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

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|------------------------|---|
| Proceeding | 88238629 |
| Applicant | Steinlaw, PA |
| Applied for Mark | STEINLAW |
| Correspondence Address | JOHN FULTON JR MALLOY & MALLOY PL 2800 SW 3RD AVENUE MIAMI, FL 33129 UNITED STATES mhasty@malloylaw.com, jfulton@malloylaw.com, msantana@malloylaw.com, trademark@malloylaw.com, filing@malloylaw.com 305-858-8000 |
| Submission | Applicants Request for Remand and Amendment |
| Attachments | 2020 03 20 - Motion to Remand - 88238629.pdf(122178 bytes) 2020 03 20 Exhibit A Signed Consent Agreement.pdf(1982681 bytes) |
| Filer's Name | Oliver Alan Ruiz |
| Filer's email | oruiz@malloylaw.com, msantana@malloylaw.com, trademark@malloylaw.com |
| Signature | /Oliver Alan Ruiz/ |
| Date | 03/20/2020 |

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

In re: Steinlaw, PA
Serial No.: 88/238,629
Mark: STEINLAW

LAW OFFICE 111
Examiner, Caitlin Watts-FitzGerald

2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129

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

APPLICANT'S MOTION TO REMAND APPLICATION TO EXAMINING ATTORNEY

Steinlaw, PA ("Applicant"), hereby moves pursuant to TBMP §§ 1207.02 and 1209.04, to remand the application to the Examining Attorney for consideration of a Consent Agreement between the Applicant and the owner of the registration cited in the Examining Attorney's 2(d) refusal. See Exhibit A.

Applicant also requests that the Board, consistent with its customary practice, suspend the appeal pending the Examining Attorney's review of the Consent Agreement.

Applicant respectfully submits that this development is material and probative to the issue of registrability, and that such request is timely as the Board has not yet issued a final decision on appeal. TBMP § 1207.02.

I. BACKGROUND FACTS

Applicant filed U.S. Serial No. 88/238,629 for the mark "STEINLAW" (the "application") for use in connection with attorney services. The Examining Attorney has previously taken the position that the

Applicant's mark, when applied to the above-referenced services, is likely to cause confusion with U.S. Registration No. 5,006,163 for the mark "LAW & STEIN, LLP," owned by Law & Stein, LLP, for use in connection with attorney services; litigation services; providing customized legal information, counseling, and advice, and litigation services in the field of business, estate planning, tax, real estate, trust administration, and probate.

After reconsideration of the Examining Attorney's Final Office Action was denied on January 9, 2020, this appeal was resumed by order of the Board on January 28, 2020.

II. ARGUMENT

A remand is appropriate so that refusal of the application may be reconsidered by the Examining Attorney in light of the execution of a Consent Agreement between the Applicant and the owner of the cited registrations. See Exhibit A. As noted in In re E.I. du Pont de Nemours & Co.:

When those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

476 F.2d at 1363, 177 USPQ at 568 (C.C.P.A. 1973).

Here, the agreement between the parties recognizes that confusion is unlikely, and the parties have further agreed to undertake certain actions to avoid confusion, should any instances of confusion arise, however unlikely.

The Court of Appeals for the Federal Circuit has recognized that

consent agreements should be given great weight, and that the Board should not rely on its own views concerning likelihood of confusion, rather than the judgment of the parties in question, without good reason. See In re Four Seasons Hotels Ltd., 987 F.2d 1565, 26 USPQ2d 1071 (Fed. Cir. 1993) ("It is well settled that in the absence of contrary evidence, a consent agreement itself may be evidence that there is no likelihood of confusion.").

WHEREFORE, Applicant respectfully requests that the Trademark Trial and Appeal Board suspend the appeal and remand the application to the Examining Attorney for further consideration of the present refusal in light of the Consent Agreement.

Dated: March 20, 2020

Respectfully submitted,

/Oliver Alan Ruiz/
John Cyril Malloy, III
Florida Bar No. 964,220
jcmalloy@malloylaw.com
Oliver Alan Ruiz
Florida Bar No. 524,786
oruiz@malloylaw.com
MALLOY & MALLOY, P.L.
2800 S.W. Third Avenue
Historic Coral Way
Miami, Florida 33129
Telephone: (305) 858-8000
Facsimile: (305) 858-0008

CERTIFICATE OF FILING

I HEREBY CERTIFY that the foregoing Motion to Remand was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board's ESTTA electronic filing system, on March 20, 2020.

By: /Oliver Alan Ruiz/
Oliver Alan Ruiz

CONSENT AGREEMENT

This Consent Agreement ("Agreement") is effective on the date of the last signature below by and between Steinlaw, PA, a Florida limited liability company having a place of business at 17971 Biscayne Boulevard, Suite 216, Aventura, Florida 33160 ("Steinlaw") and Law and Stein, LLP, a California corporation having an address at 2601 Main Street, Suite 1200, Irvine, California 92614 ("Law and Stein").

WHEREAS Steinlaw is a provider of attorney services throughout the State of Florida, with a primary focus on personal injury law;

WHEREAS Steinlaw's primary channels of trade are directed to its clients via its internet website at www.steinlaw.com and physical offices located throughout the State of Florida;

WHEREAS, in or about 2013, Steinlaw selected and adopted the marks "STEINLAW" and "STEINLAW" (Stylized) (collectively, the "STEINLAW MARKS") for use in connection with attorney services, and has used the STEINLAW MARKS continuously on such services since that time;

WHEREAS, on or about December 21, 2018 Steinlaw filed U.S. Trademark Application Serial Nos. 88/238,605 and 88/238,629 for the marks "STEINLAW" and "STEINLAW" (Stylized), respectively (the "STEINLAW APPLICATIONS"), in connection with attorney services in International Class 045 (the "STEINLAW SERVICES");

WHEREAS, a true and accurate representation of the STEINLAW" (Stylized) mark is presented below:

STEINLAW

WHEREAS, Law and Stein is a provider of legal services in Southern California, with a primary focus on estate and trust planning, trust administration, trust and estate litigation, tax planning, general business litigation, and insurance defense law;

WHEREAS Law and Stein's primary channels of trade are direct to its clients via its internet website at www.lawandsteinllp.com and its physical office located in Southern California;

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