UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

VERSATILE HOUSEWARES & GARDENING SYSTEMS, INC.,

Plaintiff,

-against-

THILL LOGISTICS, INC., SAS GROUP, INC., NAT, LLC, and JORDAN DREW CORPORATION,

Defendants.

SAS GROUP, INC. and JORDAN DREW CORPORATION,

Counterclaim and Third-Party Plaintiffs,

-against-

VERSATILE HOUSEWARES & GARDENING SYSTEMS, INC. and THOMAS MOTOSKO,

Counterclaim and Third-Party Defendants.

09 Civ. 10182 (SHS) (AJP)

ORDER

SIDNEY H. STEIN, U.S. District Judge.

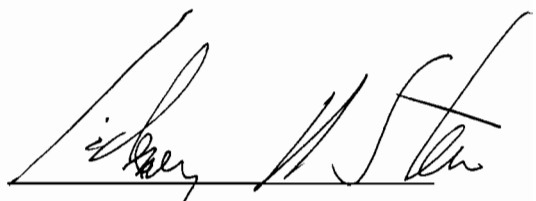
Defendants contend that the inventor of a gardening tool—third-party defendant Thomas Motosko—defrauded the U.S. Patent and Trademark Office ("PTO") by applying for a patent in September 2002 without informing the PTO that the invention had been on the market for almost three years. According to defendants, disclosure of that fact would have foreclosed the invention from receiving a patent. The same attorney who represented Motosko before the PTO now represents Motosko and plaintiff

Versatile Housewares & Gardening Systems, Inc., in this matter. Defendants anticipate calling that attorney, Michael Gratz, as a fact witness at trial to testify that Motosko withheld from him the information that (according to defendants) Gratz or Motosko should have disclosed to the PTO. Defendants have now moved to disqualify Gratz and his law firm from representing Motosko and Versatile in this action.

Defendants base their motion on the advocate-witness rule, which gives district courts the discretion to disqualify trial counsel who will also serve as a fact witness at trial. But it is far too early to know whether this action will proceed to trial and whether Gratz will participate as trial counsel. Indeed, motions for summary judgment are currently pending before this Court. Thus, even if defendants are correct about the role of Gratz as a necessary fact witness, the motion is premature. The Court therefore denies the motion without prejudice. *See Murray v. Metro. Life Ins. Co.*, 583 F.3d 173, 178-79 (2d Cir. 2009) (warning that motions to disqualify may be abused for litigation purposes, and explaining that many purposes for the advocate-witness rule do not apply to a litigation attorney who "will not act as an advocate before the jury"); *Ross v. Blitzer*, No. 09 Civ. 8666 , 2009 WL 4907062, at *3 (S.D.N.Y. Dec. 21, 2009) ("[W]here . . . it is not yet clear the extent to which an attorney's testimony might be necessary or prejudicial, numerous courts have found that motions to disqualify counsel are premature." (citing cases)); *Kent v. Scamardella*, No. 07 Civ. 844, 2007 WL 2012418, at *1 (S.D.N.Y. July 11, 2007) (treating motions to disqualify counsel with "strict scrutiny" because of potential for abuse as a litigation tactic).

Dated: New York, New York
March 24, 2014

SO ORDERED:



Sidney H. Stein, U.S.D.J.