

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 WILLIAM WADDELL**

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 William Waddell, dated March 17, 2009, as follows:

Evidence:	Applicant's Objection:	Opposer's Response:
UMG has entered into numerous license agreements with third parties for use of	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself	The witness has testified as to, <i>inter alia</i> , his position with his employer and his familiarity with its books

<p>MOTOWN and MOTOWN-formative trademarks referenced in the chart attached hereto as Exhibit I (the “MOTOWN Marks”) in connection with a wide variety of goods and services, which have generated significant additional revenue for UMG. (Waddell Decl., ¶ 3.)</p>	<p>(Fed. R. Evid. 1002).</p>	<p>and records. His testimony regarding trademark licensing is appropriate non-opinion fact testimony. His testimony and introduction of a chart of trademarks is likewise appropriate foundational testimony. This evidence is admissible under, <i>inter alia</i>, FRE 701, 1002, and 1003.</p>
<p>In connection with the nationwide sale of toys, games, and playthings in particular, UMG’s licensing activity is as follows. (Waddell Decl., ¶ 4.)</p>	<p>(a) Exhibit speaks for itself (Fed. R. Evid. 1002); (b) Lack of Foundation/Personal Knowledge (Fed. R. Evid. 602); (c) Mischaracterizes evidence.</p>	<p>Applicant’s objections are improper including because there is no “exhibit” referenced in this portion of the Waddell Declaration. Moreover, his testimony regarding his employer’s licensing activity is based on his personal knowledge and does not violate FRE</p>

		602. Moreover, the witness does not mischaracterize evidence (nor does Applicant even attempt to explain what is purportedly mischaracterized).
On or around December 1, 2001, UMG's predecessor-in-interest entered into a license agreement with CA One Services Inc, for use of MOTOWN Marks and Motown memorabilia in connection with the operation of a Motown Store in the Detroit metropolitan area. A true and correct copy of that license agreement, which is regularly kept in the course of UMG's business, and photographic depictions of	(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002).	The witness has testified as to, <i>inter alia</i> , his position with his employer and his familiarity with its books and records. His introduction of a license agreement, photographs of licensed merchandise, and testimony in connection therewith is appropriate non-opinion fact testimony. His authentication thereof is likewise appropriate foundational testimony. This evidence is admissible under, <i>inter alia</i> , FRE 701,

<p>some of the licensed merchandise are attached hereto as, respectively, Exhibits J and K. (Waddell Decl., ¶ 5.)</p>		<p>1002, 1003 and TBMP 703.01.</p>
<p>On or around October 31, 2002, UMG entered into a license agreement with Late for the Sky Productions Co., Inc., for use of MOTOWN Marks in connection with a board game. A true and correct copy of that license agreement, which is regularly kept in the course of UMG's business, and photographic depictions of the licensed merchandise are attached hereto as, respectively, Exhibits L and M. (Waddell Decl., ¶ 6.)</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer and his familiarity with its books and records. His introduction of a license agreement, photographs of licensed merchandise, and testimony in connection therewith is appropriate non-opinion fact testimony. His authentication thereof is likewise appropriate foundational testimony. This evidence is admissible under, <i>inter alia</i>, FRE 701, 1002, 1003 and TBMP</p>

		703.01.
<p>On or around February 7, 2003, UMG entered into a license agreement with The Singing Machine Company, Inc., for use of MOTOWN Marks in connection with a karaoke machine and karaoke “CDGs” (CDs with graphics). A true and correct copy of that license agreement, which is regularly kept in the course of UMG’s business, and photographic depictions of the licensed merchandise are attached hereto as, respectively, Exhibits N and O. (Waddell Decl., ¶ 7.)</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701);</p> <p>(b) Exhibit speaks for itself (Fed. R. Evid. 1002).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer and his familiarity with its books and records. His introduction of a license agreement, photographs of licensed merchandise, and testimony in connection therewith is appropriate non-opinion fact testimony. His authentication thereof is likewise appropriate foundational testimony. This evidence is admissible under, <i>inter alia</i>, FRE 701, 1002, 1003 and TBMP 703.01.</p>
<p>On or around November 16, 2004, UMG entered into a license agreement with</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701);</p> <p>(b) Exhibit speaks for itself</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer and his</p>

<p>Konami Digital Entertainment, Inc., for use of MOTOWN Marks in connection with a videogame. A true and correct copy of that license agreement, which is regularly kept in the course of UMG's business, and photographic depictions of the licensed merchandise are attached hereto as, respectively, Exhibits P and Q. (Waddell Decl., ¶ 8.)</p>	<p>(Fed. R. Evid. 1002).</p>	<p>familiarity with its books and records. His introduction of a license agreement, photographs of licensed merchandise, and testimony in connection therewith is appropriate non-opinion fact testimony. His authentication thereof is likewise appropriate foundational testimony. This evidence is admissible under, <i>inter alia</i>, FRE 701, 1002, 1003 and TBMP 703.01.</p>
<p>On or around May 19, 2004, UMG entered into a license agreement with Hasbro, Inc., for use of MOTOWN Marks in connection with a toy known as "HitClips." A</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer and his familiarity with its books and records. His introduction of license agreements, photographs of</p>

<p>true and correct copy of that license agreement, which is regularly kept in the course of UMG's business, and photographic depictions of the licensed merchandise are attached hereto as, respectively, Exhibits R and S. On or around November 6, 2008, UMG also entered into a license relationship with Hasbro, Inc. in connection with a "ToothTunes" musical toothbrush, a photographic depiction of which is attached hereto as Exhibit T. (Waddell Decl., ¶ 9.)</p>		<p>licensed merchandise, and testimony in connection therewith is appropriate non-opinion fact testimony. His authentication thereof is likewise appropriate foundational testimony. This evidence is admissible under, <i>inter alia</i>, FRE 701, 1002, 1003 and TBMP 703.01.</p>
<p>True and correct copies of UMG's business records reflecting royalties in</p>	<p>(a) Exhibit speaks for itself (Fed. R. Evid. 1002).</p>	<p>The witness has testified as to, <i>inter alia</i>, his position with his employer and his</p>

<p>connection with its aforementioned licenses in connection with toys, games, and playthings, which are regularly kept in the course of UMG's business, are attached hereto as Exhibit U, including: (1) "licensing reports" produced by UMG in the course of this Opposition, bates-labeled UMG 106, 108 and 123; (2) correspondence between UMG and its licensing agents produced by UMG in the course of this Opposition, bates-labeled UMG 100, 110, 112, 115 and 121; (3) "quarterly royalty statements" produced by UMG in the</p>		<p>familiarity with its books and records. His introduction and authentication of those business records is appropriate foundational testimony, and is admissible under, <i>inter alia</i>, FRE 1002 and 1003.</p>
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<p>course of this Opposition, bates-labeled UMG 82, 83, 89, 95, 97, 103, 109, 113, 114, 126, 130 and 133; (4) copies of checks produced by UMG in the course of this Opposition, bates-labeled UMG74, 81, 88, 93, 96, 98, 101, 104, 105, 107, 116, 117, 120, 124, 127, 128, 131 and 134; (5) a wire transfer statement produced by UMG in the course of this Opposition, bates-labeled UMG 132; (6) a journal entry produced by UMG in the course of this Opposition, bates- labeled UMG 72; (7) "payment requests" produced by UMG in the course of this Opposition,</p>		
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<p>bates-labeled UMG 76, 87, 92, 94, 99, 102, 111, 125 and 129; (8) a Hasbro report, produced by UMG in the course of this Opposition, bates-labeled UMG 215; (9) documents entitled "Summary of Revenues / Royalties Paid produced by UMG in the course of this Opposition, bates-labeled UMG 207-214. (Waddell Decl., ¶ 10.)</p>		
<p>All of the foregoing use of the MOTOWN Marks by third parties is under license from UMG and inures to UMG's benefit. (Waddell Decl., ¶ 11.)</p>	<p>(a) Improper Legal Opinion (Fed. R. Evid. 701); (b) Exhibit speaks for itself (Fed. R. Evid. 1002).</p>	<p>Applicant's objections are improper including because there is no "exhibit" referenced in this portion of the Waddell Declaration. Moreover, the witness has testified as to, <i>inter alia</i>, his position with his employer and his familiarity with its</p>

		books and records. His testimony regarding trademark licensing is appropriate non-opinion fact testimony, and this evidence is admissible under, <i>inter alia</i> , FRE 701.
True and correct copies of UMG's U.S Registration Nos. 1075409, 2663608, 2767101, 0881471, 0985976, 0985972, 2516930, and 3073897 for the Motown marks and various related official records, copies of which are regularly kept in the course of UMG's business, are attached hereto as Exhibit V. (Waddell Decl., ¶ 12.)	(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) Lacks Authentication (Fed. R. Evid. 901); [(e)] Improper submission of registrations (Trademark Rule 2.122(d)).	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 its trademark registrations is appropriate non-opinion fact testimony. His introduction of the same is based on his personal knowledge and likewise appropriate foundational and authentication

		testimony. This evidence is admissible under, <i>inter alia</i> , FRE 602, 701, 901, 1002, and 1003. Moreover, Opposer has properly submitted its registrations under separate cover, and there is no bar to witness testimony in connection therewith.
UMG vigorously enforces its trademark rights against third parties. Attached hereto as Exhibit W is a representative sampling of true and correct copies of enforcement documents sent by UMG to various third parties, copies of which are regularly kept in the course of UMG's business, including: (1) a	(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) Hearsay (Fed. R. Evid. 802).	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 its trademark enforcement is appropriate non-opinion fact testimony. His introduction of the same is based on his personal

<p>February 25, 2005 cease and desist letter to Beasley Broadcast Group, Inc.; (2) a July 18, 2005 opposition to Millers Oils Limited; (3) an October 3, 2005 cease and desist letter to SOFA Home Entertainment; (4) an April 6, 2006 cease and desist letter to SonyBMG; (5) an April 18, 2007 cease and desist letter to American Motown.com, LLC; (6) a February 20, 2008 Opposition to Motown Harley-Davidson, Inc.; (7) a May 13, 2008 cease and desist letter to 1 & 1 Internet, Inc. and SJG Productions LLC; (8) a September 10, 2008 cease and desist letter to Peter</p>		<p>knowledge and likewise appropriate foundational and authentication testimony. This evidence is admissible under, <i>inter alia</i>, FRE 602, 701, 1002 and 1003. 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 rule, including but not limited to FRE 803(6).</p>
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Brent Promotions. (Waddell Decl., ¶ 13.)		
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Dated: March 15, 2010

Respectfully submitted,



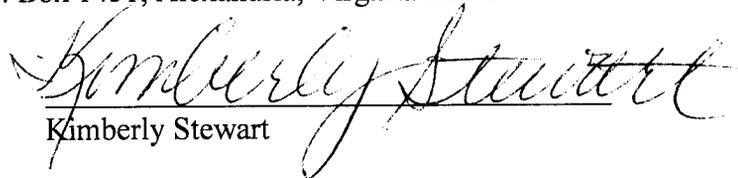
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CERTIFICATE OF MAILING

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 WILLIAM WADDELL**, 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 WILLIAM WADDELL** 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 _____ 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

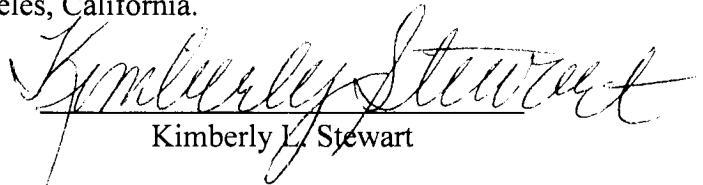
am readily familiar with the firm's practice for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at 11377 West Olympic Boulevard, Los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