

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**

N/A

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**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE: 8/30/2010**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION**

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3695038 and 3695129. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

**--General Principles in Determining Likelihood of Confusion**

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

**--Similarities Between the Marks**

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

The applicant applied to register the mark LADY GAGA LG, with design. The registered marks are

LADY GAGA; and, LADY GAGA.

The applicant's mark is similar to the registrant's marks. The applicant's mark incorporates the registrant's entire mark and creates the same overall commercial impression as the registrant's marks.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *See Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

#### --Similarities Between the Goods and/or Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

In this case, the applicant's goods identified as "Body jewelry; Bracelets; Broaches; Bronze jewelry; Brooches; Charms; Charms for collar jewelry and bracelet; Costume jewelry; Diamond jewelry; Gemstone jewelry; Identification bracelets; Jewelry; Jewelry and imitation jewelry; Jewelry boxes; Jewelry boxes not of metal; Jewelry boxes of metal; Jewelry boxes of precious metal; Jewelry brooches; Jewelry cases; Jewelry cases not of precious metal; Jewelry cases of precious metal; Jewelry chains; Jewelry for attachment to clothing; Jewelry for the head; Jewelry in the nature of armbands; Jewelry organizers; Jewelry pins for use on hats; Jewelry ring holders; Jewelry to be affixed to bikinis; Jewelry watches; Jewelry, namely, amulets; Jewelry, namely, anklets; Jewelry, namely, arm cuffs; Jewelry, namely, crosses; Lapel pins; Leather jewelry and accessory boxes; Pins being jewelry; Plastic bracelets in the nature of jewelry; Rings; Rings being jewelry; Stainless steel jewelry bracelets; Watches and jewelry; Watches, clocks, jewelry and imitation jewelry" are related to the registrant's goods and services identified as "Clothing for women, men and children, namely, shirts, t-shirts, sweatshirts, blouses, pullovers, tank tops, jackets, coats, sweaters, vests, pants, sweatpants, shorts, bottoms, skirts, and dresses; fashion accessories, namely, hats, caps, visors, headbands, wristbands, hoods, scarves, bandanas, neckties, mufflers, gloves, mittens and belts; underwear, namely, boxer shorts, undershorts, underpants, bras, socks, and hosiery; footwear, namely, shoes, sneakers and boots; swim wear, beachwear, and loungewear, namely, pajamas and robes" and "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."

That is, they are types of goods and/or services which are frequently offered by the same source and under the same mark.

Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely, jewelry, and clothing and musical entertainment services, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii). (See attachments).

--Conclusion

Where the marks create the same overall commercial impression and the goods and/or services are related, confusion as to the source of the goods is likely. For the foregoing reasons the mark is refused registration under Section 2(d) of the Trademark Act.

--IF THE APPLICANT OWNS THE CITED REGISTRATIONS

If the marks in the cited registrations have been assigned to applicant, applicant can provide evidence of ownership of the marks by satisfying one of the following:

(1) Record the assignment with the Office's Assignment Services Branch (ownership transfer documents such as assignments can be filed online at <http://etas.uspto.gov>) and promptly notify the trademark examining attorney that the assignment has been duly recorded;

(2) Submit copies of documents evidencing the chain of title; or

(3) Submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **"Applicant is the owner of U.S. Registration Nos. 3695038 and 3695129."**

TMEP §812.01; *see* 15 U.S.C. §1060; 37 C.F.R. §§2.193(e)(1), 3.25, 3.73; TMEP §502.02(a).

Merely recording a document with the Assignment Services Branch does not constitute a response to an Office action. TMEP §503.01(d).

PRIOR-FILED APPLICATION(S)

The filing dates of pending Application Serial Nos. 77925278 and 85032486 precede applicant's filing date. See attached referenced applications. If one or more of the marks in the referenced applications register, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s). *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced applications.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the marks in the referenced applications. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

## ADDITIONAL ISSUES

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

### NAME OF PARTICULAR LIVING INDIVIDUAL

Applicant must clarify whether the name or signature in the applied-for mark identifies a particular living individual. Written consent is required for registration of a name, including a pseudonym, stage name or nickname, or signature, if the name or signature identifies a specific living individual. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §813; *see* TMEP §§1206 *et seq.*

**If the name or signature shown in the mark identifies a particular living individual**, then applicant must submit the following:

- (1) A written consent, personally signed by the individual whose name or signature appears in the mark, authorizing applicant to register the name, pseudonym, stage name, nickname or signature as a trademark and/or service mark with the USPTO; and
- (2) A statement that **"LADY GAGA"** identifies a living individual whose consent is of record. If the name represents that of a pseudonym, stage name or nickname, applicant must include a statement that **"LADY GAGA"** identifies the stage name of Gwen Germanotta, a living individual whose consent is of record.

*See* TMEP §§813, 813.01(a), 1206.04(a).

**However, if the name or signature in the mark does not identify a living individual**, then applicant must submit a statement that **"LADY GAGA"** does not identify a living individual. TMEP §813.01(b).

### DESCRIPTION OF THE MARK

The description of the mark is accurate but incomplete because it does not describe all the significant aspects of the applied-for mark. Applications for marks not in standard characters must include an accurate and concise description of the entire mark that identifies literal elements as well as any design elements. *See* 37 C.F.R. §2.37; TMEP §§808 *et seq.*

Therefore, applicant must provide a more complete description of the applied-for mark. The following is suggested:

**The mark consists of "LADY GAGA LG" with the letters "LG" in a box, and a line under the "L" in "LADY" and the first "G" in "GAGA".**

### ADDITIONAL FEE REQUIRED

Applicant must submit an additional application processing fee of \$50 per class because the application as filed did not meet the TEAS Plus application filing requirements. *See* 37 C.F.R. §§2.6(a)(1)(iv), 2.22(a), (b); TMEP §§819.01 *et seq.*, 819.04. Specifically, the following application filing requirement(s) was not met: a signed consent from the living individual identified in the mark.

The additional fee is required even if applicant later corrects these application requirements.

## TRADEMARK COUNSEL

Applicant may wish to hire an attorney to assist in prosecuting this application because of the legal technicalities involved. The Office, however, cannot aid in the selection of an attorney. 37 C.F.R. §2.11. Applicant may wish to consult a local telephone directory for a listing of attorneys specializing in trademark or intellectual property law, or seek guidance from a local bar association attorney-referral service.

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. Responding by telephone to authorize an examiner's amendment will not incur this additional fee.

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**TO RESPOND TO THIS LETTER:** Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.