

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE ADMINISTRATIVE LAW JUDGE**

In the Matter of:

Bang-er Shia,

Respondent.

Proceeding No. D2014-31

April 22, 2015

Appearances:

Melinda M. DeAtley, Esq.
Elizabeth Ullmer Mendel, Esq.
Associate Solicitors
United States Patent and Trademark Office

Dr. Bang-er Shia
Pro se

Before: Alexander FERNÁNDEZ, Administrative Law Judge

INITIAL DECISION AND ORDER

On July 22, 2014, the Director of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) filed an *Amended Complaint and Notice of Proceedings Under 35 U.S.C. § 32* (“Complaint”) in Proceeding No. D2014-31 against Dr. Bang-er Shia (“Respondent”).¹ The *Complaint* seeks the exclusion or suspension of Respondent for committing violations of the USPTO practitioner disciplinary rules.

On August 20, 2014, Respondent filed an *Answer and Counterclaim to Amended Complaint* (“Answer”) summarily denying the allegations in the *Complaint* and raising a number of affirmative defenses.

The hearing in this matter was held on October 6-10, 2014 in Washington, District of Columbia. The testimony of the following witnesses was received: Tanya Amos, TEAS Administrator in the Legal Policy Office of the USPTO; Catherine Cain, staff attorney in the Office of Trademark Legal Policy and editor of the *Trademark Manual of Examining Procedure*; Jennifer Harchick, staff attorney in the Office of Enrollment and Discipline; and Respondent.

¹ The OED Director also filed a *Complaint and Notice of Proceedings Under 35 U.S.C. § 32* against Respondent in Proceeding No. D2014-04, which was withdrawn at the hearing resulting in the dismissal of the D2014-04 proceeding. The original *Complaint and Notice of Proceedings Under 35 U.S.C. § 32* in Proceeding No. D2014-31 was filed on June 27, 2014.

The Court also accepted the deposition testimony of Marynell Gainer, records custodian of Windstream Communications, Inc., in lieu of her live testimony.

Following the Court's receipt of the transcript on October 27, 2014, the parties were ordered to file post-hearing briefs and response briefs. After the timely receipt of the parties' briefs, the record was closed.

Applicable Law

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." Kroll v. Finnerty, 242 F.3d 1359, 1364 (Fed. Cir. 2001). 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.

The USPTO has duly promulgated regulations governing the conduct of persons authorized to practice before the Office. The USPTO Rules of Professional Conduct (37 C.F.R. §§ 11.100 *et seq.*) apply to persons who practice before the Office and became effective May 3, 2013. For alleged violations of USPTO disciplinary rules occurring prior to May 3, 2013, the USPTO Code of Professional Responsibility (37 C.F.R. §§ 10.20 *et seq.*) applies.²

Burden of Proof. The OED Director has the burden of proving the alleged violations by clear and convincing evidence. 37 C.F.R. § 11.49. Thereafter, it is Respondent's burden to prove any affirmative defense by clear and convincing evidence. Id.

The clear and convincing standard is applied "to protect particularly important interests . . . where there is a clear liberty interest at stake." Thomas v. Nicholson, 423 F.3d 1279, 1283 (Fed. Cir. 2005). This is an intermediate standard "between a preponderance of the evidence and proof beyond a reasonable doubt." Addington v. Texas, 441 U.S. 418, 424-425 (1979). The 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." Jimenez v. DaimlerChrysler Corp., 269 F.3d 439, 450 (4th Cir. 2001). "Evidence is clear if it is certain, unambiguous, and plain to the understanding, and it is convincing if it is reasonable and persuasive enough to cause the trier of facts to believe it." Foster v. Alliedsignal, Inc., 293 F.3d 1187, 1194 (10th Cir. 2002) (citing Ortega v. IBP, Inc., 874 P.2d 1188, 1198 (1994), disapproved of by In re B.D.-Y., 187 P.3d 594 (2008)).

Findings of Fact

Background

1. On September 26, 2005, the USPTO registered Dr. Bang-er Shia ("Respondent") as a patent agent. Respondent's registration number is 57,568.

² The *Complaint* alleges Respondent committed various violations of the USPTO disciplinary rules both before and after the effective date of the USPTO Rules of Professional Conduct.

2. Respondent operates a business called the International Patent Office of Bang Shia.
3. Respondent is associated with the following e-mail addresses: [REDACTED]; [REDACTED]; and [REDACTED]. Respondent authorized her husband, Yu Liang Yu, to access these e-mail addresses.
4. Respondent 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”).
5. Respondent is authorized to practice before the USPTO as a patent agent in patent matters only and is not authorized to practice before the USPTO in trademark matters.
6. Respondent is not, and never has been, an attorney licensed in any state to practice law.
7. Since 2006, Respondent has acted as the domestic representative for certain foreign applicants based in Taiwan and China.
8. On January 23, 2012, the Commissioner for Trademarks (“Commissioner”) sent a show cause letter to Respondent informing her that the USPTO had determined that it appeared Respondent may be engaging in the unauthorized practice of trademark law before the Office.
9. By letter dated January 27, 2012, Respondent answered the show cause letter denying that she was engaged in the unauthorized practice of trademark law.
10. On February 21, 2013, after considering Respondent’s answer to the show cause letter, the Commissioner excluded Respondent from participating as correspondent or domestic representative in any trademark matters before the USPTO. The Commissioner’s Exclusion Order stated that Respondent’s exclusion was effective immediately.
11. After the issuance of the Exclusion Order, Respondent’s foreign clients instructed her to remove her name as their domestic representative.
12. However Respondent’s clients also asked her to continue assisting with their trademark applications.
13. On March 19, 2013, Respondent’s appeal of the Commissioner’s Exclusion Order (“Respondent’s Petition to the Director”) was filed with the USPTO.
14. On December 27, 2013, the USPTO Director³ issued a Memorandum and Order affirming the Commissioner’s Exclusion Order.

³ The Memorandum and Order was signed by Ari Leifman, Acting Chief of Staff, Office of Policy and International Affairs, USPTO on behalf of Margaret Focarino, Commissioner for Patents performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the USPTO.

Trademark Application 85/585,031

15. On March 30, 2012, Respondent filed U.S. Trademark Application, Principal Register Serial No. 85/585,031 (“the ‘031 application”) with the USPTO.
16. The ‘031 application lists Dongshan Dongxing Aquatic Processing Co., Ltd (“Dongshang”) as the applicant and owner of the mark seeking registration.
17. In the Correspondence Information fields, Respondent’s [REDACTED] e-mail address was identified as the designated correspondence e-mail address.
18. The ‘031 application was prepared by an attorney in China with Shinwha Co. Ltd. and forwarded to Respondent for filing with the USPTO.
19. Prior to submitting the ‘031 application, Respondent electronically entered the signature “/Chi-Ching Weng/” as the declaration signature for the ‘031 application.
20. Respondent also entered her name and [REDACTED] e-mail address as designated recipient for the filing confirmation.
21. On April 11, 2012, Respondent filed a Change of Correspondence Address with the USPTO.
22. The Change of Correspondence Address identified Respondent’s Canyon Creek address and [REDACTED] e-mail address as the new correspondence addresses for the ‘031 application.
23. Respondent electronically signed the name “Chi-ching Weng” to the Change of Correspondence Address.

Trademark Application 85/712,340

24. On August 24, 2012, U.S. Trademark Application Serial No. 85/712,340 (“the ‘340 application”) was filed with the USPTO.
25. The ‘340 application listed Jet Crown International Co., Ltd. (“Jet Crown”), as the owner of the mark. Jet Crown is a corporation in Taiwan with no known U.S. subsidiaries.
26. In the field designated for the e-mail address of Jet Crown, as the owner of the mark, Respondent’s [REDACTED] e-mail address was input.
27. The ‘340 application identified Jet Crown as the correspondent for the application. However, Respondent’s Lindencrest address was used as the correspondent address and Respondent’s [REDACTED] e-mail address was input as the correspondent e-mail address.

28. Respondent submitted the '340 application to the USPTO. However, prior to doing so, Respondent electronically signed “/Wang, Edmund/” as the declaration signature.
29. Respondent 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.
30. On May 26, 2013, Respondent filed a Statement of Use related to the '340 application.
31. The Statement of Use also changed the correspondence address for Jet Crown to “c/o SW TW SHEN” and identified Respondent’s Summerfield Ridge address and [REDACTED] e-mail address.
32. The Statement of Use was executed using the HSign-on method, wherein a .pdf bearing the handwritten signature of Edmund Wang was attached.

Trademark Application 85/747,741

33. On October 7, 2012, Respondent submitted U.S. Trademark Application Serial No. 85/747,741 (“the '741 application”) to the USPTO.
34. The '741 application identifies Min Hsiang Corporation (“Min Hsiang”) as the applicant and owner of the mark seeking registration.
35. Prior to submitting the '741 application to the USPTO, Respondent entered the electronic signature “/Tim Wu/” into the declaration signature field.
36. On February 7, 2013, an Outgoing Office Action was issued in the '741 application. The Outgoing Office Action inquired as to whether the wording “Min Hsiang” in the trademark had an English translation and requested other clarifications. The Outgoing Office Action provided a telephone number for an applicant to call with questions and noted that TEAS Plus applicants must submit documents electronically or submit a filing fee.
37. On March 24, 2013, Respondent submitted a Response to Office Action to the USPTO.
38. Before submitting the Response to Office Action, Respondent entered the electronic signature “/Tim Wu/” into the signature field. However, Respondent also submitted a .pdf to the Miscellaneous Statement section for the '741 application. The .pdf included a handwritten signature by Tim Wu dated March 6, 2013.
39. Respondent’s [REDACTED] e-mail address was designated as the reply e-mail for the Response to Office Action.
40. On August 17, 2013, Respondent filed a Statement of Use for the '741 application. Before doing so, she electronically entered “/Tim Wu/” as the name of the signatory. Respondent also attached the handwritten signature of Tim Wu.

Trademark Application 85/595,869

41. On April 12, 2012, U.S. Trademark Application Serial No. 85/595,869 (“the ‘869 application”) was filed with the USPTO.
42. Eng Ku Optical Industrial Co., Ltd. (“Eng Ku”) is identified as the applicant and owner of the mark seeking registration.
43. Lan Loop Patent & Trademark (“Lan Loop”) and Respondent’s Canyon Creek address were identified in the “Correspondence Information” fields for the ‘869 application.
44. Lan Loop is the name of a patent and trademark office in Taiwan that provided legal services to Eng Ku.
45. The ‘869 application was completed using the HSign-on method by Terry Chou, president of Eng Ku.
46. Respondent filed the ‘869 application with the USPTO.
47. On April 30, 2012, Respondent submitted a Change of Correspondence Address to the USPTO for the ‘869 application.
48. The Change of Correspondence Address purported to change the original correspondence address from “LAN LOOP PATENT & TRADEMARK VICTORIA Texas 77479 US” to Respondent’s Canyon Creek address. Respondent’s [REDACTED] e-mail address remained the correspondence e-mail for ‘869 application.
49. Respondent affixed Mr. Terry Chou’s electronic signature to the Change of Correspondence Address and transmitted it to the USPTO.
50. On January 22, 2013, a Statement of Use was submitted to the USPTO for the ‘869 application.
51. Respondent entered Mr. Chou’s electronic signature on the Statement of Use prior to submitting it to the USPTO.
52. Respondent also attached a .pdf to the Statement of Use. The .pdf included a copy of the Statement of Use signed on January 17, 2013, by Mr. Chou.

Trademark Application 85/689,678

53. On July 30, 2012, U.S. Trademark Application 85/689,678 (“the ‘678 application”) was filed with the USPTO.

54. The '678 application identified KUNSHAN PEPWING TEXTILE CO., LTD ("Kunshan") as the applicant and owner of the mark seeking registration, but identified Respondent's [REDACTED] e-mail address for Kunshan.
55. The '678 application was completed by an attorney of Kingkraft in China who then transmitted it to Respondent for filing with the USPTO.
56. The '678 application identified the Office of Bang Shia and included Respondent's Canyon Creek address in the Correspondence Information fields.
57. Prior to filing the '678 application with the USPTO, Respondent electronically entered the signature "/George YANG/" in the declaration signature field.
58. The name of Respondent's husband and Respondent's [REDACTED] e-mail address were identified to receive the filing receipt.
59. On November 28, 2012, the USPTO issued an Office Action related to the '678 application. The Office Action stated a response was due within six months.
60. The Office Action was sent to Respondent's [REDACTED] e-mail address. Respondent forwarded the Office Action to Kunshan's attorneys in China.
61. An attorney with Kingkraft prepared a Response to Office Action for the '678 application and sent it to Respondent for filing with the USPTO.
62. Prior to submitting the Response to Office Action for the '678 application, Respondent entered the electronic signature "/George Yang/" to the document.
63. On March 5, 2013, a Change of Correspondence Address was filed with the USPTO for the '678 application.
64. The Change of Correspondence Address purported to change the correspondence address from Respondent's Canyon Creek address to a post office box in Taiwan but Respondent's e-mail addresses was not changed.
65. Respondent prepared and completed the Change of Correspondence Address and entered the electronic signature "/George Yang/" in the signature field.

Trademark Application 85/719,310

66. On September 3, 2012, U.S. Trademark Application Serial No. 85/719,310 ("the '310 application") was filed with the USPTO.
67. Shuangfei Daily Chemicals USA Inc. ("Shuangfei") is identified as the applicant and owner of the mark seeking registration.

68. Although Shuangfei is identified as a corporation incorporated in the state of Pennsylvania, the '310 application provided Respondent's Lindencrest address and [REDACTED] e-mail address in the correspondence information fields.
69. The '310 application was transmitted to Respondent by Shuangfei's attorney in China.
70. Respondent filed the '310 application with the USPTO. However, before doing so she entered the electronic signature "/Zhenhui Li/" in the declaration signature field.
71. The name of Respondent's husband and Respondent's [REDACTED] e-mail address were identified for receipt of the filing receipt.
72. On March 5, 2013, Respondent filed a Change of Correspondence Address related to the '310 application with the USPTO.
73. The Change of Correspondence Address purported to change the correspondence address from Respondent's Lindencrest address to an address in Taiwan. However, Respondent's [REDACTED] e-mail address remained as the correspondence e-mail address.
74. Prior to submitting the Change of Correspondence Address to the USPTO, Respondent entered the electronic signature "/Zhenhui Li/" into the signature field.

Trademark Application 85/748,531

75. On October 8, 2012, Respondent filed U.S. Trademark Application Serial No. 85/748,531 ("the '531 application") with the USPTO.
76. This was a second trademark application for Min Hsiang. Although the application was for the same trademark, the '531 application identified a different class of goods than the '741 application.
77. Prior to filing the '531 application with the USPTO, Respondent entered the electronic signature "/Tim Wu/" in the declaration signature field.
78. On March 24, 2013, Respondent filed a Response to Office Action for the '531 application.
79. Although Respondent included a .pdf copy with Tim Wu's handwritten signature, Respondent also entered the electronic signature "/Tim Wu/" in the signature field.
80. On August 17, 2013, Respondent filed a Statement of Use related to the '531 application with the USPTO.
81. A .pdf document attached to the Statement of Use included a copy Tim Wu's handwritten signature.

Trademark Application 85/756,529

82. On October 17, 2012, Respondent filed U.S. Trademark Application Serial No. 85/756,529 (“the ‘529 application”) with the USPTO.
83. This was a third trademark application for Min Hsiang. Although this application was for the same trademark, the ‘529 application identified a different class of goods than the ‘531 or ‘729 applications.
84. Prior to filing the ‘529 application with the USPTO, Respondent electronically signed “/Tim Wu/” in the declaration signature field of the application.

Trademark Application 77/836,647⁴

85. On February 7, 2013, Respondent completed, signed, and filed a Change of Correspondence Address related to U.S. Trademark Application Serial No. 77/836,647 (“the ‘647 application”) with the USPTO.
86. The Change of Correspondence Address changed the correspondence address from Respondent’s Lindencrest address to an address in Taiwan belonging to the applicant.

Discussion⁵

The OED Director claims Respondent engaged in misconduct related to the eight trademark applications referenced, *supra*. The OED Director also claims that Respondent’s misconduct constitutes violations of the USPTO disciplinary rules. As such, the OED Director requests an order excluding Respondent from practice before the USPTO in all matters.

I. Respondent’s Actions Constitute Misconduct

The OED Director alleges Respondent improperly handled trademark matters on behalf of her clients. Specifically, the OED Director claims Respondent (A) improperly signed documents related to trademark applications filed on behalf of her clients; (B) filed trademark documents with the USPTO that were completed by foreign attorneys; (C) went beyond the role of a domestic representative and/or correspondent by actively practicing before the Office in trademark matters; and (D) continued to act as a domestic representative and/or correspondent despite being excluded by the Commissioner of Trademarks. The alleged misconduct all relates

⁴ In the *Order on Respondent’s Motion to Dismiss*, dated September 5, 2014, the Court held that acts related to the ‘647 application that occurred prior to the Commissioner’s Show Cause Letter fell outside the statute of limitations, because such acts were “made known” to the Commissioner no later than January 23, 2012. The facts cited below occurred after the Show Cause Letter and were not made known to the OED Director until January 9, 2014, and are, therefore, not time-barred by the statute of limitations.

⁵ The Court has considered all issues raised and all documentary and testimonial evidence in the record and presented at hearing. Those issues not discussed here are not addressed because the Court finds they lack materiality or importance to the decision.

to Respondent's submission of trademark documents to the USPTO using the Trademark Electronic Application System ("TEAS").

As a means of simplifying the trademark filing system and reducing errors, the USPTO allows the public to electronically file certain trademark-related forms on TEAS. Upon completing a form, the user may upload the form to TEAS or save a .pdf version of it for later submission. If the user opts to save a .pdf version of the form, TEAS downloads a copy of the completed form but deletes any signatures electronically entered directly onto the form. Deleting the signature requires the user to re-sign the form just prior to submitting it, thereby ensuring that the information contained in the form is verified. This is necessary as the signatory is often required to attest to the truthfulness of facts contained in the form.⁶

There are three acceptable signature methods for TEAS filings. One is the direct signature method wherein the appropriate signatory personally enters his or her own electronic signature between two forward slashes. Specifically, the signatory may select any combination of letters, numbers, spaces and/or punctuation marks that he or she has designated as a signature. See 37 C.F.R. § 2.193(c)(1). Whatever combination the signatory adopts as his or her signature must be *personally entered* between two forward slash symbols in the signature block.⁷ Id. "ESign-on" is the second method, wherein a user can e-mail a text version of the form to the appropriate signatory, who then returns the signed electronic copy to the user for submission. Finally, "HSign-on" is a method wherein a user can submit a printed pen-and-ink signature personally made by an appropriate signatory that is then scanned as a .pdf or .jpeg and attached to the form.

A. Respondent improperly signed trademark documents filed with the USPTO.

The OED Director claims Respondent failed to comply with USPTO signature regulations by knowingly entering the electronic signatures of foreign applicants on trademark documents and submitting those documents to the Office. The OED Director also claims Respondent inappropriately entered her own name and electronic signature onto a Change of Correspondence Address related to the '647 application.

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 documents that require a verification of the facts must be sworn to in a declaration that is signed by the owner or the owner's authorized representative. Id. at § 2.193(e)(1). 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

⁶ TEAS applications include a declaration wherein the signatory attests to the truthfulness of the facts contained in the application. The declaration contains the following language, "The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and behalf are believed to be true."

⁷ 37 C.F.R. § 2.193(c)(2) purports to authorize the signatory to sign a verified statement using "some other form of electronic signature specified by the Director." The Court interprets this language to serve as a place holder for if or when the Director authorizes another form or method of electronic signature. Thus, until another form or method of electronic signature is authorized, an electronic signature is only acceptable if it meets the requirements of 37 C.F.R. § 2.193(c)(1).

(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 power of attorney from the owner.⁸ *Id.* However, when the applicant is a juristic entity rather than an individual person, additional requirements apply. For instance, “[w]here a document must be signed by someone with legal authority to bind a corporation, a corporate officer must sign. An officer is a person who holds an office established in the articles of incorporation or corporate bylaws.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 611.06(d).

At the hearing, Respondent admitted that she entered the electronic signature of the applicants onto trademark documents and then filed the documents with the USPTO. Respondent’s testimony on the matter is as follows:

The applicant signs their signature, typed in their signature before. But their signatures, their personal signatures, were taken away by USPTO. As an e-filer, I had to put it back. I cannot put in my name because the — their signatures on the forms is not my name. Their handwritten pen-and-ink signature is not my name.

Respondent also acknowledged that she was not an officer of any of the client corporations on whose behalf the trademark applications were filed. Regardless, Respondent claims she acted properly because she had legal authority to bind the applicants. In support of her argument, Respondent filed several documents after the hearing, which she alleges bestowed upon her the legal authority to sign the applicant’s names to the trademark documents.⁹ The documents include purported Powers of Attorney for the ‘031, ‘869, ‘340, ‘741, ‘310, ‘531, and ‘529 applications, and an “authorization” for the ‘678 application.

After careful review of these documents, the Court finds that they do not authorize Respondent to enter the electronic signature of the applicants onto the declarations verifying the facts in the trademark applications cited above. Most of the documents do appear to be powers of attorney. However, they are insufficient to authorize Respondent to sign on behalf of the applicants because she is not an attorney. *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); *see also* 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).

Further, the Court questions what authority, if any, the purported powers of attorney actually convey to Respondent. “The nature and extent of the authority granted must be

⁸ At the hearing, Respondent asked when the “firsthand knowledge” language was included in the regulation, because she believed “firsthand knowledge” was not a requirement until after her alleged misconduct occurred. The Court takes judicial notice that the current regulation, which includes the “firsthand knowledge” language, became effective on December 28, 2009. The Court also notes that “firsthand knowledge” was already required for “verified statements” supported by declarations in a prior version of the regulation effective October 30, 1999. *See* 64 FR 48900-01, 48908.

⁹ Respondent’s post-hearing submission of evidence was authorized by the *Order for Documents*, dated October 9, 2014.

ascertained from the instrument granting the power of attorney.” Hardy v. Robinson, 170 S.W.3d 777, 780 (Tex. App. 2005); Dingle v. Prikhdina, 59 So. 3d 326, 328 (Fla. Dist. Ct. App. 2011) (general rule is that a power of attorney must be strictly construed and the instrument will be held to grant only those powers which are specified.”); Tennessee Farmers Life Reassurance Co. v. Rose, 239 S.W.3d 743, 749 (Tenn. 2007) (“A power of attorney is a written instrument that evidences to third parties the purpose of the agency and the extent of the agent’s powers.”); Kline By & Through Kline v. Utah Dep’t of Health, 776 P.2d 57, 61 (Utah Ct. App. 1989) (“The scope of the authority so conferred may, by the terms of the instrument itself, be general or limited, but the instrument creating this agency relationship is to be strictly construed.”)

Each of these documents includes the heading “Power of Attorney,” with some variation of “with Legal Authority to Bind the Applicant.” However, the body of each document is nothing more than a cut-and-pasted declaration, signed by the applicant, attesting to the veracity of the statements made in a trademark application. The only reference to Respondent is under the heading “Contact Information,” wherein Respondent’s name, address, and phone numbers are listed. To conclude that the documents bestow upon Respondent the authority to bind the applicant in matters before the USPTO would require a very liberal interpretation of the applicants’ intent for most, if not all, the purported Powers of Attorney submitted.¹⁰

One of the documents titled “Authorization from the Applicant before the USPTO” goes as far as confirming that Respondent has “legal authority to act on behalf of the applicant” in the body of the document. However, this document was not signed by the applicant. Rather, it was executed by the applicant’s attorney from KunShan Baike Trademark Agent Co., Ltd. This signature is impermissible because USPTO regulation requires a power of attorney to be signed by a corporate officer if the applicant is a corporation. 37 C.F.R. § 2.17(c)(1)-(2). Moreover, the Trademark Manual of Examining Procedure (“Trademark Manual”) explicitly states,

Simply stating that a person has been granted authority to act on behalf of the applicant or registrant is insufficient. Documents purporting to authorize representation, even if signed by officers, will not be accepted as establishing the authority of a person who is not the equivalent of an officer. The applicant or registrant must state that the signatory has the authority to legally bind the applicant or registrant under its bylaws or articles of incorporation.

TMEP § 611.06(e). Still, had Respondent been properly bestowed with the authority to act on behalf of the applicant, Respondent could not sign sworn declarations because she did not have firsthand knowledge of the facts.¹¹

¹⁰ The Court notes that the purported Power of Attorney for the ‘340 application goes further by stating “[t]his is to authorize Dr. Banger Shia . . . to have the legal authority to bind the applicant before the USPTO” above the cut-and-pasted declaration. However, this still does not authorize Respondent to sign documents, on behalf of the applicant, to be filed with the USPTO, because she is not an attorney.

¹¹ At the hearing, Respondent admitted that she did not have firsthand knowledge of the facts contained in the applications cited above. Rather, Respondent testified that the applicants, whose electronic signature she was entering, had firsthand knowledge.

Further, the Court finds that even if Respondent was the proper signatory — meaning legal authority to bind the applicants in matters before the USPTO was properly conveyed to her and she had firsthand knowledge of the facts — Respondent should have identified herself as signatory and personally entered her own electronic signature (i.e. Respondent’s own name in between two forward slashes) rather than the signature of another person. See 37 C.F.R. § 2.193(a) (For all trademark correspondence with the Office that requires a signature, the signature must be either a handwritten signature of the signatory, or an electronic signature that is *personally entered by the person named as the signatory.*)

Accordingly, the Court finds that Respondent is not legally authorized to bind the applicants in the aforementioned trademark applications in matters before the USPTO. Her practice of entering the electronic signatures of the applicants onto trademark documents filed with the USPTO was inappropriate and constitutes misconduct.

B. Respondent filed trademark documents prepared by foreign attorneys.

Respondent consistently and emphatically testified that foreign attorneys would prepare the trademark documents and forward them to Respondent for filing with the USPTO. At the hearing, Respondent’s testimony on the matter is as follows:

All the forms were prepared by either attorneys in Taiwan or attorneys in China and they asked their—their clients, the applicant, to authorize me to represent them—represent them to submit those forms to USPTO. What I did were only to add whatever is missed, the signature, from their document.

...

Everything [USPTO] received were prepared by attorneys in Taiwan or attorneys in China, and they downloaded it into a E-file and they sent that file to me. My job was to make sure nothing is missing from the—their file.

...

All [documents USPTO] received were prepared by the attorneys in Taiwan and in China.

The evidence in the record of this proceeding demonstrates that foreign attorneys, who are not recognized to practice before the Office in trademark matters, prepared trademark applications, Statements of Use, and Responses to Office Actions. The foreign attorneys then paid Respondent to review the trademark documents for accuracy and file them with the USPTO. Accordingly, the Court finds that the trademark applications at issue, along with all Statements of Use and Responses to Office Action cited above, were initially prepared by foreign attorneys and transmitted to Respondent for filing with the USPTO.

C. Respondent's actions went beyond the role of a domestic representative and constituted practice before the Office in trademark matters.

The OED Director claims Respondent went beyond her role as a domestic representative or correspondent by actively practicing before the Office in trademark matters. Specifically, the OED Director alleges Respondent "prepared electronic trademark applications, electronically signed the applications, and filed the applications with the Office." Respondent also allegedly "prepared, electronically signed, and submitted Responses to Office Actions and Statements of Use with the Office."

An owner of a mark may represent himself or herself in prosecuting an application. 37 C.F.R. § 11.14(e); TMEP § 601. An owner of a mark may also be represented by a practitioner authorized under 37 C.F.R. § 11.14. Section 11.14 identifies the following individuals who may practice before the Office in trademark matters: (a) attorneys; (b) non-lawyers who were recognized to practice before the Office in trademark matters prior to January 1, 1957; and (c) foreign attorneys that have been specially recognized by the USPTO for the limited purpose of representing parties located in their country. Only the aforementioned individuals are permitted to practice before the Office in trademark matters.

Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment that may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board. 37 C.F.R. § 11.5(b)(2). An individual who is not authorized to practice before the Office in trademark matters may not sign documents on behalf of applicants. TMEP § 608.01. Such an individual may, however, act as a domestic representative or correspondent. The Trademark Manual describes a domestic representative as an individual who serves and receives correspondence and process on behalf of an overseas client. TMEP § 608.01.

Respondent testified that foreign attorneys would prepare trademark applications, Responses to Office Action, and Statements of Use, and send them to her for submission. Upon receiving said documents, Respondent would review the documents for completeness and accuracy. On several occasions, Respondent completed the trademark documents by entering the applicant's electronic signature. Respondent would then submit the completed document to the USPTO for filing. In addition, Respondent also prepared Change of Correspondence Address forms and entered either the electronic signature of the applicant or her own electronic signature. Such conduct went beyond merely forwarding correspondence between the applicants and the USPTO and constitutes practice before the Office in trademark matters.

D. Respondent continued to act as domestic representative after being excluded from doing so by the Commissioner.

The OED Director claims Respondent ignored the Commissioner's Exclusion Order excluding Respondent from acting as a domestic representative or correspondent in trademark

matters before the USPTO. The OED Director also alleges Respondent attempted to conceal the fact that she was continuing to serve as a domestic representative by changing the mailing addresses and providing an e-mail address that the USPTO had not attributed to Respondent.

The first sentence of the Exclusion Order states, “This letter is to notify you that, effective immediately, the [USPTO] is excluding you from participating as a correspondent or domestic representative in any trademark matters before the USPTO.” The Exclusion Order also explained that domestic representatives are appointed for the purpose of providing a contact and address for service of process for foreign applicants.

Respondent acknowledged that she read and understood the letter. She also testified that she ceased serving as a correspondent for her clients after receiving the Exclusion Order.

I don’t think it is a fair decision in the [Exclusion Order] dated February 21, 2013 from the Trademark Director. However, after I received this letter, with the permission of the foreign applicants, I stopped being – I stopped acting as a U.S. domestic representative or correspondence addressee in front of USPTO.

...

After receiving the Trademark Director’s letter of February 21, 2013, . . . With permission from my clients, I took off my name and my company’s name from all the related USPTO website or documents and changed their correspondent address to their attorneys in China and in Taiwan.

Although Respondent argues that she did not agree with the Exclusion Order and had appealed it, Respondent testified that her clients also understood that she was excluded from acting as a correspondent. Respondent’s testimony on that matter is as follows:

The language in the first paragraph [of the Exclusion Order] said I was excluded, so my clients advised me to take off my name and not act as the correspondent or the domestic representative.

However, while Respondent’s mailing address was removed as the correspondence address for the applications at issue, Respondent continued to receive and submit trademark documents on behalf of her clients. This is evidenced by the following testimony from Respondent:

It should be stated like this: [My clients] wanted to take off my name as domestic representative; however, they still authorized me to help with the application.

...

My client said USPTO had excluded me from trademark business; however, they knew that I was innocent. So they just borrow my

address and email address just in case the letters and communications got lost.

The evidence in the record of this proceeding demonstrates that Respondent continued to file trademark documents with the USPTO even after receiving the Exclusion Order. Such documents include Statements of Use, Responses to Office Actions, and Change of Correspondence Address forms related to the '340, '741, '678, '310, and '531 applications. On the Change of Correspondence forms for both the '678 and the '310 applications, the correspondence addresses were changed from Respondent's mailing address to addresses in Taiwan, but Respondent's [REDACTED] e-mail address continued to be identified as the e-mail address for receiving correspondence. At this time, the [REDACTED] e-mail address had not been identified by the USPTO as belonging to Respondent.

Based upon the foregoing, the Court finds that Respondent continued to act as the domestic representative or correspondent for the applicants despite being excluded from doing so by the Commissioner. The Court also finds that Respondent attempted to conceal this fact from the USPTO by filing Change of Correspondence forms that included the [REDACTED] e-mail address for receipt of correspondence.

II. Respondent's Misconduct Violates the USPTO Disciplinary Rules

The OED Director claims Respondent's misconduct violated a litany of disciplinary rules under the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct. The Court applies the Code of Professional Conduct to misconduct that occurred prior to May 3, 2013, and the Rules of Professional Responsibility to misconduct that occurred thereafter. See 37 C.F.R. § 11.901.

A. Respondent engaged in disreputable conduct.

The OED Director claims Respondent's conduct constitutes disreputable or gross misconduct in violation of 37 C.F.R. § 10.23(a). "With respect to attorneys or other agents, disreputable conduct has generally included unprofessional conduct . . . to include any conduct violative of the ordinary standard of professional obligation and honor." In re Lane, Proceeding No. D2013-07 (USPTO Mar. 11, 2014) (quoting Poole v. United States, CIV. A. 84-0300, 1984 WL 742 (D.D.C. June 29, 1984)).

A respondent's misconduct is not outside the disciplinary reach of the Office simply because the misconduct is not specifically enumerated within the USPTO's disciplinary rules. See In re Edington, Proceeding No. D08-12, at 6 (USPTO Jul. 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 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)). The Rules of Practice in Trademark Cases ("Rules of Practice") are set forth in Title 37, part 2 of the Code of Federal Regulations. "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.” TMEP INTRODUCTION. In addition, the Trademark Manual provides “trademark applicants, and attorneys and representatives for trademark applicants with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO.” As such, the Rules of Practice and the Trademark Manual offer guidance as to the appropriate conduct trademark applicants, attorneys, and representatives for trademark applicants should undertake when registering a mark with the USPTO. While a violation of the Rules of Practice is not a *per se* violation of the USPTO disciplinary rules, the underlying conduct may, nevertheless, constitute misconduct.

As noted, *supra*, by affixing her clients’ electronic signatures to trademark documents, Respondent violated the Rules of Practice, which requires that signatories personally sign trademark documents. In addition, Respondent’s practice of filing trademark documents prepared by unauthorized foreign attorneys is inconsistent with the standard set forth by the Rules of Practice, which allows only authorized persons to practice before the Office in trademark matters. Such conduct is therefore considered disreputable because it does not comply with the practices and procedures outlined by the USPTO.

The Court also finds that Respondent engaged in disreputable conduct by continuing to act as domestic correspondent after being excluded from doing so by the Commissioner. Respondent knew she had been excluded, but attempted to conceal the fact that she was involved with the prosecution of the trademark applications by changing the addresses on the Change of Correspondence Address forms and continuing to use an e-mail address that had not yet been discovered by the USPTO as belonging to Respondent. Respondents conduct deliberately defied the Exclusion Order and is therefore disreputable. Accordingly, the Court finds Respondent engaged in disreputable conduct in violation of 37 C.F.R. § 10.23(a).

B. Respondent’s misconduct involved deceit and misrepresentations made to the USPTO.

The OED Director claims Respondent’s misconduct involves dishonesty, fraud, deceit, or misrepresentation in violation of the USPTO Code of Professional Responsibility and Rules of Professional Conduct.

Practitioners shall not engage 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 forgery of a person’s signature constitutes an act of deceit. 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, 2014-Ohio-5487, ¶ 3 (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); see also In re Lane, Proceeding No. D2013-07, at 14 (deceit is dishonest behavior or behavior that is meant to fool or trick someone.).

A misrepresentation is the act of making a false or misleading assertion about something, usually with the intent to deceive, and includes not just written or spoken words but also any other conduct that amounts to a false assertion. Lane, at 14 (citing *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). Giving false or misleading information to the Office or any employee of the Office constitutes misconduct. 37 C.F.R. § 10.23(c)(2)(ii).

In Uchendu, an attorney admitted to signing his clients’ names onto probate documents that required verification. The attorney claimed that he had his clients’ permission to verify the documents on his clients’ behalf, and the attorney presented affidavits of his clients asserting that he had their permission to sign for them. The attorney also testified that he did not know his conduct was improper. The court in Uchendu noted that the attorney could not sign verifications as an agent of his clients, because the verifications, by statute, had to be “personally made.” In the instances where the attorney signed clients’ names without indicating that the clients were not the actual signatories, the court found the attorney made false representations to the court.

Here, Respondent entered the signatures of applicants into several trademark applications and other documents ancillary to the trademark registration proceedings. Respondent did not make any indication that the electronic signatures were entered by anyone other than the purported signatories. And, even if the applicants had personally signed some version of these documents at some point in time, most of the documents actually filed were signed by Respondent. By filing these documents with the USPTO, Respondent was falsely representing that they bore the applicants’ actual signatures. Such conduct is deceitful and misled the examining trademark attorneys into believing that the applicants personally entered their signatures onto these documents.

Respondent also engaged in deceitful conduct by preparing Change of Correspondence Address forms that purported to remove Respondent as the domestic correspondent. Although Respondent had changed the mailing address, she continued to provide an e-mail address that the USPTO had not yet attributed to her. This was done with the intent to conceal the fact that Respondent was continuing to act as a domestic correspondent despite being excluded from doing so by the Commissioner.

Lastly, Respondent 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 for “authorized signature.” Such an assertion is false because a Change of Correspondence Address must be signed by the applicant, someone with legal authority to bind the applicant, or a practitioner qualified to practice before the Office in trademark matters. Respondent was none of these. Accordingly, the Court finds Respondent’s conduct involved deceit and misrepresentations in violation of 37 C.F.R. § 10.23(b)(4) and 37 C.F.R. § 11.804(c). Respondent’s conduct also violates 37 C.F.R. § 10.23(c)(2)(ii) because these false representations were knowingly made to the Office or to an employee of the Office.

C. Respondent failed to correct the misrepresentations she made to the Office.

The OED Director alleges Respondent's misrepresentations to the Office also constitute a violation under 37 C.F.R. § 11.303(a)(1), because Respondent did not correct the false representations previously made to the Office.

Practitioners shall not knowingly make 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). The term "knowingly" means actual knowledge of the fact in question, and a person's knowledge may be inferred from the circumstances. 37 C.F.R. § 11.1. The intent to deceive is not required. Comm. on Prof'l Ethics & Conduct of the Iowa State Bar Ass'n v. Wunschel, 461 N.W.2d 840, 847 (Iowa 1990) ("Even absent an intent to deceive, an attorney's failure to recognize and correct potentially misleading situations is unethical.")

As noted, Respondent made misrepresentations to the Office. The Commissioner's Exclusion Order, dated February 21, 2013, explained to Respondent that electronically signing an applicant's name onto trademark documents is inappropriate. Respondent understood this, as evidenced by the fact that Respondent later filed Statements of Use using the HSign-on method. However, Respondent made no attempt to correct her prior misrepresentations related to the trademark documents cited in this matter. Respondent's failure to correct these false representations to the Office violates 37 C.F.R. § 11.303(a)(1). See also In re Fuller, 586 P.2d 1111, 1111 (Or. 1978) ("We hasten to add that the ethical difference between active misrepresentation and failure to correct a false impression that one has given is of little import. Either act on accused's part is deceitful.")

D. Respondent handled legal matters she should have known she was not competent to handle.

The OED Director alleges that by engaging in unauthorized practice before the Office in trademark matters, Respondent handled matters that she was not competent to handle, in violation of 37 C.F.R. § 10.77(a). The Code of Professional Conduct prohibits practitioners from handling a legal matter that the practitioner knows or should know the practitioner is not competent to handle, without associating with another practitioner who is competent to handle it. 37 C.F.R. § 10.77(a). This 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. Reibman v. Senie, 302 A.D.2d 290, 291 (N.Y. App. Div. 2003); Attorney Grievance Comm'n of Maryland 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).

Respondent agreed to act as domestic representative to file documents with the Office on behalf of foreign applicants. In so doing, Respondent was required to educate herself on the proper method for filing electronically on TEAS. Namely, Respondent should have recognized the distinctions between the different signature options and how to file a trademark document

with the appropriate signature. Such information could be found in the Rules of Practice, the Trademark Manual, or by simply reviewing the “help” section on the form that explains the three different signature approaches and how they are intended to be used. However, rather than undertake such an endeavor, Respondent simply assumed it was appropriate for her to forge the signatures she believed TEAS had inadvertently removed.¹² Respondent’s failure to educate herself on the Rules of Practice and the signature requirements of TEAS resulted in improperly signed trademark applications and their related documents. Accordingly, the Court finds Respondent handled legal matters that she was not competent to handle.

E. Respondent aided others in the unauthorized practice of law.

The OED Director also claims that by engaging in the unauthorized practice before the Office in trademark matters, and by aiding foreign attorneys in doing the same before the Office, Respondent violated the USPTO Rules of Professional Conduct proscribing the unauthorized practice of law.

Practitioners may not practice law in a jurisdiction in violation of the rules of the legal profession in that jurisdiction, or assist another in doing so.¹³ 37 C.F.R. § 11.505; See In re Kenneth Paul Campbell, 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).

Determining whether conduct constitutes aiding another in the unauthorized practice of law requires a two-step analysis. Comm. on Prof’l Ethics & Conduct of the Iowa State Bar Ass’n v. Baker, 492 N.W.2d 695, 701 (Iowa 1992). First, the Court must determine whether actions taken by the foreign attorneys constitute unauthorized practice in trademark matters before the Office. Id.; but see Wayne Cty. Bar Ass’n. v. Naumoff, 660 N.E.2d 1177, 1178 (Ohio 1996) (noting that this step does not require a separate adjudication). Second the Court must determine whether Respondent aided in those actions. Id. Generally, the preparation of legal documents constitutes the practice of law. Geauga Cty. Bar Ass’n. v. Haig, 955 N.E.2d 352 (Ohio 2011); but see Real Estate Bar Ass’n for Massachusetts, Inc. v. Nat’l Real Estate Info. Servs., 946 N.E.2d 665, 678 (Mass. 2011) (“Whether [drafting or preparing documents with legal implications] constitute the practice of law depends to some degree on the type of document, whether legal rights and obligations are being established, whether the document involves providing legal advice or a legal opinion, and whether the document is tailored to address a client’s individual legal needs.”)

¹² It is particularly concerning that Respondent did not verify that the applicants had actually signed the trademark applications before they were transmitted to Respondent. There is no evidence in the record that Respondent ever corresponded with the applicants. Rather, Respondent relied on secondhand assurances that the applicants had signed the applications prior to transmission.

¹³ The USPTO is considered a jurisdiction for the purposes of this rule. CHANGES TO REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE, 78 FR 20180-01; see also In Re Discipline of Peirce, 128 P.3d 443, 444 (2006) (“We therefore conclude that “another jurisdiction” includes the USPTO. The professional conduct rules are similar, so that what constitutes misconduct before the USPTO is misconduct in Nevada.”).

Respondent filed Statements of Use for the '340 application and the '531 application. The documents were prepared by foreign attorneys and sent to Respondent for filing. As noted, *supra*, the foreign attorneys who prepared these documents engaged in the unauthorized practice of law before the Office in trademark matters. Respondent knew or should have known that such attorneys were not authorized to do so pursuant to USPTO regulations. By accepting these documents from the foreign attorneys and filing them with the USPTO, Respondent aided the foreign attorneys in the unauthorized practice of law before the Office, in violation of 37 C.F.R. § 11.505.

Although the Court finds Respondent violated 37 C.F.R. § 11.505 by aiding foreign attorneys, the Court does not find Respondent's practice of filing Statements of Use, or completing, signing, and filing Change of Correspondence forms constitute the unauthorized practice of law.¹⁴ When filing the Statements of Use, Respondent attached a .pdf of the applicant's handwritten signature to each document. Respondent's act of merely filing the Statements of Use with the USPTO, without more, is insufficient to constitute the unauthorized practice of law, because the Rules of Practice authorize non-attorneys to file and receive correspondence between the USPTO and applicants. As to the Change of Correspondence Address forms, the Court reaches a similar conclusion because these forms do not have any legal implications. Although it was improper for Respondent to sign such forms, doing so does not constitute the practice of law. *See In re Peel*, 725 F.3d 696, 700 (7th Cir. 2013) (finding that merely signing and filing a document does not require legal knowledge or skill and is therefore not the unauthorized practice of law); *Drew v. Unauthorized Practice of Law Comm.*, 970 S.W.2d 152, 156 (Tex. App. 1998) (Court noting that while a state's habeas corpus statute allows a non-attorney to sign and present a habeas petition, the state's restrictions against the unauthorized practice of law still require an attorney to draft the documents and appear in court on behalf of another.) Accordingly, although the Court finds Respondent did not personally engage in the unauthorized practice of law, Respondent still violated the USPTO Rules of Professional Conduct by aiding foreign attorneys in the unauthorized practice of law.

F. Respondent's misconduct was prejudicial to the administration of justice.

The OED Director claims Respondent's misconduct is prejudicial to the administration of justice in violation of the USPTO disciplinary rules. *See* 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 Am. Exp. 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

¹⁴ The Court draws a distinction between the Respondent's conduct occurring before and after May 3, 2013, because the OED Director has only alleged an unauthorized practice of law violation under the Rules of Professional Conduct, which became effective on that date.

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.”); Iowa Supreme Court Attorney Disciplinary Bd. v. Liles, 808 N.W.2d 203, 206 (Iowa 2012) (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.).

As found above, Respondent aided foreign attorneys in the unauthorized practice of law before the Office. Respondent also forged the signatures of trademark applicants onto documents submitted to the USPTO. After being excluded from acting as a domestic representative by the Commissioner, Respondent knowingly violated the Exclusion Order by continuing to send and receive correspondence on behalf of the applicants. Such conduct is prejudicial to the administration of justice and violates the USPTO disciplinary rules.

G. Respondent did not make false or misleading communications about herself or her services.

The OED Director also claims Respondent represented to foreign local services that she was authorized to represent others in trademark matters before the Office and that she actually undertook such representation. The USPTO Rules of Professional Conduct prohibit practitioners from making false or misleading communications about themselves or their services. 37 C.F.R. § 11.701.

The record of this proceeding does not support a finding that Respondent violated 37 C.F.R. § 11.701 by making false or misleading communications to foreign local services. No evidence was proffered to demonstrate Respondent suggested to the foreign attorneys that she was authorized to practice before the Office in trademark matters. At the very least, it is reasonable to find that Respondent represented to foreign attorneys that she could act as a domestic representative or correspondent. Further, there is evidence that after Respondent was excluded from acting as a domestic correspondent, the foreign attorneys were aware of that fact but proceeded to pay Respondent for her services anyway. Accordingly, the Court finds the OED Director failed to prove this violation with clear and convincing evidence.

H. Respondent did not engage in any other activity that adversely reflects on her fitness to practice before the Office.

The OED Director claims Respondent violated the Code of Professional Responsibility by otherwise engaging in acts and omissions that do not constitute violations of the preceding regulations. A practitioner shall not “[e]ngage in any other conduct that adversely reflects on the practitioner’s fitness to practice before the Office.” (emphasis added) 37 C.F.R. § 10.23(b)(6). This subsection of the regulation is essentially a “catch all” provision regulating conduct that does not fall under the subsections immediately preceding it. Therefore, by the language of the subsection, if the alleged conduct is found to violate any provision of § 10.23(b)(1) through

(b)(5), it cannot also violate § 10.23(b)(6). In re Lane, No. D2013-07, at 16; In re Kelber, No. 2006-13 at 59 (USPTO Sept. 23, 2008).

The OED Director has not specifically cited conduct that is applicable to this violation. As the Court finds Respondent's misconduct violates the disciplinary rules previously cited, the Court concludes that the OED Director has not demonstrated Respondent engaged in any *other* conduct that adversely reflects on her fitness to practice before the Office.

III. Respondent's Affirmative Defenses

Respondent raises numerous defenses in response to the allegations contained in the *Amended Complaint*. Specifically, Respondent claims (A) her constitutional rights have been violated; (B) there is no jurisdiction for this disciplinary action; and (C) the OED Director failed to follow procedural requirements in instituting this disciplinary proceeding.

In a disciplinary proceeding, Respondent has the burden of proving any affirmative defense by clear and convincing evidence. 37 C.F.R. § 11.49. Such defenses must be stated affirmatively in the *Answer*, wherein Respondent must draw a nexus between the defense and the misconduct, and the reason it provides a defense or mitigation. 37 C.F.R. § 11.36(c). Although, generally, a respondent may not rely on a defense that was not raised in the respondent's answer, the Court may, for good cause, allow a respondent to file the statement late. Id.

A. Respondent's Constitutional Arguments

Respondent raises several claims that this proceeding should be dismissed on constitutional grounds.

1. Due Process Clause

Respondent claims the *Amended Complaint* violates the Fifth Amendment's Due Process Clause because it seeks to deprive her of her "liberty to represent others in patent, trademark, and other matters" without notice. Respondent claims she has engaged in the same alleged misconduct since 2006 but was never told that she was doing anything wrong.

The Fifth Amendment states that "No person shall be . . . deprived of life, liberty, or property, without due process of law." U.S. CONST. AMEND. V. The "root requirement" of the Due Process Clause is that an individual be given an opportunity to be heard before she is deprived of any significant property interest. See Fuentes v. Shevin, 407 U.S. 67, 82 (1972); Boddie v. Connecticut, 401 U.S. 371, 379 (1971); Armstrong v. Manzo, 380 U.S. 545, 552 (1965) (the fundamental requirement of due process is the opportunity to be heard "at a meaningful time and in a meaningful manner").

The *Amended Complaint* included an extensive recitation of the alleged facts that the OED Director believed supported his decision to institute the disciplinary proceeding at bar. The *Amended Complaint* also outlined the disciplinary rules that Respondent is alleged to have violated. At the hearing, Respondent acknowledged that she understood what the *Amended*

Complaint was and the allegations contained therein. Although the Court suggested Respondent obtain counsel to represent her at the hearing, Respondent insisted on proceeding *pro se*. Respondent actively participated in the hearing and provided several exhibits in support of her position. Accordingly, Respondent has not demonstrated a deprivation of due process.

The Court also finds Respondent's claim that she was not notified of her misconduct until 2012 is insufficient to demonstrate a deprivation of due process. As noted, *supra*, Respondent is responsible for knowing and understanding the regulations governing signatures and the filing of documents with the USPTO if she is providing such services. Moreover, the fact that Respondent forged the applicants' signatures onto the documents, rather than indicate that she was signing on behalf of the applicants, directly contributed to the delay in the USPTO discovering the misconduct. At the hearing, Respondent elicited the following testimony from Ms. Amos:

Q. If you accepted the document with a signature and we don't receive any communication or correspondence from you telling us that the signature is improper, do you—does it mean that the signatory, either the electronic signature or the handwritten signature, is not doing anything illegal?

A. If on its fact the electronic signature or the handwritten signature appears proper under our rule, we would not question it any further so that if the applicant's name appeared between the slashes on—in an electronic signature, we would have no reason to inquire any further.

Based upon the foregoing, the Court finds Respondent has not met her burden to prove this affirmative defense.

2. Contract Clause

Respondent also claims that implementation of the USPTO rules violates her right to contract with clients without government restriction, which Respondent claims is constitutionally protected by Article I of the U.S. Constitution.

Article I of the U.S. Constitution states that “no state shall . . . pass any . . . Law impairing the Obligation of Contracts.” U.S. Const. art. I, § 10, cl. 1. In determining whether the Contract Clause affords a litigant protection from state legislation, a court considers (1) whether a contractual relationship exists; (2) whether a change in law impairs that contractual relationship; and (3) whether the impairment is substantial. Gen. Motors Corp. v. Romein, 503 U.S. 181, 186 (1992).

However, the Court need not undertake these inquiries here because the Contract Clause applies to state legislation and not to the federal government. Pueblo of Santa Ana v. Kelly, 932 F. Supp. 1284, 1297 (D.N.M. 1996) *aff'd*, 104 F.3d 1546 (10th Cir. 1997) *cert denied*, 522 U.S. 807 (1997). Even assuming, *arguendo*, that the Contract Clause is implicated here, Respondent has not produced any evidence of the contracts she and her clients entered into. This is material

to the Court's determination as the contracts must be executed prior to the enactment of the legislation that purportedly impairs it. See Fabri v. United Technologies Int'l, Inc., 387 F.3d 109, 124 (2d Cir. 2004) (noting that the Contract Clause prohibits the impairment by a state of *existing* contracts). Without evidence of the contracts and their terms, the Court is also unable to determine how, if at all, the contracts have been impaired by the USPTO's regulations. Accordingly, the Court finds Respondent has not met her burden to prove this affirmative defense.

3. Selective Enforcement

Respondent claims she is being denied equal protection under the Fourteenth Amendment because she is being treated differently than similarly situated parties. In other words, Respondent alleges that the OED Director has ignored the similar conduct of other foreign e-filers while "meticulously" reviewing Respondent's conduct.

The federal government has the "broad discretion" to enforce the law. United States v. Armstrong, 517 U.S. 456, 463-64 (1996). Thus, a "presumption of regularity supports their prosecutorial decisions and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties." Id. (citing United States v. Chemical Foundation, Inc., 272 U.S. 1, 14-15 (1923)). In order to prevail in a selective enforcement claim, Respondent must demonstrate that (1) she has been singled out while other similarly situated violators were left untouched; and (2) that the OED Director elected to pursue this disciplinary action against Respondent "invidious[ly] or in bad faith, i.e., based upon such impermissible considerations as race, religion, or the desire to prevent the exercise of [their] constitutional rights." United States v. Smithfield Foods, Inc., 969 F. Supp. 975, 985 (E.D. Va. 1997). "Evidence of mere selectivity, without more, cannot sustain a claim of selective prosecution." United States v. Hendrickson, 664 F. Supp. 2d 793, 798 (E.D. Mich. 2009).

At the hearing, Respondent identified certain individuals whom she alleges also e-signed trademark documents on behalf of applicants despite not being attorneys or appropriately authorized signatories.

Jaye Huang is only an authorized correspondent, and . . . he E-signed for Yunsheng Tianen; however, he didn't have to provide the evidence to show the authorization . . . While my authorization is from the attorney in Taiwan and in China, so I don't know why I did everything legal and I have to sit here and Jaye Huang doesn't have to sit here.

Respondent also identified additional individuals and the documents they submitted to the USPTO that Respondent claims were inappropriately signed, but nevertheless accepted by the USPTO, as Respondent's filings were.

However, that is the extent of Respondent's evidence. Respondent's submissions are, therefore, insufficient to support a selective enforcement claim. While Respondent purports to identify several individuals whose conduct similarly violates the USPTO disciplinary rules,

Respondent has not demonstrated that such individuals have avoided discipline or even an investigation. Simply because they were not parties to the same disciplinary proceeding does not mean that the OED Director has not investigated or instituted disciplinary proceedings against them. And, even if such individuals were “left untouched,” Respondent has not proven, by clear and convincing evidence, that the OED Director has pursued disciplinary action against Respondent based upon an impermissible purpose. After all,

[t]here is no right under the Constitution to have the law go unenforced against you, even if you are the first person against whom it is enforced, and even if you think (or can prove) that you are not as culpable as some others who have gone unpunished. The law does not need to be enforced everywhere to be legitimately enforced somewhere; and prosecutors have broad discretion in deciding whom to prosecute.

Futernick v. Sumpter Twp., 78 F.3d 1051, 1056 (6th Cir. 1996).

Accordingly, the Court finds Respondent’s selective enforcement claim has not been sufficiently proven.

B. Lack of Jurisdiction

Respondent also claims that there is no jurisdiction for this disciplinary proceeding because Respondent’s alleged misconduct does not constitute grounds for discipline under 37 C.F.R. § 11.19(b).

All practitioners engaged in practice before the Office are subject to the disciplinary jurisdiction of the Office. 37 C.F.R. § 11.19(a); see also Chambers v. NASCO, Inc., 501 U.S. 32, 43, (1991) (stating that the power to control admission to its bar and to discipline attorneys who appear before it is incidental to all courts). The violation of any USPTO disciplinary rule constitutes a ground for discipline. 37 C.F.R. § 11.19(b)(1)(iv).

Respondent acknowledges she is a registered patent agent with the USPTO. She is therefore subject to the disciplinary jurisdiction of the Office. Moreover, the Court has found that Respondent has violated a number of USPTO disciplinary rules. These violations constitute grounds for discipline. Accordingly, the Court finds that Respondent’s lack of jurisdiction claim is without merit.

C. Respondent’s claim regarding the OED Director’s procedural violations.

Respondent also raises a number of claims related to the OED’s investigation and the OED Director’s institution of this disciplinary proceeding. Specifically, Respondent claims the OED’s investigation of her alleged misconduct does not comply with 37 C.F.R. § 11.22 and that the OED Director violated the procedures of 37 C.F.R. § 11.32. In support of her argument, Respondent cites to statements by counsel for the OED Director suggesting that OED did not request authorization documents from Respondent until the hearing.

The OED Director is authorized to investigate possible grounds for discipline against a practitioner. 37 C.F.R. § 11.22(a). The OED Director is required to notify the practitioner in writing of the initiation of an investigation into whether a practitioner has engaged in conduct constituting possible grounds for discipline. *Id.* at § 11.22(e). The OED Director may request information and evidence regarding possible grounds for discipline from the practitioner. *Id.* at § 11.22(f).

At the hearing, Respondent consistently testified that she had not previously provided the Powers of Attorney documents because the OED Director did not ask for the documents. There is no regulatory requirement that the OED Director request specific documents from a practitioner alleged to have violated the disciplinary rules. Moreover, even if the OED Director had requested such documentation, it is unclear whether Respondent would have produced it. At the hearing, the following exchange took place between counsel for the OED Director and Respondent:

Q. Did you provide OED with any [documents proving Respondent’s relationship with the applicant]?

A. I – I didn’t dare, because he said I [revealed] client’s information – confidential information.

Respondent also testified that she “pleaded the Fifth Amendment” in response to the OED’s request. Accordingly, the Court finds Respondent’s argument to be unpersuasive. The OED Director’s investigation could not have included documents the OED did not know were in existence, or that Respondent refused to submit. Accordingly, the Court finds this argument to be without merit.

Sanctions

The OED Director requests that the Court sanction Respondent by entering an order that excludes Respondent from practice before the Office. Before sanctioning a practitioner, the Court must consider 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. Respondent violated her duties to the clients, the legal system, and the legal profession.

Respondent violated her duties to her clients and the legal profession.¹⁵ Respondent was obligated to serve her clients competently by learning and understanding the requirements for submitting trademark documents to the USPTO via TEAS. Respondent did not do so. Respondent also failed to maintain the integrity and competence of the legal profession by engaging in disreputable conduct, engaging in deceitful conduct, making false and misleading representations to the Office, and by aiding others in the unauthorized practice of law. Accordingly, this factor warrants a maximum sanction. United States v. Johnson, 327 F.3d 554, 560 (7th Cir. 2003) (“The unauthorized practice of law poses a serious threat to the integrity of the legal profession.”); State ex rel. Oklahoma Bar Ass’n v. Pacenza, 2006 OK 23, ¶ 33 (“Honesty and integrity are the cornerstones of the legal profession. Nothing reflects more negatively upon the profession than deceit.”).

2. Respondent acted knowingly and intentionally.

Respondent acted knowingly by submitting trademark documents that Respondent knew were not signed by the applicants. Respondent also knowingly aided others in the unauthorized practice of law by filing trademark documents she knew were prepared by foreign attorneys who were not recognized to practice before the Office.

The Court also finds that Respondent acted intentionally by continuing to serve as domestic representative despite being excluded by the Commissioner. Respondent understood that she had been excluded, but continued to act as a domestic representative and actively concealed that fact from the USPTO. Such conduct is especially egregious and demonstrates a lack of respect for the Commissioner’s authority to manage and direct all aspects of the USPTO that affect the administration of trademark operations. Accordingly, the Court finds this factor warrants a maximum sanction. See In re Cofield, 26 So. 3d 729, 733 (La. 2010), (“Disbarment is generally appropriate when ... a lawyer engages in any other intentional conduct involving dishonesty, fraud, deceit, or misrepresentation that seriously adversely reflects on the lawyer’s fitness to practice.”).

3. The potential injury caused by Respondent’s misconduct is significant.

The OED Director has not proffered evidence of any actual injury caused by Respondent’s misconduct. However, evidence in the record suggests Respondent’s misconduct could cause significant injury to the applicants of the trademark applications cited above. Trademark registrations that have not been appropriately verified may be subject to cancellation. Here, Respondent inappropriately verified the facts of the trademark applications in question. Accordingly, the factor supports a moderate sanction.

¹⁵ The Court’s reference to the “legal profession” pertains to the profession of being a practitioner appearing before the Office.

4. Aggravating and mitigating factors exist in this case.

The Court often looks to the ABA's Standards for Imposing Lawyer Sanctions ("ABA Standards") when determining whether aggravating or mitigating factors exist. See In re Chae, Proceeding No. D2013-01, at 4 (USPTO Oct. 21, 2013). A review of the record reveals that aggravating factors, and one mitigating factor exist in this case.

Respondent has not proffered evidence supporting any mitigating factors. However, the OED Director stipulates that Respondent has been admitted to the patent bar for nine years and has no prior disciplinary record. Accordingly, the Court finds Respondent's lack of a disciplinary record serves as a mitigating factor.

Respondent acted with a dishonest motive, which is an aggravating factor under the ABA Standards. Specifically, Respondent intentionally concealed the fact that she continued to serve as domestic representative by filing Change of Correspondence Address forms that purported to change the mailing address, while maintaining an e-mail address belonging to Respondent. Accordingly, the Court finds this aggravating factor to be present.

The Court also finds that Respondent engaged in a pattern of misconduct, which is also an aggravating factor under the ABA Standards. The Commissioner's Exclusion Order references more than 230 trademark applications or registrations with which Respondent has been involved. During the hearing, Respondent offered testimony suggesting she had been entering the electronic signatures of applicants onto trademark documents transmitted by foreign attorneys since 2006. While it is unclear the extent of Respondent's misconduct as to the applications cited in the Commissioner's Exclusion Order, the Court is persuaded that Respondent has been engaged in this pattern of misconduct for an extensive period of time.

In addition, Respondent has refused to acknowledge that her actions constitute misconduct. Rather than take responsibility, Respondent has blamed foreign attorneys for directing her to engage in said misconduct, and even blamed the OED for not investigating others for engaging in similar conduct and for not taking steps to correct her misconduct sooner. Respondent also accuses the USPTO trademark examining attorneys of aiding in the unauthorized practice law despite the fact that it was Respondent's own misleading actions that caused the USPTO to accept her filings and to continue corresponding with the applicants through Respondent. Respondent, as a practitioner before the Office, and having agreed to provide services to foreign applicants, must understand the relevant rules and appropriate practices.

Respondent's dishonest motive, extensive pattern of misconduct, and outright refusal to acknowledge her misconduct further supports the imposition of the maximum sanction.

Conclusion

Based upon the foregoing, the Court finds Respondent electronically entered the signature of trademark applicants onto the applications cited above and on numerous documents supporting said applications. She then filed these documents with the USPTO. Her practice of

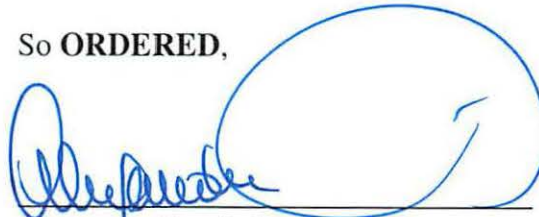
signing the applicants' names, without identifying that someone other than the signatory had signed the document, was misleading. In addition, Respondent concealed the fact that she was continuing to serve as domestic representative despite being excluded by the Commissioner. Respondent's actions effectively aided foreign attorneys in the unauthorized practice of trademark law before the Office. Accordingly, Respondent's actions constitute violations of the USPTO disciplinary rules as cited above.

ORDER

The Court considers Respondent's numerous violations of the USPTO disciplinary rules and the factors set forth by 37 C.F.R. § 11.54(b). Accordingly, the Court finds the record supports an order excluding Respondent from practice before the Office in patent, trademark, and other non-patent matters.

It is therefore **ORDERED** that Respondent is excluded from practice before the Office in patent, trademark, and other non-patent matters. Respondent is directed to 37 C.F.R. § 11.58 regarding responsibilities in cases of suspension or exclusion, and 37 C.F.R. § 11.60 concerning petitions for reinstatement.

So **ORDERED**,



Alexander Fernández
Administrative Law Judge

Notice of Appeal Rights: Within thirty (30) days of this initial decision, either party may file an appeal to the USPTO Director. 37 C.F.R. § 11.55(a).

CERTIFICATE OF SERVICE

I hereby certify that copies of this **INITIAL DECISION AND ORDER**, Issued by Alexander Fernández, Administrative Law Judge in D2014-31, were sent to the following parties on this 22nd day of April, 2015, in the manner indicated:


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