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

Proceeding	91183701
Party	Plaintiff Enterprise Rent-A-Car Company
Correspondence Address	Hadi S. Al-Shathir Thompson Coburn LLP One US Bank Plaza Saint Louis, MO 63101 UNITED STATES ipdocket@thompsoncoburn.com
Submission	Other Motions/Papers
Filer's Name	Hadi S. Al-Shathir
Filer's e-mail	ipdocket@thompsoncoburn.com, hal-shathir@thompsoncoburn.com
Signature	/s/ Hadi S. Al-Shathir
Date	09/30/2008
Attachments	petition to disqualify.pdf (12 pages)(577092 bytes)

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

ENTERPRISE RENT-A-CAR	:	
COMPANY,	:	
	:	
Opposer,	:	Opposition No. 91183701
	:	
v.	:	Opposition No. 91183702
	:	
KEVIN D. BLACKWELL,	:	
	:	
Applicant.	:	

PETITION TO DISQUALIFY THE FIRM OF GALLOP, JOHNSON, & NEUMAN

Introduction

Enterprise Rent-A-Car Company (“Enterprise”) petitions to disqualify the firm of Gallop, Johnson, & Neuman, pursuant to 37 C.F.R. § 10.130(b), on the grounds that one of its partners has recently represented Enterprise in trademark matters. Specifically, while a partner at Thompson Coburn, the firm representing Enterprise in these proceedings, and prior thereto, Howell & Haferkamp, a small intellectual property boutique firm that merged with Thompson Coburn in 2001, Mr. Kenneth Solomon was exposed to and participated in trademark matters for Enterprise. Despite this exposure to and participation in Enterprise’s strategies regarding enforcement of its trademarks and settlement of trademark disputes, Mr. Solomon and his law firm (Gallop, Johnson, & Neuman) nevertheless entered their appearance on behalf of a party adverse to Enterprise, Applicant Kevin Blackwell, in proceedings that directly involve Enterprise’s trademarks. Such representation is a conflict of interest under the Patent and Trademark Office Code of Professional Responsibility and the Missouri Rules of Professional Conduct. Accordingly, Enterprise respectfully requests disqualification of Jeffrey H. Kass,

Kenneth Solomon, and the law firm of Gallop, Johnson, & Neuman from representing Applicant Kevin D. Blackwell because of this conflict of interest.

Argument

Pursuant to the Patent and Trademark Office Code of Professional Responsibility, 37 C.F.R. §§ 10.20 *et seq.*, an attorney is prohibited from representing a client adverse to a former client as to subject matter that is “substantially related” to the subject matter of a previous representation. *See Finger Furniture Co. v. Finger Interests Number One Ltd.*, 71 USPQ2d 1287, 1290 (PTO, Dir. 2004); *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071 (Comm’r 1984). *See also* 37 C.F.R. §§ 10.56, 10.61, and 10.66. If an attorney is disqualified from representing a party because that attorney has previously represented an adverse party in a similar matter, then that disqualification is imputed to all members of the attorney’s firm. *See* 37 C.F.R. § 10.66(d).

The Missouri Rules of Professional Conduct, to which Mr. Solomon and Mr. Kass are further subject (given that their law practice is based in Missouri) also prohibit an attorney from representing a client adverse to a former client as to subject matter that is “substantially related” to the subject matter of the previous representation. Mo. Sup. Ct. R. 4–1.9(a)(“A lawyer who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which the person’s interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing.”). Missouri also imputes an attorney’s disqualification based on a conflict of interest to all members of the attorney’s firm. Mo. Sup. Ct. R. 4–1.10(a).

Enterprise was a long-standing intellectual property client of Howell & Haferkamp, with which Mr. Solomon was a partner. Maddock Affidavit ¶ 2. That relationship has continued after

Howell & Haferkamp's merger with Thompson Coburn, which represents Enterprise in these proceedings. *Id.* Mr. Solomon has practiced for over 25 years according to his biography, the bulk of it with either Howell & Haferkamp or Thompson Coburn. *See* Exhibit 1 to Maddock Affidavit. While at Howell & Haferkamp and Thompson Coburn, Mr. Solomon was exposed to and participated in matters involving Enterprise's trademark portfolio, including how it used its trademarks and its trademark enforcement practices. Maddock Affidavit at ¶ 3. For example, in 2006, Mr. Solomon participated in significant trademark litigation involving Enterprise and U-Haul. *Id.* Enclosed herewith is a copy of a timesheet of Mr. Solomon's time spent for that litigation matter. *See* Exhibit 2 to Maddock Affidavit. In the timesheet, Mr. Solomon notes various teleconferences with Mr. Paul A. Maddock regarding "trademark issues in settlement agreement" and his "review and revision of trademark section of agreement."

Mr. Maddock, who represents Enterprise in these proceedings, was Mr. Solomon's partner while Mr. Solomon was with Howell & Haferkamp and Thompson Coburn. Maddock Affidavit ¶ 2. In the enclosed affidavit, Mr. Maddock confirms that Mr. Solomon was exposed to and participated in matters involving Enterprise's trademark portfolio, including Enterprise's trademark enforcement strategies and its trademark settlement strategies, during Mr. Solomon's tenure at Howell & Haferkamp and Thompson Coburn. *Id.* at ¶ 3. Moreover, Mr. Maddock specifically recalls the discussions referenced in the enclosed timesheet, which included discussions regarding enforcement, litigation, and settlement strategies for Enterprise's trademarks. *Id.* at ¶ 6.

It is beyond dispute that as a result of Mr. Solomon's participation in Enterprise trademark matters while at Thompson Coburn and Howell & Haferkamp, he was exposed to, and has intimate knowledge of, many confidences of Enterprise that are directly related to these

proceedings, including, but not limited to, Enterprise's litigation strategies regarding its trademarks, its use of its trademarks, and its trademark enforcement practices. Accordingly, neither Mr. Solomon nor Gallop, Johnson, & Neuman can ethically represent Mr. Blackwell in these opposition proceedings.

Enterprise informed Mr. Solomon, Mr. Kass, and their firm that it does not consent to them representing Mr. Blackwell in this matter due to the conflict of interest, via correspondence dated August 26, 2008. While Mr. Kass verbally indicated that he has brought the conflict to the attention of his firm's enforcement officer, Gallop, Johnson, & Neuman has not, to date, withdrawn its representation of Mr. Blackwell. Mr. Kass advised that the enforcement officer would need about a couple of weeks to determine whether a conflict existed. Given that over a month has passed, Enterprise has no choice but to file this motion. Accordingly, Enterprise respectfully requests that Mr. Solomon, Mr. Kass, and Gallop, Johnson, & Neuman be disqualified from representing Mr. Blackwell.

Conclusion

Mr. Solomon, Mr. Kass, and Gallop, Johnson, & Neuman's representation of Kevin Blackwell in these proceedings is, without question, prohibited by the Patent and Trademark Office Code of Professional Responsibility and Missouri Rules of Professional Conduct, due to Mr. Solomon's previous representation of Enterprise in substantially related trademark matters while at Howell & Haferkamp and Thompson Coburn. Mr. Solomon, Mr. Kass, and Gallop, Johnson & Neuman should therefore be disqualified from representing Kevin Blackwell in these proceedings.

Respectfully submitted,

THOMPSON COBURN LLP

By: /s/ Hadi S. Al-Shathir
Paul A. Maddock
Hadi S. Al-Shathir
One US Bank Plaza
St. Louis, Missouri 63101
(314) 552-6000 (phone)
(314) 552-7000 (fax)

Attorneys for Opposer Enterprise Rent-A-Car Company

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 30, 2008, a copy of the foregoing was sent via first class U.S. Mail, postage prepaid, to:

Jeffrey H. Kass
Kenneth Solomon
Gallop, Johnson & Neuman, L.C.
101 S. Hanley Road, Suite 1700
St. Louis, MO 63105

Attorneys for Applicant

/s/ Hadi S. Al-Shathir

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

ENTERPRISE RENT-A-CAR	:	
COMPANY,	:	
	:	
Opposer,	:	Opposition No. 91183701
	:	
v.	:	Opposition No. 91183702
	:	
KEVIN D. BLACKWELL,	:	
	:	
Applicant.	:	

AFFIDAVIT OF PAUL A. MADDOCK

Paul A. Maddock, being first duly sworn, does upon his oath depose and state:

1. I am presently a partner with the law firm of Thompson Coburn LLP. I am over the age of twenty-one (21) and have personal knowledge of the matters related in this Affidavit.

2. Before joining Gallop, Johnson, & Neuman earlier this year, Mr. Kenneth Solomon was a partner of mine at Thompson Coburn LLP, which is currently representing Enterprise in these proceedings, and handles various other intellectual property matters for Enterprise. Mr. Solomon was also a partner at Howell & Haferkamp, a small intellectual property boutique firm that merged with Thompson Coburn in 2001. I understand that Howell & Haferkamp also handled intellectual property matters for Enterprise since at least 1970, long before its merger with Thompson Coburn. Enterprise, therefore, has had a long-standing relationship with both Howell & Haferkamp and Thompson Coburn with respect to its intellectual property.

3. Mr. Solomon has practiced for over 25 years according to his biography, which is enclosed as Exhibit 1, the bulk of it with either Howell & Haferkamp or Thompson Coburn. While at Howell & Haferkamp and Thompson Coburn, Mr. Solomon was exposed to and

participated in matters involving Enterprise's trademark portfolio, including how it used its trademarks and its trademark enforcement practices. For example, in 2006, Mr. Solomon participated with me in discussing enforcement and settlement strategies in significant trademark litigation involving Enterprise and U-Haul. Enclosed herein as Exhibit 2 is a redacted but otherwise true and accurate copy of a timesheet of Mr. Solomon's time spent for that matter.

4. Mr. Solomon's time entry of October 16, 2006 states: "Telephone conference with J. Howell and intraoffice conference with P. Maddock re trademark issues in settlement agreement; review and revision of trademark section of agreement; review of revisions by P. Maddock."

5. Mr. Solomon's time entry of October 17, 2006 states: "Intraoffice conference with J. Howell and P. Maddock re trademark issues in settlement agreement; further review and revision of trademark section of agreement."

6. I recall having had the above discussions with Mr. Solomon regarding Enterprise's trademarks for this litigation matter. Those discussions included how Enterprise uses its trademarks, and enforcement, litigation, and settlement strategies for Enterprise's trademarks.

FURTHER AFFIANT SAYETH NOT.



Paul A. Maddock

STATE OF MISSOURI)
) SS.
CITY OF ST. LOUIS)

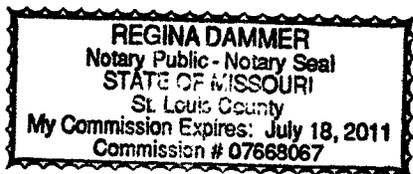
On this 30th day of September, 2008, before me appeared Paul A. Maddock, to me personally known, who being by me duly sworn, did state that he is authorized to make this affidavit, and that the statements made herein are true to the best of his knowledge, information and belief.

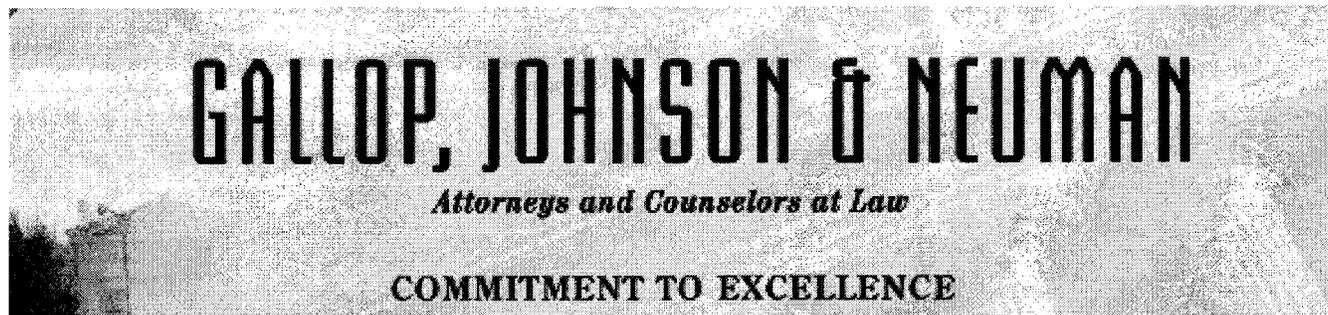
IN TESTIMONY WHEREOF, I hereunto set my hand and affix my official seal in the City and State aforesaid, the date and year written above.

Regina Dammer

Notary Public

My Commission Expires:





Our Lawyers

Kenneth Solomon - Attorney

(314) 615-6290 (Direct Dial)

(314) 615-6001 (Fax)

[Email Me](#)

vCard: 

Areas of Practice:

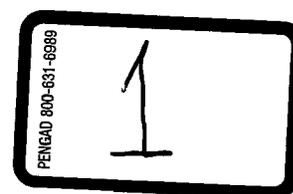
Intellectual Property
Litigation



Mr. Solomon is a partner in the firm's Intellectual Property Practice Group. He has over twenty-five years of experience as a patent and trademark attorney representing clients in the U.S. and internationally in virtually all areas of intellectual property law. He is currently teaching a course on trademark law as an adjunct faculty member at the Washington University School of Law in St. Louis.

Mr. Solomon focuses his practice on management of large, international intellectual property portfolios, from obtaining and securing rights through the preparation and prosecution of patent and trademark applications, to protection of such rights through client counseling, policing, licensing and litigation, as well as defensive protection against rights asserted by others. His practice entails coordination of such intellectual property rights by development of sophisticated strategies aimed at comprehensive coverage of clients' rights in view of their business needs and goals. His expertise includes drafting a wide range of intellectual property agreements, and preparing patentability, validity and infringement opinions on behalf of clients. Mr. Solomon has also managed entire international intellectual property portfolios, each comprising hundreds to well over one thousand patents and trademarks, for: Converse Inc., Broyhill Furniture Industries, Inc., Petrolite Corp., and Astaris LLC (a joint venture of Solutia Inc. and FMC Corporation) and, at all times throughout the last 15+ years, he served as lead or coordinating attorney in dozens of trademark oppositions pending throughout the world.

In managing the client portfolios, Mr. Solomon coordinates the clients' intellectual property rights by development of sophisticated strategies aimed at comprehensive coverage of clients' rights in view of their business needs and goals. His expertise includes drafting a wide range of intellectual property agreements, and preparing patentability, validity and infringement opinions on behalf of clients, and has prepared and prosecuted hundreds of patent applications on behalf of, among others, Monsanto Company, Baker Hughes Incorporated, Petrolite Corp., Mallinckrodt Inc., Solutia Inc., Astaris LLC, Converse Inc., Broyhill Furniture Industries, Inc., Washington University, Florida State University, University of Illinois, Southern Illinois University, and University of Missouri.



Mr. Solomon has substantial practice area experience in many industry sectors and technologies, including those involving the chemical arts and the mechanical arts. He has prepared and prosecuted applications for products and processes in biochemical and pharmaceutical technologies, petroleum industry technologies and industrial chemistry, among other areas.

On a *pro bono* basis, Mr. Solomon has chaired or co-chaired several committees on behalf of the Bar Association of Metropolitan St. Louis, and also served as President of the American Jewish Congress, West Central Region, among other professional and community activities.

Bar Admissions:

Illinois

Missouri

Pennsylvania

U.S. Patent and Trademark Office

U.S. Court of Appeals 7th Circuit

U.S. Court of Appeals Federal Circuit

Professional Associations and Memberships:

Illinois, Missouri and Pennsylvania Bars
Member

Bar Association of Metropolitan St. Louis
Member

American Bar Association

American Intellectual Property Law Association (AIPLA)
Member

Education:

Illinois Institute of Technology Chicago-Kent College of Law, Chicago, Illinois
J.D.

University of Illinois at Urbana-Champaign, Urbana, Illinois
B.S.
Major: Chemical Engineering

101 South Hanley, Suite 1700 • St. Louis, Missouri 63105 U.S.A. • (314) 615-6000 • (314) 615-6001 Fax

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Thompson Coburn LLP
Client Detailed Time And Expense Report

Client: 51017 Enterprise Rent-A-Car Company Bill Tkpr: 3061
Matter: 43584 Enterprise Rent-A-Car v. U-Haul and eMo Resp Tkpr: 3074

Detailed Time Section (Matter)

Tkpr	Date	Rate	Status	Description of Services Rendered
3080	10/16/2006	1.20	B	Telephone conferences with J. Howell and intraoffice conference with P. Maddock re trademark issues in settlement agreement; review and revision of trademark section of agreement; review of revisions by P. Maddock
3080	10/17/2006	2.00	B	Intraoffice conference with J. Howell and P. Maddock re trademark issues in settlement agreement; further review and revision of trademark section of agreement
Time Total		3.20		

Working Timekeeper Summary Section (Matter)

Timekeeper

3080 Solomon, Kenneth

