

TTAB

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD	
In the Trademark Cancellation of:  Chaos Holdings, Inc. <div style="text-align: right;">Petitioner</div> <div style="text-align: center;">v.</div> Luxottica Leasing S.P.A. (Assignee of Bausch & Lomb, Inc.) <div style="text-align: right;">Registrant</div>	Cancellation No. 30,782  Date: December 13, 2002

**TRANSMITTAL LETTER ACCOMPANYING  
 MOTION FOR SUSPENSION OF PROCEEDINGS  
 AND REQUEST FOR PERMISSION TO WITHDRAW**

Box TTAB NO FEE  
 Commission for Trademarks  
 2900 Crystal Drive  
 Arlington, VA 22202-3513



12-16-2002

U.S. Patent & TMO/c/TM Mail RcptDt. #7

Sir or Madam:

Enclosed for filing are the following:

1. Motion For Suspension of Proceeding;
2. Volpe and Koenig, P.C.'s Request for Permission to Withdraw as Attorneys of Record; and

Certificate of Mailing and Service

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Box TTAB NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on December 13, 2002.

I further certify that a copy of this correspondence is being served upon Registrant by forwarding the same via first class mail to Michael A. Grow, Esquire, Arent Fox Kintner Plotkin & Kahn, PLLC, 1050 Connecticut Avenue, NW, Washington, DC 20036, on December 13, 2002.

12/13/02  
 Date of Signature

Frank A. Mazzeo  
 Registration No. 46,259

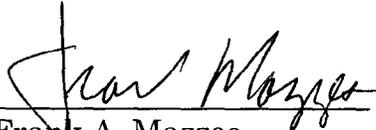
SAB

**TRADEMARK**  
**Cancellation No.: 30,782**

3. Memorandum of Law in Support of Volpe and Koenig, P.C.'s Request for Permission to Withdraw as Attorneys of Record.

Respectfully submitted,

Chaos Holdings, Inc.

By   
Frank A. Mazzeo  
Registration No. 46,259  
(215) 568-6400  
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FAM/md

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD	
In the Trademark Cancellation of:  Chaos Holdings, Inc. <div style="text-align: right;">Petitioner</div> <div style="text-align: center;">v.</div> Luxottica Leasing S.P.A. (Assignee of Bausch & Lomb, Inc.) <div style="text-align: right;">Registrant</div>	Cancellation No. 30,782  Date: December 13, 2002

### MOTION FOR SUSPENSION OF PROCEEDINGS

Box TTAB NO FEE  
 Commissioner for Trademarks  
 2900 Crystal Drive  
 Arlington, VA 22202-3513



12-16-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #75

Sir or Madam:

Petitioner, Chaos Holdings, Inc., hereby moves to suspend these proceedings. The discovery period is currently scheduled to end on February 14, 2003.

On February 11, 2002, Petitioner filed for bankruptcy under Chapter 11 in the Northern District of Alabama. As a result of its financial condition and the bankruptcy, Petitioner is not able to continue with this cancellation proceeding at this time. Accordingly, Petitioner requests that the proceedings be suspended until it comes out of bankruptcy.

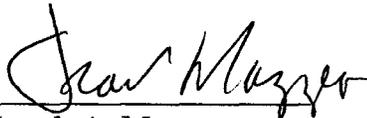
On even date, Petitioner's counsel filed a Request for Permission to Withdraw as Attorneys of Record and a supporting Memorandum of Law, true and correct copies of which are attached here to and collectively marked as Exhibit "A."

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Petitioner respectfully requests that its Motion for a Suspension of the Proceedings be granted.

Respectfully submitted,

Chaos Holdings, Inc.

By   
Frank A. Mazzeo  
Registration No. 46,259  
(215) 568-6400  
Attorney for Petitioner

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FAM/cfj  
Enclosures



**TRADEMARK**

<b>IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD</b>	
In the Trademark Cancellation of:  Chaos Holdings, Inc. <p style="text-align: right;">Petitioner</p> v.  Luxottica Leasing S.P.A. (Assignee of Bausch & Lomb, Inc.) <p style="text-align: right;">Registrant</p>	Cancellation No. 30,782  Date: December 13, 2002

**MEMORANDUM OF LAW IN SUPPORT OF VOLPE AND KOENIG, P.C.'S  
REQUEST FOR PERMISSION TO WITHDRAW AS ATTORNEYS OF  
RECORD**

**I. NATURE AND STAGE OF PROCEEDINGS**

On May 2, 2000, Petitioner Chaos Holdings, Inc. (Chaos) filed a Petition for Cancellation against Registrant Bausch & Lomb, Inc. (Bausch) relative to Bausch's registration for the mark CHAOS, Registration No. 2,054,723. Chaos had filed trademark application No. 75,681,866 for CHAOS. Luxottica Leasing, S.P.A. is the assignee of Bausch. The case has been assigned Case No. 30,782.

On July 29, 2002, the Trademark Trial and Appeal Board issued an order ending a period of suspension and scheduling the discovery period to end on February 14, 2003.

**II. FACTS**

Walter Sims, acting as president of Chaos, originally retained Louis Weinstein, Esquire and Weinstein and Kimmelman to serve as counsel for litigating

the Petition for Cancellation on Chaos' behalf. However, when Weinstein and Kimmelman merged with Volpe and Koenig in 2000, Chaos retained Volpe and Koenig for the Petition for Cancellation.

At all times relevant hereto, Louis Weinstein, Frank A. Mazzeo and Volpe and Koenig served as counsel to Chaos, and adequately kept Mr. Sims informed and updated on this matter.

On February 11, 2002, Chaos filed for bankruptcy under Chapter 11 in the Northern District of Alabama. Over the course of the past several months, Mr. Sims has failed to respond to almost all correspondence (e-mails and letters) sent from Volpe and Koenig. Based on Mr. Sims' refusal to respond to its communications, Volpe and Koenig recently sent Mr. Sims a series of letters indicating their clear intention to withdraw as counsel in this matter in the event that Mr. Sims did not forward a retainer.<sup>1</sup> As Mr. Sims has neither forwarded a retainer, nor responded in a timely fashion to these letters, e-mails, phone calls, and other communications, Volpe and Koenig is now moving to withdraw as counsel for Chaos in this matter.

### **III. ARGUMENT**

As the procedural posture described above indicates, the discovery period in the cancellation proceeding is due to end on February 14, 2003. Due to Mr. Sims' refusal to forward a retainer and communicate with his counsel in this matter, he

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<sup>1</sup> Copies of the correspondence between Volpe & Koenig, P.C. and Mr. Sims have not been attached as it involves privileged attorney-client communications. The correspondence can be provided at the request of this Board for an *in camera* inspection.

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has made it impossible for Volpe and Koenig to continue to represent him. Accordingly, Volpe and Koenig should be permitted to withdraw from representation of Chaos in this matter.

37 C.F.R. § 2.19(b) states, “[a]n individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Commissioner.” See also 37 C.F.R. 10.40(a). A request for permission to withdraw as attorney of record shall include the following five enumerated elements:

- (1) A statement of the reason(s) for the request to withdraw. See 37 C.F.R. § 10.40;<sup>2</sup>
- (2) A statement that the attorney has given due notice to the applicant that the attorney is withdrawing from employment and will be filing the necessary papers with the United States Patent and Trademark Office. See In re Legendary, Inc., 26 U.S.P.Q.2d 1478 (Comm'r Pats. 1992);
- (3) A statement that the attorney has delivered to the applicant all papers and property in the attorney's file concerning the prosecution of the application. See In re Legendary, Inc., supra;
- (4) A statement that the attorney notified the applicant of any responses that may be due and the time frame within which applicant must respond; and

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<sup>2</sup> 37 C.F.R. § 10.40(c) states in pertinent part:

(c) Permissive withdrawal... a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

(1) The petitioner's client:

...  
(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

...  
(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

(5) A statement that the applicant was given notice of the attorney's withdraw from employment at least two months prior to the expiration of the response period.<sup>3</sup>

In re Slack, 54 U.S.P.Q.2d 1504, 1506 (Comm'r Pats. 2000).

In the present matter, Volpe and Koenig has sufficient grounds to withdraw pursuant to 37 C.F.R. § 10.40(c). Chaos has made it unreasonably difficult for Volpe and Koenig to continue representation since Mr. Sims has refused to respond to Volpe and Koenig's communications. Chaos also has failed to pay a retainer in advance, even after Volpe and Koenig's repeated letters requesting such a retainer. Accordingly, Volpe and Koenig have sufficiently satisfied the grounds for withdraw as set forth in § 10.40(c).

Volpe and Koenig has provided Mr. Sims with adequate notice of their intention to withdraw. From May, 2002 through the present, Volpe and Koenig repeatedly contacted Mr. Sims informing him of their intention to withdraw provided that he does not forward a retainer. Finally, by letter dated August 28, 2002, Volpe and Koenig informed Mr. Sims of their intention to file a request to withdraw with the United States Patent and Trademark Office.

Additionally, Volpe and Koenig routinely forwards all papers and property in Chaos' file to Mr. Sims. Volpe and Koenig also continues to inform Mr. Sims of any responses that may be due and the time frame within which he must respond. For

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<sup>3</sup> Prior to Slack, requests to withdraw were generally only granted if there was at least thirty (30) days between the time the Office *approved withdraw* and the expiration date of a response period. See TMEP § 602.03(a). However, the Commissioner in Slack changed this policy requiring only that applicant receive timely and sufficient notice of the attorney's intent to withdraw, regardless of whether there is 30 days between the approval of the request to withdraw and the expiration of the response period.

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example, by a letter sent via e-mail and regular mail on September 12, 2002, Volpe and Koenig informed Mr. Sims that the discovery period end date had been reset for February 14, 2003.

The final element set forth in Slack requires that “the applicant was given notice of the attorney’s withdrawal from employment at least two months prior to expiration of the response period.” The “response period” in Slack referred to the period for responding to an office action in an application for trademark registration. In the instant situation, Volpe and Koenig by its communications to Mr. Sims on September 12, 2002, provided Mr. Sims with notice that it was withdrawing at least more than five months before the discovery deadline. Additionally, Volpe and Koenig is concurrently filing a motion to suspend the proceedings due to Chaos’ bankruptcy. A true and correct copy of the motion is attached hereto and marked as Exhibit “A.”

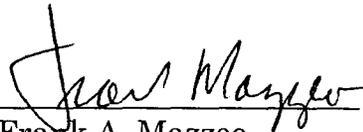
Accordingly, withdrawal should be permitted in this case, as withdrawal will not result in any prejudice to the Chaos, and Volpe and Koenig has proper grounds to withdraw.

IV. CONCLUSION

For the reasons set forth above, this Court should grant Volpe and Koenig's Request for Permission to Withdraw as Attorney of Record for Chaos Holdings, Inc.

Respectfully submitted,

Chaos Holding, Inc.

By 

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