

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

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Mailed: June 18, 2012

Opposition No. 91200355

Motorola Mobility, Inc.,  
Motorola Trademark Holdings,  
LLC

v.

Nextel Communications, Inc.

Before Seeherman, Holtzman and Bergsman,  
Administrative Trademark Judges.

By the Board.

This opposition involves the application filed by Nextel Communications, Inc. ("Nextel") to register the sound mark described as follows:

The mark is a sound. The mark consists of a tone at 1800 Hz played at a cadence of 24 milliseconds (ms) ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON.

("1800 Hz sound" or "sound") for the following services in International Class 38:

telecommunication services, namely, electronic, electric and digital transmission of voice, data, pictures, music, video, and other electronic information via wireless networks; two-way radio services; electronic transmission of voice, text, images, data, music and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, handheld units, namely, personal computers and digital assistants (PDAs), dispatch radios, and pagers; paging services; transmission of positioning, tracking,

monitoring and security data via wireless communications devices; mobile telephone communication services; wireless Internet access 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; wireless communications service.<sup>1</sup>

Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC. ("Motorola") oppose registration on the grounds of 1) mere descriptiveness and lack of distinctiveness, 2) failure to function as a mark, 3) functionality, 4) issue preclusion and claim preclusion, 5) non-use, and 6) fraud on the USPTO.

Decision in Opposition No. 91164353

While Nextel's application was suspended in examination, the Board decided Opposition No. 91164353, brought by Nextel against registration of Motorola's 1800 Hz sound, or "chirp" sound - the same sound that Nextel seeks to register for services in the application opposed herein - for *goods*, namely, "cellular telephones and two-way radios" in International Class

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<sup>1</sup> Application Serial No. 78575442, filed February 25, 2005, based on use of the mark in commerce pursuant to Trademark Act § 1(a), claiming a date of first use anywhere and date of first use in commerce of May 16, 1997, and claiming acquired distinctiveness pursuant to Trademark Act § 2(f).

The parties' briefs indicate that the 1800 Hz sound is an operational alert tone or "chirp" which is emitted by wireless communications devices, manufactured by Motorola or others, to signal the user of a certain status or condition, namely, to signal the "talk permit" status of two-way radio communications over Nextel's network.

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9. See *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393 (TTAB 2009) ("Opposition No. 91164353"). The Board sustained that opposition:

1) with respect to "two-way radios," applying the preclusive (issue preclusion) effect of its decision sustaining Opposition No. 91161817 (*Nextel Communications, Inc. v. Motorola, Inc.* (TTAB February 27, 2008)), wherein the Board found that Motorola's applied-for sound, described as

...an electronic chirp consisting of a tone  
at 911 Hz played at a cadence of 25 ms ON,  
25 ms OFF, 25 ms ON, 25 ms OFF, 50 ms ON

failed to function as a mark for said goods. *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d at 1399; and

2) with respect to "cellular telephones," finding that the 1800 Hz sound was an operational alert tone that was not inherently distinctive and had not acquired distinctiveness for these goods. *Id* at 1408. In particular, the Board found that Motorola had not provided sufficient evidence that consumers recognize the sound as a source-identifier for said goods, and that evidence of Nextel's contemporaneous use of this sound in connection with promoting its services for nearly as long as Motorola rebutted Motorola's contention of substantially exclusive use of the sound as a mark. *Id.*

The instant opposition

On December 8, 2011, the Board denied Nextel's motion seeking dismissal for failure to state a claim upon which

relief may be granted, which motion was directed to Motorola's functionality, claim and issue preclusion, and fraud claims. In that same order, the Board allowed the parties to file cross-motions for summary judgment on the issue of res judicata and/or collateral estoppel. These claims are based on the Board's sustaining, in Opposition No. 91164353, Nextel's opposition to registration of the sound for Motorola's goods. It is Motorola's position that the Board's decision in that opposition operates to bar Nextel's registration of the sound as a mark for its telecommunications services, while Nextel seeks judgment that the decision in Opposition No. 91164353 does not act as a bar. This proceeding is now before the Board for consideration of the cross-motions, which are fully briefed.<sup>2</sup>

Summary judgment standard

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). Summary judgment is appropriate in preclusion cases. See *Zoba Int'l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108-09 (TTAB 2011).

To prevail on its motion, Motorola must prove that there is no genuine dispute of material fact that the

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<sup>2</sup> As a preliminary matter, Nextel's unopposed motion for leave to file an amended answer is granted. Its amended answer, filed January 31, 2012, to the notice of opposition is entered.

elements of claim preclusion, or issue preclusion, are satisfied such that the Board's decision in Opposition No. 91164353 operates to bar registration of the 1800 Hz sound as a mark for Nextel's services. Correspondingly, to prevail on *its* motion, Nextel must prove that there is no genuine dispute of material fact that the elements of claim preclusion, or issue preclusion, are not satisfied and thus the decision in Opposition No. 91164353 does *not* bar registration of the sound as a mark for its services.<sup>3</sup>

Res judicata (claim preclusion)

While our primary reviewing court advises that "[c]aution is warranted in the application of preclusion by the PTO," see *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1314 (Fed. Cir. 2005), it is within the Board's discretion to apply preclusion where it is warranted. See *Parklane Hosiery Co., Inc. v. Shore*, 439 U.S. 322 (1979).

Application of the doctrine of claim preclusion to bar a subsequent claim is appropriate when:

- (1) there is an identity of parties or their privies;
- (2) there was 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 and should have

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<sup>3</sup> Motorola moves for leave to use testimony of Mr. Peter Aloumanis of Motorola, Inc., and of Mr. Mark Schweitzer of Nextel Communications, Inc., taken in Opposition No. 91164353. Similarly, Nextel moves for leave to use testimony of Mr. Schweitzer, taken in Opposition No. 91164353. Said motions are unopposed, and are granted solely for the purpose of the cross-motions for summary judgment. See Trademark Rule 2.127(a).

been litigated in the prior case.

*See Sharp Kabushiki Kaisha v. Thinksharp, Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006); *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

Regarding the first element, on summary judgment the parties do not dispute that there is an identity of parties or their privies.

The second element is met, as the Board entered a final decision on the registrability of the sound for Motorola's "cellular telephones and two-way radios."

However, the third element of claim preclusion is not met inasmuch as the instant opposition is not based on the same set of transactional facts that were before the Board in Opposition No. 91164353. In that proceeding, the core issue before the Board (the issue which was not precluded by the decision in Opposition No. 91161817) was whether the sound had inherent or acquired distinctiveness as a mark with respect to Motorola's "cellular telephones." The Board made no finding as to whether the sound had acquired distinctiveness as a mark as used in connection with any of Nextel's services. In discussing the probative value of two consumer surveys submitted therein, the Board noted

...we make no finding herein that the chirp has acquired distinctiveness in connection with opposer's services (that issue is not before us)...

and in discussing evidence of advertisements wherein the sound is played, it noted

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.

*Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d at 1403, 1408.

The Board had before it evidence of use of the sound by Nextel in connection with its services. However such evidence was presented in order to rebut Motorola's assertion that the sound had acquired distinctiveness as a mark for Motorola's "cellular telephones," and in particular to rebut Motorola's assertion that its use of the sound had been substantially exclusive. As noted above, the Board did not rule with respect to whether the sound was inherently distinctive, or had acquired distinctiveness as a mark for Nextel's services. The effect of the transactional facts underlying the issue in the instant opposition - whether the sound functions as a mark as used in connection with certain or all of the services identified in Nextel's application - was not presented in Opposition No. 91164353, and was not an issue that needed to be litigated therein.

Accordingly, the elements of claim preclusion are not satisfied with respect to the decision in Opposition No. 91164353 so as to bar Nextel's registration of the 1800 Hz sound for its identified services.

Collateral estoppel (issue preclusion)

In the absence of claim preclusion, the related principle of collateral estoppel may bar relitigation of the same issue in a second action. See *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 76 USPQ2d at 1312.

Regarding whether issue preclusion, or collateral estoppel, is applicable based on a district court's decision,

[t]he doctrine of collateral estoppel ... normally will bar the relitigation of an issue of law or fact that was raised, litigated, and actually decided by a judgment in a prior proceeding between the parties, if the determination of that issue was essential to the judgment, regardless of whether or not the two proceedings are based on the same claim.

*NLRB v. United Technologies Corp.*, 706 F.2d 1254, 1260 (2d Cir. 1983). The application of collateral estoppel requires:

- (1) identity of an issue in the current and a prior proceeding;
- (2) actual litigation of that issue in the prior proceeding;
- (3) necessity of a determination of the issue in entering judgment in the prior proceeding; and
- (4) a full and fair opportunity existed, for the party with the burden of proof on that issue in the second proceeding, to have litigated the issue in the prior proceeding.

See *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 76 USPQ2d at 1313.

For the same reasons that Opposition No. 91164353 and the instant opposition are not based on the same set of

transactional facts, the first element of issue preclusion is not met. There is no identity of issues inasmuch as the issues resolved in Opposition No. 91164353 differ materially from those presented in the instant opposition.

The issue that is now before the Board is the registrability of the sound for some or all of Nextel's identified services. This requires the Board to ascertain whether the sound can be inherently distinctive as a mark for the services, and if not found to be so, whether it has acquired distinctiveness as a mark for the services.

In asserting issue preclusion in its motion, Motorola argues that "given the inseparable nature of Motorola's iDEN® Goods and Nextel's iDEN® Services, the 'issues' of whether the Chirp Tone functions as a mark, whether it is inherently distinctive, and whether it has acquired distinctiveness are identical" (Motorola's brief, p. 20). However, this is Motorola's own characterization of the relatedness of its goods and Nextel's services. The Board did not find the parties' goods and services to be "inseparable," and in fact made no separate finding as to their relatedness or unrelatedness.

In particular, the Board found that the sound, when used in connection with "cellular telephones," cannot be inherently distinctive as a mark; it did not consider evidence on the issue of whether the sound is inherently

distinctive as a mark for any of Nextel's services in connection with which the sound is emitted as part of the actual operation of those goods. The Board turned next to the issue of acquired distinctiveness, finding that the evidence did not demonstrate that the sound had acquired distinctiveness as a mark for "cellular telephones." In noting that Nextel's use of the sound invalidates Motorola's claim of "substantially" exclusive use, the Board stated that the services were "closely related to applicant's goods." *Nextel Communications, Inc. v. Motorola, Inc.*, 91 USPQ2d at 1408. However, the determination of the lack of acquired distinctiveness of the sound as a mark for "cellular telephones" turned on the Board's consideration of a body of evidence going to that issue, and furthermore did not extend to Nextel's services. Consequently, the premise on which Motorola bases its argument that there is an identity of issues fails.

Turning to the second and third elements of issue preclusion, inasmuch as there is no identity of the issue which the Board determined in Opposition No. 91164353, and that which is now before us - whether the sound has inherent or acquired distinctiveness as a mark for Nextel's services - it follows that the latter was not actually litigated, and was not necessary for the determination that the sound was not registrable for "cellular telephones."

Finally, the Board found relevant the evidence of Nextel's contemporaneous use of the sound, such as in advertisements for its services, in ascertaining whether such use could rebut Motorola's claim that its use of the sound was "substantially" exclusive, and concluded that Nextel's use, along with other deficiencies in Motorola's evidence, defeated Motorola's claim of acquired distinctiveness. However, inasmuch as the registrability of the sound for Nextel's services was not at issue, Nextel did not have a full and fair opportunity to litigate this in Opposition No. 91164353. Thus, the fourth element of issue preclusion has not been met.

Accordingly, the elements of issue preclusion are not satisfied with respect to the decision in Opposition No. 91164353 so as to bar Nextel's registration of the 1800 Hz sound for its identified services.

In summary, Nextel has demonstrated that there is no genuine dispute of material fact that the elements of neither claim preclusion, nor issue preclusion, are met here. In view thereof, Nextel is entitled to judgment as a matter of law with respect to Motorola's claim that the Board's prior decision in Opposition No. 91164353 bars Nextel's registration of the 1800 Hz sound for Nextel's identified Class 38 services. With respect to Motorola's preclusion claims, set forth in Paragraphs 27 through 30 of

the notice of opposition, judgment is entered in favor of Nextel.<sup>4</sup>

Schedule

Proceedings are resumed with respect to Motorola's remaining claims. Conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for Required Discovery Conference	7/20/2012
Discovery Opens	7/20/2012
Initial Disclosures Due	8/19/2012
Expert Disclosures Due	12/17/2012
Discovery Closes	1/16/2013
Plaintiff's Pretrial Disclosures due	3/2/2013
Plaintiff's 30-day Trial Period Ends	4/16/2013
Defendant's Pretrial Disclosures due	5/1/2013
Defendant's 30-day Trial Period Ends	6/15/2013
Plaintiff's Rebuttal Disclosures due	6/30/2013
Plaintiff's 15-day Rebuttal Period Ends	7/30/2013

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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<sup>4</sup> The evidence submitted in connection with the cross-motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, e.g., *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n. 14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

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Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.