional, and incentive award programs, namely, managing and tracking the transfer and redemption of points that are earned or awarded for purchases made by members; customer incentive loyalty, discount, and reward programs featuring information on and access to special events offered to members; promotion of special events of others</p> <p>(Int'l Class: 39) air transport of passengers, cargo, and</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>freight; providing travel agency services, namely, providing travel reservation services for others, air transportation reservation services for others, vehicle reservation services for others, cruise reservation services for others and vacation reservation services in the nature of coordinating travel arrangements for individuals and groups; providing information in the field of travel; ground support services in the field of air transportation, namely, transfer and transport of passengers' luggage; providing information concerning passengers' luggage in transit and delivery; air travel passenger ticketing and check-in services; transportation services, namely, checking of baggage; airport services featuring transit lounge facilities for passengers; booking and providing ancillary travel services, namely, making reservations in the nature of seat selection; airport ramp services, namely, transfer of checked baggage to aircraft; airport ramp services, namely, transfer of carry-on baggage to aircraft; airline services, namely, providing priority boarding for customers, and access to airport lounge facilities</p> <p>(Int'l Class: 45) facilitating expedited passenger screening, namely, providing priority access to airline passenger and baggage security screening</p>
AADVANTAGE GOLD	5559147	September 11, 2018	<p>(Int'l Class: 35) promoting goods and services of others by means of a loyalty program, discount program, promotional program and an incentive awards program whereby points are earned or awarded for purchases made by members which can then be redeemed for merchandise, services and travel; promoting goods and services of others by means of providing an on-line shopping</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, gift cards, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise; provision, organization, operation, and administration of a loyalty program, a discount program, a promotional program and an incentive awards program whereby points are earned for purchases made via credit cards which can be redeemed for merchandise, services and travel; provision, organization, operation, and administration of loyalty, discount, promotional, and incentive award programs, namely, managing and tracking the transfer and redemption of points that are earned or awarded for purchases made by members; customer incentive loyalty, discount, and reward programs featuring information on and access to special events offered to members; promotion of special events of others</p> <p>(Int'l Class: 39) air transport of passengers, cargo, and freight; providing travel agency services, namely, providing travel reservation services for others, air transportation reservation services for others, vehicle reservation services for others, cruise reservation services for others and vacation reservation services in the nature of coordinating travel arrangements for individuals and groups; providing information in the field of travel; ground support services in the field of air transportation, namely, transfer and transport of passengers' luggage; providing information concerning passengers' luggage in transit and delivery; air travel</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p>passenger ticketing and check-in services; transportation services, namely, checking of baggage; airport services featuring transit lounge facilities for passengers; booking and providing ancillary travel services, namely, making reservations in the nature of seat selection; airport ramp services, namely, transfer of checked baggage to aircraft; airport ramp services, namely, transfer of carry-on baggage to aircraft; airline services, namely, providing priority boarding for customers, and access to airport lounge facilities</p> <p>(Int'l Class: 45) facilitating expedited passenger screening, namely, providing priority access to airline passenger and baggage security screening</p>
<p>AMERICAN AIRLINES AADVANTAGE</p>	<p>5360206</p>	<p>December 19, 2017</p>	<p>(Int'l Class: 35) promoting the goods and services of others by means of discount program and an incentive awards program whereby purchase points are awarded for purchases made by vendor subscribers or travel made conducted by member subscribers which can then be redeemed for merchandise and travel; online retail stores services featuring gift cards and private club membership; promoting the goods and services of others by means of providing an on-line shopping mall with links to the retail web sites of others in the field of books, computers, software, office supplies, consumer electronics, music, sporting and recreational equipment, gifts, travel items, apparel, jewelry, health and beauty, toys, travel, home and garden-related items, and general retail merchandise</p> <p>(Int'l Class: 39) air transport of passengers, cargo, and freight; providing travel agency services,</p>

MARK	REG. NO	REG. DATE	GOODS / SERVICES
			<p data-bbox="857 254 1412 506">namely, providing travel reservation services for others, air transportation reservation services for others, vehicle reservation services for others, cruise reservation services for others and vacation travel reservation services for others by means of an incentive rewards program</p> <p data-bbox="857 541 1398 684">(Int'l Class: 41) providing online electronic publications, namely, an online magazine and an online newsletter</p> <p data-bbox="857 726 1406 1010">(Int'l Class: 43) providing food and beverage services for others and hotel accommodation services for others by means of an incentive rewards program, namely, providing hotel accommodation reservation services for others and providing restaurant reservation services for others</p>

Copies of the federal registration certificates and TSDR status information for the above referenced registrations are attached as **Exhibit 1**. These federal registrations are valid, subsisting and in full force and effect.

6. American's federal registrations are *prima facie* evidence of validity of these marks as well as American's ownership and exclusive right to use these marks in connection with the identified services. 15 U.S.C. § 1057(b). Indeed, Opposer's right to use many of the above marks is incontestable pursuant to 15 U.S.C. § 1065.

7. The AADVANTAGE Marks are strong and have achieved a substantial level of consumer recognition in the United States and worldwide as a result of American's exclusive and long-standing use of the AADVANTAGE Marks in association with air transportation of passengers, cargo and freight, and providing reservation services for air transportation, cruises and vacations.

8. The AADVANTAGE Marks are inherently distinctive and have acquired significant distinctiveness and fame among the consuming public through the extensive, exclusive and continuous use and promotion of the AADVANTAGE Marks for more than ~~38~~40 years.

9. Notwithstanding Opposer's prior rights in and to the AADVANTAGE Marks, Applicant filed U.S. Trademark Application Serial No. 88/417283 for the trademark DINING ADVANTAGE on May 6, 2019 and U.S. Trademark Application Serial No. 88/417301 for the trademark DINING ADVANTAGE BY ENTERTAINMENT on May 6, 2019. These applications cover "Advertising and promotional services, namely, promoting the goods and services of others through the distribution of coupons, and discount offers ~~...~~" in Class 35, and further cover which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities; Providing advertising service through the distribution of advertisements, coupons and discount offers for display on Internet, namely, in websites, e-mails and multimedia messages; Providing via on-line computer services a membership program entitling the participants to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities, and providing in connection therewith an on-line directory of information about the discount program and participating businesses" in Class 35, and "Non-magnetically encoded printed coupon and discount cards all which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise~~...~~", travel, movies, sports, theater, and other leisure activities sold separately or as part of a unit" in Class 16 (collectively, "Applicant's Goods and Services").

10. At the time it filed its applications, Applicant had constructive knowledge of Opposer's rights in the AADVANTAGE Marks.

11. At the time it filed its applications, Applicant had actual knowledge of Opposer's rights in the AADVANTAGE Marks in view of a series of prior agreements from 1994 and 1996 related to the AADVANTAGE Marks between Opposer, Applicant's wholly-owned subsidiary, Entertainment Publications, Inc. ("Entertainment"), and Entertainment's prior parent company, CUC International, Inc. ~~Pursuant to those agreements, Entertainment expressly covenanted not to use or allow to be used DINING ADVANTAGE in association with the provision of frequent flyer miles or points, air travel awards, upgrades or other air travel benefits, which are services broadly covered by the Opposed Applications.~~(the "Agreements").

12. As a result of the Agreements, Applicant is contractually estopped from applying for the Opposed Marks in association with at least some of Applicant's Goods and Services. Specifically, Applicant's use and attempted registration of the Opposed Marks violates the terms of the Agreements. More specifically, pursuant to those agreements, among other things, Applicant agreed to "not use or allow to be used the mark 'Dining Advantage' in association with the provision of frequent flyer miles or points, air travel rewards, upgrades or other air travel benefits." See Exhibit 2 at 15. Thus, Applicant has contracted away its right to register the Opposed Marks at least in connection with "Advertising and promotional services, namely, promoting the goods and services of others through the distribution of coupons, and discount offers which entitle the holder to receive discounts on ... travel," "Providing via on-line computer services a membership program entitling the participants to receive discounts on ... travel ... and providing in connection therewith an on-line directory of information about the discount program and participating businesses," and "Non-magnetically encoded printed coupon and discount cards all which entitle the holder to receive discounts on ... travel ... sold separately or as part of a unit" (collectively, the "Opposed Goods and Services"), insofar as "travel" broadly encompasses

frequent flyer miles or points, air travel awards, upgrades or other air travel benefits, and the Opposed Marks are therefore in direct conflict with the parties' prior agreements and violate Opposer's express rights under those agreements. For example, Applicant uses the Opposed Marks in connection with the Opposed Goods and Services in association with co-branding partnerships involving Opposer's direct competitors. Because Applicant contracted away its rights in the Opposed Marks in association with the Opposed Goods and Services, it therefore is not the owner of, and lacks any real interest in, the Opposed Marks in association with the Opposed Goods and Services, in violation of 15 U.S.C. § 1051(a)(1).

12-13. The Opposed Marks are confusingly similar to Opposer's AADVANTAGE Marks, and the registration and use of the Opposed Marks by Applicant in association with the ~~claimed goods~~Opposed Goods and ~~services~~Services are likely to cause confusion as to the source or origin of ~~Applicant's~~the Opposed Goods and Services, and are likely to mislead consumers, all to Opposer's damage.

13-14. ~~Applicant's~~The Opposed Goods and Services are the same as or closely related to American's services provided under the AADVANTAGE Marks. In particular, ~~Applicant's "Providing via on-line computer services a membership program entitling the participants to receive discounts on dining, hotel accommodations, consumer merchandise, travel" services~~the Opposed Goods and Services directly overlap with American's services.

14-15. Consumers encountering Applicant's Opposed Goods and Services provided under the Opposed Marks would be likely to believe that Applicant is affiliated, connected or associated with American, and/or that Applicant's Opposed Goods and Services originate from or are sponsored or approved by American.

~~15.16.~~ American will be damaged by the registration of the Opposed Marks in association with the Opposed Goods and Services, which would cause the public to be confused or mistakenly believe that the ~~services~~Opposed Goods and Services provided by Applicant are associated with, endorsed or sponsored by American. Registration of the Opposed Marks in association with the Opposed Goods and Services is likely to damage American because the Opposed Marks are likely to cause confusion, cause mistake, or deceive consumers. Thus, the Opposed Marks are unregistrable for the Opposed Goods and Services under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and should be refused registration.

WHEREFORE, Opposer, believes that it will be damaged by registration of the marks that are the subject of United States Trademark Application Serial Nos. 88/417283 and 88/417301, and therefore respectfully requests that this opposition be sustained and such registrations be refused in relation to the Opposed Goods and Services on the grounds of likelihood of confusion and violation of Opposer's rights pursuant to the parties' 1994 and 1996 Agreements related to the Dining Advantage Marks.

The Director hereby is authorized to charge the filing fee for this First Amended Notice of Opposition to Deposit Account No. 50-2428.

Respectfully submitted,

Dated: ~~October 10, 2019~~ August 31, 2021

/s/ Eric J. Maiers

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CERTIFICATE OF SERVICE

This is to certify that a copy of the attached FIRST AMENDED CONSOLIDATED NOTICE OF OPPOSITION was served on Applicant's counsel of record on August 31, 2021 via electronic mail, addressed to:

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