

ESTTA Tracking number: **ESTTA295331**

Filing date: **07/14/2009**

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

Name	Directlaw, Inc.
Granted to Date of previous extension	07/15/2009
Address	800 Village Square Crossing Suite 318 Palm Beach Gardens, FL 33410 UNITED STATES
Correspondence information	Michael D. Oliver, Esq. Attorney Bowie & Jensen, LLC 29 W. Susquehanna Ave. Suite 600 Towson, MD 21204 UNITED STATES oliver@bowie-jensen.com Phone:410-583-2400

Applicant Information

Application No	77474991	Publication date	03/17/2009
Opposition Filing Date	07/14/2009	Opposition Period Ends	07/15/2009
Applicant	Cyberlaw Associates, LLC Suite 600 1800 Century Park East Los Angeles, CA 90067 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 2006/10/25 First Use In Commerce: 2006/10/25 All goods and services in the class are opposed, namely: Legal document preparation; Providing a website featuring general legal information
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lanham Act Section 18, petition to limit goods and services

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77621346	Application Date	11/25/2008
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	DIRECTLAW
Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2008/02/20 First Use In Commerce: 2008/02/20 On-line computer services, namely, providing law firms with a web portal to supply legal forms, legal services and legal advice to their clients

Attachments	77621346#TMSN.jpeg (1 page)(bytes) Notice of Opposition -Directlegal_draft_.pdf (5 pages)(25441 bytes)
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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.

Signature	/Michael D. Oliver/
Name	Michael D. Oliver, Esq.
Date	07/14/2009

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

In re Application of Cyberlaw
Associates, LLC
Serial No.: 77/474991
Publication Date: March 17, 2009
Trademark: "DIRECTLEGAL"

Opposition
No.

DIRECTLAW, INC.

Opposer

v.

CYBERLAW ASSOCIATES, LLC

Applicant

NOTICE OF OPPOSITION

DirectLaw, Inc. ("Petitioner" or "Opposer"), by counsel, files this Opposition to the registration on the principal register of the trademark "DIRECTLEGAL", having Serial Number 77/474991, and alleges as follows:

1. DirectLaw, Inc. ("DirectLaw") is a Delaware corporation, with its principal office at 800 Village Square Crossing, suite 318, Palm Beach Gardens, Florida 33410.

2. DirectLaw operates an online business at the URL www.directlaw.com (the "Website"). The Website is a service that allows lawyers to run a "virtual" law office – i.e. lawyers purchase the DirectLaw service to have a one stop electronic office for their clients – and these services can include a website for the lawyer, document sharing, document preparation, billing, client communications, and other electronic services that lawyers offer to

clients. The DirectLaw service does not provide direct-to-consumer legal services – in other words, a consumer seeking either legal advice, legal document preparation, or other legal services, would not purchase services from DirectLaw (they may, however, hire a lawyer who has purchased the DirectLaw service).

3. The DirectLaw service was launched in the United States in the spring or early summer of 2005, the first actual sale in the United States under the DIRECTLAW mark took place on August 1, 2005.

4. The URL was registered on January 20, 1998, and a service similar to the current service was in operation on the world wide web at that URL (for United Kingdom lawyers) since approximately 2000.

5. DirectLaw is the owner of the pending trademark application DIRECTLAW, Serial No. 77/621346 for “on-line computer services, namely, providing law firms with a web portal to supply legal forms, legal services and legal advice to their clients’, which was filed with the United States Patent and Trademark Office (“PTO”) on November 25, 2008 in class 42.

6. Applicant has filed an application for registration on May 15, 2008 with the PTO for the trademark “DIRECTLEGAL” in class 45, Serial No. 77/474991 for “legal document preparation; providing a website featuring general legal information.” Applicant has claimed a date of first use in commerce of October 25, 2006.

7. Notwithstanding the stated goods and services in the Applicant’s application, the DIRECTLEGAL mark is in fact used on much narrower services – specifically, on legal document preparation and legal information concerning trademark and copyright applications.

8. Applicant's DIRECTLEGAL trademark application has been cited by the examiner in Petitioner's application prosecution and has been asserted to bar Petitioner's registration for DIRECTLAW on the grounds that DIRECTLAW is likely to cause confusion with Petitioner's DIRECTLEGAL mark.

9. Petitioner does not believe that a likelihood of confusion exists between the Applicant's and Petitioner's trademarks because the marks are used for entirely different services and customers; however, Petitioner's actual use pre-dates and is senior to Applicant's use, if in fact the two marks are confusingly similar.

10. Petitioner hereby petitions the Trademark Trial and Appeal Board, pursuant to Section 18 of the Lanham Act (15 U.S.C. § 1068), to "modify the application or registration [of Applicant] by limiting the goods or services specified therein" as follows:

"legal document preparation in the field of trademarks and copyrights; providing a website featuring general legal information in the field of trademarks and copyrights."

11. Petitioner asserts that the restrictions and limitations requested herein will avoid a finding of confusion and Applicant is not actually using its mark on the broad class of services currently identified in its application.

12. In the alternative to the relief requested in paragraph 10, Petitioner, as the senior user of the mark at common law, hereby petitions the Trademark Trial and Appeal Board to refuse registration of the Applicant's mark DIRECTLEGAL on the grounds that registration of the mark would damage Petitioner because Applicant's mark would be likely to cause confusion with Petitioner's DIRECTLAW mark, and therefore Applicant's mark is unregistrable under 15 U.S.C. § 1052(d).

WHEREFORE, Opposer requests that the registration for Applicant's mark be refused

unless Applicant limits and restricts its goods and services as provided above, or in the alternative, that Applicant's mark be refused on the grounds that it so resembles Petitioner's which was previously used in the United States and not abandoned, 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, or in the alternative, to enter an order providing such other relief under the Lanham Act as may be necessary or appropriate in the case to limit the likelihood of confusion between the Applicant's and Petitioner's marks.

Dated: July 14, 2009

Respectfully submitted,

A handwritten signature in black ink, appearing to read "M. Oliver", with a long horizontal flourish extending to the right.

Michael D. Oliver
Bowie & Jensen, LLC
29 West Susquehanna Avenue, Suite 600
Towson, Maryland 21204
(410) 583-2400

CERTIFICATE OF SERVICE

I HEREBY certify that a copy of the foregoing **NOTICE OF OPPOSITION** will be sent on the 15th day of July, 2009, via first-class mail, postage pre-paid, to the following:

LORNE EISENSTAT
CYBERLAW ASSOCIATES, LLC
1800 CENTURY PARK E STE 600
LOS ANGELES, CA 90067-1508
Attorney for Applicant

A handwritten signature in black ink, appearing to read "M. Oliver", written over a horizontal line.

Michael D. Oliver, Esq.