ESTTA Tracking number: **ESTTA454952**
Filing date: **02/06/2012**

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

Proceeding	91200355
Party	Plaintiff Motorola Mobility, Inc., Motorola Trademark Holdings, LLC
Correspondence Address	THOMAS M WILLIAMS WINSTON & STRAWN LLP 35 W WACKER DRIVE CHICAGO, IL 60601-9703 UNITED STATES tmwilliams@winston.com, docketCH@winston.com, ahodgson@winston.com, iagarcia@winston.com
Submission	Other Motions/Papers
Filer's Name	Thomas M. Williams
Filer's e-mail	tmwilliams@winston.com, iagarcia@winston.com, ahodgson@winston.com, tmdavis@winston.com
Signature	s/Thomas M. Williams/
Date	02/06/2012
Attachments	Appendix A.pdf (65 pages)(1873222 bytes)

APPENDIX A

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

Application Serial No. 78/575,442 Filed: February 25, 2005 Published: February 22, 2011, in the *Official Gazette* For: SOUND MARK	)	Opposition No. 91/200,355
Motorola Mobility, Inc. and Motorola Trademark Holdings, LLC, **Opposers,** **vs.** **Nextel Communications, Inc.** **Applicant.**	)	

DECLARATION OF ALISSA HODGSON IN SUPPORT OF OPPOSERS' MOTION FOR SUMMARY JUDGMENT ON THE ISSUES OF RES JUDICATA AND COLLATERAL ESTOPPEL

I, Alissa Hodgson, under penalty of perjury, declare as follows:

1. I am a paralegal at the law firm Winston & Strawn LLP in Chicago, Illinois. I have worked at this firm since March 2011. I have been a law firm paralegal since June 1995. In my position as a paralegal, I have significant experience in handling legal pleadings and dockets. I am making this declaration based on my personal knowledge and in support of Opposers' motion for summary judgment in the above-captioned opposition proceeding.

2. Attached as Exhibit 1 is a true and correct copy of the U.S.P.T.O. Trademark Application and Registration Retrieval page for trademark application serial number 78/235,365, filed by Motorola, Inc. and described as follows: "The mark consists of an electronic chirp consisting of a tone at 1800 Hz played at a cadence of 24 milliseconds ON, 24 ms OFF, 24 ms

ON, 24 ms OFF, 48 ms ON." This document was downloaded from the U.S.P.T.O.'s TARR web page on February 6, 2012.

3. Attached as Exhibit 2 is a true and correct copy of the Amended Notice of Opposition (with its exhibits A-C) from the opposition proceeding captioned as *Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353) appearing at docket entry 7. This document was downloaded from the T.T.A.B.'s TTABVUE web page on January 11, 2012.

4. Attached as Exhibit 3 is a true and correct copy of excerpts from the testimony deposition transcript of Peter Aloumanis from the opposition proceeding captioned as *Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353) appearing at docket entry 73. This document was downloaded from the T.T.A.B.'s TTABVUE web page on January 12, 2012.

5. Attached as Exhibit 4 is a true and correct copy of excerpts from the testimony deposition transcript of Mark Schweitzer from the opposition proceeding captioned as *Nextel Communications, Inc. v. Motorola, Inc.* (T.T.A.B. Case No. 91/164,353) appearing at docket entry 71. This document was downloaded from the T.T.A.B.'s TTABVUE web page on January 11, 2012.

6. Attached as Exhibit 5 is a true and correct copy of a Notice of Opposition filed by Southern Communications Services, Inc. from the opposition proceeding captioned as *Southern Communications Services, Inc. v. S-N Merger Corp.* (T.T.A.B. Case No. 91/200,324) appearing at docket entry 1. This document was downloaded from the T.T.A.B.'s TTABVUE web page on February 6, 2012.

I certify under penalty of perjury of the laws of the United States of America that the foregoing is true and correct.

Dated: February 6, 2012

By: /s/Alissa Hodgson

Name: Alissa Hodgson

Title: Senior Paralegal

CHI:2620101.2

EXHIBIT 1
TO THE DECLARATION
OF ALISSA HODGSON

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-02-06 12:10:43 ET

Serial Number: 78235365 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark : (SENSORY MARK ONLY)

Standard Character claim: No

Current Status: Abandoned after an inter partes decision by the Trademark Trial and Appeal Board. For further information, see TTABVUE on the Trademark Trial and Appeal Board web page.

Date of Status: 2009-08-28

Filing Date: 2003-04-08

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 845 -TTAB

Date In Location: 2009-08-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

---

1. Motorola, Inc.

Address:
Motorola, Inc.
1303 East Algonquin Road
Schaumburg, IL 60196
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware
Phone Number: 847-523-1633
Fax Number: 847-523-4348

GOODS AND/OR SERVICES

International Class: 009
Class Status: Abandoned
Cellular telephones and two-way radios
Basis: 1(a)
First Use Date: 1996-04-30
First Use in Commerce Date: 1996-04-30

ADDITIONAL INFORMATION

Description of Mark: The mark consists of an electronic chirp consisting of a tone at 1800 Hz played at a cadence of 24 milliseconds ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON.

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-08-28 - Abandonment Notice Mailed - Inter Partes Decision

2009-08-28 - Abandonment - After inter partes decision (Initial exam)

2009-08-28 - Opposition terminated for Proceeding

2009-06-12 - Opposition sustained for Proceeding

2009-03-06 - Attorney Revoked And/Or Appointed

2009-03-06 - TEAS Revoke/Appoint Attorney Received

2005-03-03 - Opposition instituted for Proceeding

2004-12-01 - Extension Of Time To Oppose Received

2004-11-02 - Published for opposition

2004-10-13 - Notice of publication

2004-08-31 - Law Office Publication Review Completed

2004-07-27 - Assigned To LIE

2004-06-14 - Approved for Pub - Principal Register (Initial exam)

2004-06-14 - EXAMINERS AMENDMENT E-MAILED

2004-06-14 - Previous Allowance Count Withdrawn

2004-06-14 - Approved for Pub - Principal Register (Initial exam)

2004-06-14 - Previous Allowance Count Withdrawn

2004-03-08 - Approved for Pub - Principal Register (Initial exam)

2004-03-08 - Amendment to Use approved

2003-12-18 - Amendment To Use Processing Complete

2003-10-20 - Use Amendment Filed

2003-10-20 - Communication received from applicant

2003-10-20 - PAPER RECEIVED

2003-10-29 - Non-final action e-mailed

2003-09-01 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
William R. Anderson

Correspondent
THOMAS WILLIAMS
WINSTON & STRAWN LLP
35 WEST WACKER DRIVE
CHICAGO, IL 60601-9703
Phone Number: 847-523-3007

EXHIBIT 2
TO THE DECLARATION
OF ALISSA HODGSON

ESTTA Tracking number: **ESTTA32964**
Filing date: **05/12/2005**

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

Proceeding	91164353
Party	Plaintiff Nextel Communications, Inc. Nextel Communications, Inc. 2001 Edmund Halley Drive Reston, VA 20191 UNITED STATES
Correspondence Address	John I. Stewart, Jr. Crowell & Moring, LLP 1001 Pennsylvania Ave., NW Washington, DC 20004 UNITED STATES jstewart@crowell.com, khermann@crowell.com, wsauers@crowell.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	William J. Sauers
Filer's e-mail	wsauers@crowell.com, jstewart@crowell.com, mjacobs@crowell.com
Signature	/William J. Sauers/
Date	05/12/2005
Attachments	Amended Notice of Opposition.pdf (26 pages)

Attorney Docket: 100773.92147US
BOX - TTAB

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

NEXTEL COMMUNICATIONS, INC., Opposer,	)	
v.	)	Opp. No.: 91/164,353 App. No.: 78/235,365 Pot. Mark: SENSORY MARK (1800 Hz tone)
MOTOROLA, INC., Applicant.	)	

BOX - TTAB – NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

AMENDED NOTICE OF OPPOSITION

Honorable Commissioner:

NEXTEL COMMUNICATIONS, INC. ("Opposer"), a corporation duly organized and existing under the laws of the state of Delaware, located and doing business at 2001 Edmund Halley Drive, Reston, VA 20191, believing that it will be damaged by registration, hereby opposes Application Serial No. 78/235,365, filed April 8, 2003, under the Trademark Act of 1946, in the name of MOTOROLA, INC. ("Applicant").

The grounds for opposition are as follows:

1. Opposer, acting on behalf of itself and through its wholly owned operating subsidiaries, is one of the largest providers of cellular telephone and dispatch communications services in the United States, and currently has over 16 million subscribers to its services nationwide.

2. Opposer and Applicant have a long-standing business relationship, whereby Applicant manufactures phones, and accessories therefor, for sale by Opposer, or its wholly owned operating subsidiaries, for use with Opposer's cellular telephone and dispatch services.

3. Applicant manufactures phones and accessories for Opposer's direct competitors.

4. Upon information and belief, on April 8, 2003, Applicant filed an application for registration of an electronic sound consisting 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 ("the 1800 Hz Tone") in connection with "cellular telephones and two-way radios," in International Class 9 ("the 1800 Hz Tone Application"). The 1800 Hz Tone Application was assigned Serial No. 78/235,365, and was published for opposition in the Official Gazette on November 2, 2004. A copy of the 1800 Hz Tone Application is attached hereto as Exhibit A.

5. The 1800 Hz Tone Application was filed under 15 U.S.C. § 1051(b).

6. On October 17, 2003, Applicant submitted an Amendment to Allege Use of the 1800 Hz Tone, together with a specimen of use in the form of a compact disc described as "[a] sound file that contains a sound that emanates from the

cellular phone or two-way radio to alert user or receiver of an incoming call or the availability to speak." The Applicant alleged April 30, 1996 as its date of first use in commerce of the 1800 Hz Tone. A copy of Applicant's October 17, 2003 Amendment to Allege Use, excluding the specimen of use, is attached hereto as Exhibit B.

7. On October 29, 2003, the United States Patent and Trademark Office ("USPTO") issued an Office Action in connection with the 1800 Hz Tone Application, requiring a description of the 1800 Hz Tone. A copy of the USPTO Office Action of October 29, 2003 is attached hereto as Exhibit C.

8. Upon information and belief, Applicant has not used the 1800 Hz Tone in commerce in connection with the goods listed in the 1800 Hz Tone Application, in derogation of 15 U.S.C. §§ 1051(a) and 1127.

9. Upon information and belief, the 1800 Hz Tone is not entitled to registration as it fails to meet requirements for registrability as per 15 U.S.C. §§ 1051, 1052 and 1127, specifically:

a. The 1800 Hz Tone is not inherently distinctive and has not acquired distinctiveness as to the goods in the 1800 Hz Tone Application, and is not entitled to registration pursuant to 15 U.S.C. §§ 1051, 1052 and 1127.

b. The 1800 Hz Tone is functional as applied to the goods in the 1800 Hz Tone Application, and is not entitled to registration pursuant to 15 U.S.C. § 1052(e).

c. The 1800 Hz Tone consists of or comprises a mark which so resembles a mark previously used in the United States by Opposer, i.e., the Nextel

Chirp as described in paragraph 10 herein, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive, and is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

10. Opposer is the owner of a mark consisting 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 ("the Nextel Chirp"), and of Federal Trademark Application Serial No. 78/575,442, for registration of the Nextel Chirp in connection with "Telecommunication services, namely, electronic, electric and digital transmission of voice, data, pictures, music, video, and other 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 services," in International Class 38 ("the Nextel Chirp Application").

11. Upon information and belief, the goods for which Applicant is seeking registration of the 1800 Hz Tone are closely related to the services offered by Opposer under its Nextel Chirp and as set out in the Nextel Chirp Application.

12. Upon information and belief, the goods for which Applicant is seeking registration of the 1800 Hz Tone are ultimately offered to the same or similar customers as the services offered by Opposer under its Nextel Chirp and as set out in the Nextel Chirp Application.

13. Upon information and belief, the goods for which Applicant is seeking registration of the 1800 Hz Tone are ultimately offered through the same channels of trade as the services offered by Opposer under its Nextel Chirp and as set out in the Nextel Chirp Application.

14. Upon information and belief, the 1800 Hz Tone for which Applicant is seeking registration is substantially similar to Opposer's Nextel Chirp as contained in the Nextel Chirp Application.

15. Upon information and belief, in the event that Applicant's 1800 Hz Tone is found to be in use as a mark and is found to be inherently distinctive or to have acquired distinctiveness, it so resembles Opposer's Nextel Chirp as to be likely, when used in connection with the goods listed in the 1800 Hz Tone Application, to cause confusion, to cause mistake, or to deceive, in derogation of 15 U.S.C. § 1052(d).

16. If Applicant is granted registration of the 1800 Hz Tone as set out in the 1800 Hz Tone Application, Applicant will obtain a *prima facie* exclusive right to use the 1800 Hz Tone in the United States despite the likelihood of confusion, mistake, or deception with the Nextel Chirp; such registration will thereby impair and diminish Opposer's goodwill and rights in the Nextel Chirp, to the irreparable damage and injury of Opposer.

WHEREFORE, Opposer, NEXTEL COMMUNICATIONS, INC., believes and avers that it is being damaged by the application for registration, and will be damaged by registration, by Applicant of the 1800 Hz Tone as aforesaid, and prays that said Application Serial No. 78/235,365 be rejected, that no registration be issued thereon to Applicant, and this Opposition be sustained in favor of Opposer.

Opposer has appointed JOHN I. STEWART, JR., MICHAEL H. JACOBS, KAREN C. HERMANN, and WILLIAM J. SAUERS, members of the law firm of **CROWELL & MORING LLP**, and members of the Bar of the District of Columbia, to prosecute this Opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

John I. Stewart, Jr.
Crowell & Moring LLP
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-5116

The filing fee in the amount of $300.00 was submitted with the originally filed Notice of Opposition. Please credit any overpayments or charge any additional fees to the Deposit Account of Crowell & Moring LLP, Account Number 05-1323 (Docket #100773.92147US).

Respectfully submitted,

May 12, 2005

John L. Stewart, Jr.
Attorney for Opposer

CROWELL & MORING LLP
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844

CERTIFICATE OF SERVICE

I hereby certify that a true copy of OPPOSER'S AMENDED NOTICE OF OPPOSITION the was served on counsel for the Applicant, this 12th day of May, 2005, by sending the same via First Class Mail, postage prepaid, to:

John T. Gabrielides
BRINKS, HOFER, GILSON & LIONE
455 North Cityfront Plaza Drive
NBC Tower, Suite 3600
Chicago, Illinois 60611-5599

William J. Sauers

Exhibit A

DOCUMENT INFORMATION	
TRADEMARK/SERVICEMARK APPLICATION	
VERSION 1.24	
APPLICANT INFORMATION	
NAME	Motorola, Inc.
STREET	1303 East Algonquin Road
CITY	Schaumburg
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60196
TELEPHONE NUMBER	847-523-1633
FAX NUMBER	847-523-4348
APPLICANT ENTITY INFORMATION	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Delaware
TRADEMARK/SERVICEMARK INFORMATION	
MARK	NO DRAWING (SOUND MARK)
TYPED FORM	Yes
BASIS FOR FILING AND GOODS/SERVICES INFORMATION	
INTENT TO USE: SECTION 1(b)	Yes
INTERNATIONAL CLASS NUMBER	009
LISTING OF GOODS AND/OR SERVICES	Cellular telephones and two-way radios
OPTIONAL INFORMATION	

DESCRIPTION OF THE MARK	The mark consists of a tone at 1800 Hz played at a cadence of 24 milliseconds ON, 24ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON.
ATTORNEY INFORMATION	
NAME	Carolyn E. Knecht
STREET	600 North U.S. Highway 45
CITY	Libertyville
STATE	IL
COUNTRY	USA
ZIP/POSTAL CODE	60048
FIRM NAME	Motorola, Inc.
E-MAIL ADDRESS	carrie.knecht@motorola.com
AUTHORIZE E-MAIL COMMUNICATION	Yes
TELEPHONE NUMBER	847-523-5876
FAX NUMBER	847-523-4348
ATTORNEY DOCKET NUMBER	TM03-1005
OTHER APPOINTED ATTORNEY(S)	Arch M. Ahern
FEE INFORMATION	
TOTAL FEES PAID	335
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1
LAW OFFICE INFORMATION	
E-MAIL ADDRESS FOR CORRESPONDENCE	carrie.knecht@motorola.com

SIGNATURE AND OTHER INFORMATION	
SIGNATURE	/cek/
DATE	04/08/2003
NAME	Carolyn E. Knecht
TITLE	Senior Trademark Counsel
MAILING ADDRESS	
LINE	Carolyn E. Knecht
LINE	Motorola, Inc.
LINE	600 North U.S. Highway 45
LINE	Libertyville IL USA 60048
SERIAL NUMBER INFORMATION	
SERIAL NUMBER	78235365
RAM INFORMATION	
RAM SALE NUMBER	410
RAM ACCOUNTING DATE	04/09/2003
INTERNET TRANSMISSION DATE	Tue Apr 08 18:30:48 EDT 2003
TEAS STAMP	USPTO/BAS-1361822221-20030408183048119048-78235365-200211f312c63e38e1f2dc77ecbc482950-DA-410-20030408182833555322
E-MAIL ADDRESS FOR ACKNOWLEDGMENT	kristen.poggensee@motorola.com

<SERIAL NUMBER> 78235365
<FILING DATE> 04/08/2003

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME>	Motorola, Inc.
<STREET>	1303 East Algonquin Road
<CITY>	Schaumburg
<STATE>	IL
<COUNTRY>	USA
<ZIP/POSTAL CODE>	60196
<TELEPHONE NUMBER>	847-523-1633
<FAX NUMBER>	847-523-4348

<APPLICANT ENTITY INFORMATION>
<CORPORATION: STATE/COUNTRY OF INCORPORATION> Delaware

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> NO DRAWING (SOUND MARK)
<TYPED FORM> Yes
~Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended).~

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>
<INTENT TO USE: SECTION 1(b)> Yes
~ The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).~
<INTERNATIONAL CLASS NUMBER> 009
<LISTING OF GOODS AND/OR SERVICES> Cellular telephones and two-way radios

<OPTIONAL INFORMATION>
<DESCRIPTION OF THE MARK> The mark consists of a tone at 1800 Hz played at a cadence of 24 milliseconds ON, 24ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON.

<ATTORNEY INFORMATION>

<NAME>	Carolyn E. Knecht
<STREET>	600 North U.S. Highway 45
<CITY>	Libertyville

<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60048
<FIRM NAME> Motorola, Inc.
<E-MAIL ADDRESS> carrie.knecht@motorola.com
<AUTHORIZE E-MAIL COMMUNICATION> Yes
<TELEPHONE NUMBER> 847-523-5876
<FAX NUMBER> 847-523-4348
<ATTORNEY DOCKET NUMBER> TM03-1005
<OTHER APPOINTED ATTORNEY(S)> Arch M. Ahern

<FEE INFORMATION>
<TOTAL FEES PAID> 335
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>
~The USPTO is authorized to communicate with the applicant's attorney at the below e-mail address~
<E-MAIL ADDRESS FOR CORRESPONDENCE> carrie.knecht@motorola.com

<SIGNATURE AND OTHER INFORMATION>
~The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.~
<SIGNATURE> /cek/
<DATE> 04/08/2003
<NAME> Carolyn E. Knecht
<TITLE> Senior Trademark Counsel

<MAILING ADDRESS>
<LINE> Carolyn E. Knecht
<LINE> Motorola, Inc.

<LINE> 600 North U.S. Highway 45
<LINE> Libertyville IL USA 60048

<SERIAL NUMBER INFORMATION>
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<TEAS STAMP>
USPTO/BAS-1361822221-20030408183048119048-78235365-
200211f312c63e38e1f2dc77ecbc482950-DA-410-20030408182833555322
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> kristen.poggensee@motorola.com

Internet Transmission Date:
2003/04/08

Serial Number:
78235365

Filing Date:
2003/04/08

TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: $335

RAM SALE NUMBER: 410
RAM ACCOUNTING DATE: 04/09/2003

NO OCR

04-08-2003

Applicant: Motorola, Inc.
Mark: (SENSORY MARK ONLY)
Serial No.: 78/235365
Class: 9
Docket No.: TM03-1005

Exhibit B

MOTOROLA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Motorola, Inc.	Examining Attorney:	David Taylor
Serial No:	78235365	Law Office:	112
Filed:	April 8, 2003	Int'l Class:	009
Mark:	(SENSORY MARK ONLY)		
Attorney Docket No:	TM03-1005		

October 17, 2003
BOX ITU
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I, Kristen D. Poggensee (printed name), hereby certify that this correspondence is being deposited with the United States Postal Service on 10/17/03 (date) as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:

Date: 10/17/03 Signature: Kristen D. Poggensee

Dear Sir:

Enclosed are Applicant's CD sound specimen and Amendment to Allege Use for the above application.

Regards,

Kristen D. Poggensee

Kristen D. Poggensee

Motorola, Inc., Corporate Law Department
600 North U.S. Highway 45, Libertyville, IL 60048 U.S.A. Tel: +1 847 523 7652
Email: Kristen.poggensee@motorola.com

10-20-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

MOTOROLA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Motorola, Inc.	Examining Attorney:	David Taylor
Serial No:	78235365	Law Office:	112
Filed:	April 8, 2003	Int'l Class:	009
Mark:	(SENSORY MARK ONLY)		
Attorney Docket No:	TM03-1005		

October 17, 2003
BOX ITU
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I, Kristen D. Poggensee (printed name), hereby certify that this correspondence is being deposited with the United States Postal Service on 10/17/03 (date) as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on:

Date: 10/17/03 Signature: Kristen D Poggensee

Dear Sir:

Enclosed are Applicant's CD sound specimen and Amendment to Allege Use for the above application.

Regards,

Kristen D. Poggensee

Kristen D. Poggensee

Motorola, Inc., Corporate Law Department
600 North U.S. Highway 45, Libertyville, IL 60048 U.S.A. Tel: +1 847 523 7652
Email: Kristen.poggensee@motorola.com

PTO/TM/1553 (Rev 4/2000)
OMB No. 0651-0009 (Exp. 08/31/2004)

* Trademark/Service Mark Allegation of Use *

* (Statement of Use/Amendment to Allege Use) *
* (15 U.S.C. §1051(c) or (d)) *

*** To the Commissioner for Trademarks ***

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK ALLEGATION OF USE>
<VERSION 1.2>

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> (SENSORY MARK ONLY)
<SERIAL NUMBER> 78235365
<LAW OFFICE ASSIGNED> LAW OFFICE 112

<APPLICANT INFORMATION>
<NAME> Motorola, Inc.
<STREET> 1303 East Algonquin Road
<CITY> Schaumburg
<STATE> IL
<COUNTRY> USA
<ZIP/POSTAL CODE> 60196

<GOODS AND SERVICES INFORMATION>
<ALL GOODS AND/OR SERVICES IN APPLICATION/NOTICE OF ALLOWANCE> Yes

~ The applicant is using or is using through a related company the mark in commerce on or in connection with all the goods/services listed in the Application/Notice of Allowance. ~

<FEE INFORMATION>
<TOTAL FEES PAID> 100
<NUMBER OF CLASSES> 1

11/10/2003 ZCLIFT01 00000083 134765 78235365
01 FC:6002 100.00 DA

<DEPOSIT ACCOUNT INFORMATION>
<DEPOSIT ACCOUNT NUMBER> 134765

~ The U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to the deposit account listed above. ~

<NAME OF PERSON AUTHORIZING ACCOUNT ACTIVITY> Arch M. Ahern
<COMPANY/FIRM NAME> Motorola, Inc.

<USE INFORMATION>
<SPECIMEN DESCRIPTION> The specimen is a sound file that contains a sound that eminates from the cellular telephone or two-way radio to alert user or receiver of an incoming call or the availability to speak.
<FIRST USE ANYWHERE DATE> 04/30/1996

<FIRST USE IN COMMERCE DATE> 04/30/1996

<SIGNATURE AND OTHER INFORMATION>

*~ **Declaration:** Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using or is using through a related company the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. ~*

~ The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true. ~

<SIGNATURE> * please sign here*
<DATE> October 16, 2003
<NAME> Arch M. Ahern
<TITLE> Senior Counsel, Trademark & Marketing
<TELEPHONE NUMBER> 847-523-1633
<E-MAIL ADDRESS> arch.ahern@motorola.com

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

on 10/17/03
Date

Kristen D. Poggensee
Signature

Kristen D. Poggensee
Typed or printed name of person signing certificate

Exhibit C

To:	Motorola, Inc. (carrie.knecht@motorola.com)
Subject:	TRADEMARK APPLICATION NO. 78235365 - TM03-1005
Sent:	10/29/03 3:47:17 PM
Sent As:	ECom112
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/235365

APPLICANT: Motorola, Inc.

CORRESPONDENT ADDRESS:
Carolyn E. Knecht
MOTOROLA
600 N US HIGHWAY 45
LIBERTYVILLE IL 60048-5343

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom112@uspto.gov

MARK:

CORRESPONDENT'S REFERENCE/DOCKET NO: TM03-1005

CORRESPONDENT EMAIL ADDRESS:
carrie.knecht@motorola.com

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 78/235365

The assigned examining attorney has reviewed the referenced application and determined the following.

Search Results
The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

Description of the Mark Needed
The applicant must submit a concise description of the mark. 37 C.F.R. §2.37; TMEP §§808 et seq. The description must identify the sound mark in common English terms. For example, the following form is acceptable, if accurate:

The mark consists of the sound of [specify, e.g., a ringing telephone].

RESPONSE GUIDELINES
No set form is required for response to this Office action. The applicant may respond via fax, electronic mail or traditional mail. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number to speed up further processing.

Note For Electronic Responses
Any communications regarding pending applications sent via e-mail to any of the law office e-mail addresses must:

(1) be in English;
(2) ***include the entire response as e-mail text, not as an attachment***;
(3) list the serial number in the "Subject" line; and
(4) include any specimens or evidence in jpg or gif format only.

For security and compatibility reasons, the Office will ***not*** accept communications that include any attachments, other than those in jpg or gif format. Thus, no ***attachments*** in WordPerfect®, Word, Adobe® PDF or any other format EXCEPT jpg or gif can be accepted.

Additionally, all such communications sent via e-mail should (1) be ***signed electronically*** (using the same format accepted for electronically-filed applications, namely, the signatory must enter any combination of alpha/numeric characters that has been specifically adopted to serve the function of the signature, preceded and followed by the forward slash (/) symbol. **Acceptable "signatures" could include: /john doe/; /jd/; and /123-4567/.** (See 64 FR 33056, 33062 (June 21, 1999))); and (2) address every issue raised. Failure to comply with these additional requirements will result in delays in prosecuting your application.

Note Regarding Timely Filing Of Responses
The statutory period for response to an Office action during examination is six months. 15 U.S.C. §1062(b). The examining attorney does not have any discretion to shorten or extend such period.

The crucial date for the response is the date it is received by the Office, not the date it is mailed by the applicant. The applicant should see 37 C.F.R. §§1.8 and 1.10; TMEP §§702.02, 702.03 and 702.04(f), regarding certificate of mailing, certificate of transmission and "Express Mail" procedures to avoid lateness.

Note Regarding Status Of Application
Current status and status date information is available on-line at http://tarr.uspto.gov/ or, via push button telephone, for all federal trademark registration and application records maintained in the

automated Trademark Reporting and Monitoring (TRAM) system. The information may be accessed by calling (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday, and entering a seven-digit registration number or eight-digit application number, followed by the "#" symbol, after the welcoming message and tone. Callers may request information for up to five registration number or application number records per call.

David T. Taylor /dtt/
2900 Crystal Drive
Arlington, VA 22202
Law Office 112
703-308-9112, ext. 164
703-746-8112
ecom112@uspto.gov

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit **http://www.uspto.gov/teas/index.html** and follow the instructions.

To respond formally via E-mail, visit **http://www.uspto.gov/web/trademarks/tmelecresp.htm** and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at **http://www.uspto.gov/main/trademarks.htm**

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

EXHIBIT 3
TO THE DECLARATION
OF ALISSA HODGSON

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
2
3 NEXTEL COMMUNICATIONS, INC.,) Opp. No.:
) 91/164,353
4 Opposer,)
) App. No.:
5 -vs-) 78/235,365
)
6 MOTOROLA, INC.,) Pot Mark:
) SENSORY MARK
7 Applicant.) (1800 Hz Tone)
8
9 Deposition of PETER ALOUMANIS, taken
10 before NANCY EATINGER, C.S.R., and Notary Public,
11 pursuant to the provisions of the United States
12 Patent and Trademark Office, pertaining to the taking
13 of depositions, at Suite 3600, 455 North Cityfront
14 Plaza Drive, Chicago, Illinois, commencing at 12:50
15 o'clock p.m., taken on the 20th day of February,
16 2008.
17
18
19
20
21
22
23
24

1 2001 up until December of last year.
2 MR. WILLIAMS: We're going to mark our first
3 exhibit.
4 (Whereupon, Aloumanis Exhibit No. 1 was
5 marked for identification.)
6 MR. WILLIAMS: Exhibit 1 is an audio CD which I'm
7 going to play for you.
8 (Whereupon, Aloumanis Exhibit No. 1 was
9 played but not taken down by the court reporter.)
10 MR. WILLIAMS: Q Can you identify that tone?
11 **A** Yeah. It's the Motorola push-to-talk chirp.
12 **Q** How are you familiar with that tone?
13 **A** It's used on our handsets.
14 **Q** Which particular handsets?
15 **A** All of them -- well, all of the ones that
16 have iDEN push-to-talk capability.
17 **Q** How does Motorola use that tone?
18 **A** It uses it in a couple ways. The first way
19 it uses it is to notify the user that a push-to-talk
20 call is being made, and the second way is as an audio
21 mark to let people know that this is a Motorola
22 handset much like the way we put a logo or a bat wing
23 or the name on the back of the handset.
24 **Q** I believe you testified that you have

1 applications that would reside in the handset, so
2 this was targeted at software developers.
3 If you look at -- I mean, I can go on, but
4 CTI Wireless, that's a trade show, so the people that
5 would go to that would be dealers, retail agents,
6 that sort of thing, looking for the latest and
7 greatest in technology and what was coming down the
8 road.
9 And then the ultimate example is the
10 Consumer Electronics Show, which is -- it's a three
11 to four-day event in Las Vegas where you have a
12 combination of dealers, distributors, carrier
13 partners are there as well as the general public, so
14 that's a smattering of pretty much anyone in the U.S.
15 can go there.
16 **Q** Would some of the trade shows identified here
17 include general members of the public?
18 **A** I would say about half of these just kind of
19 looking at this list would be open to the general
20 public.
21 **Q** Do you know whether the audible chirp tone
22 was demonstrated at any of these trade shows?
23 **A** It's demonstrated at almost all of them.
24 **Q** How do you know that?

1 **A** Because that's the key differentiator for our
2 product relative to all the other handsets and
3 equipment in the market, so one of the things that we
4 wanted to show people was the fact that they could do
5 business instantaneously through the use of the iDEN
6 technology, and you know, the chirp is an integral
7 part of that message, so people -- you know, we would
8 demonstrate the product at a show that's not listed
9 here, which I think it took place in 1999, we
10 actually were demonstrating the fact that you could
11 talk from New Orleans to Key West and New Orleans to
12 California, so we had video feeds set up at the
13 different locations, and people could press the
14 button and talk from the convention center in New
15 Orleans to someone in Key West or somebody in LA, and
16 the chirp was integral to that experience.
17 **Q** Do you know whether the chirp was actually
18 heard during that experience?
19 **A** It was, it was. Almost all of these shows
20 feature live handsets, so you know, people want --
21 you know, you encourage people to use them so that
22 the chirp would have been heard at pretty much all of
23 these.
24 **Q** Would you say that this is an incomplete list

1 and that sort of thing.
2 **Q** I believe you named two carriers in the U.S.
3 Are you familiar with the business
4 relationship between Motorola and its carrier,
5 Nextel?
6 **A** Yes.
7 **Q** Does Motorola sell products to Nextel?
8 **A** Yes, we do.
9 **Q** Which products does Motorola sell to Nextel?
10 **A** We sell iDEN handsets, iDEN infrastructure.
11 That's pretty much it.
12 **Q** Do you know what Nextel then does with those
13 products?
14 **A** Nextel then resells the products to end
15 users, and Nextel deploys our infrastructure
16 equipment into their network.
17 **Q** What do you mean by "our infrastructure"?
18 **A** We sell on bay stations, switching complexes.
19 They purchase that, and then they put it into larger
20 network clusters. They put them into buildings and
21 hook them up to antennas so that they can make a
22 network functional.
23 **Q** Are you familiar with the business
24 relationship between Motorola and its carrier,

1 **Q** Can you tell us what this is?
2 **A** This is a photocopy of the box of an i880s
3 phone that was being sold to SouthernLINC.
4 **Q** Are you familiar with this packaging?
5 **A** Yes.
6 **Q** How are you familiar with it?
7 **A** Again, my team put most of this together.
8 **Q** In the ordinary course of its business
9 activities?
10 **A** Yes.
11 **Q** I ask you to turn to the second page, page
12 434?
13 **A** Sure.
14 **Q** Do you see the first bullet point which
15 identifies instant link SM two-way radio?
16 **A** Uh-huh.
17 **Q** Are you familiar with the term "instant
18 link"?
19 **A** Yes.
20 **Q** What does that relate to?
21 **A** Instant link is SouthernLINC's terminology
22 for direct connect, which is the Nextel terminology
23 for private call.
24 **Q** Can you clarify that a little bit?

1 **A** So private call is a trunking term that
2 Motorola came up with which talks about making
3 essentially a call on a digital two-way radio, so you
4 press the button, you get a talk-permit tone and you
5 make the call.
6 Nextel came up with a different name.
7 Rather than use private call, they came up with
8 direct connect, and SouthernLINC came up with instant
9 link, and if you go to the other carriers around the
10 world, they have their own terminology for that
11 capability.
12 **Q** Does instant link and direct connect describe
13 the same service?
14 **A** Yes.
15 **Q** And how does that service relate to the
16 audible chirp tone?
17 **A** Well, it's different names, but the audible
18 tone is consistent throughout all of the -- despite
19 the service name differences, the audible tone
20 remains the same, and again, that's not only in
21 SouthernLINC's case and Nextel's case, but it's the
22 same for all of the iDEN carriers.
23 **Q** Now, when you say "the audible tone remains
24 the same", which audible tone are you referring to?

1 **A** The chirp, the Motorola chirp.
2 **Q** And this product depicted in the SouthernLINC
3 exhibit, is that an iDEN handset?
4 **A** Yes. It's an iDEN handset that was designed
5 in Japan.
6 **Q** Does this handset emit the audible chirp?
7 **A** Yes, it does, and if you notice on page two,
8 it still has that same three-quarter profile shot
9 with the push-to-talk and the dimples on it and so
10 on. Again, we were trying to be real consistent with
11 the use of the visual as well as the audio branding
12 across the line.
13 **Q** Has Motorola's use of the chirp tone been
14 audibly consistent since its inception?
15 **A** Yes.
16 **Q** How do you know that?
17 **A** Since I've been associated with the iDEN
18 product, I know that the use has been consistent.
19 Prior to that -- I mean, most of the people that came
20 to this technology came to this technology from
21 trunking and two-way radio, so it's been an evolution
22 of that technology that created MIRS and then
23 ultimately led to iDEN, so that's kind of my basis.
24 **Q** And iDEN related to the use of the chirp

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

NEXTEL COMMUNICATIONS, INC., Opposer, v. MOTOROLA, INC., Applicant.	Opp. No.: 91/164,353 App. No.: 78/235,365 Mark: Sensory Mark (1800 Hz Tone)

I, PETER ALOUMANIS, being first duly sworn, on oath say that I am the deponent in the aforesaid testimonial deposition taken on February 20, 2008, that I have read the foregoing transcript of the testimonial deposition, consisting of pages 1 to 112 inclusive, and affix my signature to same.

Date: 05-6-08

By: _____
Peter Aloumanis

State of: Florida)
) ss:
County of: Broward)

Subscribed and sworn to before me
this 06th day of May, 2008.

_____
(Notary Public)

My commission expires: 4-30-2011

MARIA M. ALBA
Comm# DD0651978
Expires 4/30/2011
Florida Notary Assn., Inc

EXHIBIT 4
TO THE DECLARATION
OF ALISSA HODGSON

1 HIGHLY CONFIDENTIAL - M. SCHWEITZER
2 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
3 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
4 ----------x
NEXTEL COMMUNICATIONS, INC.,)
5)
Opposer,)
6)Opp. No. 91/164,353
v.)App. No. 78/235,365
7)Pot. Mark SENSORY MARK
MOTOROLA, INC.,) (1800 Hz Tone)
8)
Applicant.)
9 ----------x
10
11
12 HIGHLY CONFIDENTIAL
13 DEPOSITION OF MARK ANDREW SCHWEITZER
14 New York, New York
15 Friday, November 30, 2007
16
17
18
19
20
21
22 Reported by:
23 KATHY S. KLEPFER, RMR, RPR, CRR, CLR
24 JOB NO. 14336
25

ORIGINAL

that requires you to distinguish between Nextel Communications and Sprint Nextel, I would ask you to make that clear in your answer or to ask me to clarify a question, if necessary.

A. Okay.

Q. You mentioned direct connect service a moment ago. What is direct connect service?

A. Direct connect is a digital walkie-talkie capability that operates across the iDEN network when two or more devices, working in combination with that network, address each other either through an alias in the phone that specifies the identity of the other individual or with using a number directly addressing another number.

Two parties. It's sort of a command-and-control style communication in the sense that one person initiates, the other person responds. The really attractive thing from a marketing standpoint is those connections happen in less than a second, and it's sort of the most direct form of instant communications in the sense of never through voice mail, never through a receptionist, never to a home

answering machine.

So the direct connect is literally connecting directly instantly with one-button access.

Q. Does Nextel also sell products in connection with providing the services that you've talked about?

A. Yes. The service is enabled with devices, so handsets and/or Blackberry devices.

Q. Who manufactures the devices that are capable of operating or using Nextel services?

A. As of now, and certainly over the period I was with the company, there were only two companies capable of that. One was Motorola and the other was RIM in the Blackberry service, but very much predominantly, Motorola in terms of providing the devices that enabled the network service that Nextel deployed.

Q. And what are the products that RIM sells?

A. We began -- actually, I'm not clear on the chronology, but somewhere around 2001-2002, and I know I have deposition testimony on this, I'm just not positive on the timeframe, but

wireless handsets typically emit. What is the purpose of those sounds?

A. The purpose generally sort of falls into two categories. One is very specific, functional. So, again, using the example of when a battery needs charging, has a different sound than a ring tone so that an end-user isn't confused that they're getting a call, and then taking action to recharge.

And again, there are also sounds -- most people configure their phone options such that their SMS or text messages emit a different sound than their phone calls. Some people might choose to activate silent, but generally, it falls in the two functions: Either notification of a communication or something associated with a device.

What manufacturers and carriers look for increasingly over time is the ability for end-users to personalize the device to sort of reduce the likelihood that they will want to change.

Q. You mentioned a moment ago that there's a sound associated with Nextel's direct

connect service; is that right?

A. Yes.

Q. And what's that sound?

A. We commonly refer to it as the chirp. At various times end-users might call it "the beep" or "Nextel me," you know, became something of a verb that related to people using the direct connect capability to have the chirp alert them.

Q. Did there come a time when Nextel decided to use the chirp sound in marketing and advertising its services?

A. When I joined the company in April of '97, we were already using it in television and advertising. So I understand possibly it was used before that, but my experience would begin in April of '97 where we were using it.

Obviously couldn't use it effectively in direct mail, though we tried, and other forms of media, but certainly television and radio we were making use of the sound.

Q. Why did Nextel adopt the chirp for marketing and advertising its services?

A. Nextel from its earliest marketing

sought to distinguish itself as the ultimate productivity partner, so the ability to get things done instantly, and because direct connect was the most efficient form of wireless communication in terms of instant communications, the chirp was synonymous with direct connect and, as a marketing reality, nobody else could provide that functionality, therefore, nobody else who used that sound would ever be able to associate it with that marketing capability.

So we believed it, in a world where we were being out-spent, you know, [redacted] by other wireless carriers in marketing, that we needed a personality that associated us with, you know, a unique, different solution to other wireless carriers, and the chirp was synonymous with that.

Q. Has Nextel's use of the chirp in marketing and advertising continued?

A. It has. Pre-merger, I'll kind of use the example of the Done Campaign, where we went through an advertising review. We developed a new tag line, which was "Nextel Done," and there

was a signature element which was a finish line that punctuated all audio and visual advertising and the finish line would come down and connected to the chirp.

Q. What was the finish line?

A. It's a vertical bar that, you know, it would read "Nextel Done," the bar would come down and the chirp would go in connection with that. And again, it was a way of punctuating that Nextel meant instant, you got things done with Nextel, and the chirp was associated with that.

We were also kind of trying to take advantage of this natural phenomena which, because direct connect conversations are less than [redacted], in a given year -- I'll take the year 2003 as an example -- Nextel would have had [redacted] of its conversations on the network were direct connect conversations and only [redacted] were cellular conversations.

The length of cellular calls was a lot longer, but whether you were a Nextel user or not, it became kind of inescapable to, at your place of work, at sporting events, to have heard

that sound, and so we sought to take advantage of that sort of natural proliferation of sound and, again, the linkage to the core of our brand, which was getting things done in instant communications. So we wanted to connect it very specifically to the Nextel brand.

Q. Is Nextel running advertising today using the chirp?

MR. WILLIAMS: Objection. Lacks foundation.

A. I'll now refer to Sprint Nextel as the post-merger entity.

In April of this year, I was part of -- or, I led the team that selected a new advertising agency for Sprint Nextel, and in that period, we briefed-in advertising requirements for that agency to develop Nextel product advertising within the Sprint Nextel brand family.

And as a consumer, I can see that over the summer those ads were produced and are running today both in direct-connect-specific ways and using the chirp associated with speed in some very specific Nextel Cup Nascar ads.

1 HIGHLY CONFIDENTIAL - M. SCHWEITZER
2 Mr. Schweitzer.
3 MR. WILLIAMS: I have to go on cross
4 to address something in that last answer.
5 This is again Applicant Motorola back on
6 cross.
7 EXAMINATION BY
8 MR. WILLIAMS:
9 Q. There have been Nextel ads that
10 include both an audible chirp and a Motorola
11 mention, correct?
12 A. Yes.
13 MR. WILLIAMS: Nothing further.
14 THE WITNESS: Okay.
15 MR. JACOBS: We're all done, too.
16 (Time Noted: 1:30 P.M.)
17 oOo
18
19
20
MARK ANDREW SCHWEITZER
21
22 Subscribed and sworn to
before me this day
23 of 2007.
24
25

EXHIBIT 5
TO THE DECLARATION
OF ALISSA HODGSON

ESTTA Tracking number: **ESTTA415634**
Filing date: **06/21/2011**

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

Name	Southern Communications Services, Inc.
Granted to Date of previous extension	06/22/2011
Address	5555 Glenridge ConnectorSuite 500 Atlanta, GA 30342 UNITED STATES

Correspondence information	Michael D. Hobbs, Jr. Troutman Sanders LLP Suite 5200 600 Peachtree St. Atlanta, GA 30308 UNITED STATES trademarks@troutmansanders.com Phone:404.885.3330

Applicant Information

Application No	78575442	Publication date	02/22/2011
Opposition Filing Date	06/21/2011	Opposition Period Ends	06/22/2011
Applicant	S-N MERGER CORP. 2001 EDMUND HALLEY DR. RESTON, VA 20191 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. First Use: 1997/05/16 First Use In Commerce: 1997/05/16
All goods and services in the class are opposed, namely: 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 services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
Other	Mark has not acquired secondary meaning pursuant to Section 2(f), 15 U.S.C. 1052(f) Mark does not function as a trademark pursuant to Sections 1, 2 and 45, 15 U.S.C. 1051, 1052 and 1116.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	the sound 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		
Goods/Services	wireless communications services		

Attachments	Chirp Notice of Opposition.pdf (6 pages)(212042 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael D. Hobbs, Jr./
Name	Michael D. Hobbs, Jr.
Date	06/21/2011

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

SOUTHERN COMMUNICATIONS SEVICES, INC.	)	
Opposer,	)	Application Serial No. 78/575442
v.	)	Mark: (Sensory Mark Only)
S-N MERGER CORP.	)	Opposition No. _____
Applicant.	)	

NOTICE OF OPPOSITION

Opposer Southern Communications Services, Inc. ("Opposer"), for its Notice of Opposition against Application Serial No. 78/575442 for the sensory mark described as "the sound 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" (the "Chirp"), believes that it will be damaged by and thus opposes registration of the mark that is the subject matter of Application Serial No. 78/575442. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a Delaware corporation with a principal place of business located at 5555 Glenridge Connector, Suite 500, Atlanta, Georgia 30342.

2. Applicant is a Delaware corporation with a correspondence address of 2001 Edmund Halley Dr., Reston, VA 20191.

3. Application No. 78/575442 was published in the U.S. Patent and Trademark Office ("PTO") *Official Gazette* on February 22, 2011.

4. Opposer has timely extended time to oppose the application through and including June 22, 2011. Therefore, this Notice of Opposition is timely filed.

5. Opposer, d/b/a SouthernLINC Wireless, is a wireless communications network backed by the strength and reliability of Southern Company - the parent company of four electric utilities in the Southeast: Alabama Power, Georgia Power, Gulf Power and Mississippi Power, which are also SouthernLINC Wireless customers. Opposer provides reliable wireless communications service, including mobile phones, to a wide range of businesses and consumers within its 127,000 square-mile coverage area that includes Alabama, Georgia, southeastern Mississippi, and the Florida Panhandle.

6. One of the important features of Opposer's products and services is "push to talk" ("PTT") 2-way radio communications that allows customers to communicate quickly and effectively without using e-mail or cell calls. When used, the PTT service causes the Opposer's handsets to emit a chirping sound (the "Chirping Mark") that is virtually identical to the Chirp.

7. Opposer has continuously used the Chirping Mark in almost all of its handsets and to identify its PTT wireless communications services since at least as early as 1996.

8. In addition to using the Chirping Mark to alert customers of the PTT wireless communications, continuously since 1996, Opposer has promoted the Chirping Mark in advertisements and promotional materials for its wireless communications services as a source identifier for the Opposer's services.

9. By virtue of widespread sales and extensive advertising and promotion of the services identified by the Chirping Mark, the Chirping Mark has become well known by the general public and in the relevant industries, is recognized and relied upon as identifying Opposer's services and as distinguishing them from the services of others, and has come to

represent and symbolize extremely valuable goodwill belonging exclusively to Opposer.

10. By virtue of purchaser's, prospective purchaser's and listener's recognition and association of the Chirping Mark with the wireless communications services of the Opposer, the Opposer has acquired trademark rights in the Chirping Mark for its wireless communications services.

11. Applicant is the owner of Application Serial No. 78/575442 for the Chirp, filed with the PTO on February 25, 2005.

12. Applicant declared under penalty of perjury that it had used the Chirp as of May 16, 1997 for all of the following services: "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 services" ("Applicant's Mark").

13. Opposer has continuously and exclusively used the Chirping Mark in connection with wireless communications services originating from Opposer prior to Applicant's filing date in the PTO, and constructive and/or actual first use date, if any, in United States commerce for Applicant's Mark.

14. Opposer's rights in the Chirping Mark are superior to Applicant's rights in the Applicant's Mark.

15. The use and registration of Applicant's Mark is likely to cause confusion in the minds of the purchasing public and to cause the purchasing public to assume that the services identified by such mark are offered by Opposer or that such services originate with or are in some way connected to Opposer, which they are not, in violation of 15 U.S.C. §§ 1052(d) and 1125(a).

16. Applicant's Mark is functional for the underlying services and registration was properly refused by the United States Patent and Trademark Office pursuant to Section 2(e) (5) of the Lanham Act, 15 U.S.C. §1052(e) (5).

17. Conceding that the Applicant's Mark is functional in that it serves a utilitarian purpose, the Applicant sought registration for the Applicant's Mark pursuant to Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f).

18. Because of Opposer's trademark rights and use of the Chirping Mark, the Applicant's use of the Chirp has not been exclusive and it has therefore not acquired secondary meaning in the Applicant's Mark pursuant to Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f), and registration should be refused.

19. Even if the Chirping Mark is determined to have not been used as a mark or to have not acquired secondary meaning, the Applicant's use of the Chirp has not been substantially

exclusive pursuant to the meaning of Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f), and registration of the Applicant's Mark should be refused.

20. The Chirp operates as a functional, operational alert of 2-way radio calls for the Applicant's customers. Accordingly, it fails to function as a trademark pursuant to Sections 1, 2 and 45 of the Lanham Ac,t and registration of the Applicant's Mark should be refused. 15 U.S.C. § 1051; 15 U.S.C. § 1052; 15 U.S.C. § 1116.

21. Use and registration of Applicant's Mark will be injurious to Opposer in violation of Section 13 of the Lanham Act, 15 U.S.C. § 1063(a).

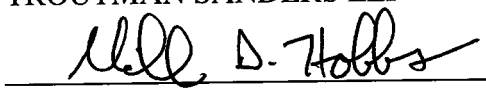
22. Opposer has paid the requisite fees to the United States Patent and Trademark Office contemporaneous with the filing of this opposition action. If such fees are deficient or any other fees are required, the USPTO is authorized to charge counsel's deposit account no. 20-1507 for the required amount.

WHEREFORE, Opposer believes that it will be damaged by the registration of the Applicant's Mark and prays that said Application Serial No. 78/575442 be refused, and that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

This 21st day of June, 2011.

Respectfully submitted,

TROUTMAN SANDERS LLP



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

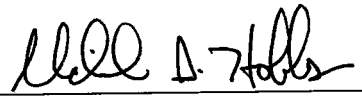
SOUTHERN COMMUNICATIONS SEVICES, INC.	)	
Opposer,	)	Application Serial No. 78/575442
v.	)	Mark: (Sensory Mark Only)
S-N MERGER CORP.	)	Opposition No. _____
Applicant.	)	

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Notice of Opposition was sent by first-class mail, postage prepaid to the Applicant, as follows:

John I. Stewart, Jr., Esq.
Crowell & Moring LLP
1001 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

This 21st day of June, 2011.



Michael D. Hobbs, Jr.