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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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**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 REPLY IN SUPPORT OF ITS
MOTION FOR SUMMARY JUDGMENT ON PRECLUSION**

Applicant Nextel Communications, Inc. (“Applicant” or “Nextel”) hereby submits this reply in support of its motion 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 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.

Opposer’s Response to Applicant’s Motion for Summary Judgment on Preclusion (“Response”) presents the same unsupportable positions that underlie its affirmative motion for summary judgment on preclusion, and continues to distort the Board’s ruling in *Nextel v. Motorola* and ignore facts contrary to its position. Moreover, Motorola’s Response does not address Nextel’s motion in detail with respect to the separate elements of Motorola’s claim

preclusion and issue preclusion arguments, conflating the two issues and thus failing to identify a genuine dispute regarding any of the facts set forth in Nextel's motion that would be material to either of the separate legal grounds for summary judgment. The Board should grant Nextel's motion in its entirety.

I. ARGUMENT

A. **Motorola's Assertion that the Board Found in *Nextel v. Motorola* that the Chirp Tone "Cannot Function as a Mark for Goods Using the Chirp Tone as an Operational Alert Tone" Is Wrong**

In its Response, Motorola asserts that "[t]he Board held in the prior precedential *Nextel v. Motorola* decision that the Chirp Tone cannot function as a mark for goods using the Chirp Tone as an operational alert tone." Response at 3. As with its earlier arguments on this issue, Motorola's argument again materially misstates the Board's prior holding. Contrary to its assertion that the Board found the Chirp cannot serve as a mark for such goods, the Board in *Nextel v. Motorola* determined that the Chirp did not serve as a mark identifying Motorola as the source of the goods. Specifically, after holding that the Chirp Tone could not be considered inherently distinctive with respect to Motorola's goods, the Board extensively addressed Motorola's evidence and arguments to determine whether it nonetheless had made a sufficient showing that the Chirp Tone had acquired distinctiveness and thus functioned as a mark for goods that used it as an operational alert tone. What the Board found was that the evidence – regarding surveys, promotions, product placements, and advertising – failed to establish that the Chirp Tone had acquired distinctiveness as a mark for Motorola's goods, *Nextel v. Motorola* at 1401-1408, not that it could never function as a mark for such goods.

Motorola admits that the Board's decision in *Nextel v. Motorola* contained statements expressly declaring that Nextel's rights in the mark were not being determined in that

proceeding. Response at 9; *see Nextel v. Motorola* at 1403, 1408. But, remarkably, Motorola still fails to explain or even address how Nextel could possibly be precluded as a matter of law from establishing its own rights in the mark by a decision in which the Board expressly stated that it was not determining Nextel's rights in the mark. It is surely the rare preclusion case (perhaps because no one would think to make such an argument) in which the decision that is asserted as an absolute bar to a subsequent claim expressly states – and reiterates – that it is not considering or deciding that very claim.

B. There Is No Basis to Extend Motorola's Preclusion Argument to All Services in Nextel's Application

Motorola next attempts to bootstrap its flawed preclusion argument to apply even to services that do not emit the Chirp as an operational alert tone. Response at 3, 15-17. Once again, however, Motorola resorts to mischaracterizations of the *Nextel v. Motorola* decision.

As a preliminary matter, none of the cases cited by Motorola in support of the “well-settled” practice by which refusal of registration with respect to some applied-for items is extended to all items in the same class addressed that issue in the context of preclusion. *See* Response at 15-16, citing *Electro-Coatings, Inc. v. Precision National Corporation*, 204 U.S.P.Q. 140 (TTAB 1979); *In re Analog Devices, Inc.*, 6 U.S.P.Q.2d 1808 (TTAB 1988); *Hewlett-Packard Development Co. v. Vudu, Inc.*, 92 U.S.P.Q.2d 1630 (TTAB 2009); *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 U.S.P.Q.2d 1251 (TTAB 2009). While there may be a rationale for applying Motorola's “general rule” in descriptiveness cases, Motorola's Response fails to cite a single decision applying its asserted rule to a preclusion case like that presented here.

Indeed, the Federal Circuit has rejected Motorola's position. *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).

Of course, the Board addressed the issue itself in *Nextel v. Motorola*, as Motorola acknowledges. Response at 16-17. Motorola quotes only part of the Board’s decision, including the Board’s description of the “whole class” approach that Motorola seeks to impose here. Response at 17 (quoting the first sentence of footnote 13). Disturbingly, Motorola then omits the Board’s explicit holding, which explained why the “whole class” approach was not applicable in *Nextel v. Motorola*, and which establishes that it is equally inapplicable here:

However, issue preclusion applies only to issues actually decided, in this case whether the chirp functions as a mark for two-way radios, and the issue as it relates to cellular telephones (albeit with a two-way radio feature) was not decided in the 911 Hz proceeding.

Nextel v. Motorola at 1399 n. 13 (emphasis added). The Board, in order “[t]o be clear,” reiterated that it was applying issue preclusion to the identical goods that were the subject of the prior case, but not to closely related goods in the same class. *Id.* at 1399. This direct precedent alone negates Motorola’s bootstrapping “whole class” argument.

C. Nextel Does Not Assert that the Chirp Tone Is Inherently Distinctive for Services that Emit the Chirp During Operation

Motorola’s Response seeks to claim that none of the services listed in Nextel’s application can be inherently distinctive “given the inseparable relationship between Motorola’s [goods] and Nextel’s [services]...” because “[t]he Board has already held that the Chirp Tone is not inherently distinctive in connection with communications goods.” Response at 18. Motorola’s argument fails for several reasons.

As a preliminary matter, Nextel is not claiming inherent distinctiveness with respect to its services that emit the Chirp as part of their operation. *See* April 29, 2010 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). Rather, Nextel is only claiming inherent distinctiveness with respect to the services that do not emit the Chirp as part of their operation. While Motorola appears to be aware of this fact, *see* Response at 6-7, it continues to argue that Nextel is precluded from making an inherent distinctiveness claim with respect to all its applied-for services, expressly including those as to which Nextel makes no such claim. Response at 17-19.

Even with respect to services that do not emit the Chirp in their normal course of operation, Motorola's reliance on the Board's application of *In re Vertex* in *Nextel v. Motorola* fails to recognize that additional evidence will need to be considered by the Board in this opposition regarding that issue. *See, e.g.*, D.I. 18, Applicant's Opposition to Opposer's Motion for Summary Judgment on Preclusion at 5-6 (Additional Facts, ¶¶ 13-20). Motorola's Summary Judgment Motion should be denied.

D. The Board's Finding of Motorola's Lack of Substantially Exclusive Use of the Chirp Tone Has No Preclusive Effect Regarding Nextel's Own Substantially Exclusive Use

Lastly, Motorola argues that the Board's determination in *Nextel v. Motorola* that Motorola's alleged use of the Chirp was not substantially exclusive somehow precludes the Board from considering in this case whether Nextel's use of the Chirp has been substantially

exclusive. Motorola's position is premised on a single statement from the Board's decision in *Nextel v. Motorola* that, when read in context, directly contradicts Motorola's position.

In *Nextel v. Motorola*, the Board found that Motorola had no substantially exclusive use of the Chirp in connection with cellular telephones because of Nextel's own substantial use. *Nextel v. Motorola* at 1408. That determination does not mean, however, that the converse must logically also be true. Indeed, to the extent the Board considered evidence of Nextel's use of the Chirp in evaluating Motorola's acquired distinctiveness argument, its intermediate findings were consistent with the opposite conclusion – that Nextel's use had resulted in acquired distinctiveness for the Chirp as a mark for Nextel's services. *Nextel v. Motorola* at 1407-1408. The single case Motorola cites for the proposition that “‘non-trademark’ use defeats a claim of substantially exclusive use” in fact holds no such thing. *See* Response at 20, *citing Flowers Indus., Inc. v. Interstate Brands Corp.*, 5 U.S.P.Q.2d 1580, 1589 (TTAB 1987) (Board refuses registration because evidence showed applicant had itself used the asserted mark only in a descriptive manner).

Moreover, 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*. Preclusion does not apply, and the Board should consider the relevant evidence in this proceeding.

E. Nextel's Opposition to Motorola's Motion for Summary Judgment on Preclusion

Motorola's Response seeks to incorporate the arguments set forth in its own separate motion for summary judgment. *See* Response at 21-22. Nextel, of course, disagrees that summary judgment in favor of Motorola on its preclusion claims would be appropriate, and requests the Board to deny that motion. *See* D.I. 18, Applicant's Opposition to Opposers'

Motion for Summary Judgment on Preclusion. Nextel's motion for summary judgment, however, should be granted based on the arguments set forth in Nextel's Opposition thereto and in this reply. *See* D.I. 11.

II. CONCLUSION

Applicant Nextel Communications, Inc., respectfully requests, for the reasons stated above, that the Board grant its motion and 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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April 2, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S REPLY
IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON PRECLUSION was
served on counsel for Opposer this 2nd day of April, 2012, by sending same via First Class Mail,
postage prepaid, to:

Thomas M. Williams
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A handwritten signature in blue ink that reads "Ann Mace". The signature is written in a cursive style. Below the signature is a horizontal line.