

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR OF THE UNITED STATES PATENT AND
TRADEMARK OFFICE

KUCZMA

Michelle Savitt

Opposer

v.

Janis Savitt

Applicant

Opposition No. 91210400

Mailed: September 29, 2014

DECISION DENYING PETITION FOR DISQUALIFICATION

Cheryl Butler, Senior Counsel, Trademark Trial and Appeal Board:¹

Applicant filed an application to register the mark JANIS BY JANIS SAVITT for *jewelry*.² Opposer opposes registration of the mark on the grounds of priority of use

¹ Authority to decide petitions seeking disqualification of attorneys in cases before the Trademark Trial and Appeal Board has been delegated to the Chief Administrative Trademark Judge. TBMP § 513.02 (2014). Under the delegation, the authority to decide this petition was further delegated.

² Serial No. 85721117, filed September 5, 2012, based on an intention to use the mark in commerce under § 1(b) of the Trademark Act.

and likelihood of confusion with the registered mark M+J SAVITT for *jewelry*.³ Additionally, Opposer also relies on Application Serial Nos. 85852617 and 85852669 filed on February 18, 2013, for the respective marks S M+J SAVITT and SAVITT for *jewelry*, which were identified on the ESTTA cover sheet filed with the Notice of Opposition.⁴

Opposer, acting *pro se*, has filed a Petition to Disqualify Applicant's counsel, Roxanne Elings, on the basis that Ms. Elings represented Opposer in a prior trademark dispute that is substantially related to the subject matter of the current Opposition. Shortly thereafter, Applicant moved to dismiss the Opposition proceeding for failure to state a claim upon which relief can be granted. The Board suspended the proceeding on June 12, 2013, pending a decision on the Petition to Disqualify. Briefing on the Motion to Dismiss is therefore deferred pending the outcome of this decision. Applicant filed a response to the Petition to Disqualify within the time set by the Board's June 13, 2013 Order, and Opposer filed a reply.⁵

For the reasons set forth below, the Petition to Disqualify is *denied*.

³ Registration No. 3022631 issued December 6, 2005; §§ 8 and 15 combined declaration accepted and acknowledged.

⁴ See *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) (the ESTTA cover sheet is read in conjunction with the notice of opposition as an integral component).

⁵ Petitions to disqualify a practitioner in ex parte or inter partes matters before the Office are not governed by §§ 11.19 through 11.60 but are handled on a case-by-case basis under such conditions as the United States Patent and Trademark Office (USPTO) Director deems appropriate. See 37 C.F.R. § 11.19(c).

BACKGROUND

Opposer argues that she was a former client of Applicant's counsel, G. Roxanne Elings. According to Opposer, Ms. Elings represented Opposer and Applicant, as well as other defendants, in connection with a prior lawsuit brought against them in the Southern District of New York, for *inter alia*, unauthorized use of the trademarks M+J SAVITT, SAVITT and S M+J SAVITT. 4 TTABVUE 2.⁶ The lawsuit was filed by Wynne Savitt, sister to Opposer and Applicant, on behalf of herself and as a shareholder of the family business M+J Savitt, Inc. (hereafter referred to as the "Wynne litigation"). In connection with her representation of Opposer in the prior lawsuit, Ms. Elings allegedly obtained confidential and protected information about Opposer and M+J Savitt, Inc., advised and counseled them regarding the legal issues involved in that dispute, and rendered her legal opinion regarding the merits of the plaintiffs' case as well as Opposer's and M+J Savitt, Inc.'s respective positions in the case, advising that there was no material conflict of interest between Opposer and M+J Savitt, Inc. on one side and Applicant and her companies on the other side. 4 TTABVUE 2-3.

Opposer maintains that Ms. Elings' representations and opinions were intentionally false and fraudulent, charging that Ms. Elings previously attempted to register the JANIS SAVITT mark on behalf of Applicant and knew that such application was refused by the USPTO because it was found to be in conflict with M+J Savitt, Inc.'s registered trademarks. According to Opposer, such knowledge of

⁶ See TTABVUE docket entry 4 at electronic page 2; hereafter such references to the docket entries will be cited as 4 TTABVUE 2.

the conflict with M+J Savitt, Inc.'s trademarks evidences that a conflict of interest existed at the time Ms. Elings represented both Opposer and Applicant. 4 TTABVUE 3.

In connection with the Wynne litigation, Applicant points out that the District Court never addressed "the trademark infringement claims against [Opposer] and these claims were summarily dismissed" because the claims were outside the scope of the permitted amendment allowed by the court. 10 TTABVUE 6, 10.

Opposer subsequently filed suit on behalf of herself and M+J Savitt, Inc., against Ms. Elings, her prior firm and Applicant in the Supreme Court for the State of New York for breach of fiduciary duty, fraud, legal malpractice, unjust enrichment and "other malevolent tortious acts" stemming from the Wynne litigation (hereafter referred to as the "State Court Action"). 10 TTABVUE 305-366; 368-432. According to Opposer, this suit involves the M+J SAVITT, SAVITT and S M+J SAVITT trademarks as well as the JANIS BY JANIS SAVITT mark. 4 TTABVUE 3.

Opposer contends that in order to enable Applicant to register her mark after an unsuccessful first attempt, Ms. Elings was instrumental in allowing the expiration of the M+J SAVITT and SAVITT registrations cited against Applicant's first application, paving the way for Applicant to register the JANIS BY JANIS SAVITT mark which is at issue in this proceeding. 4 TTABVUE 3. In view of the foregoing, Opposer plans to call Ms. Elings to testify in this opposition proceeding and in the New York Supreme Court litigation, to determine whether she participated in devising a strategy of letting the M+J SAVITT and SAVITT registrations "'die' to

clear the way for registration of the mark at issue” in this opposition proceeding. 4 TTABVUE 3-4, 11 TTABVUE 5.

According to Applicant, all claims against her in the New York Supreme Court suit have been dismissed and the non-malpractice claims against Ms. Elings and her prior firm have been dismissed. 10 TTABVUE 8. Based on the foregoing, Applicant argues Opposer’s statement that “there is ongoing litigation between some of these parties which concerns the subject trademarks with [Applicant] and [Elings] named personally as defendants” is at best misleading. 10 TTABVUE 8.

In her response to the Disqualification Petition, Applicant observes that this is not the typical disqualification case because Ms. Elings has consistently represented Applicant; rather, it is Opposer that has “changed sides” during the history of litigation described above. 10 TTABVUE 2, 14. With respect to Opposer’s argument that Ms. Elings is expected to testify as a witness in this proceeding, Applicant denies that Ms. Elings had any involvement with her prior trademark application which was handled by Dennis Cavanaugh of DH Cavanaugh Associates. 10 TTABVUE 9. She also denies Ms. Elings’ involvement in allowing the registrations for the M+J SAVITT and SAVITT marks to expire. 10 TTABVUE 3, 8-9. In view of the foregoing, Applicant argues Opposer has failed to provide any support for her contention that Ms. Elings may be called as a witness in this proceeding. 10 TTABVUE 15.

Even if Ms. Elings were to be called as a witness in this proceeding, Applicant argues that the exception to the rule that an attorney shall not advocate at a

proceeding before a tribunal in which the attorney is to be likely to be called as a necessary witness, namely, where disqualification would work a substantial hardship on the client, applies in this case. 10 TTABVUE 16. Applicant attests that she would be “negatively impacted” if Ms. Elings were disqualified⁷ and that if Ms. Elings were disqualified, Applicant would suffer substantial hardship by being forced to sever her relationship with her longtime attorney who is familiar with the issues in the instant proceeding. 10 TTABVUE 16. Applicant also contends that disqualification of Ms. Elings will result in prejudice to Applicant. According to Applicant, Ms. Elings is familiar with the relevant marks in this proceeding as well as the history of litigation involving the parties. Applicant argues that the disruption to the attorney-client relationship between Ms. Elings and Applicant that would result from Ms. Elings’ disqualification is the reason that motions to disqualify are generally disfavored and weighs heavily against granting Opposer’s Petition. 10 TTABVUE 14.

As to Opposer’s contention that Ms. Elings obtained confidential information about Opposer, Applicant notes that Opposer has not pointed to any confidential information that Ms. Elings is privy to or how it would damage Opposer, and “given that Opposer and Applicant were on the same side in the former litigation, it is unlikely that Ms. Elings would have had such access” to such information. 10 TTABVUE 11.

⁷ See Declaration of Janis Savitt in Opposition to Petition to Disqualify ¶ 6 located at 10 TTABVUE 510.

Applicant notes that disqualification is a drastic measure that is generally disfavored and that Opposer has not met her heavy burden. Additionally, Applicant contends that given Opposer's "history of bringing litigation against [Applicant] in both state court and in Surrogate's Court, along with [Opposer's] misrepresentation of the State Court Action, it is likely that this Petition is tactically motivated." 10 TTABVUE 12. Applicant also complains that Opposer waited over three months after the mark at issue was published for opposition and until just days before a response to the Notice of Opposition was due to file the Petition to Disqualify. This delay combined with Opposer's failure to properly serve the Petition resulted in valuable resources being expended by Applicant in preparing and filing the Motion to Dismiss the Opposition. Applicant contends that this delay too was "quite likely" for tactical reasons.

Opposer's reply maintains Opposer's position that Ms. Elings represented M+J Savitt, Inc., that she was privy to "confidential trademark and business information" and "all the confidential information and confidential business information of M+J Savitt, Inc., as well as business and confidential information concerning [Opposer]" and that Ms. Elings "is using and will continue to use this information against the interests of M+J Savitt, Inc., and [Opposer]." 11 TTABVUE 2-4 ¶¶ 1, 4, 6. Opposer contends that because both the Wynne litigation and this Opposition involve the M+J SAVITT, SAVITT and S M+J SAVITT trademarks, the proceedings involve substantially related matter. 11 TTABVUE 4 ¶ 6.

FACTS

For purposes of the Petition to Disqualify, the following facts are found:

1. Michelle Savitt (Opposer or Michelle) and Janis Savitt (Applicant or Janis) are sisters, and are also founders and shareholders of M+J Savitt, Inc., a closely held corporation that designed and sold jewelry. 1 TTABVUE 3; 10 TTABVUE 486, 510.
2. Opposer filed a Notice of Opposition against Applicant's application to register the mark JANIS BY JANIS SAVITT on April 26, 2013, and is representing herself in this matter. 1 TTABVUE 1-5.
3. Applicant is the owner of Designs by Janis Savitt, Inc., a jewelry company formed in 2007. 10 TTABVUE 487.
4. Applicant is represented herein by Roxanne Elings ("Elings"), of Davis, Wright, Tremaine LLP, 10 TTABVUE 1, 17, formerly of Greenberg Traurig, LLP, 10 TTABVUE 4.
5. On May 29, 2013, Opposer filed a Petition to Disqualify Applicant's counsel. 4 TTABVUE.
6. Registration No. 3022631, for the mark M+J SAVITT, registered December 6, 2005, in the name of M+J Savitt, Inc. and was cancelled on January 29, 2013, for failure to file an acceptable declaration of use under Section 8 of the Trademark Act, 15 U.S.C. § 1058.⁸ M+J Savitt, Inc.'s Registration No. 2941210 for the mark SAVITT was also cancelled for failure to file an

⁸ 10 TTABVUE 502; *also see* TSDR electronic database report for Registration No. 3022631.

acceptable declaration of use under Section 8 of the Trademark Act.⁹

Opposer, identifying herself as “Officer and Director” of M+J Savitt, Inc., petitioned to reinstate Registration No. 3022631 on February 13, 2013. 10 TTABVUE 502-505. The petition to reinstate was granted on March 21, 2013. 1 TTABVUE 5.¹⁰

7. On February 18, 2013, M+J Savitt, Inc. filed applications to register the marks S M+J SAVITT¹¹ and SAVITT¹² in standard characters for jewelry.
8. According to the Petition for Revival of Cancelled Registration No. 3022631 for the mark M+J SAVITT, which was signed by Opposer, the law firm of Stephen E. Feldman, P.C. was retained to file the Declarations of Use under §§ 8 and 15 for Registration No. 3022631. Due to this firm’s alleged role in the cancellation of the Registration resulting from the filing of an improper specimen, the firm was discharged by M+J Savitt, Inc. 10 TTABVUE 502.
9. Janis applied to register the mark JANIS SAVITT on October 31, 2006, and was refused registration under § 2(d) of the Trademark Act based on a likelihood of confusion with the marks shown in Registration Nos. 2116162 (S M+J SAVITT stylized), 2941210 (SAVITT), and 3022631 (M+J SAVITT) which were registered in the name of M+J Savitt, Inc. 10 TTABVUE 91. The application for the mark JANIS SAVITT was abandoned on April 15, 2008.

⁹ Registration No. 2941210, issued April 19, 2005 and was cancelled on January 19, 2012. See TSDR electronic database report for Registration No. 2941210.

¹⁰ See also TSDR electronic database report for Registration No. 3022631.

¹¹ Serial No. 85852617, currently suspended pending the outcome of this proceeding; 1 TTABVUE 2; see also TSDR electronic database report.

¹² Serial No. 85852669, currently suspended pending the outcome of this proceeding; 1 TTABVUE 2; see also TSDR electronic database report.

- 10 TTABVUE 87. The attorney of record for this application was Dennis H. Cavanaugh of DH Cavanaugh Associates. 10 TTABVUE 89-90, 112.
10. At the time of M+J Savitt, Inc.'s incorporation in 1972, Opposer and Applicant, and their sister Wynne Savitt (Wynne), were each 27 percent shareholders of the M+J Savitt, Inc. jewelry design company, with their mother as the remaining shareholder. 10 TTABVUE 179, 486-87; 11 TTABVUE 7.
11. On October 7, 2008, Wynne filed suit on behalf of herself and M+J Savitt, Inc. in the Southern District of New York against Applicant and others ("Wynne litigation"). 10 TTABVUE 23-64.
12. On December 22, 2008, Wynne filed an Amended Complaint naming Opposer as a defendant. 10 TTABVUE 124, 176, 181.
13. Upon amendment of the Complaint to include Opposer, the Greenberg Traurig firm and attorney Elings offered to represent Opposer in the Wynne litigation. 10 TTABVUE 487.
14. In early 2009, Wynne filed a Second Amended Complaint expanding her claims and adding Opposer's husband, Sepp Donahower and his company, Seppel, Inc., as defendants. 10 TTABVUE 216-301.
15. The claims brought by Wynne, M+J Savitt, Inc., or both, against either Opposer individually or all defendants, included trademark infringement, contributory trademark infringement, copyright infringement, contributory copyright infringement, trademark dilution, engagement in "deceptive acts

and practices,” breach of contract, unjust enrichment, conversion, vicarious liability for infringement, tortious interference with business relationships, breach of fiduciary duty, defamation, fraudulent and deceitful conduct, negligence, and gross negligence causing harm. 10 TTABVUE 297-298.

16. Wynne’s Second Amended Complaint alleged *inter alia* that Opposer and Sepp Donahower, without M+J Savitt’s consent or authorization, used and are currently using M+J Savitt’s Marks, Copyrights and designs in their individual capacity and for their own personal interest to compete with M+J Savitt, 10 TTABVUE 228 at ¶¶ 83-84; that Opposer through the Sepp1 corporate entity, entered into business discussions with M+J Savitt vendors and others to promote and sell jewelry, 10 TTABVUE 228-229 at ¶¶ 86-87; that the use of the Marks, Copyrights and designs by Opposer, Sepp Donahower and Sepp1 creates a false association and suggests that Sepp1 is sponsored or affiliated with M+J Savitt, Inc., 10 TTABVUE 230 at ¶ 94-95; that the unauthorized intentional and personal usage of the Marks by Applicant, Opposer, Sepp Donahower, Designs by Janis Savitt, and Sepp1 in commerce has caused and is likely to continue to cause consumer confusion as to the origin of sponsorship of their products and services with M+J Savitt Inc.’s products or services, 10 TTABVUE 242 at ¶ 171; all defendants were involved in contributory infringement in that they assisted each other in selling products with M+J Savitt, Inc.’s marks on them, sharing customer

information, and sharing stolen jewelry, and inducing infringement. 10
TTABVUE 244 at ¶ 184, 245 at ¶¶ 191, 192.

17. With the exception of a defamation claim against Applicant, Wynne's claims against Opposer and Applicant were dismissed by the District Court. 10
TTABVUE 214. All of Wynne's claims on behalf of M+J Savitt, Inc. were dismissed because they were not pled with sufficient particularity. 10
TTABVUE 193-196. In dismissing the claims, the District Court found that the allegations regarding Opposer's alleged use of the marks for her own benefit did not adequately show how Opposer "is an interested director with respect to the *transactions the litigation sought to challenge involving [Applicant's] use of the [M+J Savitt, Inc.] intellectual property* to benefit herself and compete with the corporation" (emphasis added); and that Wynne's "efforts to link these two separate sets of transactions are entirely conclusory (*e.g.*, the allegation that all defendants are 'assisting' one another in selling products that compete with M+J Savitt, [Inc.]), and simply do not allege with sufficient particularity how [Opposer] is an interested director as to *[Applicant's] alleged misuse of the M+J Savitt, [Inc.] intellectual property and inventory which is the only conduct this litigation seeks to challenge.*"
March 17, 2009, Opinion and Order by District Court Judge Denise Cote located at 10 TTABVUE 192-193 (emphasis added).

18. In January 2012, Opposer filed suit individually and on behalf of M+J Savitt, Inc. in the Supreme Court of the State of New York against Greenberg

Traurig, Ms. Elings, Applicant, and her company Designs by Janis Savitt, Inc., alleging breach of fiduciary duty, fraud, malpractice, and violation of Judiciary Law § 487, based on Greenberg Traurig and Elings' representation of Opposer in the previous Wynne litigation. 10 TTABVUE 488. An amended Verified Complaint for breach of fiduciary duties, fraud, legal malpractice, and other malevolent tortious acts was filed on July 10, 2012.

19. The suit against Elings and her prior firm involved allegations that they had “deliberately misrepresented to Plaintiffs here that there were no meritorious causes of action which they could have pursued against Defendants JANIS and DESIGNS and lied that there was no need for MICHELLE and M+J [Savitt, Inc.] to retain independent counsel and that it is advisable for them and JANIS and DESIGNS to be represented by one firm.” 10 TTABVUE 369 at ¶ 2; that “all of the claims asserted against JANIS and Designs by Janis Savitt, Inc. in the Prior Complaint were devoid of any merit,” that the causes of action in the Prior Complaint “did not have a leg to stand on,” . . . that it “[was] in her interests to execute the Settlement Agreement,” 10 TTABVUE at 400-403 at ¶¶ 196, 200-201; based upon Greenberg Traurig and Elings' legal advice, Opposer “entered into a settlement agreement whereby, in addition to releasing Wynne Savitt Weiner, [she] also released JANIS SAVITT and her company from all liability.” 10 TTABVUE 370 at ¶ 10.
20. The New York Supreme Court granted the defendants' motion to dismiss for failure to state a claim and dismissed all claims except for the legal

malpractice claims against Ms. Elings and the Greenberg Traurig firm. 10 TTABVUE 500. Opposer is in “the process of appealing” the dismissal of the non-legal malpractice claims. 11 TTABVUE 3, 13.

DISCUSSION

Opposer seeks to have attorney Elings disqualified from representing Applicant because: (a) Ms. Elings previously represented Opposer in legal matters substantially related to this proceeding wherein Opposer is now adverse to Ms. Elings’ client; (b) in her representation of Applicant, Ms. Elings will be using confidential and protected information she obtained in her prior role as counsel to Opposer; and (c) Ms. Elings will be called as a witness in litigation involving the trademarks at issue here and is a defendant in other legal actions concerning those trademarks. 4 TTABVUE 5.

In support of her Disqualification Petition, Opposer contends Ms. Eling’s representation of Applicant is contrary to 37 C.F.R. § 10.63 as well as the USPTO Rules of Professional Conduct, namely 37 C.F.R. § 11.109(a). 4 TTABVUE 4-5. Opposer’s reliance on section ¶ 10.63 is misplaced. Part 10 of 37 C.F.R. has been removed with corresponding rules found in 37 C.F.R. Part 11.¹³ As Applicant correctly notes, the current provision is 37 C.F.R. § 11.307, and provides that a practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be called as a necessary witness unless: . . . (3) disqualification would work substantial hardship on the client.

¹³ Opposer’s Disqualification Petition was filed on May 29, 2013. Effective May 3, 2013, 37 C.F.R. Part 10 was removed. See 78 FR 20180, April 3, 2013.

Section 11.109(a) provides:

(a) A practitioner 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 that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing.

In deciding a petition to disqualify, “the movant has the burden of proving that opposing counsel should be disqualified.” *McKinney v. McMeans*, 147 F. Supp.2d 898, 900 (W.D. Tenn. 2001). That burden is a heavy one, and a party moving for disqualification must satisfy a “high standard of proof.” *Government of India v. Cook Industries, Inc.*, 569 F.2d 737, 739 (2d Cir. 1978). Accordingly, petitions to disqualify are viewed with disfavor, are considered a drastic remedy, *Finger Furniture Co. v. Finger Interests Number One Ltd.*, 71 USPQ2d 1287, 1295 (Director USPTO 2004), and are subject to a high standard of proof, in part because they can be used tactically as leverage in litigation. *Revise Clothing, Inc. v. Joe's Jeans Subsidiary, Inc.*, 687 F. Supp.2d 381, 388 (S.D.N.Y. 2010).

We now consider the primary basis of Opposer's Disqualification Petition: Ms. Elings' previous representation of Opposer in legal matters alleged to be substantially related to this proceeding wherein Opposer is adverse to Ms. Elings' client. The “typical” petition to disqualify a practitioner concerns a former client who is alleging that its former attorney is now representing an adverse client in regard to subject matter that is substantially related to the subject matter of the previous representation. *Plus Products v. Con-Stan Industries, Inc.*, 221 USPQ 1071, 1074 (Comm'r Pat. 1984). If Opposer is a former client, and if Ms. Elings now

represents an adverse party, the test for disqualification is, *inter alia*, whether the subject matter of the present representation is substantially related to the subject matter of the previous representation. *Finger Furniture*, 71 USPQ2d at 1290 and *Plus Products*, 221 USPQ at 1074. The parties are in agreement that this is the test for deciding this petition. *See* 4 TTABVUE 2 and 10 TTABVUE 10.

To meet her burden, Opposer must first prove that she had a prior attorney-client relationship with Ms. Elings. Inasmuch as it is undisputed that Elings represented Opposer in the Wynne litigation, (4 TTABVUE 2 at ¶¶1-2; 11 TTABVUE 2 at ¶ 1, 3 at ¶ 6, 10 at ¶ 5), Opposer is a former client of Ms. Elings. There is also no dispute that Ms. Elings now represents Applicant, who is adverse to Opposer in this proceeding. Therefore, we move forward to consider whether the subject matter of this Opposition is substantially related to the subject matter involved in the Wynne litigation.

As explained in *Revise Clothing*, 687 F. Supp.2d at 392, the “substantially related” prong is established “only upon a showing that the relationship between issues in the prior and present cases is ‘patently clear.’ Put more specifically, disqualification has been granted or approved recently only when the issues involved have been ‘identical’ or ‘essentially the same.’” *Government of India*, 569 F.2d at 739-40 (citations omitted); *accord Leslie Dick Worldwide, Ltd. v. Soros*, 2009 WL 2190207, at *9 (S.D.N.Y. 2009); *Bennett Silvershein Associates v. Furman*, 776 F.Supp. 800, 803 (S.D.N.Y.1991). “[T]his standard is easily applied to cases where both the prior and present representation involve litigation: ‘if the facts giving rise

to an issue which is material in both the former and the present litigations are as a practical matter the same, then there is a “substantial relationship” between the representations for purposes of a disqualification motion.” *Guerrilla Girls, Inc. v. Kaz*, 2004 WL 2238510, at *3 (S.D.N.Y. 2004) (quoting *United States Football League v. National Football League*, 605 F.Supp. 1448, 1459 (S.D.N.Y. 1985)).

This opposition proceeding involves the registrability of the JANIS BY JANIS SAVITT mark, and particularly, whether the mark is likely to be confused with the M+J SAVITT, SAVITT and S M+J SAVITT marks allegedly owned by M+J Savitt, Inc. (sometimes hereafter referred to as the “corporate marks”), and asserted by Opposer. The pertinent alleged claims in the Wynne litigation concerned unauthorized uses of the same marks by Applicant, Opposer, and various other defendants. 10 TTABVUE 219 ¶¶23, 225-230 ¶¶ 65-96.¹⁴

According to Opposer, in her role as counsel for defendants in the Wynne litigation, Ms. Elings advised Opposer and Applicant of their respective legal positions as to the corporate trademark rights being asserted by Wynne on behalf of M+J Savitt, Inc. 4 TTABVUE 2. Applicant’s response that Ms. Elings has consistently represented Applicant and that it is Opposer “who has changed sides in this history of litigation involving M+J Savitt, Inc.,” 10 TTABVUE 2, misses the crux of the matter. The determination whether there is a substantial relationship

¹⁴ Applicant characterizes Opposer’s State Court Action as a non-trademark infringement action stemming from the Wynne litigation where trademark infringement was not a claim that was litigated with respect to Opposer. 10 TTABVUE 6. While both parties agree that the court in the Wynne litigation did not make any determination as to the merits of the trademark issues involved in the case, 10 TTABVUE 6; 11 TTABVUE 2, ¶ 2, this does not end our inquiry into whether there is a substantial relationship between the subject matter of the proceedings.

between the subject matter of the Wynne litigation and this Opposition requires a more thorough consideration of the claims and parties involved in each proceeding.

Opposer and her husband, co-owners of a company named Seppel, Inc., were sued in the Wynne litigation for the unauthorized use of the corporate trademarks based on their activities conducted through Seppel, Inc. and in connection with the other defendants. 10 TTABVUE 228-230, 242, 244-245 at ¶¶ 83-84, 86-87, 94-95, 171, 184, 191. In this opposition proceeding however, Opposer stands in the shoes of M+J Savitt, Inc. asserting the corporate trademarks as a basis for opposing registration of the JANIS BY JANIS SAVITT mark by Applicant.

Although Opposer, Michelle Savitt, is a named party in both proceedings, the respective claims relate to her engagement in different activities on behalf of separate and distinct business entities, *i.e.*, her activities in connection with Seppel, Inc. and the other defendants in the Wynne litigation versus the rights she asserts on behalf of M+J Savitt, Inc. in this Opposition. Notably, in dismissing the Wynne litigation, the District Court judge found that Applicant's alleged misuse of M+J Savitt, Inc.'s intellectual property is "the only conduct this litigation seeks to challenge." March 17, 2009 Opinion and Order by District Court Judge Denise Cote located at 10 TTABVUE 192-193. Therefore, the conduct challenged in the Wynne litigation was *Applicant's* misuse of the M+J Savitt, Inc. intellectual property. In view of the foregoing, the subject matter of the two proceedings is not substantially related.

“It is the congruence of *factual* matters, rather than areas of law, that establishes a substantial relationship between representations for disqualification purposes.” *United States Football League*, 605 F.Supp. at 1460 n.26 (emphasis in original); *accord, Leslie Dick Worldwide*, 2009 WL 2190207, at *9.

The fact that both proceedings involve Opposer and the corporate trademarks does not suffice to prove that the involved proceedings are substantially related. Therefore, despite the fact that an attorney-client relationship existed between Opposer and Ms. Elings, Opposer has not met her burden of proving the necessary factual predicate to the existence of a “substantial relationship” between the Wynne litigation and this Opposition. Accordingly, disqualification is not warranted under the facts of this case.

We next address Opposer’s contentions in (b) and (c) above, namely, that in connection with Ms. Elings’ representation of Applicant in this Opposition, Ms. Elings will be using confidential and protected information she obtained in her prior role as counsel to Opposer, and that Ms. Elings will be called as a witness in this proceeding and in the State Court Action.

Ms. Elings represented several parties, including both Opposer and Applicant, in the Wynne litigation involving, *inter alia*, usage of the trademarks at issue in this proceeding. 10 TTABVUE 225-230, 242-243. In her role as counsel for the defendants in the Wynne litigation, Ms. Elings allegedly obtained and used unspecified confidential and protected information about Opposer and M+J Savitt, Inc., advised and counseled Opposer regarding the legal issues involved, rendered

her legal opinion regarding the merits of the plaintiffs' case as well as regarding Opposer's and M+J Savitt Inc.'s respective positions in the case. 4 TTABVUE 2-3.

Despite Opposer's contentions that Ms. Elings also represented M+J Savitt, Inc. in the Wynne litigation, that she obtained confidential information about M+J Savitt, Inc., and advised M+J Savitt, Inc. as to its legal position in that litigation, there is no support in the record for such contentions.¹⁵ To the contrary, the Second Amended Complaint filed in the Wynne litigation, identifies M+J Savitt, Inc. as a named plaintiff in the case, directly adverse to Opposer and Applicant.¹⁶

We are mindful of the well-established principle that in order to grant a disqualification motion, a court should not require proof that an attorney actually had access to or received privileged information while representing the client in a prior case as such requirement places the client in the undesirable position of either having to disclose its privileged information in order to disqualify its former attorney or having to refrain from the disqualification motion altogether. *Government of India*, 569 F.2d at 740. Therefore, once it is established that a substantial relationship exists between the prior and current matters, it is

¹⁵ In support of these contentions, Opposer submitted with her Reply Brief, the Declaration of Alexander Shapiro, Opposer's attorney in the State Court Action. We exercise our discretion under Rule 2.127(a), 37 C.F.R. § 2.127(a), to consider Opposer's Reply brief as well as the accompanying Declarations of Michelle Savitt and Alexander Shapiro. Inasmuch as the pertinent statements in Mr. Shapiro's Declaration at 11 TTABVUE 13 ¶ 3, are based on hearsay and lack specificity, they do not provide support for Opposer's contentions.

¹⁶ Opposer points to Ms. Elings' involvement in a M+J Savitt, Inc. shareholder meeting in November 2008, to further support her position that Ms. Elings represented M+J Savitt, Inc. 11 TTABVUE 10. However, the record shows that rather than representing M+J Savitt, Inc., Ms. Elings and her firm were representing Opposer and Applicant in their capacity as shareholders of M+J Savitt, Inc. and as defendants in the Wynne litigation. 10 TTABVUE 444-445.

presumed that counsel who participated in both had access during the first litigation to confidential information that would be relevant in the second. This presumption, however, is rebuttable. *Revise Clothing*, 687 F.Supp.2d at 392-393.

Here, we determined that there is no substantial relationship between the subject matter of the Wynne litigation and this proceeding. Accordingly, there is no presumption that during the Wynne litigation Ms. Elings had access to confidential information that would be relevant here. Therefore, it remains Opposer's burden to prove that Ms. Elings will use "confidential and protected information" she allegedly obtained in her prior role as counsel to Opposer. In this situation, we find it appropriate to note that Opposer fails to specify the general nature of the confidential and protected information allegedly acquired by Ms. Elings, or how such information is relevant to, or could be used by, Ms. Elings on behalf of Applicant in this proceeding. Based on the non-relatedness of the proceedings, we are unable to reach the conclusion that any such information would be relevant to or could be used by Ms. Elings on behalf of Applicant.

Lastly, Opposer argues that Ms. Elings will be called as a witness in this proceeding and in the State Court Action which concerns the same marks as involved in this opposition. 4 TTABVUE 3; 11 TTABVUE 3 at ¶ 3; 5 at ¶ 8. As support for the need to call Ms. Elings as a witness, Opposer contends that Ms. Elings provided opinions and represented that there were no material conflicts of interest between Opposer "and M+J Savitt Inc. on one side and [Applicant] and her companies on the other side." While Opposer describes such representations and

opinions as “intentionally false and fraudulent,” (4 TTABVUE 3), there are insufficient facts to support such conclusions. For example, Opposer asserts that Ms. Elings previously attempted to register the mark JANIS SAVITT on behalf of Applicant and had knowledge that the application was refused registration based on M+J Savitt Inc.’s then-existing registrations. 4 TTABVUE 3. In fact, Dennis H. Cavanaugh of DH Cavanaugh Associates filed the prior application on behalf of Applicant. 10 TTABVUE 89-90, 112. Ms. Elings was not the attorney of record for the previously-filed JANIS SAVITT application and had no involvement with that application. *See* Declaration of Janis Savitt in Opposition to Petition to Disqualify ¶¶ Nos. 3-4, 10 TTABVUE 509.

Opposer also charges that Ms. Elings was “instrumental in allowing registrations of the two petitioners’¹⁷ valuable trademarks, namely SAVITT and S M+J SAVITT, to expire.” 4 TTABVUE 3 at ¶ No. 3. Based upon her belief that Ms. Elings had something to do with allowing the registrations to lapse for failure to file declarations of use, Opposer plans to call Ms. Elings as a witness in this proceeding to determine “whether or not she devised or helped to devise a strategy of letting the two M+J Savitt’s marks ‘die’ to clear the way for registering” Applicant’s mark, as her prior attempt to register her JANIS SAVITT mark was thwarted by the USPTO. 4 TTABVUE 3-4.

¹⁷ While Opposer’s Disqualification Petition (4 TTABVUE) makes several references to “both petitioners” and “petitioners” (see *e.g.*, 4 TTABVUE 2 at ¶ No. 2; 3 at ¶ No. 3; 4 at ¶ No. 4), the Notice of Opposition clearly identifies Michelle Savitt as the sole Opposer. Hence, she is necessarily the sole petitioner in connection with the Disqualification Petition.

We note that Opposer's allegations are directly contrary to the representations she made to the USPTO in the Petition for Revival of Cancelled Registration No. 3022631. In that Petition, Opposer explicitly acknowledged that "[t]he law firm of Stephen E. Feldman, P.C. had been retained to file Declarations of Use" under §§ 8 and 15 of the Trademark Act for all three marks, i.e., M+J SAVITT, SAVITT and S M+J SAVITT, that the "law firm of Stephen E. Feldman, P.C. failed to notify Registrant of the requirements of the USPTO regarding said Declarations pertaining to the Mark;" that the "law firm of Stephen E. Feldman, P.C. was duly discharged for allowing the marks SAVITT and S M+J SAVITT to be cancelled."¹⁸ Thus, the record establishes that Ms. Elings was neither responsible for, nor involved with, the maintenance of those Registrations. In view of the foregoing, Opposer has not demonstrated any basis for calling Ms. Elings as a witness in this proceeding.¹⁹

We have carefully considered all of the evidence made of record pertaining to the issues, as well as all of the parties' arguments related thereto, including any evidence and arguments not specifically discussed in this opinion. We have not belabored this opinion with a discussion of such arguments; for those we have not mentioned, we simply note that we have found them unpersuasive.

¹⁸ See 10 TTABVUE 3, 8-9 and Petition for Revival of Cancelled Registration attached as Exhibit 9 to Declaration of Lisa D. Keith in Opposition to Petition to Disqualify located at 10 TTABVUE 502.

¹⁹ In light of our discussion *supra* regarding the lack of a substantial relationship, Opposer's bald contention that Ms. Elings will be called as a witness in the State Court Action in connection with Opposer's legal malpractice claim against Ms. Elings is not a sufficient basis for granting the Petition to Disqualify.

DECISION

In view of the foregoing, the Petition to Disqualify is DENIED. Proceedings remain suspended except as follows: opposer is allowed TWENTY DAYS from the mailing date of this order in which to serve and file her response to applicant's motion to dismiss (filed June 5, 2013); applicant's reply thereto, if any, is due in accordance with Trademark Rule 2.127(a).

OTHER INFORMATION

The Board notes that opposer is representing herself. Opposer may do so. However, it should also be noted that while Patent and Trademark Rule 11.14(e) permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though may provide information as to procedure. As the plaintiff, opposer has the burden of proving her case. Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties. In this case, opposer submitted her filings single-spaced in contravention of Trademark Rule 2.126(a)(1), which requires submissions to be double-spaced. *See also* TBMP § 106.03 (2014). Future filings that do not meet the requirements may not be considered.

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