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Filing date: **10/28/2005**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Nextel Communications, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES		

Attorney information	Edward W. Gray, Jr. Morrison & Foerster LLP 2000 Pennsylvania Avenue, N.W.Suite 5500 Washington, DC 20006 UNITED STATES trademark-dc@mofa.com Phone:202-887-1500		
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Registration Subject to Cancellation

Registration No	2606643	Registration date	08/13/2002
Registrant	CenturyTel, Inc. P.O. Box 4065 Monroe, LA 712114065 UNITED STATES		
Goods/Services Subject to Cancellation	Class 038. First Use: 20000629, First Use In Commerce: 20000629 Goods/Services: WIRELESS TELEPHONE COMMUNICATION SERVICES FEATURING A RATE PLAN		

Attachments	DIRECT TALK Petitin to Cancel.pdf (9 pages)
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Signature	/Edward W. Gray, Jr./
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Name	Edward W. Gray, Jr.
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Date	10/28/2005
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36030-6278.501

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

NEXTEL COMMUNICATIONS, INC.)	
)	
Petitioner,)	
v.)	
)	
CENTURYTEL, INC.)	
)	
Registrant.)	
)	Cancellation No.:
Reg. No.: 2,606,643)	
Reg. Date: August 13, 2002)	
Mark: DIRECT TALK)	
)	
)	
)	

PETITION FOR CANCELLATION

Nextel Communications, Inc., (hereinafter "Nextel") a Delaware Corporation, having a principal place of business at 2001 Edmund Halley Drive, Reston, Virginia 20191, believes that it is and will be damaged by registration of the trademark DIRECT TALK, Registration No. 2,606,643 by CenturyTel, Inc., (hereinafter "CenturyTel") having a place of business at P.O. Box 4065, Monroe, Louisiana 71211-4065 and therefore hereby petitions to cancel the same upon the following grounds:

FACTUAL ALLEGATIONS

- 1) Upon information and belief, CenturyTel, in its Registration No. 2,606,643, obtained a registration on the Principal Register for the mark DIRECT TALK in connection with

“wireless telephone communication services featuring a rate plan.” Said Registration was issued by the U.S. Patent and Trademark Office on August 13, 2002 and is presently registered and owned by CenturyTel, Inc.

- 2) Upon information and belief, CenturyTel’s earliest date of constructive or actual use of the mark DIRECT TALK upon which it can rely is no earlier than June 29, 2000, the date of first use specified in Registration No. 2,606,643.
- 3) Nextel filed an Intent to Use Application for the mark DIRECT TALK on May 24, 2004, Appl. Ser. No. 78423924.
- 4) Nextel’s DIRECT TALK application has been refused registration based upon CenturyTel’s DIRECT TALK registration pursuant to an Office Action issued on January 18, 2005.
- 5) Nextel is the owner of the following Federal Trademark Registrations:
 - a) Reg. No. 2,236,098, filed February 19, 1997, registered March 30, 1999, for the mark NEXTEL DIRECT CONNECT, in Class 38 for “telecommunications services, namely, two-way radio communications;”
 - b) Reg. No. 2,797,952, registered September 30, 2003, for the mark DIRECT CONNECT, in Class 38 for “Telecommunication services, namely, providing voice, data, pictures, music and video via wireless networks and two-way radio dispatching services, electronic transmission of voice, text, images data and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, dispatch radios, pagers; paging services; mobile telephone communication services; wireless Internet access services; and wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data,

images, information, text, numeric messaging and text messaging and for accessing a global communications network; ”

- c) Reg. No. 2,236,098, registered on February 3, 2004 for the mark DIRECT CONNECT in class 9 for use on “Equipment used in providing telecommunications services, namely mobile radios, two-way radios, cellular telephones, digital cellular telephones, mobile telephones, dispatch radios, pagers, mobile dispatch radios, mobile data receivers; hardware and software for use in communications networks, namely, internet protocol and telecommunications network transmitters, receivers, converters, and routers which allow the user to send voice, data, pictures, music and video over wireless networks”
- d) Reg. No. 2,901,463, registered on November 9, 2004 for the mark NATIONWIDE DIRECT CONNECT in class 38 for “Telecommunication services, namely, providing voice, data, pictures, music and video via wireless networks and two-way radio dispatching services, electronic transmission of voice, text, images, data and information by means of two-way radios, mobile radios, cellular telephones, digital cellular telephones, mobile telephones, electronic handheld units for the wireless receipt and/or transmission of voice/data/video/pictures, dispatch radios, and pagers; paging services; mobile telephone communication services; wireless Internet access services; and wireless data services for mobile electronic hand held units for the purpose of sending and receiving via a wireless network, electronic mail, facsimiles, data, images, information, text, numeric messaging and text messaging and for accessing a global communications network.”

- 6) Nextel has used the mark DIRECT CONNECT in commerce throughout the United States at least as early as March 3, 1997.
- 7) Nextel has used the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT in commerce prior to the earliest date of constructive or actual use of the DIRECT TALK Mark by CenturyTel, upon which they can rely, i.e., June 29, 2000.
- 8) CenturyTel's use of the DIRECT TALK Marks is without the consent or permission of Nextel.
- 9) Nextel has expended substantial monies in marketing, advertising, and promoting the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT in connection with its telecommunications goods and services in interstate commerce throughout the United States.
- 10) Nextel has enjoyed substantial revenue derived from the sale of said telecommunications goods and services in connection with the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT in the United States.
- 11) By reason of the extensive marketing, advertising and promotion, the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT are associated with Nextel.

COUNT I – ABANDONMENT

- 12) Nextel hereby incorporates the allegations contained in paragraph nos. 1-11 by reference herein.
- 13) Upon information and belief, CenturyTel is not using the mark DIRECT TALK in commerce in connection with the services recited in Registration No. 2,606,643

14) Upon information and belief, CenturyTel discontinued its use of the mark DIRECT TALK in commerce with the intent not to resume such use.

15) By the maintenance of CenturyTel's abandoned mark DIRECT TALK on the Principal Register, Nextel Communications is irreparably harmed. Therefore, Nextel Communications petitions to cancel the Registration of CenturyTel's DIRECT TALK mark pursuant to 15 U.S.C. § 1064, as amended by the Trademark Act of 1999.

COUNT II- LIKELIHOOD OF CONFUSION

16) Nextel hereby incorporates the allegations contained in paragraph nos. 1-15 by reference herein.

17) By reason of the extensive marketing, advertising and promotion of said telecommunications goods and services in connection with the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT, the mark DIRECT CONNECT has become famous and distinctive and represents an extremely valuable goodwill associated with Nextel.

18) Upon information and belief, the services for which CenturyTel has obtained registration of the DIRECT TALK Mark are substantially similar to the goods and services in connection with which Nextel uses its marks NEXTEL DIRECT CONNECT and DIRECT CONNECT.

19) Upon information and belief, the services for which CenturyTel has obtained registration of the DIRECT TALK Mark are offered to the same customers that Nextel offers its goods and services in connection with its marks NEXTEL DIRECT CONNECT and DIRECT CONNECT.

- 20) Upon information and belief, the services for which CenturyTel has obtained registration of the DIRECT TALK Mark are offered through the same channels of trade that Nextel offers its goods and services in connection with its marks NEXTEL DIRECT CONNECT and DIRECT CONNECT.
- 21) The DIRECT TALK Mark for which CenturyTel has obtained registration is substantially similar to the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT which are used by Nextel.
- 22) CenturyTel's DIRECT TALK Mark is confusingly similar to Nextel's marks NEXTEL DIRECT CONNECT and DIRECT CONNECT and use thereof by CenturyTel on the services specified in Trademark Registration No. 2,606,643 is likely to cause confusion, mistake or deception that CenturyTel's services are those of Nextel or are otherwise endorsed, sponsored, or approved by Nextel, whereby Nextel will be damaged by the registration of the DIRECT TALK Mark on the Principal Register of the United States Patent and Trademark Office.
- 23) If CenturyTel is permitted to maintain registration of the DIRECT TALK Mark as shown in Registration No. 2,606,643, CenturyTel will thereby obtain *prima facie* exclusive right to use such marks in the United States and such registration will impair and diminish Nextel's goodwill and rights in its marks NEXTEL DIRECT CONNECT and DIRECT CONNECT thereby causing irreparable damage and injury to Nextel. Therefore, Nextel petitions to cancel the registration of CenturyTel's DIRECT TALK Mark pursuant to 15 U.S.C. §§ 1052 and 1063(a), as amended by the Trademark Act of 1999.

COUNT III-DILUTION

- 24) Nextel hereby incorporates the allegations contained in paragraph nos. 1-23 by reference herein.
- 25) The marks NEXTEL DIRECT CONNECT and DIRECT CONNECT have come to represent extremely valuable goodwill associated with Nextel by reason of the extensive use, marketing, publicity, and advertising of the mark, since at least as early as 1997.
- 26) Nextel's marks NEXTEL DIRECT CONNECT and DIRECT CONNECT are 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).
- 27) Upon information and belief, the services in connection with which the CenturyTel has obtained registration of the DIRECT TALK Mark are likely to be sold to the same customers and through the same channels of trade that Nextel sells its telecommunications goods and services in connection with the marks NEXTEL DIRECT CONNECT and DIRECT CONNECT.
- 28) CenturyTel's DIRECT TALK Mark is confusingly similar to Nextel's marks NEXTEL DIRECT CONNECT and DIRECT CONNECT that are used by Nextel in connection with telecommunications goods and services in the United States.
- 29) Upon information and belief, Nextel's marks NEXTEL DIRECT CONNECT and DIRECT CONNECT became famous and distinctive prior to CenturyTel's filing date of its application or any commercial use of CenturyTel's DIRECT TALK mark in commerce.
- 30) If CenturyTel is permitted to maintain its registration of its DIRECT TALK Mark as shown in Registration No. 2,606,643, CenturyTel will thereby maintain the *prima facie* exclusive

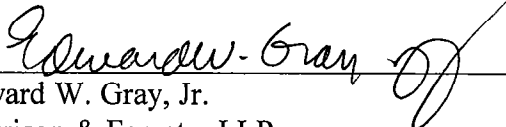
right to use such mark, and such registration will impair, diminish and dilute Nextel's goodwill and rights in its marks NEXTEL DIRECT CONNECT and DIRECT CONNECT thereby causing irreparable injury to Nextel. Therefore, Nextel petitions to cancel registration of CenturyTel's DIRECT TALK Mark pursuant to 15 U.S.C. §§ 1052 and 1063(a), as amended by the Trademark Amendments Act of 1999.

PRAYER FOR RELIEF

WHEREFORE, Nextel Communications prays that Registration No. 2,606,643 be canceled.

Respectfully submitted,

October 28, 2005

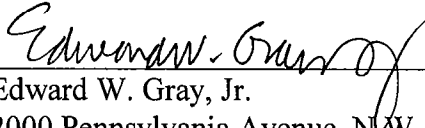
By: 
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CERTIFICATE OF PETITIONER'S ATTORNEYS

We hereby certify that we are trademark attorneys for Nextel Communications, Inc.,
Petitioner herein, and that we have been instructed to file the foregoing Petition for Cancellation.
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

October 28, 2005

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Attorney for Opposer