

ESTTA Tracking number: **ESTTA356140**

Filing date: **07/02/2010**

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

Proceeding	91191031
Party	Plaintiff Directlaw, Inc.
Correspondence Address	JOSHUA A. GLIKIN BOWIE & JENSEN, LLC 29 W. SUSQUEHANNA AVE., 6TH FLOOR TOWSON, MD 21204 UNITED STATES oliver@bowie-jensen.com
Submission	Withdrawal of Opposition
Filer's Name	Pamela K. Riewerts
Filer's e-mail	riewerts@bowie-jensen.com
Signature	/Pamela K. Riewerts/
Date	07/02/2010
Attachments	Response to Board's CORR in Connection to Withdraw OPP with Prejudice.PDF ( 14 pages )(846514 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Trademark Trial and Appeal Board

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Directlaw, Inc.	)	Opposition No. 91/191,031
	)	
	)	Applicant Serial No. 77/474,991
Opposer,	)	Opposer Serial No. 77/621,346
	)	
	)	<b>RESPONSE TO THE BOARD'S JUNE 9, 2010</b>
	)	<b>CORRESPONDENCE IN CONNECTION WITH</b>
	)	<b>THE PARTIES' STIPULATION TO</b>
	)	<b>WITHDRAW OPPOSITION WITH PREJUDICE</b>
v.	)	
	)	
Cyberlaw Associates, LLC	)	
	)	
Applicant.	)	

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**RESPONSE TO THE BOARD'S JUNE 9, 2010 CORRESPONDENCE IN CONNECTION  
WITH THE PARTIES' STIPULATION TO WITHDRAW  
OPPOSITION WITH PREJUDICE**

In accordance with the Board's correspondence to the parties dated June 9, 2010, Opposer is notifying the Board that the Examining Attorney reviewing Opposer's application Serial No. 77/621,346 has approved Opposer's amendment to the identification of goods or services.

On May 6, 2010, the Parties filed a Stipulation to Withdraw Opposition with Prejudice (Stipulated Motion) with the Board contingent upon the approval of Applicant's and Opposer's amendments respectively.

In the Board's June 9, 2010 correspondence responding to the Parties' Stipulated Motion, the Board approved the Applicant's amendment and suspended the present Opposition proceeding pending the Examining Attorney's review of Opposer's proposed amendment as

agreed to by the Parties. Opposer subsequently filed its proposed amendment with the Examining Attorney for consideration.

On June 23, the Examining Attorney approved Opposer's proposed amendment of the subject application Serial No. 77/621,346 as agreed to by the Parties as follows:

**From:** "On-line computer services, namely, providing lawyers and law firms with a web portal to supply legal forms, legal services and legal advice to their clients."

**To:** "On-line computer services, namely, providing lawyers and law firms with a web portal to supply legal forms, legal services and legal advice to their clients, specifically excluding providing said web portal services to non-lawyers and non-law firms."

See Examiner's Amendment, attached herewith.

In light of the Examining Attorney's approval of Opposer's amendment, Opposer respectfully requests that the Board grant the Parties' Stipulation to Withdraw Opposition with Prejudice.

Date: July 2, 2010



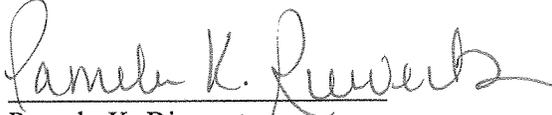
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(410) 583-2400

*Counsel for Opposer Directlaw, Inc.*

**CERTIFICATE OF SERVICE**

I HEREBY certify that on this 2nd day of July 2010, a copy of the foregoing **Response to the Board's June 9, 2010 Correspondence in Connection with the Parties' Stipulation to Withdraw Opposition with Prejudice** was served via electronic mail (by mutual agreement of the Parties in this Action), to the following:

Jeffrey Sonnabend, Esq.  
SonnabendLaw  
600 Prospect Avenue  
Brooklyn, NY 11215  
Attorney for Applicant, Cyberlaw Associates, LLC.

  
Pamela K. Riewerts

Document Description: **Examiners Amendment**  
 Mail / Create Date: **23-Jun-2010**

Previous Page      Next Page      You are currently on page  of

**To:** Directlaw, Inc. ([oliver@bowie-jensen.com](mailto:oliver@bowie-jensen.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77621346 - DIRECTLAW - N/A  
**Sent:** 6/23/2010 12:08:26 PM  
**Sent As:** ECOM110@USPTO.GOV  
**Attachments:**

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
 OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.**      77621346

**MARK:** DIRECTLAW

**\*77621346\***

**CORRESPONDENT ADDRESS:**  
 MICHAEL D. OLIVER  
 BOWIE & JENSEN, LLC  
 29 W SUSQUEHANNA AVE STE 600  
 TOWSON, MD 21204-5214

**GENERAL TRADEMARK INFORMATION:**  
<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:**      Directlaw, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET  
 NO:** N/A

**CORRESPONDENT E-MAIL ADDRESS:**  
[oliver@bowie-jensen.com](mailto:oliver@bowie-jensen.com)

**EXAMINER'S AMENDMENT**

**ISSUE/MAILING DATE:** 6/23/2010

I  
 I

**DATABASE SEARCH:** The trademark examining attorney has searched the USPTO's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

**APPLICATION HAS BEEN AMENDED:** In accordance with the authorization *granted pursuant to TMEP Section 707.02*, the application has been AMENDED as indicated below. No response is necessary unless there is an objection to the amendment. Any future amendments to the identification of goods or services must be in accordance with 37 C.F.R. 2.71(a); TMEP section 1402.07(e). Please advise the undersigned if there is an objection to the amendment.

The examining attorney accepts the amendment with regard to the recitation of services and withdraws the

possible Trademark Act Section 2(d) refusal with regard to Application Serial No. 77474991, as the applicant has filed a consent agreement.

AMENDMENT OF CLASSIFICATION

The examining attorney has amended the application to classify the services in Class 45.

/Caroline E. Wood/  
Trademark Examining Attorney  
Law Office 110  
(571) 272-9243

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

TDR Home

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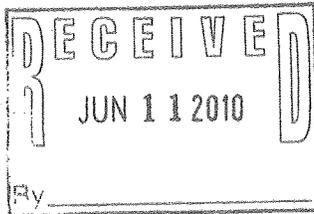
*If you need help:*

- **General trademark information:** Please e-mail [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov), or telephone either 571-272-9250 or 1-800-786-9199.
- **Technical help:** For instructions on how to use TDR, or help in resolving **technical** glitches, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). If outside of the normal business hours of the USPTO, please e-mail [Electronic Business Support](mailto:ElectronicBusinessSupport@uspto.gov), or call 1-800-786-9199.
- **Questions about USPTO programs:** Please e-mail [USPTO Contact Center \(UCC\)](mailto:USPTOContactCenter@uspto.gov).

**NOTE:** Within any e-mail, please include your telephone number so we can talk to you directly, if necessary. Also, include the relevant serial number or registration number, if existing.

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,<sup>1</sup> 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

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<sup>1</sup> 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).

suspended application, along with a copy of the parties' consent agreement,<sup>2</sup> 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

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<sup>2</sup> 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.

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.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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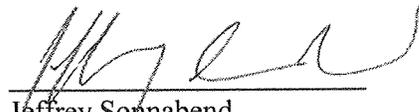
Directlaw, Inc.	)	Opposition No. 91/191,031
	)	
	)	Applicant Serial No. 77/474,991
Opposer,	)	Opposer Serial No. 77/621,346
	)	
	)	
	)	<b>PARTIES' STIPULATION TO WITHDRAW</b>
	)	<b>OPPOSITION WITH PREJUDICE</b>
v.	)	
	)	
Cyberlaw Associates, LLC	)	
	)	
Applicant.	)	

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**PARTIES' STIPULATION TO WITHDRAW OPPOSITION WITH PREJUDICE**

Opposer, Directlaw, Inc. ("Opposer") and Applicant, Cyberlaw Associates, LLC ("Applicant") have entered into a Consent to Registration Agreement, which was executed by both parties on or about April 22, 2010. The Consent to Registration Agreement resolves Opposer's issues with Applicant's trademark application for the DIRECTLEGAL mark. Accordingly, both parties stipulate that Opposition No. 91/191,031 is hereby withdrawn with prejudice contingent on the following two items: (1) the amendment of the Opposer's trademark application, U.S. Application Serial No. 77/621,346, as set forth in Opposer's Motion to Amend Application Pursuant to 37 C.F.R. § 2.133(a); and (2) the amendment of Applicant's trademark application, U.S. Application Serial No. 77/474,991, as set forth in Applicant's Motion to Amend Application Pursuant to 37 C.F.R. § 2.133(a), which are both being filed concurrently with this Parties' Stipulation to Withdraw Opposition With Prejudice.

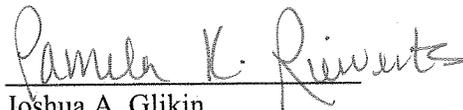
Date: May 6, 2010



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*Counsel for Applicant  
Cyberlaw Associates, LLC*

Date: May 6, 2010



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*Counsel for Opposer Directlaw, Inc.*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Trademark Trial and Appeal Board

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Directlaw, Inc.	)	Opposition No. 91/191,031
	)	
	)	Applicant Serial No. 77/474,991
Opposer,	)	Opposer Serial No. 77/621,346
	)	
	)	
	)	<b>OPPOSER'S MOTION TO</b>
v.	)	<b>AMEND TRADEMARK APPLICATION</b>
	)	<b>PURSUANT TO 37 CFR § 2.133(a)</b>
Cyberlaw Associates, LLC	)	
	)	
Applicant.	)	

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**OPPOSER'S MOTION TO AMEND  
TRADEMARK APPLICATION PURSUANT TO 37 C.F.R. § 2.133(a)**

The Trademark Trial and Appeal Board is herewith notified of the settlement of the above-captioned Opposition by the parties thereto as evidenced by a stipulated motion filed by Opposer with Applicant's consent that the Opposition be dismissed with prejudice due to settlement by the parties. Contemporaneous with such dismissal of the Opposition the Board is requested to grant Opposer's Motion to Amend the Opposer's Application pursuant to 37 C.F.R. § 2.133(a) as follows:

On-line computer services, namely, providing lawyers and law firms with a web portal to supply legal forms, legal services and legal advice to their clients, specifically excluding providing said web portal services to non-lawyers and non-law firms.

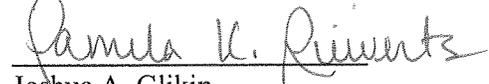
The amendment to the description of goods and services of Int. Class 42 is with the consent of Applicant.

The proposed amended description of goods and services is narrower in scope than the previous description of goods and services in the application and does not materially differ in nature from the description of goods and services in the application, and so re-examination of the mark is not required.

In view of the foregoing, the granting of this motion by the Trademark Trial and Appeal Board is respectfully requested, and upon the granting thereof resumption of proceedings before the Trademark Examining Attorney is respectfully requested.

Dated: May 6, 2010

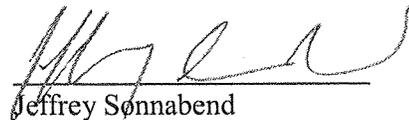
Respectfully submitted,



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Pamela K. Riewerts  
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410-583-2400  
*Counsel for Opposer Directlaw, Inc.*

Dated: May 6, 2010

Consented to,



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*Counsel for Applicant  
Cyberlaw Associates, LLC*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Trademark Trial and Appeal Board

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Directlaw, Inc.	)	Opposition No. 91/191,031
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	)	
	)	
	)	
v.	)	
	)	
Cyberlaw Associates, LLC	)	
	)	
Applicant.	)	

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**APPLICANT'S MOTION TO AMEND  
TRADEMARK APPLICATION PURSUANT TO 37 C.F.R. § 2.133(a)**

The Trademark Trial and Appeal Board is herewith notified of the settlement of the above-captioned Opposition by the parties thereto as evidenced by a stipulated motion filed by Opposer with Applicant's consent that the Opposition be dismissed with prejudice due to settlement by the parties. Contemporaneous with such dismissal of the Opposition the Board is requested to grant Applicant's Motion to Amend the subject Application pursuant to 37 C.F.R. § 2.133(a) as follows:

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.

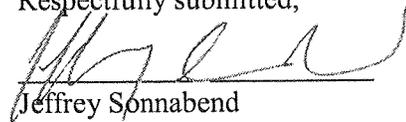
The amendment to the description of goods and services of Int. Class 45 is with the consent of Opposer.

The proposed amended description of goods and services is narrower in scope than the previously published description of goods and services and does not materially differ in nature from the previously published description of goods and services, and so republication of the mark is not required.

In view of the foregoing, the granting of this motion by the Trademark Trial and Appeal Board is respectfully requested.

Dated: May 6, 2010

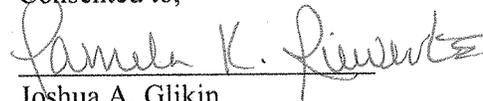
Respectfully submitted,



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Dated: May 6, 2010

Consented to,



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*Counsel for Opposer Directlaw, Inc.*