

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

In the Matter of

Respondent

)
)
) Proceeding No. D2021-8
)
)

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26

The Director of the Office of Enrollment and Discipline ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office") and "Respondent") have submitted a Proposed Settlement Agreement ("Agreement") to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("USPTO Director") for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties' joint stipulated facts, joint legal conclusions, and agreed-upon sanction found in the Agreement.

Jurisdiction

1. At all times relevant hereto, Respondent of Cary, North Carolina, has been a registered patent attorney (Registration No. _____ and an attorney in good standing in the State of Massachusetts who was engaged in practice before the Office in trademark matters. Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

Joint Stipulated Facts

3. At all times relevant hereto, Respondent has been a registered patent attorney and a U.S. attorney in good standing in the State of Massachusetts.

4. Respondent has a solo practice, _____), where he provides patent, trademark, and copyright legal services. Additionally, Respondent performs patent prosecution services for other law firms.

5. Respondent advertised his legal services at _____ on Fiverr, an online freelancing platform.

6. On July 31, 2019, an individual named “Wen” contacted Respondent on Fiverr seeking a “USPTO registered attorney” to “do our US trademark applications.” Wen represented an association with a China-based IP firm that would “have no problem...fil[ing] the trademark applications, but...would like to use your name as our domestic REP.”

7. Prior to agreeing to a business relationship with Wen, Respondent did not inquire whether Wen was an active member in good standing of the bar of the highest court of any State or otherwise authorized to practice before the Office in trademark matters. Respondent acknowledges the unreasonableness of his due diligence in fully learning the extent to which Wen intended to use, and later used, Respondent’s bar credentials.

8. Respondent agreed to a business relationship that allowed Wen to use Respondent’s name to file applications and receive trademark certificates from the USPTO as a domestic representative. Respondent agreed to be paid thirty dollars (\$30) per trademark application filing.

9. Over the course of Respondent’s business relationship with Wen:

- a. Respondent did not monitor the status of, or review the trademark applications filed using his name, despite being apprised of the filings by Wen.

- b. Respondent was listed as the attorney of record in approximately one hundred and forty (140) trademark applications filed by Wen or one of Wen's associates with the USPTO.
- c. Respondent did not advise or discuss with the applicants, directly or through a bona fide foreign representative, or with Wen, important legal issues regarding their trademark applications, such as what constitutes a proper specimen and the difference between Section 1(a) and Section 1(b) trademark applications. Nor did Respondent provide them with any other substantive legal advice about their trademark applications.
- d. Respondent did not review or personally approve of the trademark applications prior to the filing of those applications by Wen or Wen's associates with the USPTO.
- e. Respondent's electronic signature was entered on at least 45 trademark applications and attendant declarations filed by Wen or one of Wen's associates with the USPTO. Respondent represents that the entry of his electronic signature on the trademark applications and attendant declarations was unbeknownst to him and done without his personal approval.

10. In early December 2019, the USPTO communicated with Respondent regarding ninety-two (92) suspect trademark applications filed on behalf of foreign-domiciled applicants bearing Respondent's name, signature, and bar information. The applications did not appear to be filed by Respondent. For example, the suspect trademark applications contained an email address that did not appear to belong to Respondent, and some applications contained an invalid Utah bar number and a Utah mailing address that did not appear to be associated with Respondent. It appeared to the USPTO that some person or entity may be impersonating Respondent for the purpose of

evading the U.S. Counsel Rule. Therefore, the USPTO sought Respondent's assistance and cooperation in removing him from the record in any application where his name, signature, or bar information may have been used without his permission.

11. Respondent represents that he concurred with the USPTO's action plan and proposed declaration, and submitted the signed declaration to support the USPTO's action. The declaration contained partially inaccurate, misstated, or misleading statements as to, *inter alia*, (a) whether Respondent agreed to serve as an attorney, correspondent, domestic representative, or signatory of the applicant or registrant, (b) whether there was reason for Respondent's name or electronic signature to appear on any filing in connection with the applicant or registration, and (c) whether Respondent's name appeared in the trademark applications without his prior knowledge. Respondent represents that he did not adequately review his records or the declaration prior to signing and submitting it to the USPTO. Respondent further represents and acknowledges that he incorrectly relied on the declaration as being the only course of action to correct the suspect trademark applications. Respondent sincerely regrets his inadequate preparation in examining the potentially contrary evidence to make an informed determination as to whether the statements in the declaration could be truthfully asserted.

12. Respondent represents that he was unaware that his electronic signature was entered on trademark applications and attendant declarations, and that he did not authorize Wen or Wen's associates to enter his electronic signature on any trademark applications and attendant declarations. Respondent, however, also acknowledges he would have been able to identify the impermissible signatures had he been actively monitoring the applications being filed using his name and bar credentials.

13. Respondent represents to OED that he did not adequately understand the U.S. Counsel

Rule during his business relationship with Wen, during his interactions with the staff attorney from the USPTO's Trademark Legal Policy Office ("TM Policy"), and when signing the declaration. Respondent represents that he now fully understands the U.S. Counsel Rule and expresses contrition for his prior lack of understanding of the U.S. Counsel Rule and recognizes that his acts and omissions implicated many provisions of the USPTO Rules of Professional Conduct.

14. Respondent acknowledges that he has a responsibility to take corrective action for potential harm caused by agreeing to serve as U.S. Counsel for foreign-domiciled trademark applicants from his business relationship with Wen. Respondent has taken corrective actions by (a) directly contacting the applicant or registrant of the suspect trademark applications on whose behalf he was attorney of record at the USPTO to inform them about the unauthorized trademark filings and the impermissible signatures on their trademark applications and attendant declarations that do not comply with the USPTO trademark signature rules, and by (b) contacting the USPTO regarding each of the filings that was made in violation of the USPTO signature regulations.

Additional Considerations

15. Respondent has expressed contrition for his prior lack of understanding of the U.S. Counsel Rule and recognizes that his acts and omissions implicated many provisions of the USPTO Rules of Professional Conduct.

16. Respondent has expressed his understanding of the seriousness of the violations of the USPTO Rules of Professional Conduct stipulated herein, and he acknowledges the potential adverse impact of his clients' intellectual property rights from the trademark filings that were made in violation of the USPTO's trademark regulations.

17. Respondent has never been the subject of professional discipline by the USPTO; and he represents that he has not been the subject of professional discipline by any court or any state bar.

18. Respondent has been fully cooperative with OED's investigation, including providing candid responses to request for information and engaging in a video interview with OED via WebEx.

Joint Legal Conclusions

19. Respondent acknowledges that, based on the information contained in the joint stipulated facts, above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

a. 37 C.F.R. § 11.101 (practitioner shall provide competent representation) and 37 C.F.R. § 11.804(d) (practitioner shall not engage in conduct prejudicial to the administration of the USPTO trademark registration process) by agreeing to serve as U.S. Counsel for foreign-domiciled trademark applicants without fully knowing or understanding U.S. Counsel Rule, including, for example, the important role played by the practitioner who represents trademark applicants before the USPTO in protecting the integrity of the U.S. trademark registration system through carefully scrutinizing applications and their contents (e.g., specimens) prior to filing of such applications with the USPTO.

b. 37 C.F.R. § 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) and 37 C.F.R. § 11.804(d) (practitioner shall not engage in conduct prejudicial to the administration of the USPTO trademark registration process) by (i) failing to take reasonable steps to ensure that he fulfilled his role under the U.S. Counsel Rule as the attorney of record in trademark applications; (ii) not reviewing adequately, or at all, applications

prepared by non-practitioners prior to those applications being filed; (iii) not monitoring the number of applications being filed under Respondent's name and bar credentials, and (iv) signing and submitting a declaration to the USPTO without first reviewing the declaration in a manner reasonable under the circumstances;

c. 37 C.F.R. § 11.503(b) (responsibilities regarding non-practitioner assistance) and 37 C.F.R. § 11.505 (assisting unauthorized practice of law) by (i) by failing to adequately understand Wen's intentions with regards to their agreement and monitor Wen's trademark application filings with the USPTO and (ii) failing to perform reasonable due diligence in preventing Wen from preparing, signing, and filing trademark documents;

d. 37 C.F.R. § 11.804(c) (practitioner shall not engage in misrepresentation) and 37 C.F.R. § 11.804(d) (practitioner shall not engage in conduct prejudicial to the USPTO trademark registration process) by (i) having trademark documents, including declarations, filed with the USPTO that were not signed by the named signatory (*i.e.*, documents impliedly falsely representing that the named signatory was the person who actually signed the document) and (ii) not reviewing or adequately reviewing, prior to filing, applications (*e.g.*, specimens purportedly showing actual use in commerce) submitted where the information provided to the USPTO in support of trademark registration was false; and

e. 37 C.F.R. § 11.804(i) (practitioner shall not engage in other conduct adversely reflecting on fitness to practice before the Office) by, prior to

entering into the business relationship with a third party, where Respondent would serve as U.S. Counsel for foreign-domiciled trademark applicants, not making an inquiry reasonable under the circumstances whether the third party would (i) communicate directly with the applicants and (ii) prepare, sign, and file trademark applications where the acts and omissions of the third party actually or potentially adversely affected the integrity of the USPTO trademark registration process.

Agreed-Upon Sanction

20. Respondent freely and voluntarily agreed, and it is hereby ORDERED that:
- a. Respondent shall be and is hereby publicly reprimanded;
 - b. Respondent shall serve a twelve (12) month probationary period beginning on the date of the Final Order;
 - c. Before the conclusion of the probationary period, Respondent shall provide to the OED Director a sworn affidavit or verified declaration attesting, and evidence demonstrating, that Respondent has successfully completed two (2) hours of continuing legal education on ethics/professional responsibility and four (4) hours on trademark law;
 - d. Before the conclusion of the probationary period, Respondent shall provide to the OED Director a sworn affidavit or verified declaration attesting that Respondent has reviewed thoroughly (1) all provisions of the Trademark Manual of Examining Procedure (TMEP), including, but not limited to, the provisions the USPTO's signature requirements, (2) 37 C.F.R. § 2.11, and (3) the commentary on the

Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, found at 84 FR 31498-01;

- e. On at least a weekly basis throughout the term of the 12-month probationary period, Respondent shall (i) search the USPTO Trademark Electronic Search System (“TESS”) for applications identifying him as the attorney of record, (ii) promptly inform appropriate persons at the USPTO of any filings identifying him as the attorney of record that were not made by him or with his knowledge and consent, and (iii) at monthly intervals during the probationary period, provide to the OED Director a sworn affidavit or verified declaration attesting that Respondent has searched TESS as set forth in this subparagraph;
- f. (1) In the event the OED Director is of the opinion that Respondent, during his probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct, the provisions of the Agreement, or any of the above conditions of probation identified in items c. through e., the OED Director shall:
 - (A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to 12 months for the violations set forth in the Joint Legal Conclusions, above;
 - (B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;
 - (C) grant Respondent fifteen (15) days to respond to the Order to Show Cause;and
- (2) In the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the

opinion that Respondent, during Respondent's probationary period, failed to comply with the USPTO Rules of Professional Conduct, the provisions of the Agreement, or any of the above conditions of probation identified in items c. through e., the OED Director shall:

(A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position;

and

(B) request that the USPTO Director enter an order immediately suspending Respondent for the violations set forth in the Joint Legal Conclusions above;

- g. Nothing in the Agreement or this Final Order shall prevent the OED Director from seeking discrete discipline for any misconduct that formed the basis for the Order to Show Cause issued pursuant to paragraph f., above;
- h. In the event the Respondent seeks a review of any action taken pursuant to paragraphs f. and g., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- i. The OED Director shall electronically publish the Final Order at the OED'S electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <https://foiadocuments.uspto.gov/oed/>;
- j. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Reprimand and Probation

This notice concerns Mr. _____, a registered practitioner (Reg. No. _____) and trademark attorney licensed in the state of Massachusetts, who resides

in Cary, North Carolina. Mr. [redacted] is hereby publicly reprimanded and placed on probation for twelve (12) months for violating 37 C.F.R. §§ 11.101, 11.103, 11.503(b); 11.505, 11.804(c), 11.804(d), and 11.804(i).

These violations are predicated on Mr. [redacted] acts and omissions during the course of his business relationship with an individual—who was not authorized to represent trademark applicants, registrants, or parties before the USPTO—with whom Mr. [redacted] had agreed to a business relationship that resulted in the individual using his name and bar credentials to file trademark application documents on behalf of foreign-domiciled applicants. Such acts and omissions allowed the individual to circumvent the purposes of the U.S. Counsel Rule, which sets forth a U.S.-licensed attorney requirement for foreign-domiciled trademark applicants and registrants. *See Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, 84 FR 31498 *et seq.* (July 2, 2019).

Mr. [redacted] is a solo practitioner who provides patent, trademark, and copyright legal services. Prior to agreeing to a business relationship with a third party, “Wen,” [redacted] did not inquire whether Wen was an active member in good standing of the bar of the highest court of any State or otherwise authorized to practice before the Office in trademark matters. Nevertheless, Mr. [redacted] agreed to a business relationship that resulted in Wen using Mr. [redacted] name to file applications and receive trademark certificates from the USPTO as a domestic representative. Mr. [redacted] agreed to be paid \$30 per trademark application filing. Over the course of Mr. [redacted]’s business relationship with Wen: (a) Mr. [redacted] did not monitor the status of or review the trademark applications filed using his name, despite being apprised of the filings by Wen; (b) Mr. [redacted] was listed as the attorney of record in approximately one hundred and forty (140) trademark applications filed by Wen or one of Wen’s associates with the USPTO; (c) Mr. [redacted] did not advise or discuss with the applicants, directly or through a bona fide foreign representative, or with Wen, important legal issues regarding their trademark applications, such as what constitutes a proper specimen and the difference between Section 1(a) and Section 1(b) trademark applications, nor did Mr. [redacted] provide them with any other substantive legal advice about their trademark applications; (d) Mr. [redacted] did not review or personally approve of the trademark applications prior to the filing of those applications by Wen or Wen’s associates with the USPTO; (e) Mr. [redacted]’s electronic signature was entered on at least 45 trademark applications and attendant declarations filed by Wen or one of Wen’s associates with the USPTO. Mr. [redacted] represents that he was unaware that his electronic signature was entered on those trademark applications and attendant declarations, and that he did not authorize Wen or Wen’s associates to enter his electronic signature on any trademark applications and attendant declarations.

In early December 2019, the USPTO communicated with Mr. [redacted] regarding ninety-two (92) suspect trademark applications filed on behalf of foreign-domiciled applicants that bore Mr. [redacted] name, signature and bar information. The applications did not appear to be filed by Mr. [redacted]. For example, the suspect

trademark applications contained an email address that did not appear to belong to Mr. [REDACTED], and some applications contained an invalid Utah bar number and Utah mailing address that did not appear to be associated with him. It appeared to the USPTO that some person or entity may be impersonating Mr. [REDACTED] for the purpose of circumventing the U.S. Counsel Rule. The USPTO sought Mr. [REDACTED] assistance and cooperation in removing him from the record in any application where his name, signature, or bar information may have been used without his permission.

Mr. [REDACTED] represents that he concurred with the USPTO's action plan and proposed declaration, and submitted his signature on the proposed declaration to support the USPTO's action. The declaration contained partially inaccurate, misstated, or misleading statements as to, *inter alia*, (a) whether Mr. [REDACTED] agreed to serve an attorney, correspondent, domestic representative, or signatory of the applicant or registrant, (b) whether there was reason for Mr. [REDACTED] name or electronic signature to appear on any filing in connection with the applicant or registration, and (c) whether Mr. [REDACTED] name appeared in the trademark applications without his prior knowledge. Mr. [REDACTED] represents that he did not adequately review his records or the proposed declaration prior to signing and submitting it to the USPTO.

Mr. [REDACTED] recognizes his ethical lapses, has demonstrated genuine contrition, and has accepted responsibility for his conduct. Mr. [REDACTED] represented to OED that he did not adequately understand the U.S. Counsel Rule during his business relationship with Wen, during his interactions with the staff attorney from the USPTO's Trademark Legal Policy Office, and when signing the declaration. Acknowledging that he personally has a duty to take remedial steps, Respondent has taken corrective action by (a) directly contacting his clients on whose behalf he has been attorney of record at the USPTO, to inform them about the unauthorized trademark filings and the impermissible signatures on their trademark applications and attendant declarations that do not comply with the USPTO trademark signature rules, and by (b) contacting the USPTO regarding each of the filings that was made in violation of the USPTO signature regulations.

Trademark practitioners engaged in practice before the USPTO are to be reasonably well informed as to the U.S. Counsel Rule. The rule became effective on August 3, 2019, and requires applicants, registrants, and parties to a trademark proceeding whose domicile is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. *See* 84 FR 31498; 37 C.F.R. § 2.11(a).

In the years preceding the U.S. Counsel Rule's effective date, the USPTO had seen many instances of unauthorized practice of law where foreign parties who are not authorized to represent trademark applicants were improperly representing foreign applicants before the USPTO. As a result, increasing numbers of foreign applicants were likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even

who the true owner of a mark is under U.S. law. This practice raised legitimate concerns that affected applications and any resulting registrations are potentially invalid, and thus negatively impacting the integrity of the trademark register. Hence, the USPTO implemented the requirement for representation by a qualified U.S. attorney in response to the increasing problem of foreign trademark applicants who purportedly were *pro se* (i.e., one who does not retain a lawyer and appears for himself or herself) and who were filing inaccurate and possibly fraudulent submissions that violated the Trademark Act and/or the USPTO's rules. For example, such foreign applicants filed applications claiming use of a mark in commerce, but frequently supported their use claim with mocked-up or digitally altered specimens. This indicated the mark may not actually have been in use. Many foreign domiciled trademark applicants appeared to be acting on the advice, or with the assistance, of foreign individuals and entities who are not authorized to represent trademark applicants before the USPTO. This practice undermines the accuracy and integrity of the U.S. trademark register and its utility as a means for the public to reliably determine whether a chosen mark is available for use or registration, and places a significant burden on the trademark examining operation. See 84 FR at 31498-31499.

The U.S. Counsel Rule is intended to increase USPTO customer compliance with U.S. trademark law and USPTO regulations, improve the accuracy of trademark submissions to the USPTO, and safeguard the integrity of the U.S. trademark register. For example, practitioners who represent trademark applicants before the USPTO are expected to, among other things, undertake a bona fide review of specimens submitted to the USPTO in support of a trademark application. A practitioner's failure to comply with his or her ethical obligations under the U.S. Counsel rule potentially adversely affects the integrity of the USPTO trademark registration process.

This action is the result of a settlement agreement between Mr. David and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <https://foiadocuments.uspto.gov/oed>;

- k. Nothing in the Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken

into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf;

- l. Respondent has agreed to waive all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- m. The parties shall bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.

Users,
Long, Stacy

Digitally signed by
Users, Long, Stacy
Date: 2021.09.24
08:21:21 -04'00'

Stacy Long
Acting Deputy General Counsel for General Law
U.S. Patent and Trademark Office
on delegated authority by

Date

Andrew Hirshfeld
Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office