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

Proceeding	91200355
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**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.)
)
NEXTEL COMMUNICATIONS, INC.)
)
Applicant.)
_____)

Opp. No.: 91/200,355
App. No.: 78/575,442
Pot. Mark: SOUND MARK

APPLICANT’S MOTION FOR SUMMARY JUDGMENT ON PRECLUSION

Applicant Nextel Communications, Inc.¹ (“Applicant” or “Nextel”) hereby moves pursuant to Federal Rule of Civil Procedure Rule 56(b) for summary judgment that registration of the Nextel Chirp as set forth in U.S. Trademark Application Serial No. 78/575,442 is not precluded by the Trademark Trial and Appeal Board’s (“TTAB”) decision in *Nextel Communications, Inc. v. Motorola, Inc.*, 91 U.S.P.Q.2d 1393 (TTAB 2009) (“*Nextel v. Motorola*”), as asserted by Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC (collectively “Opposer” or “Motorola”) in its Notice of Opposition (“Opp.”).

The Board’s conclusion in *Nextel v. Motorola* that Motorola had not provided sufficient evidence that consumers associate the Chirp with Motorola’s cellular telephones simply has no bearing on whether Nextel should be permitted to prove that the Chirp is distinctive as a mark

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

identifying Nextel's communications services. Indeed, the Board expressly stated in its prior decision that that issue was neither presented nor decided.

I. INTRODUCTION

Motorola asserts that the doctrines of issue preclusion and claim preclusion bar Nextel from registering the Chirp Tone. Opp. at ¶¶ 27-30. It bases these claims on the assertion that the Board previously determined, in *Nextel v. Motorola*, that the Chirp Tone was not registrable “because it was not inherently distinctive and had not acquired distinctiveness [as] a trademark in connection with the applied-for goods.” Opp. at ¶ 27 (emphasis added). As discussed below, the assertion that Applicant is now somehow precluded from seeking registration of the Nextel Chirp for the services it offers (as opposed to the goods for which Motorola applied) is flatly wrong and unsupported by law. The Board in *Nextel v. Motorola* expressly stated that it was *not* addressing the registrability of the Chirp Tone in connection with Nextel's services. In addition, because *Nextel v. Motorola* related to Nextel's opposition to Motorola's application for registration of the Chirp Tone in connection with Motorola's two-way radios and cell phones, Nextel did not have a reason or an opportunity to present its complete case regarding registrability of the Chirp Tone in connection with the services identified in Application Serial No. 78/575,442, which are the subject of the instant opposition. The critical issues – whether the Chirp Tone is inherently distinctive or has acquired distinctiveness with respect to the services in Nextel's application – and the facts related to and dispositive of those issues were not presented to or decided by the Board in *Nextel v. Motorola*. Opposer's preclusion claims should be disposed of by summary judgment.

II. STATEMENT OF UNDISPUTED FACTS

1. Applicant provides wireless communications services. One of the services it offers is “Direct Connect” two-way radio service provided to its subscriber customers over its network, in part using equipment manufactured by Opposer, *see* Opp. at ¶ 5, and by other manufacturers.

2. In connection with the operation of the Direct Connect service, the subscribers’ wireless devices emit a variety of operational alert tones to signal the user of various status conditions and events. One such tone, which Applicant refers to as the “Nextel Chirp,” and which is emitted to signal the “talk permit” status of certain two-way radio communications, is the subject of this proceeding. *See id.* at ¶¶ 4, 7.

3. Applicant seeks registration of the Nextel Chirp based on its use of that sound as a source-identifying brand for a range of services it offers, including not only services for which the sound is an operational alert tone but also services in which the Nextel Chirp is not heard at all (*i.e.*, what Opposer calls “non-iDEN” services, *see id.* at ¶ 33), and as a brand identifier for Nextel services in general. *See id.* at ¶ 7.

4. The Nextel Chirp has been used by Nextel as a brand in connection with advertising “iDEN-based” and “non-iDEN” service offerings since at least 1997. *See id.* at ¶ 15.

5. During the application process, Nextel stated in a response to an Office Action 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

paggers; 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.”

See id. at ¶ 12.

6. 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.” *Id.*

7. During prosecution, Nextel did not submit a claim that the Chirp Tone has acquired distinctiveness in connection with the remaining services listed in its application, namely “Paging services; Transmission of positioning, tracking, monitoring and security data via wireless communications devices; Wireless internet access services.” *Id.* at ¶ 13.

8. Applicant and Opposer have already litigated a substantial opposition proceeding involving this same sound, *see id.* at ¶¶ 8-9, which resulted in the Board decision in *Nextel v. Motorola*.² That proceeding involved Motorola’s attempt to register the sound as a mark for the wireless devices it manufactured and sold to Nextel. *See id.*, 91 U.S.P.Q.2d at 1395. Motorola argued that it had used the sound as a trademark because the sound was “affixed” to its goods

² Opposer cites and relies on the Board’s prior decision, and record evidence presented in that prior proceeding, throughout its Notice of Opposition. *See Opp.* at ¶¶ 8, 9, 17, 21, 27, 28, 29, 34.

upon sale, and because it was audible as part of Motorola's demonstration of the operation of its goods at trade shows and as part of depictions of their operation in product placements and in Motorola's advertising. *See id.* at 1404-1406. The Board held, however, that with respect to the applied-for goods, the chirp sound was an operational alert tone that could not be considered inherently distinctive, and Motorola's "use" of the tone in merely demonstrating or depicting the operation of the product did not result in acquired distinctiveness of the chirp sound as a trademark for Motorola's products. *Id.* at 1401, 1403-1405.

9. Nextel, as Opposer in the prior proceeding, presented evidence showing that, by contrast to Motorola, it had used the sound as a mark, in extensive national radio and television advertising over many years, reinforcing the sound mark even in print advertising, for example, by touting Nextel services as "pretty chirping fast." *Id.* at 1398. Motorola argued that any trademark significance of the chirp sound garnered through Nextel's extensive advertising should accrue to its own benefit because of its purported partial funding of those advertisements through a co-op credit program. *Id.* at 1406-1407.

10. The Board found, however, that Nextel's advertisements were "noticeably different from [Motorola's] advertisements and product placements . . . , inasmuch as the chirp is played in a manner not necessarily associated with the normal operation" of the devices, but "is either emitted gratuitously or as an audible prompt used to underscore points made by the narrator" regarding features of the cellular telephone or associated services. *Id.* at 1407. The Board also found that "in all of [Nextel's] advertisements of record, the source-association made with the chirp, if any, is with 'Nextel.'" *Id.* The Board found that the television commercials thus did not show "use of the chirp as a source-identifier for [Motorola's] goods," and did not support Motorola's acquired distinctiveness assertion. *Id.*

11. Based on its review of the advertising evidence, the Board further observed that the impression the spots created was that the advertiser was seeking “to associate the chirp with ‘Nextel,’” and that notwithstanding Nextel’s sale of both goods and services, “to the extent that a viewer of these advertisements would consider the chirp as a trademark, it is more likely that the viewer would associate the chirp with [Nextel’s] services, rather than [Motorola’s] cellular telephones.” *Id.* at 1408. The Board concluded that because of the nature of the advertising, “we cannot find that consumers would associate the chirp with [Motorola’s] cellular telephones.” *Id.*

12. Nextel also presented a pair of consumer surveys, credited by the Board, that showed that a substantial majority of respondents associated the chirp sound with a single source of goods or services, and that 53 percent of all respondents associated that sound with Nextel, compared with 1.5 percent for Motorola. *Id.* at 1402-1403. The Board concluded, that “[i]n sum, the Jacoby testimony and surveys do not support [Motorola’s] claim that the chirp has acquired distinctiveness for [Motorola’s] cellular telephones.” *Id.* at 1403.

13. Based on all the evidence before it, the Board held that the chirp “has not acquired distinctiveness for [Motorola’s] cellular telephones.” *Id.* at 1408.

14. The Board was clear that it was not deciding whether the chirp had acquired distinctiveness as a Nextel mark. In fact, the Board expressly stated that “. . . we make no finding herein that the chirp has acquired distinctiveness in connection with [Nextel’s] services (that issue is not before us) . . .”). *Id.* at 1403. The Board reiterated this point, stating “Again, we make no finding as to whether the chirp serves as a trademark for opposer’s services as that issue is not currently before us. Rather, based on the use of the ‘Nextel’ name in the

advertisements, we cannot find that consumers would associate the chirp with [Motorola's] cellular telephones." *Id.* at 1408.³

15. The Board specifically acknowledged that Nextel's application had been suspended pending the outcome of its opposition to Motorola's application. *Id.* at 1397-98.

16. Nonetheless, Motorola asserts in its Notice of Opposition that the doctrines of issue preclusion and claim preclusion operate as a bar to registration of Nextel's Chirp. Opp. ¶¶ 27-30.

17. Regarding issue preclusion, Motorola asserts that that the issues that are identical between the prior proceeding and this one are "whether the Chirp Tone is distinctive and functions as a mark," which Motorola also refers to as the "issues of distinctiveness and trademark use." *See id.* at ¶¶ 28(a), (c). Motorola further asserts that the Board necessarily determined in the prior proceeding "that the Chirp Tone was non-distinctive and did not function as a mark," and that Applicant is therefore precluded from proving that the mark "is distinctive and registrable on the Principal Register" here. *See id.* at ¶¶ 28(c), (d).

18. Regarding claim preclusion, Motorola asserts that "the second claim" (apparently Nextel's registration application here) is based on the same set of transactional facts as "the first" (apparently its opposition in the *Nextel v. Motorola* case), stating that

"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

³ The Board also stated that because it found that Motorola had failed to establish that the chirp had acquired distinctiveness as a source for Motorola's goods, "we need not make a separate determination as to [Nextel's] other ground for opposition, that applicant has not used the chirp as a trademark in commerce for cellular telephones." *Id.* at 1408.

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."

See Opp. at ¶ 29(c).

19. Nextel's Application encompasses services as to which the sound is emitted in the normal course of providing them (such as "push to talk" walkie-talkie communications services that operate on the iDEN network) as well as services as to which the Nextel Chirp is not emitted at all (such as position tracking data transmission services). *See id.* at ¶ 7.

20. Opposer asserts that as of the February 25, 2005 filing date of Nextel's application:

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."

See id. at ¶ 31.

21. Opposer asserts that, as a result, "the application is void ab initio as to the remaining services identified in the Chirp Tone service mark application." *See id.* at ¶ 32.

22. Contrary to Motorola's assertion in its opposition, Nextel's Application was based upon use in commerce as of the February 25, 2005 filing date of the application. *See* Application Serial No. 78/575,442.

III. ARGUMENT

A. Legal Standard

Summary judgment is appropriate when there are no genuine issues of material fact in dispute, leaving the movant entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c), 37 C.F.R. § 2.116(a); *see also Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743-44 (Fed.Cir. 1984) and *Flatley v. Trump*, 11 U.S.P.Q.2d 1284, 1287 (TTAB 1989).

Nextel, as the party moving for summary judgment, bears the initial burden of demonstrating that Motorola cannot establish an essential element of its case upon which it would bear the ultimate burden of proof at trial. *Celotex*, 477 U.S. at 322 (1986). However, Nextel does not need to support its motion with affidavits or other similar materials “negating” Motorola’s case. *Id.* at 323.

Once Nextel meets this burden, the burden passes to Motorola, as the non-moving party, to establish the existence of a genuine dispute regarding a factual element necessary to its case in order to avoid entry of an adverse judgment. A dispute is genuine only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant. *Sweats Fashions v. Pannill Knitting Co.*, 833 F.2d 1560, 1562, 4 U.S.P.Q.2d 1793, 1795 (Fed. Cir. 1987).

In the face of Nextel’s motion, supported by evidence, Motorola may not rest on mere denials or conclusory assertions, but must proffer affirmative countervailing evidence. *Otocom Systems, Inc. v Houston Computer Services, Inc.*, 16 U.S.P.Q.2d 1783, 1786 (Fed. Cir. 1990); *Blansett Pharmaceutical Co. v. Carmrick Laboratories, Inc.*, 25 U.S.P.Q.2d 1473, 1476 (TTAB 1992). If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party. Fed.R.Civ.P. 56(e).

B. Summary Judgment Denying Motorola's Preclusion Claims Is Appropriate

1. Motorola's Assertion that Nextel's Application Is Barred By Issue Preclusion Fails

Issue preclusion prevents relitigating issues previously adjudicated in a case between the same parties. *Wright & Miller*, 18 *Fed. Prac. & Proc. Juris.* § 4402 (2d. ed.). The doctrine applies only if four factors are present: (1) identity of an issue in the first and second proceedings; (2) the issue was actually litigated in the first proceeding; (3) the determination of the issue in the first proceeding was necessary to the resulting judgment; and (4) the party defending against preclusion had a full and fair opportunity to litigate the issue. *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1366, 55 U.S.P.Q.2d 1854, 1859 (Fed. Cir. 2000). Because there is no genuine dispute that none of these factors are met, Motorola's claim of issue preclusion necessarily fails.

a. There Is No Identity of Issues

Opposer bases its issue preclusion argument principally on a misstatement of the issues actually involved in the prior proceeding. In particular, Motorola asserts that the issues that are identical between the prior proceeding and this one are "whether the Chirp Tone is distinctive and functions as a mark," which Motorola also refers to as the "issues of distinctiveness and trademark use." Statement of Facts ¶ 17 (Opp. at ¶¶ 28(a), (c)). It says that the Board necessarily determined in the prior proceeding "that the Chirp Tone was non-distinctive and did not function as a mark," and that Applicant is therefore precluded from proving that the mark "is distinctive and registrable on the Principal Register" here. *Id.* (Opp. at ¶¶ 28(c), (d)). It thus seeks to preclude the Board from considering evidence in this proceeding about whether such a sound is distinctive when used with respect to Applicant's applied-for services, a number of which actually do not involve the emission of that sound in the course of their operation at all,

and whether Applicant has used the mark in such a way that it has acquired distinctiveness with respect to Applicant's services.

Based on both the essential nature of the Board's holdings and the Board's express disclaimers in its prior decision, however, it is obvious that the issues resolved in the prior proceeding differ materially from the issues presented in the current proceeding, and there is thus no material dispute as to the complete absence of any relevant facts that would be necessary to support a preclusion claim. The Board and the courts look beyond mere superficial overlaps or similarities when asked to determine whether or to what extent a registration application is barred by doctrines of issue or claim preclusion. *See, e.g., MasterCard Int'l Inc. v. American Express Co.*, 14 U.S.P.Q.2d 1551, 1553 (TTAB 1990) (finding that a district court's decision that GOLD CARD was generic as to card charge services did not support issue preclusion with respect to whether GOLD CARD was generic as to hotel and motel reservation services); *see also Nextel v. Motorola* at 1399 & n.11 (finding issue preclusion with respect to whether the Chirp functioned as a mark with respect to two-way radios but not cellular telephones with a two-way radio feature).

i. Inherent Distinctiveness. A threshold issue in the prior proceeding was whether the operational alert tone emitted by Motorola-manufactured communications devices could be considered inherently distinctive when used in connection with those goods. Statement of Facts ¶ 8 (*Nextel v. Motorola* at 1400-01). The Board's determination that it could not be so considered related only to Motorola's goods, and did not include any determination as to the status of such sounds in connection with a registration for services rather than goods. *Id.* (*see*

Nextel v. Motorola at 1400-01).⁴ Moreover, the current Application encompasses services as to which the Nextel Chirp is not emitted at all (such as position tracking data transmission services), not just services as to which the sound is emitted in the normal course of providing them (such as “push to talk” walkie-talkie communications services). Statement of Facts ¶ 19. Under any theory, a determination of lack of inherent distinctiveness in the prior proceeding, based on specific evidence that an operational alert tone was emitted by all the goods claimed in the application, cannot preclude an argument in this proceeding that the sound may be considered inherently distinctive with respect to particular services rather than goods, especially where the services include several as to which the sound is not emitted at all. *See Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 1233-34, 76 U.S.P.Q.2d 1310, 1314 (Fed. Cir. 2005) (reversing Board’s grant of summary judgment in opposition proceeding based on issue preclusion and claim preclusion, where, inter alia, registration would cover more goods than those at issue in prior infringement action)

Even if Motorola had asserted preclusion only with respect to the narrower issue of whether the Nextel Chirp could be considered inherently distinctive with respect to just those services as to which the Nextel Chirp may be emitted as part of their actual operation, the Board in *Nextel v. Motorola* never considered evidence on that issue and never determined that issue in

⁴ Opposer’s counsel, at least, has made the argument that the inherent distinctiveness ruling of the *Vertex* case, which was later followed by the Board in *Nextel v. Motorola*, applies only to goods, not services. Thomas M. Williams, *The Bell Tolls for Inherently Distinctive Sound Marks*, 77 Pat. Trademark & Copyright J. (BNA) 685, 688 (Apr. 17, 2009) (stating that “Sound Marks for Services Are Unaffected”).

its prior decision. *See Jet, Inc.*, 223 F.3d at 1366, 55 U.S.P.Q.2d at 1859 (“identity of issues” analysis requires review of actual facts and evidence in prior proceeding). If the Board is to resolve that issue here, it should do so on the basis of evidence presented for the first time in this proceeding, and not on the basis of Motorola’s unsupported issue preclusion argument.

ii. Acquired Distinctiveness. In addition, Applicant is not precluded by the prior decision from litigating whether the Nextel Chirp is or has become distinctive with respect to its applied-for services, since the Board’s prior decision was only with respect to whether the sound had acquired distinctiveness with respect to Motorola’s applied-for goods. The Board’s prior decision, on which Opposer relies exclusively for its issue preclusion claim, makes clear that there is no identity of issues. The Board expressly found only that “[Motorola’s] proposed chirp mark . . . , based on this record, has not acquired distinctiveness for [Motorola’s] cellular telephones.” Statement of Facts ¶ 13, *Nextel v. Motorola* at 1408 (emphasis added). Far from determining the issue now presented in connection with the current application, the Board’s decision specifically acknowledged that Nextel’s application had been suspended pending the outcome of its opposition to Motorola’s application. *Id.* at ¶ 15, *Nextel v. Motorola* at 1397-98.

Moreover, in connection with its review of evidence of a consumer survey regarding the chirp sound, the Board expressly stated that:

while we make no finding herein that the chirp has acquired distinctiveness in connection with [Nextel’s] services (that issue is not before us), we do not discount that numerous survey respondents identified [Nextel] as the source associated with the chirp.

See id. at ¶ 14, *Nextel v. Motorola* at 1403 (emphasis added). After reviewing the evidence on Nextel’s use of the chirp in its own advertising, the Board expressly stated that:

Again, we make no finding as to whether the chirp serves as a trademark for [Nextel’s] services as that issue is not currently

before us. Rather, based on the use of the “Nextel” name in the advertisements, we cannot find that consumers would associate the chirp with [Motorola’s] cellular telephones.

Id., *Nextel v. Motorola* at 1408 (emphasis added). It could hardly be clearer that the Board’s prior determination that the sound had not acquired distinctiveness and did not function as a mark for Motorola’s goods does not preclude Nextel from arguing in this new proceeding that it has acquired distinctiveness and does function as a mark for Nextel’s services.

b. The Other Issue Preclusion Factors Are Not Met

Motorola’s assertion of the issue preclusion doctrine necessarily fails, given the lack of identity of the issues. Motorola fails to meet the second requirement as well, because the issue of Nextel’s use was not actually litigated in the first proceeding. *Nextel v. Motorola* at 1403, 1408. Moreover, because the questions of whether Nextel’s use of the Chirp constituted trademark use and whether the Chirp had acquired distinctiveness with respect to Nextel’s services were not at issue in the prior proceeding, the determination of those questions could not have been “necessary to the resulting judgment,” and Nextel certainly did not have a “full and fair opportunity to litigate” them. *See id.*; *Jet, Inc.*, 223 F.3d at 1366, 55 U.S.P.Q.2d at 1859. Because the Board in *Nextel v. Motorola* was considering only whether the evidence presented by the parties supported a claim of acquired distinctiveness regarding Motorola’s application, *see* Statement of Facts ¶¶ 8,14-15, Nextel did not make a full presentation of its evidence of trademark use and was not required to present argument regarding the legal consequences of its use of the sound in connection with its own services.

That Motorola may have sought to piggy-back on some of Nextel’s own trademark use in support of its claims makes no difference. The Board did not reject Motorola’s argument because of a determination that there was no use of the mark by Nextel, but rather because of its

finding that the Nextel advertisements showed no use to which Motorola could lay claim in support of its application – a completely different question. *See* Statement of Facts ¶ 14, *Nextel v. Motorola* at 1408 (“Again, we make no finding as to whether the chirp serves as a trademark for opposer’s services as that issue is not currently before us. Rather, based on the use of the ‘Nextel’ name in the advertisements, we cannot find that consumers would associate the chirp with [Motorola’s] cellular telephones.”) (emphasis added).

Motorola’s assertion that issue preclusion is applicable because the Board determined in the prior proceeding “that the Chirp Tone was non-distinctive and did not function as a mark” fails to recognize the critical fact that the Board’s determination was exclusively with respect to Motorola’s goods, and not Nextel’s services. The Board, by contrast, expressly recognized the significant difference between consideration of the evidence of record in relation to Motorola’s goods and consideration of that evidence in relation to Nextel’s services – the difference that Motorola’s opposition in this case seeks to conflate.

It would be especially illogical and inequitable to apply issue preclusion here, when the Board’s own *dicta* in the prior case indicated that it could well reach an opposite conclusion in a case properly raising the issue of Nextel’s, rather than Motorola’s, trademark rights in the chirp sound. The Board stated that, “to the extent that a viewer of these advertisements would consider the chirp as a trademark, it is more likely that the viewer would associate the chirp with [Nextel’s] services, rather than [Motorola’s] cellular telephones,” that “in all of [Nextel’s] advertisements of record, the source-association made with the chirp, if any, is with ‘Nextel,’” and that the impression Nextel’s advertising spots created was that the advertiser was seeking “to associate the chirp with ‘Nextel.’” Statement of Facts ¶¶ 10-11 (*Nextel v. Motorola* at 1407). Motorola’s argument that the Board may not hear evidence and argument seeking to demonstrate

the association it observed in the prior case in a case where the issue is now squarely before it would be a miscarriage of justice.

The obvious nature and express language of the *Nextel v. Motorola* decision are undisputed (indeed, indisputable). Because, in light of these undisputed facts, there is no identity of issues between the previous opposition and the current opposition as to the inherent distinctiveness or acquired distinctiveness of the Nextel Chirp with respect to the applied-for services, and particularly because the Board's prior decision expressly stated that it was not determining the issue of the distinctiveness of the mark with respect to Nextel's services, Motorola cannot show that the requirements for issue preclusion are met, and summary judgment denying Motorola's issue preclusion argument is appropriate.

2. Motorola's Assertion that Nextel's Application Is Barred By Claim Preclusion Also Fails

Motorola's assertion that the doctrine of claim preclusion bars Nextel altogether from seeking a registration for the Nextel Chirp is premised on the same flawed arguments as its issue preclusion allegations. *See* Statement of Facts ¶ 18 (Opp. at ¶ 29(c)). Claim preclusion prevents a second lawsuit involving the same parties and a cause of action based on the same facts, whether or not the cause of action was raised in a previous adjudication. *Wright & Miller*, 18 *Fed. Prac. & Proc. Juris.* § 4402 (2d. ed.). Three requirements must be met: (1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first. *Jet, Inc.*, 223 F.3d at 1362-63, 55 U.S.P.Q.2d at 1856 (*citing Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n. 5 (1979)).

For the reasons discussed above regarding the lack of identity of issues with respect to issue preclusion, this opposition proceeding does not involve the same claim that was resolved in

the prior proceeding. A claim in which Nextel challenged Motorola's rights in the mark is fundamentally different from the current proceeding, in which Nextel is seeking to demonstrate its own rights in the same mark. *See id.* 223 F.3d at 1363, 55 U.S.P.Q.2d at 1857 (Federal Circuit holds that infringement litigation, in which plaintiff asserts its own rights in a mark against defendant, does not involve the same claim as subsequent cancellation proceeding in which same plaintiff seeks to establish that same defendant does not have rights in same mark). Even though the same two parties and the same sound mark are involved, Nextel's application to establish its rights in the mark could not possibly be precluded by its successful prior opposition to Motorola's attempts to assert its own rights in that mark. Indeed, the Board was quite clear that it was reserving, and not deciding, the issue of the registrability of the sound as a mark for Nextel services. Statement of Facts ¶ 14, *Nextel v. Motorola* at 1397-98, 1403, 1408.

There is no genuine dispute regarding any material fact regarding the clear conclusion that the *Nextel v. Motorola* decision did not involve the same claim as that at issue in the instant proceeding. Summary judgment disposing of Motorola's claim preclusion argument is appropriate.

IV. CONCLUSION

For the reasons stated above, Applicant Nextel Communications, Inc., respectfully requests the Board to issue an order of summary judgment holding that neither issue preclusion nor claim preclusion bars registration of the Nextel Chirp or the introduction of evidence establishing the distinctiveness of and Nextel's use of that mark, and denying the claims made by Motorola in paragraphs 25-30 of its Notice of Opposition.

Respectfully submitted,



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February 6, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S MOTION FOR SUMMARY JUDGMENT ON PRECLUSION was served on counsel for Opposer this 6th day of February, 2012, by sending same via First Class Mail, postage prepaid, to:

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