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**IN THE UNITED STATE PATENT AND TRADEMARK OFFICE**
**ASSISTANT COMMISSIONER FOR TRADEMARKS**

| | |
|---|---|
| In Re Application of: | Sierra Tel Communications Group, Inc. |
| Mark: | SIERRA TEL NETWORKS |
| Serial No: | 78/057,034 |
| Filed: | April 5, 2001 |

Assistant Commissioner for Trademark
Attn: Jill C. Alt, Esq.
Law Office 114
2900 Crystal Drive
Arlington, VA 22202-3514

**REQUEST FOR AMENDMENT TO U.S. TRADEMARK APPLICATION**

Dear Ms. Alt:

Enclosed please find Applicant's Request For Amendment To U.S. Trademark Application.

Respectfully submitted,

COOPER, WHITE & COOPER LLP

By: _____

Todd E. Bolinger
Legal Assistant
201 California Street, 17th Floor
San Francisco, California 94111
(415) 433-1900

01-02-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #64

Dated: December 30, 2003

SF:486368
7022-32522

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| In re Application of: | Sierra Tel Communications Group |
| Mark: | SIERRA TEL NETWORKS |
| Serial No: | 78/057,034 |
| Classes: | 38, 42 |
| Filed: | April 5, 2001 |
| Trademark Attorney: | Jill C. Alt |
| Law Office: | 114 |

ORIGINAL

Assistant Commissioner for Trademark
Attn: Jill C. Alt, Esq.
Law Office 114
2900 Crystal Drive
Arlington, VA 22202-3514

**REQUEST FOR AMENDMENT TO U.S TRADEMARK APPLICATION**

Dear Ms. Alt:

Applicant Sierra Tel Communications Group, Inc. requests an amendment to the recitation of services as applied for in its application for the Mark "SIERRA TEL NETWORKS", Serial Number 78/057,034. The amendment reflects, in part, the basis of a recently executed Co-Existence Agreement by and between the potential Opposer to the Mark, Sierra Entertainment, Inc. ("Sierra") and Applicant Sierra Tel Communications Group, Inc. ("Sierra Tel"). Upon amendment of the application, Sierra has agreed to withdraw its opposition.

## A. Background

On February 4, 2003, the Mark "SIERRA TEL NETWORKS", Serial Number 78/057,034 was published for opposition. On March 18, 2003 an Extension of Time to Oppose this application was filed before the United States Trademark Trial and Appeal Board by Sierra. Furthermore, on October 2, 2003 Sierra filed two additional requests for extensions of time to oppose Sierra Tel trademark applications, "SIERRA TEL INTERNET", Serial Number 76/311,608 and "STI SIERRA TEL INTERNET" and Design, Serial Number 76/311,603. Applicant Sierra Tel negotiated a Trademark Co-Existence Agreement with Sierra, attached hereto as Exhibit "A", to resolve the disputes that Sierra maintained against these Sierra Tel trademark applications. Sierra has agreed to drop its pending oppositions to the referenced Sierra Tel Marks upon amendment of the applications.

## B. Request for Amendment

In conformance with the mutually agreed upon rights, privileges and responsibilities as set forth in the Trademark Co-existence Agreement, Applicant Sierra Tel requests that the following amendment be entered in its entirety as to the description of services applied for in International Class 38, within Trademark Application "SIERRA TEL NETWORKS", Serial Number 78/057,034:

> "Interactive video and data services, namely, video conferencing consultation, video teleconference network design and integration, video streaming via a local area network, video streaming via a global computer network, video broadcasting and transmission services, integration of voice, data and video, but not for use for computer games, electronic games and interactive games; computer game software or entertainment and amusements associated or connected with computer games, electronic

games, interactive games and/or on-line interactive gaming software provided by means of a global computer network or electronic games played on the Internet."

Additionally, Applicant requests that the following amendment be adopted in its entirety as to the description of services applied for within International Class 42 for the Trademark Application "SIERRA TEL NETWORKS", Serial Number 78/057,034:

"Integration of computer systems and networks, namely, hardware and software system integration, but not for use for computer games, electronic games and interactive games; computer game software or entertainment and amusements associated or connected with computer games, electronic games, interactive games and/or on-line interactive gaming software provided by means of a global computer network or electronic games played on the Internet."

## CONCLUSION

For the foregoing reasons, Applicant respectfully requests these amendments to the description of services as set forth above within the Application for "SIERRA TEL NETWORKS", Serial Number 78/057,034, in International Classes 38 and 42. The undersigned welcomes a telephone interview with the Trademark Attorney about any of the issues discussed above or any other

matters that can be handled by telephone to expedite the handling of this application.

Respectfully submitted,

DATED: December 29, 2003 COOPER, WHITE & COOPER, LLP

By: _____

Walter W. Hansell
Cyrus P. Wadia
Attorneys for Applicant
201 California Street, 17th Floor
San Francisco, California 94111
(415) 433-1900

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Assistant Commissioner for Trademarks, Attn: Jill C. Alt, Esq., Law Office 114, 2900 Crystal Drive, Arlington, VA 22202-3514, on December 30, 2003.

Dated: December 30, 2003 By: _____
Todd Bolinger

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SF:484600.1/7022-32506

# TRADEMARK CO-EXISTENCE AGREEMENT

**THIS AGREEMENT** ("Agreement") is by and between Sierra Entertainment, Inc., a Delaware corporation with a place of business at 3060 139th Ave SE #500, Bellevue, WA 98005 ("Sierra"), and Sierra Tel Communications Group, a California Corporation with a place of business at Oakhurst, California, 93644 ("Sierra Tel").

**WHEREAS**, Sierra uses and is the owner of numerous trademarks incorporating the word SIERRA (the "SIERRA Marks") which it uses and has used since at least as early as 1984 in association with a wide variety of goods and services in the computer software and entertainment fields, and owns trademark registrations and applications for the same in several countries throughout the world, including the United States, and has developed substantial goodwill and name recognition in the SIERRA Marks;

**WHEREAS**, Sierra Tel uses and is the owner of numerous trademarks incorporating the words SIERRA TEL (the "SIERRA TEL Marks") which it uses and has used since at least as early as 1996 in association with a wide variety of goods and services in the field of telecommunications and computer software related thereto, and owns trademark registrations and applications for the same in the United States, and has developed substantial goodwill and name recognition in the SIERRA TEL Marks;

**WHEREAS**, Sierra Tel uses the trademark SIERRA TEL NETWORKS (the "SIERRA TEL NETWORKS Mark") in association with interactive video and data services, namely, video conferencing consultation, video teleconference network design and integration, video streaming via a local area network, video streaming via a global computer network, video broadcasting and transmission services, and integration of voice, data, and video (collectively "SIERRA TEL

NETWORKS Goods and Services") and has a trademark application pending in the United States for use in association with the same (Serial Number 78/057,034) (the "SIERRA TEL NETWORKS Application");

WHEREAS, Sierra Tel uses the trademark SIERRA TEL INTERNET (the "SIERRA TEL INTERNET Mark") in association with computer software for use in telephone billing, directory assistance, file transfer utilities, service order processing, and automated switch service provisioning; telephones; cellular telephones; radio pagers; telecommunication equipment, namely, ISDN terminal adaptors, HDSL adaptors, routers, access servers, telecommunication switches, hubs, and protocol converters; two-way radios; telephone answering machines; and telephone apparatus, namely intercoms (Class 9); Telephone directory information; telephone operator services (Class 35); Telecommunications services, namely, audio teleconferencing, cellular telephone services, electronic mail services, electronic transmission of data and documents via computer terminals, electronic voice messaging, namely, the recording, storage, and subsequent transmission of voice messages by telephone, facsimile transmission, ISDN services, gateway services, paging services, PBX dialing services, PABX dialing services, rental of telecommunication equipment, telephone communication services, video teleconferencing, videotext services, wireless digital messaging services, wireless facsimile mail services, and providing telecommunications connections to a global computer network (Class 38); Computer education training services (Class 41); and Computer software design for others; technical support services, namely, troubleshooting of computer software problems by telephone (Class 42) (collectively "SIERRA TEL INTERNET Goods and Services") and has trademark applications pending in the United States for use in association with the same (Serial Numbers 76/311,603 and 76/311,608) (the "SIERRA TEL INTERNET Applications");

**WHEREAS**, Sierra Tel uses the trademark SIERRA TEL DIGITAL SOLUTIONS (the "SIERRA TEL DIGITAL SOLUTIONS Mark") in association with telephones; cellular telephones; radio pagers; telecommunication equipment, namely, ISDN terminal adaptors, HDSL adaptors, routers, access servers, telecommunication switches, hubs, and protocol converters; two-way radios; telephone answering machines; and telephone apparatus, namely intercoms (Class 9); Maintenance, repair and installation of computer networks (Class 37); Telecommunications services, namely, audio teleconferencing, cellular telephone services, electronic mail services, electronic transmission of data and documents via computer terminals, electronic voice messaging, namely, the recording, storage, and subsequent transmission of voice messages by telephone, facsimile transmission, ISDN services, gateway services, paging services, PBX dialing services, PABX dialing services, rental of telecommunication equipment, telephone communication services, video teleconferencing, videotext services, wireless digital messaging services, wireless facsimile mail services, and providing telecommunications connections to a global computer network (Class 38); and Computer education training services (Class 41) (collectively "SIERRA TEL DIGITAL SOLUTIONS Goods and Services") and has a trademark application pending in the United States for use in association with the same (Serial Number 76/311,609) (the "SIERRA TEL NETWORKS Application");

**WHEREAS**, a dispute has arisen between the parties with respect to Sierra Tel's' right to use and register the SIERRA TEL NETWORKS, SIERRA TEL INTERNET, and SIERRA TEL DIGITAL SOLUTIONS Marks, and the parties wish to resolve this dispute amicably;

**NOW, THEREFORE**, in consideration of the mutual covenants and obligations expressed herein and for good and valuable consideration, the sufficiency of which is hereby acknowledged, the parties hereto agree as follows:

1. The parties acknowledge and agree that, as between the two of them, Sierra has senior trademark rights with respect to the goods and services for which the SIERRA Marks were applied for, and nothing in this Agreement is intended to restrict such rights. Nevertheless, Sierra hereby agrees that Sierra Tel shall have the right to use the SIERRA TEL NETWORKS, SIERRA TEL INTERNET, and SIERRA TEL DIGITAL SOLUTIONS Marks in association with SIERRA TEL NETWORKS Goods and Services, SIERRA TEL INTERNET Goods and Services, and SIERRA TEL DIGITAL SOLUTIONS Goods and Services, respectively, provided: (i) that use of the SIERRA TEL Marks, including but not limited to SIERRA TEL NETWORKS, SIERRA TEL INTERNET, and SIERRA TEL DIGITAL SOLUTIONS, in any and all promotional, marketing or advertising materials, including on the Internet, shall be as composite marks such as "SIERRA TEL NETWORKS", "SIERRA TEL INTERNET", or "SIERRA TEL DIGITAL SOLUTIONS", and that the words "Tel Networks", "Tel Internet", "Tel Digital Solutions", or other composite component shall always be readable and shall be immediately proximate to and the same size, color, and prominence as the term "Sierra"; and (ii) Sierra Tel shall not use a design, picture or depiction of a mountain or mountain range in association with the SIERRA TEL Marks or any SIERRA TEL goods or services except the mountain range designs as indicated in Exhibit "A" hereto, or similar variations thereof. Sierra Tel hereby agrees to the restriction on use of the SIERRA TEL Marks as described above.

2. Furthermore, Sierra Tel shall amend its application for the SIERRA TEL NETWORKS Mark to specify that the goods for which the mark is to be used is not intended for computer games, electronic games and interactive games; computer game software or entertainment and amusements associated or connected with computer games, electronic games,

interactive games and/or on-line interactive gaming software provided by means of a global computer network or electronic games played on the Internet.

3. Furthermore, Sierra Tel shall amend its applications for SIERRA TEL INTERNET in International Classes 41 and 42 to specify that the services for which the mark is to be used is not intended for computer games, electronic games and interactive games; computer game software or entertainment and amusements associated or connected with computer games, electronic games, interactive games and/or on-line interactive gaming software provided by means of a global computer network or electronic games played on the Internet.

4. Provided that Sierra Tel uses the SIERRA TEL Marks as outlined above, Sierra hereby consents to, waives any related claim against, and covenants not to sue or otherwise object to, Sierra Tel's use or registration of the SIERRA TEL NETWORKS, SIERRA TEL INTERNET, and SIERRA TEL DIGITAL SOLUTIONS Marks in connection with SIERRA TEL NETWORKS', SIERRA TEL INTERNET's, and SIERRA TEL DIGITAL SOLUTIONS' Goods and Services.

5. Sierra Tel shall not apply to register or register, in any country of the world, the SIERRA TEL Marks or any other mark containing "SIERRA" as a trademark, service mark, domain name, trade name or otherwise, for use in association with computer games, electronic games, interactive games, computer game software including but not limited to entertainment and amusements associated or connected with computer games, and/or on-line interactive gaming software provided by means of a global computer network or any of the aforementioned played via the Internet..

6. Each party agrees that it shall take no action, legal or otherwise, to challenge or otherwise interfere with the use of the other parties' respective mark, so long as such use is

otherwise in accordance with the terms of this Agreement. Sierra Tel hereby consents to, waives any claim against, and covenants not to sue or otherwise object to Sierra's right to use and register the SIERRA Mark. Sierra hereby consents to, waives any claim against, and covenants not to sue or otherwise object to Sierra Tel's right to use and register the SIERRA TEL NETWORKS, SIERA TEL INTERNET, and SIERRA TEL DIGITAL SOLUTIONS Marks, so long as such use or registration is in accordance with the terms of this Agreement.

7. Each party agrees to take all affirmative steps to provide consents to registration to the other to effectuate the registration of the other party's marks as permitted herein.

8. The parties agree to consult and cooperate in good faith to resolve or prevent any future conditions or developments that suggest that there exists any likelihood of confusion between the SIERRA Marks and SIERRA TEL Marks.

9. This Agreement shall be binding upon and inure to the benefit of the parties hereto, their successors, assigns, licensees, parents, affiliates and subsidiaries, including their officers, agents and employees.

10. This Agreement shall be of worldwide effect.

11. This Agreement shall be governed by the laws of the State of California, without regard to its conflict of laws rules. All parties shall submit and not object to personal jurisdiction and venue in the federal or state courts located in the Central District of California in connection with any claims arising out of this Agreement.

12. This Agreement sets forth the entire agreement between the parties. No agreement changing, amending, extending, superseding, rescinding, terminating, or discharging this Agreement or any provisions hereof shall be valid unless by a signed writing. No waiver or any breach hereof shall be construed to be a continuing waiver or consent to any subsequent

breach hereof. If any provision of this Agreement is invalid or unenforceable, it shall not effect the validity or enforceability of the other provisions.

IN WITNESS WHEREOF, the parties hereto execute this document on the dates written below.

SIERRA ENTERTAINMENT, INC.

By: Peter Della Penna
Its: V.P.
Date: 12/17/03

SIERRA TEL COMMUNICATIONS GROUP

By: Harley H Baker
Its: President
Date: November 21, 2003

482413.1/7238-32500

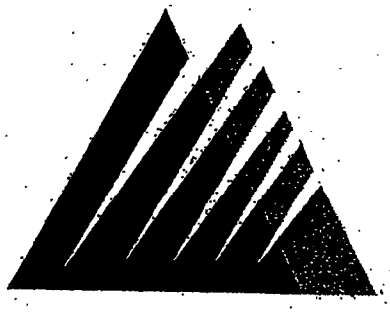

EXHIBIT A