

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Winter/rr

Mailed: December 10, 2008

Opposition No. 91186986

LOEST & McNAMEE, INC.

v.

SHAUN ROBERTS ALLEN

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

The Board notes the motion filed November 25, 2008 by applicant's counsel, John A. Galbreath, to withdraw as counsel and applicant's answer filed on November 24, 2008.

Motion to Withdraw as Counsel

Counsel's motion to withdraw as counsel of record in this case is hereby *denied without prejudice* because it fails to comply with the requirements of Trademark Rule 2.19(b) and Patent and Trademark Rule 10.40.

Specifically, the motion does not include one or more of the following requirements: (1) a statement that the practitioner has notified the client of his or her desire to withdraw from employment, and has allowed time for employment

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of another practitioner in the United States¹; (2) a statement that all papers and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (3) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded; and (4) proof of service of the request upon the client and upon every other party to the proceeding. See Patent and Trademark Rule 10.40, 37 CFR § 10.40. Cf. *In re Legendary Inc.*, 26 USPQ2d 1478 (Comm'r 1992).

In view thereof, counsel is allowed **THIRTY DAYS** from the mailing date of this order to submit a motion which complies

¹ The Board notes counsel's statement that another attorney has filed applicant's answer. Said counsel from New Zealand has not shown that it meets the provisions of 37 C.F.R. § 11.14(c). A foreign attorney who resides and practices in a foreign country other than Canada and who is not a member in good standing of the bar of the highest court of a state in the United States may not practice before the USPTO. Any such attorney or agent who wishes to represent a party in a trademark matter must file a written request to do so with the USPTO Office of Enrollment and Discipline. This request must be filed prior to representing a party before the USPTO and should include proof that the attorney or agent is in good standing with the foreign patent or trademark office, and that the foreign patent or trademark office provides substantially reciprocal rights to United States attorneys. See TMEP § 602.06(b) (5th ed. 2007). See <http://www.uspto.gov/web/offices/dcom/olia/oed/oedcontact.htm>. Specifically, a foreign attorney who is not authorized under 37 C.F.R. § 11.14(c) cannot: prepare an application, response, or other paper to be filed in the USPTO; sign amendments, responses to Office actions, petitions, or letters of express abandonment; authorize examiner's amendments, priority actions, or changes of correspondence address; or otherwise represent an applicant, registrant, or party to a proceeding in the USPTO. See *Id.* § 602.06(c). See also 37 C.F.R. §§ 11.14(f) and 1.21(a)(1)(i).

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with Trademark Rule 2.19(b) and Patent and Trademark Rule 10.40.

Answer

The Board notes that applicant's answer was executed and submitted by an attorney in New Zealand and that the answer states that said counsel are "Attorneys for Defendant/Applicant."

Patent and Trademark Rule 11.14(c) provides as follows:

"Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and is possessed of good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark matters before the Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain."

Counsel from New Zealand has not shown that it is qualified under the provisions of Rule 11.14(c). In view thereof, applicant's answer is not acceptable because it may not have been submitted by properly authorized counsel.

Accordingly, applicant is allowed **FORTY DAYS** from the mailing date of this order to file with the Board either an answer that is ratified by applicant (or applicant's U.S.

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counsel) or proof that applicant's New Zealand counsel has been approved by the USPTO Office of Enrollment and Discipline to represent applicant in this proceeding, failing which the Board may issue a notice of default under Fed. R. Civ. P. 55(a).

Proceedings Suspended

Except to the extent indicated above, proceedings are **SUSPENDED**. The parties will be notified by the Board when proceedings are resumed, and appropriate dates will be rescheduled in due course.

A copy of this order has been sent to all persons listed below.

cc:

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NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and

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Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>