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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 OPPOSITION TO OPPOSER’S MOTION FOR SUMMARY
JUDGMENT ON PRECLUSION**

Applicant Nextel Communications, Inc.¹ (“Applicant” or “Nextel”) hereby opposes Motorola Mobility, Inc.’s and Motorola Trademark Holdings, LLC’s (collectively “Opposer” or “Motorola”) motion pursuant to Federal Rule of Civil Procedure Rule 56(b) and Trademark Trial and Appeal Board Manual of Procedure Rule 528 for summary judgment (“Motorola Motion”) that registration of the Nextel Chirp as set forth in U.S. Trademark Application Serial No. 78/575,442 is 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 (T.T.A.B. 2009) (“*Nextel v. Motorola*”).

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

I. INTRODUCTION

Motorola's Motion for Summary Judgment seeks to bar Nextel altogether from pursuing any registration of the Chirp as a mark for its services, essentially on the ground that Motorola was unable to prove in a prior Board proceeding that it should obtain a registration for the Chirp as a mark for its own goods. Its arguments distort the law and the facts in an attempt to justify such an unprecedented ruling. Especially in light of the Board's explicit reservation in its prior decision of the very claims and issues Motorola now seeks to prevent the Board from hearing, and because Motorola's arguments are not supported by the law or the facts, its Motion should be denied.

II. STATEMENT OF ADDITIONAL FACTS

The facts relevant to the preclusion arguments presented here consist of the Board's decision in *Nextel v. Motorola*, the prosecution history of Nextel's application in this proceeding, and certain evidence introduced in the prior proceeding. Motorola's Statement of Facts does not specify the facts that it asserts are undisputed, as required pursuant to Trial and Appeal Board Manual of Procedure Rule 528.01. *See* Motorola Motion at 4-11. Moreover, several paragraphs of Motorola's Statement consist of argument combined with partial factual statements. Nextel is thus unable to respond narrowly and directly to Motorola's Statement in order to identify disputed facts, if any. Motorola's Statement, however, omits portions of the Board's decision, the prosecution history, and the record evidence from the prior proceeding that are relevant to the determination of the preclusion issues. Nextel provides the following additional facts in order to provide the Board with these relevant omitted facts.

A. Nextel's Application for Registration of the Chirp

1. Nextel is not claiming inherent distinctiveness with respect to the services that emit the Chirp as part of their operation. *See* October 29, 2009 Response to Office Action (providing a list of applied-for services that involve sound emissions and stating that applicant believes the mark had acquired distinctiveness with respect to the foregoing services while pointing out that other applied-for services were not included on the list because they did not emit a sound as part of their operation); *see also* Bowman Declaration, attached to October 29, 2009 Response to Office Action. Nextel is claiming inherent distinctiveness with respect to the services that do not emit the Chirp as part of their operation. *Id.*

B. The TTAB'S Findings in Nextel v. Motorola

2. The Board made no finding in *Nextel v. Motorola* regarding whether the Chirp had acquired distinctiveness or served as a trademark in connection with Nextel's services. *Nextel v. Motorola*, at 1403, 1408.

3. The limited evidence of Nextel's use of the Chirp in the *Nextel v. Motorola* case was presented to rebut Motorola's arguments that it had exclusively used the mark and that the mark had acquired distinctiveness in connection with Motorola's goods, and was not considered as evidence establishing Nextel's rights or its entitlement to registration of the Chirp in connection with Nextel's services. *Id.* at 1403, 1408.

4. The Board found in *Nextel v. Motorola* that the Chirp as emitted from Motorola cellular phones would not be perceived by consumers as a source identifier or trademark "affixed" to Motorola's goods. The Board reached the same conclusion regarding "limited edition models" of Motorola phones that also included the trademarks of others. *Id.* at 1404.

5. The Board found that the Chirp did not serve a trademark function for Motorola during demonstrations of iDEN-enabled cellular telephones at tradeshows. *Id.* at 1404.

6. The Board found that product placement advertisements – where the Chirp was heard in television programs and movies as part of the operation of the cellular telephone – did not cause viewers to perceive the Chirp as a source-identifier for Motorola goods. *Id.* at 1405.

7. The Board found that Motorola’s evidence of its two radio and television ads did not support its argument that the Chirp is a source-identifier for Motorola goods. *Id.* at 1406.

8. The Board found that advertisements produced as part of the co-op advertising support program did not cause consumers to associate the Chirp with Motorola’s cellular telephones. *Id.* at 1408.

9. The Board in *Nextel v. Motorola* denied Motorola’s application for registration of the Chirp in connection with cellular telephones because the mark was not inherently distinctive for Motorola’s cellular telephones and had not acquired distinctiveness for Motorola’s cellular telephones. *Id.* at 1404, 1408.

10. The Board in *Nextel v. Motorola* acknowledged that a mark can have acquired distinctiveness despite use by others, but found that Nextel’s own use of the Chirp had been substantial, and that Motorola’s claimed use was therefore not “substantially exclusive.” *Id.* at 1408.

11. In Opposition No. 91/161,817 (the “911 Hz Case”) the Board sustained Nextel’s opposition to Motorola’s attempt to register a nearly identical mark (the sound had the same cadence, but with a tone at 911 Hz instead of 1800 Hz) on the ground that, based on that record, the 911 Hz chirp failed to function as a trademark for two-way radios. *Id.* at 1398.

12. Based on the 911 Hz decision, the Board in *Nextel v. Motorola* found that issue preclusion applied to Motorola's attempt to register the Chirp for two-way radios (but did not preclude Motorola from seeking to establish that the Chirp should be registered as a mark for its cellular telephones). *Id.* at 1399.

C. Nextel's Use of the Chirp

13. Nextel has used the Chirp in marketing and advertising Nextel services that do not use the Chirp sound in their normal operation. Appendix A, Declaration of Ann M. Mace in Support of Applicant's Opposition to Opposer's Motion for Summary Judgment on Preclusion ("Mace Decl.") at Exhibit 1 (Schweitzer Testimony at 56-58, 61, 62, 65, 70).

14. In the *Nextel v. Motorola* proceeding, Mr. Mark Schweitzer, former Chief Marketing Officer, presented testimony in 2007 regarding Nextel's use of the Chirp as a mark and as a brand from 1997 through at least 2007. Motorola Motion at 9; Appendix A, Mace Decl. at Exhibit 1 (Schweitzer Testimony at 56-58, 62, 65, 70).

15. For example, starting in the summer of 2003, Nextel ran television ads that included the "Nextel Done" tagline, which featured a vertical bar that read "Nextel Done" that came down over the screen as the Chirp sound was heard. The ad was intended to emphasize that "Nextel meant instant, you got things done with Nextel." *Id.* (Schweitzer Testimony at 56-57, 65).

16. In another set of ads, the "Nextel Cup Nascar ads," Nextel used the Chirp sound to associate Nextel with speed. *Id.* (Schweitzer Testimony at 58).

17. Another example of Nextel's use of the Chirp as a brand beyond goods or services that use the sound in their operation was the "CBS Sports package." One facet of that ad

campaign was that Nextel was featured during the football game half-time show, and the Chirp sound was used in connection with any mention of Nextel. *Id.* (Schweitzer Testimony at 70).

18. Mr. Schweitzer testified that Nextel ads featuring the Chirp fell into two categories, one of which involved using the Chirp even though the ad did not feature a good or service (such as Direct Connect) that emitted the Chirp:

You have ads that are about cellular features like no roaming or one-second rounding . . . , and in the case of the first ad on the tape, "vacuum, no roaming," and the third ad on the tape, "one-second rounding," both of those use the chirp as a signature ending in spite of the fact direct connect wasn't featured in the ad.

Id. (Schweitzer Testimony at 62).

19. Mr. Schweitzer testified that one such ad had been broadcast as early as 1997, used the Chirp as a tagline in a commercial about Nextel's cellular communications pricing plan.

Id. (Schweitzer Testimony at 61-62).

20. Mr. Schweitzer also testified that after 1999, he intended to use the Chirp in all television and radio ads. He explained that "if it was a non-direct-connect ad, it most likely would appear in connection with a tag line; if it was [a] direct connect ad, it might appear both inside and with the tag line." *Id.* (Schweitzer Testimony at 65). Then, in 2003, beginning with the "Nextel Done" campaign, the company adopted a policy to include the Chirp sound in all television and radio ads. *Id.* (Schweitzer Testimony at 65-66).

III. ARGUMENT

A. Motorola Is Not Entitled to Summary Judgment on Claim Preclusion

Motorola argues that Nextel cannot register the Chirp Tone at all for any of its services because the Board denied Motorola's own application to register the Chirp for "cellular telephones and two-way radios." Motorola Motion at 12. It says that Nextel is barred from "relitigating the same claim" in this case. *Id.*

Motorola's argument for claim preclusion misses the forest for the trees. The "claim" resolved in the first proceeding was whether the Chirp could be registered as a mark for Motorola's goods. The "claim" presented here is that the Chirp should be registered as a mark for Nextel's services. Not only was this claim not decided in the first case, it could not have been decided in the first case. Statement of Additional Facts ("Additional Facts") ¶ 2; *Nextel v. Motorola* at 1397-98 (Nextel's application had been suspended), 1403, 1408 (whether the Chirp serves as Nextel's trademark "is not before us"), 1409 n.16 (even if issue of Nextel's ownership of the mark had been fully litigated, "because we find that [Motorola] has not established on this record that the chirp has acquired distinctiveness for [Motorola's] cellular telephones, we need not determine any [Nextel] ownership issue."). Motorola's motion for summary judgment on claim preclusion grounds should be denied.

Even looking at the "trees" rather than the "forest" does not change this conclusion. For Motorola to prevail on a claim of *res judicata* (claim preclusion), it must prove that the instant opposition is based on the same "set of transactional facts" as in *Nextel v. Motorola*. See *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1362, 55 U.S.P.Q.2d 1854, 1856 (Fed. Cir. 2000).² Courts have defined the term as a "core of operative facts," the "same operative facts," or the "same nucleus of operative facts," and "based on the same, or nearly the same factual allegations." *Herrmann v. Cencom Cable Assocs., Inc.*, 999 F.2d 223, 226 (7th Cir. 1993) (citing *Parsons Steel, Inc. v. First Ala. Bank*, 474 U.S. 518, 521 (1986)). But the fundamental

² Because Motorola cannot meet the transactional facts test, we do not address the other necessary elements of proving claim preclusion as stated in the *Jet, Inc.* decision, *i.e.*, that the parties are identical or in privity and that the first suit proceeded to a final judgment on the merits. *Jet, Inc.*, 223 F.3d at 1362, 55 U.S.P.Q.2d at 1856.

requirement is that the “same cause of action” is or could have been litigated in the first case. *See Lawlor v. Nat’l Screen Serv. Corp.*, 349 U.S. 322, 329 (1955) (“[A] prior judgment is *res judicata* only as to suits involving the same cause of action.”).

Moreover, material operative facts that occurred after the decision in the first proceeding, taken by themselves or in conjunction with facts from the first proceeding, “comprise a transaction which may be made the basis of a second action not precluded by the first.” Restatement (Second) of Judgments 24 cmt. f; *see also Lawlor*, 349 U.S. at 327-28 (prior dismissal of antitrust complaint did not bar new antitrust complaint based on conduct occurring after the first judgment).

This opposition does not involve the same cause of action as the first case, and the facts that will be presented here will include additional operative facts and later-occurring operative facts. Motorola’s assertion of claim preclusion fails as a matter of law because it does not satisfy the “same transactional facts” prerequisite of the legal standard.

None of Motorola’s additional arguments provide a basis for finding claim preclusion.

1. Motorola’s Attempts to Equate its Goods with Nextel’s Services Are Unavailing

Motorola attempts to gloss over one of the fundamental gaps in its claim preclusion argument by asserting that the “two-way radio services” at issue here are “inextricably intertwined” with or “inseparable” from the “two-way radio’ goods” in *Nextel v. Motorola*. Motorola Motion at 15 (emphasis added). There are two separate problems with Motorola’s arguments, each of which obviates Motorola’s assertions.

First, all of the cases Motorola cites in support of the proposition that the Board should not distinguish between Motorola’s goods and Nextel’s services, Motorola Motion at 15-16, involve a materially different situation that is inapplicable to the circumstances here. Those

cases hold simply that the generic name of a product must also be held generic with respect to the service of selling that product. *In re Tires, Tires, Tires*, 94 U.S.P.Q.2d 1153, 1159 (T.T.A.B. 2009) (TIRES, TIRES, TIRES generic for a retail tire store); *In re A La Vieille Russie, Inc.*, 60 U.S.P.Q.2d 1895, 1900 (T.T.A.B. 2001) (RUSSIANART generic for applicant's Russian art dealership service); *In re Log Cabin Homes, Ltd.*, 52 U.S.P.Q.2d 1206, 1210 (T.T.A.B. 1999) (LOG CABIN HOMES generic for "retail outlets featuring kits for constructing buildings, especially houses"). The Board did not find in *Nextel v. Motorola* that the Chirp was generic with respect to Motorola's goods. Nor does the instant application seek registration for the service of selling "Chirps," or even of selling Motorola's goods.

Second, the Board's decision in *Nextel v. Motorola* expressly stated that it was not considering or determining the registrability of the Chirp as a mark for Nextel's services. Additional Facts ¶ 2; *Nextel v. Motorola* at 1397-98, 1403, 1408, 1409 n.16. Moreover, the Board, applying the law of preclusion in *Nextel v. Motorola*, expressly declined to apply preclusion with respect to goods in Motorola's application that were not identical to the goods addressed in Motorola's first sound mark application. Additional Facts ¶ 12; *Nextel v. Motorola* at 1399. The Board applied issue preclusion³ with respect to the registrability of a chirp sound used in the "two-way radios" that were claimed in both of Motorola's applications for registration, but not to the overlapping and interrelated goods ("cellular telephones, albeit with a two-way radio feature") that were claimed only in Motorola's second application. Additional Facts ¶ ¶ 11-12; *Nextel v. Motorola* at 1399 & n. 11 ("Here, the application. . . covers cellular

³ Although Motorola cites this decision in support of its proposed claim preclusion argument, Motorola Motion at 15, the Board was clear that it was applying issue preclusion, since it was relevant only to a portion of the goods covered by the application. *Nextel v. Motorola* at 1399 & n. 13.

telephones *and* two-way radios, the latter goods being the same as those in the 911 Hz proceeding. . . . To be clear, we find that issue preclusion is not applicable to applicant's proposed mark in connection with cellular telephones."'). Thus, Motorola's assertion that a decision regarding the non-registrability of the Chirp for its cell phones precludes registration of the Chirp for Nextel's services, including both services that emit the Chirp as well as those that do not, stands in direct contradiction to the Board's preclusion decision in *Nextel v. Motorola*.⁴

2. The Transactional Facts Regarding Inherent Distinctiveness are Not the Same

Motorola seeks to assert that the Board's application of the *In re Vertex* ruling in *Nextel v. Motorola* to find that the Chirp was not inherently distinctive with respect to Motorola's cell phones precludes an inherent distinctiveness claim for Nextel's services here, "given the relationship between Motorola's iDEN® Goods and Nextel's iDEN® services." Motorola Motion at 16. In support of this argument, Motorola cites to statements contained in Nextel's answer and prior testimony, and the prosecution history of the instant application.

But Motorola's asserted "support" ignores a critical fact. All of Motorola's citations relate to Nextel services that emit the Chirp during provision of the service, but Nextel is not claiming inherent distinctiveness with respect to any of those services. Additional Facts, ¶ 1. Rather, as is clear from the prosecution history of the instant application, Nextel asserts that the

⁴ Moreover, Motorola's argument misses the point: the Board's application of the preclusion doctrine with respect to Motorola's two-way radios was premised on Motorola's own earlier application for the same goods. That is not the case for Nextel's application here. Unlike the Board's decisions regarding the registrability of a chirp sound for Motorola's two-way radios in the two prior decisions, the Board's decision with regard to Motorola's cellular telephones in *Nextel v. Motorola* was not based on the same set of transactional facts as is presented here.

Chirp is inherently distinctive only with respect to those services in its application that do not emit the Chirp. *Id.* There is substantial evidence that the Board will need to consider in this opposition regarding that issue. *See, e.g.*, Additional Facts, ¶¶ 13-20. Motorola’s assertion that the doctrine of claim preclusion requires the denial of Nextel’s assertion of inherent distinctiveness on summary judgment fails for this reason alone.

Indeed, *In re Vertex Group, LLC*, on which the Board’s inherent distinctiveness decision in *Nextel v. Motorola* was based, held only that a sound mark cannot be inherently distinctive with respect to goods that emit the sound in their normal course of operation. *In re Vertex*, 89 U.S.P.Q.2d 1694, 1700 (T.T.A.B. 2009). *In re Vertex* does not address at all the question of whether a sound mark may be inherently distinctive with respect to services that do not involve the emission of that sound, such as Nextel’s services that do not emit the Chirp during their normal operation, including GPS and fleet location services, that have been advertised using the Chirp. *Compare* Nextel Trademark Application (Feb. 25, 2005) to services listed as emitting sound in Oct. 29, 2009 Response to Office Action. A sound mark can be inherently distinctive with respect to such services. *In re General Elec. Broadcasting Co.*, 199 U.S.P.Q. 560, 563 (T.T.A.B. 1978) (“unique, different or distinctive” sounds can be registered without proof of secondary meaning). The set of transactional facts relevant to Nextel’s inherent distinctiveness claim in this proceeding were simply not at issue in *Nextel v. Motorola*.⁵

⁵ At a minimum, there is a genuine dispute regarding whether Motorola’s cellular phones are sufficiently similar to services that do not emit the chirp during their operation to constitute the same “transactional facts.” Thus, even if the Board were not to grant Nextel’s own motion for summary judgment with respect to claim preclusion, denial of Motorola’s cross-motion on its claim preclusion allegations regarding Nextel’s claim of inherent distinctiveness is appropriate given the genuine dispute regarding the transactional facts presented in the two proceedings.

3. The Transactional Facts Regarding Acquired Distinctiveness are Not the Same

Motorola next argues that because the Board's finding in *Nextel v. Motorola* that Nextel's substantial use of the Chirp in advertising negated Motorola's ability to claim that it had made substantially exclusive use of the Chirp, the Board is now required to hold that Motorola's "use" correspondingly negates Nextel's ability to assert substantially exclusive use of the Chirp in connection with its services. Motorola Motion at 17-18; Additional Facts ¶ 10. This ground for asserting claim preclusion⁶ with respect to Nextel's claim of acquired distinctiveness fails as a matter of law and fact.

First, Motorola's position is based on a mischaracterization of the transactional facts that were at issue in *Nextel v. Motorola*. Motorola asserts that "the parties' concurrent use was the subject of the prior *Nextel v. Motorola* case." Motorola Motion at 18. This is not the case. Rather, the question in *Motorola v. Nextel* was whether Nextel's substantial use of the Chirp as a Nextel mark negated Motorola's assertion that it had made substantially exclusive use of the Chirp itself. *Nextel v. Motorola* at 1402, 1408. The Board found Motorola had no substantially exclusive use of the Chirp in connection with cell phones. *Id.* at 1408; Additional Facts ¶ 10. Contrary to Motorola's assertions, that determination does not mean that the converse is true, as the transactional facts surrounding Nextel's claim of acquired distinctiveness, including whether Nextel's substantial use has been substantially exclusive, were not considered in *Nextel v. Motorola*. Additional Facts ¶ 3. Motorola's argument fails for this reason alone.

The case Motorola cites in supposed support of its illogical argument instead undercuts that argument. Motorola represents in its Motion that the Board's decision in *Flowers Indus.*,

⁶ Again, this appears more properly to be an argument relating to issue preclusion.

Inc. v. Interstate Brands Corp., 5 U.S.P.Q.2d 1580 (T.T.A.B. 1987) holds that “‘descriptive’ uses [are] relevant to [a] Section 2(f) analysis.” Motorola Motion at 18. Motorola presumably makes such a misrepresentation of the case’s holding in order to suggest that its own non-trademark “use” of the Chirp should somehow be held to preclude a finding that Nextel’s use of the Chirp was substantially exclusive. *See id.* But the Board actually held in that case that while numerous third parties had used the asserted mark in a merely descriptive manner, the evidence showed that the applicant had also used the asserted mark only in a descriptive manner. *Flowers Indus., Inc. v. Interstate Brands Corp.*, 5 U.S.P.Q.2d at 1589 (“there is no real difference between applicant’s manner of use” and that of the numerous third parties). Moreover, the Board found that “the evidence of record convinces us that purchasers who encounter the bread products of applicant, opposer, and others bearing the descriptive designation ‘HONEY WHEAT’ would regard the designation as nothing more than the descriptive name of a type of bread.” *Id.*

The law is clear that use of a mark may be considered “substantially exclusive” for Section 2(f) purposes even if the applicant’s use was not actually and completely exclusive, so long as any use by others was “inconsequential or infringing.” *See L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352, 52 USPQ2d 1307, 1309 (Fed. Cir. 1999); TMEP § 1212.05(b); Additional Facts ¶ 10; *see also Nextel v. Motorola* at 1408 (acknowledging that acquired distinctiveness may be established despite use by others, but not if such others’ use is substantial, and finding that Nextel’s use of the Chirp was “at the very least, substantial,” but making no such finding with respect to Motorola’s alleged use of the Chirp). Nextel intends to show that any “use” of the Chirp by Motorola or others was inconsequential or infringing, and Nextel is not

precluded from making such a showing, either logically or legally, by the Board's rejection of Motorola's acquired distinctiveness claim in *Nextel v. Motorola*.⁷

B. Motorola is Not Entitled to Summary Judgment on Issue Preclusion

Like its claim preclusion argument, Motorola's issue preclusion argument relies on unwarranted reinterpretations of the issues and rulings actually addressed in *Nextel v. Motorola*. Motorola cannot prevail if it cannot show "identity of an issue in the first and second proceedings." *Jet, Inc.*, 223 F.3d at 1360, 55 U.S.P.Q.2d at 1859. Motorola's Motion itself reveals that it cannot make this showing – the issues that were litigated in *Nextel v. Motorola* are not the same as those presented here.

1. Motorola's "Inseparability" Theory Does Not Create an Identity of Issues

Motorola identifies three issues that the proceedings purportedly share: "(1) whether the Chirp Tone functioned as a mark in connection with two-way radios; (2) whether it was inherently distinctive in connection with cellular telephones; and (3) whether it had acquired

⁷ Moreover, Motorola's assertion that "the parties' use of the Chirp Tone, their promotional efforts, such as product placement, radio and television advertising, survey evidence, and a co-operative advertising program" are somehow "the same transactional facts," Motorola Motion at 17, is premised on a mischaracterization of the transactional facts in the respective proceedings. Although the Board in *Nextel v. Motorola* did consider evidence of Nextel's use of the Chirp in advertising, it did so only to find that Motorola could not lay claim to Nextel's use to support its own claim of acquired distinctiveness with respect to its products. *Nextel v. Motorola* at 1407; Additional Facts ¶ 3. In fact, the Board's rejection of Motorola's argument was premised in part on its findings that Nextel's advertisements showed use of the mark and customer recognition of the Chirp in association with Nextel, not Motorola. *Nextel v. Motorola* at 1407; Additional Facts ¶ 8. But it would be nonsensical for the Board's rejection of Motorola's attempts to rely on Nextel's advertising to try to show its own use of the Chirp as somehow precluding Nextel from presenting evidence about its advertising in this proceeding to demonstrate acquired distinctiveness in connection with Nextel's services.

distinctiveness in connection with cellular telephones.” Motorola Motion at 19. But for each of the three issues, the only subject addressed by the Board was Motorola’s two-way radios and cellular telephones.⁸ In an attempt to cure that obvious flaw in its preclusion argument – that Nextel’s use of the Chirp as a mark and Nextel’s services were not actually at issue in the previous proceeding – Motorola argues that the alleged “inseparability” of its goods and Nextel’s services nonetheless satisfies the “identity of issues” component of the issue preclusion test. Motorola Motion at 20. Motorola cites no cases in support of this position. To the contrary, the Board and courts look beyond superficial overlaps or similarities when determining whether 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 (T.T.A.B. 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); *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).

⁸ Regarding two-way radios, the *Nextel* Board stated: “Here, the application subject to this proceeding covers cellular telephones *and* two-way radios, the latter goods being the same as those in the 911 Hz proceeding. Thus, the Board’s 911 Hz decision finding [Motorola’s] 911 Hz chirp failed to function as a mark on [Motorola’s] two-way radios does have a preclusive effect inasmuch as the application before us now includes two-way radios.” (emphasis in original; footnotes omitted). *Nextel v. Motorola* at 1399. And, regarding cellular telephones, the Board found that “[Motorola’s] proposed chirp mark is not inherently distinctive, and based on this record, has not acquired distinctiveness for [Motorola’s] cellular telephones. . .” *Id.* at 1408.

Motorola then urges the Board to extrapolate its expressly limited prior determinations even further, and to preclude Nextel from arguing that the Chirp functions as a mark, is inherently distinctive,⁹ or has acquired distinctiveness with respect to all of Nextel's applied-for goods and services, including those that do not emit the Chirp as part of their operation.

Motorola Motion at 21. Motorola provides no support for its position. But the Board in *Nextel v. Motorola* declined to apply issue preclusion in this very way. In that case, because Motorola's previous application related only to two-way radios, the Board found that issue preclusion did not apply to additional goods included in Motorola's subsequent application. *Nextel v. Motorola* at 1399.

Finally, surprisingly, Motorola's brief fails to explain the Board's repeated, express statements in *Nextel v. Motorola* that it was not determining Nextel's rights in the Chirp mark:

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.

Nextel v. Motorola at 1403 (emphasis added). The Board further 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. at 1408 (emphasis added). Those issues are now squarely presented for the Board's

⁹ The *Nextel* Board relied on *In re Vertex* in determining that Motorola's use of the chirp was not inherently distinctive. *Vertex* does not require preclusion for services and applies to goods only. See *supra*, Section III(A)(2).

consideration and determination in this proceeding. They are in no way precluded by the Board's prior determination, and Motorola's Motion should be denied.

2. Because There Is No Identity of Issues, the Remaining Portions of the Issue Preclusion Test Are Irrelevant

Nextel does not dispute that *Nextel v. Motorola* determined Motorola's rights to the Chirp mark, and that those issues were actually litigated, the determination was necessary to the resulting judgment, and that Nextel had a full and fair opportunity in the prior proceeding to litigate the issues relating to Motorola's rights. Additional Facts ¶ 4-9. As explained fully above, however, Nextel's rights in the Chirp tone have never been at issue and therefore have not been actually litigated, there has been no resulting judgment, and there has been no opportunity for Nextel to present all its evidence relating to its use of the mark. *See Nextel v. Motorola* at 1403, 1408.

Moreover, the limited evidence of Nextel's use of the Chirp in the *Nextel v. Motorola* case was presented to rebut Motorola's arguments that it had used the mark exclusively and that the mark had acquired distinctiveness in connection with Motorola's goods, *not* to seek a determination of Nextel's rights. *Nextel v. Motorola* at 1403, 1408; Additional Facts ¶ 3; *see also supra*, Section III(A)(3) (Motorola's inability to show substantially exclusive use of the Chirp in connection with cell phones not the same transactional facts or issues as whether Nextel's use of the Chirp in connection with its services was substantially exclusive.).

IV. CONCLUSION

For the reasons stated above, Applicant Nextel Communications, Inc., respectfully requests that the Board (1) deny Motorola's motion for summary judgment in its entirety, and (2) issue an order granting Nextel's cross-motion for summary judgment and 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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March 12, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S
OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT ON PRECLUSION
was served on counsel for Opposer this 12th day of March, 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



APPENDIX A

**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

**DECLARATION OF ANN M. MACE IN SUPPORT OF APPLICANT'S MOTION FOR
LEAVE TO USE TESTIMONY FROM ANOTHER PROCEEDING IN
SUPPORT OF ITS OPPOSITION TO APPLICANT'S MOTION FOR
SUMMARY JUDGMENT ON PRECLUSION**

I, Ann M. Mace, declare as follows:

1. I am an attorney with the law firm of Crowell & Moring, LLP, in Washington DC.
2. Attached as Exhibit 1 is a true and correct copy of excerpts from the testimonial deposition transcript of Mark Schweitzer from the opposition proceeding captioned as *Nextel Communications, Inc. v. Motorola, Inc.*, (T.T.A.B. Case No. 91/164,353) appearing at docket entry 71. This document was downloaded from the TTABVUE web page on March 12, 2012.

I certify under penalty of perjury that the foregoing is true and correct.

March 12, 2012



Ann M. Mace

EXHIBIT 1

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HIGHLY CONFIDENTIAL - M. SCHWEITZER
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----x

NEXTEL COMMUNICATIONS, INC.,)



)
Opposer,)

) Opp. No. 91/164,353

v.) App. No. 78/235,365

) Pot. Mark SENSORY MARK

MOTOROLA, INC.,)

(1800 Hz Tone)

)
Applicant.)

-----x

HIGHLY CONFIDENTIAL
DEPOSITION OF MARK ANDREW SCHWEITZER
New York, New York
Friday, November 30, 2007

Reported by:

KATHY S. KLEPFER, RMR, RPR, CRR, CLR

JOB NO. 14336

1 HIGHLY CONFIDENTIAL - M. SCHWEITZER
2 sought to distinguish itself as the ultimate
3 productivity partner, so the ability to get
4 things done instantly, and because direct
5 connect was the most efficient form of wireless
6 communication in terms of instant
7 communications, the chirp was synonymous with
8 direct connect and, as a marketing reality,
9 nobody else could provide that functionality,
10 therefore, nobody else who used that sound would
11 ever be able to associate it with that marketing
12 capability.

13 So we believed it, in a world where we
14 were being out-spent, you know, [REDACTED] by
15 other wireless carriers in marketing, that we
16 needed a personality that associated us with,
17 you know, a unique, different solution to other
18 wireless carriers, and the chirp was synonymous
19 with that.

20 Q. Has Nextel's use of the chirp in
21 marketing and advertising continued?

22 A. It has. Pre-merger, I'll kind of use
23 the example of the Done Campaign, where we went
24 through an advertising review. We developed a
25 new tag line, which was "Nextel Done," and there

1 HIGHLY CONFIDENTIAL - M. SCHWEITZER
2 was a signature element which was a finish line
3 that punctuated all audio and visual advertising
4 and the finish line would come down and
5 connected to the chirp.

6 Q. What was the finish line?

7 A. It's a vertical bar that, you know, it
8 would read "Nextel Done," the bar would come
9 down and the chirp would go in connection with
10 that. And again, it was a way of punctuating
11 that Nextel meant instant, you got things done
12 with Nextel, and the chirp was associated with
13 that.

14 We were also kind of trying to take
15 advantage of this natural phenomena which,
16 because direct connect conversations are less
17 than [REDACTED], in a given year -- I'll take
18 the year 2003 as an example -- Nextel would have
19 had [REDACTED] of its conversations on the
20 network were direct connect conversations and
21 only [REDACTED] were cellular conversations.

22 The length of cellular calls was a lot
23 longer, but whether you were a Nextel user or
24 not, it became kind of inescapable to, at your
25 place of work, at sporting events, to have heard

1 HIGHLY CONFIDENTIAL - M. SCHWEITZER

2 that sound, and so we sought to take advantage
3 of that sort of natural proliferation of sound
4 and, again, the linkage to the core of our
5 brand, which was getting things done in instant
6 communications. So we wanted to connect it very
7 specifically to the Nextel brand.

8 Q. Is Nextel running advertising today
9 using the chirp?

10 MR. WILLIAMS: Objection. Lacks
11 foundation.

12 A. I'll now refer to Sprint Nextel as the
13 post-merger entity.

14 In April of this year, I was part
15 of -- or, I led the team that selected a new
16 advertising agency for Sprint Nextel, and in
17 that period, we briefed-in advertising
18 requirements for that agency to develop Nextel
19 product advertising within the Sprint Nextel
20 brand family.

21 And as a consumer, I can see that over
22 the summer those ads were produced and are
23 running today both in direct-connect-specific
24 ways and using the chirp associated with speed
25 in some very specific Nextel Cup Nascar ads.

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2 labeled Mullen Ads, and that's -- Mullen was the
3 advertising agency that Nextel used at launch up
4 through I want to say up through second quarter
5 of 2003 or thereabouts.

6 Q. Did the advertisements we just saw
7 actually air?

8 A. They did. Each of those aired for
9 varying lengths.

10 Q. How do you know that they aired?

11 A. In the earliest examples, I used the
12 example of what I'm calling the "vacuum, no
13 roaming," which was the first ad on the tape we
14 just saw, I had responsibility in April of '97
15 for the telemarketing center where the amount of
16 calls from 1-800-Nextel9 went, and I sort of
17 recall unveiling them to the telemarketing
18 center, or that one to the telemarketing center
19 myself.

20 The first two ads on the tape, what
21 I'm calling "vacuum" or "cliff hanger," the
22 first one I wasn't involved in producing, and
23 then, beginning with the second one, what I'm
24 calling "cliff hanger," I was involved in the
25 focus groups that -- the internal focus groups,

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2 excuse me, that evaluated whether that was an ad
3 that was going to run.

4 And then, beginning in this tape with
5 the ad which I'll call "one-second rounding"
6 with the two guys in the airport with the clocks
7 over the top of them, from then on in the tape,
8 I had advertising responsibility and would have
9 approved the concept of the ad, the final
10 execution of the ad, and the airing of the ad.
11 That's how I know.

12 Q. Do these ads illustrate anything about
13 Nextel's use of the chirp sound in its
14 advertising?

15 A. Yes. You have, broadly, two kinds of
16 ads here. You have ads that are about cellular
17 features like no roaming or one-second rounding
18 and you have ads that are about the direct
19 connect feature or focus on the direct connect
20 feature, and in the case of the first ad on the
21 tape, "vacuum, no roaming," and the third ad on
22 the tape, "one-second rounding," both of those
23 use the chirp as a signature ending in spite of
24 the fact direct connect wasn't featured in the
25 ad.

1 HIGHLY CONFIDENTIAL - M. SCHWEITZER

2 sort of 18 years of advertising experience.

3 A tag line is meant to uniquely
4 associate a phrase with the company. So when we
5 used, "Nextel. You've never used a phone like
6 this before," that was a tag line that was
7 directly associated with us wanting to drive
8 handset purchases of Nextel-provided devices
9 that will get you on the Nextel network.

10 Later we used a tag line like, "Nextel
11 Done," with a finish line I described before.
12 It doesn't mention a handset, but again, was
13 meant to be uniquely about Nextel.

14 Q. And the chirp was part of that?

15 A. Yes. Again, after 1999 or
16 thereabouts, I would have had a policy that,
17 whether the chirp ended the ad or the chirp was
18 part of the action, for all television or radio,
19 the strategic intent was to have the chirp part
20 of the ad. So if it was a non-direct-connect
21 ad, it most likely would appear in connection
22 with a tag line; if it was direct connect ad, it
23 might appear both inside and with the tag line.

24 As of the Done Campaign, which was
25 summer of 2003 forward, any ad that had a Nextel

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2 product we used the chirp, and so kind of in the
3 history you would say it was used over 90
4 percent of the time in all television and radio,
5 and then there came to be a very specific policy
6 around using it as of the Done Campaign forward.

7 Q. Mr. Schweitzer, referring to the ads
8 that we just saw on the DVD, did any of these
9 ads advertise phones for sale?

10 A. There wasn't a phone price or a phone
11 special. In a few of them, again, we used the
12 tag line "you've never used a phone like this
13 before" as a kind of reminder, if you want to
14 get what this network provides and what you've
15 just seen in this ad, you know, ask about Nextel
16 phones, but none of these were device-price
17 phone-focused. They were really about the
18 functionality and our desire to have subscribers
19 that valued instant communication.

20 Q. Did any of these advertisements
21 mention Motorola?

22 A. I would say no. This is about my
23 third viewing of them, and I don't recall seeing
24 Motorola in any of it. I'm sorry, any mention
25 of Motorola, visually or verbally. I think if

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2 Q. Okay. Thank you.

3 Did Nextel have other uses of the
4 chirp in its advertising?

5 A. Yes. Again, over time, we tried more
6 and more to associate it generally with the
7 company. So, in 2000, I believe, we made what
8 at the time was the biggest marketing commitment
9 Nextel had made, which was a CBS Sports package
10 which included the Nextel half-time show on
11 CBS's AFC coverage.

12 In that instance, we got lots of
13 features within action, it's again in the first
14 half, which would lead you to watch the Nextel
15 half-time show, and we used the chirp in
16 connection with any mention of Nextel in the
17 half-time show as a signature element. So, big
18 visibility; and for CBS, not in connection with
19 the 30-second spot.

20 When we got into the Nextel cup, which
21 was the Nascar sponsorship, one of reasons it
22 made so much strategic sense for us, it was
23 about speed. And so we used the drivers in the
24 public appearances, in advertising, and
25 importantly, in the television that aired the