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

THE GILMAN CORPORATION, PETITIONER
v.
THE GILMAN BROTHERS COMPANY, RESPONDENT-REGISTRANT
Cancellation No. 17,140
Disqualification No. 91-2
June 14, 1991

Attorney for Petitioner

Robert S. Smith, Esq.

Attorney for Respondent

Paul Fields, Esq.

***1** Darby & Darby P.C.

Harry F. Manbeck, Jr.

Assistant Secretary and Commissioner of Patents and Trademarks

DECISION DENYING PETITION TO DISQUALIFY

The Gilman Corporation and The Gilman Brothers Company are involved in Cancellation Proceeding No. 17,140 before the Trademark Trial and Appeal Board. In the cancellation proceeding, The Gilman Corporation (Gilman Corp.) seeks to cancel Trademark Registration No. 716,301 (SOFTLITE), owned by The Gilman Brothers Company (Gilman Bros.). Gilman Corp. has petitioned for entry of an order disqualifying (1) Mr. Paul Fields, (2) any attorney previously associated with Mr. Fields in connection with Cancellation No. 17,140, and (3) the firm of Darby & Darby P.C. from representing Gilman Bros. in the proceeding. For the following reasons, the petition is DENIED.

Facts

The facts are taken essentially from the petition filed by Petitioner Gilman Corp. It should be understood that the facts recited herein are those alleged by Gilman Corp. Inasmuch as the petition is being denied on the assumption that the facts as alleged by Gilman Corp. are correct, it is not necessary to resolve any factual disputes which may exist between the parties. References in parentheses are to the numbered paragraphs in section two of Gilman Corp.'s petition.

1. Lawrence M. Gilman was president of both Gilman Corp. and Gilman Bros. from 1948 to 1987 (Nos. 1 & 2).

2. Gilman Corp. and Gilman Bros. are closely held corporations (No. 3).

3. Lawrence Gilman maintained a single office in Gilman, Connecticut, for both Gilman Corp. and Gilman Bros. for many years (No. 5).

4. William R. Liberman, Esq. (Mr. Liberman), represented Gilman Bros. for many years (No. 6).

5. Lawrence Gilman met with Mr. Liberman in Gilman, Connecticut, and in New York City (Nos. 7-9).

6. Mr. Liberman filed several trademark applications for Gilman Bros. at the request of Lawrence Gilman. The trademark applications prosecuted by Mr. Liberman included the application that resulted in Registration No. 716,301, for the trademark SOFTLITE (Nos. 10-22).

7. Mr. Liberman was "of counsel" to the law firm of McAulay, Fields, Fisher, Goldstein & Nissen (McAulay Fields) for a period of time during the year 1979 (No. 32, 33).

8. Mr. Paul Fields, Esq. (Mr. Fields), was a partner in McAulay Fields from at least 1979 until after Gilman Corp.'s cancellation petition was filed on April 4, 1988 (Nos. 23, 35, 36).

9. Mr. Fields assumed personal responsibility for the Gilman Bros.' work at the McAulay Fields firm after Mr. Liberman's death in 1979. The work included maintaining trademarks and filing trademark applications (Nos. 24-31). Mr. Fields was Gilman Bros.' attorney of record when Registration No. 716,301 for the mark SOFTLITE was renewed in 1981 (No. 73).

***2** 10. Gilman Corp. has petitioned to cancel the trademark SOFTLITE, Registration No. 716,301, owned by Gilman Bros. The cancellation proceeding involves allegations of abandonment of the mark (Nos. 65, 66).

11. Both Mr. Fields and Ms. Roberta Bren, Esq., previously an associate at McAulay Fields, have filed papers in the pending cancellation proceeding. Mr. Fields is currently a partner in the firm of Darby & Darby P.C. For a period of time after leaving the McAulay Fields firm, Ms. Bren was of counsel at Darby & Darby P.C. (Nos. 37, 39-59).

12. Mr. Fields represented Richard Gilman, c/o The Gilman Corporation, in the prosecution of U.S. Patent No. 4,304,268. (Respondent's Answer, Exhibit 1).

13. There is present litigation between the real parties in interest at Gilman Corp. and Gilman Bros. (No. 71).

Discussion

As a basis for the requested disqualification, Gilman Corp. alleges

Gilman Bros.' representation by Mr. Fields and the firm of Darby & Darby P.C. violates Canons 4 and 5 of the Code of Professional Responsibility of the Patent and Trademark Office (PTO), 37 C.F.R. § § 10.56 and 10.61, and Disciplinary Rules, 37 C.F.R. § § 10.57(a) and 10.66(d).

Canon 4, 37 C.F.R. § 10.56, provides: "A practitioner should preserve the confidences and secrets of a client." The Commissioner has disqualified an attorney from appearing on behalf of an adversary to a former client in a subsequent substantially related proceeding before the PTO. Halcon Int'l, Inc. v. Werbow, 228 USPQ 611 (Comm'r Pat.1980); Plus Products v. Con-Stan Industries, Inc., 221 USPQ 1071 (Comm'r Pat.1984).

In order to succeed with its disqualification petition, Gilman Corp. must demonstrate that:

(1) Mr. Fields was Gilman Corp.'s former attorney;

(2) Mr. Fields now represents a party adverse to Gilman Corp.; and

(3) the subject matter embraced by the present representation is "substantially related" to the subject matter in which Mr. Fields previously represented Gilman Corp.

Plus Products, Id. at 1074 (following T.C. Theatre Corp. v. Warner Bros. Pictures, Inc., 113 F.Supp. 265 (S.D.N.Y.1953)).

To satisfy the first requirement for disqualification, Gilman Corp. alleges that Mr. Fields and Mr. Liberman represented Gilman Corp. "either expressly or inherently" (Nos. 38 and 72). The single event Gilman Corp. cites which suggests that it is a former client of Mr. Fields is the prosecution of a patent application that issued as Patent No. 4,304,268 to Richard Gilman. PTO records reflect that Richard Gilman himself is currently the patent owner, not Gilman Corp. All petitioner's allegations concerning representation by either Mr. Liberman or Mr. Fields in trademark matters indicate that (1) Gilman Bros. owned the trademarks--not Gilman Corp., and (2) the representation was on behalf of Gilman Bros. (Nos. 10-22; 26-31; 67-68)--not Gilman Corp. Thus, taking the allegations as true, petitioner has not established former client status of Gilman Corp. in connection with any matter, let alone the trademark matter specifically at issue in this cancellation proceeding.

***3** Moreover, Gilman Bros. has not retained new counsel for the cancellation proceeding, i.e., Gilman Bros.' counsel has not "switched sides." Mr. Fields was retained by Gilman Bros. at least as early as 1981, in connection with the renewal of the SOFTLITE trademark (No. 73). Compare Plus Products, supra (attorney representing respondent in a trademark opposition proceeding disqualified in view of his previous representation of the petitioner in PTO proceedings and infringement litigation concerning the same trademark issues); Halcon Int'l, supra (attorney representing one party in an interference proceeding disqualified in view of his previous representation of the adverse party in connection with a process similar to the process involved in the interference).

Further, to the extent that Lawrence Gilman communicated Gilman Corp.'s confidential information to Mr. Liberman or Mr. Fields during their representation of Gilman Bros. in the prosecution and renewal of the SOFTLITE trademark, confidentiality was waived.

Nevertheless, assuming arguendo petitioner's allegations that a former "express" or "inherent" attorney-client relationship existed, disqualification is still not justified under the facts of this case. Gilman Corp. has not met the burden of proving the necessary factual predicate to the existence of a "substantial relationship" between the trademark cancellation and the previous "representation"--the patent. Disqualification will only be granted

> ... upon a showing that the relationship between issues in the prior and present cases is "patently clear" ... [i.e.] only when the issues involved have been "identical" or "essentially the same". Government of India v. Cook Industries, Inc. 569 F.2d 737, 739-40 (2d Cir.1978) (citations omitted).

In the present case, even if Gilman Corp. had established former client status with either Mr. Liberman or Mr. Fields, there is no showing that there is a "substantial relationship" between the subject matter of the earlier representation (the patent application) and the issues raised in the cancellation proceeding (the SOFTLITE trademark). Gilman Bros. has at all times been the record owner of trademark Reg. No. 716,301 for SOFTLITE.

Decision

Petitioner has failed in its burden in this renewed petition to present a prima facie case that Mr. Fields, or the firm of Darby & Darby P.C., should be disqualified from representing Gilman Bros. in Cancellation Proceeding No. 17,140. Accordingly, the renewed petition is DENIED.

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