

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

THIS DECISION IS NOT A  
PRECEDENT OF THE TTAB

*Cove Surf Company Inc.*  
Plaintiff

v.

*Columbia Insurance Company*  
Defendant

Cancellation No. 92085620

Mailed: May 27, 2026

DECISION DENYING PETITION FOR DISQUALIFICATION

Cheryl Butler, Appointed Petitions Attorney, Trademark Trial and Appeal Board:<sup>1</sup>

Columbia Insurance Company (“Respondent”) filed a petition to disqualify Omid E. Khalifeh from representing Cove Surf Company Inc. (“Petitioner”) on the grounds that Mr. Khalifeh has made himself a witness in this cancellation proceeding.<sup>2</sup>

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<sup>1</sup> 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. TTAB MANUAL OF PROCEDURE (“TBMP”) § 513.02. Under such delegation, the authority to decide this petition was further delegated.

<sup>2</sup> Petitions to disqualify are governed by 37 C.F.R. § 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

Respondent owns a registration for the standard character mark COVE SHOE COMPANY for “footwear” in Class 25.<sup>3</sup> As grounds for cancellation, Petitioner asserts a claim of abandonment, alleging discontinuation of use by Respondent for a period of at least three years with intent not to resume such use. 1 TTABVUE 4-5. Petitioner further asserts a claim of fraud in maintaining the registration. *Id.* at 5-8. Respondent denies the essential allegations of the complaint. 4 TTABVUE.

Petitioner’s trial period closed on June 28, 2025. 6 TTABVUE 2. During its testimony period, Petitioner submitted several notices of reliance. 7-12 TTABVUE. Before its pretrial disclosures were due, Respondent filed motions to strike three of the notices of reliance. The motions were fully briefed. In an order dated December 3, 2025, the Board deferred to final decision determination of the objections asserted to the extent they are substantive in nature. 20 TTABVUE 2-6. The Board overruled the objection to one of the notices of reliance and denied the motion to strike the declaration at issue. *Id.* at 4. Trial and briefing dates were reset commencing with Respondent’s pretrial disclosures. *Id.* at 7.

On January 5, 2026, the due date for Respondent’s pretrial disclosures, Respondent filed a petition to disqualify Petitioner’s attorney. 23 TTABVUE. The petition is fully briefed. Respondent seeks disqualification alleging that Mr. Khalifeh

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<sup>3</sup> Registration No. 4038967 issued on October 11, 2011, claiming a date of first use anywhere and in commerce of July 2009. Renewed. TSDR March 9, 2022 *Notice-Acceptance-Renewal*. TSDR refers to the USPTO’s Trademark Status and Document Retrieval database.

is a necessary witness because he submitted his declaration in support of exhibits accompanying Petitioner's notice of reliance ("NOR") 5.

### FACTS

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

1. On June 27, 2025, Petitioner filed NOR 5 to support its position that "that the footwear allegedly sold under the "COVE" mark was not genuinely offered to or purchased by third-party retailers, and that the alleged purchase orders may reflect internal transactions or fictitious sales."<sup>4</sup> 12 TTABVUE 2.
2. Exhibit A to NOR 5 consists of three purchase orders showing order dates of December 1, 2017, 2018 and 2019, respectively. The "Ex Factory Date" entry is one month later for each order date. The "Vendor" identifies Cove Shoe Company and the "Deliver To" field identifies "Shoe Factory Outlet." *Id.* at 10-13.
3. Exhibit B to NOR 5 consists of an image of a pair of boots showing the wording COVE SHOE COMPANY and a logo. *Id.* at 14-15. The boots are sitting on a display rack with other boots.
4. Exhibit 21 to NOR 5 consists of copies of email exchanges between Mr. Khalifeh and the email address shoefactoryoutlet@hhbrown.com, dated April 18, 2025, with the first email, dated and time stamped for Fri., Apr. 18, 2025 at 12:45 p.m., addressed generally to "Dan and Denise." *Id.* at 16-19.

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<sup>4</sup> This description conforms to the requirement that a notice of reliance "must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding." 37 C.F.R. § 2.122(g).

5. The Exhibits are introduced by the declaration of Mr. Khalifeh. *Id.* at 6-9. Mr. Khalifeh recites that 1) he called the Shoe Factory Outlet to confirm the purchases identified in the purchase orders produced by Respondent; 2) he spoke with “Dan” who informed him that the store did not carry footwear under the COVE brand and referred Mr. Khalifeh to “Denise, who has been with the company for over 30 years.”; 3) that subsequently he spoke with Denise who also informed him that COVE branded shoes were not available at the store; 4) that he inquired about a photo of a COVE branded boot and was asked to send the image by email, and did so; 4) that Denise indicated she could not recall the store selling such boot or any footwear under the COVE brand; 6) and that Dan explained the store was locally referred to as COVE but “the store carries only H & H, Caroline, Cochran, and Matterhorn branded footwear, and not any product bearing the COVE mark.” *Id.*

#### ARGUMENTS

In support of disqualification, Respondent argues that Mr. Khalifeh’s declaration is based on his personal, first-hand knowledge of purported phone conversations and email exchanges between himself and third-party individuals; that the proposed “testimony” is relevant, material and unobtainable elsewhere because there are no other persons available to testify in his place; and that none of the limited exceptions apply. According to Respondent, Mr. Khalifeh’s declaration is “testimonial evidence” that attempts to establish the truth of the matter asserted going to the substantive factual dispute between the parties rather than peripheral or uncontested matter.

Respondent expresses its interpretation that the declaration includes Mr. Khalifeh's opinion as to the authenticity and credibility of Respondent's evidence by suggesting that the produced purchase orders appear "facially irregular." Respondent concludes that Mr. Khalifeh has made himself a necessary witness and must be disqualified from representing Petitioner. 23 TTABVUE 3-8.

It is Petitioner's position that its attorney did not interject himself as a witness on the merits of the case but instead provided a declaration to authenticate the proffered documents, explain the circumstances under which the documents were obtained, and "contextualize Respondent's own facially deficient evidence of alleged trademark use." 26 TTABVUE 2. Petitioner argues that the evidence submitted with the declaration was offered to highlight the absence of corroboration, internal inconsistencies and lack of ordinary indicia of Respondent's documents, all of which are classic evidentiary advocacy functions, not testimony on the merits of the dispute between the parties. Petitioner points out that, even if aspects of the declaration touch on matters of factual relevance, the information is obtainable from other sources: from Respondent itself and from the customer identified in the purchase orders. Petitioner contends that Respondent's disqualification request is a "tactical repackaging" of Respondent's motion to strike Petitioner's notices of reliance, which was denied. Petitioner argues that disqualification would work a substantial hardship because its attorney has represented it throughout this proceeding, is familiar with the factual and procedural record and because Petitioner has already completed its main trial period. Petitioner believes that disqualification at this late

stage of the proceeding is disproportionate because it would impose unnecessary costs, delay and prejudice where any concerns raised by Respondent may be fully addressed through the ordinary evaluation of evidence. *Id.* at 4-6.

In reply, Respondent argues that Petitioner's counsel testified under oath to factual assertions based on his personal knowledge and investigative activities, making him a necessary witness. 27 TTABVue 2. Respondent contends that, even if the declaration is not offered for the truth of the matters asserted, Mr. Khalifeh's statements still go to the occurrence, content and significance of the communications. *Id.* at 3-4. Respondent insists that statements in the declaration are "substantive factual assertions and opinions," going well beyond the exhibits, seeking "to persuade the Board of factual conclusions based on counsel's personal assessment." *Id.* at 5. Respondent argues that Mr. Khalifeh's testimony is relevant and material; non-cumulative and unobtainable through other sources; and that no exceptions apply. *Id.* at 7-10.

#### DISCUSSION

Disqualification of counsel "is a drastic measure which courts should hesitate to impose except when absolutely necessary." *Freeman v. Chi. Musical Instrument Co.*, 689 F.2d 715, 721 (7th Cir. 1982); *see also Mills v. Hausmann-McNally*, S.C., 992 F.Supp.2d 885, 890 (S.D. Ind. 2014). "[S]uch motions should be viewed with extreme caution for they can be misused as techniques of harassment." *Freeman*, at 722.

Section 11.307(a) of THE USPTO RULES OF PROFESSIONAL CONDUCT, 37 C.F.R. § 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.

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).

Mr. Khalifeh is not a necessary witness. It appears the declaration may have been provided to introduce the email exchanges between Mr. Khalifeh and employees of the Shoe Factory Outlet (specifically, Dan and Denise), found at Exhibit 21 (12 TTABVUE 17-19).<sup>5</sup> *See also* the Board’s determination on Respondent’s motion to strike, “Exhibit 21 will be considered as an exhibit to counsel’s declaration insofar as references in the declaration can be associated to the emails under Exhibit 21.” 20 TTABVUE 6.

TTAB trial periods are set for the introduction of evidence. The parties’ briefing periods provide the opportunity for persuasive argument based on the facts presented. To the extent the explanations in Mr. Khalifeh’s declaration are intended

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<sup>5</sup> Exhibit A consists of copies of purchase orders provided by Respondent. Exhibit B consists of a photograph of a pair of boots showing a COVE and design imprint, also provided by Respondent. The documents were introduced with NOR 2. The latter at 10 TTABVUE 41 and the former at 10 TTABVUE 43-45. Although a final determination of admissibility will be made with the final decision in this case, the documents appear to be admissible under a notice of reliance because they were referenced in, and therefore included with, Respondent’s interrogatory responses. *See* Interrogatory Response No. 12 referring to a picture of boots and to purchase orders submitted in response Request for Production No. 2. 10 TTABVUE 15-16. *See* 37 C.F.R. § 2.120(k)(3)(i); TBMP § 704.10.

to explain what prompted the inquiry he made, they are not considered opinion or argument. To the extent they may be viewed as inadmissible argument provided with submission of trial evidence, they may not be considered. As the parties are aware, determination of Respondent's substantive objections to NOR 5 is deferred to final decision, in accordance with Board practice. *Id.*

Clearly there are other persons available to testify on the potential matters brought up by NOR 5. The Shoe Factory Outlet is available to address its relationship with Respondent and products purchased. More specifically to NOR 5, the Shoe Factory Outlet's employees are available to address the inquiry made, the information they purported provided, the request for a photo that originated from one of the employees, and contents of the telephone and email exchanges. Respondent is the primary source to address its relationship with the Shoe Factory Outlet, including the sales made and the products sold.

Mr. Khalifeh is not a necessary witness. Accordingly, there is no need to address the exceptions where an attorney is found to be a necessary witness.

### DECISION

The petition for disqualification of Omid Khalifeh as counsel for Petitioner is denied. Proceedings remain suspended pending the issuance by the Board of a resumption schedule.

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