

This Opinion is Not a
Precedent of the TTAB

Mailed: March 30, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Ate My Heart, Inc.
v.
Ga Ga Jeans Limited

—
Opposition No. 91205110
to Application Serial No. 85456166

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Brad D. Rose, Ryan S. Klarberg, Dyan Finguerra-DuCharme, Nicole E. Kaplan, and
Muzamil Huq of Pryor Cashman LLP for Ate My Heart, Inc.

David C. Buxbaum of Anderson Anderson LLP for Ga Ga Jeans Limited.

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Before Quinn, Ritchie and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Ga Ga Jeans Limited (“Applicant”) seeks registration on the Principal Register of the mark GAGA JEANS (in standard characters), with JEANS disclaimed, for “Jeans” in International Class 25 (“Application”).¹ Ate My Heart, Inc. (“Opposer”)

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¹ Application No. 85456166, filed on October 25, 2011, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

opposes the application based on likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and likelihood of dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).² Opposer is a company established to handle certain aspects of business relating to Stefani Germanotta, the performer known as “Lady Gaga.”³ In the notice of opposition, Opposer pleaded ownership of the following registered marks:

LADY GAGA (in standard characters) for “Clothing for women, men and children, namely, t-shirts, sweatshirts, pullovers, tank tops, vests, shorts and dresses; fashion accessories, namely, hats, headbands, wristbands, scarves and bandanas” in International Class 25.⁴

LADY GAGA (in standard characters) for “Entertainment services, namely, performances and public appearances by a live musical artist and providing non-downloadable prerecorded music online and information regarding a musical artist online via a global computer network” in International Class 41.⁵

LADY GAGA (in standard characters) for “Series of musical sound recordings, audio-visual recordings featuring music and musical-based entertainment; downloadable musical sound recordings and audio-visual recordings featuring music and musical-based entertainment; downloadable ringtones via a global computer network and wireless devices; computer application software for mobile phones, namely, for electronic storage of data and graphics, for downloading and playing music and video clips, and for the receipt and

² Opposer’s notice of opposition also included claims of deceptiveness and false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), but has not pursued these claims or addressed them in its brief. Therefore, we deem them waived. See *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1435 (TTAB 2013); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005); TBMP § 801.01 (2015).

³ 64 TTABVUE at 7-8 (Campbell testimony deposition).

⁴ Reg. No. 3695129, filed January 13, 2009, issued October 13, 2009, and claims June 30, 2008 as the date of first use in commerce; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

⁵ Reg. No. 3695038, filed November 13, 2008, issued October 13, 2009, claiming September 1, 2006 as the date of first use in commerce; Section 8 affidavit accepted; Section 15 affidavit acknowledged.

transmission of messages; vinyl covers specially adapted for cell phones, MP3 players, laptops, and gaming devices; headphones” in International Class 9; “Printed materials, namely, posters, songbooks; pens” in International Class 16; “Clothing, namely, tank tops, t-shirts, jackets, hooded sweatshirts; headwear” in International Class 25; “Issuing gift certificates which may then be redeemed for goods and services” in International Class 35; “Providing on-line chat rooms for transmission of messages among computer users concerning a musical performer” in International Class 38; “Entertainment services, namely, live musical performances; providing a website featuring entertainment information on a recording artist and her tours, performances, appearances, news, a biography, non-downloadable audio and audiovisual recordings featuring music and musical-based entertainment, photographs, and other entertainment information; online journals, namely, blogs featuring information on a recording artist; fan clubs; entertainment services, namely, providing webcasts featuring music and musical-based entertainment” in International Class 41.⁶

Opposer also pleaded ownership of the following pending application:

LADY GAGA (in standard characters) for various goods and services in International Classes 3, 9, 11, 14, 16, 18, 21, 24, 25, 26, 28, and 35, including “Santa hats; masquerade costumes; masquerade costumes and masks sold therewith; Halloween costumes; Halloween costumes and masks sold therewith; clothing, namely, undergarments, board shorts, hot pants, crop shirts, wrap around hoods; gloves” in International Class 25.⁷

In its answer, Applicant denies the salient allegations in the notice of opposition and asserted various “affirmative defenses.”⁸ However, the “affirmative defenses” are not properly characterized as such because they merely address factors or arguments to be considered in connection with the likelihood of confusion and dilution

⁶ Reg. No. 3960468, filed February 1, 2010, issued May 17, 2011, claiming various dates of first use in commerce, with June 30, 2008 claimed as the first use date for the clothing in International Class 25.

⁷ Application Serial No. 85115004, was filed August 24, 2010 based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming various dates of first use in commerce, with October 2, 2008 claimed as the first use date for the clothing in International Class 25.

⁸ 4 TTABVUE.

allegations. *See Harry Winston, Inc.*, 111 USPQ2d at 1422 n.5. In addition, in its brief, Applicant did not argue any affirmative defenses, and we therefore deem them waived. *Id.*

I. Evidentiary Record

As a preliminary matter, one evidentiary objection must be resolved. Applicant submitted a testimonial affidavit of its sole director, Asaf Josef Navon, 72 TTABVUE, but Opposer objects that it did not agree to testimony by affidavit from this witness, as required by Trademark Rule 2.123(b), 37 C.F.R. § 2.123(b), and moves to strike the affidavit. The parties briefed this motion as part of their final briefs. The parties stipulated to submit *expert* testimony by declarations or affidavits. 56 TTABVUE (Stipulation of the Parties). They did not so stipulate for *fact* witnesses, however. *Id.* In response, Applicant contends first that the affidavit should be admissible under a provision of the parties' stipulation addressing the authenticity of "documents and things produced by the Parties in this opposition proceeding." Second, Applicant indicates that regardless of the limitation in the stipulation to expert witness affidavit testimony, Applicant assumed that the stipulation allowed for testimony by affidavit for *any* witness, and Applicant indicated in its pretrial disclosure an intention to submit Mr. Navon's testimony by affidavit, to which Opposer did not object. Third, Applicant argues that Mr. Navon may be considered an expert witness in "marketing and designing jeans in the garment field." 79 TTABVUE at 47.

Opposer counters all three arguments, noting that Applicant's first and second points run contrary to the plain meaning of the Stipulation of the Parties, and that,

with regard to the third point, Applicant attested repeatedly in interrogatory answers that Mr. Navon is not an expert, instead identifying him as a “layman.”⁹

Trademark Rule 2.123(b) allows for witness testimony by affidavit only “[b]y written agreement of the parties.” 37 C.F.R. § 2.123(b). No such agreement exists for the testimony of Mr. Navon, as the parties’ written stipulation does not provide for fact witness testimony by affidavit. 56 TTABVUE. Applicant clearly identified Mr. Navon as a fact witness rather than as an expert, and we find that the parties’ stipulation regarding authenticity of produced documents does not constitute an agreement to admit fact witness testimony by affidavit. The stipulation reflects an agreement to testimony by affidavit only for experts, and Applicant’s assumption otherwise is misplaced. Accordingly, Opposer’s objection to Mr. Navon’s affidavit is sustained, and we exclude the affidavit.¹⁰

The record consists of:

- the pleadings;
- pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the opposed Application Serial No. 85456166;
- the testimony declaration of Opposer’s expert, Dr. Gerald L. Ford, and exhibits thereto, 58 TTABVUE;
- Exhibit B from Opposer’s Notice of Reliance, 60 TTABVUE at 35-54, consisting of copies of the pleaded registrations showing status and title and a copy of an

⁹ 61 TTABVUE at 5, 6, 7.

¹⁰ We note that consideration of the affidavit would not have changed the result.

additional registration owned by Opposer for the mark GAGA for wine, 60 TTABVUE at 55-60;

- Exhibit C (confidential in part) from Opposer's Notice of Reliance, 61 TTABVUE, consisting of certain of Applicant's discovery responses;¹¹
- Exhibit D from Opposer's Notice of Reliance, 60 TTABVUE at 61-535, consisting of 123 printed publications offered pursuant to Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e);
- Exhibit D from Opposer's Notice of Reliance, 60 TTABVUE at 536-538, consisting of a State of California Secretary of State Business Entity Detail for Opposer, offered as an official record;¹² and
- the testimony deposition of Robert Campbell, manager for Lady Gaga, and exhibits thereto (confidential in part) 64-69, 74 & 77 TTABVUE.

II. Standing and Priority

By Order dated March 10, 2015, the Board granted summary judgment as to Opposer's standing, indicating "there is no reason for the parties to submit further evidence or argument on the issue of standing at trial."¹³

Opposer's pleaded registrations establish that Section 2(d) priority is not an issue in this case as to the marks and the goods and services covered by these registrations.

¹¹ The parties stipulated that "All documents and things produced by the Parties in this opposition proceeding are authentic, complete and genuine and may be submitted as evidence without the need for authentication by testimony." 56 TTABVUE at 2.

¹² Exhibit D also contains documents from the file of the opposed application, but as noted above, by rule the opposed application file forms part of the record, and these documents need not be separately introduced.

¹³ 52 TTABVUE at 3 n.3.

See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Miss Universe L.P. v. Cmty. Mktg. Inc.*, 82 USPQ2d 1562, 1566 (TTAB 2007). Applicant does not contest Opposer's priority.

III. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses primarily on the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

A. Opposer's Consumer Survey

Opposer introduced a consumer survey conducted by its expert Dr. Gerald L. Ford in support of its assertion that its mark qualifies as famous and to show likely confusion.¹⁴ This online likelihood of confusion survey included 401 participants.

¹⁴ Dr. Ford's declaration includes a detailed description of the survey. 58 TTABVUE.

The survey respondents consisted of males and females at least 13 years of age who are likely within the next year to purchase jeans.¹⁵ Roughly half were in a test group who were shown and asked about GAGA JEANS and the other half were in a control group who were shown and asked about a fictitious control mark, ZAZA JEANS, and all inquiries were in connection with the product description “jeans.” The survey results indicated that when asked who makes or puts out the GAGA JEANS jeans, approximately 66% of respondents identified Lady Gaga as the source or sponsor.¹⁶

Applicant criticizes Opposer’s consumer survey on numerous grounds and contends that it lacks probative value.¹⁷ First, Applicant asserts a flaw in the survey population because it did not target Applicant’s prospective customers, alleged to be female “children and youngest teenagers,” ages 7 to 13 years old.¹⁸ However, Applicant’s identification of “jeans” in its application provides no basis to so limit its prospective customers. As noted above, where the identification is unrestricted, “we must deem the goods to travel in all appropriate trade channels to all potential purchasers of such goods.” *Cunningham*, 55 USPQ2d at 1846.

Second, Applicant argues that the sample size is too small, but again relies on its incorrect premise about its narrow target customer base, alleging that only the small subset of responses from very young females may be considered.¹⁹ Dr. Ford’s

¹⁵ *Id.* at 10.

¹⁶ *Id.* at 7, 19-24, 30.

¹⁷ 79 TTABVUE at 16-21.

¹⁸ *Id.* at 18.

¹⁹ *Id.* at 19-20.

declaration notes that the sample size and selection meet generally accepted standards and procedures in the field of surveys, and that the survey design meets the criteria set forth in the *Manual for Complex Litigation*.²⁰ Surveys with comparable sample sizes have been credited. *See, e.g., Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1828 (TTAB 2015); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1753 (TTAB 2006).

Next, Applicant alleges biased language in the survey questions about source because of the use of “who” and “whoever” rather than something “more business oriented” such as “which company” or “which manufacturer.”²¹ Applicant argues that the use of these pronouns rendered it more likely that survey respondents would think of Lady Gaga the performer, an individual, rather than a business entity. Opposer responds that the use of “who” in this manner falls in line with accepted survey formats and points to supporting case law as well as *McCarthy on Trademarks and Unfair Competition* § 32:174 (4th ed. 2015).²² In addition, Opposer points out that even with the use of “who” and “whoever,” a significant portion of control group respondents responded by identifying the fictitious company “Zaza Jeans,” rather than an individual, thereby disproving Applicant’s claim of bias. Our precedent credits this so-called *Ever-Ready* survey format²³ that uses these pronouns in the

²⁰ 58 TTABVUE at 8-9.

²¹ 79 TTABVUE at 20.

²² 80 TTABVUE at 11.

²³ In *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 188 USPQ 623 (7th Cir. 1976), cert. denied, 191 USPQ 416 (1976), the plaintiff conducted a survey to determine whether there was a likelihood of confusion between defendant’s EVER-READY lamps and plaintiff Union Carbide’s EVEREADY batteries, flashlights and bulbs. The survey asked: “Who do

survey questions. *See, e.g., Anheuser-Busch*, 115 USPQ2d at 1828 (“The likelihood of confusion part of the survey follows the familiar ‘Eveready’ [footnote omitted] model, a widely used and well-accepted format for likelihood of confusion surveys”); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d at 1753 (“Rather, given the way in which this survey format carefully follows the Ever-Ready likelihood of confusion survey format, we find that it is reliable and therefore of probative value on the issue of likelihood of confusion herein”); *Carl Karcher Ent. Inc. v. Stars Rest. Corp.*, 35 USPQ2d 1125, 1132 (TTAB 1995) (“We do not find the survey questions to be biased but, rather, to be in keeping with fairly standard survey formats”). We find no bias in the formulation of the survey questions here.

Finally, Applicant maintains that the approximately 20% validation rate of Opposer’s survey falls below the recommended level for litigation surveys. Applicant cites to INTA Courts & Tribunals Subcommittee Report on Best Practices in Conducting Surveys in Trademark Matters, available at <http://www.inta.org/PDF%20Library/INTA%20Report%20on%20Best%20Practices%20in%20Conducting%20Surveys%20in%20Trademark%20Matters.pdf>,²⁴ which notes at p.11 that validation helps ensure that a “survey instrument was implemented in an unbiased fashion and according to instructions [to interviewers].”

you think puts out the lamp shown here? [showing a picture of defendant’s EVER-READY lamp and mark],” and “What makes you think so?” *Id.* at 640.

²⁴ Although Opposer maintains that the report should not be considered because Applicant failed to introduce it via a notice of reliance, 80 TTABVue at 9, Applicant’s reliance on the report is more as a legal resource rather than as factual evidence that must be admitted into the record.

The report further notes that heightened standards for litigation surveys *may* include validation of at least 50% of the interviews. Given that this survey was conducted online with written questions asked in a uniform way, the decreased opportunity for bias or failure by interviewer personnel to follow instructions regarding selection and questioning decreases the degree of validation necessary. Moreover, Dr. Ford's declaration indicates that the validation level used here exceeds that recommended by the Council of American Survey Research Organizations standards for online data surveys.²⁵ Accordingly, we find the survey interviews in this case sufficiently validated to accomplish the intended purposes of validation.

Based on our review of the declaration of Dr. Ford, we are convinced that he qualifies as a competent expert in the field of market research, including that done for the express purpose of litigation involving likelihood of confusion issues. Applicant does not dispute Dr. Ford's qualification as an expert in this case. We agree with Dr. Ford's conclusion that the 66% result here weighs strongly in favor of likelihood of confusion.²⁶ *See J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991) (Consumer survey in which 30% of the respondents were confused supports a finding of likely confusion); *Ava Enters., Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783, 1787 (TTAB 2006) (57% survey result is "strongly probative of a likelihood of confusion").

²⁵ 58 TTABVUE at 9.

²⁶ *Id.* at 7.

B. Relatedness of the Goods

Among the goods and services identified in Opposer's registrations, we find the closest to the "jeans" in the Application to be Opposer's "Clothing for women, men and children, namely, t-shirts, sweatshirts, pullovers, tank tops, vests, shorts and dresses; fashion accessories, namely, hats, headbands, wristbands, scarves and bandanas." Thus, we focus our analysis on these identified goods, and references hereinafter to the "Registration" relate to Registration Number 3695129.

As to the goods, we must determine whether their degree of relatedness rises to such a level that consumers would mistakenly believe the parties' goods emanate from the same source. The comparison must be assessed based on the goods identified in the Application and Opposer's registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); *Octocom Sys., Inc. v. Houston Computers Serv. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

In comparing Opposer's clothing items to Applicant's jeans, we find them highly related. Although the identified goods in the Registration do not include jeans, the evidence clearly shows that the same entities provide jeans and the types of clothing items identified in the Registration. Jeans are frequently sold under the same mark as other clothing items. For example, third-party websites that offer for sale both jeans and t-shirts, as well as other goods identified in Opposer's registration under the same mark include:

- H&M website²⁷ featuring jeans, t-shirts and tank tops under the H&M mark;
- Macy's website featuring jeans and shirts sold under the RALPH LAUREN mark;²⁸
- Macy's website featuring jeans, t-shirts, and pullovers under the INC INTERNATIONAL CONCEPTS mark;²⁹
- Levi's website featuring jeans and tank tops under the LEVI'S mark;³⁰ and True Religion website featuring t-shirts, sweatshirts, tank tops, pullovers, dresses, and jeans under the same TRUE RELIGION mark.³¹

The record overall establishes that the sorts of clothing items identified in the Registration, such as t-shirts, sweatshirts, pullovers, tank tops and dresses and jeans tend to come from a single source. The evidence suggests that consumers are well accustomed to encountering the same entities providing these items under the same mark. Although Applicant argues a lack of similarity of the goods in light of Opposer's actual clothing allegedly being "unusual for the relevant public," we reject this argument and reiterate that limitations not reflected in the identifications of goods in the Application and Registration may not be considered. *Octocom*, 16 USPQ2d at 1787 (identifications are controlling). Accordingly, we find Applicant's goods highly related to the clothing in Opposer's pleaded Registration. *See Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1236-37 (TTAB 1992) (finding underwear and neckties "clearly related"); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397, 398-99

²⁷ 60 TTABVUE at 360-; www.hm.com/us.

²⁸ 60 TTABVUE at 402, 405, 412; macys.com.

²⁹ *Id.* at 409-10, 412; macys.com.

³⁰ *Id.* at 418-437; <http://us.levi.com>.

³¹ *Id.* at 485-501; truereligion.com.

(TTAB 1982) (finding hosiery related to trousers); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400, 404 (TTAB 1964) (finding girdles related to men's slacks).

C. Trade Channels and Classes of Purchasers

We presume that because Opposer's and Applicant's identifications contain no trade channel restrictions, their goods travel through all usual channels of trade for these goods. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012). In addition to clothing stores and department stores, the evidence indicates that the relevant trade channels comprise consumer retail clothing websites, such that the purchasers include members of the general public. The websites discussed above and other evidence also show that jeans and other types of clothing often are sold together through a single retail website. Examples of other evidence supporting this finding include the JOESJEANS.COM website that offers jeans, tops, pullovers, dresses, and shorts,³² and the US.BURBERRY.COM website that offers jeans and t-shirts.³³ The evidence clearly indicates that goods such as those identified by Applicant and Opposer move in the identical trade channels, and therefore it can be assumed that the same class of consumers shops for these goods.

Applicant concedes that the Application "does not limit the channels of trade."³⁴ However, Applicant nonetheless argues that the trade channels differ because

³² *Id.* at 437-84.

³³ *Id.* at 502-10.

³⁴ 79 TTABVUE at 37.

Opposer's Class 25 goods allegedly travel in an out-of-the-ordinary trade channel in that they are sold at Lady Gaga's concerts. Applicant acknowledges, however, that Opposer's clothing also is sold online and through retail stores.³⁵ Again, given the unrestricted identifications, which control the analysis, Applicant's assertions about alleged actual trade channels that find no basis in the Registration's identification lack merit.

Similarly, Applicant's claims about differences in the classes of purchasers of its goods versus Opposer's fail because they involve disregarding the identifications of goods. For example, Applicant's argument about its own goods relies on considering not the identified "jeans," but rather its contention that it actually makes do-it-yourself jeans kits for a targeted customer base of girls, ages 7 to 13 years old, who consider them "jeans as a plaything or a toy."³⁶ Applicant then contends that Opposer did not prove that its "products are in fact intended for and sold to this same group."³⁷ Because the identifications of the clothing goods in the Application and Registration reflect no restrictions as to classes of purchasers, *Octocom*, 16 USPQ2d at 1787 (identifications are controlling), and because this type of clothing is sold to the general public, we find that the classes of purchasers of Applicant's and Registrant's goods are identical, and that these members of the general consuming public would not be considered sophisticated purchasers. *See NASDAQ Stock Market, Inc. v. Antarctica*

³⁵ 79 TTABVUE at 37-38.

³⁶ *Id.* at 40.

³⁷ *Id.* at 41.

S.r.l., 69 USPQ2d 1718, 1732 (TTAB 2003) (“[T]he channels of trade are not limited, so our analysis of likelihood of confusion must assume that the goods will be marketed to all possible consumers”).

D. Strength of Opposer’s LADY GAGA Mark

Opposer argues that its mark qualifies for fame for purposes of this *du Pont* factor, while Applicant contends that the LADY GAGA marks is weak. “In determining the strength of a mark we consider both its inherent strength based on the nature of the mark itself and its market strength.” *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1898-99 (TTAB 2006).

According to Applicant, “[t]he components of the mark individually are generic and descriptive and an aspect of the ... goods of Opposer” because they refer to and describe the performer Lady Gaga.³⁸ We grant Applicant’s request that we take judicial notice of definitions of “lady” and “gaga” from the online *American Heritage Dictionary*.³⁹ Applicant contends that “[t]he mark, bearing lady and gaga together, is meant to describe Ms. Stefani Germanotta on stage and in the media, whose persona is portrayed to be a completely fascinated and crazy lady.”⁴⁰ Applicant further argues that because some of Opposer’s goods feature a photo or the name of the performer Lady Gaga, the mark is descriptive of such goods and should be considered weak.

³⁸ 79 TTABVUE at 23-24.

³⁹ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁴⁰ 79 TTABVUE at 23-24.

As an initial matter, we note that Registration Number 3695129 is on the Principal Register with no disclaimer or claim of acquired distinctiveness, and is entitled to the statutory presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). Moreover, any consideration of the descriptiveness of LADY GAGA must be in relation to the identified clothing items. Applicant acknowledges that the mark likely would be understood by consumers as a reference to the performer Lady Gaga rather than a mere combination of the component words “LADY” and “GAGA”, and Applicant points to no evidence that this term would be descriptive of the identified clothing. To the extent the mark for clothing may bring to mind LADY GAGA in connection with entertainment services, as evidenced by Registration Number 3695038, the mark may identify the source of the clothing, as it identifies the source of the services, without being considered descriptive. *See In re WNBA Enters., LLC*, 70 USPQ2d 1153, 1156 (TTAB 2003) (holding that ORLANDO MIRACLE cannot be considered descriptive of publications about the women’s basketball team that uses the same mark for its entertainment services, and that it “is the mark by which applicant identifies the source of the publications, in the same manner that it is the mark under which applicant renders its services”). Thus, we do not find LADY GAGA descriptive of clothing or otherwise inherently weak.

We next consider Opposer’s assertion that its LADY GAGA mark merits famous mark status. A famous mark, reflecting extensive public recognition and renown, enjoys a broad scope of protection. *Bose Corp. v. QSC Audio Prod. Inc.*, 293 F.3d 1367, 1371, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d

1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Because of this wide latitude of legal protection and the important role fame may play in the likelihood of confusion analysis, a party asserting fame must clearly prove it. *Harry Winston*, 111 USPQ2d at 1437-38; *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Fame for likelihood of confusion purposes exists when a “significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods sold under the mark, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services. *See Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014); *see also Bose Corp.*, 63 USPQ2d at 1308.

In support of its assertion that its mark should be considered famous, Opposer points to the inherent distinctiveness of its mark, the fame of Lady Gaga as a performer, her “influence in the world of fashion” and related activities,⁴¹ the results of the consumer survey previously discussed, length of use of its LADY GAGA mark (in connection with clothing since 2008), sales figures arising from the sale of Class 25 goods under its mark,⁴² marketing and promotion expenditures, and unsolicited

⁴¹ 75 TTABUVE at 14-18.

⁴² Opposer designated the precise figures confidential. Discussion of the sales and marketing of the clothing goods is found in the testimony of Robert Campbell, 64 TTABVUE at 19-21.

media attention devoted to the style and fashion sense of Lady Gaga the performer. The record contains considerable evidence regarding Lady Gaga's success in the music business, including substantial musical recording and concert ticket sales, social media presence, and industry awards and other media recognition.⁴³

While Lady Gaga the performer undeniably qualifies as famous,⁴⁴ we find the necessary clear evidence lacking on this record to accord LADY GAGA the status of a famous source indicator for clothing goods. While the fame of Lady Gaga as a performer factors into the analysis here, it does not translate directly to fame of Opposer's mark for clothing. Opposer's survey data, specifically the individual responses, are enlightening as to the distinction between the fame of the performer and the fame as a mark for clothing goods.⁴⁵ Although a high percentage of survey respondents identified Lady Gaga the performer as the person who "makes or puts out jeans" under the mark, in explaining why, many responses reflected assumptions or guesses as to the source stemming from name recognition of the performer, rather than brand recognition of the mark for clothing. Representative examples of responses included:

- "The use of 'Gaga' automatically made me think of the celebrity."⁴⁶

⁴³ 60 TTABVUE at 61-358; 64-69, 74 & 77 TTABVUE (Campbell testimony deposition and exhibits).

⁴⁴ The testimony of Robert Campbell includes detailed information regarding the fame of Lady Gaga the performer. 64-69, 74 & 77 TTABVUE (Campbell testimony deposition and exhibits).

⁴⁵ 58 TTABVUE at 32-42.

⁴⁶ *Id.* at 32.

- “Because, it is ‘Gaga Jeans’ but I’m not even sure she has a clothing line.”⁴⁷
- “I’m just guessing because of the name.”⁴⁸
- “Because it is the same name and celebrities are famous for putting their names on clothing,”⁴⁹
- “Sounds like her name. Could be her clothing line.”⁵⁰
- “The artist name is Lady Gaga and artist [sic] these days love their own clothing lines.”⁵¹
- “I think she’s wanting to start her own clothing line.”⁵²
- “Because she is the only entertainer out there with that name and she is very popular.”⁵³

Opposer’s sales figures and advertising expenditures with respect to clothing are not extraordinary, and in some respects the advertising evidence provided is so general that we lack the necessary detail to ascertain whether it relates to the LADY GAGA mark for clothing rather than to Lady Gaga the performer or, as her manager describes it “a lifestyle to people of her brand.”⁵⁴ Also, Opposer did not introduce evidence to show how its revenue and marketing figures compare to competitors in the industry. *See Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014) (“Evidence of fame might be bolstered if opposer also offered evidence that

⁴⁷ *Id.* at 33.

⁴⁸ *Id.* at 34.

⁴⁹ *Id.*

⁵⁰ *Id.* at 35.

⁵¹ *Id.* at 36.

⁵² *Id.* at 37.

⁵³ *Id.*

⁵⁴ 64 TTABVUE at 20.

would provide additional context to the data, such as data concerning competitors' performance as to the criteria at issue").

Overall, Opposer's LADY GAGA mark appears to have achieved a degree of recognition such that it can be considered a commercially strong mark. However, the evidence in the record does not rise to the level needed to show that LADY GAGA has achieved true fame among consumers as a source indicator for clothing goods. *See, e.g., Blue Man Prods. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005) ("From the probative evidence, we conclude that BLUE MAN GROUP has achieved a degree of recognition as a mark for entertainment services" but cannot be deemed famous).

E. Similarity of the Marks

With respect to the marks, we must compare them "in their entireties as to appearance, sound, connotation and commercial impression." *Palm Bay Imports*, 73 USPQ2d at 1691 (quoting *du Pont*, 177 USPQ at 567). The proper comparison inquires "not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether they are sufficiently similar in their overall commercial impression." *Midwestern Pet Foods, Inc. v. Societe des Produits Nesle S.A.*, 685 F.3d 1046, 1053 (Fed. Cir. 2012).

LADY GAGA and GAGA JEANS both consist of two words, and they share the identical word GAGA. The disclaimed generic word JEANS in Applicant's mark carries less significance in the mark because consumers are unlikely to rely on the generic portion of a mark as source-indicating. *See In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). Thus, GAGA dominates

Applicant's mark. The parties agree that Opposer's LADY GAGA mark derives its commercial impression by reference to the famous performer Lady Gaga. The record also reflects that she and Opposer sometimes refer to her and her associated goods and services using GAGA without LADY, such as the "Gaga's Workshop" at Barney's Department Store in New York and "Eau de Gaga" perfume.⁵⁵ Moreover, "the users of language have a universal habit of shortening full names -- from haste or laziness or just economy of words," *In re Abcor Dev. Corp.*, 588 F.2d 811, 815, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring), such that consumers also may be inclined to use GAGA as a short form. Thus, for consumers familiar with the performer Lady Gaga, GAGA dominates the mark. For consumers unfamiliar with the performer, the LADY portion of the mark could be perceived as referring to women's clothing, and therefore GAGA again dominates the mark. Accordingly, given the identical dominant word GAGA and considering the nature of the other elements of each mark, the two marks in their entireties look and sound similar. They also share a very similar commercial impression. As reflected in Opposer's survey results, consumers perceive the marks as quite alike.

F. The Number and Nature of Similar Marks in Use on Similar Goods

Although Applicant argued this *du Pont* factor by asserting in its brief that a number of third-party registrations for goods and services in various International

⁵⁵ 64 TTABVUE at 15-16 (Gaga's Workshop), 20 (Eau de Gaga); 77 TTABVUE at 6-11 (Gaga's Workshop).

Classes consist of or contain the term GAGA,⁵⁶ Applicant failed to introduce any supporting evidence. Merely listing third-party marks with the International Class noted fails to comply with Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). “To make a third-party registration of record, a copy of the registration, either a copy of the paper USPTO record, or a copy taken from the electronic records of the Office, should be submitted. [citations omitted].” *In re Jump Designs*, 80 USPQ2d 1370, 1372 (TTAB 2006) (also noting that lists that do not show the goods/services of the registrations have “extremely limited probative value” regardless). Thus, the marks listed in Applicant’s brief have not been considered, but we note that even had they been considered, with only one possible exception, they do not appear to be for clothing goods, and therefore lack persuasive force to show any weakness of marks containing GAGA for clothing.

IV. Conclusion

Given the strength of Opposer’s LADY GAGA mark for the clothing items identified in Registration Number 3128335, the similarity of the marks at issue, and the highly related goods that travel in the same trade channels to the same classes of consumers, along with compelling consumer survey results, we conclude that confusion is likely.

In view of our holding of likely confusion, we need not reach the merits of Opposer’s dilution claim. *See Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d at

⁵⁶ Opposer notes in its brief that 5 of the 16 marks are not registered, one of the registered marks is owned by Opposer, and none of the third-party registrations covers goods in International Class 25. 80 TTABVUE at 15.

1755; *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-2040 (TTAB 1989), *aff'd in op. not for pub.*, 17 USPQ2d 1726 (Fed. Cir. 1990).

Decision: The opposition is sustained.