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

Proceeding	91212768
Party	Defendant Disidual Clothing, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTS It Is Not The Same, GmbH,

Opposer,

v.

Disidual Clothing, LLC,

Applicant.

Serial No. 85/836,544

Opposition No. 91212768

Mark: DISIDUAL

**DISIDUAL CLOTHING’S REPLY IN SUPPORT OF  
PETITION TO DISQUALIFY JOHN S. EGBERT**

Applicant Disidual Clothing, LLC (“Disidual”), through its counsel, Marshall, Gerstein & Borun LLP, hereby submits this reply in support of its Petition to Disqualify John S. Egbert from serving as counsel for Opposer INTS It Is Not The Same, GmbH (“Opposer”), and in response to Opposer’s Response to Applicant’s Motion to Disqualify John S. Egbert (“Response”).

**I. DISQUALIFICATION OF MR. EGBERT IS WARRANTED UNDER THE “OUGHT TO BE CALLED” STANDARD.**

Opposer states that “[t]he 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.’” Response, p. 2 (citing *Wickes v. Ward*, 706 F. Supp. 290, 292 (S.D.N.Y. 1989)). Applying this standard, Disidual has provided sufficient evidence to establish that Mr. Egbert should be disqualified from representing Opposer in this proceeding. In fact, Opposer itself demonstrates that disqualification is warranted despite opposing Disidual’s petition.

In its Response, Opposer admits that Mr. Egbert filed and signed Opposer’s applications, statements of use, renewals, and/or declarations of use and incontestability for four of the five registrations that Opposer asserts in its Notice of Opposition. See Response, p. 2. Curiously,

Opposer simultaneously claims that Mr. Egbert should not be disqualified from representing Opposer because he signed these documents pursuant to a power of attorney, and not in his personal capacity. *Id.* Opposer's argument is contradicted by the declarations that Mr. Egbert signed. In particular, all of the declarations signed by Mr. Egbert are based on his personal knowledge and/or on information and belief (*see* Petition to Disqualify, Exhibit A), and Opposer does not offer a single piece of evidence to establish that Mr. Egbert made these statements pursuant to a power of attorney. Further, even if Mr. Egbert filed and signed these declarations pursuant to a power of attorney, it does not mean that Mr. Egbert does not have personal knowledge of the facts in this case. To the contrary, Opposer identified Mr. Egbert in its Initial Disclosures as a person likely to have discoverable information regarding "Opposer's knowledge of Opposer's registration," which supports Disidual's position that Mr. Egbert has personal knowledge relevant to the issues in this case and *ought* to be called to testify. *See id.* at Exhibit B.

Moreover, Opposer's argument that there are numerous instances where "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" has no bearing on the question of disqualification in this case. *See* Response, p. 3. Likewise, Opposer's attempt to analogize the signing of applications, statements of use, renewals, and declarations of use and incontestability to notices of opposition, answers, and motions is misplaced. The very nature of pleadings and motions squarely place the attorney in a representative role and not as a potential witness attesting to facts based on the signatory's personal knowledge for purposes of prosecuting an application or maintaining/renewing a registration. *See* Response, p. 2-3.

Opposer's position that Disidual mischaracterized the cases cited in its Petition to Disqualify is disingenuous. First, with respect to *Norac, Inc. v. Elementis Specialties, Inc.*, Disidual highlighted facts from the case (relying on a direct quote) that support its position, namely, that "the Director of the U.S. Patent and Trademark Office concluded that Mr. Cronin *ought* to be called to testify on his client's behalf because he provided a declaration and attested to facts based on his personal knowledge that were used to overcome the applicant's motion for summary judgment." Petition to Disqualify, p. 3; *Norac, Inc. v. Elementis Specialties, Inc.*, Opposition Nos. 91124364 & 91154897, Dkt. No. 48, 12 (TTAB Aug. 31, 2004) (emphasis added). Opposer references the same quote in its Response and then strangely claims that Disidual failed to accurately portray the reason for disqualification in *Norac*. See Response, p. 4. Opposer's claim of mischaracterization is baseless and confusing in light of the plain language of the *Norac* decision to which Disidual cites.

Second, in *J.M. Smucker Co. v. Weston Firm, P.C.*, the district court stated in pertinent part:

The record demonstrates that Attorney Weston is responsible for the creation, content, and maintenance of the website that is at the heart of this litigation. Moreover, in its own initial disclosures, TWF [The Weston Firm] identifies only two sets of persons likely to have discoverable information: 1) employees, officers, and directors of Smucker; and 2) Gregory S. Weston. Doc 21-5. Based on the briefings of the parties, and the oral arguments made on June 24, 2013, the Court finds that Attorney Weston's testimony would be both relevant and material.

Case No. 5:13 CV 0448, 2013 WL 3713457, at \*4 (N.D. Ohio July 15, 2013). While Opposer tries to downplay the importance of the initial disclosures in the district court's decision, the court makes specific mention of the fact that Attorney Weston was included in TWF's initial disclosures immediately preceding its finding that "Attorney Weston's testimony would be both relevant and material." Thus, there is no ignoring the fact that the identification of Attorney

Weston in the initial disclosures was important to the court's determination that Attorney Weston was a necessary witness.

Accordingly, Opposer's opposition not only fails to negate the evidence that Disidual put forth establishing that Mr. Egbert ought to be called to testify in this proceeding, but undoubtedly supports a ruling in favor of disqualification.

## **II. OPPOSER'S REQUEST FOR SANCTIONS IS INAPPROPRIATE AND UNWARRANTED.**

Opposer requests sanctions against Disidual, namely, that Disidual be required to seek approval from the Board prior to filing any future motions. Response, p. 5. In support, Opposer asserts that Disidual's Petition to Disqualify is frivolous. Response, p. 1. Disidual would prefer to ignore such an inappropriate and unwarranted request; however, it takes these accusations seriously and, therefore, must respond. Making the matter of the request more unfortunate, Opposer appears to have failed to comply with the Board's rules in seeking sanctions against Disidual.

Specifically, Opposer's request for sanctions is procedurally flawed. The rules are clear that a motion for sanctions must be made separately from any other motion and the motion must not be filed until 21 days after service of the motion to give the non-movant an opportunity to withdraw or appropriately correct the submission. Fed. R. Civ. P. 11(c)(2); Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 527.02. Opposer failed to comply with these requirements and, on that basis alone, Opposer's request for sanctions should be denied. *Id.*

Regarding the merits of Disidual's motions to date, the Board has not yet had a chance to decide the question of disqualification and, while Disidual may not have prevailed on its Motion to Strike Pled Registrations (Dkt. 7), there was no ruling that the earlier motion was presented for an improper purpose. Both the Motion to Strike Pled Registrations and the pending Petition to

Disqualify were (and remain) warranted by existing law or non-frivolous argument, and the allegations and other factual contentions set forth in these motions had evidentiary support in compliance with Rule 11 of the Federal Rules of Civil Procedure. Fed. R. Civ. P. 11(b). Disidual must be permitted to defend itself against and contest the claims asserted in Opposer's Notice of Opposition, which Disidual has done in full compliance with the Board's rules.

Disidual lastly submits that Opposer's request for sanctions is presented for an improper purpose in violation of Rule 11(b) of the Federal Rules of Civil Procedure, namely, to harass Disidual for vigorously defending its case. Disidual, however, considers any request for an appropriate Rule 11(c) sanction against Opposer to be premature insofar as the Board has yet to rule on the Motion to Disqualify, but Disidual reserves the right to seek relief to prevent any potential future harassment by Opposer.

### **III. CONCLUSION**

For the reasons set forth above, Disidual respectfully requests that the Board grant Disidual's Petition to Disqualify John S. Egbert.

Respectfully submitted,

DISIDUAL CLOTHING, LLC

Dated: January 29, 2015

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**CERTIFICATE OF FILING**

The undersigned affirms that DISIDUAL CLOTHING’S REPLY IN SUPPORT OF PETITION TO DISQUALIFY JOHN S. EGBERT was filed with the Trademark Trial and Appeal Board via the ESTTA electronic filing system on the date below.

Dated: January 29, 2015

/Craig Beaker/  
Craig A. Beaker

**CERTIFICATE OF SERVICE**

The undersigned affirms that DISIDUAL CLOTHING’S REPLY IN SUPPORT OF PETITION TO DISQUALIFY JOHN S. EGBERT was served by first class mail on the date below upon the following:

John S. Egbert  
Egbert Law Offices, PLLC  
1314 Texas, 21st Floor  
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Dated: January 29, 2015

/Craig Beaker/  
Craig A. Beaker