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

Proceeding	91176791
Party	Defendant MATTEL, INC.
Correspondence Address	Lawrence Y. Iser, Esq. Kinsella Weitzman Iser Kump & Aldisert LLP 808 Wilshire Blvd., Suite 300 Santa Monica, CA 90401 UNITED STATES CFitzgerald@kwikalaw.com
Submission	Other Motions/Papers
Filer's Name	Chad R. Fitzgerald
Filer's e-mail	cfitzgerald@kwikalaw.com
Signature	/crf/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/751,105
Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.

Applicant

**APPLICANT MATTEL, INC.'S EVIDENTIARY OBJECTIONS TO AND REQUESTS
TO STRIKE PORTIONS OF TRIAL DECLARATION OF JERRY JUSTE**

Applicant Mattel, Inc. hereby objects to and moves to strike portions of the Trial
Declaration of Jerry Juste dated March 16, 2009.

The following format is used below:

- (1) the Declaration is copied verbatim;
- (2) where Applicant objects to all or a portion of a paragraph, the objected-to portion is shown as stricken (e.g., ~~The person told me that~~ ...) followed by a highlighted "objection number" (e.g., [Obj. 2]); and

TRIAL DECLARATION OF JERRY JUSTE DATED MARCH 16, 2009

WITH OBJECTIONABLE PORTIONS STRICKEN

TRIAL DECLARATION OF JERRY JUSTE

JERRY JUSTE declares under penalty of perjury as follows:

1. I am Senior Vice President, Business & Legal Affairs, Universal Motown Republic Group, an unincorporated division of Opposer UMG Recordings, Inc. (“UMG”), with offices at 1755 Broadway, 6th Floor, New York, New York 10019. My responsibilities as Senior Vice President, Business & Legal Affairs of Universal Motown Republic Group include overseeing the business affairs of the Motown recording label (hereinafter “Motown”)[†]. **[Obj. 1]** I first joined the Motown Records division (which has since become part of the Universal Motown Republic Group) of UMG as Director, Business & Legal Affairs in 1996, and was appointed to my present position in 2008. I submit this declaration as testimony in connection with the above-captioned proceeding.

OBJECTION NO.	REFERENCE	GROUND S	BOARD’S RULING
1	¶ 1 at n. 1.	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid.	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

[†]~~The Motown label and rights in the MOTOWN Marks have passed ownership several times since the inception of the label. Berry Gordy originally formed the recording label as Motown Records Corporation, whose interests were later assigned to Motown Record Company, L.P. In 1993, the recording label and all rights therein were assigned to MRAC, L.P., who then changed its name back to Motown Record Company, L.P. In 2003, Motown Record Company, L.P. assigned the Motown recording label and all rights therein to UMG. True and correct copies of the applicable assignment documents, which were regularly kept in the course of UMG’s business, are attached hereto as Exhibit B. [Obj. 1]~~

		602); (d) Lacks Authentication (Fed. R. Evid. 901).	
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2. I have access to the books and records of UMG relevant to the matters covered herein, including all records pertaining to its division Universal Motown Republic Group and Motown. As a result of my job responsibilities I am generally familiar with the history and operation of Motown and UMG and their predecessors' use and licensing of the MOTOWN and MOTOWN-formative trademarks referenced in the chart attached hereto as Exhibit A (the "MOTOWN Marks"). I confirm that the facts and matters set out herein are based on my own knowledge and understanding and/or from the records and documents of UMG to which I have access.

A. Introduction

3. Like many of the artists on the Motown recording label over the years, Motown itself is a cultural icon. From its groundbreaking origins as the most successful African-American founded, owned and operated record company and business in the United States during the 1960s and 1970s, straight through to the present, Motown's success and renown has endured. Recordings bearing the MOTOWN Marks, both old and new, have remained atop the music charts and at the forefront of music sales in the United States (see Section B, *infra*). Given Motown's pervasive and ongoing use of the MOTOWN Marks for half a century in connection with hundreds of hit recordings and live concert events, as well as the label's historical significance and place as one of the most successful recording labels in the history of the music industry, the MOTOWN name and mark has become one of the most famous and instantly recognizable marks in all of the recording industry.

B. The History and Success of Motown

4. In 1959, Detroit, Michigan native and songwriter Berry Gordy founded the Motown recording label. Within a year, Berry Gordy established Motown’s renowned headquarters at 2648 West Grand Boulevard in Detroit ~~and the recording label had its first million sale, national hit recording, “Shop Around” by The Miracles. By 1961, Motown had achieved its first No. 1 Pop hit recording, “Please Mr. Postman” by The Marvelettes.~~ [Obj. 2]

OBJECTION NO.	REFERENCE	GROUNDNS	BOARD’S RULING
2	¶ 4	(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

5. ~~From 1961-1971, Motown exploded onto the national charts with more than 160 Top-20 hits, including songs and recordings from world-renowned artists Stevie Wonder, Marvin Gaye, Diana Ross & The Supremes, The Four Tops, The Jackson 5, The Temptations, Martha & The Vandellas, Brenda Holloway and Gladys Knight & The Pips. In 1965, The Supremes had five No. 1 hits in a row, appeared on the cover of Time magazine and made a well-publicized appearance at The Copacabana. In 1968, an unprecedented 75% of Motown’s releases made the national charts.~~ [Obj. 3]

OBJECTION NO.	REFERENCE	GROUNDNS	BOARD’S RULING
3	¶ 5	(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid.	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

		602).	
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6. During this seminal period, Berry Gordy and Motown carefully crafted a unique, soulful sound with enormous pop appeal that became known as “The Motown Sound” – a sound that pervaded Motown’s recordings during this era and that helped foster the label’s iconic status that continues today. ~~The Motown Sound was typified by a number of characteristics: the use of tambourines to accent the back beat; prominent and often melodic electric bass guitar lines; distinctive melodies and chord structures; and a call and response singing style that was rooted in gospel music. In addition, the Motown Sound also incorporated pop production techniques such, as the use of orchestral string sections, charted horn sections, and carefully arranged background vocals.~~ [Obj. 4]

OBJECTION NO.	REFERENCE	GROUND	BOARD’S RULING
4	¶ 6	(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

7. ~~The hits continued in the 1970’s as Marvin Gaye, Diana Ross and Smokey Robinson, along with new acts like the Commodores, continued to blaze the creative trail. During the decade, Motown averaged a Top 10 hit every three weeks. Rolling Stone magazine declared Marvin Gaye’s album What’s Going On Album of The Year (1971) and his hit single Let’s Get It On Best Single of the Year (1973). Also, Diana Ross received a Best Actress Academy Award nomination for Motown’s motion picture Lady Sings the Blues, the soundtrack for which was also a Motown release. Other Motown films included Thank God Its Friday and~~

~~The Wiz, both released in 1978, and the latter starring Diana Ross and Michael Jackson among other famous Motown artists. But no one dominated the decade like Stevie Wonder, who kept Motown on the cutting edge, continually topping the charts with groundbreaking albums such as Talking Book, Innervisions and Songs in the Key of Life and cleaning up the GRAMMY Awards in 1975. [Obj. 5]~~

OBJECTION NO.	REFERENCE	GROUNDS	BOARD'S RULING
5	¶ 7	(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

~~8. Motown's third decade provided both new sounds and a reminder of the legacy it had created. Stevie Wonder, Diana Ross and Smokey Robinson (who Rolling Stone magazine declared Best Soul Artist in 1980), among others, continued to climb the charts, joined by Rick James' punk funk jams (e.g., the hit Superfreak), DeBarge's family harmonies and ex-Commodores singer Lionel Richie's big ballads. 1983 saw a revival of sorts for the already legendary Motown Sound, including a top-rated television special Motown 25: Yesterday, Today and Forever and the hit motion picture The Big Chill, which was filled with Motown classics. Indeed, the soundtracks The Big Chill (which has been re-released in enhanced versions in 1990, 1998 and 2004) and The Big Chill: More Songs from the Original Soundtrack, both Motown releases featuring dozens of Motown recordings, have sold more than seven million units to date. The Big Chill soundtrack alone surpassed the 6x Platinum mark as determined by the Recording Industry Association of America ("RIAA"), making it one of the top 100 selling albums of all time—see infra, Exs. C-D. Also, in the mid to late 1980s, Stevie~~

~~Wonder and Lionel Ritchie both won Academy Awards for Best Song In A Motion Picture, and Motown legends Smokey Robinson, Marvin Gaye and Berry Gordy were inducted into the Rock & Roll Hall of Fame. [Obj. 6]~~

OBJECTION NO.	REFERENCE	GROUNDS	BOARD'S RULING
6	¶ 8	(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Hearsay (Fed. R. Evid. 802); (d) Lacks Authentication (Fed. R. Evid. 901).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

9. Through the 1990s and continuing today, the Motown recording label remains vibrant with talent both old and new. Motown continues to release widely acclaimed hit music by artists such as Erykah Badu, Nelly, Akon (through SRC Records) and Lil Wayne (through Cash Money Records). Indeed, Boys II Men's album II (1994), released by Motown, is one of the best-selling albums of all time, with more than 25 million units sold worldwide and more than 12 million units sold in the United States, making it one of the Top 50 best-selling albums in the United States of all time. See *infra*, Ex. D. Moreover, in 2000, then Motown artist India.Arie scored the most GRAMMY nominations of any female artist in history.

10. ~~The enduring success of the Motown brand is further highlighted by the fact that Motown recordings continue to surge past the Gold / Platinum / Multi Platinum thresholds~~

established by the RIAA.² ~~In the 1990s alone, more than fifty Motown records surpassed the Gold / Platinum / Multi Platinum certification thresholds, and since 2000, more than thirty Motown albums have surpassed the coveted RIAA levels. Attached hereto as Exhibit C is a true and correct printout from the RIAA database (available at www.riaa.com) listing Motown's Gold, Platinum and Multi Platinum recordings. [Obj. 7]~~

OBJECTION NO.	REFERENCE	GROUNDS	BOARD'S RULING
7	¶ 10	(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Irrelevant (Fed. R. Evid. 402); (d) Hearsay (Fed. R. Evid. 802); (e) Lacks Authentication (Fed. R. Evid. 901).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

11. ~~Any slice of Motown's history contains numerous success stories, but the achievements over the lifetime of the recording label are among the most impressive in the industry. In total, Motown has released more than eighty Gold albums, more than forty Platinum albums and fourteen multi Platinum albums. See Exhibit C. Motown has five entries on the Top~~

² ~~RIAA issues Gold Record certification when U.S. sales exceed 500,000 units, Platinum Record certification when U.S. sales exceed 1,000,000 units and Multi Platinum Record certifications for every million records sold thereafter. Attached hereto as Exhibit D is a true and correct printout from the RIAA website (www.riaa.com) detailing these certification criteria. [Obj. 10]~~

~~100 Albums of all time (based on U.S. sales) — Boys II Men, II (12x Platinum), Stevie Wonder, Songs in the Key of Life (10x Platinum), Lionel Richie, Can't Slow Down (10x Platinum), Boys II Men, Cooliehigharmony (9x Platinum) and The Big Chill Soundtrack (6x Platinum). Attached hereto as Exhibit E is a printout from the RIAA database reflecting the Top 100 Albums in the United States. Over the course of its history, Motown has had over 50 Number One Singles in the United States on Billboard Magazine's "The Billboard Hot 100" and over 150 Number One hits across the Billboard charts (e.g., Pop, R&B, etc.). [Obj. 8]~~

OBJECTION NO.	REFERENCE	GROUNDS	BOARD'S RULING
8	¶ 11	(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Irrelevant (Fed. R. Evid. 402); (d) Hearsay (Fed. R. Evid. 802); (e) Lacks Authentication (Fed. R. Evid. 901).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

~~12. Motown's pivotal place in American history is further supported by the numerous publications that have been dedicated to the recording label. Attached hereto as Exhibit F are true and correct photocopies of the cover pages of Motown owned publications, which are regularly kept in the course of UMG's business. But also, there have been numerous third-party publications about Motown, which are referenced in the Declaration of Mario Ortiz submitted contemporaneously herewith. Also, the media consistently recognizes the importance and~~

~~renown of the Motown brand with its press coverage over the years. Attached hereto as Exhibit G are printouts of a representative sampling of third party articles discussing Motown that have been published in the United States and around the world during the last ten years.~~

[Obj. 9]

OBJECTION NO.	REFERENCE	GROUND	BOARD'S RULING
9	¶ 12	(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Hearsay (Fed. R. Evid. 802); (d) Lacks Authentication (Fed. R. Evid. 901).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

13. ~~As a result of the enormous success of the Motown recording label, the MOTOWN Marks have become inordinately famous and immediately recognizable to consumers in the United States. The use and fame of the MOTOWN Marks in connection with a wide range of goods and services, including Motown's licensing of the MOTOWN Marks in connection with toys, games and playthings, is covered in detail in the Declarations submitted contemporaneously herewith. [Obj. 10]~~

OBJECTION NO.	REFERENCE	GROUND	BOARD'S RULING
10	¶ 13	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b)	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

		Documents speak for themselves (Fed. R. Evid. 1002); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Improper Speculation; (e) Hearsay (Fed. R. Evid. 802); (f) Mischaracterizes testimony.	
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14. ~~In addition to licensing its MOTOWN Marks in connection with toys, games, and playthings, one of UMG's predecessors was directly involved in the sale of such goods. Namely, in 1995 Motown Records established Motown Animation. In 1996, through Image Comics, Motown Animation published the comic book series "The Crush." Various MOTOWN Marks appeared prominently in connection with that series of comic books. True and correct copies of selected pages from Issues 1-5 of "The Crush," depicting the use of MOTOWN Marks in connection with comic books, are attached hereto as Exhibit H. [Obj. 11]~~

OBJECTION NO.	REFERENCE	GROUND S	BOARD'S RULING
11	¶ 14	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of Foundation/Personal	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

		Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Mischaracterizes testimony; (f) Lacks Authentication (Fed. R. Evid. 901).	
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C. UMG and Applicant Mattel, Inc.

15. ~~UMG has no business relationship with Mattel, Inc. (“Applicant”), nor has Applicant had any business relationship with Motown or any of UMG’s predecessors. UMG has never authorized Applicant or otherwise permitted it to use the MOTOWN Marks, or any variation thereof or other mark similar thereto. There has never been any consent agreement, assignment, license or any other agreement between UMG and Applicant relating to the use of any of the marks at issue in this opposition proceeding. [Obj. 12]~~

OBJECTION NO.	REFERENCE	GROUND	BOARD’S RULING
12	¶ 15	(a) Irrelevant (Fed. R. Evid. 402).	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

16. ~~We at UMG were very upset to learn that the Applicant has applied to register a mark that consists primarily of the term MOTOWN, which is identical to many of the MOTOWN Marks and is virtually indistinguishable from the remainder of the MOTOWN Marks. If Applicant were permitted to obtain a registration for a mark identical to the MOTOWN Marks in connection with goods identical to those offered by UMG’s licensees under its MOTOWN Marks, the value of the MOTOWN Marks and the ability of the marks to indicate~~

~~goods and services emanating from a single source would be greatly injured. The great investment by UMG and its predecessors in its MOTOWN Marks would be injured as well.~~

~~Accordingly, UMG strongly objects to registration of Applicant's mark. [Obj. 13]~~

OBJECTION NO.	REFERENCE	GROUNDS	BOARD'S RULING
13	¶ 16	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Improper Speculation; (d) Irrelevant (Fed. R. Evid. 402); (e) Mischaracterizes testimony.	<input type="checkbox"/> Sustained/Stricken <input type="checkbox"/> Overruled

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. Executed on March 16th, 2009, at New York, New York.

/S/
Jerry Juste

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Evidentiary Objections and Request to Strike has been personally served on counsel for Opposer UMG Recordings, Inc., both personally and through ESTTA, on February 11, 2010.

/crf/

Chad R. Fitzgerald