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

Proceeding	91176791
Party	Defendant MATTEL, INC. MATTEL, INC. M1-1518, 333 CONTINENTAL BLVD. EL SEGUNDO, CA 902455012
Correspondence Address	Lawrence Y. Iser, Esq. Kinsella Weitzman Iser Kump & Aldisert LLP 808 Wilshire Blvd., Suite 300 Santa Monica, CA 90401 UNITED STATES liser@kwiklaw.com
Submission	Answer and Counterclaim
Filer's Name	Lawrence Y. Iser
Filer's e-mail	liser@puremedspa.com
Signature	/lawrenceiser/
Date	07/05/2007
Attachments	answer2.pdf ( 9 pages )(455802 bytes )

Registration Subject to Cancellation

Registration No	3073897	Registration date	03/28/2006
Registrant	UMG Recordings, Inc. 2220 Colorado Avenue Santa Monica, CA 90404 UNITED STATES		
Goods/Services Subject to Cancellation	Class 035. First Use: 2005/07/23 , First Use In Commerce: 2005/07/23 Goods/Services: RETAIL GIFT STORE FEATURING MUSIC, CLOTHING, READING MATERIALS AND SOUVENIRS		

**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.:

Opposer

v.

MATTEL, INC.,

Applicant

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**MATTEL, INC.'S ANSWER TO AMENDED OPPOSITION; COUNTERCLAIM TO  
CANCEL AND/OR LIMIT TRADEMARK REGISTRATIONS**

Applicant Mattel, Inc. ("Mattel"), a Delaware corporation which maintains its principal place of business at 333 Continental Blvd., El Segundo, California 90245, hereby answers the Amended Opposition to Mattel's application to register the mark MOTOWN METAL, Application Serial No. 78/751,105, filed by opposer UMG Recordings, Inc. ("UMG") as follows:

1. Answering paragraph 1 of UMG's Amended Opposition, Mattel admits that, on or about November 10, 2005, Mattel filed an intent-to-use application with the United States Patent & Trademark Office to register the mark MOTOWN METAL for toys, games and playthings, in

International Class 28 (the "Application"). Mattel further avers that the contents of its Application are as set forth in the document and not otherwise.

2. Mattel lacks sufficient information or belief to admit or deny the allegations of paragraph 2 of the Amended Opposition, and therefore denies such allegations for lack of information and belief.

3. Mattel lacks sufficient information or belief to admit or deny the allegations of paragraph 3 of the Amended Opposition, and therefore denies such allegations for lack of information and belief.

4. Mattel lacks sufficient information or belief to admit or deny the allegations of paragraph 4 of the Amended Opposition and therefore denies such allegations for lack of information and belief.

5. Mattel is informed and believes, and based thereon alleges that UMG has never used the marks MOTOWN and/or MOTOWN and Design in commerce for goods and services in International Class 28 and has never engaged in the manufacture or sale of toys, games and playthings using the marks MOTOWN and/or MOTOWN and Design. Except as so alleged, Mattel denies the allegations of paragraph 5 of the Amended Opposition for lack of information and belief.

6. Mattel is informed and believes, and based thereon alleges that UMG has never engaged in the manufacture or sale of toys, games and playthings using the marks MOTOWN and/or MOTOWN and Design, and that, consequently, UMG's alleged use of said marks in connection with such goods and services does not predate Mattel's use of MOTOWN METAL. Except as so alleged, Mattel denies the allegations of paragraph 6 of the Amended Opposition for lack of information and belief.

7. Answering paragraph 7, Mattel denies that UMG has used the marks MOTOWN and/or MOTOWN and Design for goods and services in International Class 28 or in connection with the advertising, promotion or sale of toys, games and playthings. Mattel denies the remaining allegations of paragraph 7 for lack of information and belief.

8. Answering paragraph 8, Mattel denies that UMG has used the marks MOTOWN and MOTOWN and Design in connection with the advertising, promotion or sale of toys, games and playthings. Mattel denies the remaining allegations of paragraph 8 for lack of information and belief.

9. Mattel denies the allegations of paragraph 9 of the Amended Opposition.

10. Mattel denies the allegations of paragraph 10 of the Amended Opposition.

11. Mattel denies the allegations of paragraph 11 of the Amended Opposition.

12. Mattel denies the allegations of paragraph 12 of the Amended Opposition.

13. Answering paragraph 13 of the Amended Opposition, Mattel admits that it did not seek or obtain permission from UMG to use the mark MOTOWN METAL. Mattel denies that UMG's permission or consent is required for Mattel's prior use of the mark MOTOWN METAL in connection with toys, games and playthings, including specifically toy vehicles and accessories.

14. Mattel denies the allegations of paragraph 14 of the Amended Opposition.

15. Responding to UMG's prayer for relief, Mattel alleges that UMG's Amended Opposition is without foundation in law or fact and that it should be denied in its entirety. Mattel further alleges that registration of the mark MOTOWN METAL as requested in the Application is appropriate and that registration should not be refused.

### **FIRST AFFIRMATIVE DEFENSE**

16. As a First Affirmative Defense to the Amended Opposition, Mattel alleges that there is no likelihood of confusion as a matter of law between Mattel's use of the mark MOTOWN METAL and UMG's use of the mark MOTOWN. Mattel does not use the word "MOTOWN" except as part of the phrase "MOTOWN METAL" in connection with miniature HOT WHEELS® die cast cars based on well-known automobiles associated with Detroit, Michigan, which city is also referred to by the well-known nick-names "Motown" and "Motor City." Mattel's HOT WHEELS® mark is well known in the minds of consumers as being associated with Mattel. The strength of Mattel's Hot Wheels™ mark precludes any likelihood that consumers would associate Mattel's MOTOWN METAL Hot Wheels cars with UMG.

17. Mattel is informed and believes that UMG's business is exclusively that of a record company. Mattel is further informed and believes that UMG has never engaged in the manufacture or distribution of any toys, games or playthings in International Class 28, including but not limited to die cast cars. Mattel is further informed and believes that UMG has not actually used the MOTOWN mark in commerce for "video game software, tapes, cartridges, cassettes, [or] joysticks" as set forth in Exhibit A to the Amended Opposition, but merely filed intent to use applications in April 2005. Mattel is informed and believes, and based thereon alleges, that UMG's intent to use applications were filed for use only in International Class 9, and not International Class 28.

18. Because Mattel's MOTOWN METAL HOT WHEELS® cars are unrelated to UMG's goods and services, there is no likelihood of consumer confusion between Mattel's use of the mark MOTOWN METAL and UMG's use of the marks MOTOWN or MOTOWN and Design.

## SECOND AFFIRMATIVE DEFENSE

19. As a Second Affirmative Defense to the Amended Opposition, Mattel alleges that there is no likelihood that Mattel's use of the mark MOTOWN METAL will dilute the distinctive quality (if any) of UMG's mark MOTOWN. Mattel does not use the word "MOTOWN" except as part of the phrase "MOTOWN METAL" in connection with miniature HOT WHEELS® die cast cars based on well-known automobiles associated with Detroit, Michigan, which city is also referred to by the well-known nick-names "Motown" and "Motor City." Mattel's HOT WHEELS® mark is well known in the minds of consumers as being associated with Mattel. Mattel did not intend to create any association with UMG's marks through the use of its MOTOWN METAL mark.

20. Mattel is informed and believes that UMG's business is exclusively that of a record company. Mattel is further informed and believes that UMG has never engaged in the manufacture or distribution of any toys, games or playthings in International Class 28, including but not limited to die cast cars. Mattel is informed and believes that UMG has not actually used the MOTOWN mark in commerce for "video game software, tapes, cartridges, cassettes, [or] joysticks" as set forth in Attachment A to the Amended Opposition, but merely filed intent to use applications in April 2005. Mattel is informed and believes, and based thereon alleges, that UMG's intent to use applications were filed for use only in International Class 9, and not International Class 28.

21. Because Mattel's use of its mark MOTOWN METAL will not diminish the identification value (if any) of UMG's marks, there is no likelihood that Mattel's mark will dilute UMG's marks.

### **THIRD AFFIRMATIVE DEFENSE**

22. "Motown" is a well-known nickname for the City of Detroit, Michigan, and refers to that city's position as the center of the automobile industry in the United States. Numerous dictionaries and other sources identify the primary definition of the word "Motown" as the nickname for Detroit, Michigan. Accordingly, the word "Motown" is a generic geographic description and thus is entitled, at best, to extremely limited protection as a trademark. Mattel has an equal right to use the word "Motown" as part of the mark MOTOWN METAL in connection with the sale of HOT WHEELS® cars.

23. Mattel is informed and believes that several companies use the word "Motown" as part of their trademarks or service marks and that UMG has not objected to the use of these marks, or otherwise asserted it has the exclusive right to use the word "Motown" as a trademark or service mark. A recent TESS search revealed that the mark MOTOWN MISSILE has been registered for toy vehicles and sports-related entertainment, and that "Motown" has been used in commerce for automotive engine castings, financial services and a "Motown USA" Harley-Davidson store in Michigan.

### **FOURTH AFFIRMATIVE DEFENSE**

24. Mattel is informed and believes, and based thereon alleges that UMG has not registered the marks MOTOWN and/or MOTOWN and Design for "toys, games and playthings, namely, toy vehicles and accessories therefor," in Class 28, the class in which Mattel seeks to register MOTOWN METAL. Mattel is further informed and believes that UMG has no "common law" rights for its marks MOTOWN and/or MOTOWN and Design in Class 28.

### **FIFTH AFFIRMATIVE DEFENSE**

25. Mattel is informed and believes, and based thereon alleges, that UMG has unclean hands and acted in bad faith in filing the Amended Opposition.

**COUNTERCLAIM TO CANCEL AND/OR LIMIT UMG'S REGISTRATIONS TO THE  
EXTENT THEY APPLY TO TOYS, GAMES AND PLAYTHINGS**

26. Mattel hereby incorporates by reference paragraphs 17 and 22-24 of this Answer and Counterclaim as though set forth in full hereat.

27. Mattel is informed and believes, and based thereon alleges, that UMG has never used the marks MOTOWN and/or MOTOWN and Design in International Class 28, "toys, games and playthings, namely, toy vehicles and accessories therefor"; nor has UMG used such marks in commerce in connection with motor vehicles of any kind.

28. Mattel is informed and believes, and based thereon alleges, that UMG does not have a valid registration for the marks MOTOWN and/or MOTOWN and Design in International Class 28, has not filed an intent to use application for such marks in Class 28, and does not have common law rights to use such marks in connection with Class 28. To the extent UMG has valid registrations for the marks MOTOWN and/or MOTOWN and Design in International Class 28 (which Mattel denies), a finding of likelihood of consumer confusion (if any) will be avoided by entry of a limitation and/or restriction on UMG's MOTOWN and MOTOWN and Design marks to preclude use in connection with any type of toy vehicles or accessories.

WHEREFORE, Mattel requests that UMG's registrations for the marks MOTOWN and/or MOTOWN and Design in International Class 28 (if any) be partially cancelled and/or limited to exclude application to toys, games and playthings, namely, toy vehicles and accessories therefor.

Please address all correspondence to Lawrence Y. Iser, Esq., Kinsella Weitzman Iser  
Kump & Aldisert LLP, 808 Wilshire Blvd., Suite 300, Santa Monica, California 90401.

DATED: July 5, 2007

KINSELLA WEITZMAN ISER KUMP &  
ALDISERT LLP

By:  (LF)  
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Lawrence Y. Iser  
Attorneys for Mattel, Inc.

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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.

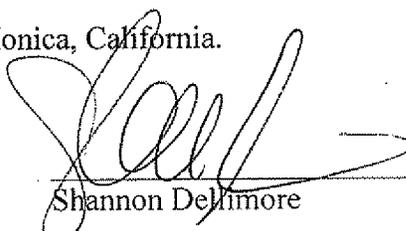
On July 5, 2007, I served the following document(s) described as **MATTEL, INC.'S ANSWER TO OPPOSITION; COUNTERCLAIM TO CANCEL AND/OR LIMIT TRADEMARK REGISTRATIONS** on the interested parties in this action as follows:

**Jeffrey D. Goldman, Esq.**  
**Mitchell Silberberg & Knupp, LLP**  
**11377 W. Olympic Boulevard**  
**Los Angeles, CA 90064**

**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 July 5, 2007, at Santa Monica, California.

  
Shannon DeJimore