

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Winter/tdc

Mailed: June 9, 2010

Opposition No. 91191031

Directlaw, Inc.

v.

Cyberlaw Associates, LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On May 7, 2010,¹ pursuant to the parties' Consent to Registration Agreement, opposer filed applicant's proposed amendment to the opposed application Serial No. 77474991 with opposer's consent, a proposed amendment to opposer's pending application Serial No. 77621346, and opposer's withdrawal of the opposition with prejudice with applicant consent, contingent upon entry of the amendments to both parties' applications.

Proposed Amendment to Application Serial No. 77621346

As a preliminary matter, the Board reminds the parties that the Board does not have jurisdiction over opposer's pending application. See TBMP § 212.01 (2d ed. rev. 2004). Consequently, opposer must submit the proposed amendment to its

¹ Opposer's consented motion (filed April 21, 2010) to extend the discovery period for two weeks (until May 5, 2010) so that it would have time to receive an executed settlement agreement from applicant is granted. See Trademark Rule 2.127(a).

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suspended application, along with a copy of the parties' consent agreement,² directly to the Trademark Examining Operation for review and consideration by the Examining Attorney assigned thereto. See TMEP § 1207.01(d)(viii) (6th ed. Rev. 2010).
Proposed Amendment to Opposed Application

Turning to the proposed amendment to the application involved in this proceeding, applicant seeks to amend the recitation of services in International Class 45 as follows:

From: "Legal document preparation; Providing a website featuring general legal information,"

To: "Legal document preparation for non-attorneys; Providing a website featuring general legal information for non-attorneys; Legal document preparation for attorneys and non-attorneys limited to documents concerning intellectual property; Providing a website featuring general legal information for attorneys and non-attorneys limited to matters of intellectual property."

Inasmuch as the amendment is clearly limiting in nature as required by Trademark Rule 2.71(a), and because opposer consents thereto, it is approved and entered. See Trademark Rule 2.133(a).

Consideration of Contingent Withdrawal Deferred

Inasmuch as the stipulated withdrawal of the opposition

² The Board notes that the Examining Attorney for opposer's application has not only objected to the recitation of services as indefinite, but has suspended opposer's application based on a potential refusal under Section 2(d) in connection with applicant's prior pending application.

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with prejudice is contingent upon the acceptance of the amendments to both parties' applications referenced herein, the Board's consideration of the withdrawal is **deferred** pending the review of the stipulated amendment to opposer's application by the Examining Attorney assigned thereto.

The parties must inform the Board within **thirty days** of the issuance of either an office action refusing such amendment (and/or continuing the potential Section 2(d) refusal) or approval of such amendment by the Examining Attorney (and/or withdrawal of the potential refusal), as to whether the Board should consider the parties' stipulated withdrawal of this opposition.

Proceeding Suspended

In view of the foregoing, this proceeding is **SUSPENDED** pending the review of opposer's proposed amendment and, presumably, the parties' consent agreement by the Examining Attorney. See Trademark Rule 2.117(c). See also *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (proceedings to be resumed if consent agreement did not overcome examining attorney's 2(d) refusal); TBMP § 510.03(b) (2d ed. rev. 2004). Trial dates will be reset, if necessary, upon resumption of this proceeding.

