

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR OF THE UNITED STATES PATENT AND
TRADEMARK OFFICE

*Upper Shirley Vineyards, LLC and
Shirley Plantation LLC*

*Shirley Plantation, LLC and Charles
H. Carter*

Plaintiffs

v.

Stillhouse Vineyards, LLC

Defendant

Opposition No. 91215114

Opposition No. 91216395

Opposition No. 91218094

Mailed: November 18, 2015

DECISION GRANTING IN PART AND DENYING IN PART PETITION FOR
DISQUALIFICATION

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

Upper Shirley Vineyards, LLC, Shirley Plantation, LLC and Charles H. Carter (also collectively “Opposers”) filed a Petition to Disqualify counsel, Philip Carter Strother, and the law firm of Strother Law Offices, PLC from representing Stillhouse Vineyards, LLC (also “Applicant”) on the basis that Mr. Strother may be

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 (2015). Under the delegation, the authority to decide this petition was further delegated.

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called as a witness in these proceedings.² Applicant has not filed any response to either of the two nearly-identical Petitions.

BACKGROUND

Applicant seeks to register the following marks” SHIRLEY PLANTATION (Serial No. 85947562, the subject matter of Opposition No. 91215114); SHIRLEY (Serial No. 86121979, the subject matter of Opposition No. 91216395); and a design consisting of a coat of arms (Serial No. 86129686, the subject matter of Opposition No. 91218094) all for, essentially, wines.

Consolidated Opposition Nos. 91215114 and 91216395

In both proceedings, Upper Shirley Vineyards, LLC (“Upper Shirley”) and Shirley Plantation LLC (“Shirley Plantation”) allege that Applicant’s marks (SHIRLEY PLANTATION and SHIRLEY) create a false suggestion of a connection with Upper Shirley and Shirley Plantation; that Applicant’s marks are primarily geographically deceptively misdescriptive; that Applicant’s marks are geographical indications; and that Opposers have priority of use and likelihood of confusion exists. Opposers additionally assert dilution in Opposition No. 91216395.

Opposition No. 91218094

Shirley Plantation and Charles H. Carter, the owner of the historic Shirley Plantation, assert that the design mark Applicant seeks to register is the Carter coat of arms, which is strongly associated with the historic Shirley Plantation; that

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”).

Applicant's mark creates a false suggestion of a connection with Shirley Plantation and with Mr. Carter; that Opposers have priority of use and likelihood of confusion exists; that Applicant's design does not function as a trademark; and that Applicant, at the time it filed its application, was not the rightful owner of the mark.

Arguments

Opposers filed Petitions to Disqualify Mr. Strother on the basis that he will be a witness in the proceedings. Opposers point out that Mr. Strother has been identified in Applicant's Supplemental Initial Disclosures and Responses to Opposers' First Set of Interrogatories as knowledgeable about the facts in dispute.³ For example, in response to Interrogatory No. 1, Mr. Strother is identified as Applicant's "Managing Member" who "runs the company." In response to Interrogatory No. 6, he is identified as the person most knowledgeable about "advertising and promotion," "sales and distribution." In response to Interrogatory No. 24, he is identified as the person who assisted in providing answers to the interrogatories. He signed the interrogatory responses as "Managing Member" of Stillhouse Vineyards, LLC. Attorney Jarrod A. Thomas signed the responses as counsel for Applicant.

Opposers argue that, because it is inappropriate for Mr. Strother to continue as counsel for Applicant, a disqualification extends to all members of his firm. In this regard, it is noted that Mr. Thomas of the Strother Law Offices is the signatory to

³ To be clear, the documents identified pertain to consolidated Opposition No. 91215114. However, Shirley Plantation and Mr. Carter incorporate these documents by reference in Opposition No. 91218094.

all filings in the opposition proceedings, although both Mr. Strother and Mr. Thomas are currently named in TTABVUE records as counsel for Applicant.

DISCUSSION

Section 11.307 of the USPTO RULES OF PROFESSIONAL CONDUCT (“USPTO Rules”), 37 CFR § 11.307, addresses the situation where a practitioner may be called as a witness:

(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.

(b) A practitioner may act as advocate in a proceeding before a tribunal in which another practitioner in the practitioner’s firm is likely to be called as a witness unless precluded from doing so by §§ 11.107 or 11.109.

It is clear that Mr. Strother owns and operates Applicant. He has been identified by Applicant as a potential witness, and as a person knowledgeable about facts relevant to the dispute between the parties. He has not been active in the representation of Applicant in these proceedings. As noted, Applicant did not respond to either of the Petitions to Disqualify Mr. Strother and has thus conceded Opposers’ request for disqualification. Accordingly, disqualification is appropriate. USPTO RULE 11.307(a); Trademark Rule 2.127(a), 37 CFR § 2.127(a).

The question becomes whether the other members of Mr. Strother’s firm, particularly Mr. Thomas, must be disqualified. USPTO RULE 11.307(b) does not require disqualification unless there is a concurrent conflict of interest, USPTO

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RULE 11.107, or a conflict of interest arising from a former representation of an adversary, USPTO RULE 11.109. Neither exists here. Accordingly, disqualification is not required.

In view of Mr. Strother's disqualification, and the continuing representation by other members of his firm, particularly Mr. Thomas, the firm is to take appropriate measures to screen Mr. Strother from information and documents obtained by the firm in connection with these cases. Mr. Thomas, and anyone else with the firm working on the cases have a duty not to disclose any such information and documents to Mr. Strother. The firm is to provide Opposers with information about what steps have been taken and put in place to so screen Mr. Strother.

Mr. Strother's firm appears to be small. In view of Mr. Strother's ownership interest in Applicant, the firm is in a situation analogous to that of in-house counsel. While a screen likely will be sufficient in addressing Opposers' concerns regarding discovery responses it may designate as trade secret/commercially sensitive, Applicant may need to retain separate counsel. *See* TBMP § 412.02(b). Opposers are reminded of their duty to make such designations in good faith. *See* TBMP §§ 412.01(a) – (c).

DECISION

The Petition for Disqualification of Philip Carter Strother as counsel of record for Applicant in these proceedings is GRANTED. The Petition for Disqualification of other attorneys with the Strother Law Offices, PLC and of the firm is DENIED.

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Applicant is allowed until **TWENTY DAYS** from the mailing date of this order to remove Mr. Strother's email address from the correspondence address of record and as attorney of record, failing which, the Board will amend the record to reflect Mr. Thomas as attorney of record and to remove Mr. Strother's email.

PROCEDURAL MATTERS

Opposition No. 91218094 is hereby consolidated with Opposition Nos. 91215114 and 91216395 for judicial economy. *See* TBMP § 511.

The parties' stipulated motion, filed August 28, 2015 in consolidated Opposition No. 91215114, to extend Opposers' time to respond Applicant's discovery requests is granted. Opposers' unconsented motion, filed August 18, 2015 for such an extension, is moot.

SCHEDULE

On August 19, 2015, Opposers filed a motion to compel in consolidated Opposition No. 91215114. Shortly thereafter, proceedings were suspended pending a decision on Opposers' Petition for Disqualification.

Applicant is allowed until **TWENTY** days from the mailing date of this order to serve and file a response to Opposers' motion. Proceedings otherwise remain suspended. Trademark Rule 2.120(e)(2), 37 CFR § 2.120(e)(2).

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