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

Proceeding	91200355
Party	Defendant Nextel Communications, Inc.
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	01/31/2012
Attachments	Nextel Unopposed Motion for Leave.pdf (3 pages)(291523 bytes) Nextel Amended Answer.pdf (11 pages)(1292003 bytes)

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

MOTOROLA MOBILITY, INC., and MOTOROLA TRADEMARK HOLDINGS, LLC,	)	
Opposers,	)	
v.	)	Opp. No.: 91/200,355 App. No.: 78/575,442 Pot. Mark: SOUND MARK
NEXTEL COMMUNICATIONS, INC.	)	
Applicant.	)	

APPLICANT'S UNOPPOSED MOTION FOR LEAVE TO FILE AN AMENDED ANSWER

Applicant Nextel Communications, Inc. hereby submits this unopposed motion for leave to file the Amended Answer to the Notice of Opposition attached hereto as Exhibit A in the above-referenced opposition pursuant to Federal Rule of Civil Procedure Rule 15(a)(2), 37 C.F.R. § 2.107(a) and TBMP §§ 315 and 507.01-507.02. As the Amended Answer is being filed prior to the start of discovery or submission of any summary judgment motions, and in consideration of the admissions and denials already contained in the previously-filed Answer regarding acquired distinctiveness, Applicant believes that there is no prejudice to Opposer from the filing of the Amended Answer, and that Applicant has a good-faith basis to submit this motion and the attached Amended Answer. *See* Fed. R. Civ. P. 15(a)(2) ("The Court should freely give leave when justice so requires.").

Counsel for Applicant met and conferred with counsel for Opposer regarding the relief sought in this motion. Opposer does not object to the relief sought. Accordingly, Applicant respectfully requests that the Board grant the instant motion and enter the Amended Answer.

Respectfully submitted,

John I. Stewart, Jr.
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January 31, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S UNOPPOSED MOTION FOR LEAVE TO FILE AN AMENDED ANSWER was served on counsel for Opposer this 31st day of January, 2012, by sending same via First Class Mail, postage prepaid, to:

Thomas M. Williams
WINSTON & STRAWN LLP
35 W. Wacker Drive
Chicago, Illinois 60601-9703

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NEXTEL COMMUNICATIONS, INC.	)	
Applicant.	)	

APPLICANT'S AMENDED ANSWER TO OPPOSERS' NOTICE OF OPPOSITION

Nextel Communications, Inc.[1] ("Applicant") by and through its undersigned counsel, responds to the Notice of Opposition as follows:

1. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in ¶ 1 and therefore denies those allegations.

2. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in ¶ 2 and therefore denies those allegations.

3. Applicant admits that it is a Delaware corporation, and that it was formerly located at 2001 Edmund Halley Dr., Reston, VA 20191, and states further that its principal place of business is located at 6200 Sprint Parkway, Overland Park, Kansas 66251. Applicant admits that it provides communications services. Applicant admits that it or its affiliated companies have purchased iDEN handsets and infrastructure from Motorola Mobility, Inc. and Motorola

[1] Applicant S-N Merger Corp. assigned the application to Nextel Communications, Inc., in an assignment recorded on March 22, 2006.

Solutions, Inc. Applicant admits that it sometimes provides handsets to its customers for use in connection with Nextel services. Applicant lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations in ¶ 3 and therefore denies those allegations.

4. Applicant denies that Motorola's engineers independently developed the iDEN walkie-talkie communications technology in the mid-1990s. Applicant admits that the "Chirp Tone" is 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. Applicant admits that iDEN handsets provided by Nextel to its customers for use in connection with its services emit the Chirp Tone when the user presses the push-to-talk button and the network locates an open and available channel for communication. Applicant lacks knowledge or information sufficient to form a belief about the remaining allegations in ¶ 4 and therefore denies those allegations.

5. Applicant admits that Motorola has sold iDEN handsets and iDEN infrastructure to Nextel. Applicant admits that Southern Communications Services, Inc. ("Southern") provides iDEN-based services using iDEN equipment and that Nextel and Southern are direct competitors with respect to some services and within a limited geographic area. Applicant also admits that each iDEN handset sold to Nextel is capable of emitting the Chirp Tone in connection with push-to-talk service. Nextel also admits that the registered mark DIRECT CONNECT® is used in connection with the promotion of the push-to-talk service. Applicant also admits that it has extensively used the Chirp Tone to advertise its services, including push-to-talk services. Applicant lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations in ¶ 5 and therefore denies those allegations.

6. Applicant admits that Motorola filed an application to register the Chirp Tone as a trademark on the Principal Register for use with "cellular telephones and two-way radios" in

application serial no. 78/235,365 ("Motorola Application"). Applicant lacks knowledge or information sufficient to form a belief about whether the application was filed for use in connection with iDEN handsets and whether the predecessor-in-interest to Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC is Motorola, Inc. and therefore denies those allegations. Applicant admits the remaining allegations in ¶ 6.

7. Applicant admits that it filed application serial no. 78/575,442 (the "Nextel Application") on February 25, 2005 based on Nextel's use in commerce of the Chirp Tone. Applicant admits that the application sought to register the Chirp Tone as a service mark on the Principal Register for the services in International Class 38, and states further that the Nextel Application speaks for itself. Applicant admits that its application was suspended pending the outcome of Motorola's Application.

8. Applicant admits that it opposed Motorola's Application on several grounds, including failure to function as a mark and likelihood of confusion. Applicant admits that it subsequently amended its Notice of Opposition to include claims of lack of inherent and acquired distinctiveness, and functionality, in addition to other grounds.

9. Paragraph 9 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that 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 (TTAB 2009). Applicant admits that the Board held, in addition to other determinations, that with respect to Motorola's applied-for-goods, the Chirp Tone was not inherently distinctive and had not acquired distinctiveness and stated 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."

10. Applicant admits that the U.S. Patent & Trademark Office lifted the suspension of Nextel's application after the Board's determination on Motorola's Application. Applicant denies the remaining allegations in ¶ 10.

11. Applicant admits the allegations in ¶ 11.

12. Applicant admits that it filed a response to an office action in which the Examining Attorney issued a query requesting that the applicant "explain which of its services involve sound emissions" and that the response stated that the specified services involved the emission of the sound mark and 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." Applicant admits that it submitted a Declaration executed under oath by Mr. 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." Applicant states further that the October 29, 2009 office action and April 29, 2010 Response and Declaration speak for themselves.

13. Applicant admits that "paging services; transmission of positioning, tracking, monitoring and security data via wireless communications devices; [and] Wireless internet access services" were not identified in its April 29, 2010 Response to the October 29, 2010 Office Action as services that involve emission of the Chirp Tone and were therefore not addressed in the Bowman Declaration. Applicant denies the remaining allegations in ¶ 13.

14. Applicant admits the allegations in ¶ 14.

15. Applicant admits the allegations in ¶ 15.

16. Applicant admits the allegations in ¶ 16.

17. Paragraph 17 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that among other uses, the Chirp Tone can be used in connection with communications services that utilize the Chirp Tone as an operational alert tone. Applicant denies the remaining allegations in ¶ 17.

18. Applicant denies that the Chirp Tone has not acquired distinctiveness for the applied-for services. On information and belief, Applicant denies that Applicant's use of the Chirp Tone has not been substantially exclusive. Applicant denies that the Chirp Tone has not acquired distinctiveness as a service mark for the services identified in Application Serial No. 78/575,442. Applicant admits that, within a limited geographic area, some Southern services directly compete with some Nextel services. Applicant lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations in ¶18 and therefore denies those allegations.

19. Applicant denies the allegations in ¶19.

20. Applicant lacks knowledge or information sufficient to form a belief about whether Motorola licensed iDEN technology to Research in Motion, Ltd. and therefore denies that allegation. Applicant admits that some RIM handsets emit the Chirp Tone but lacks knowledge or information sufficient to form a belief about whether those handsets are offered under license from Motorola. Applicant denies the remaining allegations in ¶ 20.

21. Paragraph 21 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that the

Trademark Trial and Appeal Board found that with respect to Motorola's applied-for-goods, the mark in Motorola's Application was not registrable because it was not inherently distinctive and had not acquired distinctiveness as a trademark in connection with Motorola's applied-for-goods. Applicant denies the remaining allegations of ¶ 21.

22. Applicant denies the allegations in ¶ 22.

23. Applicant admits that Southern provides some communications services through iDEN handsets and iDEN infrastructure, and utilizes the Chirp Tone as an operational alert tone during the ordinary course of the services. Applicant lacks knowledge or information sufficient to form a belief about whether other service providers provide communications services through iDEN handsets and iDEN infrastructure and therefore denies that allegation. Applicant lacks knowledge or information sufficient to form a belief about whether communications services provided by other service providers use the Chirp Tone as an operational alert tone during the ordinary course of the services and therefore denies that allegation. Applicant admits that it uses the Chirp Tone in its advertising for the applied-for-services but lacks knowledge or information sufficient to form a belief about whether other service providers use the Chirp Tone in advertising and whether such services directly compete with one another and therefore denies those allegations. Applicant denies the remaining allegations of ¶ 23.

24. Applicant denies the allegations in ¶ 24.

25. Paragraph 25 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that the Chirp Tone is an operational alert tone when used in connection with certain services provided via Motorola's iDEN handsets and iDEN infrastructure. Applicant admits that the Chirp Tone may

be emitted as a signal that the walkie-talkie service is enabled and that a channel is available for communications. Applicant denies the remaining allegations in ¶ 25.

26. Applicant denies the allegations in ¶ 26.

27. Paragraph 27 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that the Board sustained Nextel's opposition to Motorola's Application and held that with respect to Motorola's applied-for goods, the mark was not inherently distinctive and had not acquired distinctiveness. Applicant admits that that proceeding involved the identical sound but denies that it involved the identical sound mark. Applicant denies the remaining allegations of ¶ 27.

28. Paragraph 28 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant denies the allegations in ¶ 28.

29. Paragraph 29 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant lacks knowledge or information sufficient to form a belief about whether Motorola's predecessor-in-interest was a party to Nextel's opposition of the prior application in Opposition No. 91/164,353 and therefore denies that allegation. Applicant admits that there was a final judgment on the merits of Nextel's opposition with respect to the application. Applicant admits that the proceeding involved the same sound but denies that it involved the same sound mark. Applicant denies the remaining allegations in ¶ 29.

30. Applicant denies the allegations in ¶ 30.

31. Applicant denies the allegations in ¶ 31.

32. Applicant denies the allegations in ¶ 32.

33. Applicant admits that it filed application serial no. 78/575,442 on February 25, 2005 based on Nextel's use in commerce of the Chirp Tone. Applicant denies the remaining allegations of ¶ 33.

34. Applicant admits that on April 29, 2010, it submitted a declaration alleging that it had made "substantially exclusive and continuous use in commerce" of the Chirp Tone in connection with "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" and that it made this statement under oath in connection with an acquired distinctiveness claim. Applicant denies the remaining allegations of ¶ 34.

35. Applicant denies the allegations of ¶ 35.

36. Paragraph 36 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that Nextel's registration of the Chirp Tone would entitle Nextel to a presumption of ownership and the

exclusive right to use the Chirp Tone. Applicant lacks knowledge or information sufficient to form a belief about whether Nextel could seek an injunction against Motorola's alleged non-trademark use, whether Nextel could seek an injunction against Motorola's alleged other iDEN customers, and whether any such litigation would result in lost sales for Motorola and therefore denies those allegations. Applicant denies the remaining allegations of ¶ 36.

37. Paragraph 37 states legal conclusions for which no answer is required. To the extent an answer is required, Applicant responds as follows: Applicant admits that Nextel's registration of the Chirp Tone would entitle Nextel to a presumption of ownership and the exclusive right to use the Chirp Tone. Applicant lacks knowledge or information sufficient to form a belief about whether Nextel could seek an injunction against Motorola's alleged non-trademark use, whether Nextel could seek an injunction against Motorola's alleged other iDEN customers, and whether any such litigation would result in lost sales for Motorola and therefore denies those allegations. Applicant denies the remaining allegations of ¶ 37.

AFFIRMATIVE DEFENSES

1. In the event that the applied-for services are not inherently distinctive, Applicant asserts in the alternative that they have acquired distinctiveness pursuant to Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).

Respectfully submitted,

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January 31, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S AMENDED ANSWER TO OPPOSERS' NOTICE OF OPPOSITION was served on counsel for Opposers this 31st day of January, 2012, by sending same First Class Mail, postage prepaid, to:

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