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

Proceeding	91205046
Party	Defendant Ate My Heart Inc.
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Attachments	Motion to Suspend Opposition 91205046.pdf ( 7 pages )(64855 bytes )

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

In the Matter of Trademark Application No. 85215017  
for the mark HAUS OF GAGA

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CHRISTINA SUKLJIAN,	:	
	:	Opposition No. 91205046
Opposer,	:	
	:	
v.	:	
	:	
ATE MY HEART, INC.,	:	
	:	
Applicant.	:	

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**MOTION TO SUSPEND OPPOSITION UNDER 37 C.F.R. § 2.117(a)**

Pursuant to §2.117(a) and TBMP §510.02, Applicant Ate My Heart, Inc. (“AMH”) by and through its undersigned attorneys, respectfully requests that the instant proceedings be suspended pending the final determination of a cancellation action between the parties before the TTAB, Proceeding No. 92055279.

**STATEMENT OF FACTS**

AMH is a wholly owned company of Stefani Germanotta, p/k/a Lady Gaga (“Lady Gaga”). Lady Gaga is one of the most renown performing artists in the world today. Since catapulting onto the music scene in 2008, Lady Gaga has dominated the charts, selling over 23 million albums, over 64 million singles and winning numerous awards including 5 Grammy Awards (and 15 nominations), 13 MTV Video Music Awards, 3 People’s Choice Awards and 5 World Music Awards, to name a few. Besides being recognized for her virtually unparalleled

musical achievements, Lady Gaga has become a fashion icon, known for her often fashion-forward and, at times, bizarre attire.

Lady Gaga, through AMH, owns federally registered trademarks for LADY GAGA® (Reg. Nos. 3960468 in classes 9, 16, 25, 35, 38 and 41 for a variety of goods and services including apparel and accessories, online chat rooms, posters and paper items, musical sound and video recordings, ring tones, and a website; 3695038 in Class 41 for, inter alia, live musical performances; and 3695129 in Class 25 for apparel items) as well as several pending applications covering a wide variety of goods and services including, but not limited to fragrances, cosmetics, candles, jewelry, musical sound recordings, video recordings, online chat rooms, posters, songbooks and pens (collectively the “LADY GAGA® Trademarks”).

Opposer claims to be the owner of a registration in Class 3 for the mark GAGA PURE PLATINUM (“Opposer’s Mark”). Opposer’s Mark was cited against AMH’s applications for the marks LADY GAGA and LADY GAGA FAME by the USPTO. After much due diligence, AMH was unable to locate any use by Opposer of Opposer’s Mark and despite Opposer’s representations to the USPTO, AMH could not confirm that Opposer’s Mark was ever actually in use in commerce. Accordingly, on March 5, 2012 AMH filed a petition to cancel Opposer’s Mark based upon non-use (Proceeding No. 92055279) (the “Cancellation Action”).

Two months after AMH filed the Cancellation Action, on May 1, 2012, Opposer filed the instant opposition against AMH’s application for the mark HAUS OF GAGA (the “Opposition”). In this Opposition, Opposer claims that AMH’s mark is confusingly similar to Opposer’s Mark – the exact same mark that is the subject of AMH’s previously filed Cancellation Action.

The first-filed Cancellation Action has a direct bearing on this case. If Opposer's Mark is ultimately cancelled based upon non-use, then Opposer will have no standing to oppose Applicant's mark in the instant proceeding. At a minimum, if AMH prevails in the Cancellation Action, it would be critical to the outcome of the instant proceeding. Accordingly, AMH respectfully submits that suspension is warranted.

### **SUSPENSION OF THE INSTANT OPPOSITION IS APPROPRIATE**

There is ample precedent that the Board has the authority to suspend a proceeding pending before it if the final determination of another Board proceeding between the parties will have a direct bearing on the issues in the present Opposition. First, pursuant to 37 C.F.R. § 2.117(a), if parties to a "pending case are engaged in ... another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the ... other Board proceeding." *See also* TBMP § 510.02(a) ("[T]he Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on issues before the Board.").

Further, in *Jeffrey Banks, Ltd. v. Jos. A. Bank Clothiers, Inc.*, 226 U.S.P.Q. 942 (D.C. Md 1985), Plaintiff Jeffrey Banks sought a declaratory judgment that its mark JEFFREY BANKS for clothing, did not cause a likelihood of confusion as to Defendant Jos. A. Bank's registered mark JOS. A. BANK. Prior to the federal lawsuit, Jos. A. Bank had filed a Notice of Opposition to the proposed registration of Jeffrey Bank's mark, arguing that Jeffrey Bank's use of the mark was likely to cause confusion with respect to the origin and source of the goods. *Id.* The Board granted Jeffrey Bank's motion to stay the proceedings before the Board pending the resolution of the civil action. *Id.* at 944.

*See also Avenza Systems Inc. v. Avencia Inc.*, 2009 TTAB LEXIS 634 at \*5 n4 (noting that an opposition between the parties was suspended pending resolution of the cancellation action); *Fishking Processors, Inc. v. Fisher King Seafoods Ltd.*, 2007 TTAB LEXIS 60 at \*3 n4 (same); *American Computer Associates, Inc. v. Model American Computer Corporation*, 2000 TTAB LEXIS 706 (TTAB September 29, 2000) (holding that proceedings were suspended pending resolution of cancellation action).

In the instant proceeding, AMH has filed a Cancellation Action against Opposer's Mark because it has a good faith belief that Opposer has not used Opposer's Mark in commerce in at least the past three years prior to the institution of AMH's Cancellation Action. If AMH prevails and Opposer's Mark is cancelled, Opposer would not have any standing in this current Opposition Proceeding. Specifically, it will be virtually impossible for the Board to determine that AMH's mark is likely to be confused with a mark that Opposer no longer owns. Thus, in the interest of judicial economy the Opposition should be stayed pending resolution of the first-filed Cancellation Action. *See* TBMP § 510.02(a). *See, e.g., Full Speed Ahead, Inc. v. SRAM Corp.*, 2008 TTAB LEXIS 618 \*4 n.4 (noting that "if Applicant had wanted us to consider the outcome of the cancellation proceeding ... it should have filed a motion to suspend the opposition proceeding."); *Whopper-Burger, Inc. v. Burger King Corporation*, 171 U.S.P.Q. 805 (TTAB 1971) ("petitioner is seeking, inter alia, to permanently enjoin respondent from using the term "WHOPPER" in connection with the rendering of its services and the sale of goods connected therewith. Additionally, petitioner has asked the United States District Court to direct the Patent Office to cancel Registration No. 782,990 here involved. There can be no doubt therefore that the outcome of the civil action will have a direct bearing on the question of the rights of the parties herein ....").

Based upon the foregoing, AMH respectfully requests that the Board exercise its discretion to grant the instant motion to suspend the Opposition pending the final determination of the Cancellation Action between the parties.

Dated: September 20, 2012

Respectfully Submitted,

By:  \_\_\_\_\_

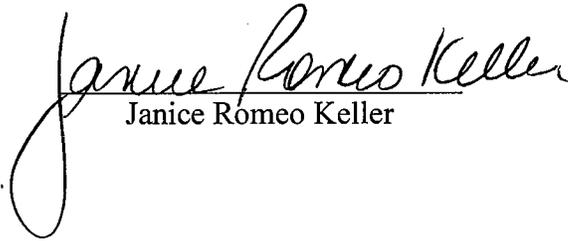
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Attorneys for AMH

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on September 20, 2012, a copy of the foregoing MOTION TO SUSPEND OPPOSITION UNDER 37 CFR § 2.117(a) was served upon Opposer by first class mail at the following address:

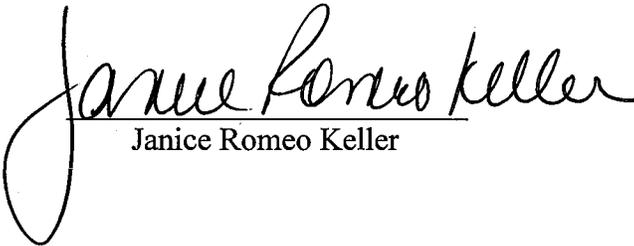
Christina Sukljan  
13 Manor Street  
Albany, NY 12207

  
Janice Romeo Keller

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on October 4, 2012 a copy of the foregoing MOTION TO SUSPEND OPPOSITION UNDER 37 CFR § 2.117(a) was served upon Opposer by first class mail at the following address:

Christina Sukljan  
13 Manor Street  
Albany, NY 12207

  
Janice Romeo Keller