

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

In the Matter of)
Joseph C. Terzo,) Proceeding No. D2016-35
Respondent)
_____)

FINAL ORDER

Pursuant to 37 C.F.R. § 11.27(b), the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) received for review and approval from the Director of the Office of Enrollment and Discipline (“OED Director”) an Affidavit of Resignation Pursuant to 37 C.F.R. § 11.27 executed by Joseph C. Terzo (“Respondent”) on October 27, 2016. Respondent submitted the three-page Affidavit of Resignation to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

For the reasons set forth herein, Respondent’s Affidavit of Resignation shall be approved, and Respondent shall be excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order.

Jurisdiction

Joseph C. Terzo of Collegeville, Pennsylvania, is a registered patent attorney (Registration No. 60,534). Respondent is subject to the USPTO Code of Professional Responsibility, 37 C.F.R. § 10.20 *et seq.*, and the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*¹

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

Pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. § 11.27, the USPTO Director has the authority to approve Respondent's Affidavit of Resignation and to exclude Respondent on consent from the practice of patent, trademark, and other non-patent law before the Office.

Respondent's Affidavit of Resignation

Respondent acknowledges in his October 27, 2016 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered, and he is not being subjected to coercion or duress.
2. He is aware that there is a disciplinary complaint pending against him (Proceeding No. D2016-35) which alleges that:
 - a. Respondent became a member of IP Law Group P.C. ("IP Law") on or about April 21, 2015, by entering into a partnership agreement with Andrew Alia. He became owner of 8,000 shares, initially holding 92,000 shares in trust. Respondent was aware that Mr. Alia was suspended from the practice of law in Pennsylvania on a temporary emergency basis on April 17, 2015.
 - b. Respondent took over representation of Mr. Alia's clients and neither informed those same clients that he was their new attorney, nor did he inform them that Mr. Alia was no longer available to be their attorney. Respondent did not obtain the clients' signatures for Revocation of Attorney forms filed with the Office in trademark applications, and instead he signed and filed the forms himself. He also did not communicate directly with clients regarding their trademark applications. Respondent relied upon a "Trademark Questionnaire" to obtain information from clients regarding their trademark applications and did not determine the accuracy of the information set forth in the questionnaire. He did not communicate with his trademark clients before filing their applications which included not explaining trademark legal concepts to them.
 - c. Respondent aided his non-lawyer assistants in the unauthorized practice of trademark law by directing them to provide legal advice and legal services to his clients. Respondent had one paralegal that lived and worked in San Diego, while Respondent lived and worked in Philadelphia. Respondent directed this paralegal to prepare, sign his name, and file trademark applications with the Office without his direct supervision. Additionally, Respondent allowed this paralegal to approve Examiner's Amendments for his clients' trademark applications. Further, he directed his non-lawyer assistants to provide patent advice and legal services to clients.

- d. Respondent attempted to limit his liability to a client for malpractice when the client was not independently represented in making the agreement.
- e. Respondent required his clients to pay in advance for their trademark legal services. He deposited the trademark clients' entire pre-paid fees and expenses into his operating account before the fees were earned and expenses incurred.
- f. Respondent did not cooperate with OED's investigation of him. He provided false information to OED and also did not produce documents that were requested.

3. He is aware that the disciplinary complaint filed against him alleges that he violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. § 11.101 (failure to provide competent representation); 37 C.F.R. § 11.104(a)(3) (failing to keep the clients reasonably informed about the status of a matter); 37 C.F.R. § 11.104(b) (failure to explain a matter to the extent reasonably necessary to permit the clients to make informed decisions regarding the representation); 37 C.F.R. § 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit or misrepresentation); 37 C.F.R. § 11.804(d) (engaging in conduct that is prejudicial to the administration of justice); 37 C.F.R. § 11.804(i) (engaging in the acts and omissions that adversely reflect on Respondent's fitness to practice before the Office); 37 C.F.R. § 11.503 (failing to make reasonable efforts as a partner in a law firm to ensure that the firm has in effect measures giving reasonable assurance that the non-attorney assistants' conduct is compatible with the professional obligations of the practitioner); 37 C.F.R. § 11.505 (aiding in the unauthorized practice of law); 37 C.F.R. § 11.108(h) (making an agreement prospectively limiting the practitioner's liability to clients for malpractice when the clients were not independently represented in making the agreement); 37 C.F.R. § 11.115(c) (failing to deposit into a client trust account legal fees and expenses that have been paid in advance, to be

withdrawn by the practitioner only as fees are earned or expenses incurred); and 37 C.F.R. § 11.801(b) (failing to cooperate with the Office of Enrollment and Discipline in an investigation).

4. Without admitting that he violated any of the Disciplinary Rules of the USPTO Code of Professional Responsibility and/or the USPTO Rules of Professional Conduct which are the subject of the disciplinary complaint in Proceeding No. D2016-35, he acknowledges that, if and when he applies for reinstatement to practice before the USPTO in patent, trademark, and/or other non-patent matters under 37 C.F.R. § 11.60, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that (a) the allegations regarding him in the complaint filed in Proceeding No. D2016-35 are true and (b) he could not have successfully defended himself against such allegations.

5. He has fully read and understands 37 C.F.R. §§ 11.5(b), 11.27, 11.58, 11.59, and 11.60, and is fully aware of the legal and factual consequences of consenting to exclusion from practice before the USPTO in patent, trademark, and other non-patent matters.

6. He consents to being excluded from practice before the USPTO in patent, trademark, and other non-patent matters.

Exclusion on Consent

Based on the foregoing, the USPTO Director has determined that Respondent's Affidavit of Resignation complies with the requirements of 37 C.F.R. § 11.27(a). Accordingly, it is hereby ORDERED that:

1. Respondent's Affidavit of Resignation shall be, and hereby is, approved;
2. Respondent shall be, and hereby is, excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order;

3. The OED Director shall electronically publish the Final Order at the Office of Enrollment and Discipline's electronic FOIA Reading Room, which is publicly accessible at <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

4. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Exclusion on Consent

This notice concerns Joseph C. Terzo, a registered patent attorney (Registration No. 60,534). The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has accepted Joseph C. Terzo's affidavit of resignation and ordered his exclusion on consent from practice before the Office in patent, trademark, and non-patent law.

Joseph C. Terzo voluntarily submitted his affidavit at a time when a disciplinary complaint was pending against him. The complaint alleged that Mr. Terzo became a member of IP Law Group P.C. on or about April 21, 2015, by entering into a partnership agreement with Andrew Alia an attorney licensed in Pennsylvania. At the time, Mr. Terzo was aware that Mr. Alia was suspended from the practice of law on an emergency basis on April 17, 2015. Mr. Terzo took over the representation of Mr. Alia's clients and neither informed those clients that he was their new attorney, nor did he inform them that Mr. Alia was no longer available to be their attorney. He relied upon a Trademark Questionnaire to obtain clients' information for their trademark applications without determining the accuracy of the information. He did not consult with or counsel his clients before filing their trademark applications. He aided his non-lawyer assistants in the unauthorized practice of both patent and trademark law by directing them to provide the clients with legal advice and legal services. In particular he directed one paralegal to prepare, sign his name, and file trademark applications with the Office without his direct supervision. He attempted to limit his liability in malpractice when the client was not independently represented. He deposited prepaid fees and expenses not yet earned and expenses not yet incurred into an operating account. He also did not cooperate with OED's investigation.

Joseph C. Terzo acknowledged the complaint alleged that his conduct violated these provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. §§ 11.101 (failure to provide competent representation); 11.104(a)(3) (failing to keep the clients reasonably informed about the status of a matter); 11.104(b) (failure to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation); 11.804(c) (engaging in conduct involving dishonesty, fraud,

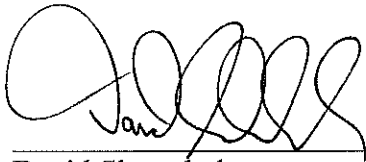
deceit or misrepresentation); 11.804(d) (engaging in conduct that is prejudicial to the administration of justice); 11.804(i) (engaging in the acts and omissions that adversely reflect on Respondent's fitness to practice before the Office); 11.503 (failing to make reasonable efforts as a partner in a law firm to ensure that the firm has in effect measures giving reasonable assurance that the non-attorney assistants' conduct is compatible with the professional obligations of the practitioner); 11.505 (aiding in the unauthorized practice of law); 11.108(h) (making an agreement prospectively limiting the practitioner's liability to clients for malpractice when the clients were not independently represented in making the agreement); 11.115(c) (failing to deposit into a client trust account legal fees and expenses that have been paid in advance, to be withdrawn by the practitioner only as fees are earned or expenses incurred); and 11.801(b) (failing to cooperate with the Office of Enrollment and Discipline in an investigation).

While Joseph C. Terzo did not admit to violating any of the Disciplinary Rules of the USPTO Code of Professional Responsibility or the USPTO Rules of Professional Conduct as alleged in the pending complaint, he acknowledged that, if and when he applies for reinstatement, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that (i) the allegations set forth in the OED investigation against him are true and (ii) he could not have successfully defended himself against such allegations.

This action is taken pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.27 and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

5. Respondent shall comply fully with 37 C.F.R. § 11.58; and
6. Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.

[Signature page follows]



David Shewchuk
Deputy General Counsel for General Law
United States Patent and Trademark Office

11/2/16

Date

on behalf of

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

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

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