Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

LITTLE CAESAR ENTERPRISES, INC., PETITIONER
v.
DOMINO'S PIZZA, INC., RESPONDENT
Disqualification No. 89-1
April 3, 1989

Donald J. Quigg

Commissioner of Patents and Trademarks

***1** Little Caesar Enterprises, Inc. (LCE) has filed a PETITION TO DISQUALIFY DOMINO'S COUNSEL. LCE is the respondent/applicant in Opposition Proceeding No. 75,396 now pending before the Trademark Trial and Appeal Board. Domino's Pizza, Inc. (Domino's) is the opposer in that opposition.

LCE requests that counsel for opposer, Mr. G. Gregory Schivley, and the law firm of Harness, Dickey & Pierce, be disqualified from further representation of Domino's in Opposition No. 75,396. The gravamen of the petition is that Mr. Schivley executed answers to interrogatories on behalf of his client. [FN1] We note that those answers by counsel have subsequently been ratified by an employee on behalf of Domino's.

As a basis for the requested disqualification, LCE alleges a violation of Canon 5 of the Rules of Practice Before the Patent and Trademark Office (PTO), 37 C.F.R. § 10.61, by Mr. Schivley. However, LCE has not specified which particular Disciplinary Rule requires that Mr. Schivley and the firm of Harness, Dickey & Pierce be disqualified. Nor has LCE cited any controlling case law that sets forth specific circumstances requiring disqualification. While the cases cited by LCE discuss verification of interrogatory answers by counsel, [FN2] these cases do not reach the disqualification issues here involved.

LCE appears to believe that Domino's counsel should be disqualified because LCE intends to call Mr. Schivley as a fact witness in connection with the interrogatory responses: "It is obvious that Mr. Schivley will be called as a witness to testify on behalf of LCE on the basis of the knowledge of factual matters he claims to hold" (Pet. p. 8 ¶ 19). LCE also asserts that Mr. Schivley can be subjected to discovery because he signed interrogatories as an agent for Domino's (Pet. p. 12). LCE does not allege that Mr. Schivley "ought to" testify on behalf of Domino's. Nor is there any suggestion that Mr. Schivley intends to testify on behalf of Domino's.

Section 10.63 of the PTO Code of Professional Responsibility, [FN3] 37 C.F.R. § 10.63, addresses the issue of whether a practitioner should be disqualified when the practitioner may become a witness in a PTO proceeding:

(a) If, after undertaking employment in a proceeding in the [Patent and Trademark] Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness on behalf of a practitioner's client, the practitioner shall

withdraw from the conduct of the proceeding and the practitioner's firm, if any, shall not continue representation in the proceeding, except that the practitioner may continue the representation and the practitioner or another practitioner in the practitioner's firm may testify in the circumstances enumerated in paragraphs (1) through (4) of [37 C.F.R.] § 10.62(b).

***2** (b) If, after undertaking employment in a proceeding before the [Patent and Trademark] Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm may be asked to sign an affidavit to be filed in the Office or be called as a witness other than on behalf of the practitioner's client, the practitioner may continue the representation until it is apparent that the practitioner's affidavit or testimony is or may be prejudicial to the practitioner's client.

37 C.F.R. § § 10.63(a) and (b).

The language of 37 C.F.R. § § 10.63(a) and (b) closely parallels Disciplinary Rules 5-102(A) and (B) of the ABA Model Code of Professional Responsibility (1980). [FN4] Decisions under those ABA Disciplinary Rules thus offer guidance in the interpretation of the PTO rules. Sections 10.63(a) and (b) of the PTO Rules do not allow any conduct that would be prohibited by ABA DR 5-102(A) and (B).

In determining whether or not disqualification is required, the principal considerations under 37 C.F.R. § § 10.63(a) and (b) are: "(1) whether an attorney ought to be called to testify on behalf of his client, ... or (2) whether the attorney may be called other than on behalf of his client and his testimony is or may be prejudicial to the client." Optyl Eyewear Fashion Int'l Corp. v. Style Cos., 760 F.2d 1045, 1048 (9th Cir.1985) (citations omitted).

As noted above, LCE does not claim that Mr. Schivley ought to be called as a witness on behalf of Domino's. Nor is there any allegation that Mr. Schivley intends to testify on behalf of Domino. See, e.g., J.P. Foley & Co. v. Vanderbilt, 523 F.2d 1357 (2d Cir.1975); Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equipment Corp., 546 F.2d 530, 192 USPQ 193 (3d Cir.1976), cert. denied, 430 U.S. 984 (1977). Accordingly, section 10.63(a) is not applicable.

Since LCE states that it will call Mr. Schivley as a witness to "testify on behalf of LCE" (Pet. p. 8 ¶ 19), one must assume that LCE's petition to disqualify is based on 37 C.F.R. § 10.63(b). However, there is no allegation that, if called, Mr. Schivley's testimony may be prejudicial to his client in any way. The mere allegation that LCE intends to call Mr. Schivley as a witness, without more, is insufficient to disqualify Mr. Schivley and his firm under § 10.63(b). See Davis v. Stamler, 494 F.Supp. 339 (D.N.J. 1980); Optyl Eyewear, supra, 760 F.2d at 1049 (party requesting disqualification offered "absolutely no showing" that opposing counsel's testimony, if called, might have been prejudicial to opposing counsel's client); Kroungold v. Triester, 521 F.2d 763 (3rd Cir.1975) (defendants' intent to call law partner of attorney for plaintiff as an adverse witness, coupled with the mere suggestion that the testimony "may prejudice" the plaintiff, was insufficient to support a disqualification under ABA DR 5-102(B)). Here, as noted above, LCE has not even alleged that Mr. Schivley's testimony "may prejudice" his client Domino's. Courts have observed, in considering disqualification motions pursuant to ABA DR 5-

102(B), that the drafters of the ABA Code cautioned that DR 5-102(B) "was not designed to permit a lawyer to call opposing counsel as a witness and thereby disqualify him as counsel." ABA Code, Canon 5, n. 31. See Optyl Eyewear, supra, 760 F.2d at 1050; Rice v. Baron, 456 F.Supp. 1361, 1370 (S.D.N.Y.1978).

***3** Petitioner has failed in its burden in this renewed petition to present a prima facie case that Mr. Schivley, or Harness, Dickey & Pierce, should be disqualified. Accordingly, the renewed petition is DENIED.

The Trademark Trial and Appeal Board is authorized to resume proceedings in the opposition.

FN1. Rule 33(a) of the Federal Rules of Civil Procedure provides that interrogatories are to be "answered by the party served or, if the party served is a public or private corporation ... by any officer or agent, who shall furnish such information as is available to the party." (Emphasis added.)

FN2. LCE states that the reference to "any officer or agent" in Rule 33(a) of the Federal Rules of Civil Procedure does not permit a "trial" attorney to verify answers to interrogatories on behalf of a corporate client (Pet. p. 13). There is no such limitation in the rule. See 8 C. Wright & Miller, Federal Practice and Procedure § 2172 (1970); Segarra v. Waterman S.S. Corp., 41 F.R.D. 245 (D.P.R.1966); Jones v. Goldstein, 41 F.R.D. 271 (D.Md.1966).

FN3. The PTO Code of Professional Responsibility applies to practitioners in trademark proceedings in the PTO. 37 C.F.R. § 10.20(b); 37 C.F.R. § 10.1(r).

FN4. See PTO notice of proposed rulemaking, 48 Fed.Reg. 36478 (1983).

11 U.S.P.Q.2d 1233

END OF DOCUMENT