

ESTTA Tracking number: **ESTTA19357**

Filing date: **11/16/2004**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Nextel Communications, Inc.
<b>Granted to Date of previous extension</b>	11/17/2004
<b>Address</b>	2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES

<b>Attorney information</b>	Edward W. Gray, Jr. Morrison & Foerster LLP 2000 Pennsylvania Ave, NW Suite 5500 Washington, DC 20006 UNITED STATES trademark-dc@mofa.com Phone:202-887-1500
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#### Applicant Information

<b>Application No</b>	76462159	<b>Publication date</b>	07/20/2004
<b>Opposition Filing Date</b>	11/16/2004	<b>Opposition Period Ends</b>	11/17/2004
<b>Applicant</b>	Nexsan Technologies, Inc. 21700 Oxnard Street Suite 1850 Woodland Hills, CA 91367		

UNITED STATES
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**Goods/Services Affected by Opposition**

Class 009.

All goods and services in the class are opposed, namely: Computer hardware, namely, redundant array of independent disks (RAID), just a bunch of drives (JBOD), storage area network (SAN) computer hardware and computer operating software, network attached storage (NAS) device, computer hard disk drives and enclosures for the aforementioned and user manual sold as a unit with the aforementioned

<b>Attachments</b>	6011114.pdf ( 8 pages )
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<b>Signature</b>	/Edward W. Gray, Jr./
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<b>Name</b>	Edward W. Gray, Jr.
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<b>Date</b>	11/16/2004
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

	)	Opposition No. _____
Nextel Communications, Inc.	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	
Nexsan Technologies, Inc.	)	
	)	
Applicant.	)	
	)	
_____	)	
	)	
Mark:    NEXSAN NEXSAN	)	
TECHNOLOGIES	)	
& DESIGN	)	
Serial No.: 76/462,159	)	
Filed:    October 28, 2002	)	
	)	
Published in Official Gazette of	)	
July 20, 2004	)	

**NOTICE OF OPPOSITION**

Nextel Communications, Inc., a Delaware Corporation, having its place of business at 2001 Edmund Halley Drive, Reston, VA 20191 (hereinafter "Opposer"), believes it will be damaged by the registration on the Principal Register of the mark NEXSAN NEXSAN TECHNOLOGIES & DESIGN, Application Serial No. 76/462,159 owned by Nexsan Technologies, Inc. (hereinafter "Applicant"), and hereby opposes the same upon the following grounds:

**FACTUAL ALLEGATIONS COMMON TO ALL COUNTS**

1. Applicant seeks to obtain registration on the Principal Register for the

mark, NEXSAN NEXSAN TECHNOLOGIES & DESIGN for use in connection with “Computer hardware, namely, redundant array of independent disks (RAID), just a bunch of drives (JBOD), storage area network (SAN) computer hardware and computer operating software, network attached storage (NAS) device, computer hard disk drives and enclosures for the aforementioned and user manual sold as a unit with the aforementioned” in Class 9.

2. Upon information and belief, Application Serial No. 76/462,159 was filed on October 28, 2002 on an Intent-to-Use (“ITU”) basis.

3. Applicant’s use of the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark is without the consent or permission of Opposer.

4. On information and belief, Applicant uses the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark on general purpose storage products sold in connection with or as part of telecommunications equipment.

5. On information and belief, Opposer has used the mark NEXTEL in connection with telecommunications goods and services since at least as early as 1988.

6. Opposer is the owner of the following related Federal Trademark Registrations and Applications, each of which is for telecommunication goods and/or services in Classes 9 and/or 38 (hereinafter collectively referred to as “NEXTEL Marks”):

<b><u>Marks</u></b>	<b><u>Reg./Appl. Nos.</u></b>	<b><u>Reg./Appl. Date</u></b>
NEXTEL (cls. 38)	Reg. No. 2,358,982	June 20, 2000
NEXTEL (cls. 9)	Reg. No. 1,884,244	March 14, 1995
NEXTEL (cls. 38)	Reg. No. 1,637,139	March 5, 1991

<u>Marks</u>	<u>Reg./Appl. Nos.</u>	<u>Reg./Appl. Date</u>
NEXTEL (cls. 9 & 38)	Reg. No. 2,391,504	October 3, 2000
NEXTEL DIRECT CONNECT (cls. 38)	Reg. No. 2,236,098	March 30, 1999
NEXTEL.HOW BUSINESS GETS DONE. (cls. 38)	Reg. No. 2,435,925	March 13, 2001
NEXTEL ONLINE (cls. 38)	Reg. No. 2,430,370	February 20, 2001
GET SMART.GET NEXTEL (cls. 38)	Reg. No. 2,403,310	November 14, 2000
NEXTEL DIRECT CONNECT GET RIGHT THROUGH (cls. 9 & 38)	Reg. No. 2,765,052	September 16, 2003
POWERED BY NEXTEL (cls. 9 & 38)	Reg. No. 2,863,268	July 13, 2004
NEXTEL GROUP CONNECT (cls. 9)	Appl. No. 76/448,245	September 4, 2002
THE NEXTEL STORE (cls. 9 & 38)	Appl. No. 76/391,789	April 5, 2002
NEXTEL	Appl. No. 76/415,495	May 15, 2002
DISCOVER THE NEXTEL ADVANTAGE (cls. 9 & 38)	Appl. No. 76/391,788	April 5, 2002
NEXTEL BROADBAND (cls. 9 & 38)	Appl. No. 76/301,026	April 23, 2002

7. Opposer used the NEXTEL Marks in commerce before October 28, 2002, the date Applicant filed its ITU application for the mark NEXSAN NEXSAN TECHNOLOGIES & DESIGN.

8. Opposer has expended substantial monies in marketing, advertising, and promoting the NEXTEL Marks in connection with its telecommunications goods including hardware and software for use in communications networks and related services in interstate commerce throughout the United States.

9. Opposer has enjoyed substantial revenue derived from the sale of said telecommunications goods and services in connection with the NEXTEL Marks in the United States.

10. By reason of its extensive marketing, advertising and promotion, the NEXTEL Marks are uniquely associated with Opposer.

11. By reason of the extensive marketing, advertising and promotion of said telecommunications goods and services in connection with the NEXTEL Marks since at least as early as 1988, the NEXTEL mark has become famous and distinctive and represent an extremely valuable goodwill associated with Opposer.

#### COUNT I- LIKELIHOOD OF CONFUSION

12. Opposer hereby incorporates and realleges the allegations contained in paragraph numbers 1 through 11 by reference herein.

13. On information and belief, the computer hardware and software goods for which Applicant is seeking registration of the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark are closely related or identical to the goods and services sold by Opposer under its NEXTEL Marks.

14. On information and belief, the computer hardware and software goods for which Applicant is seeking registration of the NEXSAN NEXSAN TECHNOLOGIES &

DESIGN mark are offered to the same customers to whom Opposer offers its goods and services in connection with its NEXTEL Marks.

15. On information and belief, the computer hardware and software goods for which Applicant is seeking registration of the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark are offered through the same channels of trade through which Opposer offers its goods and services in connection with its NEXTEL Marks.

16. On information and belief, the NEXSAN NEXSAN TECHNOLOGIES mark for which Applicant is seeking registration is substantially similar to the NEXTEL Marks which Opposer uses.

17. On information and belief, Applicant's NEXSAN NEXSAN TECHNOLOGIES mark is confusingly similar to the NEXTEL Marks and Applicant's use of NEXSAN NEXSAN TECHNOLOGIES in connection with the goods specified in Application Serial No. 76/462,159 is likely to cause confusion, mistake or deception that Applicant's goods are those of Opposer or are otherwise endorsed, sponsored, or approved by Opposer, whereby Opposer will be damaged by the registration of the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark on the Principal Register of the United States Patent and Trademark Office.

18. If Applicant is granted registration of its NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark as shown in Application Serial No. 76/462,159, Applicant will thereby obtain *prima facie* exclusive right to use such mark in the United States and such registration will impair and diminish Opposer's goodwill and rights in its NEXTEL Marks thereby causing irreparable damage and injury to Opposer. Therefore, Opposer opposes the registration of Applicant's NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark pursuant to 15 U.S.C. §§ 1052 and 1063(a), as amended by the Trademark Act of 1999.

## COUNT II-DILUTION

19. Opposer hereby incorporates and realleges the allegations contained in paragraph numbers 1 through 18 by reference herein.

20. Opposer's NEXTEL mark is distinctive and famous marks within the meaning of the Lanham Act and are entitled to the protection of the anti-dilution provisions of the Lanham Act, including 15 U.S.C. § 1125(c).

21. On information and belief, Applicant sells the computer hardware and software goods for which it seeks registration of the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark to the same customers and through the same channels of trade that Opposer sells its telecommunications goods and services in connection with the NEXTEL mark.

22. Applicant's NEXSAN NEXSAN TECHNOLOGIES mark is confusingly similar to Opposer's NEXTEL mark that Opposer uses in connection with telecommunications goods and services throughout the United States.

23. Opposer's NEXTEL mark became famous and distinctive prior to Applicant's first commercial use of its mark in commerce.

24. If Applicant is granted registration of its NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark as shown in Application Serial No. 76/462,159 Applicant will thereby obtain the *prima facie* exclusive right to use such mark, and such registration will impair, diminish and dilute Opposer's goodwill and rights in its NEXTEL mark thereby causing irreparable injury to Opposer. Therefore, Opposer opposes registration of Applicant's NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark pursuant to 15 U.S.C. §§ 1052 and 1063(a), as amended by the Trademark Amendments Act of 1999.



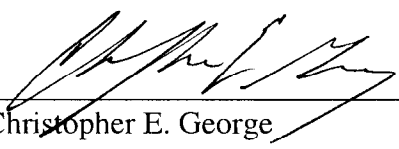
**PRAYER FOR RELIEF**

WHEREFORE, Opposer prays that Application Serial No. 76/462,159 be rejected and that registration of the NEXSAN NEXSAN TECHNOLOGIES & DESIGN mark for the goods specified therein be refused and that Opposer be awarded such further relief as this Board deems just and proper.

Respectfully submitted,

November 16, 2004

By: \_\_\_\_\_

  
Christopher E. George

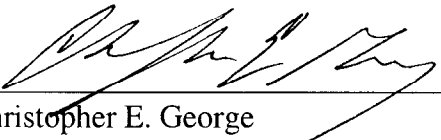
Morrison & Foerster  
2000 Pennsylvania Avenue, NW  
Suite 5500  
Washington, DC 20006-1888  
(202) 887-1500

**CERTIFICATE OF OPPOSER'S ATTORNEYS**

We hereby certify that we are trademark attorneys for Nextel Communications, Inc.,  
Opposer herein, and that we have been instructed to file the foregoing Notice of Opposition. We  
are, therefore, filing this Notice of Opposition under Section 14 of the Trademark Act of 1946  
and under Trademark Rule 2.111.

Morrison & Foerster LLP

November 16, 2004

By:   
Christopher E. George

Attorney for Opposer

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