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

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/836,544
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

**OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO
DISQUALIFY JOHN S. EGBERT**

Applicant, Disidual Clothing, LLC, moved to disqualify John S. Egbert from serving as counsel for Opposer INTS It Is Not The Same, GmbH. Opposer, INTS It Is Not The Same, GmbH, by and through his counsel of record, hereby responds to the Motion to Disqualify John S. Egbert.

DISCUSSION

1. Applicant is establishing a disturbing trend of harassing Opposer by filing frivolous motions. The motions appear to be motivated purely by the Applicant's desire to delay this proceeding and increase the costs Opposer must bear to prosecute this Opposition. On December 20, 2013 Applicant filed a frivolous Motion to Strike Opposer's pleaded registrations. The Applicant's Motion to Strike Opposer's registrations was unequivocally contrary to well-established law, and the Board denied the motion. Similarly, the Applicant has now filed a frivolous Motion to Disqualify John S. Egbert as the attorney for Opposer. The current Motion to Disqualify John S. Egbert is without merit, and Applicant's motion mischaracterizes the cases cited within the motion.

2. With regard to motions to disqualify, it has been observed that they "should be viewed with extreme caution for they can be misused as techniques of harassment." *Reed Elsevier, Inc. v. TheLaw.Net Corp.*, 197 F. Supp.2d 1025, 1027 (S.D. Ohio 2002). Withdrawal of an attorney may be required when the practitioner becomes a witness. The test for determining whether to disqualify counsel "is not whether the attorney will be called as a witness, or whether the plaintiff plans to call the attorney, but whether the attorney 'ought' to be called." *Wickes v. Ward*, 706 F. Supp. 290, 292 (S.D.N.Y. 1989).

3. Applicant contends that Mr. Egbert should be disqualified, because he is likely to be a necessary witness in this proceeding. The central premise for Applicant's dubious position is based upon the fact that "Mr. Egbert personally signed Opposer's applications, statements of use, renewals, and/or declarations of use and incontestability for four of the five registrations that Opposer alleged in its Notice of Opposition." *See* [Applicant's Motion to Disqualify, pg. 1].

4. Applicant is correct that Mr. Egbert has filed and signed on behalf of Opposer for applications, statements of use, renewals, and/or declarations of use and incontestability. However, Applicant's supposition that Mr. Egbert signed these documents in his personal capacity is wholly incorrect. Mr. Egbert signed those documents pursuant to a Power of Attorney that authorized him to sign and file the documents on behalf of INTS It Is Not The Same, GmbH.

5. Mr. Egbert signed and filed the Notice of Opposition against Trademark Application No. 85/836,544 for the mark "DISIDUAL". However, Mr. Egbert did not sign and file the current Opposition in his personal capacity, and Mr. Egbert is not a party to this Opposition. Instead, the current Opposition was signed and filed by Mr. Egbert on behalf of the Opposer in this Opposition, INTS It Is Not The Same, GmbH. Moreover, the Trademark Trial and Appeal Board Manual of

Procedure requires that "[e]very document filed in an inter partes or ex parte proceeding before the Board . . . must be signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate, and the signatory must be identified. TBMP § 106.02.

6. Matthew Ciesielski signed and filed Applicant's Answer. *See* [Applicant's Answer]. Craig Beaker signed and filed Applicant's Petition to Disqualify John S. Egbert. *See* [Applicant's Motion to Disqualify]. It would be disingenuous to suggest that Mr. Ciesielski and Mr. Beaker signed and filed the respective documents in their personal capacity, when Mr. Ciesielski and Mr. Beaker are not even parties to the Opposition. Quite clearly, those documents were signed and filed by Mr. Ciesielski and Mr. Beaker on behalf of the Applicant in this Opposition, Disidual Clothing, LLC. *See* TBMP § 106.02.

7. The Trademark Trial and Appeal Board docket is replete with cases in which the attorney of record has signed and filed on behalf of their client applications, statements of use, renewals, and/or declarations of use and incontestability. The fact remains that the attorney is a representative for the client, and the client is entitled to choose the representative attorney of their choice.

8. The case law cited by Applicant in its Motion to Disqualify John S. Egbert fails to support Applicant's Motion, because the cases cited by Applicant are factually different in fundamental and critical ways. First, the Applicant contends that Mr. Egbert is a necessary fact witness, because Mr. Egbert has filed and signed on behalf of Opposer for applications, statements of use, renewals, and/or declarations of use and incontestability. *See* [Applicant's Motion to Disqualify, pg. 3]. The Applicant's reasoning for this supposition is based on *Norac, Inc.*, where "the Opposer moved to disqualify applicant's co-counsel, Michael Cronin, because he signed the

Applicant's amendment to allege use and interrogatory answers as well as submitted a declaration in opposition to the opposer's motion for summary judgment." *See id.* at 3 (citing *Norac, Inc. v. Elementis Specialties, Inc.*, Opposition Nos. 91124364 & 9115 4897, Dkt. No. 48, 11-12 (TTAB Aug. 31, 2004) (internal citations omitted)). While the Applicant is correct that Mr. Cronin was disqualified in the *Norac, Inc.* case, the Applicant has not accurately portrayed the reason for the disqualification. Mr. Cronin was disqualified, because "Applicant has chosen to use its in-house counsel as counsel in the proceeding when it is apparent that the counsel is also its fact witness." *See Norac, Inc. v. Elementis Specialties, Inc.*, Opposition Nos. 91124364 & 9115 4897, Dkt. No. 48, 15 (TTAB Aug. 31, 2004). The crux of the Court's decision focused on the fact that Mr. Cronin had submitted a "declaration used to defeat a motion for summary judgment, it set out facts based on his personal knowledge, and applicant has not presented any facts or arguments that indicates that this testimony was unnecessary or cumulative." *Id.* at 12. The fact that Mr. Cronin had filed an amendment to allege use, alone, was not pertinent to the Court' decision. In the case at bar, Mr. Egbert is not the in-house attorney for the Opposer, and Mr. Egbert will not draft motions based on his personal knowledge. Mr. Egbert is merely outside counsel for Opposer.

9. The Applicant next posits that because Mr. Egbert is mentioned in Opposer's Initial Disclosures, Mr. Egbert should be disqualified. The only legal authority Applicant proffers to support this contention is *J.J. Smucker Co. v. Weston Firm, P.C.*, Case No. 5:13 CV 0448, 2013 WL 3713457, at *1 (N.D. Ohio July 15, 2013). *See* [Applicant's Motion to Disqualify, pg. 4]. The *J.J. Smucker Co.* case is inapposite when applied to the current Opposition. Applicant fails to recognize that in the *J.J. Smucker Co.* case, Mr. Weston was disqualified, because "Mr. Weston [was] a principal—indeed, he [was] the founding member and the sole named partner" of the defendant,

Weston Firm, P.C. *J.J. Smucker Co. v. Weston Firm, P.C.*, Case No. 5:13 CV 0448 (April 8, 2013 Motion to Disqualify, pg. 3) (N.D. Ohio July 15, 2013). Therefore, unsurprisingly, the court found that "Mr. Weston is responsible for the creation, content, and maintenance of the website that is at the heart of [the] litigation." *J.J. Smucker Co. v. Weston Firm, P.C.*, Case No. 5:13 CV 0448 (July 15, 2013 Order Granting the Motion to Disqualify, pg. 7) (N.D. Ohio July 15, 2013). The fact that Mr. Weston was named in the Initial Disclosures, on its own, was not the relevant inquiry. In the case at bar, Mr. Egbert is not a principal, and Mr. Egbert is not a member of the Opposer, INTS It Is Not The Same, GmbH. Mr. Egbert is not responsible for any issue at the heart of this litigation. Mr. Egbert is merely outside counsel for the Opposer.

WHEREFORE, Applicant respectfully requests that the Board deny Applicant's Motion to Disqualify John S. Egbert. Opposer also requests Sanctions in the form that Applicant must request approval from the Interlocutory Attorney's prior to filing any future motions. Applicant also requests all other relief to which it may be entitled.

Respectfully submitted,

January 9, 2015
Date

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