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Filing date: **11/24/2020**

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

Proceeding	92075486
Party	Defendant Hsp Epi Acquisition, LLC
Correspondence Address	HSP EPI ACQUISITION, LLC 1401 CROOKS ROAD, SUITE 150 TROY, MI 48084 UNITED STATES No email provided. No phone number provided.
Submission	Answer and Counterclaim
Filer's Name	Gail M. O'Brien
Filer's email	gobrien@entertainment.com
Signature	/s/Gail M. O'Brien
Date	11/24/2020
Attachments	HSP answer and CC to AAPetition to Cancel final.pdf(427943 bytes)

Registrations Subject to the filing

Registration No.	4897372	Registration date	02/09/2016
Registrant	American Airlines, Inc. 4333 AMON CARTER BOULEVARD FORT WORTH, TX 76155 UNITED STATES		

Goods/Services Subject to the filing

Class 035. First Use: 1981/04/20 First Use In Commerce: 1981/04/20 All goods and services in the class are requested, namely: 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			
Registration No.	5640441	Registration date	01/01/2019
Registrant	American Airlines, Inc. 4333 AMON CARTER BOULEVARD FORT WORTH, TX 76155 UNITED STATES		

Goods/Services Subject to the filing

Class 035. First Use: 1981/04/20 First Use In Commerce: 1981/04/20 All goods and services in the class are requested, namely: 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			
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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

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

AMERICAN AIRLINES, INC.,)	
Petitioner)	
)	
v.)	Cancellation No. 92075486
)	
)	
HSP EPIACQUISITION, LLC,)	Registration No.4286631
Registrant)	
)	

**REGISTRANT’S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM TO PETITION
FOR CANCELLATION**

Registrant HSP EPI ACQUISITION, LLC ("Entertainment" or "Registrant"), a corporation duly organized and existing under the laws of the State of Delaware, with its principal place of business in Troy, Michigan, holds the uncontestable registration of the mark diningadvantage.com[®] that is subject to United States Registration No. 4286631. On or about October 9, 2020, American Airlines, Inc. ("American" or "Petitioner") filed a petition to cancel the diningadvantage.com[®] mark ("Petition"). In response to the Petition Entertainment provides the following answers, affirmative defenses, and counterclaim:

1. Entertainment lacks knowledge or information sufficient to either admit or deny the allegations contained in Paragraph 1.
2. Entertainment lacks knowledge or information sufficient to either admit or deny the allegations contained in Paragraph 2.
3. Entertainment lacks knowledge or information sufficient to either admit or deny the allegations contained in Paragraph 3.

4. Entertainment lacks knowledge or information sufficient to either admit or deny the allegations contained Paragraph 4.

5. In response to the allegations of Paragraph 5 where Petitioner cites U.S. registrations trademarks, the records are the best evidence of their content; therefore, reference is hereby made to the same. Except as admitted, the allegations of Paragraph 5 are denied.

6. Entertainment lacks knowledge or information sufficient to either admit or deny the allegations contained Paragraph 6.

7. Entertainment lacks knowledge or information sufficient to either admit or deny the allegations contained in Paragraph 7.

8. In response to the allegations of Paragraph 8 where Petitioner cites U.S. registrations trademarks, the records are the best evidence of their content; therefore, reference is hereby made to the same.

9. In response to the allegations of Paragraph 9 where Petitioner cites U.S. registrations trademarks, the records are the best evidence of their content; therefore, reference is hereby made to the same.

10. In response to the allegations of Paragraph 10 where Petitioner cites U.S. registrations trademarks, the records are the best evidence of their content; therefore, reference is hereby made to the same.

11. Entertainment denies that it has a wholly owned subsidiary named Entertainment Publications Inc. Entertainment admits that its predecessors had many agreements with Petitioner over the past 26 years. Except as admitted, the allegations of Paragraph 11 are denied.

12. Petitioner cites Exhibit 2 in Paragraph 12 of its petition, Entertainment admits that Exhibit 2 is an accurate copy of an agreement with one of Entertainment's predecessors, the agreement is the best evidence of the content; therefore, reference is hereby made to the same.

13. The allegations of Paragraph 13 are denied.

14. The allegations of Paragraph 14 are denied.

15. The allegations of Paragraph 15 are denied.

To the extent not explicitly admitted, all allegations in the Petition are denied.

COUNT I (Non-Use as to Travel Discounts)

16. Entertainment hereby repeats and realleges each of the responses contained in the preceding paragraphs as if fully stated herein.

17. The allegations of Paragraph 17 are denied.

18. The allegations of Paragraph 18 are denied.

19. The allegations of Paragraph 19 are denied.

20. The allegations of Paragraph 20 are denied.

21. The allegations of Paragraph 21 are denied.

22. The allegations of Paragraph 22 are denied.

COUNT II (Fraudulent Statements and Declarations of Use)

23. Entertainment hereby repeats and realleges each of the responses contained in the preceding paragraphs as if fully stated herein.

24. In response to the allegations of Paragraph 24 where Petitioner cites U.S. registrations trademarks, the records are the best evidence of their content; therefore, reference is hereby made to the same.

25. The allegations of Paragraph 25 are denied.
26. The allegations of Paragraph 26 are denied.
27. The allegations of Paragraph 27 are denied.
28. The allegations of Paragraph 28 are denied.
29. The allegations of Paragraph 29 are denied.

COUNT III (Lack of Real Interest Due to Contract)

30. Entertainment hereby repeats and realleges each of the responses contained in the preceding paragraphs as if fully stated herein.

31. The allegations of Paragraph 31 are denied.
32. The allegations of Paragraph 32 are denied.
33. The allegations of Paragraph 33 are denied.
34. The allegations of Paragraph 34 are denied.

AFFIRMATIVE DEFENSES AND COUNTERCLAIM

Entertainment undertakes the burden of proof only as to those defenses deemed affirmative defenses by law, regardless of how such defenses are denominated below. Entertainment expressly reserves the right to plead additional affirmative and other defenses should any such defenses be revealed by discovery in this case. As and for its affirmative and other defenses, Entertainment states as follows:

FACTUAL ALLEGATIONS COMMON TO ALL AFFIRMATIVE DEFENSES AND COUNTERCLAIM

35. Entertainment hereby repeats and realleges each of the responses contained in the preceding paragraphs as if fully stated herein.

36. Entertainment is the largest supplier of various assortments of promotional and discount products, provided through mobile, online and printed discounts, which are utilized for loyalty programs and fundraising purposes by educational, non-profit and other entities throughout the United States and Canada. "Entertainment" as used herein, refers to both the Registrant and predecessors of the Entertainment® Business, as defined in Paragraph 3 below.

37. Entertainment sold its international trademarks to Entertainment Australia in 2013.

38. Entertainment offers the sale of coupon/discount books - such as Entertainment® books, custom discount products, and has multiple discount and loyalty websites, including but not limited to: entertainment.com®, diningadvantage.com®, and co-branded websites all of which provide savings and discounts for local and national restaurants, travel, car rental, movies, car washes, grocery stores and other related goods and services - for loyalty and fundraising purposes in the U.S. and Canada ("Business").

39. Since 1962, Entertainment® has developed global name-recognition and goodwill in its Business, has become a household name, and has continually used the tradename Entertainment®.

40. In 1989, Entertainment launched its discount program named "Dining Advantage" and applied for the Dining Advantage® trademark.

41. Since 1989, Entertainment has extensively used, and continues to use, the Dining Advantage® trademark and/or service mark Dining Advantage®, alone and in connection with other words and designs in connection with discount loyalty programs, membership programs, incentive programs, in interstate commerce.

42. In July 1990, Entertainment successors obtained U.S. Registration Number 1,608,460 in class 035 for Dining Advantage® - Promoting the goods and services of others through the distribution of discount cards and coupons for restaurants.

43. At that time, the parent company of Entertainment or its affiliates also owned the following advantage trademarks, many of which predate Petitioner's AAdvantage marks:

The Financial Advantage	1,344,981
Shopper's Advantage	1,352,175
The Traveler's Advantage	1,393,539
Autovantage	1,533,199
Buyer's Advantage	1,531,245
Gourmet Advantage	1,542,848
Legal Advantage	1,438,746
Warranty Advantage	1,503,239

44. Petitioner became aware of the ownership of these other advantage marks after it objected to Entertainment's use of Dining Advantage by letter dated June 7, 1990 because of its class 39 Aadvantage with a design mark **AAdvantage** Registered No. 2006172. Letter attached as Dkt #9 Exhibit A to Consolidated Notice of Opposition no. 91251601.

45. Entertainment successors responded to Petitioner's objection. Response attached as Exhibit B Dkt #9 Consolidated Notice of Opposition no. 91251601. Petitioner did not pursue its 1990 objection after Entertainment sent the response in Exhibit B.

46. Pursuant to a series of prior agreements between Petitioner, and previous owners of Entertainment, specifically Entertainment Publications, Inc., Petitioner expressly covenanted

that: “American will not register or apply to register “AAdvantage® Dining” at any time during or after the term of this Agreement. However, American shall be entitled to use “AAdvantage® Dining” after the termination of this Agreement.” (“Petitioner’s Covenant”). Page 15 of 1994 AAdvantage Participation Agreement attached as Exhibit 2 to Petition to Cancel.

47. As part of the consideration for Petitioner’s Covenant, Entertainment agreed 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” [“Entertainment’s Covenant” or collectively “Covenant(s)"].

48. More than six years after Entertainment received the registration for DINING ADVANTAGE® in 1996, Petitioner obtained the Aadvantage mark with a design **AAdvantage** for the same class as DINING ADVANTAGE® (Class 35, Registration No. 2006172) “promoting travel services, credit card use, long-distance service car rentals, and hotel accommodations through the administration of award programs.”

49. Despite Petitioner’s Covenant, on February 7, 2000, Petitioner’s filed an application 75911404 for registration of the mark “AADVANTAGE DINING”.

50. Without participation from Entertainment, the Board denied the AADVANTAGE DINING application by the U.S. Patent and Trademark Office based on the likelihood of confusion with DINING ADVANTAGE®.

51. In response to the denial, on March 28, 2001 Petitioner filed a Petition for Cancellation for Entertainment’s Registration No. 1,608,460 for DINING ADVANTAGE®. The basis for that petition was also non-use. Petitioner withdrew the Petition with prejudice in 2003.

52. Petitioner’s also abandoned the application for AADVANTAGE DINING.

53. In 2011, adding to the DINING ADVANTAGE® mark, Entertainment applied for a federal registration for the trademark DININGADVANTAGE.COM®. U.S. Registration Number 4,286,631 was granted in 2013 in classes:

a. 016 - 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.

035 - 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. (Emphasis added).

54. Petitioner requested an extension of time to file an objection to the application but withdrew its opposition to Entertainment's diningadvantage.com application.

55. At the time, Petitioner had an advertising services agreement with Entertainment which allowed Entertainment to use Petitioner offers in all its programs.

56. Entertainment has never breached its Covenant and by withdrawing its 2012 Opposition to diningadvantage.com®, Petitioner acknowledged that diningadvantage.com® was not a breach of the Covenant provisions.

57. Three years later, Petitioner obtained registration No. 4897372 of a plain typeset Advantage mark in class 035 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, ...travel items, apparel, ... travel....”(Emphasis added). Thus, arguably, encroaching on Entertainment’s diningadvantage.com® mark based upon Petitioner’s claims in its 2019 Opposition and this Petition.

58. On September 10, 2019, Entertainment received Official USPTO Notice of Acceptance/Acknowledgement Sections 8 and 15: U.S. Trademark RN 4286631: DININGADVANTAGE.COM: Docket/Reference No. 235585343258. Thus, Entertainment’s right to use the mark is incontestable pursuant to 15 U.S.C. § 1065.

59. Copies of the TSDR status information for the above referenced Dining Advantage® registrations are attached as Exhibit C. Dkt #9 Consolidated Notice of Opposition no. 91251601, U.S. Registration Number 1,608,460 and U.S. Registration Number 4,286,631 (“Prior DA Marks”) are valid, subsisting and in full force and effect.

60. Entertainment's federal registrations are prima facie evidence of validity of these marks as well as Entertainment's ownership and exclusive right to use these marks in connection with the identified products and services. 15 U.S.C. § 1057(b).

61. The Prior DA Marks are strong and have achieved a substantial level of consumer recognition in the United States and Canada as a result of Entertainment's exclusive and long-

standing use of the Prior DA Marks in association with discounts on dining, travel, and other leisure activities.

62. The Prior DA 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 Prior DA Marks for over 30 years.

63. On May 6, 2019, Entertainment filed U.S. Trademark Applications Serial No. 88/417283 for an updated DINING ADVANTAGE mark which added a fork and knife in the center of a thin circle all inside a larger, thicker circle to the left of the wording DINING ADVANTAGE and U.S. Trademark Application Serial No. 88/417301 for “DINING ADVANTAGE BY ENTERTAINMENT” which added a fork and knife in the center of a thin circle all inside a larger, thicker circle to the left of the wording DINING ADVANTAGE above the wording “BY ENTERTAINMENT” with a four-point crown in between the words “BY” and “ENTERTAINMENT”, and referred to the Prior DA marks in the applications.

64. These applications are in Class 35 and in Class 16 for the same goods and services described for the registered mark DININGADVANTAGE.COM® and similar to the Dining Advantage® mark. The Prior DA Marks are substantially like the opposed marks and for substantially similar goods and/or services, causing no added injury to Petitioner.

65. Over the 30 year use of the Dining Advantage marks no confusion as to the source or origin of Entertainment's Goods and Services, and Petitioner's has been caused (MSJ Dkt. 16, aka MSJ Exhibit I).

66. Notwithstanding Entertainment's prior rights in and to the Prior DA Marks, Petitioner filed a currently pending Consolidated Notice of Opposition no. 91251601 in October 2019.

67. Entertainment has never breached this obligation, neither diningadvantage.com® nor its current applications, conflict with this obligation.

68. Entertainment's summary judgement motion in the Opposition is pending.

69. Entertainment's Reply Brief, Opposition no. 91251601 DKT 18, Exhibit 1, provides examples of travel related discounts used in conjunction with diningadvantage.com®.

70. "Travel" is defined in the Merriam-webster dictionary as "to go on or as if on a trip or tour: JOURNEY"... "to go from place to place".

71. The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

72. Currently and at all times in the past, DININGADVANTAGE.COM® consumers not only travel to restaurants in their hometowns they receive dining discounts for use while they are traveling all over the United States and Canada, they also receive discounts related to cars, bikes, tours, entertainment venues and more.

73. Petitioner asked Entertainment to agree to amend its Opposition at that time Entertainment filed its summary judgement motion.

74. Entertainment refused for three reasons:

- a. Rule 2.127(d) provides that the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the potentially

dispositive motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order,

- b. the “new” claim was known to Petitioner when it filed the Opposition a year earlier, and
- c. the proposed claim was not properly pled.

75. The Petition is an abuse of the Opposition process because it is Petitioner’s attempt to avoid issue preclusion because the claim was not filed when Petitioner had knowledge of the facts supporting the claim or and it is required to obtain Board approval to amend its Opposition.

AFFIRMATIVE DEFENSES

As for its affirmative defenses, Entertainment asserts and states as follows:

76. Entertainment repeats and realleges each of the responses and allegations set forth above as if fully set forth herein.

77. The Petition for Cancellation **fails to state a claim** upon which relief can be granted for the following reasons:

a. Count 1 of the Petition alleging partial abandonment does not include any allegation that the diningadvantage.com[®] mark has lost all capacity to act as a source-indicator for Entertainment’s discounts, thus it fails to state a claim for relief. *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702-03 (TTAB 2002)

b. To plead a claim of fraud, Petitioner must allege, with sufficient factual specificity required by Rule 9(b), that (1) Entertainment made a false representation to the USPTO; (2) the false representation is material to the registrability of the mark; (3)

Entertainment had knowledge of the falsity of the representation; and (4) Entertainment made the representation with intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91USPQ2d 1938, 1941 (Fed. Cir. 2009).

- i. Petitioner has alleged no facts supporting an inference of deceptive intent. Alleged conduct must indicate sufficient culpability to require a finding of intent to deceive. “There is no room for speculation, inference or surmise” *Id.* Allegations [based solely upon information and belief fail to meet the Fed. R. Civ. P. 9(b) requirements. *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1524-25 (TTAB 2013). Petitioner has failed to satisfy the standard required to plead a fraud claim.
- ii. Petitioner has failed to allege facts that support the reference to travel in Registration No. 4286631 is material to the diningadvange.com® mark for discounts.

c. Lack of Standing. Petitioner is only authorized to seek cancellation of a mark where it has both a real interest in the proceeding as well as a reasonable basis for its belief of damage. *Corcamore, LLC v. SFM, LLC*, Case No. 19-1526 (Fed. Cir. Oct. 27, 2020). Based upon the concurrent 30 year use of the Entertainment’s prior Dining Advantage® and diningadvange.com® marks and Petitioner marks since 1990, Petitioner’s damage allegations in the cancellation petition have a no reasonable basis in fact. See Opposition no. 91251601, Dkt #16 -18 summary judgment briefs.

d. Count III of the Petition, lack of real interest due to contract, fails to state a claim because once the registration of a mark like diningadvantage.com® becomes five years

old the registration can only be challenged on the grounds stated in Section 14 of the Trademark Act, 15 U.S.C. § 1064.8.

- i. The assertions that Entertainment may have fraudulently procured its registration or has allegedly abandoned the registration which are valid grounds for cancellation of a registration that is more than five years old under Section 14, do not allow Petitioner to also assert a ground that is available only when a registration is less than five years old. *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1524-25 (TTAB 2013)

78. Equitable, Contractual and Collateral Estoppel. Petitioner's is estopped from seeking the relief sought in its Petition based upon:

- a. the following promises, actions, and inaction:
 - i. prior agreements related to the marks between Petitioner and Entertainment predecessors;
 - ii. Petitioner'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 Entertainment Dining Advantage® marks (Entertainment prior U.S. Registration Number(s) 1608460 and 4286631) ("Prior DA Marks");
 - iii. Petitioner's 2003 withdrawal with prejudice of its petition for cancellation of Dining Advantage®,
 - iv. the withdrawal of its opposition in 2011 to the diningadvantage.com application, and
 - v. Petitioner's

failure to seek leave from the Board amend Opposition No. 91251601 with the claims contained in this petition.

b. Entertainment's reliance upon Petitioner's promise and inaction was reasonably foreseeable by Petitioner.

c. Entertainment has not used the marks with the provision of frequent flyer miles or points, air travel awards, upgrades or other air travel benefits.

d. Entertainment did not agree to restrict the use of the Dining Advantage marks from travel related discounts.

e. Entertainment relied upon Petitioner's representations to its detriment and has spent a considerable amount of money developed name-recognition and goodwill since the 1994 agreement.

f. Petitioner is barred from belatedly raising new issues by way of this cancellation proceeding.

79. Doctrine of Unclean Hands. As a result of Petitioner's own acts and/or omissions, the Petitioner is barred by the doctrine of unclean hands.

a. Petitioner has unclean hands after wrongfully breaching the Covenant, petitioning to cancel Entertainment's Dining Advantage® mark in 2002, failing to seek leave from the Board to amend Opposition No. 91251601 with the claims contained in this Petition, and/or alleging in Opposer's Answers to Interrogatories filed fifteen days prior to this Petition, on September 23, 2020, that "[u]pon information and belief, discounts on travel-related goods and services, including air travel, **are offered** through Applicant's Dining Advantage

loyalty discount program constituting breach of Exhibit C. (MSJ Dkt. 16, p. 154, aka MSJ Exhibit I, 3rd document, page at 4) while now alleging in this Petition that travel has been abandoned by Entertainment.

- b. Petitioner's actions will cause Entertainment substantial economic harm to the Prior DA Marks name-recognition and goodwill.
- c. Petitioner's acts and practices are unfair, deceptive, and contrary to generally recognized standards of business.

COUNTERCLAIM – CANCELLATION OF REGISTRATION NO. No. 4897372 and 5640441

Registrant/Counter-Petitioner, HSP EPI ACQUISITION, LLC ("Entertainment" or "CP"), pursuant to 37 C.F.R. § 2.114(b)(3), hereby counterclaims for cancellation of American Airlines, Counter Registrant ("CR"), 2016 and 2019 REGISTRATION NOS. 4897372 and 5640441, because Entertainment believes it will be damaged by the continued registration of the Aadvantage plain typset mark without its previous design element ("CR Marks") that are subject to United States Application Registration Nos. 4897372 and 5640441, and hereby counterclaims for cancellation of the CR Marks because they are confusingly similar to Entertainment's Prior DA Marks, likely to cause confusion and mislead consumers, all to Entertainment's damage.

The grounds for the cancellation are as follows:

80. Entertainment repeats and realleges each of the responses and allegations set forth above as if fully set forth herein.

81. Notwithstanding CP's prior rights in and to the Dining Advantage® Marks, CR filed and obtained U.S. Trademark Serial Nos. 4897372 and 5640441 for "Aadvantage", without

its previous 1998 design element, for plain typeset mark in 2016 and 2019 which are confusingly similar to Entertainment's prior diningadvantage.com® mark.

82. The plain typeset Advantage mark in class 035 in 2016 and 2019 also expands the use of the mark from the 1998 description of "promoting the goods and services of others by means of **an incentive awards programs**" to "promoting the goods and services of others by means of **loyalty program, discount program**, and an incentive awards program" 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" and is strikingly similar to Entertainment's prior diningadvantage.com® mark description.

83. At the time it filed its applications, CR had actual knowledge of Entertainment's rights in the Dining Advantage® marks.

84. The CR Mark without the previous design element is confusingly similar to the Dining Advantage® marks, and the registration and use of the CR Marks in association with the claimed goods and services are likely to cause confusion as to the source or origin of CR's Goods and Services, and are likely to mislead consumers, all to Entertainment's damage.

85. CR's expanded goods and services in the 2016 and 2019 marks are the same as, or closely related to, Entertainment's services under the Dining Advantage® Marks. CR's goods and services for a "**loyalty program, discount program**, and an incentive awards program" by means of "providing an **on-line shopping mall**" for a variety of retail products directly overlaps with Entertainment's services.

86. Consumers encountering CR's goods and services using the CR Marks are likely to believe that CR is affiliated, connected, or associated with Entertainment, and/or that CR's goods and services originate from or are sponsored or approved by Entertainment.

87. Entertainment will be damaged by the continued registration of the CR Marks, which would cause the public to be confused or mistakenly believe that the services provided by CR are associated with, endorsed, or sponsored by Entertainment. The CR Marks are likely to damage Entertainment because the CR Marks are likely to cause confusion, cause mistake, or deceive consumers. Thus, the CR Marks should be canceled.

88. The Board's 2000 denial of the AADVANTAGE DINING application by the U.S. Patent and Trademark Office based on the likelihood of confusion with DINING ADVANTAGE® supports this conclusion.

89. Entertainment mistakenly assumed that CR was using its CR Marks without substantive change since 2011, relying upon the parties' prior agreements related to the marks; the USPTO 2000 denial of the CR application on the ground that it would likely be confused with Entertainment Dining Advantage® marks, CR's 2003 withdrawal with prejudice of its petition for cancellation of Dining Advantage and CR's withdrawal of its opposition in 2011 to the diningadvantage.com application.

90. Entertainment did not become aware that CR had broadened its mark to exclude the design element until the 2019 Opposition had been filed and did not realize the goods and services had been expanded to include discount programs until this Petition was filed.

91. The 2016 and 2019 CR Marks are not eligible to receive Official USPTO Notice of Acceptance/Acknowledgement under Sections 8 and 15.

92. However, U.S. Trademark RN 4286631: DININGADVANTAGE.COM:

Docket/Reference No. 235585343258 has received Notice of Acceptance/Acknowledgement under Sections 8 and 15. Thus, Entertainment's right to use the mark is incontestable pursuant to 15 U.S.C. § 1065.

93. No Fraud or abandonment has occurred with respect to the registration of DININGADVANTAGE.COM.

WHEREFORE, there are no grounds for cancellation of Entertainment's United States Trademark Registration No. 4286631. Entertainment respectfully requests that the Petition for Cancellation be dismissed with prejudice, together with whatever other relief the Board may deem appropriate. Entertainment further requests that United States Trademark Registration Nos. 4897372 and 5640441.

Respectfully submitted, this the 24rd day of November 2020.

/S/ Gail M. O'Brien

Gail M. O'Brien,
General Counsel
HSP EPI Acquisition, LLC dba Entertainment
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586-404-1048

CERTIFICATE OF SERVICE

I, Gail M. O'Brien, hereby certify that on November 24, 2020, I served a true and correct copy of HSP EPI ACQUISITION LLC's ANSWER and AFFIRMATIVE DEFENSES, by electronic mail upon:

Counsel for Petitioner Eric Maiers
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/S/ Gail M. O'Brien

Gail M. O'Brien