UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

G. MICHAEL ROEBUCK, P.C. Plaintiff v. WILD RABBIT, LLC Defendant	Opposition No. 91226018 Mailed: September 26, 2016

DECISION DENYING PETITION FOR DISQUALIFICATION

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

Applicant, Rabbit Wild, LLC ("Applicant"), submitted a petition to disqualify G. Michael Roebuck from representing Opposer, G. Michael Roebuck, P.C. ("Opposer"), in Opposition No. 91226018 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 (2016). 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 RABBIT WILDE for "audio and video recordings featuring music and artistic performances and entertainment, namely, live music concerts."[3] As grounds for opposition, filed January 27, 2016, Opposer alleges priority and likelihood of confusion with its previously used and registered marks composed in whole or in part of the term WILD RABBIT for numerous items, including "entertainment, namely, live performances by a musical band" 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. 4055935, WILD RABBIT SALAD, for "entertainment, namely, live performances by a musical band," alleging Opposer was not the owner of the WILD RABBIT SALAD mark at the time it was registered, or, alternatively, abandonment. In its Answer, Opposer denied the essential elements of the counterclaim.

On April 15, 2016, Applicant petitioned to disqualify Opposer's attorney, G. Michael Roebuck, under 37 CFR § 11.307(a) as a necessary witness on the basis that "Mr. Roebuck is the sole member, manager, and director of Opposer, and by all appearances, is the only individual who can speak on its behalf. Mr. Roebuck also personally signed Opposer's application and statement of use, and he appears to be

[3] Application Serial No. 86609919, filed April 25, 2015, based on Trademark Act § 1(b), 15 U.S.C. § 1051(b).

[4] Specifically, Opposer asserts ownership of Registration No. 4055935 for the mark WILD RABBIT SALAD, issued November 15, 2011; Registration No. 4991208 for a mark consisting of a cartoon smiling rabbit, issued July 5, 2016; and Registration No. 4999853 for the mark WILD RABBIT, issued July 12, 2016.

the only witness who can testify regarding Opposer's use and/or licensing of the mark 'Wild Rabbit Salad'." 9 TTABVUE 1. Applicant also argues that Mr. Roebuck 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.* at 2. On April 25, 2016, Mr. Roebuck entered an appearance on behalf of Opposer, G. Michael Roebuck, P.C., in his capacity as "President-Owner" of Opposer. 10 TTABVUE 1.

In response to Applicant's petition to disqualify, Opposer does not concede Mr. Roebuck is a necessary witness, but argues, assuming arguendo that Mr. Roebuck is a necessary witness, 37 CFR § 11.14(e) is an exception to disqualification as a necessary witness. 11 TTABVUE 1.

FACTS

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

1. Opposer pleaded ownership of Registration No. 4055935 and Application Nos. 86574463 (since matured into Registration No. 4991208) and 86672357 (since matured into Registration No. 4999853). 1 TTABVUE.
2. Opposer G. Michael Roebuck, P.C., is a corporation organized under the laws of the State of Texas, and G. Michael Roebuck is the corporation's attorney of record. File records for application Serial Nos. 85280374, 86574463, and 86672357.
3. Mr. Roebuck is the "President-Owner" of G. Michael Roebuck, P.C. 10 TTABVUE 1.

4. Mr. Roebuck was the attorney of record for the underlying applications which matured into Registration Nos. 4055935, 4991208, and 4999853. File records for application Serial Nos. 85280374, 86574463, and 86672357.
5. Mr. Roebuck signed, as "Attorney for Applicant," the underlying application which matured into Registration No. 4999853. File record for application Serial No. 86574463.
6. Mr. Roebuck signed, as "Owner," the underlying applications which matured into Registration Nos. 4055935 and 4991208. File records for application Serial Nos. 85280374 and 86672357, respectively.
7. Mr. Roebuck, as "President-Owner" of G. Michael Roebuck, P.C., entered an appearance on behalf of Opposer on April 25, 2016. 10 TTABVUE 1.

ARGUMENTS

In its petition to disqualify Mr. Roebuck, Applicant argues Mr. Roebuck is a necessary witness in this proceeding. In support of its petition, Applicant contends Mr. Roebuck is the sole member, manager, and director of Opposer and is the only individual who can speak on Opposer's behalf. Furthermore, Applicant argues Mr. Roebuck is the only witness who can testify regarding Opposer's ownership, use, and/or licensing of the mark WILD RABBIT SALAD (Registration No. 4055935). Applicant also argues that none of the exceptions to the necessary witness disqualification rule apply in this case.

In response to Applicant's petition, Opposer argues Mr. Roebuck should not be disqualified from representing Opposer – even if he is a necessary witness – because

Mr. Roebuck has entered an appearance as "President-Owner" of Opposer,[5] and officers of a corporation are permitted by 37 CFR § 11.14(e) to represent the corporation in proceedings before the Office. Opposer argues 37 CFR § 11.14(e) operates as an exception to the necessary witness rule found at 37 CFR § 11.307(a).

DISCUSSION

Section 11.307(a) of the USPTO RULES OF PROFESSIONAL CONDUCT ("USPTO RULES"), 37 CFR § 11.307(a), addresses 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.

USPTO RULE 11.14(e), 37 CFR § 11.14(e), recognizes certain individuals that are permitted to practice on behalf of a client in a trademark matter before the Office:

> (e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Any individual may appear in a trademark or other non-patent matter in his or her own behalf. Any individual may appear in a trademark matter for:
> (1) A firm of which he or she is a member,
> (2) A partnership of which he or she is a partner, or
> (3) A corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, partnership, corporation, or association is a party to a trademark proceeding pending before the Office.

[5] This entry of appearance as "President-Owner" effectively withdrew G. Michael Roebuck's representation as attorney for Opposer. Mr. Roebuck is recognized in his capacity as an officer of Opposer. 37 CFR § 11.14(e)(3).

It is not accurate to characterize § 11.14(e) as an exemption to the necessary witness disqualification under § 11.307(a). Rather, § 11.307(a) does not apply at all to individuals appearing before the Office as allowed under § 11.14(e), because § 11.307(a) applies only to "practitioners" as defined in 37 CFR § 11.1. A "practitioner" is defined as:

> (1) An attorney or agent registered to practice before the Office in patent matters;
> (2) An individual authorized under 5 U.S.C. 500(b), or otherwise as provided by § 11.14(a), (b), and (c), to practice before the Office in trademark matters or other non-patent matters;
> (3) An individual authorized to practice before the Office in a patent case or matters under § 11.9(a) or (b); or
> (4) An individual authorized to practice before the Office under § 11.16(d).

37 CFR § 11.1.

Individuals identified under Section 11.14(e) are not included in the definition of "practitioner." Instead, individuals authorized to appear in trademark matters before the Office under § 11.14(e) are not considered "practitioners," even if they are also attorneys, for purposes of representing a client before the Office. In fact, if individuals authorized to appear before the Office under § 11.14(e) *were* considered practitioners, § 11.14(e) would be rendered nearly worthless by the necessary witness disqualification rule, because the vast majority of members of firms, partners of partnerships, or officers of corporations could be disqualified.

Here, applicant seeks to disqualify G. Michael Roebuck from serving as counsel for Opposer, G. Michael Roebuck, P.C., on the basis that Mr. Roebuck is allegedly a necessary witness under § 11.307(a). However, Mr. Roebuck entered an appearance as "President-Owner" of G. Michael Roebuck, P.C. on April 25, 2016. Thus he is

appearing on behalf of Opposer as an officer and is, accordingly, authorized to represent Opposer in this opposition proceeding. It is not necessary to decide whether Mr. Roebuck, as attorney for Opposer, would be considered a necessary witness, because § 11.307(a) does not apply to individuals appearing before the Office as authorized by § 11.14(e).[6]

DECISION

The petition for disqualification of G. Michael Roebuck as counsel for Opposer in Opposition No. 91226018 is DENIED.

PROCEEDINGS RESUMED

Proceedings are resumed. Dates are reset as follows:

Deadline for Discovery Conference	October 26, 2106
Discovery Opens	October 26, 2106
Initial Disclosures Due	November 25, 2106
Expert Disclosures Due	March 25, 2107
Discovery Closes	April 24, 2107
Plaintiff's Pretrial Disclosures	June 8, 2107
30-day testimony period for plaintiff's testimony to close	July 23, 2107
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	August 7, 2107
30-day testimony period for defendant and plaintiff in the counterclaim to close	September 21, 2107
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	October 6, 2107

[6] As noted earlier, Mr. Roebuck signed application Serial No. 85280374 (Registration No. 4055935), the subject of Applicant's counterclaim as "OWNER" of Opposer and not as "attorney."

30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	November 20, 2107
Counterclaim Plaintiff's Rebuttal Disclosures Due	December 5, 2107
15-day rebuttal period for plaintiff in the counterclaim to close	January 4, 2108
Brief for plaintiff due	March 4, 2108
Brief for defendant and plaintiff in the counterclaim due	April 3, 2108
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	May 3, 2108
Reply brief, if any, for plaintiff in the counterclaim due	May 18, 2108

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 the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in 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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