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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

AMENDED NOTICE OF OPPOSITION

UMG Recordings, Inc., ("Opposer" or "UMG"), a Delaware corporation having its principal place of business in Santa Monica, California, believes it would be damaged by the registration of the mark MOTOWN METAL as shown in Application Serial No. 78/751,105 filed by Mattel, Inc. ("Applicant") and hereby opposes same.

As grounds for this opposition it is alleged:

1. On or before November 10, 2005, Applicant filed an intent-to-use application with the United States Patent & Trademark Office to register the mark

05-29-2007
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

MOTOWN METAL for toys, games and playthings, namely, toy vehicles and accessories therefor, in International Class 28 ("the Application").

2. On January 10, 2007, UMG requested a 90-day extension of time to oppose the Application, which was granted by the PTO. UMG was therefore given until April 11, 2007 to oppose the Application.

3. UMG filed its Notice of Opposition on April 11, 2007. Applicant's Answer is due May 29, 2007.

4. UMG is the owner of various United States Registrations and Applications for the marks MOTOWN and MOTOWN and Design, *inter alia*, as shown on Attachment A, which is specifically incorporated herein. In addition, UMG is the owner of common law rights for the marks MOTOWN and MOTOWN and Design, *inter alia*, as shown on Attachment B, which is specifically incorporated herein.

5. UMG has been using the marks MOTOWN and MOTOWN and Design for, *inter alia*, the goods and services as shown on Attachment A, since at least as early as 1960. As such, UMG has for many years been engaged in the manufacture, sale and provision of the goods and services in connection with the marks MOTOWN and MOTOWN and Design prior to the filing of the Application.

6. The Application was filed on November 10, 2005. The dates of filing or first use of Opposer's marks MOTOWN and MOTOWN and Design predate November 10, 2005. Therefore, Opposer's use precedes any use by Applicant.

7. Prior to Applicant's filing of the application for the mark MOTOWN METAL and/or any alleged use of said mark, UMG has made substantial and continuous use of the MOTOWN and MOTOWN and Design marks in interstate commerce on and in connection with the advertising, promotion, and sale of many types of goods and services, including those shown on Attachments A and B, specifically, in connection with toys, games, and playthings.

8. By virtue of aforesaid advertising, promotion and sales, UMG's MOTOWN and MOTOWN and Design trademarks have come to represent valuable good will owned by UMG.

9. The goods and services on which UMG uses its MOTOWN and MOTOWN and Design trademarks, and the goods on which Applicant intends to use the MOTOWN METAL mark are related and are sold through the same channels of trade and to the same class of purchasers.

10. Furthermore, UMG's marks MOTOWN and MOTOWN and Design and Applicant's mark MOTOWN METAL are highly similar.

11. Use by Applicant of the mark MOTOWN METAL will be likely to cause confusion, mistake, or deception with UMG's aforesaid MOTOWN and MOTOWN and Design trademarks and result in the belief that Applicant or its goods are in some way legitimately connected with, sponsored by, or approved by UMG.

12. UMG's marks MOTOWN and MOTOWN and Design are famous. Use by Applicant of the mark MOTOWN METAL will dilute the distinctive quality of UMG's famous marks.

13. Any use Applicant has made or may make of the mark MOTOWN METAL is and will be without UMG's consent or permission.

14. For the reasons stated above, UMG would be damaged by the registration of the mark shown in the Application, in that, *inter alia*, such registration would give Applicant a prima facie exclusive right to the use of MOTOWN METAL, despite the likelihood of confusion, mistake, or deception and dilution described above.

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

Please charge any fees or credit overpayment in connection herewith to Deposit Account No. 13-3735.

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

This request is being submitted in triplicate as required by 37.C.F.R.§ 2.102(d).

Respectfully submitted,

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

Date of Deposit: May 25, 2007

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

(Signature)

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the county of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is Mitchell Silberberg & Knupp LLP, 11377 West Olympic Boulevard, Los Angeles, California 90064-1683.

On May 25, 2007, I served a copy of the foregoing document(s) described as **AMENDED NOTICE OF OPPOSITION (RE: OPPOSITION NO. 91176791)** on the interested parties in this action at their last known address as set forth below by taking the action described below:

Michael Moore
Mattel, Inc.
M1-1518
333 Continental Boulevard
El Segundo, CA 90245

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.

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

Executed on May 25, 2007, at Los Angeles, California.

Kimberly L. Stewart

ATTACHMENT A				
Mark	**Application Number**	**Registration Number**	**Date of First Use in Commerce or Date Intent-To-Use Application Filed**	**Goods and Services:**
motown	78/617356		Intent to use application filed on April 26, 2005	Production and distribution of television and radio programs; production, distribution and publishing of music; fan clubs; development and dissemination of educational material of others in the field of music and entertainment; radio entertainment production and distribution; audio recording production; record production; videotape production; television program syndication; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media; publication of books and magazines; entertainment in the nature of ongoing radio programs in the field of music and entertainment; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely personal appearances by musical groups, musical artists and celebrities; educational and entertainment

Mark	Application Number	Registration Number	Date of First Use in Commerce	Goods & Services:
				services, namely, production and presentation of television shows, sports events, fashion shows, game shows, music shows, award shows and comedy shows before live audiences which are all broadcast live or taped for later broadcast; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer; discotheques; operating of a discotheque; nightclubs; art exhibitions; conducting entertainment exhibitions in the nature of music festivals. organizing exhibitions for the promotion of music and the arts; and publishing of web magazines.

Mark	Application Number	Registration Number	Date of First Use in Commerce	Goods & Services:
motown	78/617352		Intent to use application filed on April 26, 2005	Pre-recorded audio tapes, discs and cassettes, video tapes, discs and cassettes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical and musical sound and video recordings; virtual reality game software; downloadable ring tones, music, mp3s, graphics, games, images and videos for wireless communication devices; computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges, cassettes, joysticks and remote control units; and computer mouse pads
MOTOWN		1075409	1964	Records, tapes, cassettes, cartridges and audio video reproducing devices in the form of tapes, cassettes, disks, cartridges.

Mark	Application Number	Registration Number	Date of First Use in Commerce	Goods & Services:
MOTOWN		2663608	1968	Printed Matter, namely, booklets, books, brochures, magazines, programs and pamphlets in the fields of music and entertainment, mounted and unmounted photographs, sheet music, calendars, pictures, playing cards.
MOTOWN		2767101	1999	Restaurant services
MOTOWN		0881471	1966	Providing popular musical entertainment
MOTOWN	78/614904		Intent to use application filed on April 22, 2005	Production and distribution of television and radio programs; production, distribution and publishing of music; fan clubs; development and dissemination of educational material of others in the field of music and entertainment; radio entertainment production and distribution; audio recording production; record production; videotape production; television program syndication; entertainment in the nature of ongoing television programs in the field of music and entertainment; entertainment, namely a continuing music and entertainment show distributed over television, satellite, audio, and video media; publication of books and magazines; entertainment in the nature of ongoing radio programs in the field of music and entertainment; entertainment in the nature of live concerts and performances by musical artists and groups; entertainment services, namely personal appearances by

Mark	Application Number	Registration Number	Date of First Use in Commerce	Goods & Services:
				musical groups, musical artists and celebrities; educational and entertainment services, namely, production and presentation of television shows, sports events, fashion shows, game shows, music shows, award shows and comedy shows before live audiences which are all broadcast live or taped for later broadcast; entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; entertainment services, namely, providing on-line reviews of music, musical artists and music videos; entertainment services, namely, providing prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; entertainment services namely live, televised and movie appearances by a professional entertainer; discotheques; operating of a discotheque; nightclubs; art exhibitions; conducting entertainment exhibitions in the nature of music festivals. organizing exhibitions for the promotion of music and the arts; and publishing of web magazines
MOTOWN	78/614895		Intent to use application filed on April 22, 2005	Pre-recorded audio tapes, discs and cassettes, video tapes, discs and cassettes, digital audio and audio video tapes and discs, CDs, DVDs, laser discs, and phonograph records featuring music and entertainment; theatrical and musical sound and video recordings; virtual

Mark	Application Number	Registration Number	Date of First Use in Commerce	Goods & Services:
				reality game software; downloadable ring tones, music, mp3s, graphics, games, images and videos for wireless communication devices; computer and video game equipment containing memory devices, namely, computer and video game software, tapes, cartridges, cassettes, joysticks and remote control units; and computer mouse pads
		0985976	1960	Photograph records, tapes and cassettes
		0985972	1960	Photograph records; tapes and cassettes

Mark	Application Number	Registration Number	Date of First Use in Commerce	Goods & Services:
MOTOWN MASTER SERIES		2516930	1993	Musical sound recordings
MOTOWN MUSIC REVIEW		3073897	2005	Retail gift store featuring music, clothing, reading material and souvenirs.

ATTACHMENT B	
Mark	**Goods and Services**
MOTOWN	Toys, games and playthings, namely, board games
MOTOWN	Toys, games and playthings, namely, board games
MOTOWN	Toys, games and playthings, namely, karaoke
MOTOWN	Toys, games and playthings, namely, karaoke