

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85033835
LAW OFFICE ASSIGNED	LAW OFFICE 116
MARK SECTION (no change)	
ARGUMENT(S)	
<p style="text-align: center;"><b>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE</b></p> <p>March 1, 2011</p> <p>John Dwyer, Examining Attorney Law Office 116 Telephone 571-272-9155</p> <p>RE: Serial NO. 85033835 Mark: LADY GAGA <b>L G</b> (&amp; Logo/Design) Applicant: Excite Worldwide, LLC Office Action of: August 30, 2010</p> <p><b>APPLICANT'S RESPONSE TO OFFICE ACTION</b></p> <p>There are two words associated with Applicant's mark, they are: 1) "<u>lady</u>" and 2) "<u>gaga</u>". The first term or word of Applicant's mark "lady" means, as defined in the Merriam Webster's Dictionary: "a) : a woman having proprietary rights or authority especially as a feudal superior b) : a woman receiving the homage or devotion of a knight or lover 2. capitalized : virgin mary —usually used with Our 3. a) : a woman of superior social position b : a woman of refinement and gentle manners". The second term therein "gaga" means, as defined in the Merriam Webster's Dictionary: "1. <b>crazy</b>, foolish 2. <b>marked by wild enthusiasm : infatuated</b>, doting". The two words or terms taken together have meaning that is clear on its face in the English language particularly in relation to the International Class in which they are filed namely jewelry. The Office Action suggests that because there exists a musical recording artist utilizing the combination of the two words as a pseudonym for Ms. Stephanie Germanotta in a different I.C. than Applicant that the two words thereby infer or imply the name of a living <u>individual in a completely different I.C.</u> from those Ms. Germanotta uses her music stage name/pseudonym. Such inference is clearly refuted when the U.S. Trademark Office database is examined pertaining to the marks "MADONNA" and "LADY MADONNA". The latter mark, "Lady Madonna", is registered as is readily referenced under Registration Number 1213333 which mark is registered under International Class ("I.C.") No. 25 the same I.C. as the mark "Madonna" (born Madonna Louise Ciccone; August 16, 1958) the mark, "Madonna", being a registered mark and pseudonym referencing a world renowned American recording artist, actress and entrepreneur. There exists no disclaimer in the U.S.T.O. as to the mark "Lady Madonna" being associated with the recording artist "Madonna". The registrant/owner of the mark "Lady Madonna" solely states that the "Lady Madonna" registered mark does not identify a particular living individual and is merely "fanciful". Applicant in this Response also states that the mark</p>	

in the instant application, "Lady Gaga **L G**" does not identify a particular living individual and is merely "fanciful" as evidenced hereafter below. Applicant respectfully submits that the mere existence of a renowned recording artist having registration of a similar or like mark in a different International Class, or even in the same I.C. such as is the case with "Madonna"; does not necessarily give credence to the mark being the name of a particular individual nor create the likelihood of confusion pertaining to the source or originator of the goods within the same I.C. - or in the case of the Applicant; pertaining to a differing I.C. Further, the mere existence of a recording artist, Stephanie Germanotta ("Germanotta"), utilizing the two words "lady" and "gaga" as a pseudonym or stage name in music, and having registered these two words in a completely different I.C. from the instant application; does not give carte blanche for the two words, "lady" and "gaga", being preserved for Ms. Germanotta in this I.C. 014, jewelry, for reasons fully set forth herein. For the avoidance of doubt, Applicant avers herein that the mark does not identify a particular living individual but instead the mark is merely fanciful. Applicant utilizes the mark for its distinguishable plain and ordinary meaning of the mark itself. Applicant makes no claim to the exclusive right to use the term "lady" and Applicant makes no claim to the exclusive right to use the term "gaga" - apart from the mark as shown.

The Office Action maintains in pertinent part that Applicant's mark should not be registered simply because recording artist, Stephanie Germanotta, is a famous recording artist and has a registration of a pseudonym namesake, a similar mark, in a completely different international class than Applicant's mark - apart from Applicant's designs and/or fonts and/or scripture of its mark. In setting aside, for the moment, the question whether the initial Office Action has actually established that the Germanotta mark is famous, it is well established by way of case law, as follows:

The fame of the [ plaintiff's ] name wasn't sufficient in itself to establish likelihood of confusion under Section 2 (d). " Likely \* \* \* to cause confusion" means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law . . .

*See: University of Notre Dame v. J. C. Gourmet Food Imports Co., Inc.*, 703 F. 2d 1372, 1374 217

There is absolutely no material evidence in the initial Office Action that supports the conclusory allegation that there is a likelihood of confusion between Applicant's mark and that of Examiner's conclusory opinion of Ms. Germanotta's mark(s) in completely different I.C.'s likely to be confused with this Applicant's mark which is solely associated with; i) jewelry goods that have Applicant's or its affiliate companies' patent numbers affixed thereto (on the jewelry and/or its associated packaging), and; ii) Applicant's jewelry goods that possess a unique propensity to glow, and; iii) Applicant's jewelry goods that are distributed solely in the same packaging as Applicant's unique worldwide patented cosmetic goods that also have the unique propensity to glow - wherein all of the foregoing make it implausible that there would be any likelihood of confusion as Applicant's mark and goods in I.C. 014 being sourced from any entity other than Applicant. Any suggestion to the contrary is inconceivable.

The Office Examiner's grounds for denial of registration is unpersuasive. There is no likelihood of confusion of Applicant's good and services in that the Examiner has failed to establish that there would be any likelihood of confusion on the part of consumers between Applicant's mark and that of Ms.

Germanotta's mark particularly in view of the fact that this Applicant's mark shall solely be sold, or offered gratis (or at a substantially reduced price to serve as a "premium" promotional product for Applicant's cosmetic goods) at retail in connection with; Applicant's ***patent protected*** cosmetic goods, specifically United States Patent No. 6582684. Similar to the U.S. Patent No. 6582684 protected cosmetic goods, all of the Applicant's jewelry goods offered in I.C. 014 shall also have the propensity to glow upon the withdrawal of light via a patent protected type of pigment embedded upon, or place inside a transparency in the jewelry, which said pigment then gives Applicant's jewelry the inherent propensity to glow a specific color either upon the withdrawal of light and/or in dim light and in a lit environment. The Applicant, and/or its affiliate companies, shall be the source of, and the originator of; the mark's unique patent protected goods in each and every jurisdiction in which the instant Applicant's mark is affixed upon the jewelry goods themselves and/or affixed upon packaging containing Applicant's, or its affiliate entities', unique patent protected goods. Applicant and/or its affiliate companies shall be the sole source in the United States of Applicant's U.S. patent protected phosphorescent-like glow pigment affixed either upon, and/or embedded in, transparent areas of the jewelry; resulting thereby in Applicant's exclusive patent protected light emitting jewelry goods, sold or offered gratis (or at a substantially reduced price) at retail in direct distribution and connection with; Applicant's U.S. Patent protected cosmetic glow goods. The source of the Applicant's goods in I.C. 014 cannot be confused with those of any other entity in that a unique, exclusive, and substantially distinguishing characteristic of the Applicant's mark is the unequivocal fact that the Applicant's mark shall always be placed either directly upon Applicant's goods and/or upon Applicant's packaging, which Applicant's goods and Applicant's packaging shall all have Applicant's patent numbers directly appearing next to the Applicant's mark which together (along with Applicant's distinguishable exclusive propensity to glow) unmistakably identify this Applicant as the sole and exclusive source of the Applicant's jewelry goods and Applicant's mark in I.C. 014. Further, all of Applicant's jewelry goods are embedded with a patent protected phosphorescent-like light emitting pigment which has received patent protection associated exclusively with Applicant. The Applicant's jewelry goods shall have the mark affixed directly upon Applicant's goods, and/or upon the packaging of Applicant's goods, which goods have the unique propensity to glow ***a specific color***, from the pantene color chart, in daylight and upon the withdrawal of light, for extended intervals of time (several hours). The exclusive distinguishing property of Applicant's jewelry goods is attributed to Applicant's, and/or its affiliate companies', patent protected small phosphorescent-like pigment particles being either embedded onto the goods and/or integrated inside a transparent consistency in localities of the jewelry goods and thereby the jewelry goods have a unique, exclusive, and distinguishable transparent consistency from which light emulates from Applicant's jewelry goods in all environments and most notably in dimly lit environments; such as lounges, movies theaters, darkened bedrooms, and similar environments. Further, Applicant's jewelry goods shall be offered solely as a "premium" promotional jewelry good offering exclusively by Applicant in the same packaging and via the same sales channels as Applicant's patent protected cosmetic goods. In view of the foregoing, Applicant's jewelry goods are only identified by consumers as having originated from the Applicant. Applicant's mark, and its jewelry goods, are respectively: i) affixed upon, and; ii) packaged directly with - Applicant's exclusive U.S. patent protected (and worldwide patented) cosmetic goods. In determining whether a likelihood of confusion exists between a similar mark and an applicant's mark, the Board considers the thirteen non-exclusive factors discussed by the Court of Customs and Patent Appeals: *In re E I Dupont de Nemours & Co.*, 476F .2d 1357, 1361, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973. ***See also***: *7-Eleven Inc. V. Wechsler* 83 U.S.P.O. 2d 1715, 1719 (TTAB 2007).

No one du Pont likelihood of confusion factor is dispositive and the emphasis of each factor may vary depending on the circumstances of the case. In this case nearly all of the relevant factors mitigate against a likelihood of confusion. In particular, given the facts of this case, factors that should weigh

most heavily in granting this Application are four fold;

First: the distinguishable nature of Applicant's goods - all of which are patent protected from encroachment by Ms. Germanotta or any other unlicensed distributor/producer or originator of this Applicant's goods in International Class 014, on which Applicant's mark shall be affixed; and this Applicant's mark cannot be confused with Ms. Germanotta as a source of the goods in I.C. 014 are the further additional undeniable facts that; Second: the inherently unique nature of the patent protected phosphorescent pigment which glows a specific color for extended intervals of time, both in lit environments and more significantly upon the withdrawal of light or in dim light, which pigment is always affixed to Applicant's goods in I.C. 014 and their being sold or offered at retail solely and exclusively with Applicant's U.S. Patent protected cosmetic goods, U.S. Patent No. 6582684, originating from Applicant and/or its affiliate companies makes the Applicant's goods inherently so unique and identifiable as to their source of origination that there can be no likelihood of confusion whatsoever; because the patent registration numbers in the U.S., Canada, and the European block of nations for this I.C. of goods, namely jewelry, and the U.S. Patent No. 6582684 (for Applicant's cosmetic goods) shall be affixed on each and every package and container of Applicant's jewelry goods in I.C. 014; making their source of origination not only plainly and ostensibly clear to consumers as to having originated solely from Applicant and its affiliate companies, and furthermore; Third: The additional and third consideration as to there being no likelihood of confusion whatsoever as to the source of this Applicant's jewelry goods and the mark not being confused by the consumer purchasing this Applicant's goods, in that the source of this Applicant's worldwide patented goods cannot be sourced from anyone else, including from Ms. Germanotta. The unequivocal fact is that Ms. Germanotta as well as others in North America and throughout the industrialized world (including but not necessarily limited to the U.S., Canada, and the European block of nations that participate in the Patent Cooperation Treaty - "PCT") cannot utilize, or be a source of, Applicant's jewelry goods due to Applicant's jewelry goods uniquely glowing with patent protected phosphor-like pigments that are affixed to the jewelry goods, or embedded in a transparent consistency in localities of the jewelry goods without infringing upon patent protected Applicant's goods. Applicant can be the sole source of these distinguishable jewelry goods, and; Fourth: Applicant's unique packaging of Applicant's jewelry goods has decorum of the Applicant's patent protected goods having the propensity to glow specific colors (from the pantene color chart and as captioned above) and the unique characteristic of glowing for extensive intervals of time - six (6) to eight (8) hours of duration. Additionally, other descriptive marks unique to Applicant are affixed on the packaging of Applicant's patent protected goods; which marks make Applicant's goods further distinguishable from any other entity, apart from Applicant, and which other distinguishing marks (apart from the mark in the instant Application) affixed on Applicant's goods and/or packaging are unique to, and emanate solely from, this Applicant, and which other Applicant's marks are further protected by intellectual property rights in the United States and other WIPO jurisdictions. Fifth: In this case, nearly all of the relevant factors militate against a finding of likelihood of confusion. In particular, given the facts of this case, the factor that should weigh most heavily is the dissimilarity of the goods in question. Because there is absolutely no relation between the parties' goods and services, there is simply no likelihood of confusion.

Applicant's goods are totally dissimilar to those of Germanotta's . Applicant's intent is use of its mark on, or in association with, solely its patent protected jewelry goods sourced and distributed with solely its exclusive unique and distinguishable U.S. Patent protected produced cosmetic goods with registered worldwide patent numbers identifying Applicant as the sole and exclusive source and originator of the jewelry goods in I.C. 014. Further, Applicant shall use its mark on, or in association with, solely its

exclusive patent protected phosphorescent-like pigments affixed upon, or embedded within a transparent consistency in localities of the jewelry goods of Applicant's jewelry goods that have the propensity to glow specific pantene colors in lit environments significantly in dim light or upon withdrawal of light which jewelry goods of Applicant are sourced from, and distributed exclusively by - Applicant. Germanotta uses her pseudonym to sell her musical recordings or her articles of clothing at musical venues and music concerts. The notion that Germanotta's pseudonym registered in, or attempted to be registered in, completely different I.C.'s from Applicant (music and clothing), has anything to do with Applicant's unique jewelry goods with patent protected materials and a unique propensity to glow - is simply implausible. Any contention that goods in the I.C.'s of clothing or jewelry at some large mega-stores may be sold in the same building or under the same roof would preclude Applicant's registration because of goods in clothing and jewelry being in the same distribution channels is not reasoning enough to make an inference that clothing and jewelry are "closely related" as somehow causing confusion to consumers, particularly in view of Applicant's inherently unique and exclusive patent protected propensity to glow characteristics and materials used on the jewelry goods exclusively by Applicant. Walmart, Target, Macy's and the like sell numerous articles of goods as "mega-store" retailers, and by mega-store retailers doing so; does not thereby give credence to a conclusory opinion that thereby clothing and jewelry are closely intertwined that similar marks in these distinguishable I.C.'s (clothing and jewelry) will be somehow confused as to origin of goods. The foregoing argument also militates against any likelihood of confusion between Germanotta's music/entertainment goods which are also distinct from Applicant's goods. There is no mechanical test for determining likelihood of confusion. The issue is not whether the actual goods are likely to be confused but, rather, whether there is a likelihood of confusion as to the *source* of the goods. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein. **Each case must be decided on its own facts.**

Examiner nonetheless asserts that Germanotta's goods are either "closely related" to those of Applicant's or somehow can be confusingly similar. They cannot be confusingly similar, nor are they; due to the exclusivity of the patent protected nature of Applicant's goods and their distinguishing characteristics setting Applicant's goods apart from all others in I.C. 014. Clothing and cosmetics are distinct International Classes and the suggestion that some retailers may sell these separate classes of items under the same roof does not thereby make the goods closely related. Such a suggestion is nonsensical in that in the U.S. and other jurisdictions it is well known that "Starbucks Coffee" retail outlets frequently sell: music, books, food, and clothing related articles all in close proximity to each other under one roof, including possibly Ms. Germanotta's musical recordings, but such retailing does not thereby make Germanotta's goods closely related to the Applicant's. There is not one scintilla of evidence to support this notion. Examiner has introduced nothing to credibly controvert the fact that Applicant's goods are wholly unrelated to those sold by Germanotta or proposed to be sold by Germanotta.

Germanotta's application filed several months after Applicant's instant application in fact does **not** meet the criteria of the U.S.T.O. . Pertaining to Germanotta's Application - Serial Number 85115004; it is clearly evident after careful examination - that the specimen that Germanotta submitted in Application Serial Number 85115004 is not a "**bona fide**" use of the mark in I.C. 003 of cosmetics. Instead, Germanotta's pending application Serial Number 85115004 is an **ornamental** use of the mark in I.C. 003 wherein the origination of the cosmetic goods were from "**MAC**" **Cosmetics, Serial Number 78581906** in I.C. 003.

Germanotta and recording artist Cyndi Lauper, did both lend their likeness to MAC Cosmetic's traditional annual campaign for "***Viva Glam***" to promote the MAC Cosmetics "MAC Aids Fund". The

foregoing MAC Cosmetics company (a division of Estee Lauder Company) is the source, manufacturer, and originator of the Germanotta cosmetic goods, not Germanotta as the Germanotta Application - Serial Number 85115004 falsely contends. Instead, Germanotta's specimen was and is from a (customarily) annual promotional campaign for MAC Cosmetic's which was and is the originator/manufacturer/distributor and source of the goods and specimen submitted in Germanotta's Application No. Serial Number 85115004 for registration of a like mark in I.C. 003. The Germanotta specimen appearing in Germanotta's Application Serial Number 85115004 was sourced from, and originated from, MAC Cosmetics, not by applicant Germanotta, along with recording artist Cyndi Lauper's name and likeness, being a specimen also used by MAC Cosmetics for the Viva Glam campaign of MAC Cosmetics (manufacturer); both specimens (Lauper's and Germanotta's) appeared on MAC Cosmetic goods, labeled as MAC Cosmetic goods, and sold with the ornamental endorsement of Germanotta and Lauper for the "MAC Aids Fund". Clear and convincing evidence of the foregoing fact can be ostensibly evidenced, by the Examiner in the U.S.T.O.; referencing the following "http" web directory address which shows MAC Cosmetics as the true source of the ornamental specimen submitted in Germanotta's Application Serial Number 85115004: <http://www.temptalia.com/mac-from-our-lips-collection-lady-gaga-cyndi-lauper-for-viva-glam-swatches-product-photos>. Germanotta's Application Serial Number 85115004 fraudulently alleges to have originated from Germanotta as the specimen's source of the goods, which is erroneous, and Germanotta deceptively attempts to perpetrate fraud upon the U.S.T.O. in her Application Serial Number 85115004. Germanotta's Application Serial Number 85115004 does not satisfy the U.S.T.O. criteria of "**bona fide**" use of the mark in Application Serial Number 85115004 in I.C. 003. Instead, Germanotta falsely, arbitrarily, and capriciously lists first "bona fide" use of Applicant's mark in I.C. 003 which in reality was solely an ornamental use of the mark originating from the manufacturer of the cosmetic good specimen; MAC Cosmetics. In reality MAC Cosmetics was the source of the specimen and cosmetic goods with Germanotta's stage name/pseudonym ornamentally used to promote MAC Cosmetics goods which was the originator, manufacturer, distributor, and retailer of the cosmetic goods. The ornamental use of both the Germanotta likeness/stage name and Cyndi Lauper (another recording artist) likeness and/or signatures affixed to MAC Cosmetic goods to promote and sell MAC Cosmetics branded and labeled cosmetic goods for MAC Cosmetic's traditional annual Viva Glam campaign to raise funds for MAC Cosmetic's "MAC Aids Fund" is not bona fide use of the mark in I.C. 003 as falsely maintained by Germanotta in Application Serial Number 85115004. MAC Cosmetics has also utilized recording artist "Mary J. Blige" and multiple other recording artists on their MAC Cosmetic goods to promote their branded cosmetics line for Viva Glam and/or similar ornamental adornment of a celebrities' signature endorsement and/or likeness on MAC Cosmetic goods for the specific purpose to promote MAC Cosmetic goods which is ornamental use. Germanotta's Application Serial Number 85115004 in I.C. 003 is an attempt to perpetrate fraud ab initio upon the U.S.T.O. . Germanotta's Application Serial Number 85115004 in I.C. 003 should be invalidated as it pertains to I.C. 003 and all other I.C.'s therein, including but not limited to I.C. 014, in that the Trademark Trial and Appeals Board in instances of fraud ab initio upon the U.S.T.O. in instances such as this (Germanotta's instant Application Serial Number 85115004) has routinely rescinded the entire Application when fraud ab initio is being committed by an applicant; as is being attempted and perpetrated by Germanotta in Application Serial Number 85115004 as is readily evidenced by the U.S.T.O. Examiner's careful examination of said Germanotta application. Further, Germanotta conveniently and deceptively lists "bona fide" use of her submitted specimen in Application Serial Number 85115004 in I.C. 003 as alleged to have been used in a "bona fide" manner sourcing Germanotta I.C. 003 cosmetic goods as originating from Germanotta (when instead they originated from MAC Cosmetics) - erroneously alleging by Germanotta there having been "bona fide" prior use by Germanotta to this Applicant's filing of the instant Application, which in view of fraud ab initio being a material part of Germanotta's Application Serial Number 85115004 - Germanotta's Application Serial Number 85115004 should be

stricken and rescinded in its entirety. To further demonstrate to the U.S.T.O. that Germanotta improperly attempts to fraudulently derail Applicant's instant application her representatives after noting Applicant's instant application having been filed in the U.S.T.O. did cause to be sent to Applicant the attached letter marked as **Exhibit A**. If indeed applicant Germanotta in her Application Serial Number 85115004 in I.C. 003 had indeed factually and in reality been a "**bona fide**" user of Germanotta's specimen in I.C. 003, as presently erroneously alleged to the U.S.T.O. in Germanotta's application filed on August 24, 2010; the intellectual property law firm that caused the letter marked as Exhibit A and attached hereto, to be sent to Applicant, therein requesting that Applicant's instant application be withdrawn would have maintained in said letter a "bona fide" prior use in the June 14, 2010 letter addressed to Applicant - Exhibit A (attached). They did not. Instead, the June 14, 2010 letter, Exhibit A, does not anywhere therein maintain any bona fide prior use by Germanotta - because in reality there was none. This Applicant preceded Germanotta in filing for the mark in I.C. 003 in the U.S.T.O. and has no intent of withdrawing it's application as requested by Germanotta's June, 14 2010 letter. When Applicant remained steadfast and did not withdraw the instant application; thereafter, Germanotta concocted a contrivance to commit **fraud ab initio** upon the U.S.T.O. in an attempt to derail this Application (falsely claiming an earlier priority use date) claiming "bona fide" use derived from the MAC Cosmetic's goods in Application Serial Number 85115004 in I.C. 003. There is clear and convincing evidence as demonstrated above to the U.S.T.O. that Germanotta, in her Application Serial Number 85115004 in I.C. 003, **falsely** certifies to the U.S.T.O. "bona fide" use. In reality the alleged bona fide use, now fraudulently maintained in Germanotta's Application; was in actuality ornamental use by MAC Cosmetics (not bona fide use by applicant Germanotta as alleged in her application) using the likeness of Germanotta and Cyndi Lauper for MAC Cosmetic branded, manufactured, distributed cosmetics originating from MAC Cosmetics. Germanotta falsely maintains to the U.S.T.O. that MAC's traditionally annual "Viva Glam" campaign using Germanotta's likeness in an ornamental manner upon MAC goods to sell MAC Cosmetics to benefit the MAC AIDS Fund via sale of MAC Cosmetic's goods in I.C. 003 with the MAC Cosmetics **Serial Number** 78581906 mark "MAC" being the true originator, manufacturer, distributor, and retailer of the cosmetic specimen was instead as Germanotta falsely submits to the U.S.T.O. in her Application Serial Number 85115004 in I.C. 003 as being "bona fide" use of the mark by Germanotta, in lieu of MAC Cosmetics. Germanotta's said application is fraudulent and plainly a false contention. Instead, it is **fraud ab initio** being perpetrated upon the U.S.T.O., by Germanotta, in her Application Serial Number 85115004. Germanotta's Application Serial Number 85115004 in I.C. 003 should be voided in its entirety for perpetrating a **fraud ab initio** upon the U.S.T.O. and thereby (perpetrating fraud) attempting to derail this Applicant's applications; Serial Number 85032486 in I.C. 003 and Applicant's instant application, under fraudulent and false pretenses by Germanotta. In view of the above fact that Germanotta's Application Serial Number 85115004 attempts to commit fraud ab initio upon the U.S.T.O. it should be invalidated in its entirety as it pertains to all I.C.'s therein, including but not limited to, I.C. 014.

### Consent

The name and/or design(s) "Lady Gaga LG" shown in the mark is merely fanciful and does not identify a particular living individual.

### Refusal – Mark Identifies a Particular Living Individual

Applicant acknowledges that there exists a recording artist with the birth name of Stephanie Germanotta that utilizes the stage name or pseudonym of "Lady Gaga". Applicant neither acknowledges nor denies the notoriety of Ms. Germanotta. The Office Action pertaining to Ms. Germanotta utilizing a stage name or pseudonym registered in I.C. 041 of musical entertainment goods when considering the unique

distinguishable patent protected characteristic features of Applicant's goods, it is respectfully submitted that Germanotta's registration of a similar mark in completely differing I.C.'s to be immaterial to Applicant's submission of this application in International Class ("I.C.") 014 in view of the fact that the Applicant is attaching the mark solely to its packaging containing its patent protected goods and/or upon the goods themselves which have Applicant's patent protected materials on its goods making Applicant's goods exclusive. Further to the foregoing Applicant's trademark affixed on Applicant's goods, and/or Applicant's packaging of its goods; shall be associated solely with a class of cosmetics that has been patented worldwide, specifically in the U.S. as U.S. Patent No. 6582684, and which patent is and has been exclusively controlled for over a decade by Applicant and its affiliate companies. In addition to the above consideration the Applicant's exclusive patent rights for the goods associated with Applicant (and its affiliate entities) cannot be utilized in the United States, Canada, nor Europe by any other entity, apart from Applicant, in that Applicant has a distribution network worldwide of its patented phosphorescent-like pigments, affixed in and/or on the jewelry goods, and Applicant shall distribute the goods in the instant Application solely with its exclusive U.S. Patent protected cosmetic goods - which can only originate from Applicant and its affiliate companies; otherwise Ms. Germanotta or any other third-party entity would be infringing upon an intellectual property right exclusively controlled by Applicant, and by its affiliated controlled entities, in the industrialized world.

#### Refusal – Likelihood of Confusion

Ms. Germanotta who the preliminary Office Action references is notably known in media circles and often referred to as "**GAGA**". It is a far stretch that the preliminary Office Action suggest that Ms. Germanotta has a monopoly of all goods and products with the word "gaga" and/or "lady" on them. Furthermore, the Applicant's goods and products in IC 014 are distinctive and distinguishable in that they have incorporated into the goods, and/or upon the goods, phosphorescent-like glowing pigments of specific pantene colors. Additionally, Applicant's goods shall be distributed, packaged with, and have patent numbers and other U.S. trademarks sourcing the origination of Applicant's goods as being solely from this Applicant or any of its controlled and affiliated entities. Further, Applicant's goods shall have on all packaging, and/or directly upon the goods themselves; exclusive intellectual property protections such as Applicant's patent Numbers in the United States, Canada, and Europe distinguishing this Applicant as the sole source of the goods in the instant application. As cited above the registrant in I.C. 25 for "Madonna" and "Lady Madonna" have been deemed by the U.S. Trademark Office to be distinguishable within the same international class of clothing (I.C. 25) where Registrant recording artist Madonna Louise Ciccone, who is much more renowned than Ms. Germanotta having sold hundreds of millions more recordings worldwide, Registrant No. 1473554 has been deemed to have readily distinguishable goods and products from Registrant No. 1213333 "Lady Madonna", wherein recording artist, Madonna Louise Ciccone, sells clothes deemed to be distinguishable from the latter Madonna registrant in that the latter registrant focuses upon "maternity" clothes. The **type of clothes**, in the same I.C., is deemed distinguishable by consumers, and there is no cause for confusion by consumers, in the preceding registrations, as ostensibly permitted by the U.S.T.O. in the preceding "Madonna" mark registrations, by differing registrants, with similar marks; "Madonna" and "Lady Madonna".

In addition to the foregoing acknowledgment by the U.S. Trademark Office pertaining to the above captioned "Madonna" marks; that like marks can co-exist not only in the same International Class without the likelihood of confusion, it is brought to the Examiner's attention that in the instant application the I.C. is readily and easily discernable as well as distinguishable from Ms. Germanotta's registration of entertainment related services and goods in I.C. 041 which I.C. is completely disparate from this Applicant's mark in I.C. 014. Further distinguishable is the fact that this Applicant's goods and products in I.C. 014 are unique and exclusive to Applicant in that Applicant's goods and products



in I.C. 014 can only originate from Applicant because there are worldwide patents in the entire U.S., all of Canada, and throughout all of Europe attached to Applicant's goods and products as fully set forth above. There can be no "false association" when Ms. Germanotta cannot source Applicant's goods without obtaining a license to do so from Applicant or from its controlled affiliated companies that wholly own and/or administer the intellectual rights to worldwide patents specific to Applicant's distinct and unique goods as specifically described herein.

#### Comparison of the Marks

For the avoidance of doubt pertaining to Applicant's distinguishability of the mark of Applicant in I.C. 014 the mark is being applied solely by Applicant onto goods with patent protected phosphorescent-like glow pigments embedded on, and/or embedded into the jewelry's transparent consistency in localities of the jewelry goods, and then distributed by Applicant at retail directly in packaging along with Applicant's U.S. patented cosmetic products that can only be manufactured, marketed, and distributed by Applicant and its wholly owned or controlled affiliate entities; due to Applicant's exclusivity of the patents connected to the goods (as specifically described herein) and caused to be manufactured by Applicant and its affiliate companies (collectively herein referred to as "Applicant"). The worldwide patents controlled and/or owned by Applicant have a distinguishable characteristic from any product or good that Ms. Germanotta would proffer to the public in that Applicant controls the worldwide patents, for the unique and distinguishable goods as set forth specifically in detail herein; exclusively in the industrialized world. Applicant and its wholly owned and/or controlled affiliate entities plan to limit the mark in the instant application to the goods that are solely associated with these worldwide patented goods and products controlled by Applicant with the propensity to glow specific colors and for long durations of time - as full set forth herein. In view of the foregoing the marks not only are applied to goods with U.S. Patent numbers ostensibly notifying consumers of the exclusive source of Applicant's marks, which patent numbers are exclusively and ostensibly identifying Applicant as the source of the jewelry goods. Further, Applicant's jewelry goods are distinguishable from all others in I.C. 014 with the patent protected phosphorescent-like glow pigments being affixed on, and/or inside, Applicant's jewelry goods causing them to have a unique, distinguishable and exclusive characteristic and propensity to glow specific colors in all environments, as more specifically described above. Also, Applicant's U.S. Patent No. 6582684 shall appear next to Applicant's mark affixed to the goods packaging in which the Applicant's jewelry goods shall be delivered to consumers. Also the mark distinctively consists of the wording "LADY GAGA **L G**". The mark's unique logo and design further sets the mark apart from others, apart from its U.S. patent protection, providing distinct evidence of the goods origin to consumers; and the mark's design along with Applicant's goods exclusive U.S. patent registrations duly apprises consumers of the sole source of the mark from Applicant, and from its wholly owned and/or controlled affiliate companies, along with the distinct fact that the mark affixed on Applicant's cosmetic goods has a unique propensity to glow various specific patent colors in all environments and for extended intervals of time and even more significantly upon the withdrawal of light from the jewelry goods.

#### Comparison of the Goods

The preliminary Office Action mistakenly intimates that the clothing of Ms. Germanotta is related to the patented cosmetic products of Applicant. There is no clothing product that is remotely related to the patented protected elements affixed onto and/or into Applicant's jewelry goods and Applicant's products that emanate from Applicant and and/or any of its affiliate entities. The suggestion that Germanotta's clothing registration of the mark "lady gaga" is a controlling or material factor pertaining to feasibility of Applicant's registration of "lady gaga" in I.C. 014, jewelry goods, is a far stretch from

what in reality the U.S.T.O. has declared permissible for similar marks in other I.C.'s particularly in view of the registration of the mark "GAGA" in I.C. 003 along with numerous other registrations of the mark "GAGA" that the U.S.T.O. allowed the following (listed below) multiple registrations of the mark "GAGA". "GAGA" either as a stand alone mark or in combination with some other word. Germanotta's alleged notoriety in the initial Office Action is not sufficient reason to decline to register this Applicant's mark in I.C. 014 based upon all of the facts contained in Applicant's instant Reply to the initial Office Action of the U.S.T.O. . The U.S.T.O. did register the mark "GAGA", and varied combinations thereof, which mark "GAGA" Ms. Germanotta is notoriously referred to as by both consumers and mainstream media alike. Germanotta has publicly acknowledged "GAGA" presently being her pseudonym stage name; Ms. Germanotta stating the foregoing fact on CBS's "60 Minutes" interview with Anderson Cooper airing on Sunday, February 13th, 2011. It cannot be the position that by the U.S.T.O. referencing Germanotta being notable in the distinct class of music and entertainment and thereby this Applicant's mark should be treated in a disparate manner from other applicants, particularly in view of the fact that mainstream media, Germanotta, and fans routinely refer to Germanotta as "GAGA". The U.S.T.O. is collaterally estopped from now taking an alternate position that Germanotta is notable in media, is often referred to as "GAGA", and thereby the instant application should be precluded from registration in I.C. 014. No such daunting leap of association has been made previously by the U.S.T.O. pertaining to other U.S.T.O. applicant registrants let alone suggested by the U.S.T.O. in the several registrations of the mark "GAGA" which are numerous and which in pertinent part are registered by the U.S.T.O. as evidenced and enumerated hereafter:

**ONE: Word Mark GAGA Goods and Services IC 045 G & S: web site featuring on-line dating services; web site featuring on-line social network services based on topics.... Registration Number 3324168**

**TWO: Word Mark GAGA Goods and Services IC 041 G & S: TELEVISION SHOW PRODUCTION, NAMELY TELEVISION SHOWS ABOUT HEALTHY LIVING, EXERCISE, AND NUTRITION; TELEVISION SHOWS ABOUT BODY, MIND, SPIRIT, AND ACHIEVEMENT Registration Number 3208898**

**THREE: Word Mark GOING GAGA Goods and Services IC 003 G & S: Non-medicated indoor and outdoor skin tanning preparations. Registration Number 3898102**

**FOUR: Word Mark BOBOGAGA Goods and Services IC 014 G & S: Jewelry. Registration Number 3877995**

**FIVE: Word Mark GAGA Goods and Services IC 030 G & S: Frozen confections; Frozen yogurt; Fruit ice bar; Ice cream; Sherbet. Registration Number 3821746**

**SIX: Word Mark BABY GAGA Goods and Services IC 035 Providing a website featuring product information and product reviews of the goods and services of others in the field of baby products; promoting the goods and services of others by providing a website at which users can link to consumer goods of others in the field of baby products Registration Number 3372033**

**SEVEN: Word Mark GAGA SISTERHOOD Goods and Services IC 016 G & S: Educational books and brochures in the field of grand parenting and useful goods for grandchildren to serve grandmothers and their interests. IC 035. Advertising the goods and services of others; providing a website with business information featuring product information, product reviews of goods and services for grandmothers. Registration Number 3624373**

**Word Mark LIFE IS GAGA. Goods and Services IC 025 G & S: Baby clothes, namely, shirts and pants Registration Number 3604621**

**Word Mark GO GAGA Goods and Services IC 018 G & S: Diaper bags. Registration Number 3671443**

**Word Mark GAGA'S SHERBETTER Goods and Services IC 030 Registration Number 3281716**

**Word Mark GAGA PURE PLATINUM Goods and Services IC 003 G & S: Cosmetics; namely nail polish, lipstick, lip-gloss, eye-liner, lip-liner, eye shadow, face powder, blush, mascara Registration Number 2898544**

**Word Mark GAGA'S ORIGINAL LEMON SHERBETTER Registration Number 2980568**

Indeed, Ms. Germanotta's followers on "Twitter demonstrates that she appeals to a technologically savvy clientele, including but not necessarily limited to the gay and lesbian communities of which are some of her most ardent followers. These consumers are not only savvy but tend to frequent boutique retail outlets that would be most often apart from mainstream outlets and these consumers undoubtedly follow the technological trends and marketing outlets of Ms. Germanotta on Twitter and other social networks. The instant Applicant has by means of prosecuting its intellectual property technology in I.C. 003 (in associated areas of phosphorescent-like glow materials) established its own unique exclusive cosmetic goods which are and have been patented in the U.S. for approximately eleven years, which U.S. Patent No. is 6582684. Germanotta's followers would notice the Applicant's patent protection U.S. Patent Number(s) and other jurisdictions patent numbers affixed to all of its goods, including the jewelry goods; which are premium patent protected products that are exclusively distributed in the same distribution networks and channels with Applicant's patented cosmetic goods. Unmistakably, this Applicant can only be identified as the sole originator or source of these goods in I.C. 014; in that they are unique to Applicant and to its wholly owned and/or controlled affiliate entities. Also, Applicant has been further developing a technological distribution network through a portal of channel of both marketing and selling its patent protected products solely via the channels to be listed on its worldwide website which is and has been established which is: "LADYGAGACOSMETICS.COM". To assure that there is no confusion of the origination of all goods and products released by Applicant all of its goods shall be offered at retail as a "premium" sales incentive gratis, or at a reduced price, product offering (as specified above) and all of Applicant's goods shall bear Applicant's U.S Patent Number 6582684 as well as other phosphorescent-like pigment patent protected numbers on all of its goods and/or packaging containing Applicant's goods and marks in the U.S. . For the avoidance of doubt, and to avoid any confusion whatsoever; Applicant restricts its entire line of goods in I.C. 014 to solely its unique phosphorescent-like light emitting jewelry line of goods as described herein and to be distributed at retail packaged in the same containers or associated containers with Applicant's cosmetic line of U.S. patented products and they shall be exclusively listed on Applicant's "http" portal on the worldwide web in that Applicant's goods are unique and distinguishable from anything in the marketplace and need not rely upon anyone apart from Applicant. Applicant maintains that the mark in I.C. 014 is readily distinguishable and does not confuse the public as to sourcing or origination of the goods and/or products. Applicant's, and its wholly owned and/or controlled affiliate entities', unique U.S. Patent protection of exclusivity of its jewelry good offerings in the U.S. and in other jurisdictions worldwide further potentiate the fact that there is no likelihood of confusion pertaining to Germanotta and the Applicant's source of cosmetic goods. In Hasbro, Inc., vs Clue Computing, Inc., in the Second District, Judge Woodlock made an interesting and relevant observation applicable to the U.S.P.T.O. granting the instant Applicant's mark:

Furthermore, to the extent that Ms. Magestro's and Mr. Britt's affidavits show actual confusion, they do not show reasonable confusion, which is required to find infringement. "[T]he law has long demanded a showing that the allegedly infringing conduct carries with it a likelihood of confounding an appreciable number of reasonably prudent purchasers exercising ordinary care. This means, of course, that confusion resulting from the consuming public's carelessness, indifference, or ennui will not suffice." IAM, 103 F.3d at 201 (citations omitted). "although the need to search for Hasbro's site may rise to the level of inconvenience, it is not sufficient to raise a dispute as to actual confusion. The paucity of evidence of reasonable and actual confusion weighs heavily against Hasbro's ability to show a likelihood of confusion."

Further to the foregoing the doctrines of equitable and collateral estoppel are applicable pertaining to the U.S. Trademark's contrary positions as it relates to its initial Office Action in this instant Application. It makes no sense whatsoever for the U.S.T.O. to permit a much more renowned recording artist, motion picture actress, and entrepreneur of the stature of "**MADONNA**" (pseudonym/stage-name) a.k.a./Madonna Louise Ciccone, having been registered in I.C. 041 G & S: ENTERTAINMENT SERVICES -NAMELY, LIVE AND RECORDED MUSICAL, DANCE AND DRAMATIC PERFORMANCES, Registrant No. 1473554, to register her mark/pseudonym/stage-name "MADONNA" for G & S: CLOTHING - NAMELY, T-SHIRTS, VESTS, SWEATSHIRTS, TOPS, PANTS AND DRESSES in I.C. No. 25 as Registrant No. 1463601, despite the fact that the mark of "Lady Madonna" was already registered (articles of clothing) in I.C. No. 25, **Registration Number** 1213333 and yet both marks co-exist with U.S.T.O. registrations. The U.S.T.O. somehow in the foregoing instance maintained that the mark/pseudonym/stage-name of "MADONNA" in the same I.C. No. 25 (clothing) is distinguishable from the mark "LADY MADONNA" (distinguishable from Ms. Ciccone's registration) solely by the fact that the latter Registrant (Registration No. 1213333) article of goods or product in clothing are of a "maternity" variety, in the same I.C. 25; and hence these two preceding registrants have somehow been deemed distinguishable by the U.S.T.O. while in a completely inapposite contention to this Applicant; inequitably and implausibly the Examiner suggests in the initial Office Action of the instant Application that somehow there is too close an association of goods in differing classes - in the instant docket (in other words Germanotta's registration in I.C. 25/clothing is too closely related to Applicant's application I.C. 014/jewelry). It is axiomatic that a completely separate and thereby completely distinguishable that the I.C. 014, jewelry, is readily distinguishable by consumers from I.C. 025, clothing. To suggest otherwise is plainly non-sensical, inequitable, and the U.S.T.O. is equitably estopped from such a contention in the initial Office Action by the doctrines of equitable and collateral estoppel. Further factors weigh-in to differentiate this Applicant's cosmetic goods from being confused with Germanotta by way of Applicant's U.S. patent registration No. 6582684 also differentiating Applicant's goods as arising from anyone but solely this Applicant in view of the fact that Applicant's goods in the instant application shall be "premium" jewelry products offered exclusively with its cosmetics goods and products to embellish Applicant's sales of its cosmetic goods. The foregoing argument of there being no confusion whatsoever by any consumer as to the source of this Applicant's goods in the instant Application; is the fact that Applicant's goods in I.C. 003 and I.C. 014 are sourced from, and thereby originate solely from; Applicant and its affiliate entities due to Applicant's and its affiliate entities' unique innovative U.S. Patent protected cosmetic goods in I.C. 003, along with their patent protected pigments embedded upon, or inside its transparent jewelry goods; that no other originator can legally be a source of, or an originator of; Applicant's (and its affiliate entities') cosmetic or jewelry goods, due to Applicant's and its affiliate entities' U.S. and in other jurisdictions - registered Patent protection - U.S. Patent No. 6582684 in I.C. 003 cosmetics for any and all of the cosmetic goods that Applicant and/or its affiliate entities shall affix the mark "lady gaga" upon and have its jewelry goods offered at retail with. For the avoidance of doubt, the Applicant by way of its

authorized Officer/Manager avers to the preceding fact by having affixed his signature to this Response attesting to the veracity of this fact without equivocation.

#### Prior Pending Application

Applicant notes the Examiner's comments in this regard and reincorporates by reference each and every argument as captioned above herein. Further to the preceding statement, Applicant defers any comments and response pertaining thereto without prejudice to Applicant's rights to raise whatever affirmative matter it desires to bring to the Examiner's attention at a later date including but not necessarily limited to an Opposition proceeding based upon predicates of fraud being perpetrated in Ms. Germanotta's application and Germanotta's application specimen submitted by Germanotta as "bona fide" use as captioned above; which specimens on their face when adequately examined by the U.S.T.O. Examiner; do not conform with requisites for issuance under U.S. Trademark guidelines as more fully set forth above. Applicant preserves herein all rights presently and that may arise at a later date and time to raise affirmative matter and information to the U.S.T.O. and Trial and Appeals Board, if and when necessary, pertaining to Germanotta's application, or any other application, as alleged to have preceded Applicant's application.

#### Description of the Mark

Applicant provides herein a more complete description of the applied-for mark which is as follows:

The mark consists of "LADY GAGA LG" and a line under the "L" in "LADY" and the first "G" in "GAGA", with the letters "LG" appearing in a shaded box directly below the words "LADY GAGA".

#### Conclusion

Applicant respectfully requests that the refusal to register the mark be withdrawn for each and all of the foregoing considerations and that Applicant's mark be granted allowance for registration upon Applicant submitting to the U.S.T.O. its bona fide specimen of use in a "use application" so that Applicant's mark in I.C. 014 may thereafter inure to registration. The Applicant has responded to all issues raised in the Office Action. If any further information or response is required please contact the undersigned Officer/Manager of Applicant, Michael Abrahamson, who may be contacted by telephone at telephone No. (312) 943-7777.

Respectfully submitted,

Michael Abrahamson

Attached: Exhibit A - June 14, 2010 Letter.

#### **EXHIBIT A**

**FROSS ZELNICK LEHRMAN & ZISSU, P. C.**

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