

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

In the Matter of)	
)	
Arturo Perez Guerrero,)	
)	Proceeding No. D2017-04
Respondent)	
_____)	

FINAL ORDER

The Deputy General Counsel for Enrollment and Discipline and the Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Arturo Perez Guerrero (“Respondent”), who is represented by counsel, have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the USPTO for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions found in the Agreement.

Jurisdiction

1. At all times relevant hereto, Respondent of San Juan, Puerto Rico, engaged in practice before the Office in trademark matters by filing trademark registration documents with the USPTO and is subject to the USPTO Rules of Professional Conduct set forth at 37 C.F.R. § 11.101 *et seq.*
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19 and 11.26.

Joint Stipulated Facts

3. Respondent represents that he is and has been a member of the Bar of the Supreme Court of Puerto Rico since January 1997.
4. Respondent represents that, over the course of approximately 15 years, he has represented hundreds of clients in trademark matters before the USPTO.

I. *Conduct Regarding Trademark Matter*

5. In October 2012, Respondent filed before the USPTO, on behalf of a client located in Colombia, South America, an Intent-to-Use (ITU) trademark application for the mark "LAYSA" for "Potato chips; Potato crisps and chips; Potato-based snack foods" in International Class 29.
6. In February 2013, the USPTO approved the LAYSA application for publication.
7. In March 2013, the USPTO published a notice in the Federal Register that it intended to register the LAYSA trademark. No opposition was filed in response to the notice.
8. In May 2013, the USPTO issued a Notice of Allowance of the "LAYSA" trademark application.
9. In June 2013, Respondent filed a Statement of Use of the LAYSA mark on behalf of the client. Respondent represents and acknowledges that he filed this Statement of Use based on information received from his client's Colombian attorney of use in interstate commerce in the United States, and that the use began on or about March 1, 2013.
10. On September 10, 2013, the USPTO issued certificate of registration number 4,401,693 for the trademark "LAYSA" for potato chips in International Class 29 ("the '693 Registration").
11. On October 9, 2013, Respondent forwarded to the client's Colombian attorney an email (also dated October 9, 2013) from Frito-Lay's counsel that requested the withdrawal of the LAYSA registration. Respondent explained to the client (through the client's Colombian attorney) that Frito-Lay threatened to initiate a cancellation proceeding against the '693 Registration before the Trademark Trial and Appeal Board ("TTAB").
12. On April 2, 2014, Frito-Lay filed a Petition for Cancellation of the '693 Registration with the TTAB, alleging a likelihood of confusion with several of the company's existing U.S. trademark registrations.
13. On April 10, 2014, Respondent received Frito-Lay's Petition for Cancellation. Respondent forwarded the Petition for Cancellation to the client's Colombian attorney, and advised the Colombian attorney that the due date for filing an answer to the Petition was May 18, 2014.¹
14. On April 30, 2014, the client, through the client's Colombian attorney, asked Respondent to provide a quote for the costs for defending the '693 Registration. Because they did not receive a response from Respondent, the Colombian attorney resent the e-mail on May 5, 2014 and had another email sent again asking for a quote on May 9, 2014.²

¹ The deadline to answer the Petition for Cancellation, May 18, 2014, fell on a Sunday. According to USPTO Rules, when a deadline to respond or answer in a trademark matter falls on a Saturday, Sunday, or federal holiday within the District of Columbia, the deadline is extended to the next business day. *See* 37 C.F.R. § 2.196.

² The May 9, 2014 email appears to come from the Colombian attorney's email address. However, the May 9, 2014 email shows the Colombian attorney's assistant as the email's sender, with the assistant's name at the bottom of the May 9, 2014 email.

15. On May 12, 2014, the client, through the client's Colombian attorney, sent an email to Respondent stating that the client wanted to file a response to Frito Lay's Petition for Cancellation, and again requested Respondent to offer a price quote for his services to file such a response before the TTAB.

16. On May 15, 2014, the Colombian attorney emailed Respondent, asking whether Respondent had received the May 12, 2014 email. Respondent did not reply.

17. The due date to file an answer to the Petition for Cancellation was May 19, 2014.³

18. On May 19, 2014, Respondent filed a "Motion Requesting Permission to Withdraw as Legal Representative" (the "Motion to Withdraw").

19. Respondent neglected to inform his client and the client's Colombian attorney that he had filed the Motion to Withdraw.

20. Respondent neglected to notify his client and the client's Colombian attorney that Respondent no longer intended to represent the client regarding the '693 cancellation proceeding. Respondent acknowledges that the client was under the impression that Respondent was representing the client in the '693 cancellation proceeding.

21. Respondent, in his May 19, 2014 Motion to Withdraw, knowingly misrepresented to the TTAB that 1) Respondent had in fact notified his client of Respondent's withdrawal; 2) all papers and property that related to the proceeding had been handed over to the client; 3) the client had decided to engage another attorney to handle the TTAB matter; and, 4) the client requested additional time to engage new counsel.

22. In part because of Respondent's misrepresentations, on June 26, 2014, the TTAB granted Respondent's Motion to Withdraw, suspended the proceedings, and granted the client thirty days to appoint new counsel, or to file papers stating that the client chose to represent itself.

23. On May 21, 2014, the client's Colombian attorney again advised Respondent that the client wanted to know his fee for representing the client during the '693 cancellation proceeding. At that time, Respondent advised the Colombian attorney that, as a matter of practice, he refers contentious matters to a colleague in New Jersey, and that he is more engaged in prosecution than in enforcement.

24. On June 4 and June 9, 2014, the Colombian attorney, on behalf of the client, again emailed Respondent regarding the cost for handling the '693 cancellation proceeding.

25. On June 26, 2014, Respondent emailed the client's Colombian attorney stating that "it is impossible to quote a fixed budget" and that the initial answer would cost \$800 but that was "just the beginning" of the process. Respondent further stated that he had consulted with a colleague "to whom I usually refer contentious matters" and that his "colleague" charges \$275-300 per

³ See *supra*, footnote 1.

hour and that the total cost could “easily go over 50 thousand, 60 thousand, even 100 thousand dollars.”

26. Respondent neglected to advise his client or his client’s Colombian attorney about the TTAB’s June 26, 2014 Order.

27. On July 2, 2014, Respondent advised the client’s Colombian attorney about the new deadline for responding to the Petition for Cancellation but failed to explain that the additional time for the client to file an answer was based on the misrepresentations in Respondent’s May 19, 2014 Motion to Withdraw.

28. On July 7, 2014, the Colombian attorney wrote to Respondent that the client “has accepted the proposal,” referring to Respondent’s June 26, 2014 email, and that “I have been asked to start by answering” the Petition for Cancellation. Respondent did not inform the Colombian attorney or the client that he did not intend to represent the client in the cancellation proceeding, and also did not advise the client or the Colombian attorney that the TTAB had granted his Motion to Withdraw.

29. On July 28, 2014, Respondent filed with the TTAB a “Motion Requesting Additional Fifteen Days to Announce New Legal Representation.” Respondent acknowledges that he forged the electronic signature of the Colombian attorney on this motion without the Colombian attorney’s knowledge or consent.⁴

30. Respondent acknowledges further that he knew or should have known that the Colombian attorney was not authorized to appear on behalf of another, including the client, before the USPTO in trademark matters.

31. Respondent neglected to advise either the Colombian attorney or his client about Respondent’s filing of the July 28, 2014 Motion Requesting Additional Fifteen Days to Announce New Legal Representation.

32. Respondent neglected to communicate with his client or his client’s Colombian attorney about the status of the TTAB proceeding.

33. On August 6, 2014, Respondent received an email from the Colombian attorney’s assistant requesting a copy of the Answer in response to the Petition for Cancellation and an invoice for work that had been performed. A copy of this email was resent to Respondent on August 12, 2014. Respondent never replied to either of these emails and acknowledges that he never prepared or ordered the preparation of an Answer to the Petition for Cancellation.

34. On September 8, 2014, the TTAB issued a Show Cause Order allowing 30 days for the client to show cause why default judgment should not be entered against it. Because Respondent had withdrawn, Respondent did not receive a copy of this Show Cause Order, or any other correspondence from the TTAB regarding the ’693 cancellation proceeding.

⁴ Electronic signature requirements are found in 37 C.F.R. § 2.193(c).

35. On October 22, 2014, the USPTO granted Frito-Lay's Petition for Cancellation of the '693 Registration.

36. Through emails dated September 30, 2014; November 19, 2014; November 24, 2014; December 11, 2014; January 22, 2015; April 13, 2015; and June 4, 2015, the client's Colombian attorney requested updates regarding the '693 cancellation proceeding, and invoices for Respondent's services that the client and the Colombian attorney believed Respondent had rendered regarding the '693 cancellation proceeding. Respondent neglected to respond to these inquiries or advise the Colombian attorney that the registration had been cancelled.

37. Respondent acknowledges that the client reasonably believed that Respondent was still the client's attorney, and that Respondent continued to represent the client before the TTAB in the '693 cancellation proceeding.

38. In May 2015, Respondent met in person with the Colombian attorney. Respondent advised the Colombian attorney that he did not file an answer to the Cancellation Petition and that the '693 Registration had been cancelled.

39. The Colombian attorney asked Respondent to file a new application for registration of the mark LAYSA.

40. In July 2015, Respondent filed a second trademark application for the LAYSA mark with the USPTO and notified the Colombian attorney that the second application had been filed. Respondent acknowledges that at the time the second application was filed the client was unaware of the filing of the second application; did not know about the cancellation of the '693 Registration; and Respondent was fully aware of these facts when he filed the second application.

41. Sometime in August of 2015, Frito-Lay sent a cease and desist letter to the client.

II. *Miscellaneous Factors*

42. Respondent states, in mitigation, that he has no history of discipline in his 20 years of practice. Respondent further states, in mitigation, that this matter involved a single client matter, and that his conduct including his lack of communication in this matter were an aberration, and not indicative of his practice. Respondent cooperated fully with the OED's investigation and has demonstrated genuine remorse for his conduct.

Joint Legal Conclusions

43. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.104(a)(3) (a practitioner shall keep the client reasonably informed about the status of the matter) by not informing his client that he filed the notice of

- withdrawal in the TTAB cancellation proceeding, by not informing the client that the LAYSA trademark registration was cancelled, and by filing a second trademark application for his unaware client at the request of the client's Colombian attorney while knowing that his client had no actual knowledge of the filing of the second trademark application;
- b. 37 C.F.R. § 11.104(a)(4) (a practitioner shall promptly comply with reasonable requests for information from the client) by failing to respond to reasonable requests for status, information, and invoices by the client, including multiple requests that Respondent received via the client's Colombian attorney;
 - c. 37 C.F.R. §§ 11.303(a)(3) (proscribing a practitioner from knowingly offering evidence that the practitioner knows to be false and requiring remedial measures) and 11.304(b) (proscribing a practitioner from falsifying evidence) by forging the electronic signature of a foreign attorney not authorized to practice before the USPTO in trademark matters on a motion, and filing such motion with a false signature before the TTAB; and
 - d. 37 C.F.R. §§ 11.303(a)(1) (proscribing a practitioner from knowingly making a false statement of fact or law to a tribunal), 11.804(c) (proscribing engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation), and 11.804(d) (proscribing conduct that is prejudicial to the administration of justice) by knowingly making false representations to the TTAB when requesting permission to withdraw.

Agreed Upon Sanction

44. Respondent agrees, and it is hereby **ORDERED** that:
- a. Respondent shall be, and hereby is, suspended from practice before the Office in trademark and other non-patent matters for twelve (12) months commencing on the date that this Final Order is signed.
 - b. Respondent shall comply with 37 C.F.R. § 11.58;
 - c. The OED Director shall comply with 37 C.F.R. § 11.59;
 - d. As a condition for reinstatement, Respondent shall complete during the period of his suspension from the USPTO at least twelve (12) hours of continuing legal education (CLE) in the field of ethics law and shall submit proof of his completion of such continuing legal education as part of any reinstatement petition filed by Respondent;
 - e. The OED Director electronically publish this Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <https://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
 - f. The OED Director to publish a notice materially consistent with the following notice in the *Official Gazette*:

Notice of Suspension

This notice concerns non-registered practitioner Arturo Perez Guerrero of San Juan, Puerto Rico, a member of the Supreme Court of Puerto Rico bar who is authorized to practice before the United States Patent and Trademark Office ("USPTO" or "Office") in trademark matters. The USPTO Director has suspended Mr. Perez Guerrero from practice before the Office in trademark and other non-patent matters for twelve (12) months. Additionally, Mr. Perez Guerrero shall complete during the period of his suspension from the USPTO at least twelve (12) hours of continuing legal education (CLE) in the field of ethics law, and shall submit proof of his completion of such continuing legal education as part of any reinstatement petition filed by Mr. Perez Guerrero.

Mr. Perez Guerrero violated the USPTO Rules of Professional Conduct, specifically, 37 C.F.R. §§11.104(a)(3) (failing to inform client of the status of a matter); 11.104(a)(4) (failing to comply with client's requests for information); 11.303(a)(3) (knowingly offering false evidence); 11.304(b) (falsifying evidence); 11.303(a)(1) (knowingly making a false statement of fact or law to a tribunal); 11.804(c) (conduct involving dishonesty, fraud, deceit, or misrepresentation); and 11.804(d) (conduct prejudicial to the administration of justice).

Mr. Perez Guerrero violated the above rules by not informing his client that he filed the notice of withdrawal in the TTAB cancellation proceeding; not informing the client that the LAYSA trademark registration was cancelled; filing a second trademark application for his unaware client at the request of the client's Colombian attorney while knowing that his client had no actual knowledge of the filing of the second trademark application; not communicating a motion requesting permission to withdraw to a client in a Trademark Trial and Appeal Board ("TTAB") cancellation proceeding; knowingly making false representations to the TTAB when requesting permission to withdraw; after the client's trademark registration was cancelled, filing a second trademark application for the client at the request of the client's foreign attorney without advising the client that he had filed second application while being aware that the client had no knowledge that a second trademark application had been filed; failing to respond to reasonable requests for status, information, and invoices from the client, including multiple requests that Mr. Perez Guerrero received via the client's foreign attorney; and forging the electronic signature of a foreign attorney not authorized to practice before the USPTO in trademark matters on a motion and filing said motion with the TTAB.

This action is the result of a settlement agreement between Mr. Perez Guerrero and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted at OED's electronic

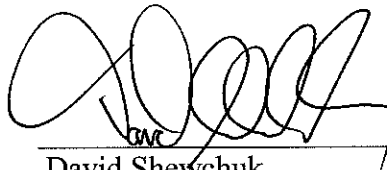
FOIA Reading Room, which is publicly accessible through the Office's website at:
<https://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- g. Nothing in the Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; and (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf;

and

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

6 Jan 2017
Date



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

On behalf of

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

cc: OED Director, USPTO

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