

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

Hartnett

INTS It Is Not The Same, GmbH

Plaintiff

v.

Disidual Clothing, LLC

Defendant

Opposition No. 91212768

Mailed: March 28, 2015

DECISION DENYING PETITION FOR DISQUALIFICATION

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

Applicant, Disidual Clothing, LLC (“Applicant”), submitted a petition to disqualify counsel John S. Egbert from representing Opposer, INTS It Is Not The Same, GmbH (“Opposer”), in Opposition No. 91212768 which is pending before the Board.²

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 Petitions to disqualify are governed by 37 CFR § 11.19(c) (“Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office . . . will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate”).

BACKGROUND

Applicant seeks to register the mark DISIDUAL for “apparel, namely, t-shirts, tank-tops, shorts, hats, jackets, sweatshirts, hooded sweatshirts, beanies, socks, pants, dresses, swimsuits, knit face masks, gloves, belts.”³ As grounds for opposition, filed October 2, 2013, Opposer alleges likelihood of confusion with its previously used and registered marks composed in whole or in part of the term DESIGUAL for numerous items, including clothing for at least some of the pleaded registrations.⁴ In its Answer, Applicant denied the essential allegations of the Notice of Opposition and counterclaimed to cancel Opposer’s pleaded Registration No. 2088319 for “clothing, namely footwear and headwear,” alleging abandonment. In its Answer, Opposer denied the essential allegations of the counterclaim.

On December 23, 2014, Applicant moved to disqualify Opposer’s attorney John S. Egbert under 37 CFR § 11.307(a) on the basis that “Mr. Egbert is likely to be a necessary witness in this case because 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.” 21 TTABVUE 2. Applicant also argues that Mr. Egbert does not fall under any of the exceptions to 37 CFR § 11.307(a) that would allow him to continue representation of the Opposer. *Id.*

³ Application Serial No. 85836544, filed January 30, 2013, claiming a date of first use anywhere and a date of first use in commerce of June 1, 2010.

⁴ Specifically, Opposer asserts ownership of Registration No. 2088319, issued August 12, 1997, renewed; Registration No. 3737499, issued January 12, 2010; Registration No. 3982329, issued June 21, 2011; Registration No. 4113640, issued March 20, 2012; and Registration No. 4269396, issued January 1, 2013.

In response, Opposer admits that “Mr. Egbert has filed and signed on behalf of Opposer for applications, statements of use, renewals, and/or declarations of use and incontestability” but he “signed those documents pursuant to a Power of Attorney that authorized him to sign and file the documents on behalf of [his client].” 23 TTABVUE 3. Opposer also argues that Mr. Egbert’s signature on the current Notice of Opposition was signed not in his personal capacity, but on behalf of his client. *Id.* Additionally, Opposer requests that this current motion be denied and requests sanctions against Applicant in the nature of requiring Applicant to obtain approval from the Interlocutory Attorney prior to filing future motions. *Id.* at 6.

In reply, Applicant argues that “all of the declarations signed by Mr. Egbert are based on his personal knowledge and/or on information and belief.” Applicant claims that Opposer has not introduced “a single piece of evidence to establish that Mr. Egbert made these statements pursuant to a power of attorney.” Applicant argues that Mr. Egbert’s signature does not mean that he is without personal knowledge of this matter. Applicant points to Opposer’s Initial Disclosures where Opposer “identified Mr. Egbert . . . as a person likely to have discoverable information regarding ‘Opposer’s knowledge of Opposer’s registration’” 24 TTABVUE 3. Applicant also responds to Opposer’s request for sanctions and asks the Board that such request be denied. *Id.* at 5.

FACTS

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

1. Opposer pleaded ownership of Registration Nos. 2088319; 3737499; 3982329; 4113640; and 4269396. 1 TTABVUE.
2. John S. Egbert was the attorney of record for the underlying applications which matured into Registration Nos. 2088319, 3737499; 3982329; and 4269396. Registration No. 2088319 TSDR “File Jacket” 3 of 3 (Mar. 02, 2007); 21 TTABVUE 37, 74, 89.
3. The underlying application, which matured into Registration No. 2088319, was signed by the named applicant. TSDR “Unclassified” 14 of 20 (Mar. 2, 2007).
4. Mr. Egbert signed, as “Attorney for Applicant,” the underlying applications which matured into Registration Nos. 3737499; 3982329; and 4269396. 21 TTABVUE 39, 76, 91
5. Mr. Egbert was appointed attorney for registrant for Registration No. 2088319 for purposes of filing the Combined Declaration of Use In Commerce & Application for Renewal of a Mark Under Section 8 & 9. *Id.* at 13.
6. Mr. Egbert signed the declaration in support of the combined filing, identifying his position as “Attorney for Registrant.” *Id.* at 12 and 14.
7. Mr. Egbert is identified as the “Attorney” for registrant for Registration No. 2088319 for purposes of filing the Combined Declaration of Use & Incomtestability (*sic*) Under §§ 8 & 15. *Id.* at 18.
8. Mr. Egbert signed the declaration in support of the combined filing, identifying his position as “Attorney for Registrant.” *Id.* at 19.

9. Mr. Egbert signed the Statements of Use for the underlying applications that matured into Registration Nos. 3737499, 3982329, 4269396 in his position as “Attorney of record.” *Id.* at 26, 48, 82.
10. Mr. Egbert is identified in Opposer’s Initial Disclosures as a person likely to have discoverable information about “Opposer’s knowledge of Opposer’s registrations; matters related to the filing of Opposer’s Notice of Opposition against Applicant’s application; information related to the current opposition proceeding.” *Id.* at 98.
11. Registration No. 4113640 is a registered extension of protection to the United States under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f. Mr. Egbert is identified as “Attorney of Record” for the underlying application, but no other submissions were offered with respect to this pleaded registration. 1 TTABVUE 36.

DISCUSSION

Section 11.307(a) of the **USPTO RULES OF PROFESSIONAL CONDUCT**, 37 CFR § 11.307(a), discusses when a practitioner for a party who may become a witness in a USPTO proceeding should be disqualified:

- (a) A practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be a necessary witness unless:
 - (1) The testimony relates to an uncontested issue;
 - (2) The testimony relates to the nature and value of legal services rendered in the case; or
 - (3) Disqualification of the practitioner would work substantial hardship on the client.

Thus, in determining whether or not disqualification is required the first consideration is whether the attorney is a necessary witness, and the second is, if necessary, does that attorney meet a listed exception.

An attorney will be considered a necessary witness where no other person is available to testify in his place. *Northbrook Digital, LLC v. Vendio Servs., Inc.*, 625 F.Supp. 2d 728, 765 (D. Minn. 2008). A necessary witness is one who offers evidence that is not available from another source. *See Horaist v. Doctor's Hosp. of Opelousas*, 255 F.3d 261, 267 (5th Cir. 2001); *Telectronics Proprietary, Ltd. v. Medtronic, Inc.*, 836 F.2d 1332, 1337, 5 USPQ2d 1424, 1428 (Fed. Cir. 1988) citing *SMI Indus. Canada Ltd. v. Caelter Indus. Inc.*, 586 F.Supp. 808, 817, 223 USPQ 742, 748 (N.D.N.Y. 1984) (an attorney as witness is one “who has crucial information in his possession that must be divulged”). An attorney is “likely to be a necessary witness where the proposed testimony is relevant, material, not merely cumulative, and unobtainable elsewhere.” *Carta v. Lumbermens Mut. Cas. Ins. Co.*, 419 F.Supp.2d 23, 29 (D. Mass. 2006) (quoting *Merrill Lynch Bus. Fin. Svcs., Inc. v. Nudell*, 239 F.Supp.2d 1170, 1173 (D. Colo. 2003)); and *Horaist*, 255 F.3d at 266. *See also Religious Technology Center v. F.A.C.T.Net, Inc.*, 945 F.Supp. 1470, 1474 (D. Colo. 1996) quoting *World Youth Day, Inc. v. Famous Artists Merchandising Exchange*, 866 F.Supp. 1297, 1302 (D.Colo. 1994) (“A lawyer is a ‘necessary’ witness if his or her testimony is relevant, material and unobtainable elsewhere.”). Without a showing by the petitioning party that the attorney has information only he may

attest to, that person will not be deemed a necessary witness. *See Macheca Transp. Co. v. Philadelphia Indem. Co.*, 463 F.3d 827, 833 (8th Cir. 2006).

A. An Attorney May Sign Verifications on Behalf of the Applicant or Registrant

An application for registration must include a verified statement signed by a “person properly authorized to sign on behalf of the applicant under § 2.193(e)(1).” 37 CFR § 2.33(a); TMEP § 804. Trademark Rule 2.193(e)(1), 37 CFR § 2.193(e)(1) provides, in relevant part, as follows:

... an application for registration, amendment to an application for registration, allegation of use under §2.76 or §2.88, request for extension of time to file a statement of use under §2.89, or an affidavit under section 8, 12(c), 15, or 71 of the Trademark Act must be sworn to or supported by a declaration under §2.20, signed by the owner or a person properly authorized to sign on behalf of the owner.

The Rule further identifies a person properly authorized to verify the facts on behalf of the owner as:

- (i) A person with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership);
- (ii) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or
- (iii) An attorney as defined in §11.1 of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the owner.

Additionally, in all opposition proceedings “[t]he opposition need not be verified, but must be signed by the opposer or the opposer’s attorney” 37 CFR § 2.101(b); TBMP § 309.01.

The USPTO clearly permits an attorney to sign the verification (e.g., a declaration) in support of an application, and other specified filings, on behalf of the applicant. Indeed, it is common for attorneys to do so. The mere signing of the

declaration does not make an attorney a “necessary witness.” Moreover, a power of attorney is only one way for an attorney to be recognized as a representative before the USPTO. An attorney may also be recognized if s/he signs a document or appears on behalf of an applicant, registrant or party to a proceeding who is not already represented by a practitioner. *See* 37 CFR § 2.17(b); and TMEP § 604.01. Thus, contrary to Applicant’s argument, evidence of record establishes that Mr. Egbert is recognized as Opposer’s representative before the USPTO and is properly authorized to sign the documents at issue on behalf of Opposer.

While Mr. Egbert signed the aforementioned documents on behalf of his client, he has not created a circumstance where he alone would need to testify to the contents of those documents. There has been no showing by Applicant that Mr. Egbert is the sole source of the information for which the documents in question were submitted. Mr. Egbert was merely a permitted signatory. Evidence and information as to the contents of those submissions can be found elsewhere. Thus, Mr. Egbert is not a necessary witness. In passing, a policy of disqualifying an attorney for signing a declaration on behalf of his client, especially where it is permitted by the Trademark Rules of Practice, without anything more, would have an undesired consequence of rendering many attorneys practicing before the Board eligible for disqualification.

B. Mr. Egbert’s Identification in Opposer’s Initial Disclosures

As noted earlier, Mr. Egbert is identified Opposer’s Initial Disclosures as a person likely to have discoverable information about:

- (i) Opposer's knowledge of Opposer's registrations;
- (ii) matters related to the filing of Opposer's Notice of Opposition against Applicant's application; and
- (iii) information related to the current opposition proceeding.

It is apparent from the stated topics that Mr. Egbert is identified with respect to information limited to the ministerial aspects associated with filing the applications, subsequent submissions in connection with the applications and registrations (e.g., Statements of Use, Section 8 and 9 filings), and the technical information regarding this proceeding. Such information is also available from USPTO databases and from Opposer. Although the identification of Mr. Egbert in the initial disclosures is unusual, the topics stated do not make him a "necessary witness."⁵

DECISION

The petition for disqualification of John S. Egbert as counsel for Opposer in Opposition No. 91212768 is DENIED.

SANCTIONS

In its response to the petition to disqualify Opposer requests sanctions against Applicant in the form of requiring approval from the Interlocutory Attorney prior to filing future motions. In support of its request, Opposer contends that Applicant seeks to delay this proceeding, and increase the costs to Opposer, by filing motions Opposer believes are meritless. Opposer argues that a trend is emerging based on the earlier denial of Applicant's motion to strike Opposer's pleaded registrations and the petition to disqualified, denied herein. However, because a confirmed

⁵ If appropriate, Opposer may amend its initial disclosures promptly. See Fed. R. Civ. P. 26(a); TBMP § 408.03.

pattern has not yet emerged, Opposer's motion for entry of sanctions is DENIED without prejudice. That is, should a clear pattern of delay emerge, the Board may enter sanctions against Applicant either under its own authority or upon consideration of a motion brought by Opposer.

It is apparent that Applicant is not familiar with practice before the USPTO in trademark application filings and opposition proceedings. Applicant is urged to become familiar with such practice as described in both the TMEP and the TBMP.

RESET SCHEDULE

Proceedings are resumed and dates are reset as follows:

Initial Disclosures Due	April 20, 2015
Expert Disclosures Due	August 18, 2015
Discovery Closes	September 17, 2015
Plaintiff's Pretrial Disclosures	November 1, 2015
30-day testimony period for plaintiff's testimony to close	December 16, 2015
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	December 31, 2015
30-day testimony period for defendant and plaintiff in the counterclaim to close	February 14, 2016
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	February 29, 2016
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	April 14, 2016

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking testimony. Trademark Rule 2.125. Briefs shall be filed in

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accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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