

ESTTA Tracking number: **ESTTA322927**

Filing date: **12/18/2009**

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

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| Name | Motorola, Inc. |
| Granted to Date of previous extension | 01/17/2010 |
| Address | 1303 East Algonquin Road Schaumburg, IL 60196 UNITED STATES |

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| Attorney information | Kristin Achterhof, Breighanne Eggert Katten Muchin Rosenman LLP 525 West Monroe Street Chicago, IL 60661 UNITED STATES kristin.achterhof@kattenlaw.com, breighanne.eggert@kattenlaw.com, deborah.wing@kattenlaw.com, Avaya.USA.AURA.OppsCans.lawdocs@brandeis.corp.mot.com |
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Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 77695553 | Publication date | 07/21/2009 |
| Opposition Filing Date | 12/18/2009 | Opposition Period Ends | 01/17/2010 |
| Applicant | Avaya Inc. 211 Mount Airy Road Basking Ridge, NJ 07920 UNITED STATES | | |

Goods/Services Affected by Opposition

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| <p>Class 009. All goods and services in the class are opposed, namely: computer software platform for providing users with uniform access to communication applications; software for creating, delivering, deploying, integrating and managing service, applications and features; software for managing, orchestrating and sequencing sessions, calls or interactions between users, devices or applications; software for managing, deploying, configuring and initializing real time and non real time multimedia communications software; software for managing profiles of users, determining specific access to applications and capabilities, security and control; software for collecting, aggregating and delivering multimodal, multimedia presence and contextual information from multiple sources; software which provides unified communication capabilities, voice, video data, conferencing, messaging, collaboration; software for consolidating the number of physical servers required within a corporate network, and delivering applications in a virtualized manner</p> |
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Grounds for Opposition

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| False suggestion of a connection | Trademark Act section 2(a) |
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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Marks Cited by Opposer as Basis for Opposition

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| U.S. Registration No. | 2139992 | Application Date | 11/13/1995 |
| Registration Date | 03/03/1998 | Foreign Priority Date | NONE |
| Word Mark | AURA | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 1995/07/00 First Use In Commerce: 1995/07/00 telecommunications devices, namely, portable telephones, wireless telephone headsets, wireless telephone handsets, wireless headphones [and wireless pagers]; and electronic circuits, namely, electronic circuits for portable telephones, wireless headsets, wireless handsets, wireless headphones [and wireless pagers] | | |

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| U.S. Registration No. | 2183229 | Application Date | 11/13/1995 |
| Registration Date | 08/25/1998 | Foreign Priority Date | NONE |
| Word Mark | AURA | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 1995/07/00 First Use In Commerce: 1995/07/00 telecommunications devices, namely, portable telephones, wireless telephone headsets, wireless telephone handsets, wireless headphones [and wireless pagers;] and electronic circuits, namely, electronic circuits for portable telephones, wireless telephone headsets, wireless telephone handsets, wireless headphones [and wireless pagers] | | |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3071318 | Application Date | 02/21/2001 |
| Registration Date | 03/21/2006 | Foreign Priority Date | NONE |
| Word Mark | AURALINK | | |

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| Design Mark | <h1>AURALINK</h1> |
| Description of Mark | NONE |
| Goods/Services | <p>Class 009. First use: First Use: 2004/07/14 First Use In Commerce: 2004/07/14</p> <p>Communication devices, namely, telephone accessories, namely, headsets, earphones, telephone speakers, telephone microphones, and data transfer devices and controllers, namely, electronic circuit boards that facilitate and control the transfer of data information; Computers, radios, headphones; Wireless communication devices, namely, personal digital assistants and mobile phones; Telematic devices, namely, wireless headsets and wireless electronic equipment, namely, electronic circuits that support a logical connection including a wireless link, all designed for use in automobiles, buses, planes, trains and other transportation vehicles; Electronic devices, namely, accessories that communicate with computers, namely, electronic circuit boards and microchips, joysticks, headsets, microphones, printers, portable computers, personal digital assistants; Electronic circuit boards coupled to transducers that maintain a wireless communication link regardless of orientation; Electronic circuitry that modulates a digital or analog signal onto a carrier frequency to transmit and receive information; transceivers, and electronic circuit boards that transmit and receive via an electromagnetic field; Security systems, namely, electronic circuits that communicate information for controlling or monitoring the access to physical or electronic locations; Remote controllers, namely, electronic circuit boards that wirelessly communicate command and control information; Audio headsets, MP3/music players, stereo headsets and game controllers; and Electronic circuits, namely, integrated circuits, microchips, semiconductors, semiconductor chips, and semiconductor devices for transmission of voice, data or audio information</p> |

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| Attachments | <p>75018046#TMSN.gif (1 page)(bytes) 76213281#TMSN.gif (1 page)(bytes) Notice of Opposition AVAYA AURA.pdf (7 pages)(22977 bytes)</p> |
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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.

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| Signature | /s/ |
| Name | Breighanne Eggert |
| Date | 12/18/2009 |

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

Applicant: Avaya Inc.
Serial No.: 77/695,553
Filing Date: March 20, 2009
Mark: AVAYA AURA

Published in the Official Gazette on July 21, 2009

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| MOTOROLA, INC., |) | |
| |) | |
| Opposer, |) | |
| |) | |
| vs. |) | Opposition No. _____ |
| |) | |
| AVAYA INC., |) | |
| |) | |
| Applicant. |) | |

NOTICE OF OPPOSITION

Opposer, Motorola, Inc. (“Opposer”), a Delaware corporation with its principal place of business located at 1303 East Algonquin Road, Schaumburg, Illinois 60196, believes that it would be damaged by registration of the trademark AVAYA AURA (“Applicant’s Mark”), depicted in U.S. Application Serial No. 77/695,553 (the “Application”), filed on March 20, 2009, by Avaya Inc. (the “Applicant”), a Delaware corporation whose address of record in the Application is 211 Mount Airy Road, Basking Ridge, New Jersey 07920. Accordingly, Opposer, by and through its attorneys, hereby opposes registration of Applicant’s Mark, and as grounds for opposition alleges as follows:

1. Since its inception in 1928, Opposer has been committed to innovation in the communications and electronics industries. Opposer is a well-known, worldwide innovator and provider of numerous goods and services including, but not limited to, electronic equipment and software comprising cellular telecommunications networks, voice and data communication

products and systems, wireless broadband systems, digital and Internet Protocol (IP) video and broadcast network interactive set-tops, end-to-end video delivery systems and an array of mobile communications devices featuring a variety of software and applications to enhance the user experience. Opposer, and its goods and services, have long been recognized by consumers as leaders in the telecommunications industry.

2. Opposer adopted and began using the trademark AURA, and other AURA-based trademarks, at least as early as July 1995 and July 2004, respectively. Such marks have been continuously used in the United States since those times, and, through extensive sales, advertising and promotion, Opposer's AURA and AURA-based trademarks have come to represent enormous goodwill now owned by Opposer.

3. Indeed, Opposer owns all rights, title and interest in and to trademark registrations for AURA that include U.S. Registration Nos. 2139992 (registered March 3, 1998) and 2183229 (registered August 25, 1998), for "telecommunications devices, namely, portable telephones, wireless telephone headsets, wireless telephone handsets, wireless headphones; and electronic circuits, namely, electronic circuits for portable telephones, wireless headsets, wireless handsets, wireless headphones."

4. Opposer also owns all rights, title and interest in and to U.S. Registration No. 3071318 (registered March 21, 2006) for AURALINK, for "[c]ommunication devices, namely, telephone accessories, namely, headsets, earphones, telephone speakers, telephone microphones, and data transfer devices and controllers, namely, electronic circuit boards that facilitate and control the transfer of data information; Computers, radios, headphones; Wireless communication devices, namely, personal digital assistants and mobile phones; Telematic devices, namely, wireless headsets and wireless electronic equipment, namely, electronic circuits

that support a logical connection including a wireless link, all designed for use in automobiles, buses, planes, trains and other transportation vehicles; Electronic devices, namely, accessories that communicate with computers, namely, electronic circuit boards and microchips, joysticks, headsets, microphones, printers, portable computers, personal digital assistants; Electronic circuit boards coupled to transducers that maintain a wireless communication link regardless of orientation; Electronic circuitry that modulates a digital or analog signal onto a carrier frequency to transmit and receive information; transceivers, and electronic circuit boards that transmit and receive via an electromagnetic field; Security systems, namely, electronic circuits that communicate information for controlling or monitoring the access to physical or electronic locations; Remote controllers, namely, electronic circuit boards that wirelessly communicate command and control information; Audio headsets, MP3/music players, stereo headsets and game controllers; and Electronic circuits, namely, integrated circuits, microchips, semiconductors, semiconductor chips, and semiconductor devices for transmission of voice, data or audio information.”

5. The goods and services of U.S. Registration Nos. 2139992, 2183229 and 3071318 are collectively referred to herein as “Opposer’s Goods and Services.”

6. Opposer’s foregoing registrations are valid, subsisting and in full force and effect, and are collectively referred to herein as the “AURA Marks.” Opposer has also acquired significant common law rights to the AURA Marks for use with Opposer’s Goods and Services.

7. On March 20, 2009, Applicant filed the Application to register Applicant’s Mark in the USPTO on an intent-to-use basis for “computer software platform for providing users with uniform access to communication applications; software for creating, delivering, deploying, integrating and managing service, applications and features; software for managing,

orchestrating and sequencing sessions, calls or interactions between users, devices or applications; software for managing, deploying, configuring and initializing real time and non real time multimedia communications software; software for managing profiles of users, determining specific access to applications and capabilities, security and control; software for collecting, aggregating and delivering multimodal, multimedia presence and contextual information from multiple sources; software which provides unified communication capabilities, voice, video data, conferencing, messaging, collaboration; software for consolidating the number of physical servers required within a corporate network, and delivering applications in a virtualized manner.” Based on publicly-available marketing materials, Applicant also uses, or plans to use, Applicant’s Mark on communications systems that provide voice, video, unified messaging, web applications, mobile clients and multimedia conferencing, and Applicant specifically and prominently advertises the compatibility of its AVAYA AURA goods and services with mobile communications devices. These goods and services are collectively referred to herein as “Applicant’s Goods and Services.”

8. Opposer’s rights in Opposer’s AURA Marks arose prior to any alleged rights of Applicant in Applicant’s Mark.

9. Applicant seeks to register Applicant’s Mark in connection with Applicant’s Goods and Services that are identical in part, and related in part, to the goods and services which Opposer offers under Opposer’s AURA Marks, and also that are well within the natural zone of expansion of Opposer’s AURA Marks, with “AURA” being an identical feature of the parties’ marks.

COUNT I

(Likelihood of Confusion)

10. Opposer realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 9.

11. Applicant's Mark so resembles Opposer's AURA Marks in sound, sight, meaning and commercial impression as to be likely, when applied to Applicant's Goods and Services, to cause confusion, mistake or deception by causing the public to believe that Applicant's Goods and Services originate from, or are otherwise sponsored or endorsed by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent damage to Opposer and the public within the meaning of 15 U.S.C. § 1063(a).

COUNT II

(False Suggestion of Connection)

12. Opposer realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 11.

13. Applicant's Mark so resembles Opposer's AURA Marks that when applied to Applicant's Goods and Services, Applicant's Mark is likely to falsely suggest a connection with Opposer and the goods and services offered by Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), with consequent damage to Opposer and the public within the meaning of 15 U.S.C. § 1063(a).

REQUEST FOR RELIEF

14. For the foregoing reasons, among others, Opposer believes that it would be damaged by the registration of Applicant's Mark. Accordingly, Opposer respectfully requests that this opposition be sustained and registration of Applicant's Mark be denied.

Dated: December 18, 2009

Respectfully submitted,

/s/ Kristin J. Achterhof
One of the attorneys for Opposer

Kristin J. Achterhof
Breighanne A. Eggert
Katten Muchin Rosenman LLP
525 West Monroe Street
Chicago, Illinois 60661
(312) 902-5200

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

Applicant: Avaya Inc.
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| AVAYA INC., |) | |
| |) | |
| Applicant. |) | |

CERTIFICATE OF SERVICE

I hereby certify that Motorola, Inc.'s Notice of Opposition for Serial No. 77/695,553 was served via U.S. mail on this 18th day of December 2009 upon Russell W. Binns, Jr., Avaya Inc., 211 Mount Airy Road, Basking Ridge, NJ 07920-2311.

/s/ Breighanne A. Eggert _____
Breighanne A. Eggert
Attorney for Opposer