

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 JERRY JUSTE**

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 Trial Declaration of Jerry Juste, dated March 16, 2009, as follows:

Evidence:	Applicant's Objection:	Opposer's Response:
The Motown label and rights in the MOTOWN Marks have passed ownership several times since the inception of the	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of	The witness has testified as to, <i>inter alia</i> , his position with his employer, his personal knowledge thereof, and his familiarity with its

<p>label. Berry Gordy originally formed the recording label as Motown Records Corporation, whose interests were later assigned to Motown Record Company, L.P. In 1993, the recording label and all rights therein were assigned to MRAC, L.P., who then changed its name back to Motown Record Company, L.P. In 2003, Motown Record Company, L.P. assigned the Motown recording label and all rights therein to UMG. True and correct copies of the applicable assignment documents, which were regularly kept in the course of UMG's business, are</p>	<p>Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>books and records. His testimony regarding his employer, including its business records, and introduction of those records is appropriate non-opinion fact testimony based upon adequate foundation and personal knowledge. His authentication of those records is likewise appropriate foundational testimony. This evidence is permissible under FRE 602, 701, 901, 1002 and 1003.</p>
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<p>attached hereto as Exhibit B. (Juste Decl., ¶ 1, at n. 1.)</p>		
<p>. . . and the recording label had its first million-sale, national hit recording, "Shop Around" by The Miracles. By 1961, Motown had achieved its first No. 1 Pop hit recording, "Please Mr. Postman" by The Marvelettes. (Juste Decl., ¶ 4.)</p>	<p>(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding his employer is appropriate non-opinion fact testimony based upon adequate foundation and personal knowledge, and is admissible under, <i>inter alia</i>, FRE 602.</p>
<p>From 1961-1971, Motown exploded onto the national charts with more than 160 Top-20 hits, including</p>	<p>(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof,</p>

<p>songs and recordings from world-renowned artists Stevie Wonder, Marvin Gaye, Diana Ross & The Supremes, The Four Tops, The Jackson 5, The Temptations, Martha & The Vandellas, Brenda Holloway and Gladys Knight & The Pips. In 1965, The Supremes had five No. 1 hits in a row, appeared on the cover of Time magazine and made a well-publicized appearance at The Copacabana. In 1968, an unprecedented 75% of Motown's releases made the national charts. (Juste Decl., ¶ 5.)</p>		<p>and his familiarity with its books and records. His testimony regarding his employer is appropriate non-opinion fact testimony based upon adequate foundation and personal knowledge, and is admissible under, <i>inter alia</i>, FRE 602.</p>
<p>The Motown Sound was</p>	<p>(a) Lack of</p>	<p>The witness has testified as</p>

<p>typified by a number of characteristics: the use of tambourines to accent the back beat; prominent and often melodic electric bass guitar lines; distinctive melodies and chord structures; and a call and response singing style that was rooted in gospel music. In addition, the Motown Sound also incorporated pop production techniques such as the use of orchestral string sections, charted horn sections, and carefully arranged background vocals. (Juste Decl., ¶ 6.)</p>	<p>Foundation/Personal Knowledge (Fed. R. Evid. 602).</p>	<p>to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding his employer is appropriate non-opinion fact testimony based upon adequate foundation and personal knowledge, and is admissible under, <i>inter alia</i>, FRE 602.</p>
<p>The hits continued in the 1970's as Marvin Gaye, Diana Ross and Smokey</p>	<p>(a) Lack of Foundation/Personal Knowledge (Fed. R. Evid.</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his</p>

<p>Robinson, along with new acts like the Commodores, continued to blaze the creative trail. During the decade, Motown averaged a Top-10 hit every three weeks. Rolling Stone magazine declared Marvin Gaye's album What's Going On Album of The Year (1971) and his hit single Let's Get It On Best Single of the Year (1973). Also, Diana Ross received a Best Actress Academy Award nomination for Motown's motion picture Lady Sings the Blues, the soundtrack for which was also a Motown release. Other Motown films included Thank God Its Friday and</p>	<p>602).</p>	<p>personal knowledge thereof, and his familiarity with its books and records. His testimony regarding his employer is appropriate non-opinion fact testimony based upon adequate foundation and personal knowledge, and is admissible under, <i>inter alia</i>, FRE 602.</p>
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<p>The Wiz, both released in 1978, and the latter starring Diana Ross and Michael Jackson among other famous Motown artists.</p> <p>But no one dominated the decade like Stevie Wonder, who kept Motown on the cutting edge, continually topping the charts with groundbreaking albums such as Talking Book, Innervisions and Songs in the Key of Life and cleaning up the GRAMMY Awards in 1975. (Juste Decl., ¶ 7.)</p>		
<p>Motown's third decade provided both new sounds and a reminder of the legacy it had created.</p>	<p>(a) Exhibit speaks for itself (Fed. R. Evid. 1002);</p> <p>(b) Lack of Foundation/Personal</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof,</p>

<p>Stevie Wonder, Diana Ross and Smokey Robinson (who Rolling Stone magazine declared Best Soul Artist in 1980), among others, continued to climb the charts, joined by Rick James' punk-funk jams (e.g., the hit Superfreak), DeBarge's family harmonies and ex- Commodores singer Lionel Ritchie's big ballads. 1983 saw a revival of sorts for the already legendary Motown Sound, including a top-rated television special Motown 25: Yesterday, Today and Forever and the hit motion picture The Big Chill, which was filled with Motown classics. Indeed, the soundtracks The Big</p>	<p>Knowledge (Fed. R. Evid. 602); (c) Hearsay (Fed. R. Evid. 802); (d) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>and his familiarity with its books and records. His testimony regarding and introduction of his employer's business records is based on his personal knowledge and likewise appropriate foundational and authentication testimony. 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, including but not limited to FRE 803(6). This evidence is admissible</p>
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<p>Chill (which has been re-released in enhanced versions in 1990, 1998 and 2004) and The Big Chill: More Songs from the Original Soundtrack, both Motown releases featuring dozens of Motown recordings, have sold more than seven million units to date. The Big Chill soundtrack alone surpassed the 6x Platinum mark as determined by the Recording Industry Association of America ("RIAA"), making it one of the top 100 selling albums of all time — see <i>infra</i>, Exs. C-D. Also, in the mid to late 1980s, Stevie Wonder and Lionel Richie</p>		<p>under, <i>inter alia</i>, FRE 602, 802, 901, 1002 and 1003.</p>
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<p>both won Academy Awards for Best Song In A Motion Picture, and Motown legends Smokey Robinson, Marvin Gaye and Berry Gordy were inducted into the Rock & Roll Hall of Fame. (Juste Decl., ¶ 8.)</p>		
<p>The enduring success of the Motown brand is further highlighted by the fact that Motown recordings continue to surge past the Gold / Platinum / Multi-Platinum thresholds established by the RIAA. In the 1990s alone, more than fifty Motown records surpassed the Gold / Platinum / Multi-Platinum certification thresholds, and</p>	<p>(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Irrelevant (Fed. R. Evid. 402); (d) Hearsay (Fed. R. Evid. 802); (e) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding and introduction of his employer's business records is based on his personal knowledge and likewise appropriate foundational and</p>

<p>since 2000, more than thirty Motown albums have surpassed the coveted RIAA levels. Attached hereto as Exhibit C is a true and correct printout from the RIAA database (available at www.riaa.com) listing Motown's Gold, Platinum and Multi-Platinum recordings.</p> <p>{Footnote 2--RIAA issues Gold Record certification when U.S. sales exceed 500,000 units, Platinum Record certification when U.S. sales exceed 1,000,000 units and Multi-Platinum Record certifications for every million records sold thereafter. Attached hereto as Exhibit D is a true and</p>		<p>authentication testimony. It is relevant to, <i>inter alia</i>, show the history and fame 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, including but not limited to FRE 803(6). This evidence is admissible under, <i>inter alia</i>, FRE 402, 602, 802, 901, 1002 and 1003.</p>
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<p>correct printout from the RIAA website (www.riaa.com) detailing these certification criteria.] (Juste Decl., ¶ 10.)</p>		
<p>Any slice of Motown's history contains numerous success stories, but the achievements over the lifetime of the recording label are among the most impressive in the industry. In total, Motown has released more than eighty Gold albums, more than forty Platinum albums and fourteen multi-Platinum albums. See Exhibit C. Motown has five entries on the Top 100 Albums of all time (based on U.S. sales)</p>	<p>(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Irrelevant (Fed. R. Evid. 402); (d) Hearsay (Fed. R. Evid. 802); (e) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding and introduction of his employer's business records is based on his personal knowledge and likewise appropriate foundational and authentication testimony. It is relevant to, <i>inter alia</i>, show the history and fame</p>

<p>— Boys II Men, II (12x Platinum), Stevie Wonder, Songs in the Key of Life (10x Platinum), Lionel Ritchie, Can't Slow Down (10x Platinum), Boys II Men, Cooliehighharmony (9x Platinum) and The Big Chill Soundtrack (6x Platinum). Attached hereto as Exhibit E is a printout from the RIAA database reflecting the Top 100 Albums in the United States. Over the course of its history, Motown has had over 50 Number- One Singles in the United States on Billboard Magazine's "The Billboard Hot 100" and over 150 Number-One hits across the Billboard</p>		<p>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, including but not limited to FRE 803(6). This evidence is admissible under, <i>inter alia</i>, FRE 402, 602, 802, 901, 1002 and 1003.</p>
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charts (e.g., Pop, R&B, etc.). (Juste Decl., ¶ 11.)		
<p>Motown's pivotal place in American history is further supported by the numerous publications that have been dedicated to the recording label. Attached hereto as Exhibit F are true and correct photocopies of the cover pages of Motown-owned publications, which are regularly kept in the course of UMG's business. But also, there have been numerous third-party publications about Motown, which are referenced in the Declaration of Mario Ortiz submitted contemporaneously</p>	<p>(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Hearsay (Fed. R. Evid. 802); (d) Lacks Authentication (Fed. R. Evid. 901).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding and introduction of his employer's business records is based on his personal knowledge and likewise appropriate foundational and authentication testimony. Moreover, this evidence is not hearsay and does not violate FRE 802, as the witness is not offering into evidence statements other</p>

<p>herewith. Also, the media consistently recognizes the importance and renown of the Motown brand with its press coverage over the years. Attached hereto as Exhibit G are printouts of a representative sampling of third-party articles discussing Motown that have been published in the United States and around the world during the last ten years. (Juste Decl., ¶ 12.)</p>		<p>than his own to prove the truth of the matter asserted, and/or the statements are an exception to the hearsay rule, including but not limited to FRE 803(6). This evidence is admissible under, <i>inter alia</i>, FRE 602, 802, 901, 1002 and 1003.</p>
<p>As a result of the enormous success of the Motown recording label, the MOTOWN Marks have become inordinately famous and immediately recognizable to consumers</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Documents speak for themselves (Fed. R. Evid. 1002); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid.</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding his</p>

<p>in the United States. The use and fame of the MOTOWN Marks in connection with a wide range of goods and services, including Motown's licensing of the MOTOWN Marks in connection with toys, games and playthings, is covered in detail in the Declarations submitted contemporaneously herewith. (Juste Decl., ¶ 13.)</p>	<p>602); (d) Improper Speculation; (e) Hearsay (Fed. R. Evid. 802); (f) Mischaracterizes testimony.</p>	<p>employer's trademarks and use thereof is appropriate non-opinion fact testimony. His testimony in connection therewith is based on his personal knowledge and likewise appropriate foundational and authentication testimony. 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, including but not limited to FRE 803(6). This evidence is admissible under, <i>inter alia</i>, FRE 602,</p>
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		701, 802, 1002 and 1003. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection).
In addition to licensing its MOTOWN Marks in connection with toys, games, and playthings, one of UMG's predecessors was directly involved in the sale of such goods. Namely, in 1995 Motown Records established Motown Animation. In 1996, through Image Comics, Motown Animation published the comic book series "The Crush." Various MOTOWN Marks appeared prominently in	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002); (c) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (d) Irrelevant (Fed. R. Evid. 402); (e) Mischaracterizes testimony; (f) Lacks Authentication (Fed. R. Evid. 901).	The witness has testified as to, <i>inter alia</i> , his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding his employer's trademarks and use thereof is appropriate non-opinion fact testimony. His testimony in connection therewith is based on his personal knowledge and likewise appropriate foundational and authentication testimony.

<p>connection with that series of comic books. True and correct copies of selected pages from Issues 1-5 of "The Crush," depicting the use of MOTOWN Marks in connection with comic books, are attached hereto as Exhibit H. (Juste Decl., ¶ 14.)</p>		<p>This evidence is relevant to, <i>inter alia</i>, show the history and fame of MOTOWN, and goods sold in connection therewith. This evidence is admissible under, <i>inter alia</i>, FRE 402, 602, 701, 901, 1002, and 1003. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain this objection).</p>
<p>UMG has no business relationship with Mattel, Inc. ("Applicant"), nor has Applicant had any business relationship with Motown or any of UMG's predecessors. UMG has never authorized Applicant</p>	<p>(a) Irrelevant (Fed. R. Evid. 402).</p>	<p>Relevant to establish that Applicant is not using MOTOWN METAL with Opposer's permission, and to show Opposer's policing of its MOTOWN trademarks.</p>

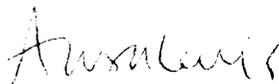
<p>or otherwise permitted it to use the MOTOWN Marks, or any variation thereof or other mark similar thereto. There has never been any consent agreement, assignment, license or any other agreement between UMG and Applicant relating to the use of any of the marks at issue in this opposition proceeding. (Juste Decl., ¶ 15.)</p>		
<p>We at UMG were very upset to learn that the Applicant has applied to register a mark that consists primarily of the term MOTOWN, which is identical to many of the MOTOWN Marks and is</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Improper Speculation; (d) Irrelevant (Fed. R. Evid. 402);</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer, his personal knowledge thereof, and his familiarity with its books and records. His testimony regarding his employer's trademarks and</p>

<p>virtually indistinguishable from the remainder of the MOTOWN Marks. If Applicant were permitted to obtain a registration for a mark identical to the MOTOWN Marks in connection with goods identical to those offered by UMG's licensees under its MOTOWN Marks, the value of the MOTOWN Marks and the ability of the marks to indicate goods and services emanating from a single source would be greatly injured. The great investment by UMG and its predecessors in its MOTOWN Marks would be injured as well.. Accordingly, UMG strongly</p>	<p>(e) Mischaracterizes testimony.</p>	<p>licensing activity is appropriate non-opinion fact testimony. His testimony in connection therewith is based on his personal knowledge and likewise appropriate foundational and authentication testimony. This evidence is relevant to, <i>inter alia</i>, establish that Applicant is not using MOTOWN METAL with Opposer's permission, and to show Opposer's policing of its MOTOWN trademarks. This evidence is admissible under, <i>inter alia</i>, FRE 402, 602, and 701. Moreover, the witness does not mischaracterize evidence (nor does</p>
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objects to registration of Applicant's mark. (Juste Decl., ¶ 16.)		Applicant even attempt to explain this objection).
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Dated: March 15, 2010

Respectfully submitted,



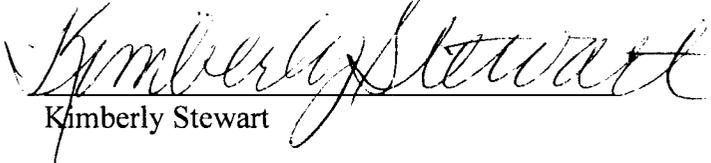
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CERTIFICATE OF MAILING

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 JERRY JUSTE**, 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 JERRY JUSTE** 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

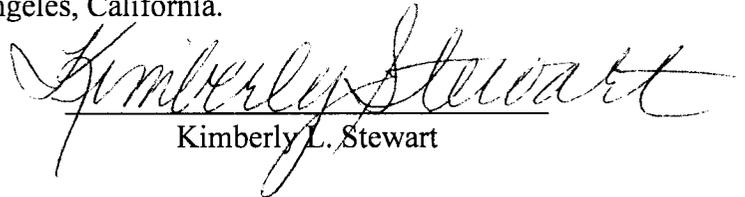
am readily familiar with the firm's practice for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at 11377 West Olympic Boulevard, Los 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