

ESTTA Tracking number: **ESTTA746196**

Filing date: **05/12/2016**

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

Proceeding	91226018
Party	Defendant Wild Rabbit LLC
Correspondence Address	DEREK QUICK STRASBURGER & PRICE LLP 720 BRAZOS SUITE 700 AUSTIN, TX 78701-3248 UNITED STATES derek.quick@strasburger.com, susan.millsapps@strasburger.com
Submission	Other Motions/Papers
Filer's Name	Derek Quick
Filer's e-mail	derek.quick@strasburger.com
Signature	/s/ Derek Quick
Date	05/12/2016
Attachments	Reply to Response to Petition to Disqualify G. Michael Roebuck.pdf(24356 bytes ) Ex A.pdf(110619 bytes )

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

<b>G. MICHAEL ROEBUCK, PC,</b>	§	
<b>Opposer,</b>	§	Mark: Rabbit Wilde
<b>v.</b>	§	
<b>WILD RABBIT, LLC</b>	§	Serial No. 86609919
<b>Applicant.</b>	§	Opposition No. 91226018
	§	

**REPLY TO RESPONSE TO PETITION TO  
DISQUALIFY G. MICHAEL ROEBUCK**

Applicant Rabbit Wilde, LLC, formerly known as Wild Rabbit, LLC (“Rabbit Wilde” or “Applicant”), through its undersigned counsel, files this reply to the response to Applicant’s Petition to Disqualify attorney G. Michael Roebuck (“Mr. Roebuck”) from serving as counsel for Opposer G. Michael Roebuck, P.C. (“Opposer”), and respectfully shows as follows.

**ARGUMENTS IN REPLY**

In its response, Opposer does not argue that Mr. Roebuck is not a necessary, material witness in this proceeding, that Opposer will suffer substantial hardship if Mr. Roebuck is not allowed to represent Opposer, or that Mr. Roebuck is only testifying on issues within the exception to the advocate-witness rule. Instead, Opposer bases its response on an order denying a petition to disqualify in *Koehler v. Toytrackerz*, Cancellation No. 92049784 (TTAB 5 Nov. 2008). According to Opposer, Mr. Roebuck should not be disqualified from serving as Opposer’s counsel in this proceeding because he has recently made an appearance as the

“President-Owner” of Opposer, such that he is entitled to represent Opposer under *Koehler* and 37 CFR § 11.14(e).<sup>1</sup>

Although the Administrative Trademark Judge in *Koehler* did deny a petition to disqualify on the grounds that the attorney was “the owner of Toytrackerz LLC and not a practitioner representing Toytrackerz as her client,” that case should not be followed here for a number of reasons. First, unlike in *Koehler*, Opposer’s alleged rights to the mark “Wild Rabbit Salad” are based entirely on use by other individuals – the members of the band Wild Rabbit Salad – *not* Opposer (which is Mr. Roebuck’s professional corporation). Thus, Mr. Roebuck is not appearing solely for Opposer as its owner/representative, but he is also in effect attempting to represent other individuals and their band, which Opposer claims is a “related company” for purposes of establishing use of the mark in question. *See* Document No. 8, at ¶ 2 (“A Related Company has solely used the mark ‘Wild Rabbit Salad’ in commerce in class 41 for ‘Entertainment, namely, live performances by a musical band’ continuously at least as early as September 18, 2009 whose use inures to the benefit of the Opposer.”). This alone distinguishes *Koehler* from the present case.

Notably, Opposer did not dispute that none of the band members of Wild Rabbit Salad are members, managers, or directors of Michael Roebuck, P.C., nor does Opposer allege that Mr. Roebuck is a member of the band. In fact, nowhere in its response does Opposer even mention the band or address why Mr. Roebuck should be allowed to serve as a representative for the band or any of its members. Because Opposer is claiming the band is a “related company” of

---

<sup>1</sup> Mr. Roebuck originally appeared as counsel for Opposer, but four days before the Response to the Petition to Disqualify was filed, Mr. Roebuck filed a notice of appearance as “President-Owner” of G. Michael Roebuck, PC. *See* Document No. 10. This was presumably an attempt to fall within the confines of *Koehler*, as the attorney in that proceeding argued that she was not “counsel of record” in the case, and instead was only appearing as a pro se owner/officer of the corporation. Mr. Roebuck, however, *did* originally appear as counsel for Opposer, as reflected in Opposer’s Notice of Opposition (Document No. 1) and Opposer’s Answer to Counterclaim (Document No 8).

Opposer, such that the band's use allegedly inures to the benefit of Opposer (which Applicants dispute), Applicant requested that Mr. Roebuck be precluded from serving as counsel in this proceeding, *including* any representation of the band Wild Rabbit Salad. *See* Motion at 4 and n.4. Given that Mr. Roebuck will be a key fact witness, including with respect to the relationship between Wild Rabbit Salad and Opposer, and the control Opposer has over Wild Rabbit Salad, if any, Mr. Roebuck should be disqualified from serving as counsel for *either* the entity G. Michael Roebuck, PC or the members of the band Wild Rabbit Salad (individually or collectively). But at the very least, Mr. Roebuck should be precluded from representing any of the members of the band (individually or collectively), especially since Opposer offered no argument to the contrary.

In addition, *Koehler* is not the sole authority on whether an attorney should be disqualified when the attorney also serves as a representative of a corporate entity. Indeed, several cases have held that counsel *should* be excluded because of the advocate-witness rule, even though they involved a person who would qualify as an internal "representative" of the client (and notably, the petitioner in *Koehler* failed to cite any such cases in bringing its petition to disqualify – or even respond to the attorney's argument on this point). *See, e.g., Acme Analgesics, Ltd. v. Lemmon Co.*, 602 F. Supp. 306, 306-307 (S.D.N.Y. 1985) (disqualifying attorney from representing plaintiff corporation where attorney was an officer and a major shareholder of the corporation and the attorney would be a material witness at trial); *Amalgamated Servs. & Allied Indus. Joint Bd. v. Supreme Hand Laundry*, 94 Civ. 2904 (MGC), 1996 U.S. Dist. LEXIS 14962, \*9-17 (S.D.N.Y. Oct. 9, 1996) (attorney and sole shareholder of several defendants disqualified); *J.J. Smucker Co. v. Weston Firm, P.C.*, Case No. 5:13 CV 0448, 2013 WL 3713457, 2013 U.S. Dist. LEXIS 98371, at \*9-12 (N.D. Ohio July 15, 2013) (disqualifying attorney "Gregory Weston" of "Weston Firm, P.C." where Mr. Weston had

personal knowledge of maintenance of law firm website and the website's use of plaintiff's trademarks); *see also Gasoline Expressway, Inc. v. Sun Oil Co.*, 64 A.D.2d 647, 647-648 (App. Div. 1978), *aff'd*, 47 N.Y.2d 847, 392 N.E.2d 572, 418 N.Y.S.2d 585 (1979) (sole owner of corporate party disqualified from representing corporation).

In *Acme Analgesics*, just like in this case, the attorney was “a material, if not the key, witness,” and the court held that the neither the attorney's status as an officer or his ownership in the plaintiff entity granted the corporation the “right to select its own counsel when such selection is clearly contrary to the Code of Professional Responsibility.” *Acme Analgesics*, 602 F. Supp. at 307. Notably, the court did not even believe it was a close call on whether the attorney should be disqualified, stating “[i]t is difficult to understand the opposition to this motion to disqualify.” *Id.* at 306.

In *Amalgamated Servs.*, the plaintiffs moved to disqualify an attorney where the attorney was the sole shareholder of four of his clients who were defendants in the action. In disqualifying an attorney, the court noted how it was clear that the attorney's testimony was necessary on the issue of the corporate relationships among the defendants that he both owns and represents. *Amalgamated Servs.*, 1996 U.S. Dist. LEXIS 14962 at \*9. Similarly here, although Mr. Roebuck does not appear to “own” Wild Rabbit Salad, Opposer claims that it is a related company, and the relationship between the band and Opposer is a key issue in the proceeding.

Opposer's argument that Mr. Roebuck should be able to represent Opposer as its Owner and President was also rejected in *Gasoline Expressway*. There, the attorney was the sole shareholder of the corporate plaintiff – just like Mr. Roebuck – and the attorney argued that disqualification would improperly deny her the right of appearing *pro se*. In rejecting the argument, the court stated:

That contention, despite its superficial appeal, must be rejected. Having made the decision to conduct business in a corporate form, thereby reaping the various advantages of the ‘corporate veil,’ the attorney may not be permitted to avoid the coexistent encumbrances of that corporate veil. The plaintiff’s corporate status must be strictly adhered to and the roles of shareholder and advocate may not be merged. By incorporating, the attorney must be deemed to have waived the right to appear pro se.

*Gasoline Expressway, Inc. v. Sun Oil Co.*, 64 A.D.2d at 648. Similarly, in *J.J. Smucker Co.*, an attorney (Gregory Weston) was disqualified from representing his professional corporation, Weston Firm, P.C., because he was a material fact witness. 2013 U.S. Dist. LEXIS 98371, at \*9-12.

Again, as noted above, the party petitioning for disqualification in *Koehler* failed to cite any case law on this issue or even respond to the attorney’s argument. And in stating that “courts have often not disqualified the attorneys” when they are representing entities of which they are a member, *Koehler* only cites to a handful of state court decisions and does not address any of the federal case law to the contrary. *See Koehler*, at 5. Thus, the board can instead follow one of the many federal cases cited herein, notwithstanding *Koehler*.

Finally, it should be noted that the attorney in *Koehler* was actually prohibited from serving as counsel in several respects in a related federal lawsuit. Specifically, in *Toytrackerz LLC et al. v. Koehler et al.*, D. Kan. Case No. 08-2297-GLR, the judge recognized the corporate party’s right to have the attorney serve as its corporate representative, but the court nevertheless precluded the attorney from serving *as counsel* at trial, from taking and defending depositions in this case, and from participating as counsel in any evidentiary hearing. *See Memorandum and Order attached hereto as Ex. A; see also J.J. Smucker Co.*, 2013 U.S. Dist. LEXIS 98371, at \*13 (“Attorney Weston may continue to represent TWF as the corporate representative, but is disqualified as acting as TWF’s attorney.”).

**CONCLUSION AND PRAYER**

For all these reasons, as well as those addressed in the Petition, Applicants respectfully request that its Petition to Disqualify Mr. Roebuck be granted, and that Mr. Roebuck be prohibited from serving as counsel in this proceeding. Additionally or alternatively, Applicants request that Mr. Roebuck be prohibited from serving as counsel for the band Wild Rabbit Salad or any of its individual members.

Dated: May 12, 2016

Respectfully submitted,

*/s/ Derek Quick*

Derek Quick

State Bar No. 24072471

**STRASBURGER & PRICE, LLP**

720 Brazos, Suite 700

Austin, Texas 78701-3248

Telephone: (512) 499-3600

Facsimile: (512) 499-3660

E-mail: [derek.quick@strasburger.com](mailto:derek.quick@strasburger.com)

**ATTORNEYS FOR APPLICANT**

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Petition to Disqualify has been served on opposing counsel by mailing said copy on May 12, 2016, via first class mail, postage prepaid to the following:

G. Michael Roebuck  
Michael Roebuck, PC  
6750 West Loop South Suite 920  
Bellaire, TX 77401  
UNITED STATES  
mroebuck@roebuckiplaw.com  
Phone: 7133763053

*/s/ Derek Quick*

Derek Quick

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF KANSAS

TOYTRACKERZ LLC,  
and NOAH C. COOP,

Plaintiffs,

Civil Action

v.

Case No. 08-2297-GLR

L. JILL KOEHLER,  
et al.,

Defendants.

**MEMORANDUM AND ORDER**

Pending before the Court is the Motion to Disqualify Counsel (doc. 68), filed by Defendants Koehler, Kosowski, and Bone.<sup>1</sup> Defendants seek to disqualify attorney Terri Coop from serving as counsel of record for Plaintiffs Toytrackerz LLC and Noah C. Coop. They argue that Ms. Coop should be disqualified from representing Plaintiffs because she is a material and essential witness under Kansas Rule of Professional Conduct 3.7. Defendants note that Ms. Coop was disqualified from representing Toytrackerz and Noah Coop in a prior case, *American Plastic Equipment, Inc. v. Toytrackerz, LLC*, et al., D. Kan. Case No. 07-2253-DJW. They argue for her disqualification here for the same reasons she was disqualified in that case. Ms. Coop and Plaintiff Noah Coop operate the family company Toytrackerz LLC, the co-Plaintiff in this case. Ms. Coop is the designated corporate representative for Plaintiff Toytrackerz LLC. More specifically the instant motion asks that Ms. Coop be disqualified from any of the following procedures:

1. Serving as trial counsel for Plaintiffs;

---

<sup>1</sup>Defendant Bone was dismissed from the action for lack of personal jurisdiction on May 28, 2009 (doc. 80).



2. Taking or defending depositions in this case;
3. Representing Plaintiffs Toytrackerz LLC or Noah Coop at the hearing on the motion for preliminary injunction;
4. Subscribing pleadings or submitting papers as attorney for either Plaintiff; and
5. Being present in the courtroom during any evidentiary hearing, except when testifying as a witness.

In response, Plaintiffs suggest that Ms. Coop is aware of the rules of conduct and that outside counsel would be required for any evidentiary hearings and trial. They argue, however, that Rule of Professional Conduct 3.7(a) does not disqualify Ms. Coop from serving as corporate representative for Plaintiff Toytrackerz LLC. Plaintiffs state they will retain attorney Justin Meeks of Fort Scott, Kansas, to serve as their counsel for trial, other hearings, and for depositions. Plaintiffs claim the right or privilege, nevertheless, for Ms. Coop to serve as the designated representative of Toytrackerz LLC, and in that capacity to be present during any depositions, evidentiary hearings, and trial.

For the reasons stated in the March 31, 2009 Memorandum and Order entered by Judge Waxse in Case No. 07-2253, the Court sustains the motion to disqualify Terry Coop from serving as counsel for Plaintiffs at trial, from taking and defending depositions in this case, and from participating as counsel in any evidentiary hearings. The motion is otherwise denied for the reasons stated in response of Plaintiffs. As a corporate party, Plaintiff Toytrackerz LLC has a right to be present by a corporate representative at trial and other evidentiary hearings and during depositions. The fact that Terry Coop may be disqualified from serving as its counsel of record does not disqualify her from attending those proceedings as the representative of Plaintiff Toytrackerz LLC. As a managing member of Toytrackerz she may serve as its representative for those purposes. That she may have knowledge and may testify as to relevant facts does not disqualify her from serving

as the representative of Toytrackerz for trial and other matters. Defendants castigate her conduct in applying for relevant trademarks and suggest she will be an untrustworthy witness. Such argument addresses her credibility as a witness, but it does not disqualify her from attending trial and other proceedings as the corporate representative for Plaintiff Toytrackerz LLC.

**IT IS THEREFORE ORDERED** that the Motion to Disqualify Counsel (doc. 68) is sustained in part and denied in part. Terry Lynn Coop is disqualified from serving as counsel for Plaintiffs at trial, from taking and defending depositions in this case, and from participating as counsel in any evidentiary hearing. She may serve, however, as the designated representative of Plaintiff Toytrackerz LLC and, in that capacity, may be present in the courtroom during any evidentiary hearings or at trial and during any depositions. The motion is otherwise denied.

Dated in Kansas City, Kansas on this 16th day of June, 2009.

s/ Gerald L. Rushfelt  
Gerald L. Rushfelt  
United States Magistrate Judge