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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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Attachments	Nextel Motion for Leave to Use Prior Testimony.pdf (16 pages)(706181 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.)
)
NEXTEL COMMUNICATIONS, INC.)
)
Applicant.)
_____)

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

**APPLICANT'S MOTION FOR LEAVE TO USE TESTIMONY FROM ANOTHER
PROCEEDING IN SUPPORT OF APPLICANT'S OPPOSITION TO OPPOSER'S
MOTION FOR SUMMARY JUDGMENT ON PRECLUSION**

Pursuant to 37 C.F.R. § 2.122(f), Applicant Nextel Communications, Inc.¹ ("Applicant" or "Nextel") hereby moves for leave to use testimony from another proceeding in support of its opposition to 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) 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*"). In particular, Nextel seeks to use excerpts from

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

the testimonial deposition of Mr. Mark Schweitzer of Nextel taken in *Nextel v. Motorola*. True and correct copies of these excerpts are submitted as Exhibit 1 to the Declaration of Ann M. Mace in Support of Applicant's Opposition to Applicant's Motion for Summary Judgment on Preclusion ("Mace Decl.") attached hereto as Appendix A.

I. FACTUAL BACKGROUND AND ARGUMENT

Motorola's Motion for summary judgment is based on allegations 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 v. Motorola*. In its motion, Motorola alleges that the transactional facts, issues, and findings attendant to the decision in *Nextel v. Motorola* warrant summary judgment on the issues of claim preclusion and issue preclusion.

The testimony from the *Nextel v. Motorola* proceeding that Nextel seeks to use in support of its opposition to Motorola's motion is relevant and material as it directly addresses and rebuts the arguments and factual assertions contained in Motorola's Motion, and provides more complete information regarding the nature of prior evidence of Nextel's use of its Chirp mark as related to the elements underlying Motorola's claim preclusion and issue preclusion claims. Motorola has itself sought leave to rely on testimony from *Nextel v. Motorola* in its summary judgment motion, including testimony from Mr. Schwietzer, likewise asserting that such testimony is relevant and material, as it purportedly "addresses the parties' goods and services at issue in the present opposition," and "addresses the parties' concurrent use of the mark at issue in both cases, namely the audible 'Chirp Tone' sound mark." Motorola Motion for Leave at 3. Accordingly, Nextel submits that the testimony sought to be relied upon by Nextel will assist the Board in deciding Motorola's Motion.

II. CONCLUSION

Nextel respectfully requests that the Board grant the instant motion for leave to use the testimony from the *Nextel v. Motorola* proceeding attached to this motion.

Respectfully submitted,



John I. Stewart, Jr.
Michael H. Jacobs
William J. Sauers
Ann M. Mace
Attorneys for Applicant

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March 12, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S MOTION FOR LEAVE TO USE TESTIMONY FROM A PRIOR PROCEEDING IN ITS SUPPORT OF ITS 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

A handwritten signature in blue ink, appearing to read "A M", is written above a horizontal line.

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

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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.

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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