

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

In the Matter of)	
)	
Gary Guttenberg,)	Proceeding No. D2015-15
)	
Practitioner)	
_____)	

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Gary Guttenberg (“Practitioner”), through counsel, have submitted a “Proposed Settlement of Disciplinary Matter Pursuant to 37 C.F.R. § 11.26” (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

Jurisdiction

1. At all times relevant hereto, Practitioner of Stockholm, Sweden, engaged in practice before the Office in trademark matters by filing trademark registration documents with the USPTO and is subject to the USPTO Rules of Professional Conduct 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.

Stipulated Facts

3. Practitioner is the sole owner of Intellectual Property Services USA Incorporated (“IPS”), which is incorporated in Sweden with a Swedish headquarters address and maintained a correspondence address of 1940 Duke Street, Alexandria, Virginia 22313. IPS is not a certified professional law corporation in California or any other state. Based on information provided by Practitioner, IPS is not a certified professional law corporation in Sweden, as the U.S. equivalent of a “certified professional law corporation” does not exist in Sweden.

4. Practitioner, through IPS, prepared and filed several post-registration trademark documents in trademark registrations before the USPTO.

5. Practitioner, through IPS, filed these post-registration trademark documents on behalf of trademark registrants after sending solicitation letters to registrants who had upcoming renewals due. The solicitation letters were sent from Europe by a service provider that

Practitioner paid to generate mailings to United States trademark registrants. These letters, mailed by Practitioner under the name Intellectual Property Services USA Incorporated with an Alexandria, Virginia correspondence address, were confusing and may have been misconstrued by recipients as being mailed by the United States Government. For example, these letters did not include the words "Advertising Material" on the outside envelopes, and did not give a reasonable impression of being mailed by a trademark practitioner.

6. Practitioner, through IPS, has not sent any solicitation materials since March 10, 2014, and does not intend to submit any additional filings with the USPTO arising out of IPS operations. Furthermore, Practitioner is in the process of dissolving IPS.

7. Practitioner received a legal opinion from a reputable law firm, of good national standing in the United States, which analyzed and approved the activities stipulated in items 3 through 6 above, prior to Practitioner having engaged in such activities. Nevertheless, Practitioner now fully understands why his conduct violated the USPTO Rules of Professional Conduct as set forth herein.

8. Practitioner is an active member of the State Bar of California and is in good standing in that jurisdiction. Practitioner has no prior history of discipline before either the USPTO or since being admitted to the State Bar of California in 1999.

Joint Legal Conclusions

9. Based on the foregoing stipulated facts, Practitioner acknowledges that his conduct violated the following disciplinary rules of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.701 (Communications concerning a practitioner's services) by sending misleading solicitations through IPS to trademark registrants who had upcoming renewals due; and
- b. 37 C.F.R. § 11.703(c) (Direct contact with prospective clients) by sending solicitations through IPS to trademark registrants who had upcoming renewals due without including the words "Advertising Material" on the outside envelope.

Agreed Upon Sanction

10. Practitioner agrees and it is hereby ORDERED that:

- a. Practitioner shall be, and hereby is, publicly reprimanded;
- b. Practitioner shall serve a twenty-four (24) month probationary period commencing on the date of this Final Order;
- c. Practitioner shall not submit any additional filings with the USPTO arising from IPS operations or that do not otherwise comply with the UPSTO Rules of Professional Conduct;

- d. Practitioner shall withdraw from IPS as soon as possible, either by merger or dissolution under Swedish law, but no later than December 31, 2015;
- e. On or before December 31, 2015, Practitioner shall submit to the OED Director: (1) an affidavit or declaration attesting to his compliance with the terms of the Agreement and this Final Order; and (2) a copy of relevant documents evidencing that IPS has been dissolved or merged so that Practitioner has no ownership or other interest in IPS;

f. It hereby directed that

(1) if the OED Director is of the good faith opinion that Practitioner, during Practitioner's probationary period, failed to comply with any provision of the Agreement, this Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) issue to Practitioner an Order to Show Cause why the USPTO Director should not enter an order immediately suspending Practitioner for up to six (6) months for the violations set forth in paragraph 9, above;

(B) send the Order to Show Cause to Practitioner at the last address of record Practitioner provided to The State Bar of California; and

(C) grant Practitioner thirty (30) days to respond to the Order to Show Cause; and

(2) in the event that after the 30-day period for response and consideration of the response, if any, received from Practitioner, the OED Director continues to be of the opinion that Practitioner, during Practitioner's probationary period, failed to comply with any provision of the Agreement, this Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Practitioner's response to the Order to Show Cause, if any; and (iii) argument and evidence causing the OED Director to be of the opinion that Practitioner, during Practitioner's probationary period, failed to comply with any provision of the Agreement, Final Order, or any provision of the USPTO Rules of Professional Conduct; and

(B) request that the USPTO Director enter an order immediately suspending Practitioner for up to six (6) months for

the violations set forth in paragraph 9, above;

- g. Nothing herein shall prevent the OED Director from seeking discipline for the misconduct leading to Practitioner's suspension pursuant to the preceding subparagraph;
- h. In the event the USPTO Director suspends Practitioner pursuant to subparagraph f., above, and Practitioner seeks a review of the suspension, any such review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- i. The OED Director shall publish a Final Order pursuant to 37 C.F.R. § 11.59(a) in the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at:
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- 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 Gary Guttenberg of Stockholm, Sweden, who is a member in good standing of the California State Bar, and who has no prior history of discipline before the USPTO or since being admitted to the State Bar of California in 1999.

Mr. Guttenberg has engaged in practice before the United States Patent and Trademark Office ("USPTO" or "Office") by filing documents in trademark registrations before the Office and is subject to the USPTO Rules of Professional Conduct set forth at 37 C.F.R. §§ 11.101 through 11.901. *See* 37 C.F.R. § 11.19(a).

The USPTO Director has publicly reprimanded Mr. Guttenberg and placed him on probation for twenty-four (24) months for violating 37 C.F.R. §§ 11.701 (Communications concerning a practitioner's services) and 11.703(c) (Direct contact with prospective clients).

Mr. Guttenberg, through his company, Intellectual Property Services USA Incorporated ("IPS"), violated the aforementioned USPTO Rules of Professional Conduct by filing post-registration trademark documents on behalf of trademark registrants after sending solicitation letters to registrants who had upcoming renewals due. The solicitation letters sent by Mr. Guttenberg, through IPS, were confusing and may have been misconstrued by recipients as being mailed by the United States Government. For

example, such letters did not include the words "Advertising Material" on the outside envelopes, and did not give a reasonable impression of being mailed by a trademark practitioner. Mr. Guttenberg now understands his violations of the USPTO Rules of Professional Conduct and has taken corrective action.

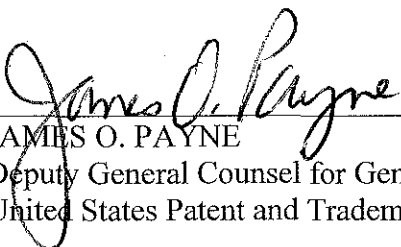
This action is the result of a settlement agreement between the OED Director and Mr. Guttenberg pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.20, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted at the Office of Enrollment and Discipline's Reading Room, which is publicly accessible at:
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

k. Nothing in the Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order:

(1) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office; and/or

(2) in any future disciplinary proceeding against Practitioner (i) as an aggravating factor to be taken under consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation made by or on Practitioner's behalf; and

l. The OED Director and Practitioner shall each bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.



JAMES O. PAYNE
Deputy General Counsel for General Law
United States Patent and Trademark Office

MAR - 9 2015

Date

on behalf of

Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office

cc: Director of the Office of Enrollment and Discipline
United States Patent and Trademark Office

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Counsel for practitioner