

**BEFORE THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of)
)
Bang-er Shia,)
)
Appellant.)
_____)

Proceeding No. D2014-31

Final Order

The Director of the Office of Enrollment and Discipline (“OED”) at the United States Patent and Trademark Office (“USPTO” or “Agency”) instituted disciplinary proceedings against Bang-er Shia (“Appellant”) for violations of its disciplinary rules in connection with improper filing of trademark documents before the Agency. A hearing was held before Administrative Law Judge (“ALJ”) Alexander Fernandez and, on April 22, 2015, ALJ Fernandez issued an initial decision concluding that the Appellant violated six (6) ethics rules governing practice before the USPTO. As a sanction, the ALJ excluded Appellant from practicing before the USPTO in patent, trademark and other non-patent matters. Pursuant to 37 C.F.R. § 11.55, Appellant appealed the April 22, 2015 initial decision of the ALJ.

On appeal, the Director herein finds that the ALJ’s findings are fully supported by the record. The record supports the ALJ’s findings that Appellant engaged in misconduct in four ways: (1) Appellant improperly signed trademark documents filed with the USPTO; (2) Appellant improperly filed trademark documents prepared by foreign attorneys; (3) Appellant’s actions went beyond the role of a domestic representative and constituted practice before the Office in trademark matters; and (4) Appellant continued to act as a domestic representative after being excluded from doing so by the Trademark Commissioner. Further, the ALJ properly concluded that the misconduct violated six (6) ethics rules. Finally, the ALJ considered the factors required by 37 C.F.R. § 11.54(b) before concluding that a sanction of exclusion was appropriate.

As discussed further below, the ALJ’s initial decision is **AFFIRMED**.

I. BACKGROUND

A. Trademark Proceedings Before The USPTO

1. For each initial trademark application, USPTO assigns a unique identifier known as a serial number. Tr.¹ at 90.

2. Documents filed in connection with a trademark application or registration must be signed by a proper person. 37 C.F.R. § 2.193(e); Trademark Manual of Examining Procedure (TMEP)² § 611.02. For example, trademark documents that require a verification of the facts, such as an initial application or Statement of Use, must be sworn to in a declaration that is signed by the owner or the owner's authorized representative. 37 C.F.R. § 2.193(e)(1); TMEP §§ 611.02, 611.03(a); Tr. at 155, 206-207. A person properly authorized to sign a declaration on behalf of an owner is either (i) a person with legal authority to bind the owner (*e.g.*, a corporate officer or general partner of a partnership); (ii) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the owner; or (iii) an attorney with a power of attorney from the owner. 37 C.F.R. § 2.193(e)(1); TMEP § 611.03(a). A person who does not satisfy one of these three requirements cannot sign a trademark document on behalf of an owner.

3. A Response to Office Action³ must be signed consistent with the procedures set forth in 37 C.F.R. § 2.193(e)(2), *see* 37 C.F.R. § 2.62(b), TMEP § 712, that is, signed by the owner, a qualified practitioner, or someone with legal authority to bind the owner.

4. Where a document must be signed by someone with legal authority to bind a corporation, "a corporate officer must sign." TMEP § 611.06(d). A corporate officer is a person who holds an office established in the articles of incorporation or corporate bylaws. *Id.* Usual titles for such officers include, but are not limited to, President, Vice-President, Secretary, or Treasurer. *Id.*

¹ "Tr." denotes references to the hearing transcript found at Tab F in the Administrative Record ("A.R.") for Proceeding D2014-31.

² The Trademark Manual of Examining Procedures (TMEP) is a reference manual for the practices and procedures for prosecuting trademark applications before USPTO. *See* <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/Apr2013/d1e2.xml#/manual/TMEP/Apr2013/introductiond1e1.xml>.

³ An Office Action is a legal document issued by the USPTO and which identifies legal and procedural issues with a trademark application, and related filings. Tr. at 143-144.

5. Proper signatories are required to ensure that documents filed with the Office and which could effectuate a change in an applicant's right are signed by someone with broad authority, not just as to their trademark rights, but as to any of the rights of the entity. Tr. at 334.

6. The procedures for trademark application proceedings allow a limited, non-signatory role for a "domestic representative" and a "correspondent." A domestic representative is an individual appointed by a foreign trademark applicant to receive notices or process in proceedings affecting the applicant's mark. TMEP § 610; Tr. at 56-57, 328. A domestic representative is not authorized to prosecute an application or represent a party in a proceeding before the USPTO, unless the domestic representative is also a qualified practitioner who has been recognized by the USPTO as the representative of an applicant or registrant or is someone with legal authority to bind a juristic applicant (*i.e.*, a corporate officer). TMEP §§ 609.04, 611.06(d); Tr. at 58, 194-195, 328-330, 342, 372.

7. A trademark applicant may also designate a correspondence address so that correspondence from the USPTO will be transmitted to a "correspondent" at that address. TMEP § 609; Tr. at 58-59, 87-88. As with a domestic representative, a correspondent may not prosecute an application or represent a party in a proceeding before the USPTO, unless the correspondent is also a qualified practitioner who has been recognized by the USPTO as the representative of the applicant or registrant or is someone with legal authority to bind a juristic applicant (*i.e.*, a corporate officer). TMEP §§ 609.04, 611.06(d); Tr. at 60-61, 344-345, 372.

B. Trademark Electronic Application System ("TEAS")

8. The Trademark Electronic Application System ("TEAS") is the electronic filing system used by applicants and registrants to file documents with the Agency. Tr. at 61. TEAS is accessed via the USPTO Webpage, www.uspto.gov/trademarks, and the various TEAS forms used to submit filings can also be found there and are available to the public. Tr. at 61, 176, 224; Appellant's Ex. P1-P2. USPTO encourages electronic filing of forms because forms filed using TEAS are automatically uploaded to the USPTO's internal systems and there are fewer filing errors. Tr. at 62.

9. Using TEAS, an applicant can fill out an application form, pay an application fee, and receive a serial number for the application. Tr. at 61. Additional filings, such as Responses to Office Actions, Changes of Correspondence Addresses, can also be filed using TEAS. Tr. at 61-62. USPTO rules govern who may sign the forms in trademark proceedings. TMEP § 611.01(b); Tr. at 205-207.

C. Methods for Electronically Signing TEAS Filings

10. There are three acceptable signature methods available when filing documents electronically through TEAS. TMEP § 611.01(c); Tr. at 67.

11. The first method is the "Direct" signature method. Here, an appropriate signatory personally enters his or her name, in any combination of letters, numbers, spaces, and/or punctuation marks, between two forward slashes. 37 C.F.R. § 2.193(c)(1); TMEP § 611.01(c); Tr. at 67, 72, 78. This is the default method of filing documents with TEAS. Tr. at 76. Using the Direct sign method, if a trademark document to be filed is saved for later filing, any electronic signature would not be saved on the TEAS form and would need to be reentered – personally by the proper signatory – due to a presumption that the document is being saved to be modified later. Tr. at 211-213. The requirement that the electronic signature be reentered at the time of filing is done purposefully, to ensure that the person signing and filing the document is able to personally verify the facts set forth in the document at the time of filing. Tr. at 211-213, 216-217. The XML data for filings using this signature method will show "<signature-type> DIRECT." *See, e.g.,* Gov. Ex. 507, at G17862.

12. The second method for signing trademark documents to be filed through TEAS is the "Esign-on" or "E-mail Text Form to second party for signature." TMEP § 611.01(c); Tr. at 67, 103-105. This method allows a TEAS user to fill out a trademark document online and email the document to the appropriate signatory for electronic signature within TEAS. TMEP § 611.01(c); Gov. Exs. 476, 478-480; Tr. at 67, 103-105, 109. Using this method, there is no block to enter an electronic signature. Tr. at 105. Rather, the appropriate signatory personally signs the document, which is then automatically returned via TEAS to the party who requested signature. TMEP § 611.01(c); Tr. at 109. The XML data for filings using this signature method will show "<signature-type> ESIGN-ON." Tr. at 116; Gov. Ex. 473, at G17739.

13. The third method for signing trademark documents is the "HSIGN-On" or "Handwritten pen-and-ink signature" method, which allows a document that is filled out online to be printed and mailed or faxed to a signatory for personal signature in the traditional pen-and-ink manner. TMEP § 611.01(c); Tr. at 67-68, 128. The signature portion, along with any required declaration, is then scanned to a JPEG or PDF file and attached to the TEAS form for submission to the USPTO. TMEP § 611.01(c). This method does not allow for an electronic signature on the TEAS form. Gov. Ex. 489; Tr. at 129-130. The XML data for filings using this signature method will show "<signature-type> HSIGN-ON." Gov. Ex. 508, at G17938; Tr. at 137.

14. A person may not electronically sign another person's name to a trademark document and file that document with the Office. TMEP § 611.01(b) and (c); Tr. at 64, 245, 340, 342.

15. There is a hyperlink in the TEAS forms that will take filers to a Help screen, which provides additional information about who is a proper signatory for each type of form. Tr. at 76, 215, 345-346.

16. If a document is signed properly then the question is whether or not the person is an authorized signatory. Tr. at 392. USPTO does not proactively investigate filings that appear correct on their face to determine if a signatory is authorized. Tr. at 363-364.

II. FINDINGS OF FACT

1. On September 26, 2005, the USPTO registered Appellant as a patent agent. Tr. at 295-296. Appellant's registration number is 57,568. Tr. at 296.

2. Appellant is not and has never been an attorney licensed in any state to practice law. Tr. at 297.

3. Appellant operates a business called the International Patent Office of Bang Shia. Tr. at 315-317. She is associated with the following e-mail addresses [REDACTED]; and [REDACTED]. Tr. at 308-309.

4. Appellant is associated with the following mailing addresses: 102 Lindencrest Court, Sugar Land, Texas 77479 ("Lindencrest address"); 204 Canyon Creek, Victoria, Texas, 77901 ("Canyon Creek address"); and 3105 Summerfield Ridge Court, Sugar Land, Texas, 77479 ("Summerfield Ridge address"). Tr. at 298, 300-301.

5. Starting in 2005, Appellant began filing documents electronically with the USPTO and began paying fees electronically with the USPTO. Tr. at 320-321.

6. Appellant began serving as a domestic representative and correspondent for foreign trademark applicants in 2005 or 2006. Tr. at 16-21, 222.

7. Since early 2005 or 2006, Appellant has been a domestic representative for patent and trademark applications. Tr. at 222. Appellant's foreign clients provided her with files which she checked for errors and filed with the USPTO. Tr. at 222, 474, 501-502, 506-507, 619.

8. For the trademark filings identified at Government Exhibits 507 through 514, Appellant admitted entering the electronic signatures of her clients on those filings and personally filing the documents with the USPTO. Tr. at 574-575. This is so despite Appellant acknowledging that she could have transmitted filings to third parties for signature and then filed the documents with the Office. Jnt. Ex. 11, at G1575; Tr. at 580.

The Trademark Applications

A. Trademark Application 85/585,031 (the '031 application)

9. On March 30, 2012, Appellant filed the '031 application with the USPTO, identifying a Chinese company, Dongshan Dongxing Aquatic Processing Co., Ltd., ("Dongshan") as the applicant and owner of the mark seeking registration. Gov. Ex. 507; Tr. at 465. Appellant is not an officer with this corporation. Tr. at 467. Appellant's [REDACTED] e-mail address was identified as the designated e-mail address in the "Applicant Information" and "Correspondence Information" fields. Gov. Ex. 507; Tr. at 467-468, 473.

10. Dongshan's foreign attorney, Xiamen Shinhwa Co., Ltd., prepared the '031 application and sent it to Appellant. Gov. Ex. 507; Tr. at 474. Appellant checked the document for accuracy and then filed it with the USPTO. Tr. at 474-475, 477-478; Gov. Ex. 507.

11. Appellant filed the '031 application by the Direct sign method, which requires that an appropriate signatory personally affix their electronic signature to the trademark documents at the time of filing. Gov. Ex. 507, at G17862. However, prior to filing, Appellant electronically entered the signature of another

person, “/Chi-Ching Weng/”, on the ‘031 application. Tr. at 478-479; Appeal at 6. Appellant also entered her name and [REDACTED] e-mail address as designated recipient for the filing confirmation. Gov. Ex. 507; Tr. at 479-480.

12. On April 11, 2012, Appellant filed a Change of Correspondence Address with the USPTO in connection with the ‘031 application. Gov. Ex. 507, at G17867; Tr. at 480. The Change of Correspondence Address identified Appellant’s Canyon Creek address and [REDACTED] e-mail address as the new correspondence addresses for the ‘031 application. Gov. Ex. 507, at G17867. Appellant filed the Change of Correspondence Address via the Direct sign method and electronically signed the name of another person, “Chi-ching Weng”, on the Change of Correspondence Address form. Gov. Ex. 507, at G17867, G17869; Tr. at 482, 574-575.

13. Appellant was paid for her work on the ‘031 trademark filings. Tr. at 467.

B. Trademark Application 85/712,340 (“the ‘340 application”)

14. The ‘340 application was filed with the USPTO on August 24, 2012 and identified Jet Crown International, Ltd., a corporation in Taiwan, as the owner of the mark. Gov. Ex. 510; Tr. at 92, 94, 516. Appellant is not an officer with this corporation. Tr. at 516. Appellant’s [REDACTED] e-mail address was identified as the designated e-mail address in the “Applicant Information” fields. Gov. Ex. 510, at G18110; Tr. at 93-94.

15. Although the ‘340 application identified Jet Crown as the correspondent for the application, Appellant’s Lindencrest Court address and her [REDACTED] email address are identified in the “Correspondence Information” fields. Gov. Ex. 510, at G18110-G18111; Tr. at 93, 517.

16. Appellant submitted the ‘340 application to the USPTO using the Direct sign method. Gov. Ex. 510, at G18116; Tr. at 96-97, 518-519. Appellant electronically signed the name of another person, “/Wang, Edmund/”, on the application and filed it with the USPTO. Tr. at 520, 574-575; Appeal at 7; Gov. Ex. 510, at G18111.

17. Appellant paid the filing fee for the '340 application using her own credit card and designated her [REDACTED] e-mail address for receipt of the filing confirmation. Gov. Ex. 510, at G18117; Tr. at 98-99; 525-526, 549.

18. On May 26, 2013, Appellant filed a Statement of Use related to the '340 application. Gov. Ex. 510, at G18131-G18133; Tr. at 526, 529. The Statement of Use was executed using the HSIGN-On method, and a PDF bearing the handwritten signature of Edmund Wang was attached to the document. Gov. Ex. 510, at G18136, G18141; Tr. at 527. The Statement of Use was filed after Appellant had received an Order of Exclusion from the Trademark Commissioner, dated February 21, 2013, excluding Appellant from participating as a correspondent or domestic representative in any trademark matters before the USPTO. Int. Ex. 4; Gov. Ex. 510; Tr. at 530.

19. In the same May 26, 2013 filing, Appellant also purported to change the correspondence address for the '340 application to "c/o SW TW Shen". Gov. Ex. 510, at G18131; Tr. at 532. However, despite identifying "SW TW Shen" as the new correspondent, the correspondence address was identified as Appellant's Summerfield Ridge address and the email was identified as Appellant's [REDACTED] e-mail address. Gov. Ex. 510, at G18131; Tr. at 533.

20. Appellant was paid for her work. Tr. at 516-517.

C. Trademark Application 85/747,741 (the '741 application)

21. On October 7, 2012, Appellant submitted the '741 application to the USPTO, identifying Min Hsiang Corporation, a corporation in Taiwan, as the applicant and owner of the mark seeking registration. Gov. Ex. 512; Tr. at 562. Appellant is not an officer with this corporation. Tr. at 561. Appellant's [REDACTED] e-mail address was identified in the "Applicant Information" field. Gov. Ex. 512, at G18247. Appellant's Lindencrest Court address and Appellant's [REDACTED] email address are identified in the "Correspondence Information" fields. Gov. Ex. 512, at G18247-G18249, G18314, G18319.

22. Appellant submitted the '741 application to the USPTO using the Direct Sign method. Gov. Ex. 512, at G18254. Prior to submitting the '741 application to the USPTO, Appellant entered the electronic signature of another person, "/Tim Wu/", into the signature field. Tr. at 574-575, 562-563; Appeal at 7.

23. On February 7, 2013, an Outgoing Office Action was issued in the '741 application, seeking various points of clarification with the application. Gov. Ex. 512, at G18258. On March 24, 2013, Appellant submitted a Response to Office Action via the Direct Sign method. Gov. Ex. 512, at G18264, G18268. Before submitting the Response to Office Action, Appellant entered the electronic signature of another person, "/Tim Wu/", into the signature field. Gov. Ex. 512, at G18264; Tr. at 564, 574-575. Appellant also submitted a .pdf to the Miscellaneous Statement section for the '741 application, which included a handwritten signature by Tim Wu, dated March 6, 2013. Gov. Ex. 512, at G18267. Appellant's [REDACTED] e-mail address was designated as the reply e-mail for the Response to Office Action. Gov. Ex. 512, at G18269.

24. On August 17, 2013, Appellant filed a Statement of Use for the '741 application. Gov. Ex. 512, at G18287; Tr. at 564. The Statement of Use was submitted using the HSIGN-On signature method. Gov. Ex. 512, at G18292. Appellant both electronically entered the name of another person, "/Tim Wu/," on the Statement of Use, as well as attached the handwritten signature of Tim Wu. Gov. Ex. 512, at G18288, G18299; Tr. at 564-565. The Statement of Use was filed after Appellant had received the Exclusion Order from the Trademark Commissioner dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 512.

D. Trademark Application 85/595,869 (the '869 application)

25. On April 12, 2012, Appellant filed the '869 application with the USPTO, identifying a Taiwanese corporation, Eng Ku Optical Industrial Co., Ltd., as the applicant and owner of the mark. Gov. Ex. 508; Tr. at 483, 489. Appellant is not an officer with this corporation. Tr. at 484. Appellant's [REDACTED] e-mail address was identified as the designated e-mail address in the "Applicant Information" fields. Gov. Ex. 508, at G17931; Tr. at 484. Appellant's Canyon Creek address and her [REDACTED] email address are identified in the "Correspondence Information" fields. Gov. Ex. 508, at G17931-G17932; Tr. at 484-485.

26. The '869 application was filed using the HSIGN-On method, which permits a handwritten pen-and-ink signature to be attached to the application. Gov. Ex. 508, at G17938; Tr. at 486-487. A signed declaration signed by "Terry Chou, President" was submitted with the application. Gov. Ex. 508, at G17941; Tr. at 488-489.

27. On April 30, 2012, Appellant submitted a Change of Correspondence Address to the USPTO for the '869 application, changing the original correspondence address from "Lan Loop Patent & Trademark, Victoria Texas 77479 US" to Appellant's Canyon Creek address. Gov. Ex. 508, at G17943; Tr. at 489-490. Appellant's [REDACTED] e-mail address remained the correspondence e-mail for the '869 application. Gov. Ex. 508, at G17943. Appellant entered the electronic signature of another person, "/Terry Chou/", to the Change of Correspondence Address form and transmitted it to the USPTO using the Direct filing method. Gov. Ex. 508, at G17945; Tr. at 490-491, 574-575.

28. On January 22, 2013, a Statement of Use was submitted to the USPTO for the '869 application. Gov. Ex. 508, at G17958-60; Tr. at 491. Appellant filed the Statement of Use using the Direct sign method. Gov. Ex. 508, at G17964; Tr. at 493-494. Appellant entered the electronic signature of another person, "/Terry Chou/", on the Statement of Use prior to submitting it to the USPTO. Gov. Ex. 508, at G17960; Tr. at 494-495; Appeal at 8. Appellant also attached a .pdf to the Statement of Use that consisted of a copy of the Statement of Use signed on January 17, 2013, by Mr. Chou. Gov. Ex. 508, at G17969; Tr. at 495.

29. Appellant was paid for her work. Tr. at 484.

E. Trademark Application 85/689,678 ("the 678 application")

30. On July 30, 2012, Appellant filed the '678 application filed with the USPTO identifying a Chinese corporation, Kunshan Pepwing Textile Co. Ltd., as the applicant and owner of the mark seeking registration. Gov. Ex. 509; Tr. at 500. Appellant is not an officer with this corporation. Tr. at 500. Appellant's [REDACTED] e-mail address was identified as the designated e-mail address in the "Applicant Information" fields. Gov. Ex. 509; Tr. at 484.

31. The '678 application was completed by an attorney of Kingkraft in China who then transmitted it to Appellant for filing with the USPTO. Tr. at 501. Appellant then checked the documents to add any missing information, including any signatures, and then filed the documents with the USPTO using the Direct sign method. Gov. Ex. 509, at G18001; Tr. at 502, 575. Appellant electronically entered the signature of another person, "/George Yang/", in the signature field. Ex. 509, at G17994; Tr. at 502, 574; Appeal at 9. Appellant's [REDACTED] e-mail address was identified to receive the filing receipt. Gov. Ex. 509, at G18003.

32. The '678 application identified the Office of Bang Shia and identified Appellant's Canyon Creek address in the "Correspondence Information" fields. Gov. Ex. 509, at G17994.

33. On November 28, 2012, the USPTO issued an Office Action related to the '678 application, which was sent to Appellant's [REDACTED] e-mail address. Gov. Ex. 509, at G18006-G18016; Tr. at 504-505. Appellant forwarded the Office Action to Kunshan's attorneys in China. Tr. at 506. An attorney with Kingkraft prepared a Response to Office Action for the '678 application and sent it to Appellant for reviewing and filing with the USPTO. Tr. at 506-507. Appellant filed the Response to Office Action on December 7, 2012 using the Direct sign method. Gov. Ex. 509, at G18013 G18016; Tr. at 507. Prior to filing it, Appellant entered the electronic signature of another person, "/George Yang/", to the Response to Office Action. Gov. Ex. 509; Tr. at 507-508, 574-575; Appeal at 9.

34. On March 5, 2013, Appellant filed a Change of Correspondence Address with the USPTO for the '678 application, changing the correspondence address from "Office of Bang Shia" in Victoria, Texas to a post office box in Taiwan. Gov. Ex. 509, at G18044-G18045; Tr. at 509, 511. However, Appellant's [REDACTED] and [REDACTED] e-mail addresses remained listed as the email address in the correspondence address fields. Gov. Ex. 509, at G18044; Tr. at 511. Appellant filed the Change of Correspondence Address using the Direct sign method and, before filing, entered the electronic signature of another person, "/George Yang/", in the signature field. Gov. Ex. 509, at G18044, G18046; Tr. at 514.

35. The Change of Correspondence Address form for the '678 application was filed after Appellant had received the Order of Exclusion from the Trademark Commissioner, dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 509; Tr. at 510.

36. Appellant was paid for her work. Tr. at 500-501.

F. Trademark Application 85/719,310 ("the '310 application")

37. On September 3, 2012, Appellant filed the '310 application with the USPTO, identifying Shuangfei Daily Chemicals USA Inc. as the applicant and owner of the mark. Gov. Ex. 511; Tr. at 539. Appellant is not an officer with this corporation. Tr. at 535. Appellant's [REDACTED] e-mail address was identified as the designated e-mail address in the "Applicant Information" fields. Gov. Ex. 511. Appellant's Lindencrest Court address and her [REDACTED] email address are identified in the "Correspondence Information" fields. Gov. Ex. 511, at G18166-G18167; Tr. at 535, 537-538.

38. Appellant filed the application using the Direct sign method. Ex. 511, at G18171. Before filing this application with the USPTO, Appellant entered the electronic signature of another person, "/Zhenhui Li/", on the application. Gov. Ex. 511, at G18167; Tr. at 545; Appeal at 10.

39. On March 5, 2013, Appellant filed a Change of Correspondence Address related to the '310 application with the USPTO, purporting to change the correspondence address from Appellant's Sugarland, Texas address to an address in Taiwan. Gov. Ex. 511, at G18185; Tr. at 556-557. However, Appellant's [REDACTED] e-mail address remained as the correspondence e-mail address. Gov. Ex. 511, at G18185. Prior to filing the Change of Correspondence Address to the USPTO via the Direct sign method, Appellant entered the electronic signature of another person, "/Zhenhui Li/", into the signature field. Gov. Ex. 511, at G18185, G18187; Tr. at 560; Appeal at 10.

40. The Change of Correspondence Address was filed after Appellant received the Order of Exclusion from the Trademark Commissioner, dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 511.

G. Trademark Application 85/748,531 ("the '531 application")

41. On October 8, 2012, Appellant filed the '531 application with the USPTO. Gov. Ex. 513; Tr. at 568. This was a second trademark application for Taiwanese company, Min Hsiang Corporation. Gov.

Exs. 512, 513. Although the application was for the same trademark as that in the '741 application, the '531 application identified a different class of goods than the '741 application. Gov. Exs. 512, 513; Tr. at 567. Appellant is not an officer with this corporation. Tr. at 561. Appellant's [REDACTED] e-mail address was identified as the designated e-mail address in the "Applicant Information" fields. Gov. Ex. 513, at G18326. Appellant's Lindencrest Court address and her [REDACTED] email address are identified in the "Correspondence Information" fields. Gov. Ex. 513, at G18326-G18327.

42. Appellant filed the '531 application using the Direct sign method. Gov. Ex. 513, at G18332. Prior to filing the '531 application with the USPTO, Appellant entered the electronic signature of another person, "/Tim Wu/," in the signature field. Tr. at 568; Appeal at 10.

43. On March 24, 2013, Appellant filed a Response to Office Action for the '531 application using the Direct sign method. Gov. Ex. 513, at G18342, G18346; Tr. at 575. Although Appellant included a .pdf copy with Tim Wu's handwritten signature with the Response, Appellant also entered the electronic signature of "/Tim Wu/" in the signature field. Gov. Ex. 513, at G18342, G18345; Tr. at 574; Appeal at 10. The Response was filed after Appellant had received the Order of Exclusion from the Trademark Commissioner, dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 510.

44. On August 17, 2013, Appellant filed a Statement of Use related to the '531 application with the USPTO. Gov. Ex. 513, at G18365-G18367; Tr. at 575. The Statement of Use was filed using the HSIGN-On method and a .pdf document attached to the Statement of Use included a copy Tim Wu's handwritten signature. Gov. Ex. 513, at G18370, G18378. The Statement of Use was filed after Appellant had received the Order of Exclusion from the Trademark Commissioner, dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 513.

H. Trademark Application 85/756,529 ("the '529 application")

45. On October 17, 2012, Appellant filed the '529 application with the USPTO. Gov. Ex. 514. This was a third trademark application for Min Hsiang. Gov. Exs. 512-514. Although this application was for the same trademark, the '529 application identified a different class of goods than the '531 or '729 applications. *Id.* Appellant's [REDACTED] e-mail address was identified as the designated e-mail

address in the "Applicant Information" fields. Gov. Ex. 514, at G18407. Appellant's Canyon Creek address and her [REDACTED] email address are identified in the "Correspondence Information" fields. Gov. Ex. 514, at G18408.

46. The '529 application was filed using the Direct sign method. Gov. Ex. 514, at G18415. Prior to filing the '529 application with the USPTO, Appellant electronically signed the name of another person, "/Tim Wu/," in the declaration signature field of the application. Gov. Ex. 514, at G18408; Tr. at 574-575; Appeal at 11.

47. On March 24, 2013, Appellant filed a Response to Office Action for the '529 application using the Direct sign method. Gov. Ex. 514, at G18425-G18426, G18429; Tr. at 575. Although Appellant included a .pdf copy with Tim Wu's handwritten signature, Appellant also entered Mr. Wu's electronic signature "/Tim Wu/" in the signature field. Gov. Ex. 514, at G18425, G18428; Tr. at 574; Appeal at 11. The Response was filed after Appellant had received the Order of Exclusion from the Trademark Commissioner, dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 514.

48. On August 17, 2013, Appellant filed a Statement of Use related to the '529 application with the USPTO. Gov. Ex. 514, at G18448-G18450; Tr. at 575. The Statement of Use was filed using the HSIGN-On method, with a .pdf document of Tim Wu's handwritten signature attached to the Statement of Use, but Appellant also entered the electronic signature of "/Tim Wu/" in the signature field. Gov. Ex. 514, at G18449, G18453, G18459; Tr. at 574. The Statement of Use was filed after Appellant had received the Order of Exclusion from the Trademark Commissioner, dated February 21, 2013. Jnt. Ex. 4; Gov. Ex. 514.

I. Trademark Application 77/836,647 ("the '647 application")

49. On February 7, 2013, Appellant completed, signed, and filed a Change of Correspondence Address related to the '647 application with the USPTO. Gov. Ex. 506, at G17852; Tr. at 574-575. The Change of Correspondence Address changed the correspondence address from "Weng Ping Huang" in Taiwan to an address in Taiwan belonging to the applicant. Gov. Ex. 506, at G17852. Appellant entered her electronic signature on the Change of Correspondence Address form and filed the document with the

USPTO. Gov. Ex. 506, at G17852; Tr. at 577; Appeal at 12. In doing so, she also affirmatively indicated that she was an authorized signatory for the Change of Correspondence Address form, *see* Gov. Ex. 506, at G17853 and Tr. at 577, despite the fact that she is neither someone with the legal authority to bind the applicant or a practitioner qualified to practice before the Office in Trademark matters.

Trademark Exclusion

50. On January 23, 2012, the Trademark Commissioner issued a Show Cause Order to Appellant, informing her that USPTO suspected her of engaging in the unauthorized practice of trademark law before the USPTO, and was considering issuing an exclusion order. Appellant's Ex. C1-C3. Appellant responded to the Show Cause Order on February 2, 2012, stating that she merely provided administrative support for applicants by serving as their correspondent or domestic representative.

51. On February 21, 2013, the Commissioner found that Appellant had engaged in unauthorized practice in trademark matters before the USPTO and excluded her from participating as a correspondent or domestic representative in any current or future trademark matters before the USPTO. Jnt. Ex. 4; Appellant's Ex. G1-G3; Tr. at 443. The basis for that Exclusion Order was a finding that Appellant engaged in the unauthorized practice of law before the USPTO by preparing and signing trademark applications and other documents. Jnt. Ex. 4. The Order advised Appellant that her contact information would be removed immediately from all relevant trademark applications and registrations and that the USPTO would notify affected applicants and registrants of any such changes, as necessary. *Id.* The Exclusion Order, which Appellant read and understood, was effective immediately. Jnt. Ex. 4; Tr. at 443.

52. Appellant appealed the Trademark Commissioner's decision to the USPTO Director. On December 27, 2013, the USPTO Director affirmed the Commissioner's decision. Jnt. Ex. 12; Gov. Ex. 13. Appellant received the Director's decision. Tr. at 457.

53. After issuance of the Exclusion Order, Appellant's foreign clients instructed her to remove her name and address from documents filed with the USPTO. Tr. at 466. USPTO also removed Appellant's name from records in the USPTO database. Appellant's Exs. I2, Z2. However, Appellant continued assisting with the trademark documents in violation of the Exclusion Order. Gov. Exs. 509-514.

Current OED Disciplinary Proceedings

54. On November 8, 2013, the Director of the Office of Enrollment and Discipline ("OED Director") filed a Complaint and Notice of Proceedings under 35 U.S.C. § 32 against Appellant, Proceeding No. D2014-04. A.R., Tab B.01.

55. On March 25, 2014, the OED Director filed an Amended Complaint in Proceeding No. D2014-04. A.R., Tab B.49.

56. On June 27, 2014, the OED Director filed a second Complaint against Appellant, Proceeding No. D2014-31. A.R., Tab C.01. At the OED Director's request, the two cases were consolidated. On July 22, 2014, the OED Director filed an Amended Complaint in D2014-31 ("Amended Complaint"), which removed certain charges and clarified others, and the matter was scheduled for a hearing. A.R., Tab C.07.

57. The Amended Complaint in D2014-31 alleged that Appellant, a registered patent agent, who is not and never has been an attorney, went beyond acting as a domestic representative for foreign applicants and engaged in unauthorized practice in trademark matters before the Office. A.R., Tab C.07. The Amended Complaint further alleged she forged the electronic signatures of applicants to trademark documents and filed those documents with the USPTO, in connection with the following trademark applications: the '031 application; the '678 application; the '340 application; the '741 application; the '310 application; the '531 application; the '529 application; and signed her own name on a trade mark document filed in connection with application serial number the '647 application. A.R., Tab C.07. Furthermore, Appellant was alleged to have continued to act as the domestic representative in certain trademark applications after being excluded from doing so by the Commissioner and to have concealed her misconduct by using an e-mail or mailing address that had not yet been detected by the USPTO as being associated with her. *Id.* Finally, Appellant was alleged to have actively assisted foreign attorneys in the unauthorized practice of trademark law. *Id.*

58. On August 20, 2014, Appellant filed an Answer and Counterclaim to the Amended Complaint ("Answer"). A.R., Tab C.21. Appellant denied the Amended Complaint's allegations and raised a number of affirmative defenses. *Id.*

59. On October 1, 2014, the OED Director filed a Motion to Dismiss D2014-04, electing to proceed to trial only on the allegations asserted in D2014-31. A.R., Tab C.40. The Motion to Dismiss D2014-04 was granted by the ALJ on the first day of the hearing. Tr. at 46, 3-4. The hearing proceeded based solely upon the Amended Complaint filed July 22, 2014 in D2014-31. *See generally*, A.R., Tab F (transcript of proceedings).

60. A hearing before the ALJ was held on October 6-10, 2014. A.R., Tab F.

III. INITIAL DECISION BY ADMINISTRATIVE LAW JUDGE

On April 22, 2015, the ALJ issued an Initial Decision and Order in Proceeding No. D2014-31. A.R., Tab A. In that decision, the ALJ found that Appellant's actions regarding documents filed in connection with the nine applications constituted misconduct in four ways: (1) Appellant improperly signed trademark documents filed with the USPTO; (2) Appellant improperly filed trademark documents prepared by foreign attorneys; (3) Appellant's actions went beyond the role of a domestic representative and constituted practice before the Office in trademark matters; and (4) Appellant continued to act as a domestic representative after being excluded from doing so by the Trademark Commissioner. *Id.* The ALJ concluded that Appellant's misconduct violated the following USPTO disciplinary rules: 37 C.F.R. § 10.23(a) (disreputable misconduct); § 10.23(b)(4) (deceit and misrepresentations to the USPTO); § 11.804(c) (deceit and misrepresentations to the USPTO); § 11.303(a)(1) (failure to correct misrepresentations made to the Office); § 10.77(a) (handling matters she was not competent to handle); 11.505 (aiding others in the unauthorized practice of law); and § 10.23(b)(5) and § 11.804(d) (conduct prejudicial to the administration of justice). *Id.*

In addition to the specific findings and conclusions, the ALJ also found that Appellant's affirmative defenses had no merit. A.R., Tab A. The ALJ rejected Appellant's constitutional, jurisdictional, and regulatory arguments in their entirety. A.R., Tab A.

Finally, after weighing the factors set forth at 37 C.F.R. § 11.54(b), the ALJ ordered that Appellant be excluded from practice before the Office in patent, trademark, and other non-patent matters. A.R., Tab A.

IV. CONCLUSIONS OF LAW

Appellant has been a registered patent agent since 2005. Tr. at 295-296. As such, she is subject to the disciplinary jurisdiction of the Office. 37 C.F.R. § 11.19(a). For the conduct involved in this disciplinary case, Appellant was subject to the ethical requirements set forth in both the USPTO Code of Professional Responsibility, 37 C.F.R. § 10.20 *et seq.*, and the Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*⁴

Appellant appeals from the April 22, 2014, initial decision of the ALJ entering judgment in favor of the Agency and excluding Appellant from the practice of patent, trademark, and other non-patent matters before the Office. *See* A.R., Tab A. USPTO regulations permit a party to appeal an ALJ's initial decision to the USPTO Director within thirty (30) days of issuance of the initial decision. *See* 37 C.F.R. § 11.55(a); *see also* 35 U.S.C. § 2(b)(2)(D). On appeal, the USPTO Director has authority to conduct a *de novo* review of the factual record. *See* 37 C.F.R. §§ 11.55(f), 11.56(a). The USPTO Director may affirm, reverse, or modify the initial decision, or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. *See* 37 C.F.R. § 11.56(a).

The Director, having considered Appellant's appeal and the record of the proceedings before the ALJ, which includes admissions made by Appellant during the hearing proceedings, finds that there is ample evidence to support the ALJ's initial decision. The decision was properly made and therefore the initial decision of the ALJ is **AFFIRMED**.

A. Jurisdiction.

Appellant has raised various arguments that the Agency has no jurisdiction to discipline her. She argues that the "PTO has no 'substantive rulemaking power.'" A.R., Tab C.53, at 16-19; Appeal at 15-17; Reply at 13-15. Additionally, she claims that the Trademark rules and TMEP "govern the conduct of

⁴ Effective May 3, 2013, the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901, apply to persons who practice before the Office. Prior to May 3, 2013, the USPTO Code of Professional Responsibility applied to persons practicing before the Office. *See* 37 C.F.R. §§ 10.20-10.112. Here, since Appellant's alleged misconduct occurred both prior to and after May 3, 2013, both the old and the new rules are implicated.

'proceedings' of trademark examination at PTO, not the conduct of 'practitioners,'" and, as a result, the Trademark rules and TMEP cannot form the basis of a disciplinary action against a practitioner. A.R., Tab C53 at 16-19; Appeal at 14; Reply at 13-15. Finally, she claims that state law, rather than federal law, applies to her practice before the Office. Reply at 13. None of these arguments has any legal support.

Congress vested the USPTO with plenary, statutory authority to promulgate regulations "govern[ing] the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. § 2(b)(2)(D); *see also Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001) (stating that the USPTO has the "exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it"); *Haley v. USPTO*, 2015 WL 5277880, at *8 (E.D. Va. Sept. 8, 2015) (noting that "Congress gave the USPTO wide latitude to govern the conduct of the members of its bar"). The Director of the USPTO may suspend or exclude a person from practice before the Patent and Trademark Office if the person is "shown to be incompetent or disreputable, or guilty of gross misconduct," or if the person violates regulations established by the Office. 35 U.S.C. § 32. Thus, there is no question that the USPTO Director has authority to regulate practice before the Office in both patent and trademark matters, including the unauthorized practice of law before the Office. (*See id.*); *see also Haley* 2015 WL 5277880, at * 9 ("Congress also explicitly gives the USPTO the power to promulgate regulations related to the conduct of its members.")

Pursuant to its authority to regulate the conduct of practitioners, the USPTO enacted its former Code of Professional Responsibility, 37 C.F.R. § 10.20 *et seq.*, and the current Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901, both of which include a number of mandatory disciplinary rules setting forth the minimum level of conduct below which no registered patent practitioner can fall without being subjected to disciplinary action. If a registered patent practitioner engages in misconduct and/or fails to comply with his or her professional obligations in violation of these rules, the USPTO has the authority to suspend or exclude the practitioner from further practice before the Office. *See* 35 U.S.C. § 32; 37 C.F.R. § 11.19. Appellant, as a registered patent agent, is a practitioner and thus is bound by the

USPTO's disciplinary rules and is subject to the disciplinary jurisdiction of the Office. 37 C.F.R. § 11.19(a).

Appellant's argument that violations of the Trademark rules and TMEP cannot form the basis of a disciplinary action is rejected. It is well-settled that a practitioner is subject to the Office's disciplinary jurisdiction for misconduct that is not specifically set forth in the disciplinary rules. *See In re Edington*, Proceeding No. D2008-12 (USPTO July 9, 2009) (finding the Respondent's manslaughter conviction to be sufficient evidence that the respondent engaged in disreputable or gross misconduct in violation of the USPTO's disciplinary rules); *In re Reynolds*, Proceeding No. D1999-12, at 19 (USPTO Apr. 4, 2001) (finding Respondent's convictions for driving while intoxicated represent conduct adversely reflecting on his fitness to practice law in violation of 37 C.F.R. § 10.23(b)). Here, the ALJ correctly noted that both the Trademark rules set forth in Title 37, part 2, of the Code of Federal Regulations, and the TMEP set forth the proper practices and procedures relative to prosecution of trademark applications before the USPTO. Dec. at 16. These authorities also offer guidance as to the appropriate conduct of trademark applicants, attorneys, representatives for trademark applicants when registering marks with the USPTO. *Id.* *See generally*, 37 C.F.R. Pt. 2; TMEP § 600. The ALJ's conclusion that conduct that violates these authorities may also constitute misconduct under the disciplinary rules is reasonable and supported by precedent. Thus, Appellant's argument that the Trademark rules and TMEP cannot form the basis of a disciplinary action is without merit.

Lastly, Appellant's argument that state law, rather than federal law, applies to her practice before the Office is without any legal foundation. It is long-settled that regulating admission and disciplinary issues before the USPTO lies within USPTO's exclusive jurisdiction. *See Sperry v. Florida ex rel. Florida Bar*, 373 U.S. 379, 385-386 (1963) (Registration with the USPTO confers a right to practice before the Office without regard to whether a state within which the practice is conducted would otherwise prohibit such conduct); *see also Kroll*, 242 F.3d at 1364 ("[T]he PTO has exclusive authority to establish qualifications and procedures for admitting persons to practice before the PTO, and to suspend or exclude those patent practitioners from practicing before the PTO.")

Finding that Appellant is bound by the USPTO's disciplinary rules and is subject to the disciplinary jurisdiction of the Office, allegations of Appellant's misconduct is discussed in detail below.

B. Appellant's Actions Constitute Misconduct.

The ALJ concluded that the Appellant engaged in four types of misconduct: (1) Appellant improperly signed trademark documents filed with the USPTO; (2) Appellant filed trademark documents prepared by foreign attorneys; (3) Appellant engaged in actions that went beyond the role of a domestic representative and constituted practice of law before the Office in trademark matters; and (4) Appellant continued to act as a domestic representative after being excluded from doing so by the Trademark Commissioner. A.R., Tab A.

Each of these conclusions, as discussed further below, are amply supported by the record.

1. Appellant Improperly Signed Trademark Documents Filed with the USPTO.

The ALJ found that Appellant lacked any authority under the trademark authorities to enter electronic signature of the applicants onto trademark documents. Dec. at 11-12. To attempt to overcome this, Appellant submitted documents that purported to be powers of attorney that conveyed to her the authority to bind applicants. Dec. at 11; A.R., Tab C.44. However, after reviewing the documents, the ALJ noted that the documents are insufficient to authorize Appellant to sign on behalf of the applicants because she is not an attorney, the intent of the documents as to what authority is actually conveyed was found to be unclear and, even if powers were properly bestowed, the ALJ concluded Appellant could not have acted on behalf of the applicant as she did not have personal knowledge of the facts, as required by the TMEP. Dec. at 11-12. Lastly, even if Appellant had been a proper signatory, the ALJ concluded that she should have signed her own name on the trademark documents and not the name of another person. Dec. at 13. Each of these findings, which are proper based upon the evidence in the record, are discussed further below.

All correspondence and filings with the Office that require a signature must bear either a handwritten signature personally signed by the person named as the signatory, or an "electronic signature" that meets the requirements of 37 C.F.R. § 2.193(c), personally signed by the signatory. *See* TMEP § 611.01(b) and

(c). Here, all of the documents at issue were filed electronically using the TEAS system. Gov. Exs. 506-514. As such, the rules governing the signature of documents filed electronically apply. As stated, those rules require that a person signing a document electronically must “*personally enter any combination of letters, numbers, spaces and/or punctuation marks in the signature block on the electronic submission.*” 37 C.F.R. § 2.193(c)(1) (emphasis added); TMEP § 611.01(c). Another person may not sign the name of a qualified practitioner or other authorized signatory. TMEP § 611.01(c). There is no instance in which a person is permitted to sign the name of another person, as Appellant admits having done repeatedly.

As stated above, using TEAS, there are three acceptable methods available for transmitting documents to the USPTO. TMEP § 611.01(c); Tr. at 67. The “Direct” signature method permits an appropriate signatory to personally enter his or her name, in a combination of letters, numbers, spaces, and/or punctuation marks, between two forward slashes. Tr. at 67, 72, 78; 37 C.F.R. § 2.193(c)(1). This is the default method of filing documents with TEAS. Tr. at 76. The XML data for filings using this signature method will show “<signature-type> DIRECT.” See, e.g., Gov. Ex. 510 (xml data for ‘340 application); Tr. at 96-97. The second method, “Esign-on” or “E-mail Text Form to second party for signature,” allows a TEAS user to email a text version of a TEAS form to the appropriate signatory for signature, which is then automatically returned via TEAS to the party who requested signature for filing. TMEP § 611.01(c); Tr. at 67, 103-105, 109-115. The third method for signing trademark documents is the “HSign-On” or “Handwritten pen-and-ink signature” method, where a user can submit a printed pen-and-ink signature personally made by an appropriate signatory, which is then scanned as a PDF or JPEG file and attached to the TEAS form for filing. TMEP § 611.01(c); Tr. at 67-68, 128. Using this method, there also is no option for an electronic signature on the TEAS form. Gov. Ex. 489; Tr. at 129-130. The XML data for filings using this signature method will show “<signature-type> HSIGN-ON.” Gov. Ex. 508, at G17938; Tr. at 137. Regardless of which of the three methods chosen, no circumstances permit a person to sign the name of another person on a trademark document. TMEP § 611.01(c); Tr. at 64. Instead, all documents must be personally signed. 37 C.F.R. § 2.193; TMEP § 611.01(c); Tr. at 64.

In addition to providing a proper signature, all documents filed with the office must be properly signed by an authorized signatory. TMEP § 611.02; Tr. at 333-334. For example, verifications of facts on behalf of an applicant or registrant, such as an application⁵ or statement of use, must be personally signed by someone meeting the requirements of 37 CFR § 2.193(c)(1). TMEP §§ 611.02, 611.03(a). Other documents must be personally signed by the applicant or registrant, someone with legal authority to bind the applicant, or a qualified practitioner. TMEP § 611.02; Tr. at 347. For a juristic applicant, a person with legal authority to bind a corporation is a corporate officer, including *inter alia* a corporate President, Vice-President, Secretary, or Treasurer. TMEP § 611.02, 611.06(d); Tr. at 329, 333-334.

The facts of the record, including admissions made by Appellant, fully support the ALJ's findings and conclusions that Appellant repeatedly improperly signed trademark documents filed with the USPTO. Appellant admitted that she electronically signed the name of applicants and registrants on trademark documents filed with the Office and which are associated with the following trademark serial numbers: '031, '340, '741, '869, '678, '310, '531, and '529. Tr. at 478-479, 482, 490-491, 494-495, 502, 507-508, 514, 520, 545, 560, 562-563, 564-565, 568, 574-575. These multiple acts of filing another person's name on trademark documents filed with the Office constitute a clear violation of the trademark rules, which require that all documents filed with the Office be personally signed, and these acts of filing are misconduct.

As a defense, Appellant repeatedly claims that she only signed the names of applicants or registrants to trademark documents because TEAS removed or erased the applicants or registrants' direct signatures. A.R., Tab C.53; Appeal at 22-25; Reply at 3. Appellant's argument demonstrates her misunderstanding of the signature options in TEAS. The bulk of the documents here were filed using the Direct signature method, which requires that an authorized signatory personally sign the document at the time of filing. Tr. at 212-213. If the document is downloaded for later filing, then TEAS requires the electronic signature to be entered again so as to ensure that the person filing it is able to personally verify the facts set forth in

⁵ 15 U.S.C. § 1051

the document at the time of filing. Tr. at 211-213, 216-217. If Appellant had wished to file a trademark document in a manner that did not require the contemporaneous electronic signature of an authorized signatory at the time of filing, she should have selected the E-sign or H-sign options. She did not. Consequently, an appropriate signatory was required to personally sign any document at the time of filing. No circumstances permit Appellant to do what she did here instead, that is, to sign electronically another person's name to a trademark document and then file that with the Office.

Appellant has not shown that she was a proper signatory for any of the filings noted above. The applicants and registrants on the filings are all juristic entities. Gov. Exs. 507-514. The record does not show Appellant to be a corporate officer for any of these entities, in which case she would have legal authority to bind these corporations. Tr. at 467, 484, 500, 516, 535, 561. Appellant claims that "[f]oreign applicants authorized Dr. Shia to submit trademark documents to the USPTO." Appeal at 5; A.R., Tab C.53. However, a review of her testimony and the documents that Appellant submitted at the hearing, all of which the ALJ considered and addressed in his opinion, do not support her argument.

First, even if the documents Appellant provided had consisted of proper Powers of Attorney, Appellant is not an attorney. Tr. at 297. *See* 37 C.F.R. § 2.193(e)(1) (An attorney with power of attorney is properly authorized to sign a declaration on behalf of an owner.) Valid Powers of Attorney must designate by name at least one individual qualified practitioner. TMEP § 605.01. *See also* 37 C.F.R. § 2.17(b) ("To be recognized as a representative in a trademark case, a practitioner qualified under § 11.14 of this chapter may [f]ile a power of attorney. . . .") (emphasis added); *Malinay v. Nishimura*, 2013 WL 4240460, at *1 (D. Haw. Aug. 14, 2013) (A power of attorney only permits nonlawyer to act on another's behalf for matters for which an attorney license is not required.); *Ryan v. Hyden*, 2012 WL 4793116 (S.D. Cal. Oct. 9, 2012) (even if a non-attorney was given a durable power of attorney with broad language regarding claims and litigation, that power of attorney does not validly provide the right to represent that person as his or her attorney); *Harris v. Philadelphia Police Dep't*, 2006 WL 3025882 (E.D. Pa. Oct. 20, 2006) (Federal courts do not permit a non-attorney to engage in the unauthorized practice of law by pursuing an action pro se with plaintiff's power of attorney.); *Ross v. Chakrabarti*, 5 A.3d 135, 139 (Md.

Ct. Spec. App. 2010) (finding a power of attorney did not give an agent the right to perform legal services, where the law does not permit the principal to act through an agent who is not licensed to perform such services).

In addition, the text of the documents Appellant submitted simply do not grant her the authority claimed. Though titled as Powers of Attorney or "Authorization From The Applicant Before the USPTO", they are not Powers of Attorney that comply with the requirements of the TMEP or 37 C.F.R. § 2.17. The documents, which appear to be cut and pasted from other documents, do not adequately describe the authorities conveyed to Appellant; they consist of "Declaration" boxes and other pieces of information that do not bear upon finding a valid power of attorney. A.R., Tab C.44. Finally, even if the document did permit Appellant to act on behalf of individual applicants or registrants, Appellant still is not permitted to enter the electronic signature for other individual applicants and registrants as was done here.

Based on the record, Appellant engaged in misconduct when she improperly signed trademark documents filed with the USPTO. Appellant improperly signed the name of trademark applicants and registrants on trademark documents, in violation of Office rules. The ALJ's findings and conclusions are supported.

2. Appellant Filed Trademark Documents Prepared by Foreign Attorneys.

The ALJ next concluded that foreign attorneys, who are not recognized to practice before the Office in trademark matters, prepared the trademark applications, Statements of Use, and Responses to Office Actions. Dec. at 13. The foreign attorneys then paid Appellant to review the trademark documents for accuracy and file them with the USPTO. Dec. at 13. These findings and conclusions find ample support in the record.

Appellant testified at the hearing on multiple occasions that foreign attorneys would prepare trademark documents and forward those documents to her for review. Tr. at 222, 474, 501-502, 506-507, 619. Appellant would then file those documents with the USPTO. Tr. at 575. Appellant was paid for her review, signing, and filing of trademark documents. Tr. at 467, 484, 500-501, 516-517.

Foreign attorneys are not recognized to practice before the office. *See* 37 C.F.R. §§ 11.1, 11.14(a). Only in limited circumstances may foreign agents or attorneys file an application for reciprocal recognition to represent parties in their country. 37 C.F.R. § 11.14(c); TMEP § 602.03. However, here, there is no evidence in the record to support a conclusion that the foreign attorneys that Appellant worked with to prepare and file trademark documents with the Office were recognized under these provisions. Thus, the filing of documents prepared by these foreign attorneys is misconduct.

3. Appellant's Actions Went Beyond the Role of Domestic Representative and Constituted Practice of Law before the Office in Trademark Matters.

The ALJ also concluded that Appellant engaged in activities that went beyond her role as a domestic representative or correspondent, and constituted the practice of trademark matters before the Office. Dec. at 14. Specific actions that Appellant engaged in and which constituted the practice of trademark law before the Office included the fact that foreign attorneys would prepare trademark applications, Responses to Office Action, and Statements of Use, and then send those documents to her for review and submission to the Office, which Appellant did. Dec. at 14. On several occasions, Appellant completed the trademark documents by entering the applicant's electronic signature and then submitted the completed document to the USPTO for filing. Dec. at 14.

Only a licensed attorney is authorized to represent an applicant or registrant in trademark matters before the USPTO. 37 C.F.R. § 11.14(a). "Individuals who are not attorneys are not recognized to practice before the Office in trademark ... matters." 37 C.F.R. § 11.14(b); *see also* TMEP § 602.01. The practice of trademark matters includes, *inter alia*, preparing a trademark application; prosecuting a trademark application including by submitting an amendment, response, or other document; and signing amendments and responses to Office actions. 37 C.F.R. § 11.5(b)(2); TMEP § 608.01. A non-attorney can interact with the USPTO concerning a trademark application or registration only in limited administrative support roles. For example, a "correspondent" may "transmit and receive correspondence." TMEP § 608.01. A "domestic representative" may receive service of "process or notice of proceedings affecting the application ... or registration or rights thereunder" for a foreign applicant or registrant. 37 C.F.R. §

3.61; *see also* TMEP § 610 (“Designation of Domestic Representative by Parties Not Domiciled in the United States”). Neither a correspondent or domestic representative is authorized to prosecute an application or represent a party in a proceeding before the USPTO, unless the domestic representative is also a qualified practitioner who has been recognized by the USPTO as the representative of an applicant or registrant or is someone with legal authority to bind a juristic applicant (*i.e.*, a corporate officer). TMEP §§ 609.04, 611.06(d); Tr. at 58, 60-61, 194-195, 328-330, 342, 344-345, 372.

Appellant unequivocally engaged in the activities cited by the ALJ and they far exceeded any authority she would have as a domestic representative or correspondent. She was not an owner of any of the marks in the applications or registrations filed and she held no corporate officer position with the applicant corporation. Gov. Exs. 506-514 ; Tr. at 467, 484, 500, 516, 535, 561. She is not an attorney. Tr. at 297. Yet, she testified that she reviewed, signed and filed trademark documents with the Office. These admissions fully support the ALJ’s findings that Appellant’s conduct went beyond merely forwarding correspondence between the applicants and the USPTO and constituted practice before the Office in trademark matters under 37 C.F.R. §11.5(b)(2) and TMEP § 608.01 and is misconduct.

4. Appellant Continued to Act As Domestic Representative After Being Excluded From Doing So by the Trademark Commissioner.

Lastly, the ALJ found that Appellant continued to file trademark documents with the USPTO even after receiving an Exclusion Order from the Commissioner for Trademarks directing her to stop acting as a domestic representative or correspondent in trademark matters before the Office. Dec. at 16. Documents for which she continued to file trademark documents included Statements of Use, Responses to Office Actions, and Change of Correspondence Address forms related to the ‘340, ‘741, ‘678, ‘310, ‘529, and ‘531 applications. Dec. at 16. Again, these findings are supported by the record.

On February 21, 2013, the Commissioner found that Appellant had engaged in unauthorized practice in trademark matters before the USPTO and excluded her participating as a correspondent or domestic representative in any current or future trademark matters before the Office. Jnt. Ex. 4; Appellant’s Ex. G1-G3; Tr. at 443. The Order advised Appellant that her contact information would be removed

immediately from all relevant trademark applications and registrations and that the USPTO will notify affected applicants and registrants of any such changes. Jnt. Ex. 4. The Exclusion Order was effective immediately. Jnt. Ex. 4. Appellant read and understood the letter. Tr. at 443. The USPTO Director affirmed the Commissioner's decision. Jnt. Ex. 12; Gov. Ex. 13. Appellant received this decision. Tr. at 457.

Despite receiving and understanding the Exclusion Order, Appellant continued assisting her foreign clients with their trademark applications. While her name and mailing address were taken off of as domestic representative or correspondent, her email address remained listed as such on documents filed with the Office. Gov. Exs. 507-511. She also continued to submit trademark documents to the Office after February 21, 2013. Gov. Exs. 509- 514; Tr. at 575. Continuing with these activities —assisting and filing trademark documents and listing her email on trademark documents as domestic representative or correspondent— after receiving and understanding the Trademark Commissioner's Exclusion Order is misconduct.

C. Appellant Violated the USPTO Code of Professional Responsibility and Rules of Professional Conduct.

Based on the uncontroverted facts in the record, the ALJ concluded that Appellant's misconduct violated 6 ethical rules of the USPTO Rules of Professional Conduct and Code of Professional Responsibility.⁶ Dec. at 16. As discussed further below, the ALJ's conclusions were appropriate.

1. 37 C.F.R. § 10.23(a) – Disreputable Conduct.

“A practitioner shall not engage in disreputable or gross misconduct.” 37 C.F.R. § 10.23(a). USPTO regulations do not define what constitutes disreputable or gross misconduct. However, “disreputable conduct has generally included unprofessional conduct” and was well understood to include “any conduct violative of the ordinary standard of professional obligation and honor.” *In re Lane*, Proceeding No.

⁶ Appellant's argument that the ALJ erred in applying the former 37 C.F.R. part 10 to the alleged misconduct is without merit. See RReply at 4. Part 10 continues to apply to misconduct that occurred prior to May 13, 2013, the date the new Rules of Professional Conduct became effective. And, although Appellant is correct that conduct engaged in prior to May 13, 2013 could also constitute violations of the new rules, 37 C.F.R. § 11.901, this does not negate the applicability of the prior Part 10.

D2013-07 (USPTO Mar. 11, 2014) (quoting *Poole v. United States*, CIV. A. 84-0300, 1984 WL 742 (D.D.C. June 29, 1984)); *See also* 50 Fed. Reg. 5158 (1985) (Practice before the Patent and Trademark Office) (citing *Poole*).

The ALJ concluded that Appellant violated 37 C.F.R. § 10.23(a) because her conduct did not comply with the practices and procedures outlined by the USPTO, specifically, by affixing her clients' electronic signatures to trademark documents and by filing trademark documents prepared by unauthorized foreign attorneys, both activities that violate the USPTO's rules. Dec. at 17. Appellant further engaged in disreputable conduct when she continued to act as domestic correspondent after being excluded from doing so by the Commissioner, and then attempted to conceal that fact from the Agency. Dec. at 17. For the reasons set forth below, the ALJ's conclusion that Appellant engaged in disreputable conduct is upheld.

As the ALJ correctly noted, the trademark rules, 37 C.F.R. pt. 2, and the TMEP, set forth the rules of practice that have been established and which must be followed when practicing trademark matters before the USPTO. *See* 37 C.F.R. pt. 2; TMEP, INTRODUCTION ("The primary function of the rules of practice is to advise the public of the regulations that have been established in accordance with the statutes, which must be followed before the USPTO.") And, though a violation of the trademark rules or TMEP are not *per se* violations of USPTO's disciplinary rules, misconduct not specifically identified within the trademark rules or TMEP may constitute misconduct for purposes of discipline. *See In re Edington*, Proceeding No. D2008-12, at 6 (USPTO Mar. 13, 2009) (finding the Respondent's manslaughter conviction to be sufficient evidence that the respondent engaged in disreputable or gross misconduct in violation of the USPTO disciplinary rules); *In re Revnolds*, Proceeding No. D1999-12, at 19 (USPTO Apr. 4, 2001) (finding Respondent's convictions for driving while intoxicated represent conduct adversely reflecting on his fitness to practice law in violation of 37 C.F.R. § 10.23(b)).

The record before the Director fully supports the ALJ's findings that Appellant affixed her clients' electronic signatures to trademark documents, filed trademark documents prepared by unauthorized foreign attorneys, and continued to act as domestic correspondent after being excluded from doing so by

the Commissioner, and then attempted to conceal that fact from the Agency. These actions unequivocally violate the trademark rules and the TMEP, as well as defied the Commissioner's authority to regulate those who practice in trademark matters before the Office. *See* 37 C.F.R. §§ 2.193; 11.1, 11.5(b)(2), 11.14(a) and (b); TMEP §§ 602.01, 602.03, 608.01, 611.01(b) and (c); Int. Ex. 4. Consequently, the ALJ's finding that Appellant engaged in disreputable conduct is proper.

2. 37 C.F.R. § 10.23(b)(4) and 11.804(c) – A practitioner shall not engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.

A practitioner shall not “[e]ngage in conduct involving dishonesty, fraud, deceit, or misrepresentation.” 37 C.F.R. § 10.23(b)(4); 37 C.F.R. § 11.804(c) (2013). The ALJ concluded that Appellant violated these provisions by falsely representing that trademark documents bore applicants' actual signatures, by filing Change of Correspondence Address forms that purported to remove her name as the domestic representative or correspondent but that provided an email address that the USPTO had not yet attributed to her, and by affirmatively misrepresenting that she was an authorized signatory on the ‘647 application when she was not. Dec. at 18.

USPTO regulations do not define “deceit,” “dishonesty,” or misrepresentation. “‘Deceit’ has been defined as ‘dishonest behavior’ or ‘behavior that is meant to fool or trick someone.’” *See In re Lane*, Proceeding No. D2013-07, at 14 (quoting Meriam-Webster.com (2014)). The forgery of a person's signature constitutes an act of deceit. *See Iowa Supreme Court Attorney Disciplinary Bd. v. Liles*, 808 N.W.2d 203, 206 (Iowa 2012) (finding an attorney's forgery of a witness's signature on a will constitutes deceitful conduct); *Disciplinary Counsel v. Wilson*, 32 N.E.3d 426, 427-428 (Ohio 2014) (finding an attorney who signed her daughter-in-law's name onto a sworn affidavit and presented that affidavit to the court engaged in conduct involving dishonesty, fraud, deceit, or misrepresentation even though the attorney believed she had her daughter-in-law's consent to do so).

“A misrepresentation is ‘[t]he act of making a false or misleading assertion about something, usu[ally] with the intent to deceive,’ and includes ‘not just written or spoken words but also any other conduct that amounts to a false assertion.’” *In re Lane*, at 14 (quoting *Black's Law Dictionary* (9th ed.

2009)). Therefore, “[c]oncealment or even non-disclosure may have the effect of a misrepresentation.” *Id.* Falsely signing a document and submitting it to the Office is a false representation even if the substance of the document is accurate, because the signature is misleading. *In re Uchendu*, 812 A.2d 933, 939 (D.C. 2002).⁷

Here, Appellant admitted to signing the signatures of applicants on several trademark applications and other trademark documents and then filing those documents with the USPTO. Tr. at 574-575; Appeal, at 6-11. Though she attempts to justify her actions by attacking the TEAS system design⁸ and by casting her actions as akin to “photocopying,” see Appeal at 12, 24-25; Reply at 3, these self-serving justifications do not excuse her actions. The ALJ correctly noted that Appellant made no attempt to provide notice or otherwise indicate that the electronic signatures were entered by anyone other than the purported signatories. Thus, she falsely represented that the documents bore the applicants’ actual signatures, which is deceitful and misleading.

The ALJ’s finding that Appellant concealed the fact that she was continuing to act as a domestic representative or correspondent despite being excluded from doing so by the Commissioner for Trademarks also finds support in the record. After receiving the Trademark Commissioner’s January 23, 2012 Show Cause Order and the February 21, 2013 Exclusion Order, Appellant filed five Change of Correspondence Address forms purporting at first glance to remove Appellant from that role. Gov. Exs.

⁷ Appellant’s attempts to distinguish *Uchendu* are unpersuasive. As here, *Uchendu* signed his clients’ names on documents that required verification and then filed those documents with a court. *SUchendu*, 812 A.2d at 934. Also as here, *Uchendu* claimed, and the court rejected, that he had the authority to sign documents for his clients. The court noted that a general right to delegate signature on probate documents would be inappropriate in light of the verification requirements for those documents. *Id.* at 937-938. Finally, *Uchendu*’s argument that he did not intend to defraud anyone was rejected by the court, which stated that “lack of intent to defraud does not alter the falsity of his representations or the dishonesty of his conduct.” *Id.* at 939. “[H]onesty is basic to the practice of law. . . .” *Id.* This reasoning is persuasive and Appellant’s defense that she lacked intent to deceive is rejected.

⁸ Appellant repeatedly stated her view that TEAS “erased” the proper signatories’ e-signatures, which necessitated her to sign the TEAS forms upon filing. A.R., Tab C.53; Appeal at 22-25; Reply at 3. However, this demonstrates Appellant’s lack of competence in using the TEAS system. Appellant chose the “Direct” sign method for the vast majority of the filings at issue. Using this method, the requirement that the electronic signature be re-entered at the time of filing is done purposefully, to ensure that the person signing and filing the document is able to personally verify the facts set forth in the document at the time of filing. Tr. at 211-213, 216-217. If she wanted to not enter a signature contemporaneously with filing, she should have elected to file the documents using the E-sign or H-sign methods.

507-511 (Change of Correspondence Address forms); Jnt. Ex. 4; Tr. at 443. Despite this apparent change, however, these Change of Correspondence Address forms identify email addresses belonging to Appellant and which USPTO had not yet associated with Appellant. Gov. Exs. 507-511 (Change of Correspondence Address forms). This conduct is deceitful.

Finally, on February 7, 2013, Appellant misrepresented to the USPTO that she was an authorized signatory on the Change of Correspondence Address for the '647 application by indicating "YES" in the section on the form that asks if the signatory is an "authorized signatory." Gov. Ex. 506, at G17852; Tr. at 577. Since a Change of Correspondence address form must be signed by someone with legal authority to bind the applicant or a practitioner qualified to practice before the Office in trademark matters, and Appellant is neither of these, this "Yes" representation was also deceitful and false.

In sum, based on the foregoing, the ALJ's conclusion that Appellant's conduct involved deceit and misrepresentations in violation of 37 C.F.R. § 10.23(b)(4) and § 11.804(c) was proper.

3. 37 C.F.R. § 11.303(a) – Failed to correct misrepresentations.

A practitioner shall not knowingly "[m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner." 37 C.F.R. § 11.303(a)(1). The ALJ correctly concluded that Appellant made misrepresentations to the Office that she failed to correct, in violation of § 11.303(a). Dec. at 19.

As noted, the ALJ properly found that Appellant falsely represented that trademark documents bore the applicants' actual signatures, filed Change of Correspondence Address forms that purported to remove her name as the domestic representative or correspondent but that provided an email address that the USPTO had not yet attributed to her, and affirmatively misrepresented that she was an authorized signatory on the '647 application when she was not. The Trademark Commissioner's Show Cause Order dated January 23, 2012 put Appellant on notice, confirmed by the Exclusion Order dated February 21, 2013 that provided further notice and explained that the act of electronically signing an applicant's name onto trademark documents is inappropriate. Jnt. Ex. 4. Appellant testified that she read the Exclusion Order and understood its contents. Tr. at 443. However, Appellant made no attempt to correct her prior

misrepresentations related to the trademark documents cited in this matter. This failure to correct these false representations to the Office violates 37 C.F.R. § 11.303(a)(1).⁹

4. 37 C.F.R. § 10.77 –Appellant handled matters she should have known she was not competent to handle.

“A practitioner shall not . . . [h]andle a legal matter which the practitioner knows or should know that the practitioner is not competent to handle. . . .” 37 C.F.R. § 10.77(a). Section 10.77(a) requires, in part, that a practitioner know the rules relating to the matter for which she is representing her clients. And, by agreeing to represent these clients it is the practitioner's duty to inform herself of the applicable rules if she does not already know them. *See Reibman v. Senie*, 302 A.D.2d 290, 291 (N.Y. App. Div. 2003); *Attorney Grievance Comm’n of Md. v. Zhang*, 100 A.3d 1112, 1129 (Md. 2014), reconsideration denied (Aug. 27, 2014) (finding an attorney did not provide competent representation to a client by failing to conduct any legal research before advising her client on a matter in which the attorney was not familiar).

By agreeing to act as domestic representative and to file documents with the Office on behalf of foreign applicants, the ALJ correctly noted that Appellant was required to educate herself on the proper method for filing electronically on TEAS and with the appropriate signature. Dec. at 19-20. Information that would have been helpful to Appellant can be found in the Trademark Rules, the TMEP, and by viewing the “Help” section on the TEAS Forms. Dec. at 20. Appellant provided no defense that would excuse why she was unwilling or unable to educate herself as to the proper signature method or how to properly file trademark documents with the Office. Her failure to educate herself means that she was handling trademark matters before the Office knowing that she lacked the competence to do so, in violation of 37 C.F.R. § 10.77(a).

5. 37 C.F.R. § 11.505 – Aiding Others in the Unauthorized Practice of Law.

“A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.” 37 C.F.R. § 11.505; *see also In re Campbell*,

⁹ Though the failure to correct false representation occurred both before and after the effective date of the new Rules of Professional Conduct, May 13, 2013, Appellant was only charged by the OED Director under the new rules. A.R., Tab C.7.

Proceeding No. D2014-11 (USPTO Apr. 29, 2014) (excluding a practitioner who engaged in the unauthorized practice of law by representing a client in a civil and criminal matter before the Colorado courts despite not being a licensed attorney). Here the ALJ concluded that Appellant violated this provision when she filed Statements of Use for the '340 and '531 applications,¹⁰ which had been prepared by foreign attorneys not authorized to practice before the Office. Dec. at 21.

Determining whether conduct constitutes aiding another in the unauthorized practice of law requires a two-step analysis. *Commission on Prof'l Ethics & Conduct of the Iowa State Bar Ass'n v. Baker*, 492 N.W.2d 695 (Iowa 1992). First, the Court must determine whether actions taken by the foreign attorneys constitute unauthorized practice in trademark matters before the Office. *Id.* at 701. Second, the Court must determine whether Appellant aided in those actions. *Id.* The practice of law goes beyond the act of representing another before a court. *Id.* The practice of law also includes "out of court services" and the preparation of legal documents constitutes the practice of law. *Id.*; *Geauga Cty. Bar Ass'n. v. Haig*, 955 N.E.2d 352 (Ohio 2011). The rules governing representing others before the Office make clear that practice before the office in trademark matters, which must be accomplished by an attorney, includes services such as consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing an application for trademark registration. 37 C.F.R. §§ 11.5(b)(2), 11.14.

Foreign attorneys are not authorized to practice before the Office except in very limited circumstances.¹¹ See 37 C.F.R. §§ 11.1, 11.14(a),(c); TMEP § 602.03. Nevertheless, Appellant testified that foreign attorneys prepared trademark documents, including the Statements of Use for the '340 and '531 applications, and forwarded these documents to her for review and filing. Tr. at 222, 474, 501-502,

¹⁰ Appellant claims that she did not violate § 11.505, which became effective May 13, 2013, because she "did not file any trademark applications after May 3, 2013." Appeal at 30. However, the record reflects that she did file Statements of Use for the '340 and '531 applications on May 26, 2013 and August 17, 2013, respectively, which is after § 11.505 became effective. Gov. Exs. 510, 513.

¹¹ Appellant vaguely argues that foreign attorneys are permitted to practice before the Office. A.R., Tab C.53; Appeal at 18. However, she offers no authority for this proposition that would contravene or negate 37 C.F.R. §§ 11.1, 11.14(a) and (c), and TMEP § 602.03, which together prohibit foreign attorneys from practicing before the Office.

506-507, 619. The foreign attorney's actions, which constituted practice in trademark matters, therefore also constituted the unauthorized practice of law. *See* 37 C.F.R. §§ 11.1, 11.14(a),(c); TMEP § 602.03. Appellant's acts of accepting these documents from the foreign attorneys and filing them with the USPTO aided those unauthorized practitioners in violation of 37 C.F.R. § 11.505.

6. 37 C.F.R. § 10.23(b) and 11.804(d) – Conduct was prejudicial to the administration of justice.

It is professional misconduct for a practitioner to “[e]ngage in conduct that is prejudicial to the administration of justice.” 37 C.F.R. § 10.23(b)(5); 37 C.F.R. § 11.804(d). Generally, an attorney engages in such conduct “when his or her conduct impacts negatively the public's perception or efficacy of the courts or legal profession.” *Attorney Grievance Comm’n v. Rand*, 981 A.2d 1234, 1242 (Md. 2009). Courts have found that the unauthorized practice of law is a serious threat to the effective administration of justice. *United States v. Johnson*, 327 F.3d 554, 560 (7th Cir. 2003); *see also American Express Co. v. Monfort Food Distrib. Co.*, 545 S.W.2d 49, 52 (Tex. Civ. App. 1976) (“The purpose of the rule requiring legal matters to be handled by persons trained in the law and familiar with court procedure is to further the efficient administration of justice.”). In addition, filing documents with forged signatures seriously interferes with the administration of justice. *See In re Vohra*, 68 A.3d 766, 783 (D.C. 2013) (By filing verified applications with forged signatures, an attorney “undermined the direct accountability of applicants that the verification requirement . . . is meant to foster.”); *Liles*, 808 N.W.2d at 206 (finding an attorney's forgery of a signature on a will and submission of the will to the court constituted conduct prejudicial to the administration of justice because it hampered the efficient operation of the court); *In re Kroll*, 33 A.D.3d 270, 272 (N.Y. App. Div. 2006) (An attorney's act of signing an applicant's name to a power of attorney constitutes conduct prejudicial to the administration of justice under the USPTO Code of Professional Responsibility.).

The ALJ found, and the record supports this finding, that Appellant engaged in numerous activities that are prejudicial to the administration of justice. As discussed above, Appellant aided foreign attorneys in the unauthorized practice of law before the Office. Appellant also forged the signatures of trademark

applicants onto documents submitted to the USPTO. Finally, Appellant knowingly defied the Trademark Commissioner's Exclusion Order by continuing to send and receive correspondence on behalf of the applicants. Appellant's engagement in these activities is uncontroverted. These activities undermined the efficiency and efficacy of the trademark registration process and are prejudicial to the administration of justice in violation of 37 C.F.R. §§ 10.23(b), 11.804(d).

D. Affirmative Defenses¹²

In an effort to avoid disciplinary sanction, Appellant raised several affirmative defenses in response to the disciplinary charges. Appellant must prove any affirmative defense by clear and convincing evidence. 37 C.F.R. § 11.49. This standard requires evidence "of such weight that it produces in the mind of the trier of fact a firm belief or conviction, without hesitancy, as to the truth of the allegations sought to be established." *In re Lane*, Proceeding No. D2013-07, at 2 (quoting *Jimenez v. DaimlerChrysler Corp.*, 269 F.3d 439, 450 (4th Cir. 2001)). Because she fails to satisfy this burden, and as more fully discussed below, her affirmative defenses fail.

1. Appellant's Constitutional Arguments.

a. Due Process

Appellant alleged that she was deprived of liberty to represent others in patent, trademark, and other matters without notice. A.R., Tab C.53; Appeal at 5; Reply at 3. Specifically, she claims she has engaged in the same alleged misconduct since 2006 but was never notified that she was doing anything wrong. *Id.* The ALJ correctly rejected these arguments. Dec. at 23-24.

"The fundamental requirement of due process is the opportunity to be heard at a meaningful time and in a meaningful manner." *See In re Karten*, 293 F.App'x 734, 736 (11th Cir. 2008) (quoting *Mathews v. Eldridge*, 424 U.S. 319, 333 (1976)). In disciplinary proceedings, an attorney is entitled to due process,

¹² Throughout the appeal, Appellant provides various arguments attacking the Trademark Commissioner's February 21, 2013 Exclusion Order. Appeal at 25-28; Reply at 2-3. That Order informed Appellant that she could appeal the exclusion decision via a Petition to the USPTO Director. Jnt. Ex. 4. Appellant did file such a Petition, and the USPTO Director upheld the Exclusion Order. Jnt. Ex. 12; Gov. Ex. 13. Thus, Appellant has exhausted the Agency's administrative processes for challenging the Trademark Commissioner's Exclusion Order and any arguments challenging the validity of that order will not be re-visited here.

such as reasonable notice of the charges before the proceedings commence. *See In re Ruffalo*, 390 U.S. 544, 551 (1968); *In re Cook*, 551 F.3d 542, 549 (6th Cir. 2009) (procedural due process includes fair notice of the charge). Due process requirements are satisfied where a respondent “attended and participated actively in the various hearings, and was afforded an opportunity to present evidence, to testify, to cross-examine witnesses, and to present argument.” *In re Squire*, 617 F.3d 461, 467 (6th Cir. 2010) (quoting *Ginger v. Circuit Court for Wayne Cty.*, 372 F.2d 620, 621 (6th Cir. 1967)); *see also In re Zdravkovich*, 634 F.3d 574 (D.C. Cir. 2011) (stating that attorney could not satisfy claim of due process deprivation where he was given notice of the charges against him, was represented by counsel, and had hearing at which counsel had the opportunity to call and cross-examine witnesses, make arguments, and submit evidence). Due process requirements are also met where a respondent is given “an opportunity to respond to the allegations set forth in the complaint, testify at length in [his] own defense, present other witnesses and evidence to support [his] version of events . . . , [and is] able to make objections to the hearing panel’s findings and recommendations.” *In re Squire*, 617 F.3d at 467 (quoting *In re Cook*, 551 F.3d at 550).

Here, Appellant received notice of the disciplinary charges and participated actively in the pre-hearing procedures and at the disciplinary hearing. A.R., Tabs C, F. Her participation, as reflected in the record, included filing and responding to various Motions, cross-examining witnesses, and testifying in her own defense. A.R., Tabs B, C. Despite this, she repeatedly argued that she lacked notice that her actions constituted misconduct until 2012. However, as already stated, Appellant is charged with educating herself as to the rules governing proper signatures and filing of documents with the USPTO. The USPTO’s trademark rules, TMEP and the TEAS Help guide would have assisted Appellant in educating herself as to governing rules. However, she failed to educate herself. Further, the ALJ’s conclusion that Appellant’s forged signatures directly contributed to the delay in the USPTO discovering the misconduct is both persuasive and supported by testimony from USPTO witness Catherin Cain. That testimony is that if a signature on a trademark document appears proper on its face – as was the case with the documents Appellant filed, which were forged by her – then further inquiry by the USPTO would not

necessarily occur. Tr. at 363-364, 368-369, 387-398. Consequently, as the delay in discovering Appellant's misconduct is in large part attributable to her own actions, Appellant has not carried her burden of establishing that she suffered a lack due process and that argument is rejected.

b. *Contract Clause*

ALJ also rejected Appellant's claim that her constitutional right to contract with clients without government restriction was violated, A.R., Tab C.7, correctly noting that this constitutional provision applies to state legislation. Dec. at 24 (citing *Pueblo of Santa Ana v. Kelly*, 932 F. Supp. 1284, 1297 (D.N.M. 1996), *aff'd*, 104 F.3d 1546 (10th Cir. 1997)). Further, even if this clause were implicated, the ALJ correctly noted that Appellant's failure to proffer any evidence of contracts between her and her clients is fatal to this claim. Dec. at 24-25 (citing *Fabri v. United Techs. Int'l, Inc.*, 387 F.3d 109, 124 (2d Cir. 2004)). Having failed to carry her burden, this argument fails.

c. *Selective Enforcement*

Throughout the disciplinary proceedings and in her post-hearing brief, Appellant argued that she was denied equal protection under the Fourteenth Amendment because she is being treated differently than similarly situated parties. A.R., Tab C.53. Specifically, Appellant alleged that the OED Director has ignored the similar conduct of other foreign e-filers while "vigilantly" reviewing Appellant's conduct. *Id.* However, the ALJ correctly rejected this argument by noting that Appellant's arguments and identifications of similarly situated individuals who allegedly received more favorable treatment are insufficient to support a selective enforcement claim. Dec. at 25-26. Appellant made no showing, at the hearing or otherwise, that the individuals she identified have actually avoided discipline or disciplinary investigation or, if they have, the reasons that no discipline was instituted against these individuals. Her conclusory statements are insufficient to satisfy her burden of proving a claim of selective enforcement.

2. Lack of Jurisdiction

For reasons already discussed, this allegation is dismissed. In short, Appellant is a registered patent agent with the USPTO. She is therefore subject to the Office's broad disciplinary jurisdiction.

3. Procedural Violations

Appellant asserts various procedural grounds as a defense to her disciplinary charges. As previously discussed, however, her arguments about the USPTO's authority to issue substantive rules and take disciplinary action as a result of conduct violating the Trademark rules and TMEP fail. Appeal at 15-16; Reply at 13-14; A.R., Tab C.53.

Lastly, Appellant argues that the OED did not conduct a proper investigation. A.R., Tab C.53. However, she offers no evidence to support her claim and the ALJ's rejection of this argument was proper.

Appellant's remaining arguments that she relied upon to contest discipline, both procedural and substantive, are without any factual or legal support and thus have no merit.

E. The Penalty of Exclusion is Appropriate.

The ALJ's initial decision concluded that Appellant violated six professional conduct standards, and that exclusion of Appellant from practice before the Office was an appropriate sanction. Dec. at 29-30. An ALJ initial decision that imposes exclusion must explain the reason for the exclusion after consideration of the following four factors:

- (1) Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession;
- (2) Whether the practitioner acted intentionally, knowingly, or negligently;
- (3) The amount of the actual or potential injury caused by the practitioner's misconduct; and
- (4) The existence of any aggravating or mitigating factors.

37 C.F.R. § 11.54(b)(1)-(4).

The Director of the USPTO reviews an appeal from an ALJ initial decision on the record before the ALJ. See 37 C.F.R. §11.55(f); see also *Marinangeli v. Lehman*, 32 F. Supp. 2d 1, 5 (D.D.C. 1998). After such review, and as discussed below, the ALJ's initial decision to exclude Appellant from practicing before the USPTO included a careful and proper analysis of the four factors set forth in 37 C.F.R. § 11.54(b). The ALJ's sanction of exclusion is warranted and thus upheld.

The ALJ properly considered and applied the four factors relevant to an exclusion under 37 C.F.R. § 11.54(b). Dec. at 27-29. First, the ALJ found that Appellant's actions violated duties owed to a client, to the public, to the legal system, and to the profession. Dec. at 28. Specifically the ALJ noted that Appellant failed to fulfill her obligation competently learn and understand the requirements for submitting trademark documents to the USPTO. *Id.* Further, he noted that Appellant failed to maintain the integrity and competence of the legal profession in several ways, including by engaging in disreputable and deceitful conduct, making false and misleading representations to the Office, and aiding others in the unauthorized practice of law, thus warranting a maximum sanction. *Id.*

As to the second factor, the ALJ found that Appellant acted knowingly and intentionally in all respects of her misconduct including when she submitted trademark documents she knew were not signed by applicants, when she aided others in the unauthorized practice of law, and when she continued to serve as a domestic representative despite be excluded by the Trademark Commissioner. Dec. at 28. The ALJ noted the particular egregiousness of disrespecting the Commissioner's authority and further concluded that this second factor counseled in favor of a maximum sanction. *Id.*

Third, the ALJ concluded that there was no evidence of any actual injury caused by Respondent's misconduct but that her misconduct could cause significant injury to the applicants and registrants where documents were not properly verified and thus subject to cancellation. Dec. at 28. This factor counseled in favor of a moderate sanction. *Id.*

Finally, the ALJ identified one mitigating and multiple aggravating factors in the case. Aggravating factors were noted as Appellant's dishonest motive by intentionally concealing the fact that she continued to serve as a domestic representative; existence of a pattern of misconduct over an "extensive period of time"; and the fact that Appellant has refused to acknowledge that her actions constitute misconduct. Dec. at 29. The fact that Appellant had been admitted to the patent bar for nine years with no prior disciplinary record was noted as a mitigating factor. *Id.*

Considering the four factors noted above, the ALJ concluded that Appellant's exclusion from practice before the Office was an appropriate sanction. Dec. at 29-30. As the ALJ's sanction was made after

considering all of the required factors, and is fully supported by the uncontroverted evidence of record, the sanction of exclusion is upheld.

ORDER

Having considered Appellant's appeal under 37 C.F.R. § 11.55, from the April 22, 2015 initial decision of the ALJ excluding Appellant from the practice of all patent, trademark, and other non-patent matters before the Office, it is **ORDERED** that the initial decision of the ALJ is **AFFIRMED**.

It is further:

ORDERED that the OED Director give notice pursuant to 37 C.F.R. § 11.59 of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s) where Appellant is admitted to practice, to courts where Appellant is known to be admitted, and to the public;

ORDERED that the USPTO dissociate Appellant's name from any Customer Numbers and the public key infrastructure ("PKI") certificate associated with those Customer Numbers;

ORDERED that Appellant shall not apply for a USPTO Customer Number, shall not obtain a USPTO Customer Number, nor shall she have her name added to a USPTO Customer Number, unless and until she is reinstated to practice before the USPTO; and

ORDERED that Appellant shall comply with the provisions of 37 C.F.R. § 11.58 governing the duties of disciplined practitioner.

RECONSIDERATION AND APPEAL RIGHTS

Any request for reconsideration of this decision must be filed within twenty (20) days from the date of entry of this decision pursuant to 37 C.F.R. § 11.56(e). Any request for reconsideration mailed to the USPTO must be addressed to:

Sarah Harris
General Counsel
United States Patent and Trademark Office

600 Dulany St.
P.O. Box 1450
Alexandria, VA 22313

A copy of the request must also be served on the attorney for the Director of Enrollment and Discipline:


Elizabeth Ullmer Mendel
Melinda M. DeAtley
Counsel for the Director of Office of Enrollment and Discipline
600 Dulany St.
P.O. Box 1450
Alexandria, VA 22313

Any request hand-delivered to the USPTO must be hand-delivered to the Office of the General Counsel, in which case the service copy for the attorney for the Director shall be hand-delivered to the Office of Enrollment and Discipline.

If a request for reconsideration is not filed, and Appellant desires further review, Appellant is notified that she is entitled to seek judicial review on the record in the U.S. District Court for the Eastern District of Virginia under 35 U.S.C. § 32 "within thirty (30) days after the date of the order recording the Director's action." *See* E.D.Va. Local Civil Rule 83.5.

IT IS SO ORDERED.

3/4/16
Date



Sarah Harris
General Counsel
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:
Bang-er Shia
Appellant

Elizabeth Ullmer Mendel
Melinda M. DeAtley
Associate Solicitors
Counsel for the Director of Office of Enrollment and Discipline