

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

In the Matter of:)
)
Nam D. Dao,) Proceeding No. D2015-23
)
Respondent)
_____)

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 Nam D. Dao (“Respondent”) have submitted a Proposed Settlement Agreement 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 USPTO 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' stipulated facts, legal conclusions, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Seattle, Washington, has been a registered patent attorney (Registration No. 63,089) and subject to the USPTO Rules of Professional Conduct set forth at 37 C.F.R. § 11.101 *et seq* and the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq*.¹
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.

Joint Stipulated Facts

3. Respondent of Seattle, Washington, is a registered patent attorney (Registration Number 63,089). He was registered as a patent attorney on September 16, 2008.

A. Representation of Clients in Patent and Trademark Matters Before the Office

Client 1

4. Respondent represented Client No. 1 in the prosecution of the client’s patent application before the Office.

¹ The USPTO Code of Professional Responsibility applies to a practitioner’s conduct that occurred prior to May 3, 2013. The USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq*., apply to a practitioner’s conduct occurring after May 2, 2013.

5. Respondent received an Office action on behalf of Client No. 1 and did not respond to it; therefore, Client No. 1's patent application became abandoned without the client's knowledge or consent.

6. After Client No. 1's patent application became abandoned, Client No. 1 inquired as to the status of the application. Respondent counseled Client No. 1 against filing an appeal, without explaining that the application was abandoned.

7. Respondent recognizes the seriousness of his misconduct concerning his representation of Client No. 1, is remorseful for his misconduct and for its effect on the reputation of the legal profession, and made timely restitution to Client No. 1.

Client 2

8. Respondent represented Client No. 2 in the prosecution of the client's patent application before the Office.

9. Respondent did not maintain the correct correspondence address in Client No. 2's patent application. Therefore, when the Office mailed a notice to file corrected application papers to Respondent, he did not receive it and Client No. 2's patent application became abandoned without the client's knowledge or consent.

10. Respondent did not timely communicate the abandonment to Client No. 2.

11. Respondent recognizes the seriousness of his misconduct concerning his representation of Client No. 2, is remorseful for his misconduct and for its effect on the reputation of the legal profession, and made timely restitution to Client No. 2.

Client 3

12. Respondent represented Client No. 3 in the prosecution of the client's patent application before the Office.

13. The USPTO mailed a Notice of Allowance and Issue Fee Due regarding Client No. 3's patent application to Respondent. Respondent received the notice, but he did not inform Client No. 3 about the issue fee or the deadline for paying the issue fee to avoid abandonment of the client's application.

14. Respondent's patent application became abandoned for failure to timely pay the issue fee without the client's knowledge or consent.

15. Respondent did not inform Client No. 3 about the abandonment of his patent application.

16. Respondent recognizes the seriousness of his misconduct concerning his representation of Client No. 3, is remorseful for his misconduct and for its effect on the

reputation of the legal profession, and undertook a timely, good faith effort to make restitution to Client No. 3.

Client 4

17. Respondent represented Client No. 4 in connection with two U.S. trademark applications filed in the Office.

18. The USPTO mailed to Respondent a Notice of Allowance in each of Client No. 4's trademark applications. Each notice informed Respondent that the filing of a statement of use was required within six months or the application would become abandoned.

19. Respondent received the notices, but did not respond to them; therefore, both trademark applications became abandoned without the client's knowledge or consent.

20. Respondent did not timely communicate with Client No. 4 about the notices, nor did he timely inform the client that the trademark applications had become abandoned.

21. Moreover, while representing Client No. 4 before the Office in the two trademark applications, Respondent was aware that he became administratively suspended from practicing law as an attorney in Wisconsin, *i.e.*, the only state where he is licensed to practice trademark and other non-patent law.

22. Because of the administrative suspension of his Wisconsin law license, Respondent was no longer an attorney qualified under 37 C.F.R. §§ 2.17(a) and 11.14 to represent clients before the Office in trademark matters. Nevertheless, Respondent remained as attorney of record in Client No. 4's trademark applications instead of withdrawing as attorney of record.

23. Respondent recognizes the seriousness of his misconduct concerning his representation of Client No. 4, is remorseful for his misconduct and for its effect on the reputation of the legal profession, and undertook a timely, good faith offer of restitution to Client No. 4, which the client declined while acknowledging Respondent's contrition.

Client 5

24. Respondent represented Client No. 5 in connection with a U.S. trademark application filed in the Office.

25. When Respondent filed Client No. 5's trademark application, Respondent was aware that he had been administratively suspended from practicing law as an attorney in Wisconsin, *i.e.*, the only state where he is licensed to practice trademark and other non-patent law.

26. Because of his administrative suspension of his Wisconsin law license, Respondent was no longer an attorney qualified under 37 C.F.R. §§ 2.17(a) and 11.14 to represent clients

before the Office in trademark matters. Nevertheless, Respondent filed Client No. 5's trademark application with the Office.

27. Respondent took steps to withdraw as attorney of record in Client No. 5's trademark application.

28. Respondent has been reinstated to active status to practice law as an attorney in Wisconsin.

B. Failure to Cooperate with OED Investigation

29. Respondent received a lawful request for information ("RFI") sent by the Office of Enrollment and Discipline ("OED") that allowed him 30 days to respond.

30. Respondent did not respond to the RFI for six months, nor did he request an extension of time to respond.

31. During the six-month interim, OED sent Respondent two reminder letters by certified mail, which were returned to OED as "unclaimed," and left a telephone message for him at a phone number with a voicemail greeting message that had Respondent's name.

32. Respondent did not contact OED during the six-month period.

33. When Respondent finally replied to the RFI, he did not offer an explanation for his delay in responding to OED's request for information. He apologized, however, for his late response and otherwise cooperated with OED's investigation thereafter.

Joint Legal Conclusions

34. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, Respondent's acts and omissions violated the following provisions of the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 10.23(b)(5) (engaging in conduct that is prejudicial to the administration of justice) and 37 C.F.R. § 11.505 (engaging in the unauthorized practice of law) by not withdrawing and continuing to represent clients in trademark applications before the Office when Respondent was no longer qualified under 37 C.F.R. §§ 2.17(a) and 11.14 to represent trademark applicants due to the administrative suspension of his license to practice law in the only jurisdiction where he was licensed to practice trademark and other non-patent law;
- b. 37 C.F.R. §§ 10.77(c) (neglecting a legal matter entrusted to the practitioner) by allowing patent applications and trademark applications to become abandoned without the clients' knowledge and consent;

- c. 37 C.F.R. § 11.104(a)(3) (keeping the client reasonably informed about the status of the matter) by failing to inform clients that their patent and/or trademark applications had become abandoned; and
- d. 37 C.F.R. § 11.801(b) by failing to cooperate in an OED investigation by not timely responding to a lawful request for information for six months without good cause.

Sanction

In light of the OED Director's and Respondent's entering into the Proposed Settlement Agreement, the OED Director's recommendation, and the discussed mitigating factors, it is hereby determined that there is no genuine issue of material fact and that discipline of Respondent is appropriate.

ACCORDINGLY, Respondent has agreed, and it is **ORDERED** that:

- a. Respondent shall be, and hereby is, suspended from practice before the Office in patent, trademark, and other non-patent matters for six (6) months commencing on the date of this Final Order;
- b. Respondent shall remain suspended from the practice of patent, trademark, and non-patent law before the USPTO until the OED Director grants a petition reinstating Respondent pursuant to 37 C.F.R. § 11.60;
- c. Respondent shall comply with 37 C.F.R. § 11.58;
- d. Respondent shall comply with 37 C.F.R. § 11.60 upon any request for reinstatement to practice before the Office;
- e. The OED Director shall electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- f. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension

This notice concerns Nam Duy Dao of Seattle, Washington, a registered patent attorney (Registration Number 63,089). The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has suspended Mr. Dao for six (6) months from practice before the Office in patent, trademark, and other non-patent matters for violating provisions of the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct. Mr. Dao recognizes the seriousness of his misconduct, is remorseful for it and

for its effect on the reputation of the legal profession, and made restitution and/or made timely, good faith efforts to make restitution to his clients.

Mr. Dao violated 37 C.F.R. § 10.77(c) (neglecting a legal matter entrusted to the practitioner) by allowing patent applications and trademark applications to become abandoned without the clients' knowledge and consent. He violated 37 C.F.R. § 11.104(a)(3) (keeping the client reasonably informed about the status of the matter) by failing to inform clients that their patent and/or trademark applications had become abandoned. Mr. Dao violated 37 C.F.R. § 10.23(b)(5) (engaging in conduct that is prejudicial to the administration of justice) and 37 C.F.R. § 11.505 (engaging in the unauthorized practice of law) by not withdrawing and continuing to represent clients in trademark applications before the Office when Mr. Dao was no longer qualified under 37 C.F.R. §§ 2.17(a) and 11.14 to represent trademark applicants due to the administrative suspension of his license to practice law in the only jurisdiction where he was licensed to practice trademark and other non-patent law.

Mr. Dao also violated 37 C.F.R. § 11.801(b) by failing to cooperate in an Office of Enrollment and Discipline ("OED") investigation by not timely responding to a lawful request for information for six months without good cause.

Practitioners are reminded of their duties under 37 C.F.R. § 11.801(b), which include the specific duty to cooperate with OED in an investigation of any matter before it. A lengthy delay in responding to a lawful request for information from the Office of Enrollment without good cause may constitute misconduct under the USPTO Rules of Professional Conduct, as it did in this case.

This action is the result of a settlement agreement between Mr. Dao 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, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted at OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at:

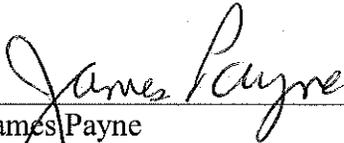
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- g. The USPTO shall dissociate Respondent's name from any Customer Numbers and the public key infrastructure ("PKI") certificate associated with those Customer Numbers;

- h. Respondent shall not apply for or obtain a USPTO Customer Number, or have his name added to a Customer number, unless and until he is reinstated to practice before the USPTO;
- i. Nothing in 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; and (3) when considering any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60; and
- j. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement.

MAY 15 2015

Date



James Payne
Deputy General Counsel for General Law
United States Patent and Trademark Office

On behalf of

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

cc:

OED Director

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