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February 26, 2007

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Commissioner for Trademarks
600 Dulany Street
Alexandria, VA 22313

Re: Becker Designs, Inc.
Application Number: 78512395



03-02-2007

U.S. Patent & TMO/ TM Mail Rcpt Dt. #11

Dear Sir or Madam:

The enclosed were inadvertently sent to your old address in Arlington, Virginia, please accept the following for filing:

- Petitioner's Motion for Enlargement of Time to File Response to Respondent's Motion for Disqualification of Counsel, and Supporting Brief.
- Petitioner's Response to Respondent's Petition to Disqualify Counsel and Motion to Suspend Proceedings Pending Final Determination of Civil Litigation, Or, Alternatively, Motion to Reopen Petitioner's Testimony Period, With Supporting Briefs.

Please contact me if you have any questions or require additional information.

Sincerely,

Kathryn D. Weston
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KDW:th
Enclosures

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

BECKER DESIGNS, INC.,

Petitioner,

Opposition No.: 91168610
Application No.: 78512395

v.

BIKER DESIGN, INC.,

Opposition No.: 91174554
Application No.: 78817785

Respondent-Registrant.

PETITIONER'S MOTION FOR ENLARGEMENT OF TIME TO FILE RESPONSE TO
RESPONDENT'S MOTION FOR DISQUALIFICATION OF COUNSEL,
AND SUPPORTING BRIEF

Petitioner, BECKER DESIGNS, INC. ("Becker"), by and through its undersigned counsel, hereby moves the Board, pursuant to Trademark Rule 2.127(a) (37 C.F.R. §2.127(a)) and TMBP 509, for an enlargement of time to file its response to Respondent's Petition to Disqualify Counsel (the "Petition") and in support thereof states as follows:

Respondent served the Petition by U.S. Mail on January 23, 2007, and the Supplement to Petition to Disqualify Counsel on January 24, 2007, in the referenced opposition proceedings. Petitioner's response to the Petition was due on or before February 12, 2007, pursuant to 27 C.F.R. §2.119(c).

A related civil action alleging, *inter alia*, trademark and copyright infringement is pending before the United States District Court for the Middle District of Florida, *Becker Designs, Inc., v. Biker Design, Inc., et al.*, Case No. 6:06-cv-56-Orl-22DAB (the "Civil Litigation"). On January 23, 2007, the Court affirmed the Magistrate Judge's disqualification of Kathryn D. Weston ("Weston") and Cobb & Cole from representing Petitioner in the Civil Litigation, finding that Weston's prior representation of Respondent in a sales tax audit was "substantially related" to the Civil Litigation



because the Petitioner's damages in the trademark and copyright infringement claims pending in the Civil Litigation would be determined based, in part, on the Respondent's sales of infringing items. Thus, the common element in both representations was the sales of Biker Design, Inc.

On or about January 31, 2007, at the request of the Petitioner, the undersigned sent all of the firm's files to Petitioner's new counsel in the Civil Litigation, including the Petitions to Disqualify Counsel, expecting that Petitioner's new counsel would be assuming all aspects of Cobb & Cole's representation of Petitioner. On or about February 12, 2007, the undersigned was advised by Petitioner's new counsel in the Civil Litigation that he would not be representing Petitioner in the opposition proceedings. On or about February 13, 2007, past the deadline for filing a response to the Petition, the undersigned received back the files related to the opposition proceedings from Petitioner's new counsel in the Civil Litigation.

The Response to Respondent's Motion for Disqualification of Counsel is being filed herewith, three days past the due date for such response. Petitioner's late filing is due to excusable neglect, and the Board should grant Petitioner's motion for an enlargement of time to file the response.

Pursuant to Fed.R.Civ.P. 6(b), made applicable to Board proceedings by 37 C.F.R. §2.116(a), a party may file a motion for an enlargement of time in which an act is required or allowed to be done. If the motion is filed after the expiration of the period as originally set or previously extended, the motion is a motion to reopen, and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. See, e.g., *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000). The excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay,

including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

The “prejudice to the nonmovant” contemplated under the first *Pioneer* factor must be more than mere inconvenience and delay caused by the movant’s previous failure to take timely action, and more than the nonmovant’s loss of any tactical advantage which it otherwise would enjoy as a result of the movant’s delay or omission. Rather, “prejudice to the nonmovant” is prejudice to the nonmovant’s ability to litigate the case, e.g., where the movant’s delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant. *Pumpkin*, 43 USPQ2d at 1587 (citations omitted). Petitioner’s three-day delay causes no prejudice to Respondent, as it does not affect Respondent’s ability to litigate the opposition proceedings. Similarly, the three-day delay will not impact the judicial proceedings, as considered in the second *Pioneer* factor.

The reason for the delay is essentially a miscommunication among Petitioner, its counsel in the Civil Litigation, and the undersigned, which was within the control of the undersigned to a limited extent. Petitioner has, at all times, acted in good faith, and quickly took the necessary steps to file this Motion and the Response to Respondent’s Motion for Disqualification of Counsel to which this Motion relates.

The three-day delay, lack of prejudice to the Respondent, and lack of any impact on the pending opposition proceedings all weigh in favor of granting this Motion.

WHEREFORE, Petitioner respectfully requests that the Board grant Petitioner's motion for an enlargement of time to file the Response to Respondent's Motion for Disqualification of Counsel, which is filed herewith.

Cobb & Cole

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ATTORNEYS FOR PETITIONER

CERTIFICATE OF MAILING

I HEREBY CERTIFY that on the 15th of February, 2007, the foregoing was deposited with the United States Postal Service with sufficient postage as First-Class Mail in an envelope addressed to:

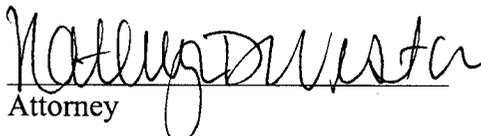
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514


Attorney

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on the 15th of February, 2007, I served a copy of the foregoing by U.S. Mail on the following::

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Attorney

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

BECKER DESIGNS, INC.,

Petitioner,

Opposition No.: 91168610

Application No.: 78512395

v.

BIKER DESIGN, INC.,

Opposition No.: 91174554

Application No.: 78817785

Respondent-Registrant.

**PETITIONER'S RESPONSE TO RESPONDENT'S PETITION TO DISQUALIFY
COUNSEL AND MOTION TO SUSPEND PROCEEDINGS PENDING FINAL
DETERMINATION OF CIVIL LITIGATION OR, ALTERNATIVELY, MOTION TO
REOPEN PETITIONER'S TESTIMONY PERIOD, WITH SUPPORTING BRIEFS**

Petitioner, Becker Designs, Inc., files this response in opposition to Respondent's Petition for Disqualification of Counsel and, pursuant to Trademark Rule 2.117(a) (37 C.F.R. §2.117(a)) and TMBP 510.02(a), moves the Board to enter an Order suspending the above-referenced opposition proceedings pending final determination of a civil action which may be dispositive of or have a bearing on these opposition proceedings, or, alternatively, to reopen for sixty (60) days the period within which Petitioner is to submit testimony to the Board in opposition proceeding No. 91168610.

Response to Respondent's Petition to Disqualify Counsel

On or about January 23, 2007, Respondent filed its Petition to Disqualify Counsel (the "Petition") in the referenced opposition proceedings seeking to disqualify Kathryn D. Weston ("Weston") and the law firm of Cobb & Cole from representing Petitioner in the proceedings. Respondent filed its Supplement to Petition to Disqualify Counsel (the "Supplement") on or about January 24, 2007. The Petition sets forth the argument that Weston's prior representation of Respondent in a sales tax audit is "substantially related" to Weston's current representation of

Petitioner in its opposition to Respondent's trademark application and, therefore, Weston and Cobb & Cole are prohibited from representing Petitioner by Rules Regulating the Florida Bar, Rule 4-1.9 and 37 C.F.R. §10.66. Respondent further argues that Weston and Cobb & Cole have an "informational advantage" that makes it unfair for them to represent Petitioner in this proceeding. Respondent made similar arguments in the pending civil action before the United States District Court for the Middle District of Florida, *Becker Designs, Inc., v. Biker Design, Inc., et al.*, Case No. 6:06-cv-56-Orl-22DAB (the "Civil Litigation"), and the Court disqualified Weston and Cobb & Cole from representing Petitioner in the Civil Litigation.

As the Orders entered in the Civil Litigation make clear, Weston's representation of Petitioner in the federal court proceeding was found to be "substantially related" to Weston's prior representation of Respondent in a sales tax audit due to the fact that Petitioner's damages in the trademark and copyright infringement case would be measured, in part, based on Respondent's sales of infringing merchandise.¹ The "substantial relationship" between the two matters of Weston's representation was that both were, in some way, related to Biker Design's sales.

That "substantial relationship" is not present in these opposition proceedings, in which Respondent's sales are not relevant. The sole legal issues involved in the opposition proceedings are whether the respective trademarks that Respondent seeks to register are entitled to trademark protection and whether there is a likelihood of confusion between the marks applied for and

¹ The Magistrate's Order is attached to the Petition; the District Court Judge's Order is attached to the Supplement. Petitioner's Memorandum of Law in Opposition to Defendants' Motion for Disqualification of Counsel is attached hereto as Exhibit "A." Petitioner's Objections to Magistrate's Order on Defendant's Motion for Disqualification of Counsel for the Plaintiff is attached hereto as Exhibit "B." The legal arguments set forth in Petitioner's pleadings are incorporated by reference as if fully set forth herein.

Petitioner's name and mark. Accordingly, there is no "substantial relationship" between Weston's prior representation of Respondent and Weston's and Cobb & Cole's representation of Petitioner in these opposition proceedings. Further, there is no evidence in the record of the federal court action or presented to the Board that Weston has any informational or other advantage in the opposition proceedings as a result of her prior representation of Respondent. Thus, the reasoning applied by the District Court in disqualification ruling in the Civil Litigation is readily distinguishable from that to be applied in these proceedings.

Rules 4.1-9 and 4.1-10, R.Reg.Fla.Bar, prohibit, in pertinent part, an attorney from representing a person in *the same or a substantially related matter* in which that lawyer had previously represented a client whose interests are materially adverse to that person. In a disqualification case, the focus of the inquiry must be on the precise nature of the relationship between the present and former representations. See, e.g., *Duncan v. Merrill Lynch, Pierce, Fenner & Smith*, 646 F.2d 1020, 1029 (5th Cir. 1981)², disavowed on other grounds, *Gibbs v. Paluk*, 742 F.2d 181 (5th Cir. 1984); *Jackson v. J.C. Penney Co., Inc.*, 521 F.Supp. at 1034. The party seeking the disqualification bears the burden of proving that the present and prior representations are the same or substantially related. *Duncan v. Merrill Lynch, Pierce, Fenner & Smith*, 646 F.2d at 1029. Merely pointing to a superficial resemblance between the present and prior representations cannot substitute for the careful comparison demanded by the rules. See, e.g., *Id.*; *Jackson v. J.C. Penney Co., Inc.*, 521 F.Supp. at 1034.

²Although the ABA Code of Professional Responsibility was applicable in *Merrill Lynch* pursuant to the Local Rules of the United States District Court for the Southern District of Florida, the Court's analysis involved interpreting the "substantial relationship" language of the applicable provisions of the ABA Code.

Respondent has failed to establish any real relationship, let alone a substantial relationship, between Weston's prior representation of Respondent and Weston's and Cobb & Cole's representation of Petitioner in the opposition proceedings. Weston's prior representation of Respondent pertained to a sales tax audit; Weston's and Cobb & Cole's representation of Petitioner pertains to opposing trademark applications that are likely to cause confusion with Petitioner's name and mark. Respondent has failed to meet its burden of proof and is not entitled to the disqualification of Weston and Cobb & Cole.

Motions for disqualification of counsel should be scrutinized strongly, because they are often used for strategic purposes. See, e.g., *Somascan Plaza, Inc. v. Siemens Medical Systems, Inc.*, 187 F.R.D. 34, *37 (D. P.R. 1999); *Smith v. Whatcott*, 757 F.2s 1098, 1099-1100 (10th Cir. 1985); *International Electronics Corp. v. Flanzer*, 527 F.2d 1288, 1289 (2d Cir. 1975). Further, disqualifying a party's chosen attorney is a serious matter which cannot be supported by the mere possibility of a conflict. See, e.g., *Somascan Plaza*, 187 at *37; *Richmond Hilton Assoc. v. City of Richmond*, 690 F.2d 1086, 1089 (4th Cir. 1982).

Motion to Suspend Proceedings Pending Final Determination of Civil Litigation

The Civil Litigation is currently scheduled for trial in July 2007. A copy of the docket for the Civil Litigation is attached hereto as Exhibit "C." Becker is a party to the opposition proceedings and the Civil Litigation. Ergun Recel and Nir Giist are the shareholders and officers of Biker Design, Inc. ("Biker") and are defendants in the Civil Litigation. Lisa Oonk and the firm of Litchfield Cavo are counsel for Respondent in the opposition proceedings and are counsel for Biker, Recel, and Giist in the Civil Litigation. Thus, there are common parties of interest between the Civil Litigation and the opposition proceedings.

The Civil Litigation includes claims by Becker that Biker's use of the mark *Biker Design*

infringes upon Becker's mark, *Becker Designs*. The opposition proceedings similarly involve Becker's opposition to Biker's attempts to register the *Biker Design* mark, based on the likelihood of confusion with the *Becker Designs* mark. The claims and issues in the Civil Litigation involve issues in common with those raised in the opposition proceedings. A decision by the Federal Court in the Civil Litigation could be binding on the Board, while the Board's decision in the opposition proceedings would not be binding on the Federal Court but would be merely advisory in nature. See, e.g., *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D. Minn. 1986).

It is in the best interests of all parties to suspend the subject opposition proceedings pending a final determination of the Civil Litigation, which is set for trial in July 2007. A final determination in the Civil Litigation would be dispositive of and, binding on all issues before the Board in the opposition proceedings. Suspending these proceedings will conserve the time and resources of the Board and will avoid an unnecessary and duplicative expenditure of time and resources by the parties in each proceeding.

Alternative Motion to Reopen Petitioner's Testimony Period

Should the Board deny Petitioner's Motion to Suspend Proceedings Pending Final Determination of Civil Litigation, Petitioner alternatively, moves the Board to Reopen Petitioner's Testimony Period.

Both Petitioner and Respondent conducted extensive discovery in the Civil Litigation, which, by agreement between the undersigned and Respondent's former counsel, was deemed to have occurred in Opposition Proceeding No. 91168610. Discovery closed on October 4, 2006, and the thirty-day testimony period for the Petitioner in Opposition Proceeding No. 91168610 expired January 2, 2007. No deadlines have yet been established by the Board in Opposition Proceeding No. 91174554. Both opposition proceedings are currently stayed pending resolution of the Petition.

As discussed above, Respondent filed its Motion to Disqualify Counsel in the Civil Litigation on October 13, 2006. On October 24, 2006, Petitioner filed its Memorandum of Law in Opposition to Respondent's Motion to Disqualify Counsel. The Magistrate Judge granted the Motion to Disqualify on December 13, 2006, and the District Court Judge affirmed that determination on January 24, 2007.

During the period of time after the Magistrate Judge's Order was issued on December 13, 2006, and before the District Court Judge affirmed the determination on January 24, 2007, the undersigned was unsure whether it was permitted by the applicable ethical rules to act as counsel for Petitioner in any regard in the related opposition proceedings other than to file Opposition No. 91174554 to preserve Petitioner's rights in that matter. Petitioner filed an unopposed motion to stay the Civil Litigation reflecting the parties' mutual uncertainty as to how to proceed in the case, including the handling of outstanding discovery requests and motions to compel discovery, prior to a ruling by the District Court Judge and agreement to postpone on taking any action in these matters until such ruling was issued. A copy of this motion is attached hereto as Exhibit "D." Petitioner did not, however, to file a corresponding motion in these opposition proceedings.

On or about January 31, 2007, at the request of the Petitioner, the undersigned sent all of the firm's files to Petitioner's new counsel in the Civil Litigation, including the Petitions to Disqualify Counsel, expecting that Petitioner's new counsel would be assuming all aspects of Cobb & Cole's representation of Petitioner. On or about February 12, 2007, the undersigned was advised by Petitioner's new counsel in the Civil Litigation that he would not be representing Petitioner in the opposition proceedings. On or about February 13, 2007, past the deadline for filing a response to the Petition, the undersigned received back the files related to the opposition proceedings from

Petitioner's new counsel in the Civil Litigation.

Pursuant to Fed.R.Civ.P. 6(b), made applicable to Board proceedings by 37 C.F.R. §2.116(a), a party may file a motion for an enlargement of time in which an act is required or allowed to be done. If the motion is filed after the expiration of the period as originally set or previously extended, the motion is a motion to reopen, and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. See, e.g., *Fairline Boats plc v. New Howmar Boats Corp.*, 59 USPQ2d 1479, 1480 (TTAB 2000). The excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Pioneer Investment Services Company v. Brunswick Associates Ltd. Partnership*, 507 U.S. 380 (1993), adopted by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

The "prejudice to the nonmovant" contemplated under the first *Pioneer* factor must be more than mere inconvenience and delay caused by the movant's previous failure to take timely action, and more than the nonmovant's loss of any tactical advantage which it otherwise would enjoy as a result of the movant's delay or omission. Rather, "prejudice to the nonmovant" is prejudice to the nonmovant's ability to litigate the case, e.g., where the movant's delay has resulted in a loss or unavailability of evidence or witnesses which otherwise would have been available to the nonmovant. *Pumpkin*, 43 USPQ2d at 1587 (citations omitted). Petitioner requests that the testimony period be reopened for sixty (60) days. While this will certainly result in a delay of the opposition proceedings, this will not result in prejudice to the Respondent, as it has no effect on Respondent's

ability to litigate the opposition proceedings. Similarly, the reopening of the testimony period for sixty (60) days will delay but not adversely affect the opposition proceedings, as considered in the second *Pioneer* factor. Indeed, Respondent's agreement to holding the proceedings in abeyance for an indeterminate period of time (i.e., until the Court ruled on the pending objections) is evidenced in Exhibit "D."

The ability to file a motion to stay the opposition proceedings was arguably within the control of the undersigned, but the undersigned was uncertain as to whether it was permitted to file such motion. Excusable negligent "is a somewhat 'elastic concept' and is not limited strictly to omissions caused by circumstances beyond the control of the movant." *Pioneer*, 507 U.S. at 391-92.

Petitioner has, at all times, acted in good faith, and, as noted above, quickly took the necessary steps to file this Motion upon receiving the file back from Petitioner's new counsel in the Civil Litigation.

The determination of excusable neglect" is "at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission." *Pioneer*, 507 U.S. ta 395. Petitioner has demonstrated the existence of excusable neglect. The relatively short delay, lack of prejudice to the Respondent, and lack of any adverse impact on the pending opposition proceedings all weigh in favor of granting this motion to reopen Petitioner's testimony period for sixty (60) days.

WHEREFORE, Petitioner respectfully requests that the Board deny Respondent's Petition for Disqualification of Counsel, grant Petitioner's Motion to Suspend Proceedings Pending Final Determination of Civil Litigation or, alternatively, grant Petitioner's Motion to Reopen Petitioner's Testimony Period, and grant such further relief as is deemed just and proper.

Cobb & Cole

By: 

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ATTORNEYS FOR PETITIONER

CERTIFICATE OF MAILING

I HEREBY CERTIFY that on the 15th of February, 2007, the foregoing was deposited with the United States Postal Service with sufficient postage as First-Class Mail in an envelope addressed to:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514


Attorney

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on the 15th of February, 2007, I served a copy of the foregoing by U.S. Mail on the following::

Lisa A. Oonk, Esquire
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Tampa, FL 33609


Attorney

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

BECKER DESIGNS, INC.,

Plaintiff/Counterdefendant,

v.

Case No. 6:06-cv-56-Orl-22DAB

BIKER DESIGN, INC.; ERGUN RECEL;
and NIR GIIST,

Defendants/Counterplaintiffs.

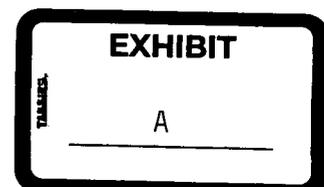
**PLAINTIFF'S MEMORANDUM OF LAW IN OPPOSITION TO DEFENDANTS'
MOTION FOR DISQUALIFICATION OF COUNSEL**

Pursuant to Local Rule 3.01, plaintiff submits this memorandum of law in opposition to defendants' Motion to Disqualify Counsel and Memorandum in Support.

Facts

This matter involves claims by plaintiff, BECKER DESIGNS, INC. ("Becker"), against defendants, BIKER DESIGN, INC. ("Biker"), ERGUN RECEL ("Recel"), and NIR GIIST ("Giist") for federal and state trademark and copyright infringement and violations of the Florida Deceptive and Unfair Trade Practices Act. Biker has brought a counterclaim against Becker for tortious interference with business or contractual relations based on cease and desist letters sent by counsel for Becker to potential customers of Biker advising those customers of the claims by Becker against Biker.

Becker first became aware of the defendants' conduct giving rise to this suit in April 2005 and sent cease and desist letters to the defendants and others shortly thereafter. This suit was initiated in January 2006 after the defendants' activities continued and the parties were unable to resolve the



dispute.

Kathryn D. Weston ("Weston") joined the law firm of Cobb & Cole as an associate in March 2006. Weston, ¶¶2-3.¹ Weston had previously been employed as an associate at Smith, Hood, Perkins, Loucks, Stout, Bigman, Lane & Brock, P.A. ("SHP") from June 2004 to February 2006, where one of the matters assigned to her was a sales tax audit of Biker. Weston, ¶4.

To the best of her recollection, a Florida sales tax auditor inspected, at the office of SHP, two binders of documents provided by Biker. Weston, ¶5. Weston does not recall reviewing the documents and has no recollection of the types of documents, the categories of documents, or any specific documents that were included in the binders. Weston, ¶5.

Weston passed along the auditor's requests for additional information to Biker and to Biker's accountant. Weston, ¶6. Weston recalls one meeting with Recel and with Biker's accountant, Mark Topol, but has no recollection of the substance of that meeting. Weston, ¶5. Biker's accountant handled any and all follow-up with the sales tax auditor.

Weston has no recollection of the specific issues involved in the sales tax audit, if any. Weston, ¶7.

Weston has no recollection of any facts whatsoever pertaining to Biker's business other than general available information, such as the fact that Biker is engaged in selling motorcycle-themed apparel. Weston, ¶5.

When Weston joined Cobb & Cole in March 2006, she was asked to participate in this case. Weston, ¶8. At that time, Weston conducted the analysis similar to that set forth in this

¹References to paragraphs contained in the Declaration of Kathryn D. Weston filed with this memorandum as Exhibit "A" are shown as "Weston, ¶__".

memorandum and determined that there was no conflict that would prevent her from assisting on the case. Weston, ¶8. Weston's notice of appearance in this case was filed shortly thereafter in March 2006. Any knowledge of Biker's business that Weston currently possesses was derived exclusively from her participation in this case. Weston, ¶8.

Although Weston had been involved with this case for many months, defendants claim to have first become aware of this potential conflict immediately prior to Weston's taking the videotaped deposition of Recel on August 22, 2006. At that time, counsel for the defendants advised that Recel thought he had recognized Weston as an attorney that had represented Biker in the past. Weston, ¶8. Weston advised defendants' counsel that she had represented Biker with regard to a sales tax audit during her employment at SHP. Weston, ¶10. Counsel for the defendants then privately conferred with Recel for several minutes. Weston, ¶11. Upon reentering the room, Weston asked Recel and his attorney whether either had any questions or concerns. Weston, ¶11. Neither Recel nor his attorney indicated that they had any questions or concerns, and they proceeded with the videotaped deposition. On August 28, 2006, Weston took the videotaped deposition of Giist. Weston, ¶12. The potential conflict was not mentioned or raised at that time. Weston, ¶12.

The defendants filed this motion to disqualify issue nearly two months after purportedly becoming aware of Weston's representation of Becker in this case and seven months after being put on notice of Weston's involvement in the case.

Analysis

The professional conduct of members of the Bar of the Middle District is governed by the Model Rules of Professional Conduct of the American Bar Association, as modified and adopted by the Supreme Court of Florida. United States District Court, M.D.Fla.Loc.R. 2.04(c); *Brotherhood*

Mutual Insurance Co. v. National Presto Industries, Inc., 846 F.Supp. 57, 59 (M.D. Fla. 1994). Rule 4.1-10(b), R.Reg.Fla.Bar, applies when an attorney moves from one firm to another. See *Nissan Motor Corp. in U.S.A. v. Orozco*, 595 So.2d 240 (Fla. 4th DCA), rev. denied, 605 So.2d 1265 (1992).

Rule 4.1-10 provides:

When a lawyer becomes associated with a firm, the firm may not knowingly represent a person in the same or a substantially related matter in which that lawyer, or a firm with which the lawyer was associated, had previously represented a client whose interests are materially adverse to that person and about whom the lawyer had acquired information protected by rules 4-1.6 and 4-1.9(b) that is material to the matter.

In applying Rule 4.1-10, the burden of proof does not lie entirely with either party. First, the moving party must establish a prima facie case for disqualification by showing that the newly associated lawyer acquired confidential information during his prior representation of the client *in the same or a substantially related case*. See, e.g., *Akrey v. Kindred Nursing Centers East, L.L.C.*, 837 So.2d 1142, 1144 (Fla. 2d DCA 2003) (citing *Scott v. Higginbotham*, 834 So.2d 221 (Fla. 2d DCA 2002); *Gaton v. Health Coalition, Inc.*, 745 So.2d 510 (Fla. 3d DCA 1999); *Koulisis v. Rivers*, 730 So.2d 289 (Fla. 4th DCA 1999)) (emphasis added). If the moving party carries that burden, then the attorney or law firm sought to be disqualified must show that the attorney has no actual knowledge of any confidential information material to the case. *Id.*

Same or Substantially Similar Matter

As a threshold issues, Rule 4.1-10 prohibits an attorney from representing an adversary of a former client only in the same matter or a substantially related matter. The Comment to Rule 4-1.9 provides the following guidance with regard to the meaning of “substantially related matter” as referenced in Rule 4-1.10:

Matters are “substantially related” for the purposes of Rule 4-1.9 if they involve the

same transaction or legal dispute, or if the current matter would involve the lawyer attacking work that the lawyer performed for the former client. For example, a lawyer who has previously represented a client in securing environmental permits to build a shopping center would be precluded from representing neighbors seeking to oppose rezoning of the property on the basis of environmental considerations; however, the lawyer would not be precluded, on the grounds of substantial relationship, from defending a tenant of the completed shopping center in resisting eviction for nonpayment of rent.

The Middle District has previously explained that “substantially related” matters are those “akin to the present action in a way reasonable persons would understand as important to the issues involved.” See *McPartland v. ISI Investment Services, Inc.*, 890 F.Supp. 1029, 1031 (M.D. Fla. 1995). This matter involves allegations of trademark and copyright infringement by Biker with regard to the “Biker Design” mark and a copyrighted design comprised of a distinctive pattern of skulls and barbed wire. Weston’s prior representation of Biker involved a Florida sales tax audit. These matters are not even remotely, let alone substantially, related.

Rather than focus on the actual facts of Weston’s prior representation, defendants have attempted to analogize the facts of the prior representation at issue in *Snapping Shoals Elec. Membership Corp. v. RLI Insu. Corp.*, 2006 WL 1877078 (N.D. Ga. 2006), which involved a corporate tax restructuring, with Weston’s limited prior representation of Biker in a sales tax audit. The nature of legal representation involved in a corporate tax restructuring is not comparable to the legal representation involved in a sales tax audit. Further, the actual facts of Weston’s prior representation of Biker must be examined, not some hypothetical facts involved in another case. A court “must look behind mere facial similarities or dissimilarities between the prior and pending cases and focus on the precise nature of the subject matters presented in the two representations. See, e.g., *Herrera-Shorthouse v. La Cubana Bail Bonds, Inc.*, 1999 WL 33266031, *3 (S.D. Fla.

1999) (citing *Smalley Transportation Co. v. Prime Computer, Inc.*, 137 F.R.D. 397, 399 (M.D. Fla. 1991)).

The defendants have further claimed that, because Weston asked questions of Recel and Giist pertaining to “record-keeping, inventory, file retention, decision-making process and employees’ responsibilities and scope of knowledge of information,” such topics were therefore an “issue” in this litigation. These topics of questioning are nearly universally explored in litigation involving business entities. The answers to such questions merely allow a questioning attorney to ascertain the whereabouts of documents or witnesses that can substantiate or refute a deponent’s testimony. To assert that an “issue” requiring disqualification is created where an attorney poses questions involving basis discovery, is to assert that all commercial litigation is “substantially related” to all other commercial litigation.

Weston’s prior representation of Biker was limited in scope and duration. A Florida sales tax auditor inspected, at the office of SHP, two binders of documents provided by Biker. Weston passed along the auditor’s requests for additional information to Biker and to Biker’s accountant. Weston has no recollection of the documents or of any facts whatsoever pertaining to Biker’s business other than general available information.

Weston’s representation of Becker in this matter does not “involve the lawyer attacking work that the lawyer performed for the former client.” Further, Biker’s sales tax audit is not “akin to the present action in a way reasonable persons would understand as important to the issues involved.” Biker has failed to establish that these matters are “substantially related,” and Weston’s representation of Becker is not prohibited in this case.

Protected Client Information

A lawyer may not represent a client directly adverse to a former client in the same or a substantially related matter if the lawyer acquired information about the former client protected by Rules 4-1.6 and 4-1.9(b) that is material to the current matter. R.Reg.Fla.Bar, Rule 4-1.10. Rule 4-1.6(a) states the general rule that a “lawyer shall not reveal information relating to representation of a client,” subject to the exceptions set forth in the rule. Rule 4-1.9(b) provides that a lawyer who formerly represented a client shall not thereafter “use information relating to the representation to the disadvantage of the former client except as rule 4-1.6 would permit ... or when the information has become generally known.”

Rule 4-1.10(b) will “operate to disqualify the firm only when the lawyer involved has actual knowledge of information protected by rules 4-1.6 and 4-1.9(b).” R.Reg.Fla.Bar, Rule 4-1.10 cmt. Weston has no recollection of any facts whatsoever pertaining to Biker’s business other than generally available information, such as the fact that Biker is engaged in selling motorcycle-themed apparel. Any knowledge of Biker’s business that Weston currently possesses was derived by her participation in discovery in this case, rather than her prior representation of Biker. Weston has no actual knowledge of information protected by Rules 4-1.6 and 4-1.9(b) that is material to the current matter.

The current matter is not the same or substantially related to the matter in which Weston previously represented Biker, and Weston has no actual knowledge of any confidential information material to the case. Accordingly, Cobb & Cole’s representation of Biker is not prohibited by Rule 4-1.10.

Evidentiary Hearing Required if Material Facts are in Dispute

When an attorney’s disqualification is at issue and material facts are in dispute, an evidentiary

hearing is required. See, e.g., *Simon DeBartolo Group, Inc., v. Bratley*, 741 So.2d 1254, 1255 (Fla. 1st DCA 1999) (citing *Boca Investors Group, Inc. v. Potash*, 728 So.2d 825 (Fla. 3d DCA 1999); *School Board of Broward Co. v. Polera Building Corp.*, 722 So.2d 971 (Fla. 4th DCA 1999)). Accordingly, if this Court determines that there are material facts in dispute, plaintiff respectfully requests that an evidentiary hearing be held.

WHEREFORE, plaintiff respectfully requests that this Court deny defendants' Motion to Disqualify Counsel and grant such further relief as the Court deems just and proper.

Cobb & Cole

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ATTORNEYS FOR PLAINTIFF and
COUNTER-DEFENDANT.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on the 24th day of October, 2006, I served the foregoing by electronically filing it with the CM/ECF system, which will deliver electronic notification to the following:

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Attorney and Trial Counsel for Defendants and
Third-Party Plaintiffs

/s/ Bruce A. Hanna
Attorney

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

BECKER DESIGNS, INC.,

Plaintiff/Counterdefendant,

v.

Case No. 6:06-cv-56-Orl-22DAB

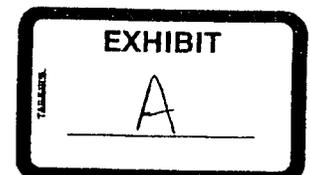
BIKER DESIGN, INC.; ERGUN RECEL;
and NIR GIIST,

Defendants/Counterplaintiffs.

**DECLARATION OF KATHRYN D. WESTON IN SUPPORT OF MEMORANDUM IN
OPPOSITION TO MOTION TO DISQUALIFY COUNSEL**

BEFORE ME, personally appeared Kathryn D. Weston, who after being first duly sworn,
stated as follows:

1. All statements made herein are based upon of my personal knowledge.
2. I am employed by Cobb & Cole, P.A. ("Cobb & Cole") as an Associate Attorney.
3. I joined Cobb & Cole in March 2006, after previously working at Smith, Hood, Perkins, Loucks, Stout, Bigman, Lane & Brock, P.A. ("SHP") from June 2004 through February 2006.
4. At SHP, I was responsible for 90 to 115 pending matters at any one time. One of the matters assigned to me at SHP was a sales tax audit of Biker Design, Inc. ("Biker"). I do not recall when, during that 22 month period, I worked on the Biker sales tax audit.
5. As best I can recall, a Florida sales tax auditor inspected, at my office, two binders of documents provided by Biker. Biker dropped off the documents at my office the morning that the auditor arrived. I do not recall reviewing all of the documents and have no recollection of the types



of documents, the categories of documents, or any specific documents that were included in the binders. I recall having one meeting with ERGUN RECEL ("Recel"), shareholder and President of Biker, and with Biker's accountant, Mark Topol, but I have no recollection of the substance of that meeting. I have no recollection of any facts whatsoever pertaining to Biker's business other than generally available information, such as the fact that Biker is engaged in selling motorcycle-themed apparel.

6. I passed along the auditor's request for additional information to Biker and to Biker's accountant. Biker's accountant handled any follow-up with the sales tax auditor.

7. I have no recollection of the specific issues or concerns, if any, involved in the sales tax audit.

8. When I was asked to participate in this case in March 2006, I conducted the analysis similar to that set forth in the memorandum in opposition to Biker's motion for disqualification and determined that there was no conflict that would prevent me from assisting on this case. Any knowledge of Biker's business that I currently possess is solely as a result of participating in discovery in this case.

9. I filed a notice of appearance in this case in March 2006, and my name has been included on all pleadings since that time.

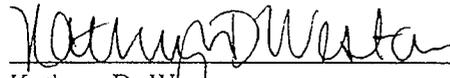
10. Immediately prior to my taking the deposition of Recel on August 22, 2006, counsel for the defendants advised me that her client thought he recognized me as an attorney that had represented Biker in the past. I advised defendants' counsel that I had represented Biker with regard to a sales tax audit at my prior firm.

11. Counsel for the defendants then conferred privately with Recel for several minutes. Upon their reentering the room, I asked if either had any questions or concerns. Neither Recel nor his attorney indicated that they had any questions or concerns and we proceeded with the deposition.

12. On August 28, 2006, the defendants did not raise the potential conflict and I took the videotaped deposition of NIR GIIST ("Giist").

13. The defendants or their counsel first raised the issue of a conflict of interest with respect to my representation of Becker Designs, Inc., in this case immediately prior to filing their motion for disqualification on October 13, 2006.

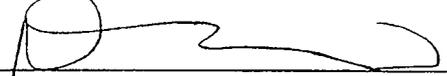
FURTHER AFFIANT SAYETH NOT.


Kathryn D. Weston

STATE OF FLORIDA
COUNTY OF VOLUSIA

The foregoing instrument was acknowledged before me this 24th day of October, 2006, by Kathryn D. Weston, who is personally known to me or has produced n/a as identification.

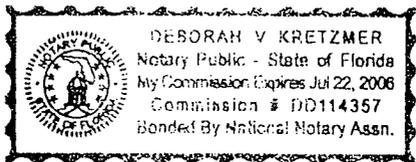
NOTARY PUBLIC:

Sign: 

Print: _____

State of _____ At Large

(Seal)



My Commission Expires:

Title/Rank:

Commission Number:

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

BECKER DESIGNS, INC.,

Plaintiff/Counterdefendant,

v.

Case No. 6:06-cv-56-Orl-22DAB

BIKER DESIGN, INC.; ERGUN RECEL;
and NIR GIIST,

Defendants/Counterplaintiffs.

**PLAINTIFF'S OBJECTIONS TO MAGISTRATE'S ORDER
ON DEFENDANT'S MOTION FOR DISQUALIFICATION
OF COUNSEL FOR THE PLAINTIFF**

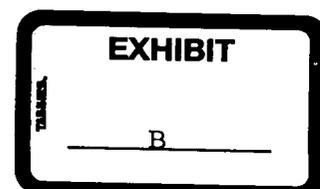
Pursuant to Fed.R.Civ.P. 72(a), plaintiff, BECKER DESIGNS, INC. ("Becker"), objects to the Magistrate's Order granting defendants' motion to disqualify counsel for the plaintiff (Dkt.57) (the "Order") and states as follows:

Procedural Status

On October 13, 2006, defendants filed their Motion for Disqualification of Counsel (Dkt. 47) with a supporting affidavit of defendant, ERGUN RECEL ("Recel") (Dkt. 48-2) seeking to disqualify counsel for the plaintiff (the "Motion") due to an alleged conflict of interest. On October 24, 2006, Becker filed Plaintiff's Memorandum of Law in Opposition to Defendants' Motion for Disqualification of Counsel (Dkt. 51) with a supporting affidavit of one of plaintiff's counsel, Kathryn D. Weston ("Weston"). On December 13, 2006, the Magistrate Judge issued the Order granting the Motion, giving plaintiff fourteen (14) days to find new counsel. (Dkt. 57).

Statement of Facts

This matter involves claims by Becker against defendants, BIKER DESIGN, INC. ("Biker"),



Recel, and NIR GIIST (“Giist”) for federal and state trademark and copyright infringement and violations of the Florida Deceptive and Unfair Trade Practices Act. This suit was initiated in January 2006.

Weston joined the law firm of Cobb & Cole as an associate in March 2006. Weston, ¶¶2-3.¹ Weston had previously been employed as an associate at Smith, Hood, Perkins, Loucks, Stout, Bigman, Lane & Brock, P.A. (“SHP”) from June 2004 to February 2006, where she briefly represented Biker in a sales tax audit. Weston, ¶4. Weston’s representation of Biker consisted of allowing a Florida sales tax auditor to inspect, at the office of SHP, two binders of documents provided by Biker; passing along the auditor’s requests for additional information to Biker and Biker’s accountant; and meeting once with Recel and Biker’s accountant. Weston, ¶¶5, 6. Weston does not recall reviewing the two binders of documents provided to the sales tax auditor. Weston, ¶5. Biker’s accountant, rather than Weston, handled any and all follow-up with the sales tax auditor. Weston, ¶6.

Weston joined the law firm of Cobb & Cole and filed a notice of appearance in this case in March 2006. The affidavit of Recel submitted by the defendants offers no testimony regarding when the defendants became aware of the potential conflict and does not dispute that the defendants have been aware of the potential conflict since March 2006 when Weston’s notice of appearance was filed.

Immediately prior to Weston’s taking the videotaped deposition of Recel on August 22, 2006, Weston discussed her prior representation with current counsel for the defendants, who then

¹References to paragraphs contained in the Declaration of Kathryn D. Weston filed with Plaintiff’s Memorandum of Law in Opposition to Defendants’ Motion for Disqualification of Counsel as Exhibit “A” are shown as “Weston, ¶__”.

privately conferred with Recel for several minutes. Weston, ¶¶8, 10-11. Weston then asked Recel and his attorney whether either had any questions or concerns. Weston, ¶11. Neither Recel nor his attorney indicated that they had any questions or concerns, and they proceeded with Weston taking the videotaped deposition of Recel. Six days later, on August 28, 2006, Weston took the videotaped deposition of Giist. Weston, ¶12. None of the defendants raised the issue of the potential conflict prior to Weston's taking Giist's deposition the following week. Weston, ¶12.

The defendants filed this motion to disqualify issue seven months after being put on notice of Weston's representation of Becker.

Legal Argument and Assignment of Errors

The professional conduct of members of the Bar of the Middle District is governed by the Model Rules of Professional Conduct of the American Bar Association, as modified and adopted by the Supreme Court of Florida. United States District Court, M.D.Fla.Loc.R. 2.04©; *Brotherhood Mutual Insurance Co. v. National Presto Industries, Inc.*, 846 F.Supp. 57, 59 (M.D. Fla. 1994). Rules 4.1-9 and 4.1-10, R. Regulating Fla. Bar, are applicable to the alleged conflict of interest in this case.

Rule 4.1-9, which applies to an individual attorney with regard to his former clients, provides as follows:

A lawyer who has formerly represented a client in a matter shall not thereafter:

(a) represent another person in *the same or a substantially related matter* in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent; or

(b) use information relating to the representation to the disadvantage of the former client except as rule 4-1.6 would permit with respect to a client or when the

information has become generally known.

(emphasis added). Rule 4.1-10, which applies to a law firm with regard to former clients of a newly associated attorney, provides:

When a lawyer becomes associated with a firm, the firm may not knowingly represent a person in *the same or a substantially related matter* in which that lawyer, or a firm with which the lawyer was associated, had previously represented a client whose interests are materially adverse to that person and about whom the lawyer had acquired information protected by rules 4-1.6 and 4-1.9(b) that is material to the matter.

(emphasis added).

Becker's interest in this case is clearly materially adverse to Biker. Weston's prior representation of Biker raises an irrefutable presumption that Weston acquired confidential client information. See, e.g., *Sears, Roebuck & Co. v. Stansbury*, 374 So.2d 1051, 1053 (Fla. 3d DCA 1979). The defendants have not argued that Weston previously represented Biker in the same matter. Accordingly, the primary issue for determination is whether Weston previously represented Biker in a "substantially related matter." The Magistrate's Order failed to properly analyze the "substantially related" requirement of Rules 4.1-9 and 4.1-10 and incorrectly concluded that Weston's prior representation of Biker in a sales tax audit was "substantially related" to Weston's current representation, two years later, of Becker in this trademark and copyright case.

Before addressing the substantive issue, this Court must first determine whether the defendants have waived the potential conflict of interest by waiting seven-months to file the motion to disqualify Weston. The Magistrate's Order failed to address the defendants' waiver of their rights to raise the issue of the potential conflict.

I. The defendants' delay in objecting to the alleged conflict waived the defendants' rights to thereafter object to the alleged conflict.

The rule of disqualification of counsel is not to be mechanically applied. *Jackson v. J.C. Penney Co., Inc.*, 521 F.Supp. 1032, 1034 (N.D. Ga. 1981) (citing *Brennan's, Inc. v. Brennan's Restaurants, Inc.*, 590 F.2d 168 (5th Cir. 1979)). Disqualification must be tempered by the need to balance a variety of considerations and complex concepts to arrive at an equitable solution, for this is an equitable, not legal matter. *Id.* (citing *American Can Co. v. Citrus Feed Co.*, 436 F.2d 1125 (5th Cir. 1971)). Before reaching the merits of a motion for disqualification, the court must first determine whether the moving party has waived its right to obtain disqualification because of its delay in raising the issue. *Id.*

A motion to disqualify should be made with reasonable promptness after the party discovers the facts which lead to the motion. *Transmark, U.S.A., Inc. v. State, Dept' of Insur.*, 631 So.2d 1112, 1116 (Fla. 1st DCA), *rev. denied*, 639 So.2d 983 (Fla. 1994); *Balda v. Sorchych*, 616 So.2d 1114, 1116 (Fla. 5th DCA 1993); *Cox v. American Cast Iron Pipe Co.*, 847 F.2d 725 (11th Cir. 1988); *Glover v. Libman*, 578 F.Supp. 748 (N.D. Ga. 1983); *Jackson v. J.C. Penney Co., Inc.*, 521 F.Supp. at 1034; *Case v. City of Miami*, 756 So.2d 259, 260-61 (Fla. 3d DCA 2000). The rationale for this rule is to prevent a litigant from using the motion for disqualification as a tool to deprive his opponent of counsel of his choice after substantial preparation of the case has been completed. *Transmark*, 631 So.2d at 1116; *Cox v. American Cast Iron Pipe Co.*, 847 F.2d at 729; *Case v. City of Miami*, 756 So.2d at 261.

In this case, defendants delayed filing their motion for disqualification seven months after first being put on notice of Weston's representation of the plaintiff and two months after Weston discussed the potential conflict with counsel for the defendants in the presence of the defendants.

A seven-month delay does not constitute “reasonable promptness” in filing a motion for disqualification. Further, the disqualification of plaintiff’s counsel would result in serious injustice to the plaintiff’s case. During the defendants’ seven-month delay in bringing the motion for disqualification, the plaintiff has, as required by this Court’s scheduling order, actively engaged in discovery, retained an expert witness, and worked with that expert witness to develop his initial expert report and supplemental expert report. As a result of defendants’ delay, it would take a new attorney significantly more time to become familiar with this very complex case at this point in time than it would have taken him or her to do so seven months ago. In addition, discovery closes in this case in a few weeks, and the parties have yet to depose the other’s expert witness.

Defendants strategically waited until just prior to the close of discovery and one week prior to the expert disclosure deadlines to attempt to disqualify Weston and Cobb & Cole. The defendants are using disqualification in this case as a tool to deprive Becker of its counsel of choice after substantial preparation of the case has been completed, as the courts have frequently warned of. Accordingly, defendants should be deemed to have waived their rights to attempt to disqualify Weston and Cobb & Cole.

II. The Magistrate failed to properly analyze “the same or a substantially related matter” standard of Rules 4.1-9 and 4.1-10, R. Regulating Fla. Bar.

Rules 4.1-9 and 4.1-10, R. Regulating Fla. Bar, prohibit, in pertinent part, an attorney from representing a person in *the same or a substantially related matter* in which that lawyer had previously represented a client whose interests are materially adverse to that person. Weston’s prior representation of Biker pertained to a sales tax audit; Weston’s and Cobb & Cole’s current representation of Becker pertains to a trademark and copyright case. The Magistrate summarized the evidence submitted by the defendants in Recel’s affidavit, as follows:

Recel provided Weston "with information and documents regarding Biker Design's finances, vendors, business contacts, customers and revenues." Recel claims Weston "gained knowledge of confidential information."

Order, p. 2 (citations omitted). The Magistrate made no findings of fact as to the legal issues involved in the instant case, but noted that, in Recel's deposition, "Weston inquired regarding the corporate structure and employees, dividends and loans the corporation may have made, and salient details regarding the corporation's record-keeping, books and sales." Order, p. 4

The Magistrate then analyzed these facts as follows:

Weston received confidential and comprehensive information on Biker's internal business operations. Those business operations are at issue in this suit. As such, Weston and her firm have the kind of informational advantage prohibited in the rules. Disqualification is appropriate.

Order, p. 7. Although the Magistrate's factual conclusions may have been correct, the legal conclusion is incorrect.

The Comment to Rule 4-1.9 explains that "matters are 'substantially related' for purposes of this rule if they involve the same transaction or legal dispute, or if the current matter would involve the lawyer attacking work that the lawyer performed for the former client." The Comment sets forth the following examples:

For example, a lawyer who has previously represented a client in securing environmental permits to build a shopping center would be precluded from representing neighbors seeking to oppose rezoning of the property on the basis of environmental considerations; however, the lawyer would not be precluded, on the grounds of substantial relationship, from defending a tenant of the completed shopping center in resisting eviction for nonpayment of rent.

This case presents the same tangential, but not "substantially related", connection as that of the lawyer in the example currently representing the tenant against the prior landlord client.

In a disqualification case, the focus of the district court's inquiry must be on the precise

nature of the relationship between the present and former representations. See, e.g., *Duncan v. Merrill Lynch, Pierce, Fenner & Smith*, 646 F.2d 1020, 1029 (5th Cir. 1981)², disavowed on other grounds, *Gibbs v. Paluk*, 742 F.2d 181 (5th Cir. 1984); *Jackson v. J.C. Penney Co., Inc.*, 521 F.Supp. at 1034. The moving party bears the burden of proving that the present and prior representations are the same or substantially related. *Duncan v. Merrill Lynch, Pierce, Fenner & Smith*, 646 F.2d at 1029. Merely pointing to a superficial resemblance between the present and prior representations cannot substitute for the careful comparison demanded by the rules. See, e.g., *Id.*; *Jackson v. J.C. Penney Co., Inc.*, 521 F.Supp. at 1034.

The defendants have failed to establish a substantial relationship, between Weston's representation of Biker in a sales tax audit and Weston's and Cobb & Cole's representation, two years later, of Becker in a trademark and copyright infringement suit. Recel's vague claim that "Weston gained knowledge of confidential information" is the type of general allegation that "offers little assistance to a court attempting to ferret out the degree of similarity, if any, between the former representation and the pending case" identified by the Court in *Merrill Lynch*. Recel's other claims about the types of information provided to Weston are applicable only to the "acquisition of confidential information" portions of Rules 4.1-9 and 4.1-10 and not to the "substantially related" portions of those rules.

The only real analysis of the "substantially related" test appears in the Magistrate's discussion on page 9 of the Order of Biker's sales. Certainly, as stated by the Magistrate, Biker's sales are an

²Although the ABA Code of Professional Responsibility was applicable in *Merrill Lynch* pursuant to the Local Rules of the United States District Court for the Southern District of Florida, the Court's analysis involved interpreting the "substantial relationship" language of the applicable provisions of the ABA Code.

issue in the current case. The sales that are at issue in the current case, however, are Biker's alleged sales of apparel that infringe the trademarks and copyrights owned by Becker. The defendants have presented no evidence that the infringing sales were an issue in the sales tax audit or that sales were even categorized in such manner in the sales tax audit. Any assumption to the contrary is not supported by the record and runs afoul of the rules that the burden for establishing disqualification is on the party seeking the disqualification.

The defendants have only pointed to a superficial resemblance between the present and prior representations and, as such, have failed to meet their burden for disqualification.

Summary and Conclusion

The defendants' seven month delay in responding to Weston's notice of appearance in this matter does not meet the "reasonable promptness" requirement for filing a motion for disqualification. Accordingly, the defendants have waived their rights to attempt to disqualify Weston and Cobb & Cole.

Even if the seven-month delay does not constitute a waiver, the defendants have failed to meet their burden to establish that Weston's prior representation of Biker in a sales tax audit is "substantially related" to Weston's and Cobb & Cole's current representation, two years later, of Becker in a trademark and copyright infringement suit. When an attorney's disqualification is at issue and material facts are in dispute, an evidentiary hearing is required. See, e.g., *Simon DeBartolo Group, Inc., v. Bratley*, 741 So.2d 1254, 1255 (Fla. 1st DCA 1999) (citing *Boca Investors Group, Inc. v. Potash*, 728 So.2d 825 (Fla. 3d DCA 1999); *School Board of Broward Co. v. Polera Building Corp.*, 722 So.2d 971 (Fla. 4th DCA 1999)). Accordingly, if this Court determines that there are material facts in dispute, an evidentiary hearing should be held.

Courts should be cautious in analyzing a disqualification motion because they are often used for strategic purposes. See, e.g., *Somascan Plaza, Inc. v. Siemens Medical Systems, Inc.*, 187 F.R.D. 34, *37 (D. P.R. 1999); *Smith v. Whatcott*, 757 F.2s 1098, 1099-1100 (10th Cir. 1985); *International Electronics Corp. v. Flanzer*, 527 F.2d 1288, 1289 (2d Cir. 1975). Further, disqualifying a party's chosen attorney is a serious matter which cannot be supported by the mere possibility of a conflict. See, e.g., *Somascan Plaza*, 187 at *37; *Richmond Hilton Assoc. v. City of Richmond*, 690 F.2d 1086, 1089 (4th Cir. 1982). Because no more than the mere possibility of a conflict has been presented in this case, the defendants' motion for disqualification should be denied.

Cobb & Cole

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ATTORNEYS FOR PLAINTIFF and
THIRD-PARTY DEFENDANTS

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on the 28th day of December, 2006, the following was filed electronically through the CM/ECF system, which will send a copy to the following:

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Tampa, FL 33609

By: /s/Kathryn D. Weston

Attorney

TRLSET

**U.S. District Court
Middle District of Florida (Orlando)
CIVIL DOCKET FOR CASE #: 6:06-cv-00056-ACC-DAB**

Becker Designs, Inc. v. Biker Design, Inc. et al
Assigned to: Judge Anne C. Conway
Referred to: Magistrate Judge David A. Baker
Cause: 17:101 Copyright Infringement

Date Filed: 01/12/2006
Jury Demand: Plaintiff
Nature of Suit: 820 Copyright
Jurisdiction: Federal Question

Plaintiff

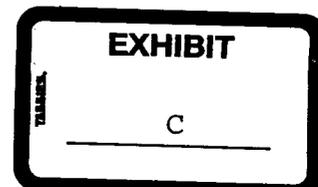
Becker Designs, Inc.
a Florida corporation

represented by **Bruce A. Hanna**
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Daytona Beach, FL 32115-2491
386/255-8171
Fax: 386/248-0323
Email: kathy.weston@cobbcole.com
ATTORNEY TO BE NOTICED

V.

Defendant

Biker Design, Inc.
a Florida corporation

represented by **Lisa A. Oonk**
Litchfield Cavo, LLP
5201 West Kennedy Boulevard
Tampa, FL 33607-5946
813/289-0690
Fax: 813/289-0692
Email: oonk@litchfieldcavo.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Neal J. Blaher
Law Office of Neal J. Blaher
PO Box 804
Orlando, FL 32802-0804
407/895-5050
Fax: 407/895-6644
Email: njblaher@juno.com
TERMINATED: 06/21/2006
LEAD ATTORNEY

Defendant

Ergun Recel
individually

represented by **Lisa A. Oonk**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Neal J. Blaher
(See above for address)
TERMINATED: 06/21/2006
LEAD ATTORNEY

Defendant

Nir Giist
individually

represented by **Lisa A. Oonk**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Neal J. Blaher
(See above for address)
TERMINATED: 06/21/2006
LEAD ATTORNEY

Counter Claimant

Biker Design, Inc.
a Florida corporation

represented by **Lisa A. Oonk**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Neal J. Blaher
(See above for address)
TERMINATED: 06/21/2006
LEAD ATTORNEY

Counter Claimant

Ergun Recel
individually

represented by **Lisa A. Oonk**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Neal J. Blaher
(See above for address)
TERMINATED: 06/21/2006
LEAD ATTORNEY

Counter Claimant

Nir Giist
individually

represented by **Lisa A. Oonk**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Neal J. Blaher
(See above for address)
TERMINATED: 06/21/2006
LEAD ATTORNEY

V.

Counter Defendant

Becker Designs, Inc.
a Florida corporation

represented by **Bruce A. Hanna**
(See above for address)

*LEAD ATTORNEY
ATTORNEY TO BE NOTICED*

Ladd H. Fassett
(See above for address)
*LEAD ATTORNEY
ATTORNEY TO BE NOTICED*

Kathryn Diane Weston
(See above for address)
ATTORNEY TO BE NOTICED

Third Party Plaintiff

Biker Design, Inc.
a Florida corporation

represented by **Lisa A. Oonk**
(See above for address)
*LEAD ATTORNEY
ATTORNEY TO BE NOTICED*

Neal J. Blaher
(See above for address)
*TERMINATED: 06/21/2006
LEAD ATTORNEY*

Third Party Plaintiff

Ergun Recel
individually

represented by **Lisa A. Oonk**
(See above for address)
*LEAD ATTORNEY
ATTORNEY TO BE NOTICED*

Neal J. Blaher
(See above for address)
*TERMINATED: 06/21/2006
LEAD ATTORNEY*

Third Party Plaintiff

Nir Giist
individually

represented by **Lisa A. Oonk**
(See above for address)
*LEAD ATTORNEY
ATTORNEY TO BE NOTICED*

Neal J. Blaher
(See above for address)
*TERMINATED: 06/21/2006
LEAD ATTORNEY*

V.

Third Party Defendant

Robert Becker

represented by **Bruce A. Hanna**

TERMINATED: 08/22/2006

(See above for address)
ATTORNEY TO BE NOTICED**Third Party Defendant****Susan Becker**

TERMINATED: 08/22/2006

represented by **Bruce A. Hanna**(See above for address)
ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
01/12/2006	<u>1</u>	COMPLAINT against Biker Design, Inc., Ergun Recel and Nir Giist with jury demand, filed by Becker Designs, Inc. (Filing fee \$250.00, receipt number 20364)(LV) (Entered: 01/13/2006)
01/13/2006		Summons issued as to Biker Design, Inc., Ergun Recel and Nir Giist. (LV) (Entered: 01/13/2006)
01/23/2006	<u>2</u>	RELATED CASE ORDER; NOTICE of designation under Local Rule 3.05 - track 2; and ORDER Requiring Electronic Filing. (Notice of pendency of other actions due by 2/7/2006.) Signed by Judge Anne C. Conway on 1/23/2006. (SAF) (Entered: 01/23/2006)
01/23/2006	<u>3</u>	INTERESTED PERSONS ORDER. (Certificate of interested persons and corporate disclosure statement due by 2/7/2006.) Signed by Judge Anne C. Conway on 1/23/2006. (SAF) (Entered: 01/23/2006)
01/31/2006	<u>4</u>	RETURN of service executed on January 26, 2006 by Becker Designs, Inc. as to Ergun Recel, Nir Giist. (Vargas, Heather) (Entered: 01/31/2006)
02/03/2006	<u>5</u>	NOTICE of pendency of other actions re order of compliance to Local Rule by Becker Designs, Inc. Related case(s): Yes (Vargas, Heather) Modified on 2/6/2006 (JRM) (Entered: 02/03/2006)
02/03/2006	<u>6</u>	CERTIFICATE of interested persons and corporate disclosure statement by Becker Designs, Inc.. (Vargas, Heather) (Entered: 02/03/2006)
02/14/2006	<u>7</u>	RETURN of service executed on February 3, 2006 by Becker Designs, Inc. as to Biker Design, Inc.. (Hanna, Bruce) (Entered: 02/14/2006)
02/14/2006	<u>8</u>	<i>Defendants Biker Design, Inc., Ergun Recel and Nir Giist ANSWER to complaint of Becker Designs, Inc., COUNTERCLAIM against Becker Designs, Inc. by Biker Design, Inc., Ergun Recel, Nir Giist. (Attachments: # <u>1</u> Exhibit Biker Design Customer Invoice to Becker Designs# <u>2</u> Exhibit Biker Design TM Registration# <u>3</u> Exhibit Biker Design Supplier Letter# <u>4</u> Exhibit Daytona Thunderwear TM Application# <u>5</u> Exhibit Daytona Thunderwear Website# <u>6</u> Exhibit Becker Cease & Desist Letters to Biker Customers# <u>7</u> Exhibit Becker Cease & Desist Letters to Biker Customers# <u>8</u> Exhibit Becker Settlement with Biker Customer# <u>9</u> Exhibit Becker Settlement with Biker Customer# <u>10</u> Exhibit Becker Settlement with Biker Customer# <u>11</u> Exhibit Becker Settlement with Biker Customer# <u>12</u> Exhibit Becker Settlement with</i>

		Biker Customer# <u>13</u> Exhibit Becker Settlement with Biker Customer# <u>14</u> Exhibit Becker Settlement with Biker Customer# <u>15</u> Exhibit Becker Settlement with Biker)(Blaher, Neal) Modified on 2/15/2006 (LV). (Entered: 02/14/2006)
02/14/2006	<u>9</u>	CERTIFICATE of compliance re <u>2</u> related case order <i>Notice of Pendency of Other Actions</i> by Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist. (Blaher, Neal) Modified on 2/15/2006 (LV). (Entered: 02/14/2006)
02/14/2006	<u>10</u>	CERTIFICATE of interested persons and corporate disclosure statement re <u>3</u> by Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist. (Blaher, Neal) Modified on 2/15/2006 (LV). (Entered: 02/14/2006)
02/14/2006	<u>11</u>	THIRD PARTY COMPLAINT against Robert Becker, Susan Becker, filed by all defendants.(Blaher, Neal) (Entered: 02/14/2006)
02/15/2006		THIRD PARTY SUMMONS issued as to Robert Becker and Susan Becker. (LV) (Entered: 02/15/2006)
02/15/2006	<u>12</u>	NOTICE by Becker Designs, Inc. of <i>Compliance with Court Orders</i> (Hanna, Bruce) (Entered: 02/15/2006)
02/21/2006	<u>13</u>	Unopposed MOTION for leave to file excess pages <i>Voluminous Exhibit Not Accepted by Electronic Filing System</i> by Biker Design, Inc., Ergun Recel, Nir Giist. (Blaher, Neal) (Entered: 02/21/2006)
02/22/2006	<u>14</u>	ENDORSED ORDER granting <u>13</u> Motion for Leave to File Excess Pages. Signed by Judge David A. Baker on 2/22/2006. (Baker, David) (Entered: 02/22/2006)
02/27/2006	<u>15</u>	NOTICE by Biker Design, Inc., Ergun Recel, Nir Giist of <i>Filing Voluminous Exhibits in Paper Form in Accordance with Court Order Dated February 22, 2006</i> (Blaher, Neal) See Court file for referenced exhibits--documents not scanned. Modified on 2/28/2006 (LV). (Entered: 02/27/2006)
03/06/2006	<u>16</u>	<i>Plaintiff/Counterdefendant's, Becker Designs, Inc.</i> , ANSWER to counterclaim of <i>Biker Design, Inc.</i> by Becker Designs, Inc., Becker Designs, Inc. Related document: <u>8</u> Answer to complaint, Third party complaint, Counterclaim, filed by Biker Design, Inc., Nir Giist, Ergun Recel.(Hanna, Bruce) (Entered: 03/06/2006)
03/06/2006	<u>17</u>	MOTION to dismiss Counterclaims of Ergun Recel and Nir Giist by Becker Designs, Inc.. (Hanna, Bruce) (Entered: 03/06/2006)
03/07/2006	<u>18</u>	SUMMONS Returned Executed by Biker Design, Inc., Ergun Recel, Nir Giist. Robert Becker served on 2/22/2006, answer due 4/24/2006. (Blaher, Neal) (Entered: 03/07/2006)
03/07/2006	<u>19</u>	SUMMONS Returned Executed by Biker Design, Inc., Ergun Recel, Nir Giist. Susan Becker served on 2/22/2006, answer due 4/24/2006. (Blaher, Neal) (Entered: 03/07/2006)

03/07/2006	<u>20</u>	PROOF of service (See Doc. <u>18</u>) by Biker Design, Inc., Ergun Recel, Nir Giist as to Robert Becker (Blaher, Neal) Modified on 3/8/2006 (LV). (Entered: 03/07/2006)
03/07/2006	<u>21</u>	PROOF of service (See Doc. <u>19</u>) by Biker Design, Inc., Ergun Recel, Nir Giist as to Susan Becker (Blaher, Neal) Modified on 3/8/2006 (LV). (Entered: 03/07/2006)
03/13/2006	<u>22</u>	CASE MANAGEMENT REPORT. (Hanna, Bruce) (Entered: 03/13/2006)
03/14/2006	<u>23</u>	Third Party MOTION to dismiss Third-Party Complaint of Ergun Recel and Nir Giist by Robert Becker, Susan Becker. (Hanna, Bruce) (Entered: 03/14/2006)
03/14/2006	<u>24</u>	<i>Third-Party Defendants'</i> ANSWER to third party complaint of <i>Biker Design, Inc.</i> by Robert Becker, Susan Becker.(Hanna, Bruce) (Entered: 03/14/2006)
03/14/2006	<u>25</u>	NOTICE by Becker Designs, Inc., Becker Designs, Inc., Robert Becker, Susan Becker of <i>Substitution of Co-Counsel</i> (Hanna, Bruce) (Entered: 03/14/2006)
03/16/2006	<u>26</u>	MEMORANDUM in opposition re <u>17</u> Motion to dismiss <i>Counterclaim against Becker Designs, Inc.</i> filed by Ergun Recel, Nir Giist. (Attachments: # <u>1</u> Proposed Amended Counterclaim)(Blaher, Neal) (Entered: 03/16/2006)
03/16/2006	<u>27</u>	MEMORANDUM in opposition re <u>23</u> Motion to dismiss <i>Third-Party Complaint</i> filed by Ergun Recel, Nir Giist. (Attachments: # <u>1</u> Proposed Amended Third-Party Complaint)(Blaher, Neal) (Entered: 03/16/2006)
03/22/2006	<u>28</u>	Joint MOTION for referral to mediation by all parties. (Hanna, Bruce) (Entered: 03/22/2006)
03/22/2006	<u>29</u>	CASE MANAGEMENT AND SCHEDULING ORDER. Signed by Judge Anne C. Conway on 3/22/2006. (Conway, Anne) (Entered: 03/22/2006)
03/23/2006	<u>30</u>	ORDER granting <u>28</u> Motion for referral to mediation. See <u>29</u> Case Management and Scheduling Order for additional requirements. Signed by Judge Anne C. Conway on 3/23/2006. (Conway, Anne) (Entered: 03/23/2006)
04/21/2006	<u>31</u>	Joint MOTION to modify Order Referring Case to Mediation and Incorporated Memorandum of Law by all parties. (Hanna, Bruce) (Entered: 04/21/2006)
04/25/2006	<u>32</u>	ORDER granting <u>31</u> Motion to modify . Signed by Judge Anne C. Conway on 4/25/2006. (Conway, Anne) (Entered: 04/25/2006)
06/02/2006	<u>33</u>	NOTICE of unavailability of counsel by Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist from June 2, 2006 to June 19, 2006. (Blaher,

		Neal) (Entered: 06/02/2006)
06/02/2006	<u>34</u>	NOTICE of Appearance by Lisa A. Oonk on behalf of Biker Design, Inc. (Oonk, Lisa) (Entered: 06/02/2006)
06/19/2006	<u>35</u>	NOTICE by Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist of <i>Withdrawal of Co-Counsel</i> (Blaher, Neal) (Entered: 06/19/2006)
06/20/2006	<u>36</u>	MOTION for Neal J. Blaher to withdraw as attorney by Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist, Biker Design, Inc., Ergun Recel, Nir Giist. (Blaher, Neal) (Entered: 06/20/2006)
06/21/2006	37	ENDORSED ORDER granting <u>36</u> Motion to withdraw as attorney. Signed by Judge David A. Baker on 6/21/2006. (Baker, David) (Entered: 06/21/2006)
07/28/2006	<u>38</u>	ORDER referring motions. Signed by Judge Anne C. Conway on 7/28/2006. (Conway, Anne) (Entered: 07/28/2006)
08/04/2006	<u>39</u>	REPORT AND RECOMMENDATION re <u>23</u> Third Party MOTION to dismiss Third-Party Complaint of Ergun Recel and Nir Giist, <u>17</u> MOTION to dismiss Counterclaims of Ergun Recel and Nir Giist. Signed by Judge David A. Baker on 8/3/2006. (ESC) (Entered: 08/04/2006)
08/22/2006	<u>40</u>	ORDER adopting Report and Recommendations re <u>39</u> , granting <u>17</u> Motion to dismiss, granting <u>23</u> Motion to dismiss . Signed by Judge Anne C. Conway on 8/22/2006. (Conway, Anne) (Entered: 08/22/2006)
08/28/2006	<u>41</u>	Second MOTION to modify Order Referring Case to Mediation and Incorporated Memorandum of Law by all parties. (Hanna, Bruce) (Entered: 08/28/2006)
08/29/2006	42	ENDORSED ORDER granting <u>41</u> Motion to modify. Signed by Judge David A. Baker on 8/29/2006. (Baker, David) (Entered: 08/29/2006)
08/29/2006	<u>43</u>	NOTICE of Appearance by Kathryn Diane Weston on behalf of Becker Designs, Inc., Becker Designs, Inc. (Weston, Kathryn) (Entered: 08/29/2006)
10/09/2006	<u>44</u>	Third MOTION to modify Mediation <i>and Incorporated Memorandum of Law</i> by Biker Design, Inc.. (Oonk, Lisa) (Entered: 10/09/2006)
10/10/2006	45	ENDORSED ORDER granting <u>44</u> Motion to modify. No further extensions should be sought absent a showing of extraordinary good cause. Signed by Judge David A. Baker on 10/10/2006. (Baker, David) (Entered: 10/10/2006)
10/13/2006	<u>46</u>	NOTICE by Biker Design, Inc. <i>Filing Deposition of Ergun Recel</i> (Attachments: # (1) Exhibit A)(Oonk, Lisa) Modified on 10/18/2006: Notice not attached; Deposition filed prior to Motion; to be refiled; pdf deleted (cbh). (Entered: 10/13/2006)
10/13/2006	<u>47</u>	MOTION to disqualify Counsel and Memorandum in Support by Biker

		Design, Inc.. (Oonk, Lisa) (Entered: 10/13/2006)
10/13/2006	<u>48</u>	NOTICE by Biker Design, Inc. re <u>47</u> MOTION to disqualify Counsel and Memorandum in Support, [46] Notice (Other) (Attachments: # <u>1</u> Exhibit A)(Oonk, Lisa) (Entered: 10/13/2006)
10/13/2006	<u>49</u>	CERTIFICATE of Counsel re <u>47</u> MOTION to disqualify Counsel and Memorandum in Support <i>Good Faith Conference</i> by Lisa A. Oonk on behalf of Biker Design, Inc. (Oonk, Lisa) (Entered: 10/13/2006)
10/18/2006	<u>50</u>	NOTICE by Biker Design, Inc., Ergun Recel & Nir Giist re <u>47</u> MOTION to disqualify Counsel and Memorandum in Support, [46] Notice (Other), <u>48</u> Notice (Other), <u>49</u> Certificate of Counsel <i>Of Filing Deposition of Ergun Recel</i> (Attachments: # <u>1</u> Exhibit A)(Oonk, Lisa) Modified on 10/19/2006 (IGC). (Entered: 10/18/2006)
10/24/2006	<u>51</u>	MEMORANDUM in opposition re <u>47</u> Motion to disqualify filed by Becker Designs, Inc.. (Attachments: # <u>1</u> Exhibit A - Declaration of Kathryn Weston in Support of Memorandum in Opposition)(Hanna, Bruce) (Entered: 10/24/2006)
11/02/2006	<u>52</u>	NOTICE OF MEDIATION by Becker Designs, Inc. re [45] Order on motion to modify (Hanna, Bruce) Modified on 11/4/2006 to clarify text (cbh). (Entered: 11/02/2006)
12/06/2006	<u>53</u>	ORDER directing the parties to file a Mediation report by December 11, 2006. Signed by Judge David A. Baker on 12/6/2006. (ESC) (Entered: 12/06/2006)
12/07/2006	<u>54</u>	MEDIATION REPORT: held 11/29/06 - Outcome: IMPASSE, filed by Becker Designs, Inc., Biker Design, Inc.. (Weston, Kathryn) Modified on 12/7/2006 (IGC). (Entered: 12/07/2006)
12/11/2006	<u>55</u>	MEDIATION REPORT. Hearing held on 11/29/06. Hearing outcome: Impasse(RDO) (Entered: 12/11/2006)
12/12/2006	<u>56</u>	Unopposed MOTION for Extension of Time to Complete Discovery by all defendants. (Oonk, Lisa) Motions referred to Magistrate Judge David A. Baker. (Entered: 12/12/2006)
12/13/2006	<u>57</u>	ORDER granting <u>47</u> Motion to disqualify; granting <u>56</u> Motion for Extension of Time to Complete Discovery. Signed by Judge David A. Baker on 12/13/2006. (ESC) (Entered: 12/13/2006)
12/28/2006	<u>58</u>	OBJECTION re <u>57</u> Order on motion to disqualify, Order on Motion for Extension of Time to Complete Discovery by Becker Designs, Inc.. (Weston, Kathryn) (Entered: 12/28/2006)
01/18/2007	<u>59</u>	MOTION to stay Magistrate's Order re <u>57</u> Order on motion to disqualify, Order on Motion for Extension of Time to Complete Discovery <i>Pending Ruling on Objections to Magistrate's Order</i> by Becker Designs, Inc.. (Weston, Kathryn) (Entered: 01/18/2007)
01/23/2007	<u>60</u>	ORDER finding as moot <u>59</u> Motion to stay and denying appeal. Signed

		by Judge Anne C. Conway on 1/23/2007. (Conway, Anne) (Entered: 01/23/2007)
02/09/2007	<u>61</u>	NOTICE of Appearance by Ladd H. Fassett on behalf of Becker Designs, Inc. (Fassett, Ladd) (Entered: 02/09/2007)

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UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

BECKER DESIGNS, INC.,

Plaintiff/Counterdefendant,

v.

Case No. 6:06-cv-56-Orl-22DAB

**BIKER DESIGN, INC.; ERGUN RECEL;
and NIR GIIST,**

Defendants/Counterplaintiffs.

**PLAINTIFF'S MOTION FOR STAY PENDING RULING
ON OBJECTIONS TO MAGISTRATE'S ORDER**

Plaintiff, BECKER DESIGNS, INC. ("BECKER DESIGNS"), moves the Court for an Order staying the Magistrate's Order granting defendants' motion to disqualify counsel for the plaintiff (Dkt.57) (the "Order") and staying this Action until such time as the Court rules on the Plaintiff's Objections to Magistrate's Order on Defendant's Motion for Disqualification (Dkt. 58) (the "Objections") in support thereof states as follows:

1. On October 13, 2006, defendants filed their Motion for Disqualification of Counsel (Dkt. 47) seeking to disqualify counsel for the plaintiff (the "Motion") due to an alleged conflict of interest.
2. On October 24, 2006, Becker filed Plaintiff's Memorandum of Law in Opposition to Defendants' Motion for Disqualification of Counsel (Dkt. 51) with a supporting affidavit of one of plaintiff's counsel.
3. On December 13, 2006, the Magistrate Judge issued the Order granting the Motion, giving plaintiff fourteen (14) days to find new counsel.

EXHIBIT

D

4. On December 28, 2006, plaintiff timely filed the Objections pursuant to Fed.R.Civ.P. 72(a).

5. A stay of the Order and this Action is appropriate pending a ruling by the Court on the Plaintiff's Objections to Magistrate's Order on Defendant's Motion for Disqualification.

Local Rule 3.01(g) Certification

The undersigned hereby certifies that she has conferred in good faith with counsel for the defendants in an effort to resolve the issues presented by this motion, and opposing counsel agrees to the relief requested in this motion.

Memorandum of Law

Both plaintiff and defendant have outstanding discovery requests to which responses fell due after the Order was entered. Further, at the time the Order was entered counsel for the plaintiff and defendant were in the process of scheduling expert depositions, the deadline for which was extended by the Order to January 21, 2007. Due to the Order and the pending objections, counsel for the plaintiff and defendant are hesitant to continue the discovery process in the event the Court upholds the Magistrate's Order and plaintiff is required to retain new counsel. On the other hand, plaintiff is reluctant to retain new counsel to complete discovery in the event the Court overrules the Magistrate's Order and plaintiff is permitted to continue with its current counsel. Either option potentially prejudices one or both parties.

A stay is appropriately granted pending a district court's review of objections to a Magistrate's non-dispositive order pursuant to Fed.R.Civ.P. 72(a). See, e.g., *Srebnik v. Dean*, 2006 WL 1041788 (D. Colo. 2006); *Herbalife Intern., Inc. v. St. Paul Fire & Marine Ins. Co.*, 2006 WL 2715164 (N.D. W.Va. 2006).

WHEREFORE, plaintiff respectfully requests that the Court enter an Order staying the Magistrate's Order granting defendants' motion to disqualify counsel for the plaintiff and staying this Action until such time as the Court rules on the Plaintiff's Objections to Magistrate's Order on Defendant's Motion for Disqualification and granting such further relief as the Court deems just and proper.

Cobb & Cole

By: s/ Kathryn D. Weston

Bruce A. Hanna, Esquire
FLA. BAR NO. 867683
Kathryn D. Weston, Esquire
FLA. BAR NO. 0897701
150 Magnolia Avenue
Post Office Box 2491
Daytona Beach, FL 32115-2491
Telephone: (386) 255-8171
Facsimile: (386) 248-0323
ATTORNEYS FOR PLAINTIFF and
COUNTERCLAIMANTS

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on the 18th day of January, 2007, I electronically filed the foregoing with the CM/ECF system, which will automatically provide a copy of the foregoing to the following:

Lisa A. Oonk, Esquire
Litchfield Cavo, LLP
5201 W. Kennedy Blvd., Suite 450
Tampa, FL 33609

s/ Kathryn D. Weston
Attorney