

ESTTA Tracking number: **ESTTA415844**

Filing date: **06/22/2011**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Motorola Mobility, Inc.
Granted to Date of previous extension	06/22/2011
Address	600 North U.S. Highway 45 Libertyville, IL 60048 UNITED STATES

Name	Motorola Trademark Holdings, LLC
Granted to Date of previous extension	06/22/2011
Address	600 North U.S. Highway 45 Libertyville, IL 60048 UNITED STATES

Attorney information	Thomas M. Williams Winston & Strawn LLP 35 W. Wacker Drive Chicago, IL 60601-9703 UNITED STATES tmwilliams@winston.com, docketCH@winston.com, ahodgson@winston.com, iagarcia@winston.com Phone:(312) 558-5600
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Applicant Information

Application No	78575442	Publication date	02/22/2011
Opposition Filing Date	06/22/2011	Opposition Period Ends	06/22/2011
Applicant	S-N MERGER CORP. 2001 EDMUND HALLEY DR. RESTON, VA 20191 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. First Use: 1997/05/16 First Use In Commerce: 1997/05/16

All goods and services in the class are opposed, namely: Telecommunication services, namely, electronic, electric and digital transmission of voice, data, pictures, music, video, and other electronic information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Mobile telephone

communication services; Wireless Internet access services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies; Wireless communications services

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Failure to function as a mark (15 U.S.C. 1051, 1052, 1127). Issue preclusion. Claim preclusion. Non-use (15 U.S.C. 1051).

Attachments	Notice of Opposition.pdf (19 pages)(74536 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/Thomas M. Williams
Name	Thomas M. Williams
Date	06/22/2011

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

Application Serial No. 78/575,442)
Filed: February 25, 2005)
Published: February 22, 2011, in the *Official*)
Gazette)
For: SOUND MARK) Opposition No. _____

Motorola Mobility, Inc. and Motorola)
Trademark Holdings, LLC,)

Opposers,)

vs.)

Nextel Communications, Inc.)

Applicant.)

NOTICE OF OPPOSITION

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

Opposers Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC (collectively, “Motorola”) believe that they will be damaged by the registration of the sound mark identified and described in Application Serial No. 78/575,442 as “a tone at 1800 Hz played at a cadence of 24 milliseconds (ms) ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON” (hereafter, the “Chirp Tone”) owned by Nextel Communications, Inc. (“Nextel”), published in the *Official Gazette* of February 22, 2011, and hereby jointly oppose registration thereof.

As grounds for opposition, Motorola alleges:

PARTIES

1. Opposer Motorola Mobility, Inc. is a Delaware corporation located at 600 North U.S. Highway 45, Libertyville, Illinois 60048. Motorola Mobility, Inc. manufactures and sells a wide range of communications products, including a full line of handsets that incorporate a push-to-talk walkie-talkie feature into a cellular telephone handset. Motorola Mobility, Inc. offers this product line under the trademark iDEN®, which refers to its proprietary “integrated digital enhanced network” infrastructure technology that enables the iDEN® walkie-talkie handsets to function on the network.

2. Opposer Motorola Trademark Holdings, LLC is a Delaware limited liability company located at 600 North U.S. Highway 45, Libertyville, Illinois 60048. Motorola Trademark Holdings, LLC is a holding company for various Motorola trademarks and is responsible for licensing trademarks to Motorola Mobility, Inc. Motorola Mobility, Inc. has the right to grant sublicenses to third parties, including Motorola’s customers, namely, communications services providers.

3. Applicant Nextel is a Delaware corporation located at 2001 Edmund Halley Dr., Reston, Virginia 20191. Nextel is a communications services provider. Nextel is Motorola’s largest customer for its iDEN® product line, including iDEN® handsets and iDEN® network infrastructure. Nextel purchases iDEN® handsets from Motorola Mobility, Inc. and iDEN® network infrastructure from Motorola Solutions, Inc. (formerly “Motorola, Inc.”), through a cooperation agreement between these Motorola entities that provides for the sale of handsets and infrastructure equipment to Motorola’s iDEN® customers. Nextel then resells the handsets to end-user consumers as part of a communications services package.

FACTUAL BACKGROUND

4. Motorola's engineers developed the iDEN® walkie-talkie communications technology in the mid-1990's. As part of that process, Motorola created various audible tones to be embedded into the iDEN® handsets to signify certain features. One of these tones was an audible "chirp"-like tone broadcast at 1800 Hz to signify that a connection was available for a push-to-talk walkie-talkie communication. That tone, the "Chirp Tone," is embedded into each iDEN® handset. It is emitted from the handset when the user presses the push-to-talk button and the network locates an open and available channel for communication. The audible Chirp Tone is not programmable and cannot be altered by either the end-user or the communications services provider who is operating the iDEN® network.

5. Motorola has sold its iDEN® handsets and iDEN® infrastructure to various communications services providers in the United States, including Nextel and Southern Communications Services, Inc. ("Southern") or its related companies. Each iDEN® handset sold to Nextel and Southern emits the audible Chirp Tone in connection with the push-to-talk walkie-talkie communications feature. Nextel and Southern are direct competitors. Both Nextel and Southern resell the iDEN® handsets to end-user consumers as part of a communications services package. Consequently, the Chirp Tone is emitted by the iDEN® handsets in connection with the communications services provided by both Nextel and Southern. Nextel refers to its iDEN® push-to-talk walkie-talkie communications service as DIRECT CONNECT®. Southern refers to its iDEN® push-to-talk walkie-talkie communications service as INSTANT LINC®. Both Nextel and Southern have extensively used an audible Chirp Tone during advertisements for their respective iDEN®-based communications services.

6. On April 8, 2003, Motorola, Inc. (the predecessor-in-interest to opposers Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC) filed an application to register the Chirp Tone as a trademark on the Principal Register for use in connection with the iDEN® handsets, namely, “cellular telephones and two-way radios” (U.S.P.T.O. Ser. No. 78/235,365). That application was ultimately published for opposition on November 2, 2004.

7. On February 25, 2005, Nextel filed the use-based service mark application at issue in this proceeding, namely, U.S.P.T.O. Ser. No. 78/575,442, seeking to register the Chirp Tone as a service mark on the Principal Register for use in connection with the communications services it provides via Motorola’s iDEN® handsets and infrastructure, as well as other miscellaneous services in International Class 38. Nextel’s Chirp Tone service mark application was eventually suspended by the U.S.P.T.O. pending the outcome of Motorola’s prior-filed Chirp Tone trademark application (U.S.P.T.O Ser. No. 78/235,365).

8. On March 2, 2005, Nextel filed a Notice of Opposition to Motorola’s Chirp Tone trademark application (U.S.P.T.O. Ser. No. 78/235,365) on several grounds, including failure to function as a mark. Nextel subsequently amended its Notice of Opposition to include claims of lack of inherent and acquired distinctiveness, and functionality. The opposition proceeding was captioned *Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353).

9. The Trademark Trial and Appeal Board sustained Nextel’s opposition in a June 12, 2009 precedential decision published as *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393 (T.T.A.B. 2009). In that decision, the Board held that with respect to the communications goods at issue, the Chirp Tone was not inherently distinctive, had not acquired distinctiveness, and that the Chirp Tone was “merely one of many tones emitted by various

cellular telephones to denote or alert the user of the operation of a particular feature thereof.” *Id.* at 1404.

10. In light of the Board’s final refusal of Motorola’s Chirp Tone trademark application, the U.S.P.T.O. lifted the suspension of Nextel’s Chirp Tone service mark application at issue in this proceeding (U.S.P.T.O. Ser. No. 78/575,442).

11. On October 29, 2009, the U.S.P.T.O. issued an office action against Nextel’s Chirp Tone service mark application requiring Nextel to “explain which of its services involve sound emissions.” The examiner went on to state, “The applicant is cautioned that, for the services that involve sound, the applicant will need to demonstrate acquired distinctiveness. In other words, where the sound is emitted in the ordinary course of the services, the applicant will have to demonstrate that consumers recognize the sound as a trademark.” (Oct. 29, 2009 Office Action.)

12. Nextel filed a response to the October 29, 2009 office action on April 29, 2010. In that response, Nextel claimed that “the following services listed in the application involve emission of the sound mark identified in the instant application in the provision of such services:”

Electronic, electric and digital transmission of voice, data, pictures, music, video, and other electronic information via wireless networks; Two-way radio services; Electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Mobile telephone communication services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a

combination of persistent interconnection and instant interconnection/instant interrupt technologies; and Wireless communications services.

With respect to those services, Nextel stated that “applicant believes that the mark has acquired distinctiveness with respect to the foregoing services, submits a declaration regarding the same, and seeks registration of those services pursuant to Section 2(f) of the Trademark Act.” (Apr. 29, 2010 Response to Office Action.) Nextel submitted a Declaration executed under oath by Mr. Danny Bowman on April 29, 2010 stating that the Chirp Tone had become distinctive for those services “through the Applicant’s substantially exclusive and continuous use in commerce of the mark in connection with said services for at least the twelve years immediately before the date of this statement.” (Bowman Declaration attached to April 29, 2010 Response to Office Action.)

13. The remaining services in Ser. No. 78/575,442, for which Nextel did not submit an acquired distinctiveness claim under Section 2(f) are: “Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Wireless internet access services.” Those remaining services were identified in Nextel’s original Chirp Tone service mark application (Ser. No. 78/575,442), but were not included in the Bowman Declaration’s claim of acquired distinctiveness. (Bowman Declaration attached to April 29, 2010 Response to Office Action.) Consequently, Nextel has not submitted a claim that the Chirp Tone has acquired distinctiveness in connection with “Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Wireless internet access services.”

14. On May 20, 2010, the U.S.P.T.O. issued a subsequent office action against Nextel’s Chirp Tone service mark application. In this office action, the examiner stated that the

Bowman Declaration submitted with Nextel's April 29, 2010 response was insufficient to show acquired distinctiveness. (May 20, 2010 Office Action.)

15. Nextel filed a response to the May 20, 2010 office action on November 22, 2010. In that response, Nextel submitted a Declaration executed under oath by Mr. Christopher K. Schaper on November 19, 2010 stating that "Applicant has expended hundreds of millions of dollars in advertising since 1997 on advertising that features the mark in above-captioned Application Serial No. 78/575,442...." He went on to state that, "Applicant continues to use the mark in above-captioned Application Serial No. 78/575,442 in advertising for the services identified in Application Serial No. 78/575,442." (Schaper Declaration attached to Nov. 22, 2010 Response to Office Action.)

16. Nextel's Chirp Tone service mark application (U.S.P.T.O. Ser. No. 78/575,442) was published for opposition in the *Official Gazette* on February 22, 2011.

GROUND

LACK OF DISTINCTIVENESS

17. The Chirp Tone is not inherently distinctive for the applied-for services. The Board has characterized it as not significantly different than other operational alert tones emitted by handsets. *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393, 1401-02 (T.T.A.B. 2009). Further, Nextel uses the Chirp Tone in connection with communications services that utilize the Chirp Tone as an operational alert tone during the provision of those services. Thus, the Chirp Tone cannot be deemed inherently distinctive.

18. The Chirp Tone has not acquired distinctiveness for the applied-for services. Nextel's use of the Chirp Tone has not been substantially exclusive as required by 15 U.S.C. § 1052(f). Motorola's second-largest iDEN® customer, Southern, extensively uses the Chirp Tone

in commerce in connection with its iDEN®-based walkie-talkie communications services and its advertising for those services. Southern's communications services offered in connection with the Chirp Tone are identical to, and directly compete with, Nextel's communications services offered in connection with the Chirp Tone. In light of Southern's use of the Chirp Tone in connection with its communications services, and its advertising for those services, Nextel's use of the Chirp Tone is not substantially exclusive. Consequently, the Chirp Tone has not acquired distinctiveness as a service mark for the services identified in Application Serial No. 78/575,442.

19. Further, Motorola uses the Chirp Tone in connection with its iDEN® handsets that emit the Chirp Tone in their normal course of operation.

20. Motorola has also licensed its iDEN® technology to another handset manufacturer, Research in Motion, Ltd. ("RIM"). RIM uses the Chirp Tone in connection with handsets offered under license from Motorola. Those licensed handsets emit the Chirp Tone in their normal course of operation.

21. The Board held that the Chirp Tone was not registrable on the Principal Register because it was not inherently distinctive and had not acquired distinctiveness a trademark in connection with Motorola's applied-for goods. *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393, 1401-02 (T.T.A.B. 2009). The services identified in Nextel's Chirp Tone service mark application at issue in this proceeding are inextricably related to the goods identified in Motorola's Chirp Tone trademark application. Nextel provides those services via Motorola's iDEN® handsets and iDEN® infrastructure. In fact, Nextel's applied-for communications services are sold to consumers as a package together with Motorola's, or its licensee's, iDEN® handsets. Consequently, the Chirp Tone cannot be deemed non-distinctive

and unregistrable as a mark in connection with the goods, on one hand, while at the same time be deemed registrable in connection with the related services, on the other hand.

22. As a result, the Chirp Tone lacks distinctiveness in connection with the applied-for services, has not acquired distinctiveness under 15 U.S.C. § 1052(f), and should be denied registration under 15 U.S.C. § 1052(e)(1).

FAILURE TO FUNCTION AS A SERVICE MARK

23. The Chirp Tone fails to function as a service mark in connection with Nextel's applied-for communications services. It is merely an operational alert tone used to signify that the iDEN® handsets operated through the iDEN® infrastructure are operational and available for walkie-talkie communications. It is not source-identifying for those services. Moreover, the Chirp Tone is incapable of identifying a single source for those services because Nextel is not the exclusive, or the substantially exclusive, source of communications services offered in connection with the Chirp Tone. Other communications services providers, including Southern, provide communications services through Motorola's iDEN® handsets and iDEN® infrastructure. Those communications services utilize the Chirp Tone as an operational alert tone during the ordinary course of the services. Moreover, Southern and Nextel both use the audible Chirp Tone in advertising for their respective, and directly competing, iDEN®-based communications services.

24. As a result, the Chirp Tone fails to function as a service mark in connection with the applied-for services and should be denied registration under 15 U.S.C. §§ 1051, 1052, and 1127.

FUNCTIONALITY

25. The Chirp Tone is functional when used in connection with the applied-for communications services. The Chirp Tone is an operational alert tone when used in connection with services provided via Motorola's proprietary iDEN® handsets and iDEN® infrastructure. The Chirp Tone provides an audible alert signal that the walkie-talkie service is enabled and that a channel is available for communications. The Chirp Tone is embedded into the iDEN® handsets and is essential to the provision of services provided via use of those handsets in the communications services context. Although Motorola, as the iDEN® handset manufacturer, affirmatively chose the Chirp Tone despite available alternative tones, the Chirp Tone is functional at the iDEN® service provider level because it cannot be removed or altered by iDEN® push-to-talk walkie-talkie communications services providers, such as Nextel and Southern, or by end-user consumers. Motorola's customers who offer iDEN®-based push-to-talk walkie-talkie communications services to consumers, including Nextel and Southern, could not provide these services without utilizing the Chirp Tone. As a result, the Chirp Tone is essential to the use or purpose of the applied-for services, and it affects the cost or quality of the applied-for services. Nextel's registration of the Chirp Tone, and its associated presumption of exclusive rights to use the Chirp Tone, would place its competitors who also provide communications services via Motorola's iDEN® handsets and iDEN® infrastructure at a significant non-reputation-related competitive disadvantage.

26. As a result, the Chirp Tone is functional with respect to the applied-for services and should be denied registration under 15 U.S.C. § 1052(e)(5).

ISSUE PRECLUSION AND CLAIM PRECLUSION

27. The Board sustained Nextel's opposition to Motorola's Chirp Tone trademark application in a June 12, 2009 precedential decision (*Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353)) published as *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393 (T.T.A.B. 2009). That proceeding involved the identical sound mark, namely, the Chirp Tone. In that proceeding, the Board held that the Chirp Tone was not registrable on the Principal Register because it was not inherently distinctive and had not acquired distinctiveness a trademark in connection with the applied-for goods. The services identified in Nextel's Chirp Tone service mark application at issue in this proceeding are inextricably related to the goods identified in Motorola's Chirp Tone trademark application. Nextel provides those services via Motorola's iDEN® handsets and iDEN® infrastructure. In fact, Nextel's applied-for communications services are sold to consumers as a package together with Motorola's iDEN® handsets. Consequently, the Chirp Tone cannot be deemed non-distinctive and unregistrable as a mark in connection with the goods, on one hand, while at the same time be deemed distinctive and registrable in connection with the related services, on the other hand.

28. The doctrine of issue preclusion operates as a bar to Nextel's pending application to register the Chirp Tone as a service mark:

- (a). The issues in the present Chirp Tone service mark opposition are identical to the issues in the prior Chirp Tone trademark opposition, namely, whether the Chirp Tone is distinctive and functions as a mark.

- (b). The issues were actually litigated in the prior Chirp Tone trademark opposition, resulting in a final judgment against Motorola's Chirp Tone trademark application.
- (c). The determination of the issues of distinctiveness and trademark use was necessary to the resulting judgment, namely, that the Chirp Tone was non-distinctive and did not function as a mark.
- (d). The party defending against preclusion had a full and fair opportunity to litigate the issues. In fact, as the party in the position as the plaintiff/opposer in the prior Chirp Tone trademark opposition (*Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353)), Nextel was the party who asserted and successfully proved the issues of non-distinctiveness and failure to function as a mark. In direct contrast to its prior position, upheld by the Board, Nextel now seeks to re-litigate these issues and prove that the Chirp Tone is distinctive and registrable on the Principal Register.

29. The doctrine of claim preclusion operates as a bar to Nextel's pending application to register the Chirp Tone as a service mark:

- (a). There is an identity of the parties. Nextel was the plaintiff/opposer challenging Motorola's Chirp Tone trademark application, and Motorola's predecessor-in-interest (Motorola, Inc.) was the defendant/applicant. In the present case, the parties are reversed: Motorola is the plaintiff/opposer and Nextel is the Chirp Tone defendant/applicant.

- (b). There was an earlier final judgment on the merits. The Board entered a final judgment against Motorola's application to register the Chirp Tone (*Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353)).
- (c). The second claim is based on the same set of transactional facts as the first. The identical Chirp Tone is at issue in both proceedings. The proceedings involve the same issues and the same set of transactional facts, namely, whether the Chirp Tone that is emitted by Motorola's iDEN® handsets during the course of Nextel's applied-for communications services is distinctive and functions as a mark that is registrable on the Principal Register. Due to the relatedness between the iDEN® handsets and the iDEN®-based communications services, there is no distinguishable difference between Motorola's use of the Chirp Tone in connection with the goods at issue in the prior proceeding and Nextel's use of the Chirp Tone in connection with the applied-for services.

30. As a result, the Chirp Tone is unregistrable under the doctrines of issue preclusion and claim preclusion.

NON-USE

31. As of the February 25, 2005 filing date of the use-based Chirp Tone service mark application (Ser.No. 78/575,442), Nextel had not made service mark use of the Chirp Tone in connection with any services other than, at most, two-way radio services offered via Motorola's, or its licensee's, iDEN® handsets and iDEN® infrastructure. Thus, the only services Nextel could conceivably claim in the Chirp Tone service mark application as of the filing date were those describing two-way radio services, namely: "electronic and digital transmission of voice

via wireless networks; two-way radio services; electronic transmission of voice by means of two-way radios, mobile radios; wireless communications services.”

32. As a result, the application is void ab initio as to the remaining services identified in the Chirp Tone service mark application, namely, “electric transmission of data, pictures, music, video, and other electronic information via wireless networks; Electronic transmission of text, images, data, music and information by means of cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Mobile telephone communication services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies.” The Chirp Tone is unregistrable as to those remaining services under 15 U.S.C. § 1051(a).

FRAUD ON THE PATENT AND TRADEMARK OFFICE

33. On February 25, 2005, Nextel filed a use-based service mark application asserting that the Chirp Tone was in use as a service mark in commerce in connection with a variety of communications services in International Class 38. As of the February 25, 2005 filing date of the use-based Chirp Tone service mark application (Ser.No. 78/575,442), Nextel had not made service mark use of the Chirp Tone in connection with any services other than, at most, two-way radio services offered via Motorola’s, or its licensee’s, iDEN® handsets and iDEN®

infrastructure. Consequently, Nextel's claim that the Chirp Tone was used as a service mark in connection with the additional non-iDEN® services identified in the application was false, namely, "electric transmission of data, pictures, music, video, and other electronic information via wireless networks; Electronic transmission of text, images, data, music and information by means of cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Mobile telephone communication services; Wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, music, information, text, numeric messaging and text messaging and for accessing a global communications network; Telecommunication services, namely, providing user access to telephone and Internet wired or wireless networks for the transmission of voice, data, images, music or video via a combination of persistent interconnection and instant interconnection/instant interrupt technologies." That false statement was material because the U.S.P.T.O. would not have allowed the application to proceed as a use-based application as to those services if it was aware that the mark was not in use therewith. However, the U.S.P.T.O. relied on that false statement and Nextel obtained a benefit that it would not have otherwise received, namely, publication of the Chirp Tone service mark application with the falsely-claimed services. Upon information and belief, Nextel knowingly and intentionally made that false material statement with the intent to deceive the U.S.P.T.O.

34. Moreover, on April 29, 2010, Nextel submitted a declaration alleging that it had made "substantially exclusive and continuous use in commerce" of the Chirp Tone. Nextel made this statement under oath in connection with an acquired distinctiveness claim under Section 2(f)

relating to the iDEN®-based services identified in the Chirp Tone service mark application. However, Nextel submitted this claim despite actual knowledge that its largest iDEN® competitor, Southern, also used the Chirp Tone in connection with its directly competing iDEN®-based push-to-talk walkie-talkie services. In addition to its marketplace awareness of Southern's activities, Southern's use of the Chirp Tone, including Southern's use in advertising its iDEN®-based services, was made of record during the *Nextel Communications, Inc. v. Motorola, Inc.* Chirp Tone trademark opposition proceeding (T.T.A.B. Case No. 91/164,353), which preceded the Section 2(f) declaration. Consequently, Nextel's April 29, 2010 statement made under oath that its use of the Chirp Tone was "substantially exclusive" was knowingly false. That knowingly false statement was material at this juncture because the Board had already held that sound marks such as the Chirp Tone were not registrable without a showing of acquired distinctiveness. The U.S.P.T.O. would not have allowed the application to proceed as to those services if it was aware that Nextel's use was not "substantially exclusive." However, the U.S.P.T.O. relied on that false statement and Nextel obtained a benefit that it would not have otherwise received, namely, publication of the Chirp Tone service mark application. Upon information and belief, Nextel knowingly and intentionally made that false material statement with the intent to deceive the U.S.P.T.O.

35. As a result, (a) all services identified in Nextel's Chirp Tone service mark application other than the two-way radio services described above were fraudulently claimed to be in use under the mark as of the February 25, 2005 filing date and (b) the two-way radio services, which are iDEN®-based services that utilize an audible Chirp Tone in the ordinary course of the services and therefore require proof of acquired distinctiveness, were fraudulently claimed to be in substantially exclusive use despite Nextel's actual knowledge that its

competitor, Southern, used the Chirp Tone in connection with its directly competing iDEN®-based services. In combination, these fraudulent and material claims reach every service identified in Nextel's Chirp Tone service mark application. Consequently, registration should be denied based on Nextel's fraud on the U.S.P.T.O.

STANDING

36. Opposer Motorola Mobility, Inc. will be damaged by Nextel's registration of the Chirp Tone in connection with its applied-for services because registration would entitle Nextel to a presumption of ownership and the exclusive right to use the Chirp Tone. As a result, Nextel could seek an injunction against Motorola's ongoing non-trademark use of the Chirp Tone in connection with its related goods, or in connection with other goods or services within Motorola's natural zone of expansion. Motorola would be forced to defend against this potential litigation. Moreover, Nextel could seek an injunction against Motorola's other iDEN® customers who use the Chirp Tone in connection with iDEN®-based communications services or related services, and related advertising, in direct competition with Nextel, including Southern. That potential litigation would likely result in lost sales for Motorola while the litigation is pending.

37. Opposer Motorola Trademark Holdings, LLC will be damaged by Nextel's registration of the Chirp Tone in connection with its applied-for services because registration would entitle Nextel to a presumption of ownership and the exclusive right to use the Chirp Tone. As a result, Nextel could seek an injunction against Motorola's other iDEN® customers who use the Chirp Tone in connection with iDEN®-based communications services or related services, and related advertising, in direct competition with Nextel, including Southern. As the licensor for certain Motorola trademarks, Motorola Trademark Holdings, LLC could be called

upon to indemnify or otherwise defend Motorola's other customers against Nextel's potential service mark infringement claims.

WHEREFORE, Motorola prays that this opposition be sustained and that registration of Ser. No. 78/575,442 be denied.

The Director is hereby authorized to charge the filing fee for this joint Notice of Opposition, \$600.00, to Deposit Account No. 232428.

Dated: June 22, 2011

Respectfully submitted,
WINSTON & STRAWN LLP

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CERTIFICATE OF SERVICE

On June 22, 2011, I served the foregoing **NOTICE OF OPPOSITION** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to counsel of record for Applicant as follows:

John I. Stewart, Jr.
Crowell Moring
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004-2595

Dated: June 22, 2011

By: /s/Thomas M. Williams
Thomas M. Williams

CHI:2541591.3