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April 1, 2008

**Box TTAB**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Re: *LegalZoom.com, Inc. v. the Otis Conner Companies, Inc.*  
Mark: WE PUT THE LAW ON YOUR SIDE  
Serial No.: 77/287,415  
Attorney Docket No. 686099.0002

Dear Madam:

Enclosed please find the following for filing in the above-identified matter:

- Notice of Opposition;
- The Commissioner is authorized to withdraw the filing fee of \$300.00 from Deposit Account No. 01-0477. A duplicate of this cover letter is enclosed; and
- A return receipt acknowledgment postcard.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment in the fees indicated above to Deposit Account No. 01-0477.

Respectfully submitted,



Daniel Moffett

Enclosures

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

LegalZoom.com, Inc., § Serial No. 77/287,415  
§  
Opposer, §  
§ Mark: WE PUT THE LAW  
§ ON YOUR SIDE  
v. §  
§  
The Otis Conner Companies, Inc., § Opposition No. \_\_\_\_\_  
§  
Applicant. §

**TTAB**

**NOTICE OF OPPOSITION**

LegalZoom.com, Inc., a California corporation having an office at 7083 Hollywood Blvd., Suite 180, Los Angeles, California 90028, believes that it will be damaged by registration of the mark shown in Application Serial No.77/287,415 in International Class 45, and hereby opposes same.

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01 FC:6402 300.00 DA

As grounds for opposition, it is alleged:

1. Opposer is a nationally recognized provider of legal document preparation services, general information on commonly-encountered legal issues, and attorney referral services. Opposer has continuously used WE PUT THE LAW ON YOUR SIDE as a mark to identify and distinguish its own services since at least as early as August 1, 2006 and displays its mark prominently on its popular Internet website through which it offers its services.
2. Opposer has filed an application for registration of the mark WE PUT THE LAW ON YOUR SIDE for use in connection with "providing online directory information on attorney listings; attorney referral and matching services" in International Class 035 and "legal document preparation services and providing general legal information via a website on global computer networks" in International Class 045, as shown in U.S. Application Serial No. 77/427,654, which was filed on March 20, 2008.



04-03-2008

3. Applicant seeks registration on the Principal Register of the mark WE PUT THE LAW ON YOUR SIDE in International Class 45 for "Legal Services" pursuant to 15 U.S.C. § 1051(a). Applicant's mark was published in the March 25, 2008 issue of the Trademark Office Official Gazette on page TM 1287.

4. Applicant, on information and belief, is a related company to Axxess Broadcast Services, Inc., a wholly owned subsidiary of Applicant. Applicant and Axxess Broadcast Services, Inc. shall hereafter be referred to collectively as "Axxess."

5. Axxess has alleged in a November 2, 2007 letter to Opposer that Axxess owns and has trademark rights in the mark WE PUT THE LAW ON YOUR SIDE, asserting ownership of the application herein opposed, and that Opposer's use of its WE PUT THE LAW ON YOUR SIDE mark is likely to cause confusion among consumers in connection with Axxess's use of its alleged mark, thereby infringing on Axxess's alleged trademark rights.

6. On information and belief, Axxess is a provider of advertising services. Axxess, upon information and belief, creates, acquires, or appropriates slogans, jingles, and advertising campaigns and sells or otherwise makes such slogans, jingles, and campaigns available to multiple unrelated clients to permit each of those clients to independently advertise their respective goods or services.

7. On information and belief, Axxess has incorporated the slogan WE PUT THE LAW ON YOUR SIDE into advertising campaigns or advertising jingles that it has sold or otherwise made available to multiple, unrelated clients to permit each of those clients to independently advertise their respective legal services, without retaining the right or ability of Axxess or any other related entity to control the nature, quality, or characteristics of the goods or services to which those clients apply the slogan.

8. On information and belief, Axxess has never used WE PUT THE LAW ON YOUR SIDE in connection with its own goods or services or the goods or services of any related company.

9. On information and belief, Axxess is not, and has never been, a provider of legal services, nor has Axxess ever been legally qualified or permitted to do so.

10. On information and belief, Axxess is prohibited by law from offering or providing legal services.

11. On information and belief, Axxess is prohibited by law from controlling the nature, quality, and characteristics of legal services offered by others.

12. Axxess has not claimed in its Application to be the owner of WE PUT THE LAW ON YOUR SIDE through use of the mark by related companies, and, on information and belief, no company related to Axxess uses WE PUT THE LAW ON YOUR SIDE such that the use of WE PUT THE LAW ON YOUR SIDE by such company serves to identify a single source of the goods or services, functions as a trademark, or inures to the benefit of Axxess.

13. Axxess has not claimed in its Application to be the owner of WE PUT THE LAW ON YOUR SIDE through use by controlled licensees pursuant to a contract or agreement, and, on information and belief, Axxess has not used WE PUT THE LAW ON YOUR SIDE pursuant to and through a controlled licensing agreement, whether as a mark or otherwise.

14. On information and belief, Axxess has no trademark or service mark rights in WE PUT THE LAW ON YOUR SIDE that are superior to the rights of Opposer in WE PUT THE LAW ON YOUR SIDE. Neither Axxess nor any sufficiently related person or entity has ever used WE PUT THE LAW ON YOUR SIDE as a mark, as that term is defined in 15 U.S.C. § 1127, and, therefore, Axxess does not own rights in the alleged mark. In the alternative,

Opposer has superior rights to Axxcess in the mark because Opposer began using WE PUT THE LAW ON YOUR SIDE as a mark before Axxcess used the term as a mark, thereby conferring priority on Opposer.

15. If the registration herein opposed is granted, Axxcess would obtain at least a *prima facie* exclusive right to use the mark WE PUT THE LAW ON YOUR SIDE in connection with "Legal Services." Such registration would damage Opposer, who has prior rights in WE PUT THE LAW ON YOUR SIDE through widespread use in connection with its own services, and would impair Opposer's continued right to use its mark which Axxcess alleges to infringe its alleged trademark rights.

**COUNT I.**

**No Use of WE PUT THE LAW ON YOUR SIDE as a Mark  
(Failure to Function as a Mark)**

16. Opposer repeats and realleges the factual allegations in paragraphs 1 through 15 as if fully set forth herein.

17. On information and belief, the slogan WE PUT THE LAW ON YOUR SIDE is a feature or part of Axxcess's advertising services offered to its clients. Axxcess does not use WE PUT THE LAW ON YOUR SIDE in connection with its own legal services, or any other of Axxcess's own goods or services.

18. On information and belief, Axxcess does not use WE PUT THE LAW ON YOUR SIDE to identify and distinguish its own services from the services of others or to indicate the source of its services.

19. On information and belief, WE PUT THE LAW ON YOUR SIDE is not being used by any person or entity related to Axxcess in connection with legal services such that the use of WE PUT THE LAW ON YOUR SIDE by such company inures to the benefit of Axxcess.

20. On information and belief, Axxess has not used WE PUT THE LAW ON YOUR SIDE in connection with legal services pursuant to and through a controlled licensing agreement. To the extent Axxess may have granted any license in and to WE PUT THE LAW ON YOUR SIDE for use on legal services, Axxess, on information and belief, does not have the right, or has failed to exercise the right, to control the nature, quality, or characteristics of the services to which WE PUT THE LAW ON YOUR SIDE may have been applied pursuant to such license.

21. Axxess has not used WE PUT THE LAW ON YOUR SIDE in a manner that creates any trademark or service mark rights or imparts ownership of a trademark or service mark to Axxess for use in connection with legal services or any other goods or services. None of the uses of WE PUT THE LAW ON YOUR SIDE by Axxess or any related person or entity function as a mark in that such uses do not indicate that the goods or services emanate from a single source.

22. Axxess is not the owner of WE PUT THE LAW ON YOUR SIDE in connection with legal services or any other goods or services, and, therefore, is not entitled to the registration it seeks.

**COUNT II.**  
**Priority in WE PUT THE LAW ON YOUR SIDE**

23. Opposer repeats and realleges the factual allegations in paragraphs 1 through 22 as if fully set forth herein.

24. Opposer has continuously used WE PUT THE LAW ON YOUR SIDE as a mark to identify and distinguish its own services since at least as early as August 1, 2006 and is the owner of trademark rights in the mark in connection with those services.

25. On information and belief, neither Axxess, nor any related company or licensee of Axxess, has ever used WE PUT THE LAW ON YOUR SIDE as a mark to identify and

distinguish Axxcess's own goods or services. In the alternative, neither Axxcess, nor any related company or licensee of Axxcess began using WE PUT THE LAW ON YOUR SIDE as a mark prior to Opposer's first use of the term as a mark.

26. Opposer has prior and superior rights to Axxcess in WE PUT THE LAW ON YOUR SIDE and, therefore, Axxcess is not the entitled to the registration it seeks.

**COUNT III.**  
**Abandonment of the Purported Mark Through Uncontrolled Licensing**  
**(In the Alternative)**

27. Opposer repeats and realleges the factual allegations in paragraphs 1 through 26 as if fully set forth herein.

28. On information and belief, Axxcess has sold or otherwise provided advertising materials or services incorporating WE PUT THE LAW ON YOUR SIDE to at least one person or entity. On further information and belief, Axxcess does not have the right, or has failed to exercise the right, to control the legal services to which WE PUT THE LAW ON YOUR SIDE is applied by such persons or entities.

29. Therefore, in the alternative, Axxcess has abandoned any rights it may have had in the purported mark WE PUT THE LAW ON YOUR SIDE by failing to exercise sufficient control over the use of the purported mark by licensees and the nature, quality, and characteristics of the goods or services provided under the purported mark by licensees. On information and belief, Axxcess's abandonment through uncontrolled licensing occurred long prior to the filing date of U.S. Application Serial No. 77/287,415.

**COUNT IV.**  
**Void Application *Ab Initio***

30. Opposer repeats and realleges the factual allegations in paragraphs 1 through 29 as if fully set forth herein.

31. On information and belief, Axxcess is not the owner of the mark shown in U.S. Application Serial No. 77/287,415 and was not the owner of such mark on the filing date of the application. Axxcess's application is therefore void and registration of the proposed mark should be denied pursuant to 37 C.F.R. § 2.71(d).

**COUNT V.  
Fraud in Application for Registration**

32. Opposer repeats and realleges the factual allegations in paragraphs 1 through 31 as if fully set forth herein.

33. On September 24, 2007, Axxcess, through its Attorney of Record, Terrell R. Miller, filed U.S. Application Serial No. 77/287,415, and a declaration in support thereof, wherein Axxcess made the following representations:

- Applicant is the owner of the service mark WE PUT THE LAW ON YOUR SIDE;
- Applicant was using the mark WE PUT THE LAW ON YOUR SIDE in commerce on September 24, 2007; and
- Applicant was using the mark WE PUT THE LAW ON YOUR SIDE in connection with legal services on September 24, 2007.

34. Upon information and belief, the above-identified representations made in Axxcess's application and declaration are false. Specifically, upon information and belief:

- Applicant does not own the mark WE PUT THE LAW ON YOUR SIDE;
- Applicant has never used the mark WE PUT THE LAW ON YOUR SIDE to identify and distinguish its own goods or services; and

- Applicant has never offered legal services, or, in the alternative, Applicant has never used WE PUT THE LAW ON YOUR SIDE to identify and distinguish Applicant's own legal services from those of others.

35. Upon information and belief, Axxcess and/or its Attorney of Record knew or should have known that these representations were false at the time they were made.

36. The false representations are material. Upon information and belief, the Examining Attorney would not have approved Axxcess's application for publication if Axxcess had not made such representations of ownership and use.

37. Accordingly, Axxcess committed fraud in prosecuting U.S. Application Serial No. 77/287,415 and registration of the mark sought in the application should be denied.

WHEREFORE, Opposer prays that registration of the proposed mark, designated as application Serial No. 77/287,415, be denied.

The Commissioner is hereby authorized to withdraw the filing fee in the amount of \$300 as required under 37 C.F.R. §2.6(a)(17) from Deposit Account No. 01-0477.

Respectfully submitted,

LEGALZOOM.COM, INC.

Dated: 4/01/2008

By: 

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**CERTIFICATE OF SERVICE**

I certify that on April 1, 2008, the foregoing Notice of Opposition was served via certified United States mail on the Attorney of Record for Applicant at the following correspondence address of record in the Trademark Office:

Terrell R. Miller  
Storm LLP  
901 Main Street, Suite 7100  
Dallas, Texas 75202

  
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Daniel Moffett

**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: Box TTAB FEE, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Name of Person Signing Certificate: Michele Patterson

**Signature:** Michele Patterson

**Date of Mailing:** 4/1/08