

ESTTA Tracking number: **ESTTA66659**

Filing date: **02/15/2006**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Nextel Communications, Inc.
Granted to Date of previous extension	02/15/2006
Address	2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES

Correspondence information	David C. Gryce Arent Fox PLLC 1050 Connecticut Avenue NW Washington, DC 20036 UNITED STATES gryce.david@arentfox.com, modzeleski.david@arentfox.com Phone:202-857-6000
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Applicant Information

Application No	78346217	Publication date	10/18/2005
Opposition Filing Date	02/15/2006	Opposition Period Ends	02/15/2006
Applicant	Orbyx Electronics, a division of InterTAN Canada Ltd. 279 Bayview Drive Barrie, Ontario, L4M 2W5 CANADA		

Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and services in the class are opposed, namely: Pocket AM and AM/FM radios, portable AM and AM/FM headset radios, stereomates, water-resistant AM/FM radio, portable and multi-band radios, novelty radios, clock and table radios, AM/FM and CD clock radios, weather radios, FRS (family radio services) 2-way hand-held radios, FRS accessories, namely chargers, electrical and power cables, carrying cases, for radios and radio chargers, radio belt-clips, electrical and power cables, walkie-talkie radios; portable audio units namely MP3 (mini-disc) players, digital recorders, tape cassette recorders and players, micro-cassette recorders and players, mini-disc players and recorders, AM/FM tape players, AM and AM/FM/cassette/CD portable players, cassette tape decks, CD players; digital storage containers in the nature of CD organizers that clip to car visors, nylon wallet CD holders with zippers for CD media, CD-R/CD-RW media, DVD-R/DVD+R media, CD/CD Rom cleaning kits comprised of head cleaning fluids, chamois cloths and swabs; automotive audio systems comprised of AM/FM/cassette players, automotive CD units, boosters/equalizers/cassette players, automotive speakers, automotive antennas, electrical and power cables; micro audio systems comprised of automotive raw speakers and replacement parts for speakers; full size audio component stereo systems; stereo systems, home theatre speaker systems, audio receivers, DVD players, AM/FM stereos, portable DVD players, AM/FM receivers, equalizers, public address systems, karaoke machines, electrical and power cables and connectors, sound mixers and</p>

reverberators, amplifiers, digital video recorders, combination TV/VCR's, combination DVD/VCR's, home televisions, portable televisions, LCD (liquid crystal display) televisions, VCR players, home theatre systems in a box, namely, speakers, receivers, radios, home theatre systems, namely, speakers, receivers, DVD players, radios, compact disc player home systems equipment, namely intercom system with the addition of a AM/FM radio, music media turntables, AM/FM intercom systems equipment, namely, speakers, receivers, radios, audio and video accessories namely, video, electrical and power cables and connectors, video amplifiers, splitters and switches, A/V S-video selectors, remote control units for all audio and audio/video equipment, universal remote controllers, RF modulators, audio and video electrical and power cables and connectors, electrical and power analog and digital multi-testers, electrical and power cables, blank video tapes, video storage cabinets, speakers namely, book shelf speakers, floor standing speakers, wireless speakers, subwoofers, raw speakers and replacement parts namely, power cables and wiring, for home speakers multi-media speakers; cameras, namely, digital cameras, compact digital cameras, camcorders, 35mm cameras, camera tripods, web and internet cameras; camera accessories, namely, battery checkers, power supplies, camcorder tapes, digital film, audio tapes, digital and video camera carrying cases, camera bags, USB card readers, electrical and power cables, connectors, optical component electrical and power cables, adapter plugs; PDA's (personal digital assistants), PDA software, PDA accessories namely, protective case covers, upgrade memory cards, cradle recharging units, plastic and metal stylus, adapters; audio accessories, namely, wireless microphones, wireless headphones, full size headphones, microphones, compact headphones, earbud headphones, headsets, personal computer microphones; personal computer, laptop computers, LCD (liquid crystal display) monitors, computer monitors, computer keyboards both wired and wireless, computer game pads, computer joysticks, computer controllers, namely, steering wheels, flight yokes, computer mice both wired and wireless, computer components, namely, optical drives, ROMs, adapters, network cables, computer wrist-rests, computer speakers, computer rams, optical drives, computer connection cables and adapters, networking cables, connectors, inkjet printers, inkjet photo printers, laser printers, laser photo printers, inkjet all-in-one print center comprised of printer, page scanner and copier combination unit; computer document scanners, digital memory storage devices, portable USB drives, digital USB storage devices in the nature of digital media card readers, digital media cards, computer upgrade cards, media storage namely, CD holders, DVD holders, cassette holders; telephones, namely, standard telephones, multi-line telephones, feature telephones, wireless telephones, fashion telephones, cordless telephones, magnetically encoded calling cards, magnetically encoded long distance calling cards, micro tape telephone answering devices, telephone auto dialer/amplifier, digital telephone answering machines, digital telephone answering machines with telephone, telephone answering device with cordless telephone, telephone accessories, namely electrical cords, extension cords, adaptors, plugs, speakerphones, over-the-ear telephone headsets, hands free mini telephones, wireless modem/telephone jacks, telephone ID electronic module; electronic door chimes, wireless electronic door chimes, electronic voice memo pads, electronic digital recording pens; automobile accessories, namely, tire pressure gauges, car compasses, electronic lock de-icers, electronic key finders, compasses; metal detectors, pro-metal detectors, portable metal detectors, thermometers, indoor/outdoor thermometers, wireless thermometers, talking thermometers, magnifying glasses, folding magnifiers, dual lens magnifiers, binoculars, optical binoculars, folding binoculars, night vision scope, microscopes, laser pointers, laser pointer pens; golf telescopes, electronic digital golf caddies, battery checkers; hand-held and desk type electronic calculators, printing calculators, scientific calculators, electronic language translators, electronic spell checkers, electronic pocket interpreters, electronic French translators, electronic dictionaries, electronic thesaurus, electronic diaries, electronic crosswords games, electronic organizers

Attachments	nexxtech.pdf (9 pages)
Signature	/David S Modzeleski/
Name	David S. Modzeleski
Date	02/15/2006

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

In re Application No. 78/346,217 for the mark NEXXTECH filed on December 29, 2003 and published on October 18, 2005.

Nextel Communications, Inc.	:	
	:	
Opposer,	:	Opposition No. _____
	:	
v.	:	
	:	
Orbyx Electronics, a division of InterTAN	:	
Canada Ltd.	:	
	:	
Applicant.	:	

BOX TTAB FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313

NOTICE OF OPPOSITION

Nextel Communications, Inc. (“Nextel”), a Delaware Corporation, believes that it will be damaged by the registration of the mark NEXXTECH, the subject of Application Serial No. 78/346,217, filed by Orbyx Electronics, a division of InterTAN Canada Ltd. (“Orbyx Electronics”), a Canadian Corporation. Nextel hereby opposes registration of the mark for the goods identified in International Class 9 (“Class 9”) under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Nextel alleges as follows:

1. Nextel has used the mark NEXTEL with goods and services related to the telecommunications industry since at least as early as 1988.
2. Nextel owns several federal trademark registrations for marks containing the term NEXTEL (collectively, the “NEXTEL Marks”), including the following:

NEXTEL (cls. 9)	Reg. No. 1,884,244
NEXTEL (cls. 38)	Reg. No. 1,637,139
NEXTEL & Design (cls. 9 & 38)	Reg. No. 2,391,504
NEXTEL WORLDWIDE (cls. 9 & 38)	Reg. No. 2,598,210
NEXTEL COMPATIBLE (cls. 38)	Reg. No. 2,751,945
NEXTEL NATIONAL PLANS (cls. 38)	Reg. No. 2,692,446
NEXTEL DIRECT CONNECT. GET RIGHT THROUGH. (cls. 9, 38)	Reg. No. 2,765,052
NEXTEL MOBILE EXTENSION (cls. 38)	Reg. No. 2,737,925
NEXTEL HOW BUSINESS GETS DONE INSTANTLY (cls. 38)	Reg. No. 2,764,617
NEXTEL. HOW BUSINESS GETS DONE. (cls. 38)	Reg. No. 2,435,925
NEXTEL ONLINE (cls. 38)	Reg. No. 2,430,370
NEXTEL NATIONAL BUSINESS PLAN (cls. 38)	Reg. No. 2,326,015
NEXTEL NEXTDAY (cls. 39)	Reg. No. 2,306,603
NEXTEL BUSINESS NETWORKS (cls. 38)	Reg. No. 2,359,176
NEXTEL LONG DISTANCE (cls. 38)	Reg. No. 2,251,278
NEXTEL DIRECT CONNECT (cls. 38)	Reg. No. 2,236,098

3. Nextel's federal registrations listed in Paragraph 2 are valid and subsisting, and they provide *prima facie* evidence of Nextel's registration of the NEXTEL Marks, Nextel's ownership of the NEXTEL Marks, and of Nextel's exclusive right to use the NEXTEL Marks in commerce on or in connection with the goods and/or services specified in the registrations.

4. Nextel's federal registrations for the marks NEXTEL (Reg. No. 1,884,244), NEXTEL (Reg. No. 1,637,139), and NEXTEL DIRECT CONNECT (Reg. No. 2,236,098) are incontestable and provide *conclusive* evidence of Nextel's registration of these marks, Nextel's ownership of the marks, and of Nextel's exclusive right to use the marks in commerce on or in connection with the goods or services specified in the registrations.

5. Nextel used, and acquired trademark rights in, the NEXTEL Marks before December 29, 2003, the date on which Orbyx Electronics filed its application to register NEXXTECH.

6. Nextel has expended substantial sums in marketing, advertising, and promoting the NEXTEL Marks in connection with its telecommunications goods and services throughout the United States.

7. Nextel has enjoyed substantial revenue derived from the sale of telecommunications goods and services under the NEXTEL Marks in the United States.

8. By reason of their extensive marketing, advertising, and promotion, the NEXTEL Marks have become uniquely associated with Nextel.

9. The NEXTEL Marks have become well known and famous as distinctive indicators of the origin of Nextel's goods and services, and they are valuable symbols of Nextel's goodwill.

10. The NEXTEL Marks are fanciful, arbitrary, inherently distinctive, and therefore strong and entitled to a broad scope of protection.

11. Notwithstanding Nextel's prior rights in the NEXTEL Marks, Orbyx Electronics filed Application No. 78/346,217 on December 29, 2003, based on intent-to-use.

12. Orbyx Electronics' mark features the prefix NEXX-, which very closely resembles the prefix NEX- found in the NEXTEL Marks.

13. Through Application No. 78/346,217, Orbyx Electronics seeks to obtain registration on the principal register for the NEXXTECH mark for use with the following goods in Class 9:

Pocket AM and AM/FM radios, portable AM and AM/FM headset radios, stereomates, water-resistant AM/FM radio, portable and multi-band radios, novelty radios, clock and table radios, AM/FM and CD clock radios, weather radios, FRS (family radio services) 2-way hand-held radios, FRS accessories, namely chargers, electrical and power cables, carrying cases, for radios and radio chargers, radio belt-clips, electrical and power cables, walkie-talkie radios; portable audio units namely MP3 (mini-disc) players, digital recorders, tape cassette recorders and players, micro-cassette recorders and players, mini-disc players and recorders, AM/FM tape players, AM and AM/FM/cassette/CD portable players, cassette tape decks, CD players; digital storage containers in the nature of CD organizers that clip to car visors, nylon wallet CD holders with zippers for CD media, CD-R/CD-RW media, DVD-R/DVD+R media, CD/CD Rom cleaning kits comprised of head cleaning fluids, chamois cloths and swabs; automotive audio systems comprised of AM/FM/cassette players, automotive CD units, boosters/equalizers/cassette players, automotive speakers, automotive antennas, electrical and power cables; micro audio systems comprised of automotive raw speakers and replacement parts for speakers; full size audio component stereo systems; stereo systems, home theatre speaker systems, audio receivers, DVD players, AM/FM stereos, portable DVD players, AM/FM receivers, equalizers, public address systems, karaoke machines, electrical and power cables and connectors, sound mixers and reverbators, amplifiers, digital video recorders, combination TV/VCR's, combination DVD/VCR's, home televisions, portable televisions, LCD (liquid crystal display) televisions, VCR players, home theatre systems in a box, namely, speakers, receivers, radios, home theatre systems, namely, speakers, receivers, DVD players, radios, compact disc player home systems equipment, namely intercom system with the addition of a AM/FM radio, music media turntables, AM/FM intercom systems equipment, namely, speakers, receivers, radios, audio and audio and video accessories namely, video, electrical and power cables and connectors, video amplifiers, splitters and switches, A/V S-video selectors, remote control units for all audio and audio/video equipment, universal remote controllers, RF modulators, audio and video electrical and power cables and connectors, electrical and power analog and digital multi-testers, electrical and power cables, blank video tapes, video storage cabinets, speakers namely, book shelf speakers, floor standing speakers, wireless speakers, subwoofers, raw speakers and replacement parts namely, power cables and wiring, for home speakers multi-media speakers; cameras, namely, digital cameras, compact digital cameras, camcorders, 35mm cameras, camera

tripods, web and internet cameras; camera accessories, namely, battery checkers, power supplies, camcorder tapes, digital film, audio tapes, digital and video camera carrying cases, camera bags, USB card readers, electrical and power cables, connectors, optical component electrical and power cables, adapter plugs; PDA's (personal digital assistants), PDA software, PDA accessories namely, protective case covers, upgrade memory cards, cradle recharging units, plastic and metal stylus, adapters; audio accessories, namely, wireless microphones, wireless headphones, full size headphones, microphones, compact headphones, earbud headphones, headsets, personal computer microphones; personal computer, laptop computers, LCD (liquid crystal display) monitors, computer monitors, computer keyboards both wired and wireless, computer game pads, computer joysticks, computer controllers, namely, steering wheels, flight yokes, computer mice both wired and wireless, computer components, namely, optical drives, ROMs, adapters, network cables, computer wrist-rests, computer speakers, computer rams, optical drives, computer connection cables and adapters, networking cables, connectors, inkjet printers, inkjet photo printers, laser printers, laser photo printers, inkjet all-in-one print center comprised of printer, page scanner and copier combination unit; computer document scanners, digital memory storage devices, portable USB drives, digital USB storage devices in the nature of digital media card readers, digital media cards, computer upgrade cards, media storage namely, CD holders, DVD holders, cassette holders; telephones, namely, standard telephones, multi-line telephones, feature telephones, wireless telephones, fashion telephones, cordless telephones, magnetically encoded calling cards, magnetically encoded long distance calling cards, micro tape telephone answering devices, telephone auto dialer/amplifier, digital telephone answering machines, digital telephone answering machines with telephone, telephone answering device with cordless telephone, telephone accessories, namely electrical cords, extension cords, adaptors, plugs, speakerphones, over-the-ear telephone headsets, hands free mini telephones, wireless modem/telephone jacks, telephone ID electronic module; electronic door chimes, wireless electronic door chimes, electronic voice memo pads, electronic digital recording pens; automobile accessories, namely, tire pressure gauges, car compasses, electronic lock de-icers, electronic key finders, compasses; metal detectors, pro-metal detectors, portable metal detectors, thermometers, indoor/outdoor thermometers, wireless thermometers, talking thermometers, magnifying glasses, folding magnifiers, dual lens magnifiers, binoculars, optical binoculars, folding binoculars, night vision scope, microscopes, laser pointers, laser pointer pens; golf telescopes, electronic digital golf caddies, battery checkers; hand-held and desk type electronic calculators, printing calculators, scientific calculators, electronic language translators, electronic spell checkers, electronic pocket interpreters, electronic French translators, electronic dictionaries, electronic thesaurus, electronic diaries, electronic crosswords games, electronic organizers.

14. Upon information and belief, Orbyx Electronics made no use of the NEXXTECH mark in the United States prior to the filing date of the application.

15. Upon information and belief, Orbyx Electronics was aware of the NEXTEL Marks prior to the filing date of the application.

16. Nextel has not consented to or authorized Orbyx Electronics' use of the NEXXTECH mark.

17. Nextel believes that it will be damaged by the registration of the NEXXTECH mark on the principal register.

COUNT I – LIKELIHOOD OF CONFUSION

18. Nextel hereby incorporates by reference the allegations contained in paragraphs 1 through 17 above.

19. The NEXXTECH mark is a colorable imitation of the NEXTEL Marks in that it so closely resembles the NEXTEL Marks that its use and registration would cause confusion, mistake, or deception as to the source of Orbyx Electronics' goods in Class 9 and injure and damage Nextel and the goodwill and reputation symbolized by the NEXTEL Marks.

20. Orbyx Electronics' goods in Class 9 are so closely related to Nextel's goods and services that the public is likely to be confused, to be deceived, and to assume erroneously that Orbyx Electronics' goods in Class 9 are those of Nextel or that Orbyx Electronics is in some way connected with, sponsored by, or affiliated with Nextel, all to Nextel's irreparable damage.

21. Likelihood of confusion in this case is enhanced by the fame of the NEXTEL Marks and by the fact that consumers associate the NEXTEL Marks with goods and services sold, approved, or endorsed by Nextel.

22. On information and belief, prospective purchasers of Orbyx Electronics' goods in Class 9 are purchasers of Nextel's goods and services, and the parties' respective goods will be sold through the same channels of trade.

23. If Orbyx Electronics is granted registration of its NEXXTECH mark, Orbyx Electronics will obtain the *prima facie* exclusive right to use the mark in the United States, and such registration will impair and diminish Nextel's goodwill and rights in the NEXTEL Marks.

COUNT II – DECEPTION/FALSE SUGGESTION OF CONNECTION

24. Nextel hereby incorporates by reference the allegations contained in paragraphs 1 through 23 above.

25. Orbyx Electronics' NEXXTECH mark so closely resembles the NEXTEL Marks that it is likely to cause deception in violation of Lanham Act Section 2(a).

26. Because the NEXXTECH mark points uniquely to Nextel, purchasers will assume that goods sold under the mark are connected with Nextel.

27. Orbyx Electronics' NEXXTECH mark is deceptive in that it falsely suggests a connection with Nextel.

COUNT III – DILUTION

28. Nextel hereby incorporates by reference the allegations contained in paragraphs 1 through 27 above.

29. The NEXTEL Marks have been widely used and extensively publicized in the United States and have become well known and famous within the meaning of Lanham Act § 43(c) as distinctive symbols of Nextel's goodwill.

30. The NEXTEL Marks became well known and famous before Orbyx Electronics made any use of the NEXXTECH mark in the United States.

31. Orbyx Electronics' NEXXTECH mark will dilute the distinctive quality of the NEXTEL Marks.

32. The use or registration of Orbyx Electronics' NEXXTECH mark will lessen the capacity of Nextel's famous NEXTEL Marks to identify and distinguish Nextel's goods and services.

By reason of the foregoing, Nextel will be damaged by the registration of the NEXXTECH mark, and registration should be refused.

WHEREFORE, Nextel prays that this opposition be sustained and that the registration be denied.

Respectfully submitted,

NEXTEL COMMUNICATIONS, INC.

By: 

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Attorneys for Opposer

CERTIFICATE OF FILING

It is hereby certified that the attached Notice of Opposition (re App. No. 78/346,217) is being filed electronically with the U.S. Patent and Trademark Office this 15th day of February 2006.

David Stuchlik