

**UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT**

SUMMARY ORDER

RULINGS BY SUMMARY ORDER DO NOT HAVE PRECEDENTIAL EFFECT. CITATION TO A SUMMARY ORDER FILED ON OR AFTER JANUARY 1, 2007, IS PERMITTED AND IS GOVERNED BY FEDERAL RULE OF APPELLATE PROCEDURE 32.1 AND THIS COURT'S LOCAL RULE 32.1.1. WHEN CITING A SUMMARY ORDER IN A DOCUMENT FILED WITH THIS COURT, A PARTY MUST CITE EITHER THE FEDERAL APPENDIX OR AN ELECTRONIC DATABASE (WITH THE NOTATION "SUMMARY ORDER"). A PARTY CITING TO A SUMMARY ORDER MUST SERVE A COPY OF IT ON ANY PARTY NOT REPRESENTED BY COUNSEL.

1 At a stated term of the United States Court of Appeals for the Second Circuit, held at the
2 Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the
3 19th day of September, two thousand seventeen.
4

5 Present:

6 DENNIS JACOBS,
7 BARRINGTON D. PARKER,
8 DEBRA ANN LIVINGSTON,
9 *Circuit Judges.*

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12 VICTORINOX AG, VICTORINOX SWISS ARMY, INC.,
13 WENGER NA, INC.,
14

15 *Plaintiffs-Counter-Defendants-*
16 *Appellees,*

17
18 v.

15-4032-cv(L), 16-386-cv(CON),
16-2757-cv(Con), 16-2690-cv

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21 B&F SYSTEM, INC., JOHN D. MEYER,
22

23 *Defendants-Counter-Claimants-*
24 *Appellants,*

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26 ABC CORPORATIONS, 1-10, JOHN DOES 1-10,
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28 *Defendants.*
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1 For Defendants-Counter-Claimants-
2 Appellants:

MICHAEL J. TRICARICO, Christopher R. Carroll,
3 Douglas J. Steinke (*on the brief*), Carroll McNulty
4 Kull LLC, New York, NY

5
6 JOSEPH H. LESSEM, Graubard Miller, New York, NY
7

8 For Plaintiffs-Counter-Defendants-
9 Appellees:

RORY J. RADDING, PHILIP TOUITOU, HARRAL S. TENNEY
10 IV, David Weild III (*on the brief*), Locke Lord LLP,
11 New York, NY
12

13 Appeal from a judgment and two orders of the United States District Court for the
14 Southern District of New York (Rakoff, J.).¹

15 **UPON DUE CONSIDERATION, IT IS HEREBY ORDERED, ADJUDGED, AND**
16 **DECREED** that the judgment of the district court is **AFFIRMED IN PART and VACATED**
17 **AND REMANDED IN PART.**

18 Defendants-Appellants The B&F System, Inc. (“B&F”) and John D. Meyer (collectively,
19 “Defendants”) appeal from a judgment of the district court granting summary judgment and
20 awarding treble damages, attorneys’ fees, and a permanent injunction to Plaintiffs Victorinox
21 AG, Victorinox Swiss Army, Inc., and Wenger NA, Inc. (collectively, “Plaintiffs” or
22 “Victorinox”) on their claim for trademark infringement under the Lanham Act, 15 § U.S.C.
23 1051 *et seq.* Defendants also appeal from an order denying them relief under Federal Rule of
24 Civil Procedure 60, and an order denying their motion to disqualify counsel. Defendants
25 contend that they did not infringe the trademark willfully or otherwise; that the mark should be
26 cancelled because it was procured with fraudulent representations and because the mark serves a
27 functional purpose; and that Plaintiffs’ counsel, Locke Lord, should have been disqualified for

¹ This Summary Order addresses two separate appeals stemming from one underlying district court case.

1 concurrently representing both Plaintiffs and Defendants. We assume the parties' familiarity
2 with the underlying facts, the procedural history of the case, and the issues on appeal.

3 **I. Trademark Infringement Claim**

4 We review grants of summary judgment *de novo*. *Ya-Chen Chen v. City Univ. of N.Y.*,
5 805 F.3d 59, 69 (2d Cir. 2015). Summary judgment is appropriate only “if the movant shows
6 that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a
7 matter of law.” *Sousa v. Marquez*, 702 F.3d 124, 127 (2d Cir. 2012) (quoting Fed. R. Civ. P.
8 56(a)). All ambiguities must be resolved, and all reasonable inferences drawn, in favor of the
9 non-movant. *Burg v. Gosselin*, 591 F.3d 95, 97 (2d Cir. 2010).

10 We analyze a trademark infringement claim “in two stages, asking first whether the mark
11 ‘merits protection’ and, second, whether the allegedly infringing use of the mark (or a similar
12 mark) is ‘likely to cause consumer confusion.’” *Christian Louboutin S.A. v. Yves Saint Laurent*
13 *Am. Holding, Inc.*, 696 F.3d 206, 224 (2d Cir. 2012) (quoting *Louis Vuitton Malletier v. Dooney*
14 *& Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006)).

15 **A. First Stage**

16 As to the first stage, “[a] certificate of registration with the [Patent and Trademark
17 Office] is prima facie evidence that the mark is registered and valid (*i.e.*, protectable), that the
18 registrant owns the mark, and that the registrant has the exclusive right to use the mark in
19 commerce.” *Lane Capital Mgmt. v. Lane Capital Mgmt.*, 192 F.3d 337, 345 (2d Cir. 1999).
20 Defendants seek cancellation of Plaintiffs’ trademark for red, oval-shaped scales on the sides of
21 multifunction pocketknives on two grounds: fraud and functionality.

1 **1. Fraud**

2 “A third party seeking cancellation of a trademark based upon fraud in the application
3 ‘bears a heavy burden.’” *Quality Serv. Grp. v. LJMJR Corp.*, 831 F. Supp. 2d 705, 710
4 (S.D.N.Y. 2011) (quoting *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009)). “The
5 allegedly fraudulent statements may not be the product of mere error or inadvertence, but must
6 indicate a ‘deliberate attempt to mislead the [PTO].’ Moreover, the knowing misstatement
7 must have been with respect to a *material* fact—one that would have affected the PTO’s action
8 on the applications.” *Orient Exp. Trading Co., Ltd. v. Federated Dep’t Stores, Inc.*, 842 F.2d
9 650, 653 (2d Cir. 1988) (alteration in original) (quoting *Money Store v. Harriscorp Fin., Inc.*,
10 689 F.2d 666, 670 (7th Cir. 1982)). Defendants claim that Plaintiffs (1) deliberately omitted
11 information about other companies’ use of the now-registered mark in its application to the PTO,
12 and (2) selectively quoted from the *Forschner* litigation, cases about red multifunction
13 pocketknives. *See Forschner Grp. v. Arrow Trading Co.*, 124 F.3d 402, 404 (2d Cir. 1997)
14 (“*Forschner II*”); *Forschner Grp. v. Arrow Trading Co.*, 30 F.3d 348, 350 (2d Cir. 1994)
15 (“*Forschner I*”). But, as the district court stated, other companies’ use of the mark alone does
16 not establish that Plaintiffs’ use was not “substantially exclusive.” *Victorinox II* J.A. 230
17 (quoting *L.D. Kichler Co. v. Davoil, Inc.*, 192 F.3d 1349, 1352 (Fed. Cir. 1999)).² Moreover,
18 Defendants failed to make any showing of the materiality of the alleged misstatements to the
19 PTO’s decision to register the mark. *See Orient Exp. Trading Co.*, 842 F.2d at 653. Thus,
20 Defendants cannot obtain cancellation of Plaintiffs’ trademark on fraud grounds.

21

² *Victorinox I* appendices refer to those filed in connection with docket numbers 15-4032 and 16-386, and *Victorinox II* appendices refer to those filed in connection with docket number 16-2690.

1 **2. Functionality**

2 Functionality “is an affirmative defense that [the Court] consider[s]” in the context of
3 determining whether the infringing use of the trademark is “likely to cause consumer confusion.”
4 *Louboutin S.A.*, 696 F.3d at 224 (internal quotation marks omitted). Registration of the mark
5 creates a presumption that the mark is not functional. *See id.* at 224. “A mark is aesthetically
6 functional, and therefore ineligible for protection under the Lanham Act, where protection of the
7 mark significantly undermines competitors’ ability to compete in the relevant market.” *Id.* at
8 222 (emphasis omitted).

9 Defendants first claim that the red handles at issue have utilitarian functionality because
10 they allegedly increase the visibility of the knives and warn the user of the need to maintain
11 vigilance when using a knife. However, as the district court noted, Defendants submitted no
12 admissible evidence in support of these allegations. Defendants also argue that the red handles
13 are aesthetically functional, relying solely on *Forschner II*. Even assuming *arguendo* that
14 *Forschner II* characterized the red handles as aesthetically functional, Victorinox acquired a
15 registered trademark for them after *Forschner II*. Defendants submitted no admissible evidence
16 to rebut the presumption that the mark is not functional. *See Louboutin S.A.*, 696 F.3d at 224.
17 Thus, we agree with the district court that Defendants cannot cancel Plaintiffs’ trademark based on
18 functionality.

19 **B. Second Stage**

20 The second stage of the trademark infringement claim looks to “whether the junior user’s
21 use of its mark is likely to cause consumers confusion as to the origin or sponsorship of the
22 junior user’s goods.” *Guthrie Healthcare Sys. v. ContextMedia, Inc.*, 826 F.3d 27, 37 (2d Cir.
23 2016). When considering this issue,

1 we generally examine the non-exclusive list of eight factors suggested by Judge
2 Friendly in his landmark opinion in *Polaroid Corp. v. Polarad Electronics Corp.*,
3 287 F.2d 492, 495 (2d Cir. 1961): the strength of the senior user’s mark; the
4 similarity of the parties’ marks; the proximity of the parties’ areas of commerce;
5 the likelihood that the senior user will bridge the gap separating their areas of
6 activity; the existence of actual consumer confusion; whether the junior user acted
7 in bad faith or was otherwise reprehensible in adopting the mark; the quality of
8 the junior user’s product; and the sophistication of the relevant consumer group.
9 The pertinence of individual factors varies with the facts of the particular case.
10 Courts should not treat any one factor as dispositive, nor apply a “mechanical
11 process” awarding judgment to the “party with the greatest number of factors
12 weighing in its favor.”

13
14 *Id.* (footnote omitted) (quoting *Nabisco, Inc. v. Warner-Lambert Co.*, 220 F.3d 43, 46 (2d Cir.
15 2000)).

16 Applying this standard, we agree with the district court that Plaintiffs proffered
17 “overwhelming evidence of the likelihood of consumer confusion.”³ *Victorinox II* J.A. 235–36.
18 Given the similarities between the two products at issue—silver-colored tools folded between
19 oblong red scales, a white cross-and-shield logo on one of the scales, notches for a toothpick and
20 tweezers at one end⁴—the average consumer (who would not have the opportunity to compare
21 the knives side-by-side) is unlikely to notice any differences. Indeed, at least one consumer
22 mistakenly returned Defendants’ knife to Plaintiffs.

23 Further, as to bad faith, Plaintiffs convincingly contend that Defendants willfully
24 infringed upon their registered mark by pointing to Defendants’ pattern of duplicating Plaintiffs’
25 products, and Defendants’ continued production of the infringing knives after Customs seized
26 the knives that gave rise to this litigation. Defendants did not submit any evidence to create a
27 genuine dispute as to these facts, but instead claim that they relied upon *Forschner II* (without

³ The district court also found that Defendants’ products were “counterfeit,” *Victorinox II* J.A. 234–35, defined by the Lanham Act as “a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.” 15 U.S.C. § 1127.

⁴ Some of Defendants’ knives even came packaged in a rectangular silver-gray box, like Plaintiffs’ Swiss Army knives.

1 advice of counsel) in producing red multifunction pocketknives. That contention fails to raise a
2 genuine issue of material fact as to Defendants’ bad faith. As discussed above, Plaintiffs
3 acquired a registered trademark for the red scales after *Forschner II*. Defendants continued to
4 reproduce knives with the red scales after that date. Accordingly, and given that Defendants
5 have otherwise submitted insufficient evidence to raise a genuine issue of material fact as to any
6 of the other seven *Polaroid* factors, we agree with the district court that Defendants knowingly
7 and willfully infringed Plaintiffs’ trademark as a matter of law.⁵

8 Defendants also argue that Plaintiffs are collaterally estopped from asserting their claims
9 because of *Forschner II*. “The judicially-created doctrine of collateral estoppel, or issue
10 preclusion, bars a party from relitigating in a subsequent proceeding an issue of fact or law that
11 was clearly raised in a prior action where the party to be precluded . . . had a full and fair
12 opportunity to litigate the issue, and a decision on that issue was necessary to support a valid and
13 final judgment on the merits.” *Env’tl. Def. v. U.S. E.P.A.*, 369 F.3d 193, 202 (2d Cir. 2004)
14 (citation omitted). Here, Plaintiffs were not party to the prior action, *Forschner II*.
15 Defendants argue—for the first time on appeal—that Plaintiffs were in privity with The
16 Forschner Group, Inc. (“Forschner”), a party to the prior action, because Forschner later became
17 Victorinox Swiss Army, Inc. (“VSAI”), and Plaintiffs eventually acquired VSAI. “In those
18 cases where we have applied the doctrine of privity to a person who was not represented by a
19 fiduciary or agent in the previous litigation, we have found that that person nonetheless exercised
20 some degree of actual control over the presentation of a party’s case at the previous proceeding.”

⁵ For this reason, Defendants’ laches defense is unavailable because Defendants lack clean hands. Defendants cite *George Basch Co., Inc. v. Blue Coral, Inc.*, 968 F.2d 1532, 1540 (2d Cir. 1992), for the proposition that laches is still available to bar an award of profits even where there is willful infringement. This contention ignores the fact that the Lanham Act was subsequently amended to subject every award of monetary damages to “principles of equity,” 15 U.S.C. § 1117, *e.g.*, unclean hands.

1 *Stichting Ter Behartiging Van de Belangen Van Oudaandeelhouders In Het Kapitaal Van*
2 *Saybolt Int’l B.V. v. Schreiber*, 327 F.3d 173, 185 (2d Cir. 2003). Defendants did not
3 allege—let alone proffer evidence—that Plaintiffs directed, controlled, or participated in
4 Forscher’s involvement in the *Forschner* cases.⁶ Therefore, we decline to apply collateral
5 estoppel here.

6 **C. Award of Profits**

7 Defendants claim that the district court erred in awarding their profits to Plaintiffs based
8 upon gross revenues without any deduction for costs. The district court excluded Defendants’
9 evidence of costs because it was offered through an expert witness whose identity was not
10 previously disclosed. Defendants concede that the district court “may have acted within its
11 discretion in excluding the expert report,” Defendants-Appellants’ Victorinox I Brief at 61, but
12 they nonetheless contend that the district court should have offered them an opportunity to prove
13 costs or otherwise should have estimated costs on its own. In support of their contention,
14 Defendants point to a case where this Court reversed a district court’s decision on damages
15 because it did not estimate the defendant’s costs “based on the evidence before it.” *Murphy*

⁶ Defendants also argue that the district court erred in holding Defendant-Appellee John Meyer personally liable. The parties contend that, to recover against a corporate officer, a plaintiff must demonstrate that the officer was a “moving, active conscious force behind [the defendant corporation’s] infringement.” *Lee Myles Auto Group, LLC v. Fiorillo*, No. 10 Civ. 6267(PKC), 2010 WL 3466687, at *7 (S.D.N.Y. Aug. 25, 2010) (alterations in original) (*quoting Cartier v. Aaron Faber, Inc.*, 512 F. Supp. 2d 165, 170 (S.D.N.Y. 2007)). Defendants’ principal argument is that Meyer became president of B&F long after the company had decided to sell red-handled multifunction pocketknives and use the Royal Crest logo. However, the evidence indicates that Meyer was involved in the company as early as 1987, when he allegedly attended a business meeting with his father. Meyer has also been the President of B&F since 2001, has worked in every department at B&F, determines whether to extend marks to different product lines, and reviews product designs developed by B&F. Further, after working with B&F’s attorneys, Meyer authorized the continued sale of the knives after U.S. Customs’ seizure. Thus, we agree with the district court that Meyer was an “active conscious force” behind Defendants’ infringement.

1 *Door Bed Co., Inc. v. Int. Sleep Sys., Inc.*, 874 F.2d 95, 103 (2d Cir. 1989). Here, however, the
2 district court had *no* evidence of costs before it, and it was Defendants’ burden to produce that
3 evidence. See 15 U.S.C. § 1117(a) (“[D]efendant must prove all elements of cost or deduction
4 claimed.”); see generally *Bambu Sales, Inc. v. Ozak Trading Inc.*, 58 F.3d 849, 854 (2d Cir.
5 1995) (concluding the district court did not err in refusing to deduct expenses not proven by
6 documentary evidence in entering default judgment for trademark infringement). Therefore, we
7 see no reason to disturb the district court’s decision not to estimate damages.

8 **D. The Scope of the Injunction**

9 Defendants contend that the district court’s injunction was overbroad, in that it prevents
10 them from conducting legitimate business outside the scope of Plaintiffs’ pocketknife-based
11 claims. We agree. While a “party who has once infringed a trademark may be required to
12 suffer a position less advantageous than that of an innocent party,” *Guthrie*, 826 F.3d at 47
13 (quoting *Patsy’s Brand, Inc. v. I.O.B. Realty*, 317 F.3d 209, 220 (2d Cir. 2003)), an injunction
14 must nonetheless be “‘narrowly tailored to fit specific legal violations’ because the district court
15 ‘should not impose unnecessary burdens on lawful activity,’” *Starter Corp. v. Converse, Inc.*,
16 170 F.3d 286, 299 (2d Cir. 1999) (quoting *Waldman Publ’g Corp. v. Landoll, Inc.*, 43 F.3d 775,
17 785 (2d Cir. 1994)). Accordingly, “[a]n injunction is overbroad when it seeks to restrain the
18 defendants from engaging in legal conduct, or from engaging in illegal conduct that was not
19 fairly the subject of litigation.” *City of New York v. Mickalis Pawn Shop, LLC*, 645 F.3d 114,
20 145 (2d Cir. 2011). We review the scope of a district court’s injunction for abuse of discretion,
21 which may consist of reliance upon a clearly erroneous factual finding or incorrect application of
22 the law. *Guthrie*, 826 F.3d at 38.

1 Here, the district court’s injunction principally enjoins Defendants from “manufacturing
2 importing, advertising, marketing, promoting, supplying, distributing, drop-shipping, offering for
3 sale, exporting, or selling any products which bear the Plaintiffs’ Marks . . . or which bear any
4 marks or designs that are identical with, substantially indistinguishable from, and/or confusingly
5 similar to Plaintiffs’ Marks.” Victorinox II J.A. 54. The injunction, in turn, defines Plaintiffs’
6 Marks as their trademark for “two elongated oval-shaped red scales with curved edges,” as well
7 as the “Swiss Army Trade Dress,” consisting of the aforementioned scales, “a light-colored
8 cross-and-shield device on one of the red scales, multiple silver metal implements that fold into
9 the knife, and notches for tweezers (identified by the color gray) and for a toothpick (identified
10 by a tan color) at one end of the knife.” Victorinox II J.A. 54, 55.

11 While this section of the injunction is tailored to the infringement at issue, a separate
12 section appears to sweep more broadly, enjoining Defendants from utilizing discrete elements of
13 the Swiss Army Trade Dress in isolation. Specifically, the injunction enjoins Defendants from
14 “engaging in any activity constituting unfair competition” with Plaintiffs including “the use of
15 design elements” and “indicia associated with [Victorinox], such as the cross and shield device.”
16 Victorinox II J.A. 55; *see also* Victorinox II J.A. 56 (requiring that Defendants “remove any
17 simulation, reproduction, counterfeit, copy or colorable imitation of Plaintiffs’ Marks, . . . design
18 elements, . . . and indicia associated with Plaintiffs, such as the cross and shield device”). The
19 injunction may thus fairly be read as prohibiting (a) arguably legal conduct, namely the
20 production of multifunction pocketknives that do not include the trademarked red scales or
21 resemble Plaintiffs’ products in any way except for the inclusion of one element of the Swiss
22 Army Trade Dress, *e.g.*, a grey notch for tweezers, and (b) conduct outside the scope of this
23 litigation, *e.g.*, the production of other products (like kitchen utensils) that bear B&F’s “Royal

1 Crest” logo. See *Starter*, 170 F.3d at 299–300 (finding injunction overbroad where it
2 “exceed[ed] the jury’s findings of infringement” by covering the trademark at issue in
3 combination with other designs and its use on all footwear rather than simply athletic footwear,
4 issues which were “not at issue in [the] litigation”); *Waldman*, 43 F.3d at 785–86 (finding
5 injunction overbroad where it enjoined the publishing of books similar to those published by the
6 plaintiff as a whole, rather than false representations as to the books’ source, because the former
7 was a copyright issue for which no copyright had been registered); *Lipton v. Nature Co.*, 71 F.3d
8 464, 475 (2d Cir. 1995) (finding injunction overbroad that enjoined use of individual terms for
9 identifying certain groups of animals, rather than their “compilation”). We therefore remand
10 with instructions to amend the injunction so as to narrow its scope. Cf. *Guthrie*, 826 F.3d at
11 38–39 (“[O]ne must assess likelihood of confusion by reference to the marks in their entirety and
12 not merely focusing on similar elements in marks which, taken as a whole, are not confusingly
13 similar.” (internal quotation marks omitted)).

14 **II. Rule 60**

15 The district court’s initial infringement finding notwithstanding, Defendants maintain that
16 it erred in refusing to vacate the judgment pursuant to Federal Rule of Civil Procedure 60(b)(2)
17 based on “newly discovered evidence.” “Rule 60(b)(2) provides relief when the movant
18 presents newly discovered evidence that could not have been discovered earlier and that is
19 relevant to the merits of the litigation.” *Boule v. Hutton*, 328 F.3d 84, 95 (2d Cir. 2003).
20 Relief pursuant to Rule 60(b) should be granted “only upon a showing of exceptional
21 circumstances.” *United States v. Int’l Bhd. of Teamsters*, 247 F.3d 370, 391 (2d Cir. 2001). In
22 particular, to prevail on a Rule 60(b) motion, “[t]he movant must demonstrate that (1) the newly
23 discovered evidence was of facts that existed at the time of trial or other dispositive proceeding,

1 (2) the movant [was] justifiably ignorant of them despite due diligence, (3) the evidence [was]
2 admissible and of such importance that it probably would have changed the outcome, and (4) the
3 evidence [was] not merely cumulative or impeaching.” *Id.* at 392 (internal quotation marks
4 omitted). We review the district court’s denial of a Rule 60(b) motion for abuse of discretion.
5 *Rodriguez v. Mitchell*, 252 F.3d 191, 200 (2d Cir. 2001).

6 Here, the “newly discovered evidence” consisted of two letters from counsel to Forscher
7 and its affiliated companies to B&F’s then-counsel in late 1986 and April 1987. According to
8 Defendants, the letters demonstrate that Plaintiffs knew of Defendants’ allegedly infringing
9 knives long before they brought suit. We agree with the district court, however, that the
10 evidence could have been discovered earlier because the letters were found in Defendants’
11 former trademark attorney’s correspondence files, which were in its possession and control.
12 Defendants do not dispute this fact but instead contend that they did not look through those files
13 because they believed that all of their important files had been transferred to subsequent counsel.
14 Defendants have not demonstrated that this mistake constitutes justifiable ignorance.
15 Therefore, the district court did not abuse its discretion in denying Defendants’ Rule 60 motion.

16 **III. Disqualification of Locke Lord**

17 In a separate appeal, Defendants argue that Locke Lord, Plaintiffs’ counsel, should have
18 been disqualified from representing Plaintiffs based on a period between January 12, 2015 and
19 December 18, 2015 when it simultaneously represented Plaintiffs in this case and B&F on other
20 matters. Concurrent representation of parties on opposing sides of a litigation is a prima facie
21 conflict of interest. *See Hempstead Video, Inc. v. Inc. Village of Valley Stream*, 409 F.3d 127,
22 133 (2d Cir. 2005). In such cases, to survive a disqualification motion, the attorney “must be
23 prepared to show, at the very least, that there will be no actual or apparent conflict in loyalties or

1 diminution in the vigor of his representation.” *Id.* (emphasis omitted) (quoting *Cinema 5, Ltd.*
2 *v. Cinerama, Inc.*, 528 F.2d 1384, 1387 (2d Cir. 1976)). When evaluating whether this
3 presumption of shared confidences has been rebutted, “[c]ourts should inquire on the facts of the
4 case before them whether the practices and structures in place are sufficient to avoid
5 disqualifying taint.” *Id.* at 137. We review a district court’s order regarding the
6 disqualification of an attorney for an abuse of discretion. *GSI Com. Sols., Inc. v. BabyCenter,*
7 *L.L.C.*, 618 F.3d 204, 209 (2d Cir. 2010).

8 We, like the district court, are troubled by aspects of the record, including (1) the absence
9 of informed consent for the concurrent representation, (2) the fact that Locke Lord only
10 conducted client screens for only those clients who had recently generated more than \$100,000
11 of revenue, and (3) the fact that the letter Locke Lord’s counsel sent to B&F to notify them that
12 the firm was ceasing representation was facially misleading. Nonetheless, we agree with the
13 district court’s conclusion that there was no actual or apparent conflict justifying disqualification.
14 The concurrent representation began approximately eleven months after the district court entered
15 judgment against Defendants, and there was no evidence that Plaintiffs’ litigation team obtained
16 any material information from the B&F litigation team. Further, the concurrent representation
17 ended in December 2015, so there is “no actual or apparent conflict” now or in the future.
18 *Hempstead*, 409 F.3d at 133 (emphasis omitted). Thus, the district court did not abuse its
19 discretion in denying B&F’s motion.

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