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

Proceeding	91210400
Party	Plaintiff MichelleSavitt
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PETITION TO DISQUALIFY (513.02)

PETITION TO DISQUALIFY G. ROXANNE ELINGS, ESQ. AS COUNSEL IN CURRENT TTAB OPPOSITION PROCEEDING # 91210400

1. Michelle Savitt and M+J Savitt Inc. Are Former Clients of Attorney G. Roxanne Elings.

Attorney G. Roxanne Elings represented Michelle Savitt, M+J Savitt Inc., Janis Savitt, and others in legal matters and disputes concerning the subject trademarks at issue here.

In October – November 2008, G. Roxanne Elings, Esq. then working at the law firm of Greenberg Traurig, began representing Michelle Savitt, M+J Savitt Inc., Janis Savitt, Paul Savitt (officer of M+J Savitt), Mildred Savitt (shareholder of M+J Savitt) in a legal dispute concerning, *inter alia*, usage of the trademarks involved in the present opposition proceedings, namely *M+J Savitt*, along with *Savitt* and *S M+J Savitt*. This was a lawsuit filed by M+J Savitt Inc. officer and shareholder Wynne Savitt Weiner.

It was held that attorney representing respondent in an opposition must be disqualified in view of his previous representation of petitioner in USPTO proceedings and in infringement litigation concerning the same trademark issues. *Plus Products v. Con-Stan Indus., Inc.* 221 USPQ 1071, 1075 (Comm'r 1984).

2. The Issues in the Past and Present Representations Are Essentially the Same.

A recent TTAB case reconfirmed the *Plus Products* opinion citing it as follows: "If applicant is a former client, 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. Plus Products, 221 USPQ at 1074." *Finger Furniture Co., Inc. v. Finger Interests Number One, Ltd.*, 71 U.S.P.Q. 2d 1287, 1289 (TB 2004).

Ms. Elings is a trademark attorney and her participation in the above-mentioned case where she represented Michelle Savitt and M+J Savitt Inc. involved the trademark issues related to the use of the petitioner M+J Savitt Inc.'s mark *M+J Savitt*, along with two other marks belonging to the said petitioner: *Savitt* and *S M+J Savitt*. At that time she obtained confidential and protected information about both petitioners.

Ms. Elings advised and counseled Michelle Savitt regarding the legal issues involved in that dispute. Also she, as a counsel for petitioners, rendered her legal opinion regarding

the merits of the plaintiff's case as well as regarding Michelle Savitt and M+J Savitt Inc. respective positions in the case. In particular, she stated that there was no material conflict of interest between Michelle Savitt and M+J Savitt Inc. on one side and Janis Savitt and her companies on the other side.

Those representations and opinions have been intentionally false and fraudulent. They were not true even in 2008 as just two years prior to that Janis Savitt via her attorney G. Roxanne Elings attempted to register a trademark "Janis Savitt". Said application had been turned down by the USPTO as it was found to be in conflict with the longstanding registered trademarks of M+J Savitt Inc. Thus, the conflict of interests existed even at the time when Ms. Elings represented both Michelle Savitt and Janis Savitt.

The *Finger* case pointed to the fact that the USPTO takes into account how the courts around the country review disqualification matters and referred to a Southern District NY case which said: "[W]here any substantial relationship can be shown between the subject matter of a former representation and that of a subsequent adverse representation, the latter will be prohibited." *T. C. Theatre Corp. v. Warner Bros. Pictures*, 113 F. Supp. 265, 268 (SDNY 1953).

Subsequently M+J Savitt Inc. filed a derivative lawsuit with causes of action against Janis Savitt and others including trademark use, usurping the goodwill, and intellectual property rights of M+J Savitt Inc. and the interests of its shareholders.

Presently, there is an ongoing litigation between some of these parties which concerns the subject trademarks with Janis Savitt and G. Roxanne Elings named personally as defendants, and M+J Savitt and Michelle Savitt as plaintiffs.

The subject trademark of that legal action is the same one at issue in this proceeding, namely, *M+J Savitt*, as well as *Savitt*, *S M+J Savitt*, and the *Janis by Janis Savitt* trademark application.

Therefore, as G. Roxanne Elings served as the attorney for Michelle Savitt and M+J Savitt Inc. in a substantially related matter and, as such, was privy to all confidential information from Michelle Savitt and from M+J Savitt Inc., there are major conflict of interest issues that exist here and a very strong appearance of impropriety.

3. Ms. Elings Will Be Called to Testify in the Upcoming Proceedings.

As was alleged in these proceedings, petitioners believe that G. Roxanne Elings became instrumental in allowing registrations of the two petitioners' valuable trademarks, namely, *Savitt* and *S M+J Savitt*, to expire. That was done in order to allow the respondent in this opposition to register the mark at issue as her prior 2006 attempt was thwarted by the USPTO.

Thus, petitioners plan to call Ms. Elings to testify in these upcoming legal proceedings. Petitioners feel it is necessary to call Ms. Elings as a witness in the current proceedings 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 the mark at issue.

It has been long established that where the attorney is a witness in the case such as giving testimony on behalf of the client the attorney should be disqualified. *See* 37 CFR § 10.63; *Focus 21 International Inc. v. Pola Kasei Kogyo Kabus hiki Kaisha,* 22 USPQ2d 1316 (TTAB 1992); *Allstate Insurance Co. v. Healthy America Inc.* 9 USPQ 2d 1663 (TTAB 1988); and *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.* 11 USPQ2d 1233 (Comm'r 1989).

In addition, as was stated above, Ms. Elings was personally named as defendant in a case before the New York Supreme Court which concerns issues substantially related to the current trademark proceedings. She is expected to testify there, too.

4. Laws Support Disqualification of G. Roxanne Elings

The petitioners believe allowing Ms. Elings' representation of the applicant in these proceedings will go contrary to the 37 CFR § 10.63 noted above as well as case precedents and the USPTO Rules of Professional Conduct.

The relevant Rule states:

§ 11.109 Duties to former clients.

(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.
(b) A practitioner shall not knowingly represent a person in the same or a substantially related matter in which a firm with which the practitioner formerly was associated had previously represented a client:
(1) Whose interests are materially adverse to that person; and
(2) About whom the practitioner had acquired information protected by §§ 11.106 and 11.109(c) that is material to the matter; unless the former client gives informed consent, confirmed in writing.
(c) A practitioner who has formerly represented a client in a matter or whose present or former firm has formerly represented a client in a matter shall not thereafter:
(1) Use information relating to the representation to the disadvantage of the former client except as the USPTO Rules of Professional Conduct would permit or require with respect to a client, or when the information has become generally known; or
(2) Reveal information relating to the representation except as the USPTO Rules of Professional Conduct would permit or require with respect to a client.

By having represented Michelle Savitt and M+J Savitt, Inc. in substantially related matters in the past, pursuant to § 11.109(a) Ms. Elings must be disqualified from participating in these proceedings other than in a witness capacity.

By virtue of her former firm, Greenberg Traurig having represented Michelle Savitt and M+J Savitt Inc. as well as her personally acquiring information protected by §§ 11.106 and 11.109(c) that is material to the matter, pursuant to § 11.109(b) Ms. Elings must be disqualified from representing Janis Savitt whose interests are materially adverse to those of petitioners.

Based on all foregoing, petitioners respectfully request that the TTAB disqualify G. Roxanne Elings as Counsel in these opposition proceedings based on the following:

(a) G. Roxanne Elings represented petitioners in legal matters substantially related to current proceedings where petitioners oppose her current client;
(b) In her representation of the applicant, G. Roxanne Elings will be using confidential and protected information she obtained as counsel to petitioners, all to their extreme detriment; and
(c) G. Roxanne Elings will be called as a witness in litigation concerning trademarks at issue here, and is a defendant in other legal actions concerning trademarks at issue in these proceedings.

Respectfully submitted,

Sincerely,

Michelle Savitt May. 29, 2013

Michelle Savitt