

ESTTA Tracking number: **ESTTA49514**

Filing date: **10/19/2005**

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>	10/19/2005
<b>Address</b>	2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES

<b>Attorney information</b>	David C. Gryce Arent Fox, PLLC 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES gryce.david@arentfox.com Phone:2028576000
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#### Applicant Information

<b>Application No</b>	76604633	<b>Publication date</b>	06/21/2005
<b>Opposition Filing Date</b>	10/19/2005	<b>Opposition Period Ends</b>	10/19/2005
<b>Applicant</b>	NEO INDEX CORPORATION Sumitomo Fudosan Sarugakucho Bldg., 8F 2-8-8 Sarugakucho, Chiyoda-ku		

Tokyo 101-0064, JAPAN
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**Goods/Services Affected by Opposition**

Class 038.

All goods and services in the class are opposed, namely: Cable, satellite, television and video-on-demand (VOD) broadcasting

<b>Attachments</b>	NextensiveOpposition.pdf ( 8 pages )
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<b>Signature</b>	/David S. Modzeleski/
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<b>Name</b>	David S. Modzeleski, Esq.
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<b>Date</b>	10/19/2005
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NEXTEL (cls. 9)	Reg. No. 1,884,244
NEXTEL (cls. 38)	Reg. No. 1,637,139
NEXTEL & Design (cls. 9 & 38)	Reg. No. 2,391,504
NEXTEL WORLDWIDE (cls. 9 & 38)	Reg. No. 2,598,210
NEXTEL COMPATIBLE (cls. 38)	Reg. No. 2,751,945
NEXTEL NATIONAL PLANS (cls. 38)	Reg. No. 2,692,446
NEXTEL DIRECT CONNECT. GET RIGHT THROUGH. (cls. 9, 38)	Reg. No. 2,765,052
NEXTEL MOBILE EXTENSION (cls. 38)	Reg. No. 2,737,925
NEXTEL HOW BUSINESS GETS DONE INSTANTLY (cls. 38)	Reg. No. 2,764,617
NEXTEL. HOW BUSINESS GETS DONE. (cls. 38)	Reg. No. 2,435,925
NEXTEL ONLINE (cls. 38)	Reg. No. 2,430,370
NEXTEL NATIONAL BUSINESS PLAN (cls. 38)	Reg. No. 2,326,015
NEXTEL NEXTDAY (cls. 39)	Reg. No. 2,306,603
NEXTEL BUSINESS NETWORKS (cls. 38)	Reg. No. 2,359,176
NEXTEL LONG DISTANCE (cls. 38)	Reg. No. 2,251,278
NEXTEL DIRECT CONNECT (cls. 38)	Reg. No. 2,236,098

3. Nextel's federal registrations listed in Paragraph 2 are valid and subsisting, and they provide *prima facie* evidence of Nextel's registration of the NEXTEL Marks, Nextel's ownership of the NEXTEL Marks, and of Nextel's exclusive right to use the NEXTEL Marks in commerce on or in connection with the goods and/or services specified in the registrations.

4. Nextel's federal registrations for the marks NEXTEL (Reg. No. 1,884,244), NEXTEL (Reg. No. 1,637,139), and NEXTEL DIRECT CONNECT (Reg. No. 2,236,098) are incontestable and provide *conclusive* evidence of Nextel's registration of these marks, Nextel's ownership of the marks, and of Nextel's exclusive right to use the marks in commerce on or in connection with the goods or services specified in the registrations.

5. Nextel has also acquired common law trademark rights in its NEXTEL Marks for a wide variety of goods and services related to the telecommunications industry since at least as early as 1988.

6. Nextel used, and acquired trademark rights in, the NEXTEL Marks before July 29, 2004 the date on which NEO Index Corp. filed its application to register NEXTENSIVE.

7. Nextel has expended substantial sums in marketing, advertising, and promoting the NEXTEL Marks in connection with its telecommunications goods and services throughout the United States.

8. Nextel has enjoyed substantial revenue derived from the sale of telecommunications goods and services under the NEXTEL Marks in the United States.

9. By reason of their extensive marketing, advertising, and promotion, the NEXTEL Marks have become uniquely associated with Nextel.

10. The NEXTEL Marks have become well known and famous as distinctive indicators of the origin of Nextel's goods and services, and they are valuable symbols of Nextel's goodwill.

11. The NEXTEL Marks are fanciful, arbitrary, inherently distinctive, and therefore strong and entitled to a broad scope of protection.

12. Notwithstanding Nextel's prior rights in the NEXTEL Marks, NEO Index Corp. filed Application No. 76/604,633 on July 29, 2004, based on intent-to-use.

13. NEO Index Corp.'s mark features the prefix NEXT-, which is identical to the prefix NEXT- found in the NEXTEL Marks.

14. Through Application No. 76/604,633, NEO Index Corp. seeks to obtain registration on the principal register for the NEXTENSIVE mark for use with the following services:

Cable, satellite, television and video-on-demand (VOD) broadcasting, in Class 38.

15. Upon information and belief, NEO Index Corp. made no use of the NEXTENSIVE mark in the United States prior to the filing date of the application.

16. Upon information and belief, NEO Index Corp. was aware of the NEXTEL Marks prior to the filing date of the application.

17. Nextel has not consented to or authorized NEO Index Corp.'s use of the NEXTENSIVE mark.

18. Nextel believes that it will be damaged by the registration of the NEXTENSIVE mark on the principal register.

#### **COUNT I – LIKELIHOOD OF CONFUSION**

19. Nextel hereby incorporates by reference the allegations contained in paragraphs 1 through 18 above.

20. The NEXTENSIVE mark is a colorable imitation of the NEXTEL Marks in that it so closely resembles the NEXTEL Marks that its use and registration would cause confusion, mistake, or deception as to the source of NEO Index Corp.'s services and injure and damage Nextel and the goodwill and reputation symbolized by the NEXTEL Marks.

21. NEO Index Corp.'s services are so closely related to Nextel's goods and services that the public is likely to be confused, to be deceived, and to assume erroneously that NEO Index Corp.'s services are those of Nextel or that NEO Index Corp. is in some way connected with, sponsored by, or affiliated with Nextel, all to Nextel's irreparable damage.

22. Likelihood of confusion in this case is enhanced by the fame of the NEXTEL Marks and by the fact that consumers associate the NEXTEL Marks with goods and services sold, approved, or endorsed by Nextel.

23. On information and belief, prospective purchasers of NEO Index Corp.'s services are purchasers of Nextel's goods and services, and the parties' respective goods and services will be sold through the same channels of trade.

24. If NEO Index Corp. is granted registration of its NEXTENSIVE mark, NEO Index Corp. will obtain the *prima facie* exclusive right to use the mark in the United States, and such registration will impair and diminish Nextel's goodwill and rights in the NEXTEL Marks.

## **COUNT II – DECEPTION/FALSE SUGGESTION OF CONNECTION**

25. Nextel hereby incorporates by reference the allegations contained in paragraphs 1 through 24 above.

26. NEO Index Corp.'s NEXTENSIVE mark so closely resembles the NEXTEL Marks that it is likely to cause deception in violation of Lanham Act Section 2(a).

27. Because the NEXTENSIVE mark points uniquely to Nextel, purchasers will assume that services sold under the mark are connected with Nextel.

28. NEO Index Corp.'s NEXTENSIVE mark is deceptive in that it falsely suggests a connection with Nextel.

### COUNT III – DILUTION

29. Nextel hereby incorporates by reference the allegations contained in paragraphs 1 through 28 above.

30. The NEXTEL Marks have been widely used and extensively publicized in the United States and have become well known and famous within the meaning of Lanham Act § 43(c) as distinctive symbols of Nextel's goodwill.

31. The NEXTEL Marks became well known and famous before NEO Index Corp. made any use of the NEXTENSIVE mark in the United States.

32. NEO Index Corp.'s NEXTENSIVE mark will dilute the distinctive quality of the NEXTEL Marks.

33. The use or registration of NEO Index Corp.'s NEXTENSIVE mark will lessen the capacity of Nextel's famous NEXTEL Marks to identify and distinguish Nextel's goods and services.

By reason of the foregoing, Nextel will be damaged by the registration of the NEXTENSIVE mark, and registration should be refused.

WHEREFORE, Nextel prays that this opposition be sustained and that the registration be denied.

Respectfully submitted,

NEXTEL COMMUNICATIONS, INC.

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**CERTIFICATE OF FILING**

It is hereby certified that the attached Notice of Opposition (re App. No. 76/604,633) is being filed electronically with the U.S. Patent and Trademark Office this 19th day of October 2005.

*Sundshudesh*