

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

---

ANSWER TO AMENDED COUNTERCLAIM TO CANCEL AND/OR LIMIT  
TRADEMARK REGISTRATIONS

UMG Recordings, Inc. ("Opposer" or "UMG"), a Delaware corporation having its principal place of business in Santa Monica, California, hereby answers the amended Counterclaim filed by Mattel, Inc. ("Applicant") as follows:

1. Answering paragraph 17 of Mattel's Counterclaim, UMG admits that its intent to use applications nos. 78/614895 and 78/617352 for "video game software, tapes, cartridges, cassettes [or] joysticks" were filed for use in International Class 9, and not International Class 28, but denies the remaining allegations of paragraph 17.



08-07-2007

2. Answering paragraph 22 of Mattel's Counterclaim, UMG lacks knowledge or information sufficient to form a belief as to the allegations of paragraph 22, and on that basis denies such allegations, except that UMG specifically and without limitation denies that the word "Motown" is a generic geographic description and thus is entitled, at best, to extremely limited protection as a trademark, and that Mattel has any right to use the word "Motown" as part of the mark MOTOWN METAL in connection with the sale of HOT WHEELS cars.

3. Answering paragraph 23 of Mattel's Counterclaim, UMG lacks knowledge or information sufficient to form a belief as to the allegations of paragraph 23, and on that basis denies such allegations.

4. Answering paragraph 24 of Mattel's Counterclaim, UMG avers that it has not registered the marks MOTOWN and/or MOTOWN and Design for "toys, games and playthings, namely, toy vehicles and accessories therefor," in Class 28, and denies that it has no common law rights in the marks MOTOWN and/or MOTOWN and Design in Class 28.

5. Answering paragraph 26 of Mattel's Counterclaim, UMG hereby incorporates by reference its responses to paragraphs 17 and 22-24 of this Answer as though set forth in full herein.

6. Answering paragraph 27 of Mattel's Counterclaim, UMG denies that it has never used the marks MOTOWN and/or MOTOWN and Design in International Class 28, "toys, games and playthings," and avers that it has not used the marks MOTOWN and/or MOTOWN and Design in connection with motor vehicles, including toy vehicles and accessories therefore.

7. UMG admits the allegations of paragraph 28 of Mattel's Counterclaim, except that UMG denies that it does not have common law rights to use the marks MOTOWN and MOTOWN and Design in Class 28, and denies that a likelihood of consumer confusion would be avoided by entry of any limitation and/or restriction on UMG's MOTOWN and MOTOWN and Design marks.

8. Responding to Mattel's prayer for relief, UMG alleges that Mattel's Counterclaim is without foundation in law or fact and that it should be denied in its entirety.

9. Although no response by UMG is required to Mattel's affirmative defenses, out of an abundance of caution and for avoidance of doubt UMG denies that any of those affirmative defenses has any merit whatsoever.

**FIRST AFFIRMATIVE DEFENSE**

10. The Counterclaim fails to state facts sufficient to constitute a cause of action against UMG.

**SECOND AFFIRMATIVE DEFENSE**

11. UMG is informed and believes, and based thereon alleges, that Mattel has unclean hands and acted in bad faith in filing its Counterclaim.

**THIRD AFFIRMATIVE DEFENSE**

12. Mattel cannot assert or obtain relief on the Counterclaim based on the doctrines of estoppel, waiver, and/or laches.

**FOURTH AFFIRMATIVE DEFENSE**

13. The Counterclaim is barred because Mattel consented to and acquiesced in UMG's conduct.

**FIFTH AFFIRMATIVE DEFENSE**

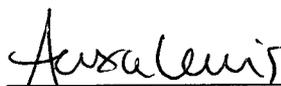
14. UMG is informed and believes, and based thereon alleges, that to the extent Mattel ever possessed any enforceable trademark rights in MOTOWN METAL, which UMG denies, Mattel has abandoned such rights.

WHEREFORE, UMG requests that this Opposition be sustained in favor of UMG, that the Application and Counterclaim be rejected, and that the registration of the Application be refused.

Please address all correspondence to Jeffrey D. Goldman, Esq. and Alexa L. Lewis, Esq., Mitchell Silberberg & Knupp, LLP, 11377 West Olympic Boulevard, Los Angeles, California 90064.

DATED: August 6, 2007

Respectfully submitted,

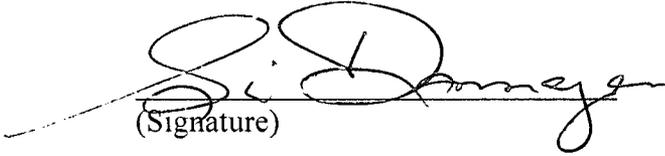


---

Jeffrey D. Goldman, Esq.  
Alexa L. Lewis, Esq.  
Mitchell Silberberg & Knupp LLP  
11377 W. Olympic Boulevard  
Los Angeles, CA 90064  
(310) 312-3715  
Attorneys for Opposer

Date of Deposit: 8/6/07

I hereby certify that this paper or fee is being deposited with the United States Postal Service on the date indicated above and is addressed to: Assistant Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

  
(Signature)

**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.

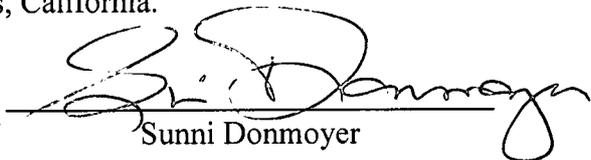
On August 6, 2007, I served a copy of the foregoing document(s) described as **ANSWER TO AMENDED COUNTERCLAIM TO CANCEL AND/OR LIMIT TRADEMARK REGISTRATIONS** on the interested parties in this action at their last known address as set forth below by taking the action described below:

Lawrence Y. Iser (liser@kwikalaw.com) Counsel for Applicant, MATTEL, INC.  
Patricia A. Millett (pmillet@kwikalaw.com)  
Kinsella, Weitzman, Iser, Kump & Aldisert  
LLP  
808 Wilshire Boulevard, 3rd Floor  
Santa Monica, CA 90401

- 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.

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

Executed on August 6, 2007, at Los Angeles, California.

  
Sunni Donmoyer