

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

**RESPONSE OF OPPOSER UMG RECORDINGS, INC., TO APPLICANT
MATTEL, INC.'S EVIDENTIARY OBJECTIONS TO AND REQUESTS TO
STRIKE PORTIONS OF TRIAL DECLARATION OF PETER CAPARIS**

Opposer UMG Recordings, Inc. ("Opposer" or "UMG") hereby responds to Applicant, Mattel, Inc.'s ("Applicant" or "Mattel") evidentiary objections to and request to strike portions of the trial declaration of Peter Caparis, dated September 14, 2009, as follows:

Evidence:	Applicant's Objection:	Opposer's Response:
Specifically, The Caparis Group is retained by sports, entertainment, consumer products, publishing and philanthropy clients to, among other things, provide	(a) Improper basis for expert testimony (Fed. R. Evid. 702); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Irrelevant (Fed. R. Evid.	This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise

<p>integrated sales and marketing solutions involving areas such as sponsorship, licensing, product development, and strategic alliances. I have over 30 years experience in consumer sales and marketing, including an emphasis on sponsorship and licensing. During my career I have been involved in all aspects of marketing, including devising marketing plans, naming products, exploiting brands, and the advertising and promotion of branded and trademarked products. I have also taught a course at the UCLA Anderson School of Management that</p>	<p>402).</p>	<p>to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. This exhibit is admissible under FRE 1002 and 1003. This evidence is relevant to, <i>inter alia</i>, establish the witness' credentials.</p>
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<p>involved the use of entertainment and sports in marketing. My CV, fee statement and materials reviewed are attached hereto as Exhibit 1. (Caparis Decl, ¶ 1.)</p>		
<p>As I will describe hereafter, Mr. Ferrara, who is a musicologist and does not indicate that he has any experience or expertise in marketing, has missed the point. He has viewed this Opposition from a “musicological perspective” and engaged in what he calls “musicological research,” when in fact the trademark issue at hand is a marketing/branding issue. (Caparis Decl, ¶ 2.)</p>	<p>(a) Improper expert testimony (Fed. R. Evid. 702); (b) Improper Speculation; (c) Irrelevant (Fed. R. Evid. 402); (d) Mischaracterizes testimony.</p>	<p>This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. This expert witness is not</p>

		<p>engaging in improper speculation. This evidence is relevant to, <i>inter alia</i>, rebut Applicant’s purported expert and establish that Applicant is not entitled to registration. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection).</p>
<p>3. The starting point for my analysis has to be the fame of the “Motown” trademark. ... Moreover, it is indisputable – and Mattel does not appear to dispute – that Motown is an extremely famous and highly recognizable trademark. I, of course, was</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Mischaracterizes</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony</p>

<p>familiar with the Motown trademark before I was retained in connection with this matter, and in addition ... (Caparis Decl, ¶ 3.)</p>	<p>testimony.</p>	<p>is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This evidence is relevant to, <i>inter alia</i>, establish that Applicant is not entitled to registration. Moreover, the witness does not mischaracterize evidence (nor does Applicant even</p>
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		attempt to explain this objection).
Over the years, Motown has been the subject of enormous media attention, including in the popular press and in books. In addition to the works mentioned above, some of the numerous books written exclusively about Motown are P. Benjaminson, <u>The Story of Motown</u> (1979); D. Waller, <u>The Motown Story: The Inside Story of America's Most Popular Music</u> (1985); S. Davis, <u>Motown: The History</u> (1988); J. R. Taraborelli, <u>Hot Wax, City Cool and Solid Gold: Motown</u> (1986); B. Fong-Torres,	(a) Improper expert testimony (Fed. R. Evid. 702); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of Foundation/ Personal Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Hearsay (Fed. R. Evid. 802); (f) Lacks Authentication (Fed. R. Evid. 901).	This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible under FRE 1002 and 1003. Sufficient evidence has been introduced to support a finding that this witness has adequate personal

<p><u>The Motown Album</u> (1990); and G. L. Early, <u>One Nation Under A Groove: Motown and American Culture</u> (revised ed. 2004). (See Exhibit 3.)</p> <p>The widespread media coverage of Motown’s recently celebrated 50th anniversary, which coincided with the release of a 10-CD boxed set containing all of Motown’s #1 singles, included feature articles in <u>Vanity Fair</u> (“It Happened In Hitsville” [December 2008]), and the <u>New York Times</u> (“Motown Turns Fifty, But the Party’s Far from Over” [September 5, 2009]). (See Exhibits 4, 5.) (Caparis Decl, ¶ 4.)</p>		<p>knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This evidence is relevant to, <i>inter alia</i>, establish that Applicant is not entitled to registration. There is no lack of authentication here, including because the testimony presented is a comparison by an expert witness. Moreover, this testimony is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay</p>
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		rule.
<p>(Of course, it has been registered several times with the U.S. Patent and Trademark Office.) Among other things, Motown recordings have been in the marketplace continuously and have sold well over one hundred million copies. (The website of the Recording Industry Association of America, Inc., reflects that Motown's sales of "Platinum" albums alone, i.e., albums certified by the Association to have sold more than one million copies, exceed 100 million copies.¹ See Exhibit 6.) Motown recordings are also among the most successful</p>	<p>(a) Improper expert testimony (Fed. R. Evid. 702); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of Foundation/ Personal Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Hearsay (Fed. R. Evid. 802); (f) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible under FRE 1002 and 1003. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal</p>

<p>and recognizable recordings in history, embodying the performances of such artists as The Jackson Five, The Supremes, The Temptations, Stevie Wonder, and Marvin Gaye, to name a few. The mark “Motown” has been widely advertised. (See examples provided in Exhibit 7.).</p> <p>There is a “Motown Museum” devoted to the record label. (See Exhibit 8.) As indicated above, Motown’s 50th anniversary has been celebrated with special events and products; its 40th Anniversary celebration likewise received widespread publicity and included a hit</p>		<p>knowledge as contemplated by FRE 602 is not required of this expert witness. This evidence is relevant to, <i>inter alia</i>, the history and success of Motown. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. There is no lack of authentication here, including because the testimony presented is a comparison by an expert witness.</p>
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<p>television special, “Motown 40: The Music Is Forever.”</p> <p>(See Exhibit 9.)</p> <p>¹ According to the RIAA website, the certification of Platinum albums began in 1976. (Caparis Decl, ¶ 5.)</p>		
<p>In these ways, among many others, the trademark “Motown” has become widely known and extremely strong. It is even referred to in dictionaries as a “trademark.” See, for example, <u>The New Grove Dictionary of Music and Musicians</u> (2d ed. 2001) attached as Exhibit B, pp. 17-18 to the Ferrara Declaration, stating “Motown: American record</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701);</p> <p>(b) Exhibit speaks for itself (Fed. R. Evid. 1002);</p> <p>(c) Lack of Foundation/ Personal Knowledge (Fed. R. Evid. 602).</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion.</p> <p>This exhibit is admissible under FRE 1002 and 1003.</p> <p>Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness.</p>

<p>company specializing in black soul music; the name is the registered trademark of the company”; and <u>The World Book Dictionary</u> (2003) referring to “Motown” as “a trademark of a Detroit record company.” (Excerpts from both works are provided in Exhibit 10.) (Caparis Decl, ¶ 6.)</p>		
<p>The Motown trademark also has been used and licensed, including as most important here, for toys, games, and playthings, such as board games, stuffed animals, video games, karaoke CDGs, musical toy keychains, novelty pens and pencils, superballs, and the</p>	<p>(a) Improper expert testimony (Fed. R. Evid. 702); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of Foundation/ Personal Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Hearsay (Fed. R. Evid. 802); (f) Mischaracterizes</p>	<p>This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable</p>

<p>like. (See e.g. Trial Declaration of William Waddell, Exhs. J-T; Declaration of Deanna Czapala, Exhs. 2-3; Declaration of William Schulte, Exh. 2; Declaration Michael Rajna, Exh. 2; Declaration of Anton Handal, Exh. 3; Declaration of Melissa K. Cote, Exh. 1.)</p> <p>There is a natural connection between such products and the Motown record label, since record companies are widely known to sell “merchandise,” which Motown does. In addition, the Motown trademark has been used on a variety of other products, including T-</p>	<p>testimony; (g) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible under FRE 1002 and 1003. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This evidence is relevant to, <i>inter alia</i>, establish that Applicant is not entitled to registration. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence</p>
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<p>shirts, hats and other clothing, merchandise such as magnets, pins, wristbands, totebags, glassware, and coasters, comic books, and “Motown Cafés” in Orlando, New York, and Las Vegas. (See <u>id.</u> and examples provided in Exhibit 11 and Trial Declaration of Jerry Juste, Exh. H.) When the Motown trademark was licensed in 2003 for use on a karaoke CDG, a UMG Strategic Marketing executive was quoted as stating that this license was “part of the ongoing merchandising initiative behind the Motown brand.” (See Exhibit 12.) (Caparis</p>		<p>statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection). There is no lack of authentication here, including because the testimony presented is a comparison by an expert witness.</p>
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Decl, ¶ 7.)		
<p>Mr. Ferrara’s entire declaration is dedicated to showing that there is a “Motown style.” To the extent that is the case, that simply evidences the strength of the Motown mark. There is no doubt that the “Motown” in “Motown style” refers to the product and goods of Motown Record Corporation and the successors thereto. The fact that Motown has been used to describe a style of music does not denigrate, but rather strengthens, its trademark and branding significance. It is only very strong and famous</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Mischaracterizes testimony.</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. Sufficient evidence has been introduced to support a finding that this witness has adequate personal</p>

<p>trademarks that are used in this manner. (Examples would be calling certain actions “mickey mouse” or a politician “teflon” or referring to “the Rolls Royce of products.”) I also note that most often in the illustrations provided by Mr. Ferrara the word “Motown” in “Motown style” is capitalized (as opposed to other types of music), further evidencing its use as a trademark.</p> <p><i>However, most important here, the trademark Motown is not used by Mattel in the sense of a style of music but only as a purported trademark on the packaging of a product.</i></p>		<p>knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This evidence is relevant to, <i>inter alia</i>, rebut Applicant’s purported expert and establish that Applicant is not entitled to registration.. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection).</p>
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(Caparis Decl, ¶ 8.)		
<p>Similarly, the evidence submitted by Mattel that refers to the city of Detroit as “Motown” also shows the strength of the Motown trademark as it refers to the record company. (Of course, Detroit is also known as “the Motor City” and “the big D,” among other nicknames.) Moreover, all of the references to Motown as one of the nicknames for Detroit that were submitted by Mattel are references in various media articles.</p> <p><i>They are not trademark uses or associated with a product, in distinction to the trademark uses of UMG</i></p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701);</p> <p>(b) Improper expert testimony (Fed. R. Evid. 702); (c) Exhibit speaks for itself (Fed. R. Evid. 1002); (d) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (e) Irrelevant (Fed. R. Evid. 402);</p> <p>(f) Hearsay (Fed. R. Evid. 802); (g) Mischaracterizes testimony; (h) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion.</p> <p>This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. This exhibit is admissible under FRE 1002 and 1003.</p> <p>Sufficient evidence has been introduced to support a</p>

<p><i>and now Mattel.</i> Any association of Motown in the minds of consumers with the city of Detroit is an association derived from the previous and ongoing fame and power of the Motown mark. The earliest use of “Motown” to refer to the record company, as reported in the Oxford English Dictionary Online, is 1961, while the earliest use of “Motown” to refer to the city of Detroit is ten years later in 1971. <u>See</u> Applicant’s Notice of Reliance Re: Printed Publications, vol. 3 of 7, Exh. A at 317-18, submitted by Mattel. An official Michigan website</p>		<p>finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This evidence is relevant to, <i>inter alia</i>, the strength of the MOTOWN mark. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. Moreover, the witness does not mischaracterize evidence (nor does Applicant even</p>
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concerning historic preservation specifically refers to the record company's influence: "In 1980 the Motown Historical Museum was established at Hitsville U.S.A. to commemorate the Motown Sound and to memorialize Motown's distinctive heritage and its global impact." (See Exhibit 13.) In essence, this "distinctive heritage" caused the city to become known (and sometimes referred to) by one of, if not its most, significant businesses and strongest trademarks: "Nashville has country music. Chicago has the blues. New Orleans has

attempt to explain this objection). There is no lack of authentication here, including because the testimony presented is a comparison by an expert witness.

<p>Dixieland. Seattle has grunge. <i>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.</i>” <u>Crain’s Detroit Business</u>, November 1, 1999. (See article attached as Exhibit 14, emphasis added.) (Caparis Decl, ¶ 9.)</p>		
<p>I will now further describe, from a marketing perspective, the reasons that, in my opinion, the use by Mattel of the Motown mark likely will cause confusion and likely will dilute UMG’s trademark.</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702).</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form</p>

(Caparis Decl, ¶ 10.)		of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case.
Initially, it should be pointed out that the fame of the Motown mark had reached those at Mattel who named their product “Motown Metal.” They knew not only of the Motown label but also of its famous recording artists. However, Mattel’s use of “Motown Metal” is curious. There is no doubt that Mattel purports to use it as a	(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Exhibit speaks for itself (Fed. R. Evid. 1002); (d) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (e) Improper Speculation; (f) Irrelevant (Fed. R. Evid. 402).	This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable

<p>trademark (even seeking this registration), and indeed, in my opinion, it does use it, albeit confusingly, in that manner on its toy cars. But there were other choices that Mattel could have made that would have been more appropriately matched to the handful of Hot Wheels toys (or the “segment,” as Mattel calls it) that are so-called “muscle cars.” For example, in its internal documents that I have reviewed, Mattel initially named these cars “Muscle Cars,” not Motown Metal. (See e.g. Exhibit 15.)</p> <p>Indeed, the name Motown Metal does not specifically</p>		<p>principles and methods, and he has applied the principles and methods reliably to the facts of the case. This exhibit is admissible under FRE 1002 and 1003.</p> <p>Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not engaging in improper speculation. This evidence is relevant to, <i>inter alia</i>, establish that Applicant is not entitled to registration.</p>
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<p>describe this genre of car, but “muscle cars” does just that. However, while “muscle cars” could refer to many of the hundreds of Hot Wheels cars, Mattel purported to use “Motown Metal” only on this one segment of five cars and does not use it anywhere else (as opposed to the widespread use by Motown Record Corporation and the successors thereto).</p> <p>Further, apparently Mattel used the “Motown Metal” name for only two years, has not used it since 2007, and has no plans to use it again. (See e.g. Mattel’s Responses to UMG Interrogatory Nos. 1, 11, 13,</p>		
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<p>attached as Exh. B to UMG’s Notice of Reliance Re: Written Discovery Responses.) Thus, there would be no reason for the public or the consumer to associate Motown or Motown Metal with Mattel and every reason to associate it with UMG’s ubiquitous Motown trademark. (Caparis Decl, ¶ 11.)</p>		
<p><u>The Two “Marks” Are Identical</u>: Probably most important from a marketing perspective (including the likelihood of confusion “Motown Metal” will engender) is the fact that the Motown trademark and Motown Metal are, from a</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Exhibit speaks for itself (Fed. R. Evid. 1002); (d) Lack of Foundation/Personal Knowledge (Fed. R.</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise</p>

<p>consumer standpoint, identical. The reasons for this are multiple: first, the word “Motown” is the most dominant aspect of “Motown Metal”; it comes first, and it modifies the word “metal.” Second, the word “metal” is not part of the “brand” but is merely descriptive of the metal composition of the toy and would be ignored by consumers as a source of origin. Third, the typeface of the Motown trademark and “Motown Metal” is the same plain typeface. Finally, Mattel even uses a stylized “M” in connection with Motown Metal, just as Motown Record Company</p>	<p>Evid. 602); (e) Improper Speculation; (f) Hearsay (Fed. R. Evid. 802); (g) Mischaracterizes testimony.</p>	<p>to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible under FRE 1002 and 1003. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not engaging in improper speculation. Moreover, this evidence is not hearsay</p>
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<p>has used a stylized “M” in connection with its Motown trademark. <u>See</u> e.g. Exhibit 16 (Deposition of Raymond Adler at 75); Exhibit 17. Beyond being identical, in the second year of its use, Mattel even increased the size and prominence of “Motown Metal” on its packaging. (See Exhibit 17.) In sum, the appearance, the sound, and the impression of the two “marks” are the same. (Caparis Decl, ¶ 12.)</p>		<p>and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection).</p>
<p><u>Type of Goods/Channels of Trade:</u> Further contributing to likely consumer confusion are various factors relating to the type of goods on which the</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Exhibit speaks for itself (Fed. R.</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training</p>

<p>Motown mark is used and their channels of trade.</p> <p><i>Both Mattel and UMG use the Motown trademark on toys and playthings.</i> Both products are leisure goods, nonessential, and collectible. (“Forever Collectibles,” one of the licensees of the Motown mark, is one of the largest manufacturers of collectible playthings.) In addition, both the toys and playthings licensed by UMG, and Motown recordings themselves, are sold in the same type of outlets as Motown Metal toys, and frequently in the same outlet itself, including in major retail stores and on</p>	<p>Evid. 1002); (d) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (e) Improper Speculation; (f) Hearsay (Fed. R. Evid. 802); (g) Mischaracterizes testimony; (h) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible under FRE 1002 and 1003. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not</p>
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<p>the Internet. Those two sources are now the two largest sources for sales of Motown recordings and also sell Hot Wheels (including Motown Metal). Examples of where both Mattel’s Motown Metal toys and Motown Records are currently sold include the popular websites Amazon.com and eBay.com, and both have been sold by K-Mart stores, Wal-Mart stores, Target stores, and Toys “R” Us. (See Exhibit 18; Exhibit 16, Adler Deposition at 100-101.) (Caparis Decl, ¶ 13.)</p>		<p>engaging in improper speculation. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection). There is no lack of authentication here, including because the testimony presented is a comparison by an expert witness.</p>
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<p><u>Demographic</u>: The consumer group for Mattel’s Motown Metal product and UMG’s Motown branded products are the same or at the least significantly overlap. Mattel has claimed that Motown Metal cars are aimed at children as well as adult collectors, and Mattel has maintained separate Hot Wheels websites for these two groups. (See Exhibit 19 and Mattel’s Response to UMG Interrogatory No. 15.) Together they cover a large age range. Of course, the Motown-licensed toys and playthings (and many other licensed</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Exhibit speaks for itself (Fed. R. Evid. 1002); (d) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (e) Improper Speculation; (f) Hearsay (Fed. R. Evid. 802); (g) Mischaracterizes testimony; (h) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible under FRE 1002 and 1003. Sufficient evidence has been introduced to support a</p>
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<p>items) also are for children; however, frequently they will be purchased by adult collectors who are very familiar with the Motown mark. Both recordings on the Motown record label and Motown Metal cars (which are circa 1970s) even evoke the same general era of approximately 40 to 50 years ago. (As a result, as noted, Motown had a large 40th Anniversary campaign, and Mattel released a “40th Anniversary Motown Metal” two-car collector set. <u>See Exhibit 20.</u>) Further, teenagers (or younger), who are among the largest group of</p>		<p>finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not engaging in improper speculation. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to</p>
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<p>purchasers of recordings, will be very familiar with the Motown name. Motown's internal marketing materials highlight the brand's "inclusive" and "generational" appeal: it is thus no surprise that the label has released recordings especially geared to children, e.g. "Motown for Kids" in 2008 and, earlier, "A Flintstones Motown Christmas," and, in addition to licensing other toys and games, has licensed videogames based on its recordings. (See e.g. Exhibit 21 and Notice of Reliance Re: Evidence Filed in <u>UMG Records, Inc.</u></p>		<p>explain this objection). There is no lack of authentication here, including because the testimony presented is a comparison by an expert witness.</p>
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<p>v. O'Rourke, Trial Declaration of Lori Froeling, Exh. 24 at p. 11.) (Caparis Decl, ¶ 14.)</p>		
<p><u>Impulse Purchase/Level of Care:</u> Both the Motown Metal toys and the Motown branded toys are classic impulse purchases. At a suggested retail list price of 99 cents, the Motown Metal toys are very inexpensive. The Motown Metal cars are interchangeable with hundreds of other Hot Wheels cars and the specific models (and their names) are replaced often; therefore, any particular toy car (and any Motown Metal car) likely is bought on impulse, not by prior design</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Exhibit speaks for itself (Fed. R. Evid. 1002); (d) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (e) Improper Speculation; (f) Hearsay (Fed. R. Evid. 802); (g) Mischaracterizes testimony.</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. These exhibits are admissible</p>

<p>or plan. Moreover, the fact that Mattel does not separately advertise Motown Metal cars (and retailers cannot even buy them individually but only in random groups which may or may not include the Motown Metal cars) evidences that buyers do not specifically target Motown Metal cars for purchase but rather that their purchase is impulsive. <u>See</u> Mattel's Supplemental Response to UMG Interrogatory No. 18 (in Exh. C to UMG's Notice of Reliance Re: Written Discovery Responses) and Exhibit 16, Adler Deposition at 98-99. Further, as Mattel has</p>		<p>under FRE 1002 and 1003. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not engaging in improper speculation. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule. Moreover, the witness</p>
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<p>testified, color that attracts children to a particular car – another sign that they are purchased on impulse. (See e.g. Exhibit 16, Adler Deposition at 115.) Finally, the purchasers of Motown Metal cars are either children or adults purchasing for children. In either event, they are not sophisticated (nor need they be) in purchasing the inexpensive toy products involved. (Even the “collectors” version of Motown Metal cars are inexpensive, with a suggested retail price of \$19.99, and often also would be impulse buys.) (Caparis Decl, ¶ 15.)</p>		<p>does not mischaracterize evidence (nor does Applicant even attempt to explain this objection).</p>
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<p>As a marketing expert, I can explain the fact there is no evidence of actual confusion here. First, the Motown Metal cars were on the market for only a relatively short period of time (two years) and, as noted, were never advertised by Mattel. Second, and probably most important, if there were actual confusion as to source and a purchaser believed that Motown Metal was associated with Opposer there would be no cause for the consumer to complain, either the Mattel or to UMG. Therefore, I would not expect there to be actual consumer complaints</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Improper Speculation.</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the facts of the case. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal</p>
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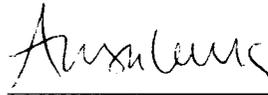
<p>evidencing confusion. (Caparis Decl, ¶ 16.)</p>		<p>knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not engaging in improper speculation.</p>
<p>My conclusion, based on my experience and the materials I have reviewed, is that the use of “Motown Metal” by Applicant is likely to cause confusion as to source among consumers who would likely believe that there is some connection between Motown Metal and UMG, and/or that UMG licensed its trademark in some fashion to Mattel, and that Motown Metal is another use of the famous Motown</p>	<p>(a) Improper legal opinion (Fed. R. Evid. 701); (b) Improper expert testimony (Fed. R. Evid. 702); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Improper Speculation.</p>	<p>This witness is not a lay witness, and is not offering improper legal opinion. This witness is qualified as an expert by knowledge, skill, experience, training and education, and may therefore testify in the form of an opinion or otherwise to this matter; his testimony is based upon sufficient facts and data, is the product of reliable principles and methods, and he has applied the principles and methods reliably to the</p>

<p>mark associated with UMG that has been used in connection with a variety of products (including toys and playthings). This conclusion is only reinforced by the fact that the packaging on the Motown Metal cars provides a lengthy list of other trademarks for which Mattel claims to have obtained a license. For that reason, the consumer would believe either that UMG licensed its trademark or that no license would be necessary to use the Motown mark. In either event, UMG would be significantly harmed, the Motown mark would be</p>		<p>facts of the case. Sufficient evidence has been introduced to support a finding that this witness has adequate personal knowledge and/or personal knowledge as contemplated by FRE 602 is not required of this expert witness. This expert witness is not engaging in improper speculation.</p>
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substantially diluted, the ability to license the mark for toys would be diminished, and its value lessened. (Caparis Decl, ¶ 17.)		
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Dated: March 15, 2010

Respectfully submitted,



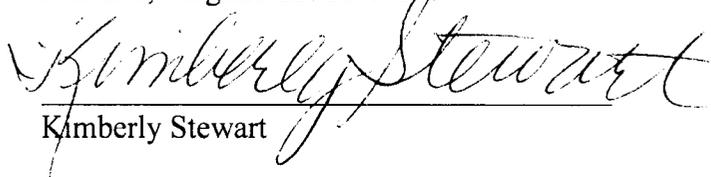
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CERTIFICATE OF MAILING

Date of Deposit: March 15, 2010

“Express Mail” mailing label number: EB519288551US

I hereby certify that this paper or fee, **RESPONSE OF OPPOSER UMG RECORDINGS, INC., TO APPLICANT MATTEL, INC.'S EVIDENTIARY OBJECTIONS TO AND REQUESTS TO STRIKE PORTIONS OF TRIAL DECLARATION OF PETER CAPARIS**, 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 **RESPONSE OF OPPOSER UMG RECORDINGS, INC., TO APPLICANT MATTEL, INC.'S EVIDENTIARY OBJECTIONS TO AND REQUESTS TO STRIKE PORTIONS OF TRIAL DECLARATION OF PETER CAPARIS** on the interested parties in this action at their last known address as set forth below by taking the action described below:

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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