

**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.

**REPLY OF OPPOSER UMG RECORDINGS, INC. IN SUPPORT OF TRIAL BRIEF
AND OPPOSITION TO TRIAL BRIEF OF MATTEL, INC.**

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Dated: March 15, 2010



03-15-2010

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Introduction

Opposer UMG Recordings, Inc. is the owner of the famous family of MOTOWN Marks, the first of which was created and placed into commerce fifty years ago, and which have been used or licensed in connection with a wide variety of goods and services, including but not limited to toys, games, and playthings. Opposer's use of its MOTOWN Marks on toys, games, and playthings was prior to Applicant's limited use of MOTOWN METAL in connection with the very same category of goods for which Applicant seeks registration.

As Opposer anticipated, Applicant's recognition of the weakness of its position and the inevitable likelihood of confusion among the consuming public, as well as dilution of Opposer's famous MOTOWN Marks, has led it to choose largely to attack Opposer's marks as descriptive rather than defend its own purported trademark. This strategy is unavailing because:

- The founder of Opposer's predecessor, Berry Gordy, *coined* the MOTOWN Marks a decade before the City of Detroit was first called Motown as a result of Opposer's fame.
- The MOTOWN Marks have been in continuous use for over fifty years and their registrations are incontestable.
- Whereas Opposer does not use its MOTOWN Marks on *any* of its products (including its toys, games, and playthings) to describe a geographic location, Applicant openly (and self-defeatingly) admits that its commercial use of "Motown" has "a primary geographic significance."

As shown in Opposer's Opening Brief, there is a likelihood of confusion as to source, sponsorship or affiliation between Opposer's MOTOWN Marks (both as used on its numerous registrations and its prior common law use on toys, games, and playthings) and MOTOWN METAL, and permitting Applicant to register MOTOWN METAL will result in dilution of Opposer's MOTOWN Marks. Applicant's Brief, which relies on flawed or inapplicable "evidence" and misconstrues the relevant legal principles, does nothing to refute that reality.

Argument

I. The Board Need Not Go Any Further Than Applicant's Assertion That It Is Using MOTOWN As Geographically Descriptive.

Applicant's steadfast position that "Motown" is geographically descriptive, if assumed to be correct, eviscerates its own case. Applicant argues (1) that "[a] mark is entitled to legal protection only to the extent that it is 'distinctive.' In order to be distinctive, it must either be inherently distinctive or, if not, have acquired distinctiveness through 'secondary meaning.' ... 'Terms that are descriptive of the geographic location or origin of goods and services are regarded by law as not being 'inherently distinctive' marks.' As the evidence unequivocally establishes, MOTOWN is a synonym for Detroit," Applicant's Trial Brief ("ATB") at 19; and (2) "It is clear that where...the goods in question are automotive or car-related, MOTOWN has a primary geographic significance." ATB at 12; *see also* ATB at 1 ("[Applicant's] toy cars were sold with packaging bearing the mark MOTOWN METAL to convey the famous muscle car's association with Detroit."); Bouman Depo. at 34:5-7 ("Motown Metal refers to Detroit. Detroit is where the cars are manufactured in one-to-one scale."). See, e.g., In re Cambridge Digital Sys., 1 U.S.P.Q.2d 1659, 1662 (TTAB 1986) (adding the descriptive word "digital" does not detract from primary geographic significance of mark).¹

In so arguing, Applicant has effectively explained why this Opposition must be sustained insofar as Applicant has not presented any evidence of secondary meaning for its limited (and now discontinued)

¹ It should be noted that Applicant's statements contradict its representations to the P.T.O. during the prosecution of its application. In a Priority Action, Applicant was required to "state ***whether the term 'Motown' has any meaning or significance*** in relation to the goods other than trademark significance. Specifically whether the 'toy' is related in any way to the term. Please note, that if the term has meaning or significance in relation to the goods, the examining attorney may require a disclaimer." (Priority Action dated May 23, 2006 (emphasis added).) Applicant responded that "the mark has no relevant significance other than significance as a trademark." (Response to Office Action dated September 15, 2006.) During this proceeding, however, the MOTOWN METAL "creator" testified that he "nailed" the name because "the cars, the actual cars were metal and the cars...were made in Detroit." (Heininger Depo. at 41:10-22.) Applicant's misrepresentations were material and knowingly false, and this Opposition should be sustained for that reason alone. Kipling Apparel Corp. v. Rich, 2007 WL 1207190 (TTAB 2007) (applicant committed fraud on the P.T.O.; opposition sustained); The Pep Boys Manny, Moe & Jack of Cal. v. Hanharutaivan, 2004 WL 2368468 (TTAB 2007) (same).

use of MOTOWN METAL. See 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 15:2 at 8.1 (2009) (hereinafter, “*McCarthy*”) (“Those categories of marks requiring proof of secondary meaning for protection are: Descriptive Marks; Geographically Descriptive Marks...”). Nor can it present such evidence, because there is none. And there cannot be any in the future, given that Applicant stopped selling its five MOTOWN METAL “basic” cars in 2007 (less than two years after it began selling them), was selling off the collector sets in its company store in 2008, and has no plans to resume any use of the name. (Mattel’s Resp. to UMG Int. No. 1; Mattel’s Supp. Resps. to UMG’s Int. Nos. 11, 13; Adler Depo. at 95:25-96:12; Bouman Depo. at 59:11-16.)

Tellingly, Applicant’s argument that it is nevertheless entitled to registration despite its admission of geographical descriptiveness is relegated to a footnote. Applicant claims that its “use of MOTOWN is suggestive rather than descriptive of Detroit because the goods in question (HOT WHEELS toys) do not and have never come from the place named, so there is no goods/place association. Instead, Applicant’s use of MOTOWN on the toys at issue suggests the city of origin of the actual cars that the toys are replicas of. An inferential leap is required to connect the toys to Detroit.” ATB at 33 n. 13. Of course, this flatly contradicts Applicant’s repeated statements that “*Motown* is synonymous with Detroit,” ATB at 8-9, and the presumption that Applicant’s products come from the only geographic location they bear. In re Handler Fenton Westerns, Inc., 214 U.S.P.Q. 848, 849-50 (TTAB 1982.) More important, even though Applicant’s goods may not have been made in Detroit (although they surely were sold there), its use of MOTOWN nevertheless is descriptive as indicating the geographic subject matter of the product (rather than its literal origin). See In re Save Venice New York, Inc., 259 F.3d 1346, 1355 (Fed. Cir. 2001) (goods were geographically descriptive of Venice, which was known for glass, lace, jewelry, and related objects even though none of the applicant’s goods were manufactured in Venice); In re Nielsen Business Media, Inc., 2010 WL 667942, at *3 (TTAB 2010) (affirming refusal to register THE BOLLYWOOD REPORTER on grounds that was merely descriptive and did not have secondary meaning, and stating: “THE BOLLYWOOD REPORTER means and creates the commercial impression of a news source regarding the Indian movie industry”); In re Stephens Media Intellectual Property, LLC,

2003 WL 21030264, at *3 (TTAB 2003) (affirming refusal of term LASVEGAS.COM because it “is merely descriptive of the service of providing an online website featuring information about Las Vegas”); In re Friends in the West, No. 74584732 (TTAB 1997) (affirming refusal to register AFRICAN CHILDREN’S CHOIR as merely descriptive of a fund-raising organization for African children).

II. Applicant’s Attack On Opposer’s Famous MOTOWN Marks Is Meritless.

Applicant devotes a substantial portion of its Trial Brief to attacking Opposer’s marks as descriptive. Opposer’s MOTOWN Marks are fanciful, the strongest type of trademark. Moreover, as the original MOTOWN Mark was first coined by Opposer’s predecessor and registered on the Principal Register fifty years ago, the family of marks is incontestable. Applicant’s claims that Opposer’s MOTOWN Marks are “descriptive at best” and “not inherently distinctive,” ATB at 19, are, quite simply, wrong.

A. MOTOWN Is A Fanciful, Coined Mark.

Applicant completely disregards the *undisputed evidence* that Opposer’s founder, Berry Gordy, coined the MOTOWN trademark fifty years ago as a trademark for his record company and that the term did not exist before it was applied to Opposer. (Caparis Decl., ¶ 3, Ex. 2 at 21; see Applicant’s Notice of Reliance Re: Printed Pubs. (“ANRPP”), Ex. A, vol. 3, p. 344.) As a coined mark, MOTOWN is inherently the strongest type of mark. Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 11 n. 12 (2d Cir. 1976) (“[T]he term “fanciful”, as a classifying concept, is usually applied to words invented solely for their use as trademarks.”). The strength of Opposer’s MOTOWN Marks was reaffirmed by the Board less than a year ago in UMG Recordings, Inc. v. O’Rourke, 92 U.S.P.Q.2d 1042, 2009 WL 2723596 (TTAB 2009).

B. Opposer’s MOTOWN Marks Are Not Descriptive.

As a coined trademark, Opposer’s MOTOWN Marks are, by their very nature, not descriptive. Moreover, seven of Opposer’s MOTOWN registrations are more than five years old, (Not. of Reliance Re U.S. Trademark Regis. And Other Official Docs.), so that any challenge to their validity on the grounds that they are not inherently distinctive and lack secondary meaning is barred. See 6 McCarthy § 32:148 at

297. Applicant ignores these facts, and proffers two equally unavailing arguments for its (incorrect) position that Opposer's MOTOWN Mark is descriptive: first, that the word "Motown" is associated with Detroit; and second, that "Motown" describes a musical style.

1. The Fact That "Motown" *Later* Became Associated With Detroit Does Not Render Opposer's MOTOWN Marks Descriptive.

Applicant's argument (at great length) that Opposer's MOTOWN Marks are geographically descriptive because Detroit is sometimes known as "Motown" misses the point.² Opposer does not dispute that Detroit may, in certain contexts, be associated with the word "Motown" *now*. However, the word Motown did not exist for any purpose before Berry Gordy coined the MOTOWN Mark a decade *before* any reference to Detroit as "Motown."³ The MOTOWN Mark, as a coined term, was registered on the Principal Register long before Detroit borrowed it (although Detroit did *not* borrow it as a trademark). The present association of "Motown" with the city of Detroit is directly attributable to Opposer's famous MOTOWN Mark, as evidenced by *Applicant's* quote: "Nashville has country music. Chicago has the blues. New Orleans has Dixieland. And Detroit will always identify itself with Motown..." ATB at 22. Applicant has selectively omitted the key remainder of this quotation, which reads in full: "And Detroit will always identify itself with Motown, *the 40-year-old record label* that set new standards for black performers in the record industry and the rest of the business world." (Caparis Decl., Ex. 14, p. 122;

² Applicant points to selected dictionary definitions in support of its argument that Motown is synonymous with Detroit. See ATB at 8-9. But dictionaries generally do not "define" trademarks, and, therefore, the fact that dictionaries do not generally define "Motown" as Opposer is no different than the fact that dictionaries generally do not define "Mattel" as Applicant. The source Applicant cites even includes an express trademark disclaimer stating that "no attempt has been made to designate as trademarks or service marks all words or terms in which proprietary marks might exist." (ANRPP, Ex. A., vol. 3, p. 314.) Moreover, many dictionaries, such as *The Oxford English Dictionary*, do refer to Opposer's MOTOWN Marks, although Applicant has selectively omitted these references. (Id., p. 317; see also Opposer's opening trial brief at 13.)

³ Although Applicant ultimately does not dispute this point, Applicant claims, without evidence, that Detroit became known as "Motown" *simultaneously* with Gordy's coinage thereof. ATB at 21. This assertion is flatly contradicted by the evidence. Berry Gordy coined the MOTOWN mark in order to use the resulting trademark in connection with goods and services emanating from his company, not to describe Detroit. (Caparis Decl., ¶ 3, Ex. 2 at 21; see ANRPP, Ex. A, at p. 344.) Applicant has not submitted any evidence of a previous or even simultaneous use of "Motown" to designate Detroit.

Opposer's Supp. Notice of Reliance Re: Printed Pubs., Ex. A at pp. 21-22 (emphasis added).) That "Motown" was inspired by "Motor City" in no way changes that fact. See The Firestone Tire & Rubber Co. v. The Goodyear Tire & Rubber Co., 186 U.S.P.Q. 557 (TTAB 1975) (dismissing opposition to mark BIASTEEL for tires despite the fact that the terms "bias" and "steel" describe characteristics of tire construction because there was no evidence that the contraction BIASTEEL was ever used before applicant's use). See also, e.g., Pebble Beach Co. v. Tour 18 I, Ltd., 942 F. Supp. 1513 (S.D.Tex. 1996) (mark "Pinehurst" for golf services in Village of Pinehurst is protectable despite geographic aspects); Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Imp. Corp., 53 S.W.3d 799 (Tex. App. 2001) (name "Horseshoe Bay" coined in part for shoreline in the rough shape of a horseshoe was protectable even though the geographic area later became known by that name).

Opposer never uses – nor does Applicant contend Opposer uses – Motown in its alleged geographic sense. Only Applicant does. See In re MBNA America Bank, N.A., 340 F.3d 1328, 1334-35 (Fed. Cir. 2003) (finding of mere descriptiveness of "Montana" and "Philadelphia" applied to credit cards based not on the fact that regional description can never be inherently distinctive but on *applicant's* use to describe a feature or characteristic of its services). In fact, because the MOTOWN Mark predates any reference to Detroit as "Motown," it cannot be considered geographically descriptive as used in Opposer's Marks. See Scheder v. Touristik Arbeitsgemeinschaft Romantische Strabe GBR, 2007 WL 1849136 (TTAB 2007); In re Pebble Beach Co., 19 U.S.P.Q.2d 1687 (TTAB 1991).

Applicant attempts to distinguish Pebble Beach claiming "because Opposer does not own the city of Detroit, *Pebble Beach* does not apply." ATB at 22. However, the principle enunciated in Pebble Beach dealt with the creation (and ownership) of a mark that later came to represent a geographic area. See, e.g., Scheder 2007 WL 1849136 at *1 (citing In re Pebble Beach, and stating that "[i]t has been held that a designation coined and promoted as a mark but which incidentally designates a particular location can function as a mark and is not primarily geographically descriptive."). Compare Grand Canyon West Ranch, LLC v. Hualapai Tribe, 88 U.S.P.Q. 2d 1501, 1506 (TTAB 2008) (denying registration because of "fundamental difference" that, unlike mark in Pebble Beach, the mark at issue had geographical

significance before applicant adopted the mark).

Understandably, Applicant barely attempts to distinguish Scheder, relegating it to two sentences in a footnote and an argument that is largely incomprehensible. ATB at 22 n.10. In Scheder, the Board granted summary judgment in a cancellation proceeding to the registrant of “Romantic Road” even though *after it was coined* the term became used as a geographic location:

“[A]s a term coined by Registrant to promote tourism, ROMANTIC ROAD is a mark that is used variously by Registrant and those authorized by Registrant to promote tourism among the member cities. It is not merely or primarily a geographic term, but has always been a term associated with Registrant and its services. The fact that the coined term has developed a reputation connoting tourism in a particular geographic region does not necessarily make that term primarily geographically descriptive under Section 2(e)(2). Indeed, the undisputed fact that the mark ROMANTIC ROAD is well known, and that people may be familiar with the tourism area comprising the ROMANTIC ROAD, establishes that it functions primarily as a mark, because it is through Registrant’s efforts that the name given by Registrant and its predecessors in interest to the region has come to be recognized as a source of tourism-related services, albeit in a particular location.” *Id.* at *3 (citing In re Pebble Beach, 19 U.S.P.Q.2d at 1688-89).

Thus, Applicant’s argument is the exact *opposite* of the following factual context described by *McCarthy* that Applicant relies upon: “Some geographic terms come to signify a certain product.... That is, the geographic term names a kind of product. When that happens, the term cannot serve as a trademark to distinguish one seller or even one group of sellers in a certain territory.” ATB at 22. In contrast, it is another statement by *McCarthy* (consistent with the cases cited here) that is applicable: namely, that “a designation that originally was used as a trademark and later becomes attached to a specific location is not ‘primarily’ geographically descriptive.” *McCarthy* § 14:28 at 86.⁴

2. Any “Motown Style” Refers To Opposer.

⁴ Applicant’s reliance on Nike, Inc. v. Bordes, Opp. No. 91178960 (TTAB 2009) is similarly flawed. ATB at 20. In Nike, the applicant admitted that its “B-MORE mark was chosen because it is a slang nickname for the city of Baltimore.” Nike, Opp. No. 91178960 at 8. See id. at 7. B-MORE was *already* a geographic term that was appropriated as a mark; it was not a coined mark like MOTOWN that later took on another meaning due to its strength. The “primary” significance (indeed, virtually its only significance of note) of B-MORE was the city of Baltimore. *Id.* at 13. Further, Applicant *intended* that its clothing bearing the B-MORE mark “promote the City of Baltimore” and focused on selling its clothing to the local Baltimore market. In fact, Nike describes Applicant’s situation here, not Opposer’s.

Even though Applicant does not contend it is using “Motown” to describe a style of music, it nevertheless argues that Opposer’s MOTOWN Marks are descriptive because “MOTOWN describes a genre of popular music.” ATB at 23. Assuming arguendo that there is a “Motown style,” Applicant does not confront the fact, as set forth in Opposer’s opening trial brief (“OTB,” at 21-22) that this designation simply reinforces, rather than detracts from, the fame and recognition of Opposer’s mark. The Motown style of music can refer to only one source of that “style” – Opposer. (See ANRPP, vol. 4., p. 385: “The Motown sound was created by Berry Gordy, Jr., in 1957.”) That is why virtually all references to the “Motown style” have a capital “M” (as opposed to such musical styles as “jazz” or “rhythm and blues,”) i.e., precisely because it refers to Opposer’s predecessor, Motown Record Corporation. ATB at 23. Even the dictionary definition quoted by Applicant makes that obvious point, defining “Motown” first as, “[d]esignating, relating to, or in the *style of music* that blends soul and pop styles, originally made popular in the 1960s by black musicians and singers recording for the Motown Record Corporation.” (ANRPP, Ex. A, vol. 3, p. 317.) The Motown style is, in this sense, no different than “the Rolls Royce of its class” or, indeed, using Applicant’s trademark “Barbie” to refer to the doll “and the values [one] contends she represents.” See Mattel, Inc. v. MCA Records, Inc., 296 F.3d 894, 900-01 (9th Cir. 2002).

Although not necessary for Opposer to prevail, Applicant’s argument concerning a “Motown style” fails for another reason. It rests entirely on a faulty assertion that “Motown” must mean a style of music beyond that distributed by Opposer itself “because a number recording artists [sic] are associated with the Motown style or referred to as ‘Motown artists’ despite the fact that they never signed with, recorded for, or released music on the Motown record label.” ATB at 15. This conclusion is not borne out by the two pieces of evidence cited by Applicant.

First, Applicant claims that “[a] biography of the legendary Aretha Franklin is titled Aretha Franklin: Motown Superstar, although she never recorded or released any music on Motown or any label owned by Opposer.” ATB at 15. This book is acknowledged as poorly researched, and is categorized as “juvenile literature” by the Library of Congress. (Ferrara Decl., Ex. K., p. 65.) The confusion also is understandable given that it is widely known that the Motown label courted Aretha Franklin in the early

1960s (although she ultimately signed with another company), and that Franklin associated with certain Motown artists. (See Caparis Decl., Ex. 5 at 47, Ex. 9 at p. 93; UMG's Not. of Rel. Re: Printed Pubs., Ex. A, p. 8.) **Second**, Applicant argues that “[l]ikewise, performing icon Tina Turner has been referred to as a ‘Motown legend,’ but she too was never signed to Motown records.” ATB at 15. Applicant supports this statement with a single article from a *British* newspaper (the Birmingham Mail). (Ferrara Decl., Ex. L at pp. 67-68.) Thus, Applicant’s entire argument rests on a single article from a foreign newspaper and on a children’s book. Even if this argument were relevant (and it is not), it is not surprising, given Opposer’s fame, that two of the thousands of references to Opposer and its goods and services were mistaken.

C. As The Owner Of A Strong, Protectable Trademark, Opposer Is Permitted To Bar Commercial Use Of Its MOTOWN Marks As A Trademark By Third Parties.

1. Opposer Does Not Seek To Prevent Non-Trademark Use Of Any Term.

Applicant claims that, by policing its trademark rights here, Opposer is attempting to “impoverish the language of commerce” and establish a “linguistic monopoly.” ATB at 2, 25, 26. In making this argument, Applicant entirely fails to distinguish between the use of a coined term, such as Motown, for purposes of public discourse and its commercial use as a trademark. This distinction is clearly illustrated by the very case Applicant brought, but refuses to cite, Mattel, Inc., 296 F.3d at 894: “Some trademarks enter our public discourse and become an integral part of our vocabulary.” Id. at 900. While the trademark owner “does not have the right to control public discourse whenever the public imbues his mark with a meaning beyond its source identifying function” (id.), that use does not diminish the mark’s trademark significance, or permit others to “label[] its commercial good with a confusingly similar mark...” Id. In other words, in such circumstances the trademark owner may not dictate public, non-trademark usage; however, it can stop use of its mark in conjunction with third parties’ products. Indeed Applicant’s own trademark, “Barbie,” has entered the vernacular and falls squarely into this category. See, e.g., dictionary.reference.com, defining “Barbie” as both “a brand of doll representing a slim, shapely young woman, esp. one with blond hair, blue eyes, and fair skin,” **and** as a noun, “a person, esp. a young woman, perceived as blandly attractive and vacuous.” (Opposer’s Supp. Request for Judicial

Notice, Ex. A.) See also Mattel, Inc., 296 F.3d at 898.

Thus, Applicant's claim that Opposer seeks a monopoly on the word "Motown" and that "all purveyors of products originating from or associated with Detroit or associated with the Motown music genre need the word to market their products because that is how [the] city and the genre are popularly known," ATB at 26, is based on an incorrect premise. These purveyors of products can use "Motown" to the extent relevant for non-trademark purposes. In fact, the very non-commercial use of "Motown Style" as a genre of music proves Applicant's premise to be false. That is, however, unlike Applicant's use.⁵

2. The Existence Of Third-Party Uses Of "Motown" Does Not Help Applicant.

Applicant cites various third-party uses of "Motown" in an effort to claim that it is entitled to register MOTOWN METAL. As an initial matter, the overwhelming majority of the third-party uses of "Motown" cited by Applicant are various publications referring to Detroit as "Motown," ATB at 9-10, which are permitted, non-commercial uses. See Mattel, Inc., 296 F.3d at 900. As to potential commercial uses, most of the examples cited by Applicant are unregistered uses by informal organizations such as car clubs and writers' groups. ATB at 13. A trademark owner is not obliged to stop uses of which it is unaware, especially ones that may not be significant or competitive. The Elizabeth Taylor Cosmetics Co., Inc. v. Annick Goutal, s.a.r.l., 673 F. Supp. 1238, 1248 (S.D.N.Y. 1987) ("the inconsequential infringement shown here does not strip Annick Goutal's Passion mark of its protectability"); Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc., 486 F. Supp. 414, 422-23 (S.D.N.Y.

⁵ Opposer's attempted analogy also betrays the fallacy of its argument. Arguing that the word Motown cannot be monopolized (which as noted above, Opposer is not doing), Applicant opines that "the existence of synonyms for 'basketball' (e.g., 'hoops') does not render the game's name any less descriptive." Plainly, this analogy does not describe Opposer's contentions relevant to *trademark* principles. A closer analogy would be that the existence of the trademark "National Basketball Association" does not limit public discourse about the NBA but does prohibit others from using it as a trademark. Applicant's authority also is clearly inapplicable. In Bada Co. v. Montgomery Ward & Co. Inc., 426 F.2d 8 (9th Cir. 1970) the issue was whether the mark MICRO, as applied to wheel weights promoted for their small size, was merely descriptive. Since (unlike here) the term "micro" *preexisted* any trademark use and was primarily descriptive, it could not be appropriated by any single competitor. Id. at 11-12. See Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373 (2d Cir. 1997) (dealing with a generic product design); Bernard v. Commerce Drug Co., 964 F.2d 1338 (2d Cir. 1992) (refusing to register drug using the word "arthritic").

1980) (“The owner of a mark is not required to police every conceivably related use thereby needlessly reducing non-competing commercial activity and encouraging litigation in order to protect a definable area of primary importance.”); Tiffany & Co. v. Classic Motor Carriages Inc., 10 U.S.P.Q.2d 1835 (TTAB 1989) (“What we can conclude from the large number of listings of companies with ‘Tiffany’ in their names, as well as the other material submitted by applicant, is that ‘Tiffany’ is not a unique term....Be that as it may, we do not think that there is a per se requirement that a mark be unique to be accorded ‘famous’ status.”) Applicant has not provided any evidence that Opposer was aware of such uses or that they were significant.

Applicant also cites “Motown”-derivative trademark registrations, most of which are on the Supplemental Register. ATB at 11-13. These are irrelevant for two reasons. *First*, in order to be probative, the evidence must establish that the *consuming public* is exposed to third-party use of similar marks on similar goods. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772, 396 F.3d 1369, 1373-74 (Fed. Cir. 2005) (disregarding evidence of at least five different alcoholic beverages that use the term VEUVE because applicant had only shown that distributors – as opposed to the consuming public – were aware that the term VEUVE was used for other alcoholic products). Third-party registrations do not rise to this level. See In re Melville Corp., 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991) (“[T]hird-party registrations...are of little probative value in determining likelihood of confusion in the absence of evidence to establish their use in the marketplace.”); Tiffany, 10 U.S.P.Q.2d at 1840-41 (evidence of third party use or registrations not probative where applicant has not shown the extent to which the names have been used, whether they are currently in use, how long they have been used, or to what degree the public is aware of such usage).

Second, even third-party use is irrelevant to likelihood of confusion when that use is in unrelated fields. See Eclipse Assocs. Ltd. v. Data Gen. Corp., 894 F.2d 1114, 1119 (9th Cir. 1990) (upholding trial court’s exclusion of evidence related to third-party use of mark in unrelated industry on question of likelihood of confusion in trademark infringement action); Rexel, Inc. v. Rexel Int’l Trading Corp., 540 F. Supp. 2d 1154, 1165 (C.D. Cal. 2007) (“[C]ontrary to Defendant’s assertions, the strength of Plaintiffs’

marks is not diminished due to their presence within a 'crowded field.' Defendants point to third-party uses of the name 'REXEL' on various office supply products, such as shredders and staplers, as well as the existence of 'Rexall' pharmacies. However, none of these third-party goods and services are offered in the electrical supply field, which is the relevant field at issue here.”).

In any event, in its reliance on and discussion of third-party uses and registrations of “Motown,” Applicant again undermines its own case for registration of MOTOWN METAL. Applicant claims “the significant third-party usage ... suggests that the word has little ability by itself to identify the source of products or services. In other words, why would a customer associate Applicant’s use of MOTOWN with Opposer over any of the other trademark users described above?,” ATB at 24-25, and “If a mark has been frequently used, the inference is that it would likely be understood by purchasers as identifying or describing the merchandise itself, rather than the source thereof, and hence as having little or no trademark significance.” ATB at 40. Yet, if this is so, exactly the same could be said of Applicant (as compared to Opposer, which does not use Motown to refer to Detroit and which has incontestable registrations). See In re Scholastic Testing Service, Inc., 196 U.S.P.Q. 517, 519 (TTAB 1977) (“a mark which is merely descriptive should not be registered merely because other such marks appear on the register”). See also In re Nett Designs, Inc., 236 F.3d 1339, 1342 (Fed. Cir. 2001) (rejecting reliance on third party registrations).

III. The Issue Of Secondary Meaning Is A Red Herring.

Applicant’s argument that Motown lacks secondary meaning as applied to toys, games, and playthings can be disposed of quickly. There is no dispute that Opposer’s use of Motown for its toys, games, and playthings was prior in time to Applicant’s. In fact, Opposer has been engaged in the use of the MOTOWN Mark in connection with toys, games, and playthings at least since 1995. As discussed above, the MOTOWN Mark is a fanciful, coined term. As applied to toys, games, and playthings, it does not describe or suggest anyone other than Opposer. Given the priority of use and given the fanciful (or at the least, suggestive) nature of the mark, no secondary meaning is necessary. *McCarthy* at § 15:2.

Moreover, as detailed in Opposer’s opening brief, Opposer’s licensees have generated significant

revenues selling toys, goods, and playthings in connection with the MOTOWN Mark, including in the period since 2005 alone. (See, e.g., OTB at 9 ; Czapla Decl., ¶ 8 & Ex. 4; Schulte Decl., ¶ 6; Atkinson Decl., ¶ 3 & Ex. 1; Cote Decl., ¶ 6 & Ex. 5 ; Waddell Decl., ¶ 3.) Also, it is not true that Opposer has submitted no evidence of advertising of toys bearing the MOTOWN Mark. (See, e.g., Schulte Decl., ¶ 8; Rajna Decl. ¶ 6.) Nor is it “indisputable” that Opposer does not make exclusive use of the MOTOWN mark *in connection with toys* – Applicant has not provided any evidence of any commercial third-party use of “Motown” in connection with toys other than its own infringing use.

IV. There Is A Likelihood Of Confusion.

Opposer has introduced evidence that consumers will be confused into believing that Applicant’s toys are somehow sponsored by or associated with Opposer in two different ways: (1) confusion due to Opposer’s half-century use of its registered MOTOWN Marks in connection with the goods and services associated with or collateral to those registrations; and (2) confusion due to Opposer’s longstanding common law use of its MOTOWN Marks in connection with, among other things, toys, games, and playthings. Applicant’s arguments to the contrary border on half-hearted. Indeed, Applicant entirely neglects to discuss an important DuPont factor analyzed in Opposer’s Opening Brief – the variety of goods on which the MOTOWN Marks are used. See OTB at 35. When it does address other factors, its discussion is unavailing.

The Parties’ Marks Are Essentially Identical. Any argument that the parties’ marks are dissimilar is not credible. The parties’ marks are far more similar than the marks in O’Rourke 2009 WL 2723596 at *8 (MTown and Motown marks were similar, as “the marks have some differences but also significant similarities”). Both parties’ marks contain the dominant element coined by Opposer’s predecessor: “Motown.” Applicant offers the bizarre argument that despite its distinctive commercial history, the term “Motown” is weak, ATB at 32 n. 11, or even “generic.” ATB at 1 n. 1. However, the cases it cites, which concern marks whose shared elements consist of common pre-existing words such as AMERICA’S, RITZ, TEEN, PARENTS, FLIP, ALL, and PEAK, are obviously distinguishable from the instant situation involving a coined, incontestable mark.

Applicant wrongly asserts that “Metal” is not descriptive of its metal toys because “metal suggests strength, force, and toughness.” (ATB at 33.) In re Venture Lending Assocs., 226 U.S.P.Q. 285, 286 (TTAB 1985) (mark merely descriptive when involved term describes a single, significant quality or characteristic of a product). To the extent “metal suggests strength, force, and toughness,” that is precisely because the product is made of *metal*. Applicant’s statement that “Applicant’s HOT WHEELS toys are indeed made of metal... but that is not why METAL was chosen for the mark,” ATB at 33, is flatly contradicted by the testimony of the creator of MOTOWN METAL:

Q: Was Motown Metal the first name that you came up with?

A: Yes.

Q: Did you consider any other names?

A: No.

Q: Why not?

MR. ISER: Objection. The question calls for the witness to speculate.

A: I had nailed it.

Q: Why did you feel that you had nailed it?

A: Well, it -- the cars, the actual cars were metal and the cars, the big three muscle cars, big three produced muscle cars were made in Detroit.

Heininger Depo. 41:10-22.

Applicant also claims that Opposer’s analysis runs afoul of the anti-dissection rule. Not so. “As a preliminary to a final comparison of the conflicting marks as a whole, it is not a violation of the anti-dissection rule to look at the parts of the composites to determine which parts are likely to make a greater or lesser impact on the ordinary buyer.” 4 *McCarthy* § 23:42 at 184. Here, the coined term “Motown” is the dominant portion of the marks. “Metal” is undeniably descriptive, and should be discounted. See, e.g., In re Chatam Intern., Inc., 380 F.3d 1340, 1343 (Fed. Cir. 2004) (“Jose Gaspar Gold” was substantially similar to “Gaspar’s Ale” because the word “Gold” was “a descriptive term offering little to alter the commercial impression of the mark”). When the marks are compared on that basis, they are undeniably similar, indeed identical.

The Parties’ Goods Are Similar. Applicant’s claims that the parties’ goods are dissimilar is

wrong. Opposer does sell, via its licensees, toys games and playthings.⁶ Opposer considers its licensees' products to be toys. (Waddell Decl., ¶¶ 4-9; Moskow Depo. at 45:15-24; 61:25-62:3; 65:12-15, 65:23-66:9; 66:17-19.) Applicant does not deny that Opposer's licensees' products are toys, games, and/or playthings. (Adler Depo. at 120:23-122:2.) Even Applicant's counsel refers to Opposer's licensees' products as toys. (Moskow Depo. at 66:12-13; 67:4-5.) The claim that the parties' goods are dissimilar because Opposer does not sell toy *vehicles* is disingenuous. Applicant has applied for a trademark registration in connection with "toys, games and playthings, namely, toy vehicles and accessories therefor." Application Serial No. 78/751,105. A "toy vehicle" is a toy, and Applicant cannot avoid a likelihood of confusion by dividing the category of "toys, games, and playthings" into infinite subgenres. See Miss World (UK), Ltd. v. Mrs. Am. Pageants, Inc., 856 F.2d 1445, 1450 (9th Cir. 1988) (district court erred in distinguishing between the parties' beauty pageant services).

Additionally, contrary to Applicant's contentions, toys are collateral to Opposer's music products that are subject to numerous registrations. See, e.g., Dreamwerks Prod. Group, Inc. v. SKG Studio, 142 F. 3d 1127, 1131 (9th Cir. 1998) ("Entertainment studios control all sorts of related industries: publishing, clothing, amusement parks, computer games and an endless list of toys and kids' products. In this environment it's easy for customers to suspect DreamWorks of sponsoring conventions at which movie merchandise is sold."); L.C. Licensing, Inc. v. Berman, 86 U.S.P.Q.2d 1883, 1889-90 (TTAB 2008) (holding as "common knowledge...that the licensing of commercial trademarks on 'collateral products' has become a part of everyday life," and finding an association between urban lifestyle clothing and custom automotive accessories); Turner Ent. Co. v. Nelson, 38 U.S.P.Q.2d 1942, 1945 (TTAB 1996) ("Opposer has generated revenue from its licensing of the mark GILLIGAN'S ISLAND in connection with pinball machines, video games, and clothing items. Opposer also licensed the mark...for use in

⁶ Applicant implies that Opposer has not provided adequate evidence of its common law use of the MOTOWN Marks because it did not introduce a table attached to its Amended Notice of Opposition. ATB at 16-17. Not true: the table was a summary of evidence in the form of licensees' Declarations. (See Atkinson Decl., ¶ 2; Cote Decl., ¶¶ 2-7; Czapla Decl., ¶¶ 2-8; Handal Decl., ¶¶ 2-5; Rajna Decl., ¶¶ 2-6; Schulte Decl., ¶¶ 2-8.)

connection with McDonald's Corporation's advertising efforts"). See also O'Rourke, 92 U.S.P.Q.2d at 1050 ("consumers familiar with opposer's famous music industry marks ... when subsequently confronted with clothing items adorned with applicant's mark, would likely conclude it was another variation on the marks used by or authorized by opposer for such goods."). Toys, games and playthings are not only a natural area of expansion from the goods and services that are the subject of Opposer's registrations, but in fact Opposer *did* expand into that area before Applicant sold a single MOTOWN METAL toy. (Waddell Decl. ¶¶ 3-9; Mattel's Resp. to UMG Int. Nos. 3, 10.)

The Parties' Goods Are Sold In Identical Channels Of Trade. Initially, "absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class or purchasers." Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1268 (Fed. Cir. 2002). Applicant's argument that the parties' goods currently are not sold in the same channels of trade rests on a factual misstatement. Applicant claims that "Opposer admits that the majority of its MOTOWN-branded 'toys' are available for purchase in *only one location*: a store in the Detroit airport." ATB at 37 (emphasis in original). That is not correct. In O'Rourke, the Board found nearly the exact same use as here to be "substantial evidence." O'Rourke, 92 U.S.P.Q.2d at 1047. This "substantial evidence" was that the clothing items in O'Rourke were sold, among other places, at the Motown Music Review store in the Detroit Metro Airport (as are Opposer's goods here), in the Motown Historical Museum, and on its website (as here), and at one of the Motown cafes in Orlando, Florida (as here, Opposer's goods are sold nationwide). See Czapla Decl., ¶¶ 1-8; Caparis Decl. ¶ 7, Ex. 11; Opposer's Req. for Judicial Notice Re: Websites, Ex. A at pp. 47-55; Waddell Decl., ¶ 4. In fact, that Applicant's products are sold in this specific array of outlets was found to be particularly important:

"[W]e note that opposer's licensed or franchised operations may utilize décor and displays of memorabilia that draw an association between opposer's history in the music industry and the items marketed in locations such as the Motown Music Review store in the Detroit airport and the Motown Café Orlando."

92 U.S.P.Q.2d at 1049. As the Board concluded:

"[F]or those who know the history of 'Motown' records and performers, and the record is substantial that the 'Motown' legacy and contributions to the music

industry are well-known, the connotation of opposer's marks will mirror that history and legacy. In this regard, we note that opposer's licensees and franchisees not only sell MOTOWN branded clothing but utilize décor and memorabilia evocative of the legions of 'Motown' artists, performers and recordings." *Id.* at 1048.

Substitute "toys, games, and playthings" for "clothing," and this conclusion is equally true here.

Opposer's evidence further establishes that both parties' goods are sold in specific stores such as K-Mart, Wal-Mart, Target, and Toys "R" Us, and on *specific websites*, Amazon.com and eBay.com (not the Internet generally). (Caparis Decl., ¶ 13, Exs. 16, 18; Adler Depo. at 100:4-101:2; Cote Decl., ¶¶ 4-5; Rajna Decl. ¶ 4; Handal Decl. ¶ 5; Opposer's Req. for Judicial Notice Re: Websites, Ex. A, pp. 23-25, 63-92, 97-100.) *See Herbko Intern. v. Kappa Books, Inc.*, 308 F.3d 1156, 1166 (Fed. Cir. 2002) (channels of trade similar where one party markets its goods through WalMart and other through K-Mart).

Therefore, "any members of the general public who visit the stores or websites of opposer's licensees or franchisees who are selling MOTOWN branded clothing at retail ... we must assume that marketing of applicant's goods can or will occur in all normal channels of trade for such items. This would include retail stores featuring clothing items and sales on the Internet, which as the record shows, are means by which opposer's licensed goods are marketed. Accordingly, there is an overlap in the parties' classes of consumers and channels of trade." *O'Rourke*, 92 U.S.P.Q.2d at 1049.

Applicant Has Failed To Provide Evidentiary Support For Its Assertion That Consumers Are Discerning. In its opening brief, Opposer provided numerous reasons why the consumers of Applicant's and Opposer's products would treat those purchases as "impulse" buys – for example, that the parties' products are inexpensive, that Applicant's toy cars are interchangeable and not advertised separately, and that its target audience is children (or adults buying for children). OTB at 32-35. Applicant asserts that its child purchasers would be discerning, but its examples – that those children would pick the toys based on their shapes, styling, and color – entirely fail to support that conclusion. Applicant provides no other support, nor does it provide expert opinion on this issue, as did Opposer. Additionally, Applicant's discussion of adult collectors does not acknowledge that there is a collector's market for MOTOWN products as well and that this demographic will be particularly conscious of Opposer's MOTOWN Marks.

Applicant's Attempts To Minimize The Scope And Import Of Opposer's Fame Are Misleading.

Applicant claims that Opposer's marks have only "niche fame" because "Opposer's mark is famous only within a limited sphere – recorded music." ATB at 39. However, the concept of "niche fame" has relevance only to a dilution claim, not to a likelihood of confusion analysis. See 4 *McCarthy* § 24:105. Applicant does not cite any authority that the concept applies to a likelihood of confusion analysis. Rather, as to likelihood of confusion, "[t]he more famous a well-known mark, the greater the likelihood that use on *non-competitive products* will cause confusion." 4 *McCarthy* § 24:49 (emphasis added). See, e.g., In re Chatam Intern, 380 F.3d at 1341 (affirming refusal to register notwithstanding the famous mark was in a different class of goods); Tiffany., 10 U.S.P.Q.2d at 1841 (sustaining opposition and rejecting applicant's contention that "even if Opposer's rights are deemed strong in its own niche ... opposer has no rights that extend to [a very different] commercial area."). See also p. 15, supra (toys, goods, and playthings are collateral to Opposer's music). In fact, "[f]ame of the mark is a dominant factor in the likelihood of confusion analysis for a famous mark, independent of the consideration of the relatedness of the goods." Recot, Inc. v. Becton, 214 F.3d 1322, 1328 (Fed. Cir. 2000) (citing cases).

Motown is a very strong, famous mark. OTB at 24-26. Opposer's wide-reaching fame is borne out by everything from the evidence it has submitted here to the Board's recent decision in O'Rourke. Applicant miscites O'Rourke for the proposition that the MOTOWN Mark only enjoys niche fame in the music market. That is not what O'Rourke held (and it never even used the term). Indeed, that entire proceeding involved the use of a common law MOTOWN Mark on *clothing*. As the Board noted, "The fame of Opposer's mark in the music industry influences our decision in this case ... for when evidence of fame of a mark is present it is always of significance." O'Rourke 92 U.S.P.Q.2d at 1046 n.14; see also id. at *17 ("the fame of Opposer's mark in the music industry also has some effect on our analysis"). See Giant Foods, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 1570 (Fed. Cir. 1983) (relying in part on TTAB findings in prior cases that Opposer's marks acquired considerable fame).

Applicant's "niche fame" argument also ignores that Opposer does not rely only on the fame of the MOTOWN Marks applied to recordings (which would be sufficient) or on the potential for collateral

uses. Here, unlike the cases cited above, Opposer's fame represented by the MOTOWN Marks actually was used with toys, games, and playthings *before* Applicant's use (*supra* at 16).

Evidence Of Third-Party Registrations Are Meaningless In A DuPont Analysis. As discussed *supra* in Section II.A.2, evidence of third-party usage has no value unless it establishes that the *consuming public* is exposed to third-party use of similar marks on similar goods. *Palm Bay Imports*, 396 F.3d at 1373-74. The third-party registrations relied upon by Applicant do not rise to this level. *See In re Melville Corp.*, 18 U.S.P.Q.2d at 1388; *AMF Inc.*, 474 F.2d at 1406.

Lack Of Evidence Of Actual Confusion Is Not Probative Here. Applicant claims that there is no evidence of actual confusion. However, the lack of any such evidence is completely meaningless in the present context. As explained by Opposer's expert, because of the nature, the limited duration, and lack of any advertising of Applicant's use, one could not expect to find evidence of actual confusion here. Thus, if a consumer purchased one of Applicant's cars mistakenly believing it emanated from, or was licensed or approved by, Opposer, there would be no reason to complain to either Applicant or Opposer. *See Tiffany & Co.*, 10 U.S.P.Q. 2d at 1841 (no evidence of actual confusion because consumers may feel no need to inquire about whether there is a connection). Moreover, because of the difficulty in garnering evidence of actual confusion, its absence should have no impact on the determination of likelihood of confusion. *Id.* Thus, the lack of evidence of actual confusion is "immaterial". *See e.g., Weiss Assocs., Inc. v. HRL Assocs, Inc.*, 902 F.2d 1546, 1549 (Fed. Cir. 1990) ("It is unnecessary to show actual confusion in establishing likelihood of confusion."). *See also O'Rourke*, 92 U.S.P.Q.2d 1042 (finding likelihood of confusion without reference to any evidence of actual confusion).

Applicant's Intent To Trade On Opposer's Goodwill. While Applicant's intent is relevant to show likelihood of confusion, Applicant's bald statement that its alleged lack of intent "establishes" that there is no likelihood of confusion, of course, is not the law. *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 666 (5th Cir. 2000). Moreover, Applicant completely fails to address Opposer's evidence that Applicant intentionally adopted MOTOWN METAL to trade on Opposer's goodwill. Applicant admittedly was familiar with Opposer's famous mark. OTB at 36. Applicant's trademark

search referred to Opposer's Mark. (Mattel's Response to UMG Request for Admission No. 3.)

Nevertheless Applicant proceeded to obtain licenses for all other trademarks used in its MOTOWN METAL toys *except for* Opposer's, even though that use was by far the most prominent one. Applicant fails to even attempt to justify its deliberate use of MOTOWN METAL in conjunction with an "M" mark; the larger font size of MOTOWN METAL in the second year of use; and the fact that the use of MOTOWN METAL was not necessary in connection with Applicant's toys.

V. Registration Of MOTOWN METAL Would Dilute Opposer's MOTOWN Marks.

Applicant licensed (and notes so on its packaging) at least *eighteen* other trademarks for use on its Motown Metal toys (and at least *seventy-five* trademarks in connection with its Hot Wheels cars in 2006, including OSCAR MAYER, World Wrestling Entertainment logos, and BATMAN). Notice of Reliance Re: Discovery Depositions., Ex. A at pp. 455-56. Its failure to do so for the Motown Mark is itself strong evidence of dilution. Notice of Reliance Re: Produced Docs., Ex. A at pp. 5, 8, 11, 14, 17, 20, 23, 26, 29, 32, 38.) Applicant makes five basic arguments, each of which is unavailing.

Opposer's MOTOWN Marks Are Not Limited To Niche Fame. Applicant's assertion that Opposer's fame is "niche fame" is incorrect. As set forth in detail in its opening brief, the MOTOWN Mark is famous to the general consuming public, given its lengthy, widespread use, including, among other things, not only for music but for motion pictures, restaurants, a museum, clothing, toys, games, and playthings.⁷ OTB at 5-16, 40-41.

The Parties' Marks Do Give Rise To An Association. The parties' marks are similar enough to give rise to a finding of dilution, particularly given that Opposer's MOTOWN Marks are fanciful and the dominant portion of the marks is identical (with Applicant adding only the descriptive term "metal").

Opposer also has introduced evidence of a consumer association in the form of unrebutted expert

⁷ Applicant's citation of the pre-T.D.R.A. case The Toro Co. v. ToroHead, Inc., 61 U.S.P.Q.2d 1164, 1180 (TTAB 2001) for the proposition that "In effect, an owner of a famous mark is attempting to demonstrate that *the English language has changed*" is off point. That proposition only makes sense if, as in Toro Co., the mark *first* was "part of the English language." Here, "Motown" was not part of the English language at all until Berry Gordy created the mark.

testimony. There is no requirement that Opposer present the Board with (expensive) survey evidence, particularly in a case such as this where Applicant declined to even present a rebuttal expert. Moseley v. V Secret Catalogue, Inc., 537 U.S. 418, 434 (2003) (superseded by statute on other grounds) (consumer surveys not be necessary if dilution proven through circumstantial evidence).

Opposer's MOTOWN Mark Is Sufficiently Distinct For Dilution. As discussed *supra* in Section II.A., Opposer's MOTOWN Marks are of the strongest variety: fanciful and incontestable. As such, they are sufficiently distinct for the purposes of a dilution claim. McGraw-Edison Co. v. Walt Disney Prods., 787 F.2d 1163, 1171 (7th Cir. 1986) (reversing summary judgment in favor of defendant on plaintiff's claim of dilution of its "coined mark" TRON); Amway Corp. v. Int'l Sales Aids, Inc., 1974 U.S. Dist. LEXIS 8333, at *24, 187 U.S.P.Q. 15 (E.D. Ark. 1974) (granting injunction against use of mark alleged to dilute plaintiff's coined mark AMWAY); cf. Quill Natural Spring Water, Ltd. v. Quill Corp., 1994 WL 559237, at *6 (N.D. Ill. 1994) (dismissing dilution claim based, in part, on the fact that the mark at issue was not a coined mark: "Were it a coined mark, the court might be compelled to find that Quill Corporation has an absolute monopoly over its use, anytime, on anything.").

Opposer Does Engage In Substantially Exclusive Use Of Its MOTOWN Marks. As discussed *supra* in Section II.C.2, Opposer does engage in substantially exclusive use of its MOTOWN Marks in a commercial, as opposed to non-commercial, sense. See Nike, Inc. v. Nikepal Int'l, Inc., 84 U.S.P.Q.2d 1521, 1527 (E.D. Cal. 2007) (finding that evidence of third-party use does not necessarily defeat a showing of substantially exclusive use, and holding for plaintiff on dilution claim: "The law does not require that use of the famous mark be absolutely exclusive, but merely 'substantially exclusive.'").

Applicant Did Intend To Create An Association With Opposer. As discussed *supra* in Section IV, Applicant did in fact intend to create an association with Opposer and its goodwill.

VI. Applicant's Attempt To Limit Opposer's Rights In Its MOTOWN Marks Fails.

Applicant devotes only two paragraphs to its "Counterclaim," which seeks to cancel or limit Opposer's registrations to preclude use in connection with "toys, games, and playthings, namely, toy vehicles and accessories therefor." ATB at 46. Applicant did not even argue for cancellation of

Opposer's registration; its argument to restrict or limit Opposer's registration is frivolous.

First, to the extent that the Board finds for Opposer, Applicant lacks standing to bring its Counterclaim. Geraghty Dyno-Tuned Prods., Inc. v. Clayton Mfg. Co., 190 U.S.P.Q. 508, 512 (TTAB 1976) ("Since we accord no recognition to any trademark rights of petitioner, it follows that petitioner has failed to demonstrate that it will be damaged by the maintenance on the register of respondent's registrations, wherefore petitioner has no standing.").

Second, seven of Opposer's MOTOWN trademark registrations on the Principal Register are over five years old. (Notice of Reliance re: U.S. Trademark Regis. And Other Official Documents.) "The Lanham Act clearly narrows and defines the grounds upon which a petition to cancel can be based. If the attacked registration is over five years old, it can be canceled only on those grounds specifically set forth in the Act." 3 *McCarthy* § 20:55 at 127-28. Those grounds include that the registered mark has become generic, has been abandoned, its registration was obtained fraudulently, or the registered mark is being used to misrepresent the source of the goods or services on or in connection with which the mark is used. 15 U.S.C. § 1064. They do not, however, include lack of secondary meaning or likelihood of confusion. Id.; see Otto Int'l, Inc. v. Otto Kern GMBH, 83 U.S.P.Q.2d 1861, 1861 (TTAB 2007) (cancellation claim based on likelihood of confusion was time-barred).

Third, Applicant admits that in order to restrict Opposer's registrations, Applicant would need to show that Opposer is not already using its mark on the goods that would be excluded if the restriction was entered. ATB at 46. Opposer has submitted extensive evidence that it is using its MOTOWN Marks in connection with toys, games, and playthings, the field of goods in Applicant's application. OTB at 9-12.

Conclusion

Opposer respectfully requests that the Board sustain its Opposition.

Dated: March 15, 2010

MITCHELL SILBERBERG & KNUPP LLP

By: 

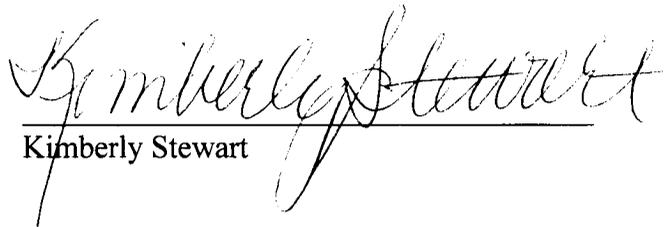
Alexa L. Lewis
Attorneys for Opposer

CERTIFICATE OF MAILING

Date of Deposit: March 15, 2010

“Express Mail” mailing label number: EB519288551US

I hereby certify that this paper or fee, **REPLY OF OPPOSER UMG RECORDINGS, INC. IN SUPPORT OF TRIAL BRIEF AND OPPOSITION TO TRIAL BRIEF OF MATTEL, INC.**, is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” on the date indicated above and is addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board , P.O. Box 1451, Alexandria, Virginia 22313-1451.



Kimberly Stewart

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the county of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is Mitchell Silberberg & Knupp LLP, 11377 West Olympic Boulevard, Los Angeles, California 90064-1683 .

On March 15, 2010, I served a copy of the foregoing document(s) described as **REPLY OF OPPOSER UMG RECORDINGS, INC. IN SUPPORT OF TRIAL BRIEF AND OPPOSITION TO TRIAL BRIEF OF MATTEL, INC.** on the interested parties in this action at their last known address as set forth below by taking the action described below:

Lawrence Y. Iser (liser@kwikalaw.com)	Counsel for Applicant, MATTEL,
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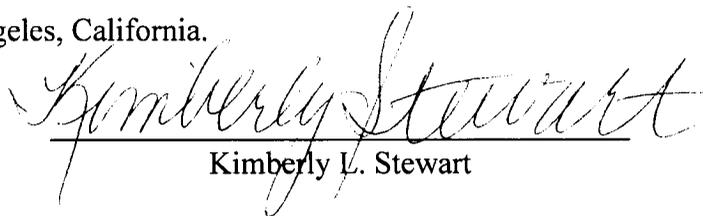
- BY MAIL:** I placed the above-mentioned document(s) in sealed envelope(s) addressed as set forth above, and deposited each envelope in the mail at Los Angeles, California. Each envelope was mailed with postage thereon fully prepaid.
- BY OVERNIGHT MAIL:** I placed the above-mentioned document(s) in sealed envelope(s) designated by the carrier, with delivery fees provided for, and addressed as set forth above, and deposited the above-described document(s) with _____ in the ordinary course of business, by depositing the document(s) in a facility regularly maintained by the carrier or delivering the document(s) to an authorized driver for the carrier.
- BY PERSONAL DELIVERY:** I placed the above-mentioned document(s) in sealed envelope(s), and caused personal delivery by FIRST LEGAL SUPPORT SERVICE of the document(s) listed above to the person(s) at the address(es) set forth above.
- BY PLACING FOR COLLECTION AND MAILING:** I placed the above-mentioned document(s) in sealed envelope(s) addressed as set forth above, and placed the envelope(s) for collection and mailing following ordinary business practices. I am readily familiar with the firm's practice for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at 11377 West Olympic Boulevard, Los Angeles, California 90064-1683 in the ordinary course of business.

- BY ELECTRONIC MAIL:** I served the above-mentioned document electronically at ___:___
___m. on the parties listed at the email addresses above and, to the best of my knowledge, the
transmission was complete and without error in that I did not receive an electronic
notification to the contrary.
- BY FAX:** On _____, at _____ am/pm, from facsimile number (310)
_____, before placing the above-described document(s) in sealed envelope(s) addressed
as set forth above, I sent a copy of the above-described document(s) to each of the
individuals set forth above at the facsimile numbers listed above. The transmission was
reported as complete and without error. The transmission report was properly issued by the
transmitting facsimile machine, and a copy of that report is attached hereto.

I declare that I am employed in the office of a member of the State Bar of California and
various federal bars, at whose direction such service was made.

I declare under penalty of perjury under the laws of the State of California that the above
is true and correct.

Executed on March 15, 2010, at Los Angeles, California.



Kimberly L. Stewart