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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

WINTER

**Mailed: May 24, 2013**

**Opposition No. 91202493**

**Ate My Heart Inc.**

**v.**

**Adam Swan**

**Before Bucher, Zervas, and Bergsman,  
Administrative Trademark Judges.**

**By the Board:**

Background

Adam Swan (hereafter “applicant”) seeks to register the mark **BABY GAGA** in standard characters for use in connection with “hats, headbands, infant and toddler one-piece clothing, jackets, pants, shirts, shoes, sweaters, [and] t-shirts.”<sup>1</sup> Ate My Heart, Inc. (hereafter “opposer”) opposes registration on the grounds of deceptiveness, false suggestion of a connection, priority and likelihood of confusion, and dilution, under Sections 2(a), 2(d), and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(a), 1052(d), and 1125(c). In support of

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<sup>1</sup> Application Serial No. 77949907, filed March 3, 2010, based on applicant’s *bona fide* intent to use the mark in commerce. The term “BABY” is disclaimed.

its claims, opposer pleads ownership of three trademark registrations for the mark **LADY GAGA**<sup>2</sup> and rights accrued at common law based on opposer's continuous use of the **LADY GAGA** mark in connection with entertainment related goods and services since September 2006, and in connection with apparel since at least as early as October 2, 2008.<sup>3</sup> Applicant has either denied or claimed to have insufficient information to admit or deny the salient allegations in the notice of opposition.

### **Motion for Summary Judgment**

This case now comes up for consideration of opposer's fully-briefed motion (filed August 30, 2012) for summary judgment on the grounds of priority and likelihood of confusion.

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c)(1). A party moving for summary judgment has the burden of demonstrating the

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<sup>2</sup> U.S. Reg. No. 3695129, issued October 13, 2009, for various clothing for women, men and children; U.S. Reg. No. 3695038, issued October 13, 2009, 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"; and U.S. Reg. No. 3960468, issued May 17, 2011, for various goods and services, including "Clothing, namely, tank tops, t-shirts, jackets, hooded sweatshirts; headwear."

<sup>3</sup> Opposer also pleads ownership of a pending application for the mark **LADY GAGA**, application Serial No. 85115004, filed August 24, 2010, under Sections 1(a), 1(b), and 44(d) of the Trademark Act, for registration of the mark **LADY GAGA** for various goods and services, including "clothing, namely, tank tops, t-shirts, jackets, hooded sweatshirts; headwear."

absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Additionally, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993). Moreover, the Board may only ascertain whether a material fact cannot be or is genuinely disputed, and may not resolve factual disputes, even on cross-motions for summary judgment. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, 23 USPQ2d at 1472.

Further, when a moving party's motion for summary judgment is supported by evidence sufficient to indicate that there is no genuine dispute as to any material fact and the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of a genuine dispute regarding at least one material fact which requires resolution at trial. The nonmoving party, however, may not rest on the mere allegations of its pleadings and assertions, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. Consequently, factual assertions, without evidentiary support, are insufficient to defend against a motion for summary judgment. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1739 (TTAB 2001) ("applicant has produced

no evidence, or raised any expectation that at trial it could produce evidence”); and *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987).

- ***Standing***

At the outset, we must first consider the question of whether opposer has standing to bring this opposition proceeding. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Id.* at 189.

Opposer did not submit proof of the current status of its pleaded registrations.<sup>4</sup> See Trademark Rule 2.122(d)(1). Rather, opposer has submitted only photocopies of the registration certificates for its three pleaded **LADY GAGA** registrations, supported by the declaration of its Chairman and Chief Executive Officer, Troy Carter (Carter dec., Exh. A). In view thereof, opposer must rely on the common law rights it has accrued in the **LADY GAGA** mark to prove standing. See, e.g., *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (common-law use

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<sup>4</sup> Mr. Carter only states that opposer is the owner of the pleaded registrations (Carter dec., ¶3).

sufficient to establish standing); and *Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009).

In that regard, Mr. Carter states in his declaration that “since at least June 2008, [opposer] has continuously used its **LADY GAGA**® Trademarks on clothing and accessories” (Carter dec., ¶13). In addition, attached to the Carter declaration are printouts from opposer’s website through which opposer sells t-shirts, including “Lady Gaga T-shirts,” women’s apparel, and outerwear, namely, sweatshirts with hoods and vests, at the on-line “Lady Gaga Official Store” (Carter dec., Exh. C). Mr. Carter’s averment and evidence of use of a similar mark on the same and similar goods prior to the filing date of the subject application is sufficient to support opposer’s allegations of a reasonable belief that it would be damaged by registration of applicant’s mark. *See Giersch*, 90 USPQ2d at 1022; *Syngenta*, 90 USPQ2d at 1118. We also note that applicant has not disputed opposer’s standing to oppose his application. Accordingly, we find that there is no genuine dispute with respect to the material fact that opposer has standing to bring this proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 189.

- ***Priority***

With respect to opposer's priority, as we noted *supra*, opposer did not submit proof of current status of its pleaded registrations. In view thereof, priority is an issue in this case. *Cf. King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Accordingly, to establish that there is no dispute as to its priority, opposer must rely on its rights in the mark **LADY GAGA** which have accrued at common law. Based on the above-referenced declaration of Mr. Carter (Carter dec., ¶13) and evidence of use of the **LADY GAGA** mark with clothing, we find that opposer has shown that it has used the mark **LADY GAGA** with t-shirts, women's apparel, and outerwear, namely, sweatshirts with hoods and vests, continuously since June 2008.

As to applicant's use of its mark, applicant has not submitted any evidence showing that he has used his mark in connection with the identified goods. In the absence of testimony or other proof demonstrating that the actual use of the mark an applicant seeks to register commenced prior to the filing date of its involved application, the earliest date upon which an applicant may rely in an opposition proceeding is the filing date of its involved application. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991). Applicant's filing date

was March 3, 2010, almost two years after opposer's undisputed date of first use of the mark **LADY GAGA** in connection with clothing.

In view of the foregoing, there is no genuine dispute as to the material fact that opposer has priority with respect to its **LADY GAGA** mark as used in connection with t-shirts, women's apparel, and outerwear, namely, sweatshirts with hoods and vests.

- ***Likelihood of Confusion***

We turn next to opposer's claim of likelihood of confusion claim under Trademark Section 2(d), 15 U.S.C. § 1052(d). "We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the applicant's goods originate from the same source as, or are associated with, opposer's goods." *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the question on a motion for summary judgment, we analyze all of the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), as well as whether there are genuine disputes as to any of these factors which would be material to a decision on the merits.<sup>5</sup> In any likelihood of confusion analysis, however, two key considerations are the similarities between the

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<sup>5</sup> Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. *See Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In this case, opposer also has introduced evidence concerning the fame of opposer's mark.

o *Fame*

We turn first to the factor of fame, because the fame of the prior mark, if it exists, plays a “dominant role in the process of balancing the *du Pont* factors.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). A famous mark has extensive public recognition and renown and enjoys a broad scope of protection or exclusivity of use. *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). *See also Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) (a strong mark “casts a long shadow which competitors must avoid”). Fame may be measured indirectly in a number of ways: by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*,



63 USPQ2d at 1305-06 and 1309. *See also Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 394 (Fed. Cir. 1983).

In support of its argument that the **LADY GAGA** mark is famous, opposer has submitted with the declaration of Mr. Carter photocopies of magazine covers and of magazine and newspaper articles featuring “Lady Gaga,” including Billboard, Rolling Stone, Out, Maxim, People, Nylon, Us, EW.COM (Entertainment Weekly), the Los Angeles Times, USA Today, and The New York Times (Carter dec., Exh. B). Mr. Carter also states that since 2008, “Lady Gaga” has sold more than 23 million albums and 64 million singles worldwide (*Id.*, ¶8); that both Time Magazine and Forbes magazine included “Lady Gaga” in its annual Time 100 list of most influential people, Forbes placing her as number seven on their annual list of the World’s 100 Most Powerful Women (*Id.*, ¶9); that “Lady Gaga” has also received numerous awards and industry acknowledgements, including Grammy Awards, MTV Video Music Awards, People’s Choice Awards, World Music Awards, and International Dance Music Awards (*Id.*, ¶10); and that “Lady Gaga” has been featured on the cover of and/or in articles in several fashion magazines, including Vogue, Vanity Fair, and Elle (*Id.*, ¶11). In addition, applicant has essentially conceded that the mark “**LADY GAGA**” is famous, insofar as he acknowledges opposer’s contention that “so famous is she, when people say “Gaga” in ‘press and in casual reference,’ they mean her” (response at 11).

Much of the evidence is directed to the fame of “Lady Gaga” for musical recordings and entertainment services. Nonetheless, without information on, e.g., advertising expenditures related to opposer’s clothing sales and the volume of sales of clothing (see *Bose v. QSC Audio Products*, 63 USPQ2d 1305-06, 1309), we cannot conclude that there is no genuine dispute as to whether the mark LADY GAGA is famous with respect to clothing. Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). *Cf. UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1883 (TTAB 2011) (finding the mark MOTOWN famous as to musical recordings and entertainment, but not so with respect to non-music related collateral goods in connection with which the mark is licensed and used). However, because we do not treat opposer’s mark as famous with respect to clothing, opposer’s evidence on this factor does not raise a genuine dispute as to a material fact. *Cf. In re Majestic Distilling*, 65 USPQ2d at 1205 (“Although ... the fame of a registered mark is relevant to likelihood of confusion, ... we decline to establish the converse rule that likelihood of confusion is precluded by a registered mark’s not being famous”).

o *Similarity of Goods*

With respect to the similarity of the parties' goods, we must compare the goods identified in applicant's application to those opposer offers under its mark, as disclosed by the evidence. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Additionally, we may find that there is a likelihood of confusion when only one item in a class of goods is commercially similar to a party's goods. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (It is sufficient for a finding of likelihood of confusion if the relatedness is established for any item encompassed by the identification of goods within a particular class in the application). *See also Research in Motion Limited v. Defining Presence Marketing Group, Inc. et al*, 102 USPQ2d 1187 (TTAB 2012) ("Likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application.").

Here, applicant seeks registration of its mark for "hats, headbands, infant and toddler one-piece clothing, jackets, pants, shirts, shoes, sweaters, [and] t-shirts," and opposer uses its mark in connection with t-shirts, women's apparel, and outerwear, namely, hoodies, and vests. One of the parties' goods, *i.e.*, t-shirts, is identical.

There is no dispute that the goods are identical in part. Consequently, the applied-for mark may be refused as to the entire class of goods because

one good identified by applicant and one product actually sold by opposer with the **LADY GAGA** mark is identical. *See Tuxedo Monopoly*, 209 USPQ at 988. *See also Hewlett-Packard Development Company, L.P. v. Vudu, Inc.*, 92 USPQ2d 1630, 1633 n.4 (TTAB 2009) (“it is sufficient if likelihood of confusion is found with respect to use of the mark on any item that comes within the description of goods in the application or registration”) (internal citations omitted).

o *Channels of Trade*

Turning next to the parties’ channels of trade, where, as here, opposer must rely upon common law use of its mark, consideration of the question of likelihood of confusion must be confined to the specific goods on which the mark has been used, as disclosed by the evidence, without the benefit of the presumptions related to trade channels and actual or potential purchasers, which are ordinarily allowed a registration under Trademark Act Section 7(b). *See Asplundh Tree Expert Company v. Defibrator Fiberboard Aktiebolag*, 208 USPQ 954, 959 (TTAB 1980). In this case, opposer’s evidence of record only shows opposer’s on-line sales of clothing in connection with the LADY GAGA mark. However, the opposed application does not include any limitation or restriction as to trade channels or purchasers or uses of its identified goods. Therefore, we must presume that applicant’s goods will be sold in all normal channels of trade (to all usual classes of purchasers for such goods which would include the general public), including on the

internet. *See Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *Toys R Us v. Lamps R Us*, 219 USPQ 340, 343 (TTAB 1983). Thus, applicant's presumed channels of trade must necessarily overlap opposer's proven channels of trade. In view thereof, there is no genuine dispute as to the material fact that the channels of trade for the parties' goods are in part the same. *See Id.*

o *Similarity of the Marks*

With respect to the similarity of the marks, we look to the marks in their entireties as to appearance, sound, meaning or connotation, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In a particular case, any one of these bases for comparison may be critical in finding marks to be similar. In addition, it is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Further, as the fame of a mark increases, the degree of similarity between the marks necessary to support a

conclusion of likely confusion declines. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1310 (“when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark”). Additionally, when the respective goods of the parties are identical, as in this case, it has been held that the degree of similarity between the marks need not be as great to support a finding of likelihood of confusion. *Century 21 Real Estate v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

There is no genuine dispute that the marks LADY GAGA and BABY GAGA are similar. In the first instance, both marks share and end with the same coined,<sup>6</sup> dominant term, “GAGA”, thus, they appear and sound similar. The marks also sound the same because as “lady” and “baby” have a similar cadence. Thus, the marks in their entireties sound very similar. Further, in each mark, the term “GAGA” is preceded by the term “LADY” or the descriptive term “BABY,” which when used in connection with clothing, may evoke an impression of the type of consumer for whom the product is

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<sup>6</sup> Applicant’s contention that there is a genuine dispute as to whether “gaga” is generic is not well-taken. In the first instance, the mark at issue is “**LADY GAGA.**” See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (in the context of a mark consisting of a phrase, “[t]he Board must ... apply the *Marvin Ginn* test to the phrase as a whole, and not focus only on the individual terms”). Further, the argument that opposer’s mark is generic for clothing is without merit and will be given no further consideration. See *H. Marvin Ginn Corp. v. Int’l Assn. of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986) (setting forth two-part test for whether a designation is generic).

intended; that is, the **BABY GAGA** products are for babies, and the **LADY GAGA** products are for adults. Thus, consumers may believe that the marks are somehow connected or affiliated with each other.

“Gaga” is defined as an adjective meaning “silly; crazy,” “completely absorbed, fascinated, or excited,” and “senile; doddering.”<sup>7</sup> GAGA combined with LADY or BABY does not have any particular meaning that is apparent to us, and applicant has not pointed to any particular meaning for its mark. Thus, applicant’s response to opposer’s interrogatories does not raise a genuine dispute for trial as to the connotations of the parties’ marks. Similarly, applicant’s contention that any determination that there is no genuine dispute that the marks are similar is based on speculation because applicant has not yet sold his “Baby Gaga’ clothing” is not well-taken. Actual use of the marks at issue is not necessary to determine whether there is a genuine dispute as to the similarity of the marks. The test under Section 2(d) of the Trademark Act is likelihood of confusion, not actual confusion. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992),

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<sup>7</sup> THE AMERICAN HERITAGE® DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition copyright ©2011 by Houghton Mifflin Harcourt Publishing Company, accessed at <http://www.ahdictionary.com/word/search.html?q=gaga>, on May 22, 2013. The Board may take judicial notice of dictionary definitions, including online reference works which exist in print format or have regular fixed editions. *See, e.g., Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (judicial notice taken of definition from the MERRIAM-WEBSTER ONLINE DICTIONARY). *See also Syngenta Crop Protection, Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009); and *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

*citing Guardian Products Company, Inc. v. Scott Paper Company*, 200 USPQ 738, 742 (“evidence of actual confusion is neither easy to come by nor necessary to show that likelihood of confusion exists”).

In view of the foregoing, there is no genuine dispute regarding the similarity of the marks in terms of appearance, sound, and commercial impression.

- *Unpleaded Defense: Unclean Hands*

We turn finally to applicant’s contention that a genuine dispute exists as to whether opposer’s claim of likelihood of confusion is barred by the affirmative defense of unclean hands. Generally, because applicant failed to plead the equitable defense of unclean hands, we would not consider applicant’s arguments or materials submitted with respect to that defense. “A party may not obtain summary judgment on an unpleaded issue, nor may a party defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense.” *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). However, because opposer did not object to applicant’s arguments and responded on the merits with respect to said defense, we will consider applicant’s contention.

Applicant’s affirmative defense of unclean hands is based on the assertion that “Lady Gaga” infringed on the copyright of a musical group by using a part of the title of a third party’s musical recording, *i.e.*, “gaga,” for



part of her name. In support thereof, applicant has submitted a certified copy of the certificate of copyright registration owned by Raincloud Productions Ltd. for the sound recording entitled “Radio Ga-Ga/I Go Crazy as recorded by Queen.”<sup>8</sup> Applicant’s allegation does not pertain to opposer’s claim of likelihood of confusion. For instance, applicant has not alleged that opposer is not the owner of the mark **LADY GAGA**. Rather, the proposed defense alleges misconduct in connection with opposer’s alleged use of a portion of another party’s song title, which is unrelated to the likelihood of confusion claim to which it is asserted as a defense. The defense of unclean hands must be related to opposer’s claim and, therefore, applicant has not asserted a viable affirmative defense of unclean hands. *See Tony Lama Company, Inc. v. Anthony Di Stefano*, 206 USPQ 176, 179 (TTAB 1980). *See also Warnaco Inc. v. Adventure Knits, Inc.*, 210 USPQ 307 (TTAB 1981) (“the concept of unclean hands denying relief to a plaintiff is not intended to serve as a punishment for extraneous transgressions”); and *VIP Foods, Inc. v. V.I.P. Food Products*, 200 USPQ 105, 113 (TTAB 1978) (“misconduct in the abstract, unrelated to the claim in which it is asserted as a defense does not constitute unclean hands”). In view thereof, applicant’s evidence that a part of a title of a musical recording includes the term “gaga” does not raise a genuine dispute as to a material fact.

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<sup>8</sup> Applicant’s uncontested motion (filed December 14, 2012) to file the exhibit as an attachment to his response to the summary judgment motion is granted. *See* Trademark Rule 2.127(a).

Thus, considering the evidentiary factors set forth in *du Pont* for which there is evidence in the record,<sup>9</sup> and having drawn all justifiable inferences in a light most favorable to applicant, we find that there is no genuine dispute as to the material facts relating to the issue of likelihood of confusion. Because the marks are similar, the goods are in part identical or otherwise related and the goods move in the same channels of trade, we find that as a matter of law that there is a likelihood of confusion with respect to opposer's pleaded LADY GAGA mark and the applied-for mark.

- *Decision*

Having considered the evidence and arguments submitted by the parties, and viewing the evidence in the light most favorable to applicant and drawing all justifiable inferences in favor of applicant, we find that opposer has satisfied its burden of setting forth a *prima facie* showing that there is no genuine dispute as to any material fact remaining for trial, that applicant has failed to demonstrate the existence of a genuine dispute regarding at least one material fact which requires resolution by trial, and that opposer is entitled to judgment as a matter of law as to its claim of priority and likelihood of confusion.

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<sup>9</sup> We have concentrated our discussion on the *du Pont* factors which the parties have discussed and/or on which we have evidence. To the extent that any other factors are applicable, we must treat them as neutral.

Accordingly, opposer's motion for summary judgment is **granted**. The opposition is sustained on the ground of priority and likelihood of confusion, and registration to applicant is refused.

Opposer's Claims under Sections 2(a) and 43(c)

This opposition is also grounded in claims of false suggestion of a connection, deceptiveness, and dilution. In view thereof, opposer is allowed until **THIRTY (30) DAYS** from the mailing date of this order to advise the Board whether it wishes to go forward on any of its other pleaded grounds for opposition,<sup>10</sup> failing which the opposition will be sustained under Section 2(d) of the Trademark Act, registration to applicant of application Serial No. 77949907 will be refused, and the opposition will be dismissed without prejudice as to opposer's remaining claims.

This proceeding is otherwise **SUSPENDED**.



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<sup>10</sup> Should opposer seek to go forward on its claims under Sections 2(a) and 43(c) of the Trademark Act, it will need to re-plead those claims because the notice of opposition fails to state a claim upon which relief can be granted with respect to either the deceptiveness, false suggestion of a connection, or dilution claims referenced on the ESTTA cover sheet. See *In re Budge Manufacturing Co., Inc.*, 837 F.2d 77, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307, 1312 (TTAB 1990), and *In re Quady Winery Inc.*, 221 USPQ 1213, 1214 (TTAB 1984), with respect to opposer's claim under Section 2(a) for deceptiveness; see *In University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), with respect to opposer's claim under Section (a) for false suggestion of a connection; and see *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1172-73 (TTAB 2001), with respect to opposer's dilution claim.