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

Proceeding	91185261
Party	Plaintiff American Cigarette Company, Inc.
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Submission	Request to Withdraw as Attorney
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Date	02/23/2012
Attachments	motion-withdraw-3d-20120223.pdf (5 pages)(49694 bytes)

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

In the matter of application Serial No. 76/415,303 and 76/415,305

Mark: "UNION GOLD" and "U-UNION and Design"

American Cigarette Company, Inc.

Opposer/Plaintiff,

v.

Opposition Nos. 91185261
91186841
Cancellation No. 92052621
(Consolidated)

N.V. Sumatra Tobacco Trading Company

Applicant/Defendant.

THIRD MOTION TO WITHDRAW

Robert C. Kain, Jr, Esq. and Darren Spielman, Esq. and the firm Kain & Associates, Attorneys at Law, P.A. hereby move to withdrawal as counsel for Opposer American Cigarette Company, Inc. There has arisen a conflict between counsel and Opposer which requires counsel to withdrawal.

Due to the attorney-client privilege, counsel for Opposer cannot reveal the nature of the conflict. Therefore, it would be futile for undersigned counsel to confer with opposing counsel prior to filing this motion as required by the Rules.

37 C.F.R. 10.40 states: "(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving

due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.”

In this matter: (A) reasonable steps have been taken to avoid foreseeable prejudice to the rights of the client. Letters have been sent to the client indicating several irreconcilable conflicts between counsel (and counsel’s law firm) and the client. The initial letter outlining these conflicts was sent in October, 2011. The client did not resolve the conflict at that time nor in November or December, 2011. Several follow-up letters and emails were sent in January and through February 13, 2012 which identified numerous reasons why several irreconcilable conflicts have arisen between counsel and client. Due to ethical rules of the Florida Bar and the USPTO, counsel is not permitted to identify these conflicts. The client has not resolved these conflicts with counsel.

(B) Several lawyers have contacted the undersigned counsel including Paul Keneally, Esq. at PKeneally@underbergkessler.com and Jeff Weissman, Esq. at jeffweissman@wdbnpa.fdn.com to resolve these conflicts. However, they have not indicated whether or not the client has retained these lawyers. These communications in February indicate that the client has had an opportunity to retain other counsel. Client has not called nor written nor emailed counsel to resolve these conflicts.

(C) The client has been given copies of all materials filed in the USPTO. Also, the client has copies of all discovery materials (other than attorneys-eyes-only material). As for the counsel’s work product, under Florida law, counsel has a legal right to retain those files and materials until the conflict is resolved.

Both retaining liens and charging liens arose under common law. Maryland Casualty

Co. v. Westinghouse Credit Corp. (In re Hanson Dredging, Inc.), 15 Bankr. 79 (S.D. Fla. 1981). See Nichols v. Kroelinger, 46 So.2d 722 (Fla. 1950). No statutes outline the requirements for valid attorney's liens in Florida. Rather, case law acts as the sole guide for both attorneys and courts as to these liens. Sinclair, Louis, Siegel, Heath, Nussbaum & Zavertnik, P.A. v. Baucom, 428 So.2d 1383 (Fla. 1983); St. Ana v. Wheeler Mattison Drugs, Inc., 129 So.2d 184 (Fla. 3d DCA), cert. denied, 133 So.2d 646 (Fla. 1961). In Sinclair, Louis, 428 So.2d at 1385, this Court set out four requirements for a valid charging lien. To impose such a lien, the attorney must show: (1) an express or implied contract between attorney and client; (2) an express or implied understanding for payment of attorney's fees out of the recovery; (3) either an avoidance of payment or a dispute as to the amount of fees; and (4) timely notice. Daniel Mones, P.A. v. Smith, 486 So. 2d 559, 561 (Fla. 1986)

The retaining lien extends to all property in counsel's possession. "In Florida an attorney has a right to a retaining lien upon all of the client's property in the attorney's possession, including money collected for the client." Daniel Mones, P.A. v. Smith, 486 So. 2d 559, 561 (Fla. 1986).

Counsel and client have a several written engagement letters which set forth counsel's right to a retaining lien. Due to the privilege for attorney-client communications, counsel cannot submit these engagement letters to the TTAB.

(D) Counsel and his law firm do not have any fees paid in advance for this TTAB litigation.

Mandatory withdraw is required because: "The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule." See Representing a Client Zealously, 37 C.F.R. 10.84. Counsel represents multiple parties and believes a conflict has arisen with those parties. See 37 C.F.R. 10.66. Client's refusal to resolve the conflict since October 2011 through February 13, 2012 is adversely effecting counsel ability to prepare for the summary judgment in this matter. See 37 C.F.R. 10.77(b).

Permissive withdrawal is requested because: "By [client's] other conduct [client] renders it unreasonably difficult for the practitioner to carry out the employment effectively," 37 C.F.R.

10.40(c)(1)(iv), client has failed to pay bills 37 C.F.R. 10.40(c)(1)(vi), and counsel's "continued employment is likely to result in a violation of a Disciplinary Rule." 37 C.F.R. 10.40(c)(2).

Counsel has been given notice of this motion to Opposer as indicated on the service list.

WHEREFORE, counsel for Opposer respectfully requests that the TTAB permit them to withdraw as counsel.

Dated: February 23, 2012

Respectfully submitted,

By: /Robert Kain/

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Attorney for Opposer American Cigarette Company,
Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 23 day of February, 2012, a true copy of the foregoing Motion to Withdraw was served via email and mail to the following:

Tara Vold
J. Paul Williamson
Fulbright & Jaworski L.L.P.
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Washington, D.C. 20004
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tvold@fulbright.com

And was served via email and mail on the attached Service List.

/Robert Kain/

Robert C. Kain, Jr.

SERVICE LIST

Karen Kamperman, CEO (karenkamperman@msn.com)
American Cigarette Company, Inc.
1291-B N.W. 65th Place
Ft. Lauderdale, Florida 33309

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