

**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

**OPPOSER UMG RECORDINGS, INC'S MOTION TO COMPEL FURTHER  
RESPONSES TO INTERROGATORIES; MOTION TO EXCLUDE; AND BRIEF IN  
SUPPORT THEREOF**



**02-29-2008**

TABLE OF CONTENTS

	Page
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD.....	1
TABLE OF CONTENTS .....	i
TABLE OF AUTHORITIES .....	ii
CASES .....	ii
STATUTES .....	ii
I. STATEMENT OF FACTS .....	2
II. THE INTERROGATORIES AT ISSUE .....	3
A. AT THE PARTIES' DISCOVERY CONFERENCE, MATTEL AGREED TO SUPPLEMENT ITS DISCOVERY RESPONSES, BUT, A MONTH AND A HALF LATER, HAS NOT DONE SO. ....	4
B. THE INTERROGATORIES THAT SHOULD BE ANSWERED BY MATTEL .....	4
1. Interrogatory No. 11 Should Be Answered by Mattel.....	5
2. Interrogatory No. 12 Should Be Answered by Mattel.....	5
3. Interrogatory No. 13 Should Be Answered by Mattel.....	6
4. Interrogatory No. 14 Should Be Answered by Mattel.....	7
5. Interrogatory No. 15 Should Be Answered by Mattel.....	8
6. Interrogatory No. 16 Should Be Answered by Mattel.....	9
7. Interrogatory No. 17 Should Be Answered by Mattel.....	10
8. Interrogatory No. 18 Should Be Answered by Mattel.....	11
9. Interrogatory No. 19 Should Be Answered by Mattel.....	12
10. Interrogatory No. 20 Should Be Answered by Mattel.....	13
11. Interrogatory No. 21 Should Be Answered by Mattel.....	14
12. Interrogatory No. 22 Should Be Answered by Mattel.....	15
13. Interrogatory No. 23 Should Be Answered by Mattel.....	16
14. Interrogatory No. 24 Should Be Answered by Mattel.....	17
15. Interrogatory No. 31 Should Be Answered by Mattel.....	18
16. Interrogatory No. 32 Should Be Answered by Mattel.....	19
17. Interrogatory No. 33 Should Be Answered by Mattel.....	20
18. Interrogatory No. 34 Should Be Answered by Mattel.....	21
III. MOTION TO STRIKE AND MOTION TO EXCLUDE .....	22
IV. CONCLUSION .....	23

**TABLE OF AUTHORITIES**

**Page**

**CASES**

*American Optical Corp. v. Exomet, Inc.*,  
181 U.S.P.Q. 120 (T.T.A.B. 1974)..... 13

*American Society of Oral Surgeons v. American College of  
Oral Maxillofacial Surgeons*,  
201 U.S.P.Q. 531 (T.T.A.B. 1979)..... 20, 22

*Dep v. Opti-Ray, Inc.*,  
768 F. Supp. 710 (C.D. Cal. 1991)..... 9

*Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*,  
7 U.S.P.Q.2d 1359 (TTAB 1988)..... 20, 21

*J.B. Williams Co., Inc. v. Pepsodent G.m.b.H.*,  
188 U.S.P.Q. 577 (TTAB 1975)..... 12, 17

*Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*,  
10 U.S.P.Q.2d 1671 (TTAB 1988)..... 3

*Mack Trucks, h/c. v. Monroe Auto Equipment Company*,  
181 U.S.P.Q. 286 (TTAB 1974)..... 22

*Shoe Factory Supplies Co. v. Thermal Engineering Company*,  
207 U.S.P.Q. 517 (TTAB 1980)..... 22

*Sunkist Growers, Inc. v. Benjamin Ansehl Company*,  
229 U.S.P.Q. 147 (TTAB 1985)..... 9, 11, 22

*Varian Associates v. Fairfield-Noble Corp.*,  
188 U.S.P.Q. 581 (TTAB 1975)..... passim

**STATUTES**

37 C.F.R. § 2.120(e) ..... 1, 2

FRCP 37 ..... 1

TBMP § 402.01 ..... 3

Pursuant to 37 C.F.R. § 2.120(e) and Federal Rule of Civil Procedure 37, Opposer UMG Recordings, Inc. ("UMG") hereby moves the Board for an order compelling Mattel, Inc. ("Mattel") to provide supplemental responses to certain of UMG's First Set of Interrogatories. Specifically, UMG's motion seeks an order compelling Mattel to fully respond to Interrogatories Nos. 11-24 and 31-34. In the alternative, UMG moves the Board for an order striking Mattel's affirmative defenses and to exclude any evidence by Mattel during its testimony period or during the rebuttal testimony period on which Mattel refuses to provide discovery.

This motion to compel is made on the grounds that: (1) despite its agreement to do so, Mattel failed to fully respond to Interrogatories Nos. 11-24 and 31-34 based upon improper objections; and (2) all of the discovery requests seek relevant and discoverable information such as Mattel's method of marketing goods bearing the MOTOWN METAL mark, the sales of the product bearing the MOTOWN METAL mark, and the amount spent by Mattel advertising its product bearing the MOTOWN METAL mark. This motion is supported by the accompanying brief, the Declaration of Alexa L. Lewis, and any other papers and argument presented to the Board.

UMG has attempted in good faith to resolve this discovery dispute with Mattel prior to filing this motion. The parties met and conferred regarding these issues on January 17, 2008, and have communicated to narrow the issues to be resolved in this motion to compel since that date. Although it has agreed to supplement its responses, Mattel has not actually done so. Thus, no resolution has been reached to prevent the necessity of filing the instant motion.

Respectfully submitted,

DATED: February 20, 2008

MITCHELL SILBERBERG & KNUPP LLP

By:



Alexa L. Lewis  
Attorneys for Opposer UMG Recordings, Inc.

## **BRIEF IN SUPPORT OF MOTION**

### **I. STATEMENT OF FACTS**

On April 11, 2007, UMG filed a Notice of Opposition against Mattel's November 10, 2005 intent-to-use application to register the mark MOTOWN METAL for toys, games and playthings, namely, toy vehicles and accessories (the "Application").

UMG is the owner of numerous MOTOWN marks, including for toys, games and playthings, as set forth in UMG's Amended Notice of Opposition, the use of which predate Mattel's use of MOTOWN METAL. The crux of this case is that Mattel's mark MOTOWN METAL so resembles UMG's MOTOWN Marks so as to be likely to cause confusion, or to cause mistake or to deceive, and that use by Mattel of the mark MOTOWN METAL will dilute the distinctive quality of UMG's famous MOTOWN marks.

Mattel contends that its mark MOTOWN METAL is not similar to UMG's mark MOTOWN, and its product bearing the MOTOWN METAL mark is used for goods that are not similar to UMG's goods for which it uses MOTOWN. In an attempt to discover facts regarding Mattel's contentions in this case, on August 28, 2007, UMG propounded its discovery requests on Mattel, including its First Set of Interrogatories ("Interrogatories") (Nos. 1-37). *See Exhibit 1*, attached to the Declaration of Alexa L. Lewis ("Lewis Decl."), filed herewith. UMG received Mattel's response on October 9, 2007. *See, Exhibit 3*, Lewis Decl.

On October 31, 2007, UMG wrote a letter to Mattel informing Mattel of the deficiency of its responses to a number of UMG's Interrogatories. UMG requested to meet and confer with Mattel pursuant to 37 C.F.R. § 2.120(e) regarding the discovery requests prior to UMG's filing a motion to compel. *See, Exhibit 5* Lewis Decl.

Counsel for the parties held a discovery conference on January 17, 2008, wherein they discussed a possible resolution to each discovery request in dispute. *See, ¶ 6*, Lewis Decl. Many issues seemed to be resolved at the meet and confer, as Mattel agreed to

supplement its written responses to UMG's discovery requests. *See*, ¶ 6 and **Exhibit 6** to Lewis Decl.

A month and a half has passed since the parties' discovery conference, and Mattel still has not supplemented its responses. *See*, ¶ 11 and **Exhibit 6**, Lewis Decl. The parties are engaged in settlement negotiations, and have filed a stipulation asking the Board to re-set upcoming deadlines. *See*, ¶ 9 and **Exhibit 7** to Lewis Decl. However, under the current schedule imposed by the Board's Order of December 5, 2007, UMG's thirty-day testimony period closes on April 1, 2008. *See*, ¶ 10 and **Exhibit 8** to Lewis Decl. Pursuant to 37 C.F.R. § 2.120(e), any motion to compel must be filed before any party's testimony period opens. UMG is thus forced to file the present motion.

Mattel's refusal to date to provide the information at issue is unsupported under the Board's rules of discovery and the Federal Rules of Civil Procedure, as explained in detail below. Therefore, UMG requests that the Board issue an order compelling Mattel to provide supplemental responses to UMG's Interrogatories at issue.

## II. THE INTERROGATORIES AT ISSUE

All of the information requested in UMG's Interrogatories is relevant and discoverable. *See* TM Trial & App. Bd. Man. of Proc. § 402.01. Mattel's refusal to provide clearly relevant and discoverable information is contrary to the policy for discovery established by the Federal Rule of Civil Procedure and the policy of the Board. *Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 10 U.S.P.Q.2d 1671, 1674 (T.T.A.B. 1988) (“[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case.”), quoting *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 U.S.P.Q. 80, 83 (T.T.A.B. 1984). UMG has satisfied its duty by inquiring into areas that are relevant to the claims and defenses of this proceeding. Mattel must fulfill its duty by allowing discovery on

such issues. The discovery sought by UMG is relevant, not burdensome to produce, and discoverable. The Board should grant UMG's motion to compel in its entirety.

**A. AT THE PARTIES' DISCOVERY CONFERENCE, MATTEL AGREED TO SUPPLEMENT ITS DISCOVERY RESPONSES, BUT, A MONTH AND A HALF LATER, HAS NOT DONE SO.**

At the parties' January 17, 2008 discovery conference, counsel for Mattel agreed to serve amended responses to UMG's Interrogatories. *See*, ¶ 6 and **Exhibit 6** to Lewis Decl. Mattel has therefore waived its objections, and should be required to supplement each Interrogatory discussed with UMG.

**B. THE INTERROGATORIES THAT SHOULD BE ANSWERED BY MATTEL**

Mattel objected to the subject Interrogatories on many grounds, all meritless.<sup>1</sup> UMG therefore requests that the Board order Mattel to fully respond to Interrogatories Nos. 11-24 and 31-34.

**INTERROGATORY NO. 11:**

State whether the use of MOTOWN METAL has been interrupted from the date of first use to the present, and explain in detail the reasons for such interruption and specify the terms of each interrupted use.

**RESPONSE TO INTERROGATORY NO. 11:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous.

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<sup>1</sup> UMG's Interrogatories seek information often corresponding with the Document Requests discussed in the Motion filed contemporaneously herewith, which is incorporated by reference herein.

**1. Interrogatory No. 11 Should Be Answered by Mattel**

This Interrogatory asked Mattel to state whether the use of MOTOWN METAL has ever been interrupted, and, if so, to explain in detail the reasons for such interruption and to specify the terms of each interrupted use. Mattel objected to this Interrogatory, claiming that it was vague and ambiguous. There is nothing vague or ambiguous about this Interrogatory. Indeed, given Mattel's failure to object to this Interrogatory's relevance, Mattel clearly understands this Interrogatory goes to UMG's fifth affirmative defense to Mattel's counterclaim -- that, to the extent that Mattel ever possessed any enforceable trademark rights in MOTOWN METAL, Mattel has abandoned such rights.

**INTERROGATORY NO. 12:**

Identify the geographic areas in which Applicant has ever sold MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 12:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds, that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

Subject to and without waiving the foregoing objections, Mattel responds as follows: The MOTOWN METAL products have been sold to retailers worldwide as part of general die cast car assortments.

**2. Interrogatory No. 12 Should Be Answered by Mattel**

This Interrogatory required Mattel to identify the geographic areas in which Applicant has sold MOTOWN METAL Products. Mattel responded that it has sold its products "to retailers worldwide as part of general die cast car assortments." UMG is

entitled to know specifically in which states the MOTOWN METAL Products were sold, or whether sales were made in all 50 states. See *Johnston Pump/Gen. Valve, Inc.*, 10 U.S.P.Q.2d at 1675 (relevant areas of inquiry include number of salesmen, locations of sales representatives who market goods bearing the mark, and geographic location of dealers who market and distribute the products under the mark); *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 U.S.P.Q. 193, 195-96 (T.T.A.B. 1976) (petitioner required to list all states to which its goods were shipped and identify all people knowledgeable about such matters); *J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 U.S.P.Q. 577, 579 (T.T.A.B. 1975) (information regarding geographic areas of distribution of goods is relevant to likelihood of confusion); *Miller & Fink Corp. v. Servicemaster Hosp. Corp.*, 184 U.S.P.Q. 495, 496 (T.T.A.B. 1975) (year by year, state by state breakdown of distribution of magazines is proper). There is nothing vague, ambiguous, overbroad, burdensome, or harassing about this Interrogatory.

**INTERROGATORY NO. 13:**

Identify the geographic areas in which applicant intends to sell MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 13:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**3. Interrogatory No. 13 Should Be Answered by Mattel**

This Interrogatory required Mattel to identify the geographic areas in which Applicant intends to sell MOTOWN METAL Products. Mattel objected, claiming that

the Interrogatory was vague, ambiguous, sought irrelevant information, and was unduly burdensome and harassing. This Interrogatory is straightforward, as opposed to vague and ambiguous, and seeks limited information that is clearly relevant to, *inter alia*, likelihood of confusion and dilution. See *Johnston Pump/Gen. Valve, Inc.*, 10 U.S.P.Q.2d at 1675 (intent to expand business to include manufactured products similar to opposing party's is relevant); *Varian Assocs. v. Fairfield-Noble Corp.*, 188 U.S.P.Q. 581, 583 (T.T.A.B. 1975) (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”). Mattel has failed to meet its burden of showing this Interrogatory is overbroad or unduly burdensome and harassing.

**INTERROGATORY NO. 14:**

Identify the channels of trade and distribution methods used to sell the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 14:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**4. Interrogatory No. 14 Should Be Answered by Mattel**

This Interrogatory asked Mattel to identify the channels of trade and distribution methods used to sell the MOTOWN METAL Products. Mattel asserted meritless objections. This Interrogatory is not vague or ambiguous; rather, it is straightforward. It seeks relevant information – indeed, the Board has required parties to describe the

manner in which goods are packaged and distributed through channels of trade. *See Varian Assocs.*, 188 U.S.P.Q. at 583. Finally, it is not overbroad or unduly burdensome and harassing.

**INTERROGATORY NO. 15:**

Identify the demographic market to which the MOTOWN METAL Products are sold or intended to be sold. Such identification shall include the age, location, and mean household income of those purchasers that Applicant expects and/or intends to buy and use such products.

**RESPONSE TO INTERROGATORY NO. 15:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**5. Interrogatory No. 15 Should Be Answered by Mattel**

This Interrogatory requested that Mattel identify the demographic market to which the MOTOWN METAL Products are sold or intended to be sold. The fourth factor considered by the Board in analyzing likelihood of confusion is the "buyers to whom sales are made." *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). As such, there is nothing overly broad, vague and ambiguous, irrelevant, or unduly burdensome or harassing about this Interrogatory. *See Johnston Pump/Gen. Valve, Inc.*, 10 U.S.P.Q.2d at 1675 (sophistication of purchasers a factor in assessing likelihood of confusion).

**INTERROGATORY NO. 16:**

Identify the retail price of the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 16:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG.

**6. Interrogatory No. 16 Should Be Answered by Mattel**

The retail price of Mattel's product bearing the MOTOWN METAL mark is relevant to whether Mattel's products under the MOTOWN METAL mark are similar to, and likely to be confused with, UMG's products bearing the MOTOWN mark. That is, if both products are priced similarly, there is a greater likelihood of confusion. Also, the price of the products is relevant to the sophistication of the parties' customers. *Dep Corp. v. Opti-Ray, Inc.*, 768 F. Supp. 710, 716 (C.D. Cal. 1991). The Board has repeatedly held that sales figures for the goods bearing the mark involved in an opposition proceeding are proper matters for discovery because such information may well have bearing on the issues of registrability and likelihood of confusion. *See Varian Assocs.*, 188 U.S.P.Q. at 583; *see also Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 U.S.P.Q. 147, 148 (T.T.A.B. 1985). Because Mattel's sales figures, including the retail price of Mattel's goods at issue, are relevant to registrability and likelihood of confusion, as well as dilution, Mattel should be required to provide that information.

Mattel's objections do not pass muster. Subsequent to the parties' discovery conference, on or about February 12, 2008, counsel for Mattel told counsel for UMG in an telephone conference that each of Mattel's individual MOTOWN METAL products

retailed for 99 cents, and that a special collector's set retailed for \$19.99. Lewis Decl. ¶ 7. However, Mattel has yet to formally amend its written discovery responses, as it is required to do.

**INTERROGATORY NO. 17:**

State the total number of units sold of the MOTOWN METAL Products to date.

**RESPONSE TO INTERROGATORY NO. 17:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**7. Interrogatory No. 17 Should Be Answered by Mattel**

This Interrogatory required Mattel to state the total number of units sold of the MOTOWN METAL Products to date. Mattel interposed inappropriate objections. There is nothing "vague and ambiguous" about the Interrogatory. The information requested is relevant; the Board has repeatedly held that sales figures for goods bearing the mark involved in an opposition proceeding are proper matters for discovery because such information may well have bearing on the issues of registrability and likelihood of confusion. *Varian Assocs.*, 188 U.S.P.Q. at 583 (sales figures have bearing on registrability); *Neville Chem. Co. v. Lubrizol Corp.*, 184 U.S.P.Q. 689, 690 (T.T.A.B. 1975) (requiring provision of sales figures); *American Optical Corp.*, 181 U.S.P.Q. at 123 (required to furnish sales figures) (overruled on other grounds); *see also Sunkist Growers, Inc.*, 229 U.S.P.Q. at 148. Finally, Mattel has not met its burden of showing that production of a total sales figure would be overbroad or unduly burdensome or harassing.

**INTERROGATORY NO. 18:**

State the amount of money Applicant has spent on advertising for the MOTOWN METAL Products on an annual basis.

**RESPONSE TO INTERROGATORY NO. 18:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**8. Interrogatory No. 18 Should Be Answered by Mattel**

Similar to Mattel's retail figures discussed in Interrogatory No. 16 above, the Board has repeatedly held that annual – even quarterly – advertising figures for specific goods bearing the involved mark are proper matters for discovery since the information may well have a bearing on the issues in the opposition proceeding. *Sunkist Growers, Inc.*, 229 U.S.P.Q. at 149 (sales figures relevant to likelihood of confusion); *Varian Assocs.*, 188 U.S.P.Q. at 583 (sales figures have bearing on registrability); *American Optical Corp. v. Exomet, Inc.*, 181 U.S.P.Q. at 123 (T.T.A.B. 1974) (required to furnish advertising expenditures relating to sales) (overruled on other grounds). The information requested in Interrogatory No. 18 is relevant to issues such as likelihood of confusion and registrability of the MOTOWN METAL mark, and dilution. *Id.*

Furthermore, this Interrogatory is not overbroad, overly burdensome, or harassing to Mattel, because Mattel has not been using the MOTOWN METAL mark very long. This is evidenced by the fact that Mattel filed an intent to use application to register MOTOWN METAL less than two and one-half years ago. Mattel should be required to provide UMG with the annual amount of money spent on advertising from Mattel's first use of the MOTOWN METAL mark to the present.

Mattel's objection that Interrogatory No. 18 is vague and ambiguous suffers a similar fate. UMG was clear in the information requested about Mattel's advertising expenditures. If there were any doubt, UMG clarified the information requested in the meet and confer process.

**INTERROGATORY NO. 19:**

Identify the methods of marketing and advertising of the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 19**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**9. Interrogatory No. 19 Should Be Answered by Mattel**

The method of marketing and advertising that Mattel employs or intends to employ to market Mattel's MOTOWN METAL product to the public is relevant, clearly requested and discoverable. The Board has determined that information on advertising of a product or service under a mark may lead to the discovery of relevant information such as the circumstances surrounding the selection of the mark, its distinctiveness or lack thereof, or other information that may have a bearing on issues normally involved in inter parties proceedings before the Board. *See J.B. Williams Co.*, 188 U.S.P.Q. at 580. Likewise, the Board has required parties, "[i]n response to interrogatories requesting information concerning the circumstances under which the public may see the involved mark *and the manner in which an involved product sold thereunder is marketed*, a party should indicate how people who purchase the products may conceivably see the mark and

should describe the manner in which the goods are packaged and distributed through channels of trade.” *Varian Assocs.*, 188 U.S.P.Q. at 583 (emphasis added).

Mattel should be required to disclose its method of marketing and advertising in this proceeding. Such information is discoverable and relevant to the circumstances surrounding Mattel’s choosing the MOTOWN METAL mark, the distinctiveness and/or Mattel’s perception of the distinctiveness of the mark MOTOWN METAL, and other information such as how Mattel uses or intends to use the mark in commerce, and what the source of the MOTOWN METAL product appears to potential customers to be.

Finally, Interrogatory No. 19 is not vague or ambiguous, overbroad, unduly burdensome, or harassing. Instead, the information is clearly stated and properly delineated.

**INTERROGATORY NO. 20:**

State whether applicant has or ever has had any marketing or advertising plans or programs directed toward or targeted to any particular trade, industry or consumer group for the MOTOWN METAL Products. If so, identify and describe in detail each such trade, industry, or consumer group.

**RESPONSE TO INTERROGATORY NO. 20:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**10. Interrogatory No. 20 Should Be Answered by Mattel**

Like Interrogatory No. 19, this Interrogatory seeks information about Mattel’s marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, irrelevant, and overbroad. Mattel’s objections are meritless.

This Interrogatory is clear on its face. Also, it seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 580.

**INTERROGATORY NO. 21:**

Identify (including by name and date) each type of print media (including newspapers and magazines) that contained any advertisement or promotional material for the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 21:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**11. Interrogatory No. 21 Should Be Answered by Mattel**

Like Interrogatory No. 19, this Interrogatory seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, irrelevant, overbroad, and unduly burdensome and harassing. Mattel's objections are meritless. This Interrogatory is clear on its face. Also, it seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 580. Finally, this Interrogatory is not overbroad or unduly burdensome and harassing.

**INTERROGATORY NO. 22:**

Identify (including by name, channel/station, and date) each television or radio program that contained any advertisements or promotional material for MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 22:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**12. Interrogatory No. 22 Should Be Answered by Mattel**

Like Interrogatory No. 19, this Interrogatory seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, irrelevant, overbroad and unduly burdensome and harassing. Mattel's objections are meritless. This Interrogatory is clear on its face. Also, it seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 580. Finally, this Interrogatory is not overbroad or unduly burdensome and harassing.

**INTERROGATORY NO. 23:**

State whether Applicant sold or offers to sell the MOTOWN METAL Products on the internet, and if so, state the URLs, domain names, or website addresses for each website that sells or offers to sell such products, and the name, address, and telephone number of the owner of each such URL, domain name or website.

**RESPONSE TO INTERROGATORY NO. 23:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG.

**13. Interrogatory No. 23 Should Be Answered by Mattel**

Mattel refused to state whether it sells or offers to sell its MOTOWN METAL product on the internet, and if so, the specific information regarding each website, based on relevance and burden, among other equally unavailing objections.

As discussed above, information regarding sales of Mattel's goods bearing the MOTOWN METAL mark, and the circumstances under which potential consumers may see the involved mark in commerce, are both relevant and discoverable. *See Varian Assocs.*, 188 U.S.P.Q. at 583. In the case of sales of Mattel's product bearing the MOTOWN METAL mark on the internet, such information is relevant to the issue of dilution, likelihood of confusion, and use of the mark, thus bearing upon registrability. Again, providing this information will not be overly burdensome or harassing to Mattel, because judging from its intent to use application to register the mark MOTOWN METAL filed in November 2005, Mattel has not been using the MOTOWN METAL mark for very long.

Mattel's objections based on overbreadth, ambiguity and vagueness are not supportable. The information requested is clearly stated and delineated, and Mattel cannot articulate a basis for these objections. Simply put, Mattel has no excuse for failing to provide the requested information.

**INTERROGATORY NO. 24:**

Identify each person who has personal knowledge regarding the marketing and advertising of the MOTOWN METAL Products, and state the nature of each such person's knowledge.

**RESPONSE TO INTERROGATORY NO. 24**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above: Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**14. Interrogatory No. 24 Should Be Answered by Mattel**

As stated above in connection with Interrogatory No. 19, the method of marketing and advertising that Mattel employs or intends to employ to market Mattel's MOTOWN METAL product to the public is relevant, clearly requested and discoverable. The Board has determined that information on the people involved with the advertising of a product or service under a mark, may lead to the discovery of relevant information such as the circumstances surrounding the selection of the mark, its distinctiveness or lack thereof, or other information that may have a bearing on issues normally involved in inter parties proceedings before the Board. *See J.B. Williams Co.*, 188 U.S.P.Q. at 580.

Finally, Interrogatory No. 24 is not overly broad, unduly burdensome, harassing, vague or ambiguous. Instead, the information is clearly stated and delineated.

**INTERROGATORY NO. 31:**

If Applicant has ever received any unfavorable comments, evaluations or information, or any criticism or complaints about the quality of any of the MOTOWN METAL Products, identify and describe in detail all communications

that refer, relate or pertain to all such comments, evaluations, information, criticism, and complaints, the date of each such communication, and the persons who made and received such communication.

**RESPONSE TO INTERROGATORY NO. 31:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**15. Interrogatory No. 31 Should Be Answered by Mattel**

This Interrogatory asks Mattel to identify any communications concerning any unfavorable comments, evaluations or information, or any criticism or complaints about the quality of any of the MOTOWN METAL Products. Mattel objected, claiming this Interrogatory was overbroad, vague and ambiguous and sought irrelevant information. This Interrogatory, like Interrogatory 32, is narrow, clear and straightforward. Moreover, it is clearly relevant to likelihood of confusion and dilution. *Varian Assocs.*, 188 U.S.P.Q. at 583 (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”).

**INTERROGATORY NO. 32:**

Identify all surveys, public opinion polls or any other forms of consumer research known to Applicant that refer, relate or pertain in any way to the mark MOTOWN METAL.

**RESPONSE TO INTERROGATORY NO. 32:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that

it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine.

**16. Interrogatory No. 32 Should Be Answered by Mattel**

This Interrogatory asks Mattel to identify surveys, public opinion polls, or any other consumer research concerning the mark MOTOWN METAL. As with Interrogatory 31, Mattel objected, claiming this Interrogatory was overbroad, vague and ambiguous and sought irrelevant information. This Interrogatory, like Interrogatory 31, is narrow, clear and straightforward. Moreover, it is clearly relevant to likelihood of confusion and dilution. *Varian Assocs.*, 188 U.S.P.Q. at 583 (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”). UMG has represented to Mattel that it does not seek any information protected by the attorney-client or work product privilege, Lewis Decl. ¶ 6, but Mattel has failed to supplement its Response.

**INTERROGATORY NO. 33:**

Identify all licensing agreements or licensing arrangements between Applicant and any third party relating to the MOTOWN METAL Products, including but not limited to the date of each such agreement or arrangement, the term of each such agreement or arrangement, a description of the right licensed, the types of goods or services relating to each such license arrangement, and the name and address of each third party licensee or licensor.

**RESPONSE TO INTERROGATORY NO. 33:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**17. Interrogatory No. 33 Should Be Answered by Mattel**

Mattel refused to supplement its response to Interrogatory No. 33 on the grounds that the information is not relevant. On the contrary, the Board has determined that information concerning a party's awareness of third party use and/or registration of the same or similar marks for the same or closely related goods or services as the involved marks is discoverable. *See Domino's Pizza Inc. v. Little Caesar Enters. Inc.*, 7 U.S.P.Q.2d 1359, 1363 n.9 (T.T.A.B. 1988) (information about third party use of marks is relevant); *Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral Maxillofacial Surgeons*, 201 U.S.P.Q. 531, 533 (T.T.A.B. 1979) (same). Similarly here, Mattel's extent of use of the mark, and knowledge of third party uses of the terms MOTOWN or MOTOWN METAL for toys, games and playthings is relevant to issues in this proceeding, such as purchaser perception and strength of the marks at issue. *Id.* To the extent that Mattel intends to rely upon third party use of similar marks, it must provide discovery on that issue. In short, Interrogatory No. 33 seeks relevant information.

Additionally, there is nothing vague, ambiguous, overbroad, unduly burdensome, or harassing about this Interrogatory.

**INTERROGATORY NO. 34:**

Identify all cross-marketing agreements or other marketing or advertising arrangements between Applicant and any third party relating to the MOTOWN

METAL Products, including but not limited to the date of each such agreement or arrangement, the term of each such agreement or arrangement, a description of the right licensed, the types of goods or services relating to each such license arrangement, and the name and address of each third party co-marketer or contracting party.

**RESPONSE TO INTERROGATORY NO. 34:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**18. Interrogatory No. 34 Should Be Answered by Mattel**

Mattel refused to supplement its response to Interrogatory No. 34 on the grounds that the information is not relevant. On the contrary, the Board has determined that information concerning a party's awareness of third party use and/or registration of the same or similar marks for the same or closely related goods or services as the involved marks is discoverable. *See Domino's Pizza Inc.*, 7 U.S.P.Q.2d at 1363 n.9 (information about third party use of marks is relevant); *Am. Soc'y of Oral Surgeons*, 201 U.S.P.Q. at 533 (same). Similarly here, Mattel's extent of use of the mark, and knowledge of third party uses of the terms MOTOWN or MOTOWN METAL for toys, games and playthings is relevant to issues in this proceeding, such as purchaser perception and strength of the marks at issue. *Id.* To the extent that Mattel intends to rely upon third party use of similar marks, it must provide discovery on that issue. In short, Interrogatory No. 34 seeks relevant information.

Additionally, there is nothing vague, ambiguous, unduly burdensome, or harassing about this Interrogatory.

### III. MOTION TO STRIKE AND MOTION TO EXCLUDE

Should Mattel continue to refuse to produce the above-requested information, UMG respectfully requests the Board to strike each and every affirmative defense of Mattel regarding the subject matter on which Mattel has refused discovery, as set forth in detail above. UMG's motion to strike in the alternative is supported by fairness in the discovery process and by previous decisions of the Board. *See Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 181 U.S.P.Q. 286, 287 (T.T.A.B. 1974).

Also, if Mattel refuses to produce information in response to Matter's discovery requests, UMG moves the Board to exclude any evidence from Mattel during Mattel's testimony period or during the rebuttal testimony period regarding the subject matters on which Mattel refused discovery. *See Shoe Factory Supplies Co. v. Thermal Eng'g Co.*, 207 U.S.P.Q. 517, 519 n. 1 (T.T.A.B. 1980). In short, UMG requests that the Board preclude Mattel from introducing or otherwise relying on such information and/or documents in this proceeding. *Sunkist Growers, Inc.*, 229 U.S.P.Q. at 149.

If the Board denies the motion to compel, motion to strike and motion to exclude, UMG will be blindsided by evidence that it has never seen before nor had the opportunity to evaluate. Furthermore, Mattel will be rewarded for its bad conduct and unwillingness to engage in the discovery process.

IV. CONCLUSION

For the reasons stated above, UMG respectfully requests that the Board grant its motion to compel in its entirety , or in the alternative, to grant its motion to strike and motion to exclude.

Respectfully submitted,

DATED: February 29, 2008

MITCHELL SILBERBERG & KNUPP LLP

By: Alexa Lewis  
Alexa L. Lewis  
Attorneys for Opposer UMG Recordings, Inc.

Date of Deposit: 2/29/08

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, Attn: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Alexa Lewis  
Alexa L. Lewis

**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 February 29, 2008, I served a copy of the foregoing document(s) described as **OPPOSER UMG RECORDINGS, INC'S MOTION TO COMPEL FURTHER RESPONSES TO INTERROGATORIES; MOTION TO EXCLUDE; AND BRIEF IN SUPPORT THEREOF** 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](mailto:liser@kwikalaw.com))

Direct (310) 566-9801

Direct Fax (310) 566-9861

Patricia A. Millett ([pmillet@kwikalaw.com](mailto:pmillet@kwikalaw.com))

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Counsel for Applicant,  
MATTEL, INC.

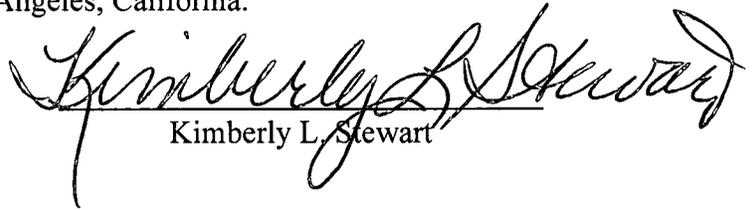
- BY MAIL:** I placed the above-mentioned document(s) in sealed envelope(s) addressed as set forth above, and deposited each envelope in the mail at Los Angeles, California. Each envelope was mailed with postage thereon fully prepaid.
- BY OVERNIGHT MAIL:** I placed the above-mentioned document(s) in 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 SERVICES of the document(s) listed above to the person(s) at the address(es) set forth above.
- 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 under penalty of perjury under the laws of the United States that the above is true and correct.

Executed on February 29, 2008, at Los Angeles, California.

  
Kimberly L. 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 FIRST LEGAL SUPPORT SERVICES, 1511 West Beverly Boulevard, Los Angeles CA 90026.

On February 29, 2008, I served the foregoing document(s) described as **OPPOSER UMG RECORDINGS, INC'S MOTION TO COMPEL FURTHER RESPONSES TO INTERROGATORIES; MOTION TO EXCLUDE; AND BRIEF IN SUPPORT THEREOF** which was enclosed in sealed envelopes addressed as follows, and taking the action described below:

Lawrence Y. Iser ([liser@kwikalaw.com](mailto:liser@kwikalaw.com))

Direct (310) 566-9801

Direct Fax (310) 566-9861

Counsel for Applicant,  
MATTEL, INC.

Patricia A. Millett ([pmillet@kwikalaw.com](mailto:pmillet@kwikalaw.com))

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Kinsella, Weitzman, Iser, Kump & Aldisert LLP

808 Wilshire Boulevard, 3rd Floor

Santa Monica, CA 90401

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Fax: (310) 566-9850

**BY PERSONAL SERVICE:** I hand delivered such envelope(s):

to the addressee(s);

to the receptionist/clerk/secretary in the office(s) of the addressee(s).

by leaving the envelope in a conspicuous place at the office of the addressee(s) between the hours of 9:00 a.m. and 5:00 p.m.

I declare under penalty of perjury under the laws of the United States that the above is true and correct.

Executed on February 29, 2008, at Los Angeles, California.

\_\_\_\_\_  
Printed Name

\_\_\_\_\_  
Signature

ORIGINAL

**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

**OPPOSER UMG RECORDINGS, INC'S MOTION TO COMPEL FURTHER  
RESPONSES TO REQUESTS FOR PRODUCTION OF DOCUMENTS AND TO  
PRODUCE DOCUMENTS BY MATTEL, INC.; MOTION TO EXCLUDE; AND BRIEF  
IN SUPPORT THEREOF**

## TABLE OF CONTENTS

	Page
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD.....	1
TABLE OF CONTENTS .....	i
TABLE OF AUTHORITIES.....	iii
CASES.....	iii
STATUTES .....	iii
BRIEF IN SUPPORT OF MOTION.....	3
I. STATEMENT OF FACTS.....	3
II. THE DOCUMENT REQUESTS AT ISSUE.....	4
A. AT THE PARTIES' DISCOVERY CONFERENCE, MATTEL AGREED TO SUPPLEMENT ITS DISCOVERY RESPONSES, BUT, A MONTH AND A HALF LATER, HAS NOT DONE SO. ....	5
B. THE DOCUMENT REQUESTS TO WHICH MATTEL FAILED TO SUBSTANTIVELY RESPOND.....	5
1. Mattel Should Produce All Responsive Documents To Document Request No. 3.....	6
2. Mattel Should Produce All Responsive Documents To Document Request No. 4.....	7
3. Mattel Should Produce All Responsive Documents To Document Request No. 5.....	7
4. Mattel Should Produce All Responsive Documents To Document Request No. 6.....	8
5. Mattel Should Produce All Responsive Documents To Document Request No. 7.....	9
6. Mattel Should Produce All Responsive Documents To Document Request No. 8.....	10
7. Mattel Should Produce All Responsive Documents To Document Request No. 9.....	11
8. Mattel Should Produce All Responsive Documents To Document Request No. 10.....	12
9. Mattel Should Produce All Responsive Documents To Document Request No. 11.....	13
10. Mattel Should Produce All Responsive Documents To Document Request No. 12.....	14
11. Mattel Should Produce All Responsive Documents To Document Request No. 15.....	15
12. Mattel Should Produce All Responsive Documents To Document Request No. 18.....	16
13. Mattel Should Produce All Responsive Documents To Document Request No. 27.....	17
14. Mattel Should Produce All Responsive Documents To Document Request No. 28.....	18

15.	Mattel Should Produce All Responsive Documents To Document Request No. 29.....	19
16.	Mattel Should Produce All Responsive Documents To Document Request No. 30.....	20
17.	Mattel Should Produce All Responsive Documents To Document Request No. 31.....	21
18.	Mattel Should Produce All Responsive Documents To Document Request No. 32.....	22
19.	Mattel Should Produce All Responsive Documents To Document Request No. 35.....	23
20.	Mattel Should Produce All Responsive Documents To Document Request No. 36.....	23
III.	MOTION TO STRIKE AND MOTION TO EXCLUDE .....	24
IV.	CONCLUSION .....	25

## TABLE OF AUTHORITIES

Page

### CASES

<i>American Optical Corp. v. Exomet, Inc.</i> , 181 U.S.P.Q. 120 (T.T.A.B. 1974).....	9
<i>American Society of Oral Surgeons v. American College of Oral Maxillofacial Surgeons</i> , 201 U.S.P.Q. 531 (T.T.A.B. 1979).....	16, 18
<i>Dep v. Opti-Ray, Inc.</i> , 768 F. Supp. 710 (C.D. Cal. 1991).....	12
<i>Domino's Pizza Inc. v. Little Caesar Enterprises Inc.</i> , 7 U.S.P.Q.2d 1359 (TTAB 1988).....	16, 18
<i>J.B. Williams Co., Inc. v. Pepsodent G.m.b.H.</i> , 188 U.S.P.Q. 577 (TTAB 1975).....	9
<i>Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.</i> , 10 U.S.P.Q.2d 1671 (TTAB 1988).....	4
<i>Mack Trucks, h1c. v. Monroe Auto Equipment Company</i> , 181 U.S.P.Q. 286 (TTAB 1974).....	24
<i>Shoe Factory Supplies Co. v. Thermal Engineering Company</i> , 207 U.S.P.Q. 517 (TTAB 1980).....	24
<i>Sunkist Growers, Inc. v. Benjamin Ansehl Company</i> , 229 U.S.P.Q. 147 (TTAB 1985).....	12, 24
<i>Varian Associates v. Fairfield-Noble Corp.</i> , 188 U.S.P.Q. 581 (TTAB 1975).....	passim

### STATUTES

37 C.F.R. § 2.120(e) .....	1, 3
FRCP 37 .....	1
TBMP § 402.01 .....	4

Pursuant to 37 C.F.R. § 2.120(e) and Federal Rule of Civil Procedure 37, Opposer UMG Recordings, Inc. ("UMG") hereby moves the Board for an order compelling Mattel, Inc. ("Mattel") to provide supplemental responses to certain of UMG's First Set of Requests for Production of Documents and Things ("Document Requests"), and to produce documents responsive to those document requests. Specifically, UMG's motion seeks an order compelling: (a) Mattel to fully respond to Document Request Nos. 3-12, 15, 18, 27-32 and 35-36; and (b) Mattel to produce documents in response to all Document Requests that are the subject of this motion to compel, at UMG's counsel's office no later than twenty days after the Board rules on this motion. In the alternative, UMG moves the Board for an order striking Mattel's affirmative defenses and to exclude any evidence by Mattel during its testimony period or during the rebuttal testimony period on which Mattel refuses to provide discovery.

This motion to compel is made on the grounds that: (1) despite its agreement to do so, Mattel refused to produce documents in response to Document Request Nos. 3-12, 15, 18, 27-32 and 35-36 stating unsupportable objections as grounds for its refusal; and (2) all of the discovery requests seek relevant and discoverable information such as Mattel's method of marketing goods bearing the MOTOWN METAL mark, the sales of the product bearing the MOTOWN METAL mark, and the amount spent by Mattel advertising its product bearing the MOTOWN METAL mark. These motions are supported by the accompanying brief, the Declaration of Alexa L. Lewis, and any other papers and argument presented to the Board.

UMG has attempted in good faith to resolve this discovery dispute with Mattel prior to filing this motion. The parties met and conferred regarding these issues on January 17, 2008, and have communicated to narrow the issues to be resolved in this motion to compel since that date. Although it has agreed to supplement its responses, Mattel has not actually done so, despite the upcoming opening of UMG's testimony

period. Thus, no resolution has been reached to prevent the necessity of filing the instant motion.

Respectfully submitted,

DATED: February 29, 2008

MITCHELL SILBERBERG & KNUPP LLP

By: *Alexa L. Lewis*  
Alexa L. Lewis  
Attorneys for Opposer UMG Recordings, Inc.

## BRIEF IN SUPPORT OF MOTION

### I. STATEMENT OF FACTS

On April 11, 2007, UMG filed a Notice of Opposition against Mattel's November 10, 2005 intent-to-use application to register the mark MOTOWN METAL for toys, games and playthings, namely, toy vehicles and accessories (the "Application").

UMG is the owner of numerous MOTOWN marks, including for toys, games and playthings, as set forth in UMG's Amended Notice of Opposition, the use of which predate Mattel's use of MOTOWN METAL. The crux of this case is that Mattel's mark MOTOWN METAL so resembles UMG's MOTOWN Marks so as to be likely to cause confusion, or to cause mistake or to deceive, and that use by Mattel of the mark MOTOWN METAL will dilute the distinctive quality of UMG's famous MOTOWN marks.

Mattel contends that its mark MOTOWN METAL is not similar to UMG's mark MOTOWN, and its product bearing the MOTOWN METAL mark is used for goods that are not similar to UMG's goods for which it uses MOTOWN. In an attempt to discover facts regarding Mattel's contentions in this case, on August 28, 2007, UMG propounded its discovery requests on Mattel, including its First Set of Requests for Production of Documents and Things ("Document Requests") (Nos. 1-43). *See Exhibit 2*, attached to the Declaration of Alexa L. Lewis ("Lewis Decl."), filed herewith. UMG received Mattel's responses on October 9, 2007. *See, Exhibit 4*, Lewis Decl. UMG has not received a complete production of documents produced in response to its discovery requests. *See, ¶ 4*, Lewis Decl.

On October 31, 2007, UMG wrote a letter to Mattel informing Mattel of the deficiency of its responses to a number of UMG's Document Requests. UMG requested to meet and confer with Mattel pursuant to 37 C.F.R. § 2.120(e) regarding the discovery requests prior to UMG's filing a motion to compel. *See, Exhibit 5* Lewis Decl.

Counsel for the parties held a discovery conference on January 17, 2008, wherein they discussed a possible resolution to each discovery request in dispute. *See, ¶ 6*, Lewis

Decl. Many issues seemed to be resolved at the meet and confer, as Mattel agreed to supplement its written responses to UMG's discovery requests. *See*, ¶ 6 and **Exhibit 6** to Lewis Decl.

A month and a half has passed since the parties' discovery conference, and Mattel still has not supplemented its responses. *See*, ¶ 11 and **Exhibit 6**, Lewis Decl. The parties are engaged in settlement negotiations, and have filed a stipulation asking the Board to re-set upcoming deadlines. *See*, ¶ 9 and **Exhibit 7** to Lewis Decl. However, under the current schedule imposed by the Board's Order of December 5, 2007, UMG's thirty-day testimony period closes on April 1, 2008. *See*, ¶ 10 and **Exhibit 8** to Lewis Decl. Pursuant to 37 C.F.R. § 2.120(e), any motion to compel must be filed before any party's testimony period opens. UMG is thus forced to file the present motion.

Mattel's refusal to date to provide the information and documents at issue is unsupportable under the Board's rules of discovery and the Federal Rules of Civil Procedure, as explained in detail below. Therefore, UMG requests that the Board issue an order compelling Mattel to provide supplemental responses to UMG's Requests at issue, to produce documents in response to the Document Requests discussed herein, and to produce all responsive documents.

## II. THE DOCUMENT REQUESTS AT ISSUE

All of the information and documents requested in UMG's Document Requests is relevant and discoverable. *See* TM Trial & App. Bd. Man. of Proc. § 402.01. Mattel's refusal to provide clearly relevant and discoverable information and documents is contrary to the policy for discovery established by the Federal Rules of Civil Procedure and the policy of the Board. *Johnston Pump/Gen. Valve Inc. v. Chromalloy Am. Corp.*, 10 U.S.P.Q.2d 1671, 1674 (T.T.A.B. 1988) (“[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case.”), quoting *Medtronic, Inc. v. Pacesetters Sys., Inc.*,

222 U.S.P.Q. 80, 83 (T.T.A.B. 1984). UMG has satisfied its duty by inquiring into areas that are relevant to the claims and defenses of this proceeding. Mattel must fulfill its duty by allowing discovery on such issues. The discovery sought by UMG is relevant, not burdensome to produce, and discoverable. The Board should grant UMG's motion to compel in its entirety.

A. **AT THE PARTIES' DISCOVERY CONFERENCE, MATTEL AGREED TO SUPPLEMENT ITS DISCOVERY RESPONSES, BUT, A MONTH AND A HALF LATER, HAS NOT DONE SO.**

At the parties' January 17, 2008 discovery conference, counsel for Mattel agreed to serve amended responses to UMG's Requests for Production. *See*, ¶ 6 and **Exhibit 6** to Lewis Decl. Mattel has therefore waived its objections, and should be required to supplement each Request discussed with UMG.

B. **THE DOCUMENT REQUESTS TO WHICH MATTEL FAILED TO SUBSTANTIVELY RESPOND**

UMG's Document Requests seek documents often corresponding with the Interrogatories discussed in the Motion filed contemporaneously herewith, which is incorporated by reference herein. Just as Mattel has no justification for withholding the information in connection therewith, it should not be allowed to withhold the corresponding documents. Mattel should be required to respond and produce documents responsive to Document Request Nos. 3-12, 15, 18, 27-32 and 35-36.

**REQUEST FOR PRODUCTION NO. 3:**

Representative specimens of each of the advertisements, commercials, press releases, brochures, catalogs, and other advertising or promotional materials by which Applicant has advertised or promoted any products under the MOTOWN METAL mark.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 3:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**1. Mattel Should Produce All Responsive Documents To Document Request No. 3**

Like Interrogatory No. 19, this Request seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, irrelevant, overbroad and sought confidential information. Mattel's objections are meritless. This Request is narrow and clear on its face. Also, this Request seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 U.S.P.Q. 577, 579 (T.T.A.B. 1975). Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 4:**

Documents sufficient to show the date on which Applicant first used the MOTOWN METAL mark in commerce in connection with toys, games, and playthings.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 4:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Subject to and without waiving the foregoing objections, Mattel will produce documents sufficient to show the date Mattel first used the MOTOWN METAL mark in commerce.

2. **Mattel Should Produce All Responsive Documents To Document Request No. 4**

This Request seeks the production of documents sufficient to show the date on which Mattel first used the MOTOWN METAL mark in commerce *in connection with toys, games, and playthings*. Mattel responded that it would produce documents “sufficient to show the date on which Mattel first used the MOTOWN METAL mark in commerce.” This response does not fully comply with UMG’s Request, and should be amended. See *Georgia-Pacific Corp. v. Great Plains Bag Co.*, 190 U.S.P.Q. 193, 195-96 (T.T.A.B. 1976); *Miller & Fink Corp. v. Servicemaster Hosp. Corp.*, 184 U.S.P.Q. 495, 496 (T.T.A.B. 1975); *Varian Assocs v. Fairfield-Noble Corp.*, 188 U.S.P.Q. 581, 583 (T.T.A.B. 1975).

**REQUEST FOR PRODUCTION NO. 5:**

Documents sufficient to show where (e.g. which newspaper, which magazine, which catalogue, which television station, which radio station, which internet site) and in what medium each advertisement for MOTOWN METAL Products has appeared.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 5:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

3. **Mattel Should Produce All Responsive Documents To Document Request No. 5**

Mattel’s objections to this Request are meritless for the same reasons discussed above in connection with Interrogatory 21. Like Interrogatory No. 21, this Request seeks information about Mattel’s marketing and advertising of the MOTOWN METAL

Products. Mattel objected that it was vague and ambiguous, irrelevant, and sought confidential information. Mattel's objections are meritless. This Request is narrow and clear on its face. Also, this Request seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 579. Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 6:**

Documents sufficient to show when (e.g. which dates, which time of day or night) each advertisement featuring the MOTOWN METAL mark or MOTOWN METAL Products has been run or published in any medium.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 6:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**4. Mattel Should Produce All Responsive Documents To Document Request No. 6**

Like Interrogatory No. 22, this Request seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, irrelevant, overbroad and seeks confidential information. Mattel's objections are meritless. This Request is narrow and clear on its face. Also, this Request seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 579. Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 7:**

Documents sufficient to show the demographic market and/or advertising market targeted for the advertisements featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 7:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**5. Mattel Should Produce All Responsive Documents To Document Request No. 7**

Mattel refused to produce documents showing the demographic market and/or the advertising market targeted for its advertisements featuring the mark MOTOWN METAL or the product bearing the MOTOWN METAL mark. As grounds for its refusal, Mattel stated inappropriate objections, none of which relieve Mattel of its responsibility to provide documents in response to this Request.

The Board has held that information regarding advertising of a product bearing a mark at issue may lead to the discovery of relevant information such as the circumstances surrounding the selection of the mark, the distinctiveness or lack of distinctiveness of the mark, or other information relevant to inter parties proceedings. *See J.B. Williams Co.*, 188 U.S.P.Q. at 580. Similarly, the Board has required responding parties to provide information regarding the circumstances under which the public may see the involved mark, and the manner in which a product bearing an involved mark is advertised. *See Varian Assocs.*, 188 U.S.P.Q. at 583, *citing Am. Optical Corp. v. Exomet, Inc.*, 181 U.S.P.Q. 120, 123 (T.T.A.B. 1974) (overruled on other grounds). UMG is entitled to learn about Mattel's target market for its advertisements, because this will show how

potential customers will see Mattel's products bearing the MOTOWN METAL mark in commerce. In keeping with the Board's previous decisions, Mattel should be required to produce documents reflecting the demographic market and/or the advertising market targeted for its advertisements for its product bearing the MOTOWN METAL mark.

Mattel's other objections are equally unsupportable. Mattel cannot show that this Request is vague and ambiguous or overbroad. Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 8:**

All documents which constitute, embody, reflect, or refer to any studies, marketing plans, opinions, or reports (including of advertising, marketing, polling, public relations, market research, and public opinion agencies) that concern Applicant's use or contemplated use of the mark MOTOWN METAL.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 8:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**6. Mattel Should Produce All Responsive Documents To Document Request No. 8**

Like Interrogatory No. 20, this Request seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, overbroad, irrelevant, and seeks privileged and confidential information. Mattel's objections are meritless. This Request is narrow and clear on its face. Also, it seeks relevant information. The Board has determined that information on

advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 579. UMG has represented to Mattel that it does not seek any documents protected by the attorney-client or work product privilege, Lewis Decl. ¶ 6, but Mattel has failed to supplement its Response. Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 9:**

Documents sufficient to show the number of units distributed and sold of each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 9:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**7. Mattel Should Produce All Responsive Documents To Document Request No. 9**

This Request seeks the production of documents regarding the number of units distributed and sold of each of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 17. There is nothing "vague and ambiguous" about the Request. The information requested is relevant; the Board has repeatedly held that sales figures for goods bearing the mark involved in an opposition proceeding are proper matters for discovery because such information may well have bearing on the issues of dilution, registrability and likelihood of confusion. *See Varian Assocs.*, 188 U.S.P.Q. at 583 (sales figures have bearing on registrability); *Neville Chem. Co. v. Lubrizol Corp.*, 184 U.S.P.Q. 689, 690 (T.T.A.B. 1975) (requiring provision of sales figures); *American Optical Corp. v. Exomet, Inc.*, 181

U.S.P.Q. at 123 (T.T.A.B. 1974) (required to furnish sales figures) (overruled on other grounds); *see also Sunkist Growers, Inc. v. Benjamin Ansehl Co.*, 229 U.S.P.Q. 147, 148 (T.T.A.B. 1985). Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 10:**

Documents sufficient to show the suggested and actual retail price of each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 10:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**8. Mattel Should Produce All Responsive Documents To Document Request No. 10**

This Request seeks the production of documents regarding the retail price of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 16. The retail price of Mattel's product bearing the MOTOWN METAL mark is relevant to whether Mattel's products under the MOTOWN METAL mark are similar to, and likely to be confused with, UMG's products bearing the MOTOWN mark. That is, if both products are priced similarly, there is a greater likelihood of confusion. Also, the price of the products is relevant to the sophistication of the parties' customers. *Dep Corp. v. Opti-Ray, Inc.*, 768 F. Supp. 710, 716 (C.D. Cal. 1991). The Board has repeatedly held that sales figures for the goods bearing the mark involved in an opposition proceeding are proper matters for discovery because such information may well have bearing on the issues of registrability and likelihood of confusion. *See Varian Assocs.*, 188 U.S.P.Q. at 583; *see also Sunkist*

*Growers, Inc.*, 229 U.S.P.Q. at 149. Because Mattel's sales figures, including the retail price of Mattel's goods at issue, are relevant to dilution, registrability and likelihood of confusion, Mattel should be required to provide that information. Finally, the Request is clear and narrowly drawn, and the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 11:**

Documents sufficient to show Applicant's annual expenditures for advertising and other promotional materials for each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 11:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**9. Mattel Should Produce All Responsive Documents To Document Request No. 11**

This Request seeks the production of documents in connection with Applicant's expenditures for advertising for the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 18. The Board has repeatedly held that annual – even quarterly – advertising figures for specific goods bearing the involved mark are proper matters for discovery since the information may well have a bearing on the issues in the opposition proceeding. *Sunkist Growers, Inc.*, 229 U.S.P.Q. at 149 (sales figures relevant to likelihood of confusion); *Varian Assocs.*, 188 U.S.P.Q. at 583 (sales figures have bearing on registrability); *American Optical Corp.*, 181 U.S.P.Q. at 123 (required to furnish advertising expenditures relating to sales) (overruled on other grounds). The information requested in

Request No. 11 is relevant to issues such as dilution, likelihood of confusion and registrability of the MOTOWN METAL mark. *See id.*

Mattel's objection that Request No. 11 is vague and ambiguous suffers a similar fate. UMG was clear in the information requested about Mattel's advertising expenditures. If there were any doubt, UMG clarified the information requested in the meet and confer process.

Finally, the Request is narrowly drawn, and the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

#### **REQUEST FOR PRODUCTION NO. 12:**

Documents sufficient to show Applicant's expenditures by type of media (e.g., television, print) for advertising and other promotional materials for each of the MOTOWN METAL Products.

#### **RESPONSE TO REQUEST FOR PRODUCTION NO. 12:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

#### **10. Mattel Should Produce All Responsive Documents To Document Request No. 12**

This Request seeks the production of documents in connection with Applicant's expenditures for advertising for the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 18. The Board has repeatedly held that annual – even quarterly – advertising figures for specific goods bearing the involved mark are proper matters for discovery since the information may well have a bearing on the issues in the opposition proceeding. *Sunkist Growers, Inc.*, 229 U.S.P.Q. at 149 (sales figures relevant to likelihood of confusion);

*Varian Assocs.*, 188 U.S.P.Q. at 583 (sales figures have bearing on registrability); *American Optical Corp.*, 181 U.S.P.Q. at 123 (required to furnish advertising expenditures relating to sales) (overruled on other grounds). The information requested in Request No. 12 is relevant to issues such as dilution, likelihood of confusion and registrability of the MOTOWN METAL mark. *See id.*

Mattel's objection that Request No. 12 is vague and ambiguous suffers a similar fate. UMG was clear in the information requested about Mattel's advertising expenditures. If there were any doubt, UMG clarified the information requested in the meet and confer process.

Finally, the Request is narrowly drawn, and the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

#### **REQUEST FOR PRODUCTION NO. 15:**

All documents that reflect or evidence any alternate marks that were considered by Applicant for use as a trademark or service mark, instead of the MOTOWN METAL mark.

#### **RESPONSE TO REQUEST FOR PRODUCTION NO. 15:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

#### **11. Mattel Should Produce All Responsive Documents To Document Request No. 15**

This Request asks Mattel to produce all documents that reflect or evidence any alternate marks that were considered by Applicant for use as a trademark or service mark, instead of the MOTOWN METAL mark. Mattel objected. However, there is nothing vague or ambiguous about this Request. Moreover, it is clearly calculated to lead to the

discovery of admissible evidence. *See Varian Assocs.*, 188 U.S.P.Q. at 583 (must identify knowledgeable employees); *Goodyear Tire & Rubber Co. v. Tyrco Indus.*, 186 U.S.P.Q. 207, 208 (T.T.A.B. 1975) (whether applicant received opinions concerning adoption of mark is not privileged and applicant must identify person, date and documents relating thereto). Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 18:**

All consent agreements or co-existence agreements between Applicant and any third parties regarding the use of any trademarks containing the word MOTOWN and all correspondence and other documents relating thereto.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 18:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**12. Mattel Should Produce All Responsive Documents To Document Request No. 18**

Mattel's refusal to provide information regarding the use by any third party of trademarks containing the term MOTOWN is discussed in UMG's concurrently filed motion to compel interrogatory responses, in connection with Interrogatory Nos. 33-34.

The Board regularly requires responding parties to provide information and documents reflecting that party's knowledge of third party use and/or registration of the same or similar mark(s). *See Domino's Pizza Inc. v. Little Caesar Enters. Inc.*, 7 U.S.P.Q.2d 1359, 1363 n.9 (T.T.A.B. 1988) (information about third party use of marks is relevant); *Am. Soc'y of Oral Surgeons v. Am. Coll. of Oral Maxillofacial Surgeons*, 201

U.S.P.Q. 531, 533 (T.T.A.B. 1979) (same). The Board should likewise require Mattel to provide these documents.

Mattel's objection that the Request is overly broad is inappropriate. Document Request No. 18 seeks documents in Mattel's possession, custody or control regarding third party use of trademarks containing the term MOTOWN. Because the Request deals with only a single term, the Request is necessarily narrow. Mattel will not be overly burdened if it is required to produce all responsive documents. Again, if Mattel intends to rely upon third party use in this proceeding, it needs to provide discovery now. Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 27:**

All documents that constitute, embody, reflect, or refer to any styleguide, rules, regulations, procedures, or internal requirements of Applicant for goods bearing the mark MOTOWN METAL.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 27:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**13. Mattel Should Produce All Responsive Documents To Document Request No. 27**

This Request asks Mattel to produce all documents that constitute, embody, reflect, or refer to any styleguide, rules, regulations, procedures, or internal requirements of Mattel for goods bearing the mark MOTOWN METAL. Mattel objected. However, there is nothing vague or ambiguous about this Request. Moreover, it is narrowly drawn and clearly calculated to lead to the discovery of admissible evidence going, for example,

to Mattel's use of the mark MOTOWN METAL and advertising of products in connection therewith. *Varian Assocs.*, 188 U.S.P.Q. at 583 (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”). Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 28:**

All documents that constitute, embody, reflect, or refer to agreements between Applicant and any person or entity concerning goods sold under the mark MOTOWN METAL, including but not limited to all assignments, licenses, and license agreements.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 28:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**14. Mattel Should Produce All Responsive Documents To Document Request No. 28**

Mattel's refusal to provide information regarding the use by any third party of trademarks containing the term MOTOWN METAL is discussed in UMG's concurrently filed motion to compel interrogatory responses, in connection with Interrogatory Nos. 33-34.

The Board regularly requires responding parties to provide information and documents reflecting that party's knowledge of third party use and/or registration of the same or similar mark(s). *See Domino's Pizza Inc.*, 7 U.S.P.Q.2d at 1363 n.9 (information

about third party use of marks is relevant); *Am. Soc'y of Oral Surgeons*, 201 U.S.P.Q. at 533 (same). The Board should likewise require Mattel to provide these documents.

Mattel's objection that the Request is overly broad is inappropriate. Document Request No. 28 seeks documents in Mattel's possession, custody or control regarding third party use of trademarks containing the term MOTOWN METAL. Because the Request deals with only a single term, the Request is necessarily narrow. Mattel will not be overly burdened if it is required to produce all responsive documents. Again, if Mattel intends to rely upon third party use in this proceeding, it needs to provide discovery now. Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 29:**

Documents sufficient to identify each outlet, store or website in the United States that sells, offers for sale, promotes, or advertises any of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 29:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**15. Mattel Should Produce All Responsive Documents To Document Request No. 29**

This Request asks Mattel to produce documents sufficient to identify each outlet, store or website in the United States that sells, offers for sale, promotes, or advertises any of the MOTOWN METAL Products. Mattel objected. However, there is nothing vague or ambiguous about this Request. Moreover, in that it seeks information regarding, for example, sales and advertising of the MOTOWN METAL Products, it is narrowly drawn

and clearly calculated to lead to the discovery of admissible evidence. *Varian Assocs.*, 188 U.S.P.Q. at 583 (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”). Finally, the Board’s standard Protective Order governs this matter, obviating Mattel’s confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 30:**

All documents that reflect or evidence the type of consumer who is intended to buy and use the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 30:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**16. Mattel Should Produce All Responsive Documents To Document Request No. 30**

This Request seeks the production of documents regarding the type of consumer who is intended to buy and use the MOTOWN METAL Products. Mattel’s objections are meritless for the same reasons discussed above in connection with Interrogatory 15. The fourth factor considered by the Board in analyzing likelihood of confusion is the “buyers to whom sales are made.” *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). As such, there is nothing vague and ambiguous, irrelevant, or overly broad about this Request. *See Johnston Pump/Gen. Valve, Inc.*, 10 U.S.P.Q.2d at 1675 (sophistication of purchasers a factor in assessing likelihood of confusion). Finally, the Board’s standard Protective Order governs this matter, obviating Mattel’s confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 31:**

All documents that reflect or evidence the channels of distribution and intended channels of distribution of each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 31:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**17. Mattel Should Produce All Responsive Documents To Document Request No. 31**

This Request seeks documents regarding the channels of distribution of each of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 14. This Request is clear and narrowly drawn, and seeks relevant information. *Varian Assocs.*, 188 U.S.P.Q. at 583 (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”). Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 32:**

All business plans of Applicant for or including the MOTOWN METAL mark.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 32:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it

is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**18. Mattel Should Produce All Responsive Documents To Document Request No. 32**

This Request asks Mattel to produce all business plans for or including the MOTOWN METAL mark. Mattel objected. However, there is nothing vague or ambiguous about this Request. Moreover, it is narrow and clearly calculated to lead to the discovery of admissible evidence going, for example, to Mattel's use of and expansion plans in connection with MOTOWN METAL. *Varian Assocs.*, 188 U.S.P.Q. at 583 (“[T]he requirement of relevancy must be construed liberally and that discovery should, therefore, be generously allowed unless it is clear, beyond any doubt, that the information sought can have no possible bearing upon the issues involved in the particular proceeding.”). Finally, the Board's standard Protective Order governs this matter, obviating Mattel's confidentiality objection. Rule § 2.116(g).

**REQUEST FOR PRODUCTION NO. 35:**

All web pages for Applicant's website featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 35:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Mattel further objects to this request on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**19. Mattel Should Produce All Responsive Documents To Document Request No. 35**

Like Interrogatory No. 19, this Request seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, irrelevant, overbroad and unduly burdensome and harassing. Mattel's objections are meritless. This Request is clear on its face. Also, it is narrowly drawn and seeks relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 579. Finally, this Request is not unduly burdensome and harassing.

**REQUEST FOR PRODUCTION NO. 36:**

All documents that reflect or evidence the number of "hits" to Applicant's website featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 36:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**20. Mattel Should Produce All Responsive Documents To Document Request No. 36**

Like Interrogatory No. 19, this Request seeks information about Mattel's marketing and advertising of the MOTOWN METAL Products. Mattel objected that it was vague and ambiguous, overbroad, and irrelevant. Mattel's objections are meritless. This Request is narrowly drawn and clear on its face. Also, it seeks relevant information protected by the Board's standard Protective Order, obviating Mattel's confidentiality

objection. Rule § 2.116(g). The Board has determined that information on advertising and marketing of a product or service under a mark is discoverable. *See J.B. Williams Co.*, 188 U.S.P.Q. at 579.

### III. MOTION TO STRIKE AND MOTION TO EXCLUDE

Should Mattel continue to refuse to produce the above-requested information and documents, UMG respectfully requests the Board to strike each and every affirmative defense of Mattel regarding the subject matter on which Mattel has refused discovery, as set forth in detail above. UMG's motion to strike in the alternative is supported by fairness in the discovery process and by previous decisions of the Board. *See Mack Trucks, Inc. v. Monroe Auto Equip. Co.*, 181 U.S.P.Q. 286, 287 (T.T.A.B. 1974).

Also, if Mattel refuses to produce information and documents in response to Matter's discovery requests, UMG moves the Board to exclude any evidence from Mattel during Mattel's testimony period or during the rebuttal testimony period regarding the subject matters on which Mattel refused discovery. *See Shoe Factory Supplies Co. v. Thermal Eng'g Co.*, 207 U.S.P.Q. 517, 519 n. 1 (T.T.A.B. 1980). In short, UMG requests that the Board preclude Mattel from introducing or otherwise relying on such information and/or documents in this proceeding. *Sunkist Growers, Inc.*, 229 U.S.P.Q. at 149.

If the Board denies the motion to compel, motion to strike and motion to exclude, UMG will be blindsided by evidence that it has never seen before nor had the opportunity to evaluate. Furthermore, Mattel will be rewarded for its bad conduct and unwillingness to engage in the discovery process.

IV. CONCLUSION

For the reasons stated above, UMG respectfully requests that the Board grant its motion to compel in its entirety, or in the alternative, to grant its motion to strike and motion to exclude.

Respectfully submitted,

DATED: February 29, 2008

MITCHELL SILBERBERG & KNUPP LLP

By: Alexa Lewis  
Alexa L. Lewis  
Attorneys for Opposer UMG Recordings, Inc.

Date of Deposit: 2/29/08

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, Attn: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Alexa Lewis  
Alexa L. Lewis

**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 February 29, 2008, I served a copy of the foregoing document(s) described as **OPPOSER UMG RECORDINGS, INC'S MOTION TO COMPEL FURTHER RESPONSES TO REQUESTS FOR PRODUCTION OF DOCUMENTS AND TO PRODUCE DOCUMENTS BY MATTEL, INC.; MOTION TO EXCLUDE; AND BRIEF IN SUPPORT THEREOF** 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](mailto:liser@kwikalaw.com))

Direct (310) 566-9801

Direct Fax (310) 566-9861

Counsel for Applicant,  
MATTEL, INC.

Patricia A. Millett ([pmillet@kwikalaw.com](mailto:pmillet@kwikalaw.com))

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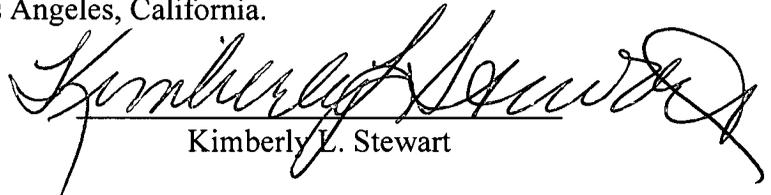
Fax: (310) 566-9850

- 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.
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I declare under penalty of perjury under the laws of the United States that the above is true and correct.

Executed on February 29, 2008, at Los Angeles, California.

  
Kimberly L. Stewart

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Counsel for Applicant,  
MATTEL, INC.

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Executed on February 29, 2008, at Los Angeles, California.

\_\_\_\_\_  
Printed Name

\_\_\_\_\_  
Signature

ORIGINAL

**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

**DECLARATION OF ALEXA L. LEWIS IN SUPPORT OF OPPOSER UMG  
RECORDINGS, INC.'S MOTION TO COMPEL FURTHER RESPONSES TO  
INTERROGATORIES AND REQUESTS FOR PRODUCTION OF DOCUMENTS AND  
TO PRODUCE DOCUMENTS BY MATTEL, INC.; MOTION TO EXCLUDE**

I, Alexa L. Lewis, declare:

1. I am an attorney at law licensed to practice before the Courts of the State of California and United States District Court for the Central District of California. I am an associate with the law firm of Mitchell Silberberg & Knupp LLP, attorneys for Opposer UMG Recordings, Inc. ("UMG") in this matter. Unless otherwise stated, I have personal knowledge of the following facts and, if called and sworn as a witness, could and would competently testify thereto.

2. On August 28, 2007, I caused to be served on Applicant Mattel, Inc. ("Mattel") UMG's First Set of Interrogatories ("Interrogatories") and First Set of Requests for Production of Documents and Things ("Document Requests"), true and correct copies of which are attached hereto, respectively, as Exhibits 1 and 2.

3. My office received Mattel's written responses to UMG's Interrogatories and Documents Requests on October 9, 2007, true and correct copies of which are attached hereto, respectively, as Exhibits 3 and 4.

4. UMG has not received a complete production of documents in response to its discovery requests.

5. Attached hereto as Exhibit 5 is a true and correct copy of a letter I sent counsel for Mattel on October 31, 2007, outlining the deficiencies in Mattel's responses to UMG's Interrogatories and Document Requests, and requesting to meet and confer on these issues.

6. I conducted a discovery conference with Chad Fitzgerald, counsel for Mattel, on January 17, 2008, wherein we discussed a possible resolution to each discovery request in dispute that would obviate the need for UMG to file a motion to compel. At the discovery conference I represented that UMG did not seek any documents or information protected by the attorney-client or work product privilege. Many if not all issues seemed to be resolved at the meet and confer, as Mattel agreed to supplement its written responses to UMG's discovery requests.

7. On or about February 12, 2008, Mr. Fitzgerald told me in an telephone conference that each of Mattel's individual MOTOWN METAL products retailed for 99 cents, and that a special collector's set retailed for \$19.99.

8. Attached hereto as Exhibit 6 is a true and correct copy of a letter I sent Mr. Fitzgerald on February 13, 2008.

9. Attached hereto as Exhibit 7 is a true and correct copy of a Stipulated Motion to Extend Testimony and Trial Dates filed on February 26, 2008.

10. Attached hereto as Exhibit 8 is a true and correct copy of this Board's December 5, 2007 scheduling order.

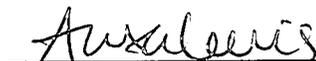
11. To date, Mattel has not supplemented its responses to UMG's Interrogatories and Documents Requests. I have informed Mr. Fitzgerald that UMG would be filing the instant motion.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct. Executed on February 29, 2008, at Los Angeles, California.

  
\_\_\_\_\_  
Alexa L. Lewis

Date of Deposit: 2/29/08

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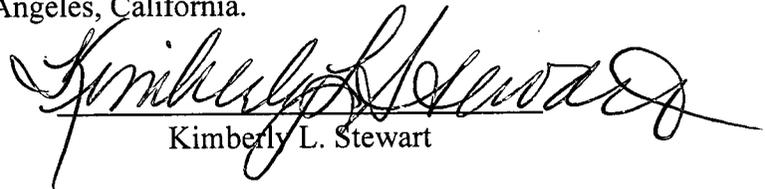
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Executed on February 29, 2008, at Los Angeles, California.

\_\_\_\_\_  
Printed Name

\_\_\_\_\_  
Signature



CPI

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re Matter of Application No. 78/751,105*

UMG RECORDINGS, INC.

Opposer,

Opposition No.: 91176791

v.

MATTEL, INC.,

**OPPOSER UMG  
RECORDINGS, INC.'S FIRST  
SET OF INTERROGATORIES  
TO APPLICANT**

Applicant.

Pursuant to FRCP 33, Opposer UMG Recordings, Inc. ("UMG") hereby requests that Applicant Mattel, Inc. ("Applicant") answer, separately, fully, in writing and under oath, pursuant to and within the deadline governed by the FRCP, the Code of Federal Regulations and the Trademark Trial and Appeal Board Manual of Procedure, the Interrogatories set forth below.

**I. INSTRUCTIONS**

If any one or more of these interrogatories is or are objected to on the grounds of privilege, overbreadth, vagueness or similar grounds, Applicant is instructed for each such Interrogatory to answer the Interrogatory within the response period as narrowed to conform with the objection. Where Applicant lacks knowledge of exact information responsive to an Interrogatory, Applicant is instructed to say so and to answer the Interrogatory to the best of its present knowledge, to supply the best available estimate of the requested information, and to explain the basis of the estimate.

These Interrogatories are continuing and Applicant is hereby requested to supplement its responses immediately whenever it acquires additional information pertinent thereto.

## II. DEFINITIONS

The following definitions are applicable to the terms of these Interrogatories, in the Instructions accompanying these Interrogatories

A. "UMG" shall mean and refer to Opposer UMG Recordings, Inc. and all of its predecessors and successors in interest, any and all of its affiliates and affiliated entities, and its licensees.

B. "Applicant" shall mean and refer to Applicant Mattel, Inc., and includes any and all of its predecessors and successors in interest, any and all of its subsidiaries, affiliates and affiliated entities, and its partners, employees, agents, officers, directors, licensees, and representatives of the foregoing, and any other person acting or purporting to act on behalf of any of the foregoing.

C. The "MOTOWN Marks" shall mean and refer to Applicant's marks as shown in Attachments A and B to UMG's Amended Notice of Opposition.

D. "MOTOWN METAL" shall mean and refer to the mark MOTOWN METAL as shown in U.S. Trademark Application No. 78/751,105, and that is, or is intended to be, used for toys, games and playthings, namely, toy vehicles and accessories therefor.

E. The "MOTOWN METAL Products" shall mean and refer to all products of Applicant bearing, or sold or offered under, or intended to be sold or offered under, the mark MOTOWN METAL.

F. The term "person" refers to natural persons, organizations, associations, partnerships, joint ventures, corporations (including Applicant) and other legal entities, and the

actions taken by a person include the actions of directors, officers, owners, members, partners, joint venturers, employees or agents acting on the person's behalf.

G. The singular includes the plural and vice versa; the words "and" and "or" shall be construed in both the conjunctive and disjunctive; the word "all" means "any and all;" the word "any" means "any and all."

H. As used herein, the term "identify" means:

1. As to documents, give their dates, the type of document (e.g., letter, notebook, etc), the number of pages of which it consists, a detailed description of the document, the author thereof, the date on which it came into Applicant's possession, and specify the person having custody or control thereof.

2. As to natural persons, give their full name, business address (or if not available home address) and telephone number, employer, job title and, if employed by Applicant, their dates and regular places of employment and general duties;

3. As to corporations and limited liability companies ("LLC"), give the full name and present or last known address of the principal place of business of the corporation or LLC, identify the officers and directors of the corporation or managers of the LLC, and the state of incorporation of the corporation or the LLC;

4. As to partnerships, state whether the partnership is a general, limited partnership, or limited liability partnership identify the limited and general partners of the partnership, and state the principal place of business of the partnership; and

5. As to joint ventures or other associations, identify all joint ventures or members of the association and state the principal place of business of the joint venture or association.

### III. INTERROGATORIES

1. Identify each of the MOTOWN METAL Products.
2. Describe in detail how the mark MOTOWN METAL appears, or is intended to appear, in relation to the MOTOWN METAL Products, including without limitation the location and size of said mark, and how it is used in connection with the advertisement and sale of the MOTOWN METAL Products.
3. Identify the date(s) that Applicant selected and/or adopted the mark MOTOWN METAL for use with toys, games, and playthings, namely, toy vehicles and accessories therefor.
4. Why did Applicant select and/or adopt the mark MOTOWN METAL for Applicant's products?
5. State whether Applicant conducted a trademark search prior to selecting and/or adopting the mark MOTOWN METAL, and if so, state whether UMG's use or intended use of, or its federal applications to register, any of the MOTOWN Marks were uncovered in such search.
6. State whether Applicant had knowledge of UMG's use, intended use of, or application to register, any of the MOTOWN Marks at the time that Applicant selected and/or adopted the mark MOTOWN METAL. If the answer to this Interrogatory is yes, identify the person who had such knowledge and describe in detail what such person knew about UMG's use, intended use of, and/or application to register, the MOTOWN Marks at that time.
7. State whether Applicant had knowledge of UMG's use, intended use of, or application to register, any of the MOTOWN Marks at the time that Applicant filed its application to register the mark MOTOWN METAL. If the answer to this Interrogatory is yes,

identify the person who had such knowledge and describe in detail what such person knew about UMG's use, intended use of, and/or application to register, the MOTOWN Marks at that time.

8. Identify each person who has personal knowledge of Applicant's creation, selection, and/or adoption of the mark MOTOWN METAL, and state the nature of each such person's knowledge.

9. Identify each person who has personal knowledge of Applicant's application for registration of the mark MOTOWN METAL, and state the nature of each such person's knowledge.

10. Identify the date that the mark MOTOWN METAL was first used in commerce on or in connection with the MOTOWN METAL Products.

11. State whether the use of MOTOWN METAL has been interrupted from the date of first use to the present, and explain in detail the reasons for such interruption and specify the terms of each interrupted use.

12. Identify the geographic areas in which Applicant has ever sold MOTOWN METAL Products.

13. Identify the geographic areas in which Applicant intends to sell MOTOWN METAL Products.

14. Identify the channels of trade and distribution methods used to sell the MOTOWN METAL Products.

15. Identify the demographic market to which the MOTOWN METAL Products are sold or intended to be sold. Such identification shall include the age, location, and mean household income of those purchasers that Applicant expects and/or intends to buy and use such products.

16. Identify the retail price of the MOTOWN METAL Products.
17. State the total number of units sold of the MOTOWN METAL Products to date.
18. State the amount of money Applicant has spent on advertising for the MOTOWN METAL Products on an annual basis.
19. Identify the methods of marketing and advertising of the MOTOWN METAL Products.
20. State whether Applicant has or ever has had any marketing or advertising plans or programs directed toward or targeted to any particular trade, industry or consumer group for the MOTOWN METAL Products. If so, identify and describe in detail each such trade, industry, or consumer group.
21. Identify (including by name and date) each type of print media (including newspapers and magazines) that contained any advertisement or promotional material for the MOTOWN METAL Products.
22. Identify (including by name, channel/station, and date) each television or radio program that contained any advertisements or promotional material for MOTOWN METAL Products.
23. State whether Applicant sold or offers to sell the MOTOWN METAL Products on the internet, and if so, state the URLs, domain names, or website addresses for each website that sells or offers to sell such products, and the name, address, and telephone number of the owner of each such URL, domain name or website.
24. Identify each person who has personal knowledge regarding the marketing and advertising of the MOTOWN METAL Products, and state the nature of each such person's knowledge.

25. Describe all circumstances surrounding Applicant's first becoming aware or acquiring knowledge of UMG's intended use, use and/or registration of, any of the MOTOWN Marks. In this description, identify the person who first learned of UMG's use, intended use and/or registration of the MOTOWN Marks, the date that Applicant first became aware of or acquired knowledge of such use, intended use, or registration, what such person knew, and how such person acquired such knowledge.

26. Identify each instance of consumer confusion or possible consumer confusion between the MOTOWN METAL Mark and any of UMG's MOTOWN Marks.

27. Identify each person who has personal knowledge of any instance of consumer confusion or possible consumer confusion between the mark MOTOWN METAL and any of UMG's MOTOWN Marks, and describe the nature of each such person's knowledge.

28. Identify and describe in detail all instances in which Applicant received any requests, inquiries, or statements from any person relating to whether there is or was some relationship, association, affiliation, or license between UMG and Applicant, or between the goods or services offered or intended to be offered by UMG under any of the MOTOWN Marks and the MOTOWN METAL Products and for each instance, identify all individuals who have knowledge of the facts thereof, a description of each instance, and the date of each instance.

29. Identify each third party to whom Applicant has made a claim, demand, complaint, or contention that their acts or conduct violate Applicant's rights in the mark MOTOWN METAL.

30. Identify each federal or state trademark registration or trademark application covering the MOTOWN METAL mark or any variation thereof owned by Applicant.

31. If Applicant has ever received any unfavorable comments, evaluations or information, or any criticism or complaints about the quality of any of the MOTOWN METAL Products, identify and describe in detail all communications that refer, relate or pertain to all such comments, evaluations, information, criticism, and complaints, the date of each such communication, and the persons who made and received such communication.

32. Identify all surveys, public opinion polls or any other forms of consumer research known to Applicant that refer, relate or pertain in any way to the mark MOTOWN METAL.

33. Identify all licensing agreements or licensing arrangements between Applicant and any third party relating to the MOTOWN METAL Products, including but not limited to the date of each such agreement or arrangement, the term of each such agreement or arrangement, a description of the right licensed, the types of goods or services relating to each such license arrangement, and the name and address of each third party licensee or licensor.

34. Identify all cross-marketing agreements or other marketing or advertising arrangements between Applicant and any third party relating to the MOTOWN METAL Products, including but not limited to the date of each such agreement or arrangement, the term of each such agreement or arrangement, a description of the right licensed, the types of goods or services relating to each such license arrangement, and the name and address of each third party co-marketer or contracting party.

35. Identify all third parties of which Applicant is aware that currently use MOTOWN or MOTOWN METAL as a mark for toys, games, and playthings.

36. Identify each person whom Applicant expects to call as an expert witness in this matter, and, for each person identified, state the subject matter(s) on which the expert witness is expected to testify, the substance of the facts and opinions to which the expert witness is

expected to testify, a summary of the grounds for each opinion to which the expert is expected to testify, the qualifications of each expert, including a list of all publications authored by the expert within the preceding ten years, the compensation to be paid for the expert's study and testimony; and a list of any other cases in which the expert has testified as an expert at trial or by deposition within the preceding four years.

37. Identify all persons who provided information for Applicant's responses to these interrogatories, and for Applicant's responses to UMG's first set of requests for production of documents and things served concurrently herewith.

Dated: August 28, 2007

MITCHELL SILBERBERG & KNUPP LLP  
RUSSELL J. FRACKMAN  
JEFFREY D. GOLDMAN  
ALEXA L. LEWIS

By: Alexander  
Attorneys for Opposer

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Santa Monica, CA 90401

(310) 566-9800

Fax: (310) 566-9850

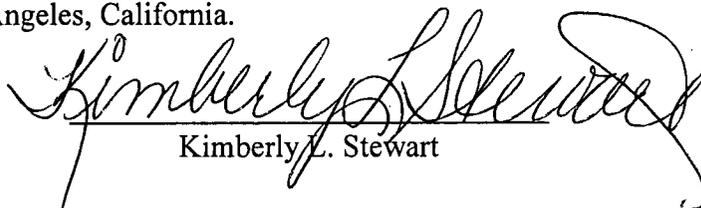
Counsel for Applicant, MATTEL,  
INC.

- 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 PERSONAL DELIVERY:** I placed the above-mentioned document(s) in sealed envelope(s), and caused personal delivery by FIRST LEGAL SUPPORT SERVICES of the document(s) listed above to the person(s) at the address(es) set forth above.

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 August 28, 2007, at Los Angeles, California.

  
Kimberly L. 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 FIRST LEGAL SUPPORT SERVICES, 1511 West Beverly Boulevard, Los Angeles CA 90026.

On August 28, 2007, I served the foregoing document(s) described as **OPPOSER UMG RECORDINGS, INC.'S FIRST SET OF INTERROGATORIES TO APPLICANT** which was enclosed in sealed envelopes addressed as follows, and taking the action described below:

Lawrence Y. Iser ([liser@kwikalaw.com](mailto:liser@kwikalaw.com))

Direct (310) 566-9801

Direct Fax (310) 566-9861

Patricia A. Millett ([pmillet@kwikalaw.com](mailto:pmillet@kwikalaw.com))

Direct (310) 566-9821

Direct Fax (310) 566-9870

Kinsella, Weitzman, Iser, Kump & Aldisert LLP

808 Wilshire Boulevard, 3rd Floor

Santa Monica, CA 90401

(310) 566-9800

Fax: (310) 566-9850

Counsel for Applicant, MATTEL,  
INC.

**BY PERSONAL SERVICE:** I hand delivered such envelope(s):

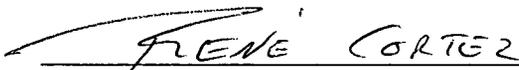
to the addressee(s);

to the receptionist/clerk/secretary in the office(s) of the addressee(s).

by leaving the envelope in a conspicuous place at the office of the addressee(s) between the hours of 9:00 a.m. and 5:00 p.m.

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

Executed on August 28, 2007, at Los Angeles, California.



Printed Name



Signature



CPI

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re Matter of Application No. 78/751,105*

UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer,

**OPPOSER UMG  
RECORDINGS, INC.'S FIRST  
SET OF REQUESTS FOR  
THE PRODUCTION OF  
DOCUMENTS AND THINGS  
TO APPLICANT MATTEL,  
INC.**

v.

MATTEL, INC.,

Applicant.

Pursuant to FRCP 34, Opposer UMG Recordings, Inc. ("UMG") hereby requests that Applicant Mattel, Inc. ("Applicant") provide written responses to the requests for documents and things listed below, and produce and permit the inspection and copying of the documents and things requested below at the offices of Mitchell Silberberg & Knupp LLP, 11377 West Olympic Blvd., Los Angeles, CA 90064, pursuant to the deadline governed by the FRCP, the Code of Federal Regulations and the Trademark Trial and Appeal Board Manual of Procedure.

**I. DEFINITIONS**

UMG adopts and incorporated by reference the Definitions in UMG's First Set of Interrogatories to Applicant Mattel, Inc., served concurrently herewith.

**II. INSTRUCTIONS**

A. Documents and things that are identified or referred to by Applicant in its answers to UMG's First Set of Interrogatories and First Requests for Admissions

5 8/28/07

("RFA") to Applicant, and documents that were relied upon in answering those Interrogatories and RFAs, shall be produced in separate files designated by reference to the corresponding Interrogatory or RFA.

B. Documents and things other than those designated by reference to the Interrogatories and RFAs pursuant to Instruction "A" above shall be produced in separate files designated by reference to the specific Request to which they are responsive.

C. As to any responsive document or thing that Applicant refuses to produce, Applicant is requested to supply a description of the document by date, author, addressee and/or recipient, custodian and subject matter sufficient to allow a motion pursuant to FRCP 37(a) for production of the document or thing. If refusal to produce is based upon a claim that the document or thing is subject to a privilege, or subject to protection as trial preparation material, in addition to the foregoing, Applicant is requested to provide a list of such withheld documents stating the form of the document withheld, the date of its preparation, the author, each addressee or recipient, the subject matter, the basis for any claim of privilege for which a document is withheld, and the name and address of any person or persons presently having custody or control of the same or a true copy thereof.

D. Produce all documents and things in Applicant's possession, custody or control. This includes, but is not limited to, documents and things in the possession of Applicant's staff, agents, employees, licensees, representatives, accountants and attorneys.

E. If any document or thing requested was formerly in Applicant's possession, custody or control and has been lost, destroyed or otherwise disposed of, Applicant is requested to submit in lieu of any such document or thing a written

statement: (i) describing in detail the nature of the document or thing and its contents; (ii) identifying the person(s) who prepared or authored the document or things and, if applicable, the person(s) to whom the document or thing was sent or shown; (iii) specifying the date on which the document or thing was prepared or transmitted; and (iv) specifying, if possible, the date on which the document or thing was lost or destroyed and, if destroyed, the conditions of and reason(s) for such destruction and the person(s) requesting and performing the destruction, their employer(s) and positions.

F. Pursuant to FRCP 26(e), Applicant is requested to seasonably amend any response if Applicant obtains information upon the basis of which it knows that the prior response was incorrect or, though the response was correct when made, it is no longer correct.

### III. REQUESTS

1. Two representative specimens of each product bearing Applicant's MOTOWN METAL mark.
2. Representative specimens of each of the different tags, packages, wrappings, labels, stickers, package inserts, instruction manuals, displays, or other means by which Applicant has applied or used the MOTOWN METAL mark on any products.
3. Representative specimens of each of the advertisements, commercials, press releases, brochures, catalogs, and other advertising or promotional materials by which Applicant has advertised or promoted any products under the MOTOWN METAL mark.
4. Documents sufficient to show the date on which Applicant first used the MOTOWN METAL mark in commerce in connection with toys, games, and playthings.

5. Documents sufficient to show where (e.g. which newspaper, which magazine, which catalogue, which television station, which radio station, which internet site) and in what medium each advertisement for MOTOWN METAL Products has appeared.

6. Documents sufficient to show when (e.g. which dates, which time of day or night) each advertisement featuring the MOTOWN METAL mark or MOTOWN METAL Products has been run or published in any medium.

7. Documents sufficient to show the demographic market and/or advertising market targeted for the advertisements featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

8. All documents which constitute, embody, reflect, or refer to any studies, marketing plans, opinions, or reports (including of advertising, marketing, polling, public relations, market research, and public opinion agencies) that concern Applicant's use or contemplated use of the mark MOTOWN METAL.

9. Documents sufficient to show the number of units distributed and sold of each of the MOTOWN METAL Products.

10. Documents sufficient to show the suggested and actual retail price of each of the MOTOWN METAL Products.

11. Documents sufficient to show Applicant's annual expenditures for advertising and other promotional materials for each of the MOTOWN METAL Products.

12. Documents sufficient to show Applicant's expenditures by type of media (e.g., television, print) for advertising and other promotional materials for each of the MOTOWN METAL Products.

13. All documents that reflect or evidence the creation, selection, and/or adoption of the mark MOTOWN METAL by Applicant, including without limitation all documents in which the selection, creation, and/or adoption of the mark MOTOWN METAL by Applicant, was suggested, discussed, or mentioned.

14. All documents that reflect or evidence the clearance of the mark MOTOWN METAL by Applicant, including without limitation all trademark search reports, investigations, memoranda and correspondence.

15. All documents that reflect or evidence any alternate marks that were considered by Applicant for use as a trademark or service mark, instead of the MOTOWN METAL mark.

16. All documents that reflect or evidence any application to register filed by Applicant, or any registration acquired by Applicant in the United States Patent and Trademark Office or in any state or other political subdivision of the United States, that consists of or includes the mark MOTOWN METAL.

17. All documents that reflect or evidence any claims, demands, or assertions by Applicant that a third party's acts or conduct infringes Applicant's rights, if any, in the mark MOTOWN METAL.

18. All consent agreements or co-existence agreements between Applicant and any third parties regarding the use of any trademarks containing the word MOTOWN and all correspondence and other documents relating thereto.

19. All documents that reflect or evidence use or registration by any third party of any trademark that contains the word MOTOWN, as used for toys, games and playthings, namely toy vehicles and accessories therefore, or related products or services.

20. All documents that reflect or evidence any alleged instances of actual confusion, mistake or deception involving Applicant's use of the mark MOTOWN METAL and the MOTOWN Marks.

21. All documents that reflect or evidence UMG's use, intended use, or registration of the MOTOWN Marks, other than pleadings filed in this case or correspondence exchanged between Applicant and UMG.

22. All documents relating to the date that Applicant first became aware or acquired knowledge of UMG's use or intended use of, or registration of, the MOTOWN Marks.

23. All documents regarding any perceived affiliations or connection between Applicant and UMG, between Applicant's MOTOWN METAL Products and products or services bearing UMG's MOTOWN Marks, or perceived sponsorship between UMG and Applicant, including without limitation, all documents relating to any misdirected telephone calls, emails, or other communications.

24. All documents which constitute, embody, reflect, or refer to any written or oral communications between Applicant and any other person or entity (other than UMG) concerning UMG's use of the MOTOWN Marks.

25. All documents that constitute, embody, reflect or refer to any communications that Applicant has had, orally or in writing, with any other person or

entity (other than UMG) regarding the use or registration of the mark MOTOWN METAL or variations thereof.

26. All documents which constitute, embody, reflect, or refer to any written or oral communications within Applicant (i.e., between or among employees, agents, and/or representatives thereof) concerning UMG's use of the MOTOWN Marks.

27. All documents that constitute, embody, reflect, or refer to any styleguide, rules, regulations, procedures, or internal requirements of Applicant for goods bearing the mark MOTOWN METAL.

28. All documents that constitute, embody, reflect, or refer to agreements between Applicant and any person or entity concerning goods sold under the mark MOTOWN METAL, including but not limited to all assignments, licenses, and license agreements.

29. Documents sufficient to identify each outlet, store or website in the United States that sells, offers for sale, promotes, or advertises any of the MOTOWN METAL Products.

30. All documents that reflect or evidence the type of consumer who is intended to buy and use the MOTOWN METAL Products.

31. All documents that reflect or evidence the channels of distribution and intended channels of distribution of each of the MOTOWN METAL Products.

32. All business plans of Applicant for or including the MOTOWN METAL mark.

33. All documents relating to, supporting, or rebutting Applicant's denial of the allegations contained in UMG's Amended Notice of Opposition.

34. All documents relating to, supporting, or rebutting the Applicant's affirmative defenses.
35. All web pages for Applicant's website featuring the MOTOWN METAL mark or the MOTOWN METAL Products.
36. All documents that reflect or evidence the number of "hits" to Applicant's website featuring the MOTOWN METAL mark or the MOTOWN METAL Products.
37. All written reports prepared by, and all exhibits to be used as a summary of or in support of the opinion of, each expert that Applicant expects to call as a witness during its testimony period.
38. All documents and things that constitute, embody, reflect or refer to communications between Applicant and any expert(s) that Applicant plans to call during its testimony period, including but not limited to all documents provided by Applicant to any expert(s) that Applicant plans to call during its testimony period.
39. All documents that reflect or evidence any pilot surveys, studios, focus groups or other research conducted by any expert(s) retained by Applicant, including but not limited to pilot surveys, completed surveys, all surveys, questionnaires, and instructions.
40. All documents that each expert retained by Applicant relied upon to form each of his or her opinions.
41. All documents that reflect or evidence all facts relied upon by each expert retained by Applicant to form each such expert's opinions and/or which each such expert's opinions are based.

42. All documents or things that were identified in response to, or relied upon in responding to, UMG's Interrogatories to Applicant.

43. All documents or things that were identified in response to, or relied upon in responding to, UMG's RFAs to Applicant.

Dated: August 28, 2007

MITCHELL SILBERBERG & KNUPP LLP  
RUSSELL J. FRACKMAN  
JEFFREY D. GOLDMAN  
ALEXA L. LEWIS

By: Alexa Lewis  
Attorneys for Opposer

**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 28, 2007, I served a copy of the foregoing document(s) described as **OPPOSER UMG RECORDINGS, INC.'S FIRST SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS AND THINGS TO APPLICANT MATTEL, INC.** on the interested parties in this action at their last known address as set forth below by taking the action described below:

Lawrence Y. Iser ([liser@kwikalaw.com](mailto:liser@kwikalaw.com))

Direct (310) 566-9801

Direct Fax (310) 566-9861

Patricia A. Millett ([pmillet@kwikalaw.com](mailto:pmillet@kwikalaw.com))

Direct (310) 566-9821

Direct Fax (310) 566-9870

Kinsella, Weitzman, Iser, Kump & Aldisert LLP

808 Wilshire Boulevard, 3rd Floor

Santa Monica, CA 90401

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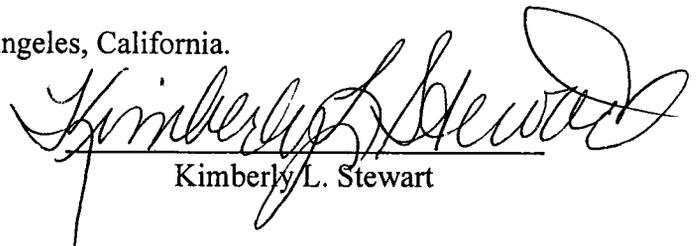
Counsel for Applicant, MATTEL,  
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I declare that I am employed in the office of a member of the State Bar of California and various federal bars, at whose direction such service was made.

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

Executed on August 28, 2007, at Los Angeles, California.

  
Kimberly L. Stewart

**PROOF OF SERVICE**

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

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I am over the age of 18, and not a party to the within action; my business address is FIRST LEGAL SUPPORT SERVICES, 1511 West Beverly Boulevard, Los Angeles CA 90026.

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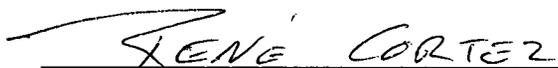
Lawrence Y. Iser ([liser@kwikalaw.com](mailto:liser@kwikalaw.com))      Counsel for Applicant, MATTEL, INC.  
Direct (310) 566-9801  
Direct Fax (310) 566-9861  
Patricia A. Millett ([pmillet@kwikalaw.com](mailto:pmillet@kwikalaw.com))  
Direct (310) 566-9821  
Direct Fax (310) 566-9870  
Kinsella, Weitzman, Iser, Kump & Aldisert  
LLP  
808 Wilshire Boulevard, 3rd Floor  
Santa Monica, CA 90401  
(310) 566-9800  
Fax: (310) 566-9850

**BY PERSONAL SERVICE:** I hand delivered such envelope(s):

- to the addressee(s);
- to the receptionist/clerk/secretary in the office(s) of the addressee(s).
- by leaving the envelope in a conspicuous place at the office of the addressee(s) between the hours of 9:00 a.m. and 5:00 p.m.

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

Executed on August 28, 2007, at Los Angeles, California.

  
\_\_\_\_\_  
Printed Name

  
\_\_\_\_\_  
Signature



**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

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UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

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**APPLICANT MATTEL, INC.'S RESPONSES TO OPPOSER UMG RECORDINGS,  
INC.'S FIRST SET OF INTERROGATORIES**

PROPOUNDING PARTY:           Opposer UMG RECORDINGS, INC.

RESPONDING PARTY:           Applicant MATTEL, INC.

SET NO.:                        ONE

**PRELIMINARY STATEMENT AND GENERAL OBJECTIONS**

As of the date hereof, Applicant Mattel, Inc. ("Mattel") has not yet completed its investigation of the matters involved herein and has not completed discovery in this action. Consequently, these responses are based only upon such information and documents presently

available, known to or understood by Mattel. As investigation and discovery proceeds, Mattel anticipates that further discovery, research and analysis may supply additional facts and additional meaning to the known facts. Therefore, the following responses are given without prejudice to Mattel's right to supplement, alter or amend these responses as the result of subsequently-discovered evidence. Mattel further reserves its right to use, as evidence in this proceeding, any hereafter-acquired or discovered evidence that would have been responsive to these requests.

Except for express admissions set forth herein, no incidental or implied admissions are intended by these responses. The fact that Mattel has objected or responded to a particular interrogatory is not intended to be an admission by Mattel of the existence of any facts set forth or assumed by the interrogatory. In so objecting or responding, Mattel does not concede the relevance, materiality, propriety or admissibility of any interrogatory or the subject matter to which it relates. These responses are made by Mattel subject to, and without in any way waiving or intending to waive:

1. Any objections as to competency, materiality, privilege, relevancy, propriety, admissibility and/or any other objections on grounds which would require exclusion of any information contained herein;
2. The right to object to other discovery proceedings involving or relating to the same subject matter as the interrogatories; or
3. The right at any time to revise, correct, add to, or clarify any of the responses set forth herein. Furthermore, these responses are given subject to correction of any omissions or errors.

Mattel objects to each interrogatory to the extent it calls for privileged information, including but not limited to, information protected by the attorney-client privilege, the attorney work product doctrine or other applicable constitutional, statutory or common law privileges, doctrines or immunity from disclosure. Mattel will not provide such information. Any inadvertent provision of such information shall not be deemed a waiver of any privileges.

Mattel objects to the interrogatories in their entirety to the extent they attempt or purport to impose obligations on Mattel beyond those set forth in the Federal Rules of Civil Procedure, the Code of Federal Regulations, or the Trademark Trial and Appeal Board Manual of Procedure. In the following responses, all definitions and other instructions shall be treated as having no force or effect to the extent that they exceed those duties.

Mattel objects to each interrogatory to the extent it attempts or purports to impose an obligation to investigate or discover information from third parties not under its control or persons who are equally accessible to Opposer UMG Recordings, Inc ("UMG").

Mattel objects to each interrogatory to the extent it attempts or purports to seek information not relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**RESPONSES TO INTERROGATORIES**

**INTERROGATORY NO. 1:**

Identify each of the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 1:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Subject to and without waiving the foregoing objections, Mattel responds as follows:

YEAR	TOY #	DESCRIPTION
<u>Hot Wheels Kid</u>		
2006	J3412	HOT WHEELS MOTOWN METAL '70 Chevelle
2006	J3413	HOT WHEELS MOTOWN METAL '65 Mustang
2006	J3414	HOT WHEELS MOTOWN METAL '70 Plymouth Road Runner
2006	J3415	HOT WHEELS MOTOWN METAL '67 Camaro
2006	J3416	HOT WHEELS MOTOWN METAL '69 Pontiac GTO
2007	J3412	HOT WHEELS MOTOWN METAL '70 Chevelle
2007	J3413	HOT WHEELS MOTOWN METAL '65 Mustang
2007	J3414	HOT WHEELS MOTOWN METAL '70 Plymouth Road Runner
2007	J3415	HOT WHEELS MOTOWN METAL '67 Camaro
2007	J3416	HOT WHEELS MOTOWN METAL '69 Pontiac GTO

Hot Wheels Adult/Collector

2007 M3264 HOT WHEELS MOTOWN METAL 40TH ANNIVERSARY  
2007 L8805 HOT WHEELS 40TH ANNIVERSARY 2-CAR SETS

**INTERROGATORY NO. 2:**

Describe in detail how the mark MOTOWN METAL appears, or is intended to appear, in relation to the MOTOWN METAL Products, including without limitation the location and size of said mark, and how it is used in connection with the advertisement and sale of the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 2:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Subject to and without waiving the foregoing objections, Mattel responds as follows:

See documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 3:**

Identify the date(s) that Applicant selected and/or adopted the mark MOTOWN METAL for use with toys, games, and playthings, namely, toy vehicles and accessories therefor.

**RESPONSE TO INTERROGATORY NO. 3:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving the foregoing objections, Mattel responds as follows:

On or about November 9, 2005.

**INTERROGATORY NO. 4:**

Why did Applicant select and/or adopt the mark MOTOWN METAL for Applicant's products?

**RESPONSE TO INTERROGATORY NO. 4:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Mattel selected the mark MOTOWN METAL because of the perceived connection between Detroit, Michigan (aka "Motown" or "Motor City") and the United States automobile industry in general.

**INTERROGATORY NO. 5:**

State whether Applicant conducted a trademark search prior to selecting and/or adopting the mark MOTOWN METAL, and if so, state whether UMG's use or intended use of, or its federal applications to register, any of the MOTOWN Marks were uncovered in such search.

**RESPONSE TO INTERROGATORY NO. 5:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Subject to and without waiving the foregoing objections, Mattel responds as follows:

*See* documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 6:**

State whether Applicant had knowledge of UMG's use, intended use of, or application to register, any of the MOTOWN Marks at the time that Applicant selected and/or adopted the mark MOTOWN METAL. If the answer to this Interrogatory is yes, identify the person who had

such knowledge and describe in detail that such person knew about UMG's use, intended use of, and/or application to register, the MOTOWN Marks at that time.

**RESPONSE TO INTERROGATORY NO. 6:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

*See* documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 7:**

State whether Applicant had knowledge of UMG's use, intended use of, or application to register, any of the MOTOWN Marks at the time that Applicant filed its application to register the mark MOTOWN METAL. If the answer to this Interrogatory is yes, identify the person who had such knowledge and describe in detail what such person knew about UMG's use, intended use of, and/or application to register, the MOTOWN Marks at that time.

**RESPONSE TO INTERROGATORY NO. 7:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

See documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 8:**

Identify each person who had personal knowledge of Applicant's creation, selection, and/or adoption of the mark MOTOWN METAL, and state the nature of each such person's knowledge.

**RESPONSE TO INTERROGATORY NO. 8:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Donald Aiken; Michael Moore; Kerry Regan; and Martha Jackson (all members of Mattel's Law Department at the relevant times); Jan Heininger (Mattel's copywriter for the MOTOWN METAL products).

**INTERROGATORY NO. 9:**

Identify each person who had personal knowledge of Applicant's application for registration of the mark MOTOWN METAL, and state the nature of each such person's knowledge.

**RESPONSE TO INTERROGATORY NO. 9:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither

relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Donald Aiken; Michael Moore; Kerry Regan; Jan Heininger; Martha Jackson.

**INTERROGATORY NO. 10:**

Identify the date that the mark MOTOWN METAL was first used in commerce on or in connection with the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 10:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing in that it seeks information equally accessible to UMG. Mattel further objects to this interrogatory to the extent that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

The MOTOWN METAL products were first shipped to retailers in or about the second quarter of 2006. The MOTOWN METAL products were shipped as part of general assortments of Hot Wheels™ basic cars, ranging from 18 to 144 cars.

**INTERROGATORY NO. 11:**

State whether the use of MOTOWN METAL has been interrupted from the date of first use to the present, and explain in detail the reasons for such interruption and specify the terms of each interruption use.

**RESPONSE TO INTERROGATORY NO. 11:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous.

**INTERROGATORY NO. 12:**

Identify the geographic areas in which Applicant has ever sold MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 12:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

Subject to and without waiving the foregoing objections, Mattel responds as follows:

The MOTOWN METAL products have been sold to retailers worldwide as part of general die cast car assortments.

**INTERROGATORY NO. 13:**

Identify the geographic areas in which applicant intends to sell MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 13:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 14:**

Identify the channels of trade and distribution methods used to sell the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 14:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 15:**

Identify the demographic market to which the MOTOWN METAL Products are sold or intended to be sold. Such identification shall include the age, location, and mean household income of those purchasers that Applicant expects and/or intends to buy and use such products.

**RESPONSE TO INTERROGATORY NO. 15:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 16:**

Identify the retail price of the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 16:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this

interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG.

**INTERROGATORY NO. 17:**

State the total number of units sold of the MOTOWN METAL Products to date.

**RESPONSE TO INTERROGATORY NO. 17:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 18:**

State the amount of money Applicant has spent on advertising for the MOTOWN METAL Products on an annual basis.

**RESPONSE TO INTERROGATORY NO. 18:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 19:**

Identify the methods of marketing and advertising of the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 19:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad

and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 20:**

State whether applicant has or ever has had any marketing or advertising plans or programs directed toward or targeted to any particular trade, industry or consumer group for the MOTOWN METAL Products. If so, identify and describe in detail each such trade, industry, or consumer group.

**RESPONSE TO INTERROGATORY NO. 20:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**INTERROGATORY NO. 21:**

Identify (including by name and date) each type of print media (including newspapers and magazines) that contained any advertisement or promotional material for the MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 21:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 22:**

Identify (including by name, channel/station, and date) each television or radio program that contained any advertisements or promotional material for MOTOWN METAL Products.

**RESPONSE TO INTERROGATORY NO. 22:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 23:**

State whether Applicant sold or offers to sell the MOTOWN METAL Products on the internet, and if so, state the URLs, domain names, or website addresses for each website that sells or offers to sell such products, and the name, address, and telephone number of the owner of each such URL, domain name or website.

**RESPONSE TO INTERROGATORY NO. 23:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG.

**INTERROGATORY NO. 24:**

Identify each person who has personal knowledge regarding the marketing and advertising of the MOTOWN METAL Products, and state the nature of each such person's knowledge.

**RESPONSE TO INTERROGATORY NO. 24:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 25:**

Describe all circumstances surrounding Applicant's first becoming aware or acquiring knowledge of UMG's intended use, use and/or registration of, any of the MOTOWN Marks. In this description, identify the person who first learned of UMG's use, intended use and/or registration of the MOTOWN Marks, the date that Applicant first became aware of or acquired knowledge of such use, intended use, or registration, what such person knew, and how such person acquired such knowledge.

**RESPONSE TO INTERROGATORY NO. 25:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

*See* documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 26:**

Identify each instance of consumer confusion or possible consumer confusion between the MOTOWN METAL Mark and any of UMG's MOTOWN Marks.

**RESPONSE TO INTERROGATORY NO. 26:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Mattel is not aware of any instances of consumer confusion between the MOTOWN METAL mark and any of UMG's MOTOWN marks.

**INTERROGATORY NO. 27:**

Identify each person who has personal knowledge of any instance of consumer confusion or possible consumer confusion between the mark MOTOWN METAL and any of UMG's MOTOWN Marks, and describe the nature of each such person's knowledge.

**RESPONSE TO INTERROGATORY NO. 27:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Mattel is not aware of any instances of consumer confusion between the MOTOWN METAL mark and any of UMG's MOTOWN marks.

**INTERROGATORY NO. 28:**

Identify and describe in detail all instances in which Applicant received any requests, inquiries, or statements from any person relating to whether there is or was some relationship, association, affiliation, or license between UMG and Applicant, or between the goods or services offered or intended to be offered by UMG under any of the MOTOWN Marks and the MOTOWN METAL Products for each instance, identify all individuals who have knowledge of the facts thereof, a description of each instance, and the date of each instance.

**RESPONSE TO INTERROGATORY NO. 28:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Mattel is not aware of any instances in which it received any requests, inquiries, or statements from any person relating to whether there is or was some relationship, association, affiliation, or license between UMG and Mattel or between the goods or services offered or intended to be offered by UMG under any of the MOTOWN marks and the MOTOWN METAL Products.

**INTERROGATORY NO. 29:**

Identify each third party to whom Applicant has made a claim, demand, complaint, or contention that their acts or conduct violate Applicant's rights in the mark MOTOWN METAL.

**RESPONSE TO INTERROGATORY NO. 29:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing and seeks information equally accessible to UMG. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Mattel has made no claim, demand, complaint, or contention to any third party that its acts or conduct violate Mattel's rights in the mark MOTOWN METAL.

**INTERROGATORY NO. 30:**

Identify each federal or state trademark registration or trademark application covering the MOTOWN METAL mark or any variation thereof owned by Applicant.

**RESPONSE TO INTERROGATORY NO. 30:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

See documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 31:**

If Applicant has ever received any unfavorable comments, evaluations or information, or any criticism or complaints about the quality of any of the MOTOWN METAL Products, identify and describe in detail all communications that refer, relate or pertain to all such

comments, evaluations, information, criticism, and complaints, the date of each such communication, and the persons who made and received such communication.

**RESPONSE TO INTERROGATORY NO. 31:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**INTERROGATORY NO. 32:**

Identify all surveys, public opinion polls or any other forms of consumer research known to Applicant that refer, relate or pertain in any way to the mark MOTOWN METAL.

**RESPONSE TO INTERROGATORY NO. 32:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine.

**INTERROGATORY NO. 33:**

Identify all licensing agreements or licensing arrangements between Applicant and any third party relating to the MOTOWN METAL Products, including but not limited to the date of each such agreement or arrangement, the term of each such agreement or arrangement, a description of the right licensed, the types of goods or services relating to each such license arrangement, and the name and address of each third party licensee or licensor.

**RESPONSE TO INTERROGATORY NO. 33:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 34:**

Identify all cross-marketing agreements or other marketing or advertising arrangements between Applicant and any third party relating to the MOTOWN METAL Products, including but not limited to the date of each such agreement or arrangement, the term of each such agreement or arrangement, a description of the right licensed, the types of goods or services relating to each such license arrangement, and the name and address of each third party co-marketer or contracting party.

**RESPONSE TO INTERROGATORY NO. 34:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague and ambiguous. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing.

**INTERROGATORY NO. 35:**

Identify all third parties of which Applicant is aware that currently use MOTOWN or MOTOWN METAL as a mark for toys, games, and playthings.

**RESPONSE TO INTERROGATORY NO. 35:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is unduly

burdensome and harassing, and seeks information equally accessible to UMG. Mattel further objects to this interrogatory on the grounds that it is unreasonably cumulative and duplicative. Subject to and without waiving the foregoing objections, Mattel responds as follows:

*See* documents to be produced by Mattel in response to UMG's First Set of Requests for Production of Documents and Things.

**INTERROGATORY NO. 36:**

Identify each person whom Applicant expects to call as an expert witness in this matter, and, for each person identified, state the subject matter(s) on which the expert witness is expected to testify, the substance of the facts and opinions to which the expert witness is expected to testify, a summary of the grounds for each opinion to which the expert is expected to testify, the qualifications of each expert, including a list of all publications authored by the expert within the preceding ten years, the compensation to be paid for the expert's study and testimony; and a list of any other cases in which the expert has testified as an expert at trial or by deposition within the preceding four years.

**RESPONSE TO INTERROGATORY NO. 36:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel further objects to this request to the extent that it seeks documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Mattel has not yet retained any expert witness to testify in this matter.

**INTERROGATORY NO. 37:**

Identify all persons who provided information for Applicant's responses to these interrogatories, and for Applicant's responses to UMG's first set of requests for production of documents and things served concurrently herewith.

**RESPONSE TO INTERROGATORY NO. 37:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this interrogatory on the grounds that it is vague

and ambiguous. Mattel further objects to this interrogatory on the grounds that it is unduly burdensome and harassing. Mattel further objects to this interrogatory on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving the foregoing objections, Mattel responds as follows:

Sam Negley; Ray Adler; Shane Amsterdam; Chris Bouman; Chris Parker; Joe Feffer; Jan Heininger; Laura Horowitz; Patti Breyfogle; Michael Dewart; Matt Emert; Marc Gallardo; Scott Neitlich; Paul Winter; Dave Zbojnowicz; John Ludwig; Yin Wong.

DATED: October 9, 2007

KINSELLA WEITZMAN ISER KUMP &  
ALDISERT LLP

By:



Chad R. Fitzgerald  
Attorneys for Mattel, Inc.

**PROOF OF SERVICE**

**STATE OF CALIFORNIA, COUNTY OF LOS ANGELES**

At the time of service, I was over 18 years of age and **not a party to this action**. I am employed in the County of Los Angeles, State of California. My business address is 808 Wilshire Boulevard, 3rd Floor, Santa Monica, California 90401.

On October 9, 2007, I served the following document(s) described as APPLICANT MATTEL, INC.'S RESPONSES TO OPPOSER UMG RECORDINGS, INC.'S FIRST SET OF INTERROGATORIES on the interested party in this action as follows:

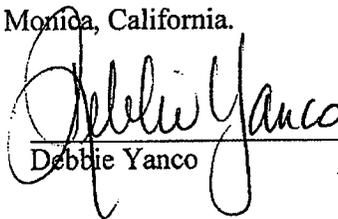
Alexa L. Lewis, Esq.  
Mitchell Silberberg & Knupp LLP  
11377 West Olympic Blvd  
Los Angeles, CA 90064  
Email: all@msk.com

**BY E-MAIL OR ELECTRONIC TRANSMISSION:** Based on a court order or an agreement of the parties to accept service by e-mail or electronic transmission, I caused the document(s) to be sent from e-mail address dyanco@kwikalaw.com to the persons at the e-mail addresses listed in the Service List. I did not receive, within a reasonable time after the transmission, any electronic message or other indication that the transmission was unsuccessful.

**BY MAIL:** I enclosed the document(s) in a sealed envelope or package addressed to the persons at the addresses listed in the Service List and placed the envelope for collection and mailing, following our ordinary business practices. I am readily familiar with Kinsella Weitzman Iser Kump & Aldisert's practice for collecting and processing correspondence for mailing. On the same day that the correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service, in a sealed envelope with postage fully prepaid.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on October 9, 2007, at Santa Monica, California.

  
\_\_\_\_\_  
Debbie Yanco



**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

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UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

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**APPLICANT MATTEL, INC.'S RESPONSE TO  
OPPOSER UMG RECORDINGS, INC.'S  
FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS**

PROPOUNDING PARTY:           Opposer UMG RECORDINGS, INC.

RESPONDING PARTY:           Applicant MATTEL, INC.

SET NO.:                        ONE

**PRELIMINARY STATEMENT AND GENERAL OBJECTIONS**

As of the date hereof, Applicant Mattel, Inc. ("Mattel") has not yet completed its investigation of the matters involved herein and has not completed discovery in this action. Consequently, these responses are based only upon such information and documents presently

available, known to or understood by Mattel. As investigation and discovery proceeds, Mattel anticipates that further discovery, research and analysis may supply additional facts and additional meaning to the known facts. Therefore, the following responses are given without prejudice to Mattel's right to supplement, alter or amend these responses as the result of subsequently-discovered evidence. Mattel further reserves its right to use, as evidence in this proceeding, any hereafter-acquired or discovered evidence that would have been responsive to these requests.

Except for express admissions set forth herein, no incidental or implied admissions are intended by these responses. The fact that Mattel has objected or responded to a particular request is not intended to be an admission by Mattel of the existence of any facts set forth or assumed by the request. In so objecting or responding, Mattel does not concede the relevance, materiality, propriety or admissibility of any request or the subject matter to which it relates. These responses are made by Mattel subject to, and without in any way waiving or intending to waive:

1. Any objections as to competency, materiality, privilege, relevancy, propriety, admissibility and/or any other objections on grounds which would require exclusion of any information contained herein;
2. The right to object to other discovery proceedings involving or relating to the same subject matter as the interrogatories; or
3. The right at any time to revise, correct, add to, or clarify any of the responses set forth herein. Furthermore, these responses are given subject to correction of any omissions or errors.

Mattel objects to each request to the extent it calls for privileged information, including but not limited to, information protected by the attorney-client privilege, the attorney work product doctrine or other applicable constitutional, statutory or common law privileges, doctrines or immunity from disclosure. Mattel will not provide such information. Any inadvertent provision of such information shall not be deemed a waiver of any privileges.

Mattel objects to the requests in their entirety to the extent they attempt or purport to impose obligations on Mattel beyond those set forth in the Federal Rules of Civil Procedure, the Code of Federal Regulations, or the Trademark Trial and Appeal Board Manual of Procedure. In the following responses, all definitions and other instructions shall be treated as having no force or effect to the extent that they exceed those duties.

Mattel objects to each request to the extent it attempts or purports to impose an obligation to investigate or discover information from third parties not under its control or persons who are equally accessible to Opposer UMG Recordings, Inc ("UMG").

Mattel objects to each request to the extent it attempts or purports to seek information not relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

### **RESPONSES TO REQUESTS FOR PRODUCTION**

#### **REQUEST FOR PRODUCTION NO. 1:**

Two representative specimens of each product bearing Applicant's MOTOWN METAL mark.

#### **RESPONSE TO REQUEST FOR PRODUCTION NO. 1:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Subject to and without waiving the foregoing objections, Mattel will produce documents sufficient to identify each of Mattel's products bearing the MOTOWN METAL mark.

**REQUEST FOR PRODUCTION NO. 2:**

Representative specimens of each of the different tags, packages, wrappings, labels, stickers, package inserts, instruction manuals, displays, or other means by which Applicant has applied or used the MOTOWN METAL mark on any products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 2:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Subject to and without waiving the foregoing objections, Mattel will produce documents sufficient to identify the packaging for each of Mattel's products bearing the MOTOWN METAL mark.

**REQUEST FOR PRODUCTION NO. 3:**

Representative specimens of each of the advertisements, commercials, press releases, brochures, catalogs, and other advertising or promotional materials by which Applicant has advertised or promoted any products under the MOTOWN METAL mark.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 3:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 4:**

Documents sufficient to show the date on which Applicant first used the MOTOWN METAL mark in commerce in connection with toys, games, and playthings.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 4:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Subject to and without waiving the foregoing objections, Mattel will produce documents sufficient to show the date Mattel first used the MOTOWN METAL mark in commerce.

**REQUEST FOR PRODUCTION NO. 5:**

Documents sufficient to show where (e.g. which newspaper, which magazine, which catalogue, which television station, which radio station, which internet site) and in what medium each advertisement for MOTOWN METAL Products has appeared.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 5:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 6:**

Documents sufficient to show when (e.g. which dates, which time of day or night) each advertisement featuring the MOTOWN METAL mark or MOTOWN METAL Products has been run or published in any medium.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 6:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the

claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 7:**

Documents sufficient to show the demographic market and/or advertising market targeted for the advertisements featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 7:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 8:**

All documents which constitute, embody, reflect, or refer to any studies, marketing plans, opinions, or reports (including of advertising, marketing, polling, public relations, market research, and public opinion agencies) that concern Applicant's use or contemplated use of the mark MOTOWN METAL.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 8:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 9:**

Documents sufficient to show the number of units distributed and sold of each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 9:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 10:**

Documents sufficient to show the suggested and actual retail price of each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 10:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 11:**

Documents sufficient to show Applicant's annual expenditures for advertising and other promotional materials for each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 11:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks

confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 12:**

Documents sufficient to show Applicant's expenditures by type of media (e.g., television, print) for advertising and other promotional materials for each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 12:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 13:**

All documents that reflect or evidence the creation, selection, and/or adoption of the mark MOTOWN METAL by Applicant, including without limitation all documents in which the selection, creation, and/or adoption of the mark MOTOWN METAL by Applicant, was suggested, discussed, or mentioned.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 13:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence. Subject to and without waiving the foregoing objections, Mattel will produce

documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 14:**

All documents that reflect or evidence the clearance of the mark MOTOWN METAL by Applicant, including without limitation all trademark search reports, investigations, memoranda and correspondence.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 14:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 15:**

All documents that reflect or evidence any alternate marks that were considered by Applicant for use as a trademark or service mark, instead of the MOTOWN METAL mark.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 15:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 16:**

All documents that reflect or evidence any application to register filed by Applicant, or any registration acquired by Applicant in the United States Patent and Trademark Office or in any state or other political subdivision of the United States, that consists of or includes the mark MOTOWN METAL.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 16:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 17:**

All documents that reflect or evidence any claims, demands, or assertions by Applicant that a third party's acts or conduct infringes Applicant's rights, if any, in the mark MOTOWN METAL.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 17:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive documents in its possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 18:**

All consent agreements or co-existence agreements between Applicant and any third parties regarding the use of any trademarks containing the word MOTOWN and all correspondence and other documents relating thereto.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 18:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 19:**

All documents that reflect or evidence use or registration by any third party of any trademark that contains the word MOTOWN, as used for toys, games and playthings, namely toy vehicles and accessories therefore, or related products or services.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 19:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 20:**

All documents that reflect or evidence any alleged instances of actual confusion, mistake or deception involving Applicant's use of the mark MOTOWN METAL and the MOTOWN Marks.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 20:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that no such documents are in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 21:**

All documents that reflect or evidence UMG's use, intended use, or registration of the MOTOWN Marks, other than pleadings filed in this case or correspondence exchanged between Applicant and UMG.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 21:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 22:**

All documents relating to the date that Applicant first became aware or acquired knowledge of UMG's use or intended use of, or registration of, the MOTOWN Marks.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 22:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 23:**

All documents regarding any perceived affiliations or connection between Applicant and UMG, between Applicant's MOTOWN METAL Products and products or services bearing UMG's MOTOWN Marks, or perceived sponsorship between UMG and Applicant, including

without limitation, all documents relating to any misdirected telephone calls, emails, or other communications.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 23:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that no such documents are in its possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 24:**

All documents which constitute, embody, reflect, or refer to any written or oral communications between Applicant and any other person or entity (other than UMG) concerning UMG's use of the MOTOWN Marks.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 24:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive, non-privileged documents in its possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 25:**

All documents that constitute, embody, reflect or refer to any communications that Applicant has had, orally or in writing, with any other person or entity (other than UMG) regarding the use or registration of the mark MOTOWN METAL or variations thereof.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 25:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and

ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive, non-privileged documents in its possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 26:**

All documents which constitute, embody, reflect, or refer to any written or oral communications within Applicant (i.e., between or among employees, agents, and/or representatives thereof) concerning UMG's use of the MOTOWN Marks.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 26:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive, non-privileged documents in its possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 27:**

All documents that constitute, embody, reflect, or refer to any styleguide, rules, regulations, procedures, or internal requirements of Applicant for goods bearing the mark MOTOWN METAL.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 27:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 28:**

All documents that constitute, embody, reflect, or refer to agreements between Applicant and any person or entity concerning goods sold under the mark MOTOWN METAL, including but not limited to all assignments, licenses, and license agreements.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 28:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 29:**

Documents sufficient to identify each outlet, store or website in the United States that sells, offers for sale, promotes, or advertises any of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 29:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 30:**

All documents that reflect or evidence the type of consumer who is intended to buy and use the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 30:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and

ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 31:**

All documents that reflect or evidence the channels of distribution and intended channels of distribution of each of the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 31:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 32:**

All business plans of Applicant for or including the MOTOWN METAL mark.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 32:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 33:**

All documents relating to, supporting, or rebutting Applicant's denial of the allegations contained in UMG's Amended Notice of Opposition.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 33:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 34:**

All documents relating to, supporting, or rebutting the Applicant's affirmative defenses.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 34:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 35:**

All web pages for Applicant's website featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 35:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is unduly burdensome and harassing, and seeks information equally accessible to UMG. Mattel further objects to this request on the grounds that it is overbroad and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 36:**

All documents that reflect or evidence the number of "hits" to Applicant's website featuring the MOTOWN METAL mark or the MOTOWN METAL Products.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 36:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request on the grounds that it is overbroad, seeks confidential business and financial information, and seeks information neither relevant to the claim or defense of any party nor reasonably calculated to lead to the discovery of admissible evidence.

**REQUEST FOR PRODUCTION NO. 37:**

All written reports prepared by, and all exhibits to be used as a summary of or in support of the opinion of, each expert that Applicant expects to call as a witness during its testimony period.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 37:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive, non-privileged documents in its possession, custody, or control at this time.

**REQUEST FOR PRODUCTION NO. 38:**

All documents and things that constitute, embody, reflect or refer to communications between Applicant and any expert(s) that Applicant plans to call during its testimony period, including but not limited to all documents provided by Applicant to any expert(s) that Applicant plans to call during its testimony period.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 38:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive, non-privileged documents in its possession, custody, or control at this time.

**REQUEST FOR PRODUCTION NO. 39:**

All documents that reflect or evidence any pilot surveys, studios, focus groups or other research conducted by any expert(s) retained by Applicant, including but not limited to pilot surveys, completed surveys, all surveys, questionnaires, and instructions.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 39:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel responds that it does not have any responsive, non-privileged documents in its possession, custody, or control.

**REQUEST FOR PRODUCTION NO. 40:**

All documents that each expert retained by Applicant relied upon to form each of his or her opinions.

**RESPONSE TO REQUEST FOR PRODUCTION NO. 40:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without

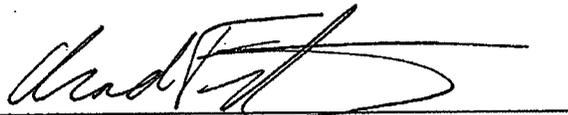
**RESPONSE TO REQUEST FOR PRODUCTION NO. 43:**

Mattel hereby incorporates by reference the Preliminary Statement and General Objections set forth above. Mattel objects to this request on the grounds that it is vague and ambiguous. Mattel further objects to this request to the extent that it seek documents protected by the attorney-client privilege or attorney work product doctrine. Subject to and without waiving the foregoing objections, Mattel will produce documents responsive to this request, to the extent that any exist in Mattel's possession, custody, or control.

DATED: October 9, 2007

KINSELLA WEITZMAN ISER KUMP &  
ALDISERT LLP

By:



Chad R. Fitzgerald  
Attorneys for Mattel, Inc.

**PROOF OF SERVICE**

**STATE OF CALIFORNIA, COUNTY OF LOS ANGELES**

At the time of service, I was over 18 years of age and **not a party to this action**. I am employed in the County of Los Angeles, State of California. My business address is 808 Wilshire Boulevard, 3rd Floor, Santa Monica, California 90401.

On October 9, 2007, I served the following document(s) described as APPLICANT MATTEL, INC.'S RESPONSE TO OPPOSER UMG RECORDINGS, INC.'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS on the interested party in this action as follows:

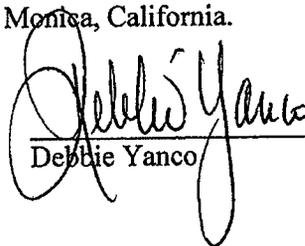
Alexa L. Lewis, Esq.  
Mitchell Silberberg & Knupp LLP  
11377 West Olympic Blvd  
Los Angeles, CA 90064  
Email: all@msk.com

**BY E-MAIL OR ELECTRONIC TRANSMISSION:** Based on a court order or an agreement of the parties to accept service by e-mail or electronic transmission, I caused the document(s) to be sent from e-mail address dyanco@kwikalaw.com to the persons at the e-mail addresses listed in the Service List. I did not receive, within a reasonable time after the transmission, any electronic message or other indication that the transmission was unsuccessful.

**BY MAIL:** I enclosed the document(s) in a sealed envelope or package addressed to the persons at the addresses listed in the Service List and placed the envelope for collection and mailing, following our ordinary business practices. I am readily familiar with Kinsella Weitzman Iser Kump & Aldisert's practice for collecting and processing correspondence for mailing. On the same day that the correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service, in a sealed envelope with postage fully prepaid.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

Executed on October 9, 2007, at Santa Monica, California.

  
\_\_\_\_\_  
Debbie Yanco





Alexa L. Lewis  
Attorney-at-Law  
(310) 312-3209 Phone  
(310) 231-8413 Fax  
all@msk.com

October 31, 2007

VIA FACSIMILE AND U.S. MAIL

Chad R. Fitzgerald, Esq.  
Kinsella, Weitzman, Iser, Kump & Aldisert LLP  
808 Wilshire Boulevard, 3rd Floor  
Santa Monica, CA 90401

Re: UMG Recordings, Inc. v. Mattel, Inc.

Dear Mr. Fitzgerald:

I am writing concerning Mattel Inc.'s responses to UMG Recordings, Inc.'s interrogatories and document requests. We believe that Mattel's responses are inadequate. This is a request to meet and confer to discuss those inadequacies in an attempt to resolve these issues without the TTAB's intervention.

**Interrogatories**

11. This interrogatory asked Mattel to state whether the use of MOTOWN METAL has ever been interrupted, and, if so, explain in detail the reasons for such interruption and specify the terms of each interrupted use. Mattel objected, claiming that this interrogatory was vague and ambiguous. UMG does not understand what could be vague and ambiguous about this interrogatory. Indeed, given Mattel's failure to object to this interrogatory's relevance, Mattel clearly understands this interrogatory goes to UMG's fifth affirmative defense to Mattel's counterclaim -- that, to the extent that Mattel ever possessed any enforceable trademark rights in MOTOWN METAL, Mattel has abandoned such rights.

12. This interrogatory required Mattel to identify the geographic areas in which Applicant has sold MOTOWN METAL Products. Mattel responded that it has sold its products "to retailers worldwide as part of general die cast car assortments." UMG is entitled to know specifically in which states the MOTOWN METAL Products were sold. See J.B. Williams Co., Inc. v. Pepsodent G.m.b.H., 188 U.S.P.Q. 577 (TTAB 1975). Please clarify if Mattel's response is that sales have been made in all 50 states.

13. This interrogatory required Mattel to identify the geographic areas in which Applicant intends to sell MOTOWN METAL Products. Mattel objected, claiming that the

interrogatory was vague, ambiguous, sought irrelevant information, and was unduly burdensome and harassing. This interrogatory is straightforward and seeks limited information that is clearly relevant to, *inter alia*, likelihood of confusion. Mattel should provide this information.

14. This interrogatory asked Mattel to identify the channels of trade and distribution methods used to sell the MOTOWN METAL Products. Mattel asserted meritless objections. This interrogatory is not vague or ambiguous; rather, it is straightforward. It seeks relevant information – indeed, the Board has required parties to describe the manner in which goods are packaged and distributed through channels of trade. See Varian Associates v. Fairfield-Noble Corp., 188 U.S.P.Q. 581 (TTAB 1975). Finally, we do not understand why Mattel claims this interrogatory is unduly burdensome and harassing.

15. This interrogatory requested that Mattel identify the demographic market to which the MOTOWN METAL Products are sold or intended to be sold. The fourth factor considered by the Board in analyzing likelihood of confusion is the “buyers to whom sales are made.” In re E.I. DuPont DeNemours & Co., 476 F.2d 1357 (C.C.P.A. 1973). As such, there is nothing vague and ambiguous, irrelevant, or unduly burdensome or harassing about this interrogatory.

16. This interrogatory asked Mattel to identify the retail price of the MOTOWN METAL Products. Mattel objected. Mattel’s objections are meritless. There is nothing “vague and ambiguous” about the concept of retail price. The retail price of the MOTOWN METAL Products is highly relevant to likelihood of confusion. See Dep v. Opti-Ray, 768 F.Supp. 710 (C.D. Cal. 1991). For example, if the parties’ products are priced similarly, there is a greater likelihood of confusion. Also, the price of the products is relevant to the sophistication of the parties’ customers. Finally, the retail price of Mattel’s own products is hardly “equally accessible” to UMG.

17. This interrogatory required Mattel to state the total number of units sold of the MOTOWN METAL Products to date. Mattel interposed inappropriate objections. There is nothing “vague and ambiguous” about the interrogatory. The information requested is relevant; the Board has repeatedly held that sales figures for goods bearing the mark involved in an opposition proceeding are proper matters for discovery because such information may well have bearing on the issues of registrability and likelihood of confusion. Varian Associates v. Fairfield-Noble Corp., 188 U.S.P.Q. 581 (TTAB 1975); see also Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 U.S.P.Q. 147 (TTAB 1985). Finally, we do not see how the production of a total sales figure could be unduly burdensome or harassing.

18. This interrogatory asked Mattel to state the amount of money it has spent on advertising for the MOTOWN METAL Products on an annual basis. Mattel objected, claiming that this interrogatory was vague, ambiguous, sought irrelevant information, and was unduly burdensome and harassing. Mattel should respond to this interrogatory. It is a straightforward request, and is not vague or ambiguous, or unduly burdensome or harassing. Annual—even quarterly—advertising figures for specific goods bearing the involved mark are relevant and proper matters for discovery in opposition proceedings. Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 U.S.P.Q. 147 (TTAB 1985).

19-24. These interrogatories sought information about Mattel's marketing and advertising of the MOTOWN METAL Products, including its methods of marketing and advertising, whether it has or ever has had any marketing or advertising plans or programs directed toward to any particular groups, the types of advertisements used by Mattel, and the identities of people with personal knowledge regarding the marketing and advertising of the MOTOWN METAL Products. In response to each interrogatory, Mattel objected that it was vague and ambiguous, irrelevant, and unduly burdensome and harassing. Mattel's objections are meritless. These interrogatories are clear on their face. Also, they seek relevant information. The Board has determined that information on advertising and marketing of a product or service under a mark, as well as the identities of people involved with said advertising and marketing, is discoverable. See *J.B. Williams Co., Inc. v. Pepsodent G.m.b.H.*, 188 U.S.P.Q. 577 (TTAB 1975). Finally, we do not understand why Mattel claims these interrogatories are unduly burdensome and harassing.

31-32. These interrogatories ask Mattel to identify surveys, public opinion polls, or any other consumer research concerning the mark MOTOWN METAL, as well as any communications concerning any unfavorable comments, evaluations or information, or any criticism or complaints about the quality of any of the MOTOWN METAL Products. Mattel objected. We fail to understand how these interrogatories are vague or ambiguous. Moreover, they are clearly relevant to likelihood of confusion and dilution. Mattel should amend its responses to identify all nonprivileged information responsive to these interrogatories.

33-34. These interrogatories ask Mattel to identify all licensing and cross-marketing agreements or arrangements between Mattel and third parties relating to the MOTOWN METAL Products. Mattel objected. However, there is nothing vague, ambiguous, unduly burdensome, or harassing about these interrogatories. Moreover, they are clearly calculated to lead to the discovery of admissible evidence.

### **Requests for Production**

As an initial matter, Mattel has not yet produced documents in response to UMG Recording, Inc.'s requests for production. Please do so immediately. To the extent that Mattel objects that its documents are confidential, that objection has been obviated by our agreement that the Board's standard protective order is in place in this opposition.

With respect to individual requests:

1-2. These requests seek the production of representative specimens of each product bearing Mattel's MOTOWN METAL mark and of the different tags, packages, wrappings, labels, stickers, package inserts, instruction manuals, displays, or other means by which Mattel has applied or used the MOTOWN METAL mark on any products. Mattel responded that it would produce documents sufficient to identify each of the MOTOWN METAL Products and their packaging. These responses do not fully comply with UMG's requests, and should be amended.

3, 5-8, 35-36. These requests seek the production of documents in connection with Mattel's advertising of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatories 19-24.

4. This request seeks the production of documents sufficient to show the date on which Mattel first used the MOTOWN METAL mark in commerce in connection with toys, games, and playthings. Mattel responded that it would produce documents "sufficient to show the date on which Mattel first used the MOTOWN METAL mark in commerce." This response does not fully comply with UMG's request, and should be amended.

9. This request seeks the production of documents regarding the number of units distributed and sold of each of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 17.

10. This request seeks the production of documents regarding the retail price of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 16.

11-12. These requests seek the production of documents in connection with Applicant's expenditures for advertising for the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 18.

15. This request asks Mattel to produce all documents that reflect or evidence any alternate marks that were considered by Applicant for use as a trademark or service mark, instead of the MOTOWN METAL mark. Mattel objected. However, there is nothing vague or ambiguous about this request. Moreover, it is clearly calculated to lead to the discovery of admissible evidence.

18, 28. These requests seek the production of agreements between Applicant and third parties concerning the mark MOTOWN METAL. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatories 33-34.

27. This request asks Mattel to produce all documents that constitute, embody, reflect, or refer to any styleguide, rules, regulations, procedures, or internal requirements of Mattel for goods bearing the mark MOTOWN METAL. Mattel objected. However, there is nothing vague or ambiguous about this request. Moreover, it is clearly calculated to lead to the discovery of admissible evidence.

29. This request asks Mattel to produce documents sufficient to identify each outlet, store or website in the United States that sells, offers for sale, promotes, or advertises any of the MOTOWN METAL Products. Mattel objected. However, there is nothing vague or ambiguous about this request. Moreover, it is clearly calculated to lead to the discovery of admissible evidence.

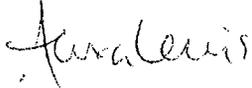
30. This request seeks the production of documents regarding the type of consumer who is intended to buy and use the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 15.

31. This request seeks the channels of distribution of each of the MOTOWN METAL Products. Mattel's objections are meritless for the same reasons discussed above in connection with Interrogatory 14.

32. This request asks Mattel to produce all business plans for or including the MOTOWN METAL mark. Mattel objected. However, there is nothing vague or ambiguous about this request. Moreover, it is clearly calculated to lead to the discovery of admissible evidence.

Please contact me with times you are available to meet to discuss these issues.

Sincerely,



Alexa L. Lewis  
MITCHELL SILBERBERG & KNUPP LLP





Alexa L. Lewis  
Attorney-at-Law  
(310) 312-3209 Phone  
(310) 231-8413 Fax  
all@msk.com

February 13, 2008

VIA FACSIMILE AND U.S. MAIL

Chad R. Fitzgerald, Esq.  
Kinsella, Weitzman, Iser, Kump & Aldisert LLP  
808 Wilshire Boulevard, 3rd Floor  
Santa Monica, CA 90401

Re: UMG Recordings, Inc. v. Mattel, Inc.

Dear Chad:

This letter follows up on our discovery conference on January 17, 2008, in which you agreed to supplement Mattel's responses to the interrogatories and document requests cited in my October 31, 2007 letter. We have not received Mattel's supplemental responses. As you know, there are upcoming deadlines in this Opposition, including the discovery deposition cutoff of February 29, 2008, and the subsequent opening of UMG's testimony period. In order to complete our review of Mattel's supplemental responses in advance of those deadlines, we require receipt of those responses by February 18, 2008.

In our telephone conversation yesterday, you indicated that Mattel is unable to identify the number of units sold of the MOTOWN METAL products, as requested in UMG's Interrogatory No. 17 and Request for Production 9, because all Hot Wheels cars are sold in assorted lots of one hundred Hot Wheels each, and Mattel does not track which cars are placed in individual boxes. If Mattel cannot determine how many MOTOWN METAL products it has sold in this manner, surely it has some other method of inventory control by which it can determine the number of units sold – such as manufacturing numbers, universal product code scans, or the like. Please include this information in Mattel's supplemental responses.

Sincerely,

Alexa L. Lewis  
MITCHELL SILBERBERG & KNUPP LLP



**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

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UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

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**STIPULATED MOTION TO EXTEND TESTIMONY AND TRIAL DATES**

Pursuant to TBMP § 501, Applicant Mattel, Inc. ("Mattel"), by its counsel, and Opposer, UMG Recordings, Inc. ("Opposer" or "UMG"), by its counsel, hereby amend their joint motion and stipulation to an extension of 90 days of the schedule set in this action. The parties are currently engaged in settlement negotiations and therefore desire to extend the schedule set in this action as set forth below.

<u>PERIOD</u>	<u>DATE</u>
Period for discovery to close:	Closed (except with regard to discovery depositions)
30-day testimony period for party in position of plaintiff in the opposition to close:	June 30, 2008
30-day testimony period for party in position of defendant in the opposition and plaintiff in the counterclaim to close:	August 29, 2008
30-day rebuttal testimony period for plaintiff in the opposition and defendant in the counterclaim to close:	October 28, 2008
15-day rebuttal testimony period for plaintiff in the counterclaim to close:	December 12, 2008

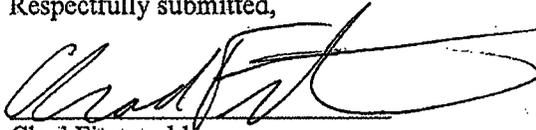
Briefs shall be due as follows:

Brief for plaintiff in the opposition shall be due:	February 10, 2009
Brief for defendant in the opposition and plaintiff in the counterclaim shall be due:	March 12, 2009
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff in the opposition shall be due:	April 13, 2009
Reply brief, if any, for plaintiff in the counterclaim shall be due:	April 27, 2009

This Stipulated Motion to Extend Testimony and Trial Dates is being submitted in triplicate.

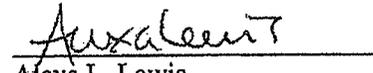
Respectfully submitted,

Date: February 26, 2008



Chad Fitzgerald  
KINSELLA, WEITZMAN, ISER, KUMP &  
ALDISERT, LLP  
808 Wilshire Boulevard, 3rd Floor  
Santa Monica, CA 90401  
(310) 566-9800  
Attorneys for Applicant  
Mattel, Inc.

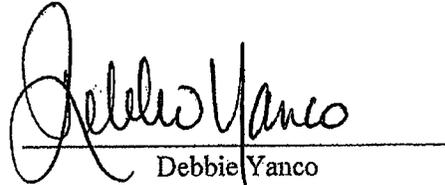
Date: February 26, 2008



Alexa L. Lewis  
MITCHELL SILBERBERG & KNUPP LLP  
11377 West Olympic Boulevard  
Los Angeles, California 90064  
(310) 312-2000  
Attorneys for Opposer  
UMG Recordings, Inc.

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service, postage prepaid, addressed to: Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451, on this 26 th day of February, 2008.



Debbie Yanco



**RECEIVED**

DEC 10 2007

Mitchell, Silberberg & Knupp LLP

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

2007

Mailed: December 5,

Opposition No. **91176791**

UMG RECORDINGS, INC.

v.

MATTEL, INC.

***Rochelle Ricks, Paralegal Specialist:***

Parties' stipulated motion filed November 26, 2007 to extend testimony and trial dates is noted and granted as indicated below.

In view thereof, (since the parties failed to include the counterclaim dates), the trial dates including all counterclaim dates are reset as modified below:<sup>1</sup>

The period for discovery to close: **CLOSED**

30-day testimony period for party in position of plaintiff in the opposition to close: **April 1, 2008**

30-day testimony period for party in position of defendant in the opposition and plaintiff in the counterclaim to close: **May 31, 2008**

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<sup>1</sup> However, in the future, the parties' consented/stipulated motions to extend discovery and/or testimony periods should include the parties counterclaim dates and comply with the requirement of Trademark Rule 2.121(d).

30-day rebuttal testimony period  
for plaintiff in the opposition and  
defendant in the counterclaim  
to close:

July 30, 2008

15-day rebuttal testimony period for  
plaintiff in the counterclaim to  
close:

September 13, 2008

**Briefs shall be due as follows:  
[See Trademark Rule 2.128(a)(2)].**

Brief for plaintiff in the  
opposition shall be due:

November 12, 2008

Brief for defendant in the  
opposition and plaintiff in  
the counterclaim shall be due:

December 12, 2008

Brief for defendant in the  
counterclaim and reply brief,  
if any, for plaintiff in the  
opposition shall be due:

January 11, 2009

Reply brief, if any, for  
plaintiff in the counterclaim  
shall be due:

January 26, 2009

If the parties stipulate to any extension of these dates,  
the filing should set forth the dates in the format shown in  
this order. See Trademark Rule 2.121(d).

An oral hearing will be set only upon request filed as  
provided by Trademark Rule 2.129.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the  
Federal Register on August 1, 2007, at 72 F.R. 42242. By  
this notice, various rules governing Trademark Trial and

Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>