

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

In the Matter of:

ANDREI MINCOV,

Respondent.

Proceeding No. D2020-30

August 23, 2021

INITIAL DECISION ON DEFAULT JUDGMENT

This matter arises from a disciplinary complaint filed by the Director for the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “the Office”) against Andrei Mincov (“Respondent”) pursuant to 35 U.S.C. § 32 as implemented by 37 C.F.R. Part 11.¹ The OED Director has filed a *Motion for Entry of Default Judgment and Imposition of Disciplinary Sanction* and a *Memorandum in Support* (“Default Motion”) seeking a default judgment and an order excluding Respondent from practice before the Office.

PROCEDURAL HISTORY

On September 29, 2020, the OED Director filed a *Complaint and Notice of Proceedings under 35 U.S.C. § 32* (“Complaint”) against Respondent pursuant to 37 C.F.R. §§ 11.32 and 11.34, alleging violations of the USPTO Rules of Professional Conduct (37 C.F.R. §§ 11.101 *et seq.*). The *Complaint* stated that Respondent was required to file a written Answer with the Court within 30 days.

On the same day that the *Complaint* was filed, the OED Director, in accordance with 37 C.F.R. § 11.35(a)(2), attempted to serve a copy of the *Complaint* on Respondent by sending a copy to him via United Parcel Service (“UPS”) overnight delivery to the British Columbia address Respondent had provided to the Office of Enrollment and Discipline (“OED”) on his Application for Reciprocal Recognition Pursuant to 37 C.F.R. §11.14(c) and used by Respondent in trademark filings made with the USPTO. UPS tracking records show that UPS delivered the package to the British Columbia address on September 30, 2020, and the person who received the package signed for the package with the name, “ANDREI.” The *Complaint* was also sent to two other addresses where the OED Director reasonably believed that Respondent received mail. UPS and USPS tracking records show that the *Complaint* was delivered to the two additional addresses.

¹ Pursuant to an Interagency Agreement in effect beginning March 27, 2013, Administrative Law Judges of the U.S. Department of Housing and Urban Development have been appointed by the U.S. Commerce Secretary and are authorized to hear cases brought by the U.S. Patent and Trademark Office.

On September 30, 2020, the Court issued a *Notice of Hearing and Order*, which required Respondent to file his answer on or before October 29, 2020, and establishing various other pre-hearing deadlines. However, Respondent did not file an Answer or otherwise enter an appearance before the Court.

On June 11, 2021, the OED Director filed the *Default Motion*. Pursuant to the *Notice of Hearing and Order*, any party opposing a motion must file his or her opposition within 10 days after the motion is docketed. Accordingly, Respondent's response to the *Default Motion* was due on or before June 21, 2021. However, Respondent has not responded to the *Default Motion*.

As of the date of this *Initial Decision*, Respondent has not filed an Answer to the *Complaint*, responded to the *Default Motion* or sought an extension of time to do so, or otherwise appeared in this matter. The Court has received no communication from or on behalf of Respondent.

APPLICABLE LAW

1. USPTO Disciplinary Proceedings

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). This authority flows from 35 U.S.C. § 2(b)(2)(D), which empowers the USPTO to establish regulations governing patent practitioners' conduct before the Office, and 35 U.S.C. § 32, which empowers the USPTO to discipline a practitioner who is “shown to be incompetent or disreputable, or guilty of gross misconduct,” or who violates the USPTO's regulations. The practitioner must receive notice and an opportunity for a hearing before such disciplinary action is taken. See 35 U.S.C. § 32. Disciplinary hearings are conducted in accordance with the USPTO's procedural rules at 37 C.F.R. part 11, subpart C, and with section 7 of the Administrative Procedure Act, 5 U.S.C. § 556, by a hearing officer appointed by the USPTO. See 37 C.F.R. §§ 11.39(a), 11.44. The OED Director has the burden of proving any alleged violations by clear and convincing evidence. See 37 C.F.R. § 11.49.

In 1985, the USPTO issued regulations based on the ABA Model Code of Professional Responsibility to govern attorney conduct and practice. See Practice Before the Patent and Trademark Office, 50 Fed. Reg. 5158 (Feb. 6, 1985) (Final Rule) (codified at 37 C.F.R. §§ 10.20-10.112). These rules set forth the USPTO Code of Professional Responsibility and “clarif[ied] and modernize[d] the rules relating to admission to practice and the conduct of disciplinary cases.” Id. In May 2013, the USPTO replaced the USPTO Code with the USPTO Rules of Professional Conduct. See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20180 (April 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901). By updating its regulations, the USPTO sought to “provid[e] attorneys with consistent professional conduct standards, and large bodies of both

case law and opinions written by disciplinary authorities that have adopted the ABA Model Rules.”² Id. at 20180.

2. Consequences for Failure to Answer Complaint

The USPTO’s procedural rules set forth the requirement for answering the *Complaint* and the consequences for failing to do so: “Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment.” 37 C.F.R. § 11.36(e).

3. Burden of Proof

The OED Director must prove alleged disciplinary violations by “clear and convincing evidence.” 37 C.F.R. § 11.49; In re Johnson, Proceeding No. D2014-12 at 2 (USPTO Dec. 31, 2014)³. This standard “protect[s] particularly important interests . . . where there is a clear liberty interest at stake.” Johnson, at 3 (quoting Thomas v. Nicholson, 423 F.3d 1279, 1283 (Fed. Cir. 2005)) (internal quotation marks omitted). “Clear and convincing evidence” requires a level of proof that falls “between a preponderance of the evidence and proof beyond a reasonable doubt.” Id. (quoting Addington v. Texas, 441 U.S. 418, 424-25 (1979)) (internal quotation marks omitted). The evidence must be of such weight so as to “produce[] 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.” Id. (quoting Jimenez v. DaimlerChrysler Corp., 269 F.3d 439, 450 (4th Cir. 2001)) (internal quotation marks omitted). “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.” Id. (quoting Foster v. AlliedSignal, Inc., 293 F.3d 1187, 1194 (10th Cir. 2002)) (internal quotation marks omitted).

FINDINGS OF FACT

Because Respondent failed to answer the *Complaint*, he is deemed to have admitted the allegations in the *Complaint*, which are set forth below as the Court’s findings of fact.

Background

On March 5, 2012, the Canadian Intellectual Property Office (“CIPO”) admitted Respondent as a registered trademark agent who was authorized to represent persons in trademark matters filed with CIPO. On April 27, 2012, the USPTO received from Respondent a signed Application for Reciprocal Recognition pursuant to 37 C.F.R. § 11.14(c). On May 7, 2012, the USPTO granted Respondent, via letter signed by the OED Director, reciprocal recognition pursuant to 37 C.F.R. § 11.14(c) for the limited purpose of representing parties located in Canada before the USPTO in the presentation and prosecution of trademark matters.

² Thus, the USPTO Code, the Comments and Annotations to the ABA Model Rules, and disciplinary decisions and opinions issued by state boards are useful to understanding the USPTO Rules. *See* Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20180.

³ Available at: <https://go.usa.gov/x7x93>.

Respondent was not authorized to represent applicants located outside of Canada in trademark matters before the USPTO.

The May 7, 2012 letter from the OED Director expressly stated:

In view of the recognition granted to you under [37 C.F.R.] § 11.14(c), you are required to conduct yourself in compliance with the U.S. Patent and Trademark Code of Professional Responsibility. 37 CFR §§ 10.20 through 10.112. This letter will constitute proof of such recognition.

On October 18, 2012, the USPTO Director notified the public, including Respondent, that the USPTO proposed to align its professional responsibility rules “by replacing the[n] current Patent and Trademark Office Code of Professional Responsibility . . . with new USPTO Rules of Professional Conduct, which are based on the Model Rules of Professional Conduct of the ABA. . . .” 77 Fed. Reg. 64190.

On April 3, 2013, the USPTO Director notified the public, including Respondent, that the USPTO was adopting the new USPTO Rules of Professional Conduct with an effective date of May 3, 2013. See 78 Fed. Reg. 20179. Respondent was on notice that he had to align his conduct to comply with 37 C.F.R. §§ 10.20 through 10.112 between May 7, 2012 and May 2, 2013, and with 37 C.F.R. §§ 11.101 through 11.804, as of May 3, 2013. At all times relevant to his representation of others before the USPTO, Respondent was aware of the USPTO regulations and guidance pertaining to the signing of trademark applications and other trademark documents that are filed with the Office.

On August 9, 2011, Respondent was admitted to practice law in British Columbia, Canada. On or around, June 30, 2015, Respondent relinquished his license to practice law and is not allowed to practice law in Canada. Respondent is not, and has never been, licensed to practice law in United States of America.

TEAS, Application Signature Methods, TICRS and IP Addresses

The Trademark Electronic Application System (“TEAS”) is the USPTO’s electronic trademark filing and prosecution system. Via TEAS, trademark documents are electronically prepared, signed, and filed with the USPTO. Id. 37 C.F.R. § 2.193(a) states, in pertinent part, that “[e]ach piece of correspondence that requires a signature” filed with the USPTO in trademark matters must bear “[a] handwritten signature personally signed . . . by the person named as the signatory . . .” or “[a]n electronic signature that meets the requirements of paragraph (c) of this section, **personally entered by the person named as the signatory.**” (emphasis added).

The “DIRECT” sign method, where the named signatory (*e.g.*, the applicant) personally enters the characters that she or he has adopted as their signature, is the default signature method for filing trademark documents with the USPTO. The other methods for electronic signatures on trademark documents are (a) “E SIGN-ON” where a link is sent to the named signatory who

opens the link and electronically signs his or her name to the document, and (b) “H SIGN-ON” where an electronic version of the named signatory’s original handwritten pen-and-ink signature (e.g. a pdf formatted version of the signed document) is uploaded via TEAS.

37 C.F.R. § 2.193(c) elaborates on the requirements for electronic signatures submitted to the USPTO and reiterates that a “person signing a document electronically must ... [p]ersonally enter” the characters that he or she has adopted as their signature, placed between two forward slash symbols. The USPTO Trademark Manual of Examining Procedure TMEP § 611.01(b) sets forth the general requirements for signatures of trademark documents filed with the Office. TMEP § 611.01(b) specifically states, “[a]nother person (e.g., paralegal, legal assistant, secretary) may not sign the name of an attorney or other authorized signatory.” (citations omitted). Id.

TMEP § 611.01(c) sets forth the USPTO’s specific rules for signatures of documents electronically filed with the Office. TMEP § 611.01(c) states, *inter alia*, “[a]ll documents **must** be personally signed[]” adding that “[t]he person(s) identified as the signatory **must** manually enter the elements of the electronic signature.” (emphasis added). Id. TMEP § 611.01(c) also states that “[a]nother person (e.g., paralegal, legal assistant, or secretary) **may not** sign the name of a qualified practitioner or other authorized signatory.” (emphasis added, citations omitted). Then TMEP § 611.01(c) points out that “[j]ust as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person **is not a valid signature** by that person.” (emphasis added). Id.

The USPTO’s signature requirements are critical to the integrity of the United States trademark registration process. For example, many documents submitted to the USPTO (e.g., each application) include a declaration required to be signed by the person whose name appears on the application as the signatory and no other person. Id. The declaration contains certifications that are signed under criminal penalty of fine or imprisonment pursuant to the provisions of 18 U.S.C. § 1001. Id.

The Trademark Image Capture & Retrieval System (“TICRS”) is a USPTO database that, among other things, captures and records (i) the date and time when a document is created on TEAS, (ii) the date and time when a document is submitted via TEAS, (iii) the signature method used when a signed document is filed with the USPTO via TEAS, and (iv) the email address to where the filing receipt for each filed document is transmitted.

Likewise, TICRS records the Internet Protocol (“IP”) address of the computer used by the document preparer to access the TEAS System. An “IP address” is a unique string of numbers separated by periods that identifies a computer using the Internet Protocol to communicate over a network. Id. When the “DIRECT” sign method is used, the IP address captured by TICRS reflects the approximate geographic location (e.g., city, state or province, and country) of the computer from where the application or other document was signed and submitted to the USPTO via TEAS.

Trademark Factory International, Inc.

Respondent is the founder and chief executive officer (“CEO”) of Trademark Factory International, Inc. (“TMF”). TMF is headquartered in Vancouver, British Columbia, Canada, and has an office in Toronto, Ontario, Canada. At all times relevant to the *Complaint*, Respondent engaged in practice before the USPTO in trademark matters from Blaine, Washington, United States; Vancouver, British Columbia, Canada; and Toronto, Ontario, Canada. As of at least February 13, 2019, TMF’s website asserts that it “is the only firm in the world that offers risk-free trademarking services with a guaranteed result for a guaranteed budget” and “proudly serve[s] clients from all over Canada, the United States and around the world.”

As the founder and CEO of TMF, Respondent practices before the USPTO in trademark matters, including providing trademark legal advice. Respondent also serves as the final decision maker with respect to all TMF client matters. Respondent affiliates with U.S. licensed attorneys who have no prior trademark experience so he can “train” them from the ground up in trademark prosecution. Respondent possessed managerial authority over all TMF non-practitioner assistants, employees, and U.S. licensed attorneys who supported TMF in providing trademark legal services before the USPTO. Respondent made no reasonable effort to ensure that practitioners and non-practitioner assistants affiliated with TMF conformed their practice before the Office with the USPTO Rules of Professional Conduct.

Respondent ordered practitioners and non-practitioner assistants affiliated with TMF to engage in conduct that violated the USPTO signature rules and Rules of Professional Conduct; ratified conduct that he specifically knew violated the USPTO signature rules and Rules of Professional Conduct; and did not, after knowing of the conduct that violated the USPTO signature rules and Rules of Professional Conduct, take reasonable remedial action at a time when the conduct’s consequences could be avoided or mitigated.

TMF’s Affiliation with Canadian Trademark Agents, a Canadian Trainee, and Attorneys Licensed to Practice Law in the United States

Respondent has affiliated with Canadian trademark agents Anita Mar and Jamie Bashtanyk; Canadian trademark agent trainee Amanda Cheply; and U.S. licensed attorneys Charles Caldwell, Sabrina Steinberg, and Lauren Lenza.

Anita Mar

Anita Mar is a Canadian trademark agent who was affiliated with TMF from January 2014 until May 2017. On December 13, 2013, the USPTO granted Ms. Mar reciprocal recognition pursuant to 37 C.F.R. § 11.14(c).⁴ Ms. Mar is not, and has never been, licensed to practice law in any of the fifty states of the United States of America, the District of Columbia,

⁴ On August 2, 2019, the Court issued an Initial Decision on Default Judgment excluding Ms. Mar from practice before the Office in patent, trademark, and other non-patent matters. *See In re Mar*, Proceeding No. D2019-11 (USPTO Aug. 2, 2019).

or any Commonwealth or territory of the United States of America. At all times relevant to the *Complaint*, Ms. Mar lived in or around Windsor, Ontario, Canada

During her time at TMF, Ms. Mar was involved in all aspects of Canadian and U.S. trademark prosecution, cancellation proceedings, and trademark oppositions. Respondent instructed Ms. Mar to prepare numerous U.S. trademark documents, including but not limited to, new applications, responses to Office actions, and Statements of Use for TMF clients. Respondent instructed Ms. Mar to enter the named signatory's signature on multiple trademark documents bearing declarations that were thereafter filed with the USPTO, where Ms. Mar was not the named signatory.

Jamie Bashtanyk

Jamie Bashtanyk is a Canadian trademark agent who was affiliated with TMF from January 2017 until September 2019. On February 3, 2016, the USPTO granted Ms. Bashtanyk reciprocal recognition pursuant to 37 C.F.R. § 11.14(c).⁵ Ms. Bashtanyk is not, and has never been, licensed to practice law in any of the fifty states of the United States of America, the District of Columbia, or any Commonwealth or territory of the United States of America. all times relevant to the *Complaint*, Ms. Bashtanyk lived in or around Saint-Lazare, Québec, Canada.⁶

Prior to working at TMF, Ms. Bashtanyk had little to no experience with the USPTO or its policies and procedures. Respondent knowingly allowed Ms. Bashtanyk to provide trademark legal advice to TMF clients. Respondent also instructed Ms. Bashtanyk to prepare numerous U.S. trademark documents, including but not limited to, new applications, responses to Office actions, and Statements of Use for TMF clients. Respondent instructed Ms. Bashtanyk to enter the named signatory's signature on multiple trademark documents bearing declarations that were thereafter filed with the USPTO. For example, Respondent instructed Ms. Bashtanyk to enter/type/input the name and signature of an attorney licensed to practice law in the United States as the Attorney of Record in multiple applications that were filed with the USPTO.

USPTO records show that, on trademark documents where Ms. Bashtanyk was identified as the named signatory (*e.g.*, trademark documents that she was authorized to file because the applicants were Canadian residents), when Ms. Bashtanyk entered her signature she did so from IP addresses approximately 13 miles from Saint-Lazare, Quebec, Canada; in either Saint-Therese, Vaudreuil-Dorion, or Les Cedres, Quebec, Canada. USPTO records show that, on trademark documents where Ms. Bashtanyk entered the named signatory's signature, and she was not the named signatory, that she did so from Saint-Therese, Quebec; Vaudreuil-Dorion, Quebec; Les Cedres, Quebec; Hudson, Quebec; or Saint-Jerome, Quebec, Canada. TICRS data indicates that, while affiliated with TMF and managed by Respondent, Ms. Bashtanyk

⁵ On April 17, 2020, the USPTO Director issued a Final Order excluding on consent Ms. Bashtanyk from practice before the Office in trademark and other non-patent matters. See In re Bashtanyk, Proceeding No. D2020-09 (USPTO Apr. 17, 2020).

⁶ Saint-Thérèse, Québec, Canada; Vaudreuil-Dorion, Québec, Canada; Les Cèdres, Québec, Canada; and Hudson, Québec, Canada are within approximately 13 miles of Saint-Lazare, Québec, Canada. Saint-Jérôme, Québec, Canada is within approximately 50 miles of Saint-Lazare, Québec. All are suburb communities of Montréal, Québec, Canada.

impermissibly signed the name of the U.S. licensed attorney identified as the named signatory on at least 52 trademark filings submitted to the USPTO. Each of the 52 trademark filings was signed and filed from either Saint-Therese, Quebec; Vaudreuil-Dorion, Quebec; Les Cedres, Quebec; Hudson, Quebec; or Saint-Jerome, Quebec, Canada.

Each of the trademark documents listed in Table 1 below, were prepared, signed, and filed by TMF for applicants who do not reside in Canada. On each of the trademark filings listed in Table 1 below, Respondent and Ms. Bashtanyk were falsely represented to the USPTO to be “other appointed attorneys” duly authorized to represent the applicant before the USPTO when, in fact, neither he nor Ms. Bashtanyk were authorized to represent applicants who do not reside in Canada.

Table 1: Documents Impermissibly Signed by TMF Employee Jamie Bashtanyk

Serial Number	Filing Date	Document	Signature Location (IP)
87616907	9/21/17	Application	Saint-Thérèse, Québec, Canada
87845778	3/22/18	Application	Les Cèdres, Québec, Canada
87616907	4/12/18	Statement of Use	Les Cèdres, Québec, Canada
87926542	5/17/18	Application	Vaudreuil-Dorion, Québec, Canada
87940127	5/29/18	Application	Vaudreuil-Dorion, Québec, Canada
88067313	8/6/18	Application	Vaudreuil-Dorion, Québec, Canada
88067292	8/6/18	Application	Vaudreuil-Dorion, Québec, Canada
88078925	8/15/18	Application	Vaudreuil-Dorion, Québec, Canada
88111674	9/11/18	Application	Vaudreuil-Dorion, Québec, Canada
88117572	9/14/18	Application	Vaudreuil-Dorion, Québec, Canada
88153645	10/12/18	Application	Les Cèdres, Québec, Canada
88157708	10/16/18	Application	Les Cèdres, Québec, Canada
88157726	10/16/18	Application	Les Cèdres, Québec, Canada
88159342	10/17/18	Application	Vaudreuil-Dorion, Québec, Canada
88164746	10/22/18	Application	Vaudreuil-Dorion, Québec, Canada
88167319	10/24/18	Application	Vaudreuil-Dorion, Québec, Canada
88170680	10/26/18	Application	Vaudreuil-Dorion, Québec, Canada
88181684	11/5/18	Application	Vaudreuil-Dorion, Québec, Canada
88191478	11/13/18	Application	Vaudreuil-Dorion, Québec, Canada
88196579	11/16/18	Application	Vaudreuil-Dorion, Québec, Canada
88067292	12/7/18	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
88225629	12/11/18	Application	Vaudreuil-Dorion, Québec, Canada
88225625	12/11/18	Application	Vaudreuil-Dorion, Québec, Canada
88234330	12/18/18	Application	Les Cèdres, Québec, Canada
88117572	12/28/18	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
88246078	12/31/18	Application	Vaudreuil-Dorion, Québec, Canada
88249149	1/3/19	Application	Les Cèdres, Québec, Canada
88269640	1/21/19	Application	Vaudreuil-Dorion, Québec, Canada

Serial Number	Filing Date	Document	Signature Location (IP)
88269570	1/21/19	Application	Vaudreuil-Dorion, Québec, Canada
88269540	1/21/19	Application	Vaudreuil-Dorion, Québec, Canada
88269512	1/21/19	Application	Vaudreuil-Dorion, Québec, Canada
88111674	1/22/19	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
87940127	1/28/19	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
88288851	2/4/19	Application	Les Cèdres, Québec, Canada
88164746	2/5/19	Response to Office Action	Les Cèdres, Québec, Canada
88164746	3/1/19	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
88225629	3/11/19	Response to Office Action	Les Cèdres, Québec, Canada
88225625	3/11/19	Response to Office Action	Les Cèdres, Québec, Canada
88067313	3/19/19	Response to Office Action	Les Cèdres, Québec, Canada
88234330	3/20/19	Response to Office Action	Les Cèdres, Québec, Canada
88157726	4/1/19	Response to Office Action	Les Cèdres, Québec, Canada
87845778	4/2/19	Statement of Use	Hudson, Québec, Canada
88288851	4/23/19	Response to Office Action	Les Cèdres, Québec, Canada
88249149	4/29/19	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
88117572	5/2/19	Statement of Use	Vaudreuil-Dorion, Québec, Canada
88246078	5/23/19	Response to Office Action	Vaudreuil-Dorion, Québec, Canada
87926542	5/29/19	Statement of Use	Vaudreuil-Dorion, Québec, Canada
88078925	6/11/19	Statement of Use	Vaudreuil-Dorion, Québec, Canada
88170680	6/12/19	Response to Office Action	Saint-Jérôme, Québec, Canada
88269640	6/13/19	Response to Office Action	Vaudreuil-Dorion, Québec, Canada

In November 2018, Ms. Bashtanyk informed Respondent that the TMF procedure of inputting the named signatory's signatures into trademark documents violated the USPTO's signature rules. In June 2019, Ms. Bashtanyk again informed Respondent that the TMF procedure of inputting the named signatory's signatures violated the USPTO's signature rules. Respondent did not cease TMF's procedure of inputting the name signatory's signatures into trademark documents filed with the Office in violation of the USPTO's trademark signature rules. Respondent instructed Ms. Bashtanyk not to cooperate with OED.

Amanda Cheply

According to TMF's website, Amanda Cheply is a Canadian Trademark Agent in Training who, as of September 29, 2020, was affiliated with TMF. At all times relevant to this *Complaint*, Ms. Cheply lived in or around Vaudreuil-Dorion, Québec, Canada. Ms. Cheply is not a Canadian trademark agent or lawyer. Ms. Cheply is not, and has never been, licensed to practice law in any of the fifty states of the United States of America, the District of Columbia, or any Commonwealth or territory of the United States of America. Ms. Cheply is not, and has never been, permitted to practice before the USPTO in trademark matters. At all times relevant to the *Complaint*, Ms. Cheply's role at TMF included coordinating the training for the newly

hired U.S. licensed attorneys, being a primary contact for law-related questions, and sending trademark work and instructions to U.S. licensed attorneys.

Respondent instructed or otherwise knowingly allowed Ms. Cheply, without adequate oversight, to provide trademark legal advice to TMF clients, and to prepare and file trademark documents on behalf of TMF clients. Respondent knowingly allowed Ms. Cheply to enter what purports to be the signature of a U.S. licensed attorney on multiple trademark documents where the U.S. licensed attorney was the named signatory on such documents.

On September 30, 2019, Ms. Cheply filed with the USPTO multiple Revocation/Appointment of power of attorney forms with what purports to be the signature of a U.S. licensed attorney using the E-SIGN signature method where the U.S. licensed attorney was the named signatory on such documents. The U.S. licensed attorney listed in the Revocation/Appointment of power of attorney forms did not personally sign the filing using the E-SIGN signature method.

Respondent instructed Ms. Mar, Ms. Bashtanyk, and Ms. Cheply to sign the names of named signatories (*e.g.*, applicants and U.S. licensed attorneys) to trademark documents filed with the USPTO in violation of the USPTO signature rules and the USPTO Rules of Professional Conduct.

Charles Caldwell

Charles Caldwell is an attorney licensed to practice law only in Florida. At all times relevant to this *Complaint*, Mr. Caldwell lived in or around Pensacola, Florida. Mr. Caldwell was affiliated with TMF from late 2015 until August 9, 2019.⁷ Mr. Caldwell had no trademark law experience before he began performing trademark legal services for his clients from TMF. At all times relevant to this *Complaint*, Mr. Caldwell did not prepare any trademark documents on behalf of his clients from TMF and did not communicate with them.

Shortly after Mr. Caldwell started working with TMF, Respondent informed him that TMF was changing its procedure such that TMF would enter the signatures of named signatories into trademark documents. Mr. Caldwell did not question this policy and acquiesced to the new policy. With the new policy's implementation, after TMF filed a trademark application with the USPTO that identified Mr. Caldwell as the named signatory, Mr. Caldwell received an email from TMF with all the application documents attached, including a declaration with his signature already entered. Mr. Caldwell then reviewed the trademark documents and correspondence prepared by TMF and subsequently returned the trademark documents and correspondence to TMF.

On August 15, 2019, after Mr. Caldwell had terminated his relationship with TMF, Mr. Caldwell, Respondent, and Ms. Bashtanyk had a telephone conversation during which Mr. Caldwell specifically indicated that his name should no longer appear on any USPTO

⁷ On March 17, 2020, the USPTO Director issued a Final Order publicly reprimanding Mr. Caldwell for violations of the USPTO Rules of Professional Conduct during his association with TMF. See In re Caldwell, Proceeding No. D2020-02 (USPTO Mar. 17, 2020).

trademark documents in the future. In addition, after Mr. Caldwell terminated his relationship with Respondent and TMF, Mr. Caldwell drafted a notice to TMF clients regarding the improper signatures and the potential adverse effects on the clients' trademark applications or trademarks. Mr. Caldwell attached this notice to an email addressed to Respondent on November 10, 2019, asking that Respondent distribute the notice to clients effected by the impermissible signatures. Respondent did not distribute the notice.

Despite Mr. Caldwell's instructions, Respondent (or a practitioner or TMF trainee at the direction of Respondent) continued to list Mr. Caldwell on some USPTO trademark documents without Mr. Caldwell's knowledge or permission and contrary to Mr. Caldwell's instructions not to do so.

Respondent also violated the ethics rules regarding fee sharing with practitioners who are not in the same firm. Although Mr. Caldwell worked on behalf of clients that he received from TMF, he was not an employee, member, owner of TMF, or partner of Respondent's. Respondent did not obtain TMF clients' consent, in writing, to pay Mr. Caldwell for the trademark legal services Mr. Caldwell provided the clients. Respondent did not inform the clients, in writing, what share of their fees would be paid to Mr. Caldwell. Respondent did not make certain that the fees paid to Mr. Caldwell were in proportion to the services performed by Mr. Caldwell.

Sabrina Steinberg

Sabrina Steinberg is an attorney licensed to practice law in the Commonwealth of Pennsylvania. At all times relevant to this *Complaint*, Ms. Steinberg lived in or around Uwchland, Pennsylvania. Ms. Steinberg was affiliated with TMF from September 15, 2019, until October 14, 2019. Ms. Steinberg had no trademark law experience before she began performing trademark legal services for clients from TMF. During the TMF job interview process, Respondent told Ms. Steinberg that he wanted to engage U.S. licensed attorneys with no prior trademark experience so he could train them from the ground up. Respondent trained Ms. Steinberg by having her watch videos, review written materials, and take so-called trademark tests administered by TMF.

Respondent instructed Ms. Steinberg to change hundreds of pending trademark applications to reflect that she was the Attorney of Record by signing Revocation/Appointment of power of attorney forms that were prepared in advance by TMF. Ms. Steinberg is not a person authorized by USPTO regulations to sign such revocation forms. See 37 C.F.R. §2.17(c)(2), TMEP §§ 611.03(c), 605.01, 605.03, and 606. Respondent also instructed Ms. Steinberg to sign and file multiple responses to Office actions that TMF prepared in advance.

With respect to Ms. Steinberg, Respondent violated the ethics rules regarding fee sharing with practitioners who are not in the same firm. Although Ms. Steinberg worked on behalf of clients that she received from TMF, she was not an employee, member, owner of TMF, or partner of Respondent's. Respondent did not obtain TMF clients' consent, in writing, to pay Ms. Steinberg for the trademark legal services Ms. Steinberg provided the clients. Respondent did not inform the clients, in writing, what share of their fees would be paid to Ms. Steinberg.

Respondent did not make certain that the fees paid to Ms. Steinberg were in proportion to the services performed by Ms. Steinberg.

Lauren Lenza

Lauren Lenza is an attorney licensed to practice law by the State of New York. At all times relevant to this *Complaint*, Ms. Lenza lived in or around New York, New York. Ms. Lenza was affiliated with Respondent and TMF from September 15, 2019, until January 21, 2020. Prior to performing trademark legal services for clients from TMF, Ms. Lenza had no professional experience in trademark law. Respondent did not provide Ms. Lenza with any formal training, other than having her take two TMF-administered tests on how to search for trademarks. Respondent instructed Ms. Lenza to ask Ms. Cheply, a non-lawyer, any law related questions. Ms. Lenza would obtain Ms. Cheply's guidance on trademark filing strategies.

Respondent instructed Ms. Lenza to sign Revocation/Appointment of power of attorney forms for approximately 130 trademark applications and to appoint herself as the new attorney of record on hundreds of trademark applications. Ms. Lenza is not a person authorized by USPTO regulations to sign such Revocation/Appointment of power of attorney forms. See 37 C.F.R. §2.17(c)(2), TMEP §§ 611.03(c), 605.01, 605.03, and 606. All of the revocations that Ms. Lenza signed and filed were prepared by Respondent or Ms. Cheply. Respondent instructed Ms. Lenza to sign and file multiple responses to Office actions that were prepared in advance by TMF personnel.

On November 10, 2019, Ms. Lenza and Respondent received an email from Mr. Caldwell relaying that the USPTO advised him that notice must be sent to TMF's clients whose marks may be affected by TMF's signature process under which his name was impermissibly entered by TMF personnel as the named signatory, as previously discussed with Respondent. Mr. Caldwell's email also included a proposed draft notice regarding impermissibly signed trademark documents and the potential adverse effects on TMF clients' trademark matters, which Respondent and Ms. Lenza were to distribute to Mr. Caldwell's former clients. Respondent did not modify TMF's signature protocol despite being notified that TMF's signature process violated U.S. federal law.

After receiving the email, Ms. Lenza expressed concern to Respondent. Respondent indicated that TMF's Signature Policy was compliant with USPTO requirements. Respondent dismissed Ms. Lenza's concern regarding his lack of compliance with USPTO requirements declaring, "I'm in Canada. They can't touch me." In the middle of November 2019, Respondent again relayed to Ms. Lenza that everything she was doing was in compliance with USPTO rules and regulations. Respondent again stated, "I'm in Canada so they can't do anything to me."

During TMF's association with Ms. Lenza, Respondent violated the ethics rules regarding fee sharing with practitioners who are not in the same firm. Although Ms. Lenza worked on behalf of clients that she received from TMF, she was not employee, member, owner of TMF, or partner of Respondent's. Respondent did not obtain TMF clients' consent, in writing, to pay Ms. Lenza for the trademark legal services Ms. Lenza provided the clients. Respondent did not inform the clients, in writing, what share of their fees would be paid to Ms.

Lenza. Respondent did not make certain that the fees paid to Ms. Lenza were in proportion to the services performed by Ms. Lenza.

Respondent’s Impermissible Signatures

Respondent lives and TMF’s headquarters is in Vancouver, British Columbia, Canada. TICSRS data indicates that Respondent, as the named signatory, electronically signed certain trademark documents using the DIRECT signature method from an IP address in the greater Vancouver, British Columbia area. TICSRS data also indicates that on multiple trademark applications where Respondent was the named signatory, someone other than Respondent signed the document as evidenced by the use of the DIRECT signature method, but where the document was signed and filed in Ontario (Wasaga Beach, Windsor) or Quebec (Bois-des-Filion, Les Cedres, Vaudreuil-Dorion)—*i.e.* over 2,000 miles away from Respondent’s Vancouver, British Columbia location.

Respondent Engaged in, and Assisted in Engaging in, the Unauthorized Practice of Law, and Respondent Instructed U.S. Practitioners to Sign Revocation/Appointment of Power of Attorney forms on Behalf of Clients

In the May 7, 2012 letter granting reciprocal recognition to practice before the USPTO, the USPTO put Respondent on notice that he was only permitted to represent trademark applicants located in Canada before the USPTO. Table 2 below, lists filings made in selected trademark applications for which Respondent was the attorney of record. On each of the following trademark filings, Respondent DIRECT signed the filing as the “Trademark Agent” of record for the applicant.

Table 2: Documents Filed by Respondent on Behalf of Clients Not Located in Canada

Serial Number	Document(s)	Applicant’s Domicile
86718895	1. Application (8/7/15) 2. Request for Extension to File SOU (10/12/16 & 4/11/17) 3. Petition to Revive Abandoned App (12/7/17)	United States
86718891	1. Application (8/7/15) 2. Request for Extension to File SOU (10/12/16 & 4/11/17) 3. Petition to Revive Abandoned App (12/7/17)	United States
86590018	1. Application (4/7/15) 2. Request for Extension to File SOU (5/1/16) 3. Change of Address (7/29/16) 4. Statement of Use (9/16/16) 5. Fax Claiming to be the Attorney of Record (5/1/17)	United States
86631156	1. Application (5/15/15)	United States

Serial Number	Document(s)	Applicant's Domicile
	2. Change of Address (7/29/16) 3. Response to Office Action (11/29/16) 4. Statement of Use (4/13/16)	
86631125	1. Application (5/15/15) 2. Statement of Use (4/13/16) 3. Change of Address (7/29/16) 4. Response to Office Action (11/29/16)	United States
86448094	1. Application (11/7/14) 2. Request for Extension to File SOU (12/27/15 & 6/29/16) 3. Change of Address (7/29/16) 4. Statement of Use (12/23/16)	Malta
86700406	1. Application (7/21/15) 2. Statement of Use (8/9/16)	United States
86122305	1. Application (11/19/13) 2. Revocation (2/25/14) 3. Response to Office Action (4/1/14) 4. Change of Address (7/29/16)	Czech Republic
86668445	1. Application (6/19/15)	United States
87222977	1. Application (11/1/16) 2. Response to Office Action (6/6/17)	Japan
87222986	1. Application (11/1/16) 2. Response to Office Action (6/6/17)	Japan
86669500	1. Application (6/22/15)	United States

The trademark applicant for U.S. Application Serial No. 88671093 lives in Khambhat, India. On February 10, 2020, during a conversation with the trademark examining attorney concerning U.S. Application Serial No. 88671093, Respondent represented himself as a U.S. licensed attorney who is authorized to practice before the USPTO on behalf of applicants who are located outside of Canada.

Failure to Take Corrective Action

Respondent instructed or otherwise allowed TMF personnel or affiliates to impermissibly enter the electric signature of Mr. Caldwell on declarations filed with the USPTO from as early as January 2017 until August 2019. Respondent also instructed or otherwise allowed TMF personnel or affiliates to impermissibly enter his electronic signature on declarations filed with the USPTO starting as early as 2015. At all times relevant to the *Complaint*, Respondent knew or should have known that Mr. Caldwell's purported electronic signature, which Respondent instructed or otherwise allowed to be entered by TMF personnel or affiliates onto USPTO trademark declarations, would jeopardize the validity of TMF clients' trademark applications or any registrations resulting therefrom.

Respondent was specifically notified on multiple occasions between November 2018 and July 1, 2020, that impermissibly signed trademark documents jeopardize the validity of TMF clients' trademark applications or any registrations resulting therefrom. Despite being made aware on multiple occasions that impermissible signatures violated U.S. federal law and USPTO regulations, Respondent has not fulfilled his specific ethical obligation to inform TMF clients that the signing of a declaration, by one other than the named signatory, jeopardizes the validity of their trademark applications or any registrations resulting therefrom. Respondent did not notify his TMF clients of: the identity of the person electronically signing documents, including declarations, filed with the USPTO; whether such person is legally authorized to do so; and the potential adverse consequences of not complying with the USPTO trademark signature rules.

Respondent was specifically notified on multiple occasions between August 15, 2019 and July 1, 2020, of his ethical obligations under the USPTO Rules of Professional Conduct to notify his clients about the impermissible signatures and their impact on the validity of TMF clients' applications or any registrations resulting therefrom. At no time did Respondent consult with and explain to clients (i) the identity of the persons electronically signing documents, including declarations, filed with the USPTO; (ii) whether such persons are legally authorized to do so; or (iii) the potential adverse consequences of not complying with the USPTO trademark signature rules.

Respondent was specifically notified on multiple occasions between August 15, 2019 and July 1, 2020, of his ethical obligation to inform the USPTO about the impermissible signatures. Despite being made aware on multiple occasion that impermissible signatures violated U.S. federal law and USPTO regulations, Respondent has not fulfilled his specific ethical obligation to disclose the trademark applications bearing the impermissible signatures to the USPTO.

*Misconduct Related to Impermissible Division
of Fees and Failure to Communicate with Clients*

Cody Downey

TMF customer Cody Downey spoke with Respondent about protecting his mark and subsequently paid TMF \$3,000 U.S. dollars to provide certain trademark legal services (*i.e.*, trademark protection). Respondent did not discuss with Mr. Downey how the \$3,000 would be divided between Respondent/TMF and any practitioners who provided legal services on behalf of Mr. Downey. Respondent and TMF did not provide Mr. Downey with information and updates about Mr. Downey's trademark application. Every time Mr. Downey expressed his frustration with the lack of updates about the matter, or asked for a refund under TMF's 100% money-back guarantee, Respondent would attempt to sell him another trademark legal services package.

Sandra Estok

Sandra Estok worked with TMF to get her trademark applications filed. She communicated with a combination of TMF personnel employees and affiliates who counseled

and advised her about her U.S. trademark applications, including Respondent, Ms. Lenza, Ms. Cheply, and Ms. Angelique De los Reyes. Ms. Estok was informed that a U.S. licensed attorney would work on her trademark applications, but she was not informed about any division of fees between the U.S. licensed attorney and TMF in the furtherance of providing her trademark legal services.

Failure to Cooperate with a Disciplinary Investigation

During the course of an investigation, the OED Director may request from a practitioner information and evidence (a “Request for Information” or “RFI”) regarding possible grounds for discipline of the practitioner. See 37 C.F.R. § 11.22(f)(1)(ii). A practitioner has an ethical obligation to respond to any lawfully issued RFI. See 37 C.F.R. § 11.801(b). On October 22, 2019, OED sent Respondent an RFI via airmail to the street address Respondent provided on his Application for Reciprocal Recognition pursuant to 37 C.F.R. § 11.14(c), namely: 300-1055 W. Hastings St., Vancouver, British Columbia, V6E 2E9 (the “British Columbia address”).

Also on October 22, 2019, OED sent Respondent an RFI via certified mail, return receipt requested, and regular U.S. mail to an address where the OED Director reasonably believed that Respondent receives mail, the address listed on TMF’s website as TMF’s U.S. address: 439 Peace Portal Dr., PMB 16571, Blaine, Washington 98230 (the “Washington address”). Also on October 22, 2019, OED sent Respondent an RFI via airmail to an address where the OED Director reasonably believed that Respondent receives mail, the address listed on TMF’s website as TMF’s Toronto office: 3 Bridgeman Avenue, Suite 204, Toronto, Ontario, M5R 3V4 (the “Ontario address”).

The October 22, 2019 RFI (“October RFI”) contained questions regarding, *inter alia*, TMF practices, policies, and procedures for completing, signing, and filing trademark documents. The October RFI also included questions related to persons working with TMF. The RFI was lawfully issued pursuant to 37 C.F.R. § 11.22(f)(1)(ii). The RFI requested that Respondent respond within twenty-one days, or on or before November 12, 2019. On November 4, 2019, Respondent acknowledged receipt of the October RFI during a telephone call with an OED Staff Attorney. During the telephone call, Respondent requested and received a 14-day extension to reply to the October RFI. Respondent did not respond to the October RFI.

On December 11, 2019, OED sent Respondent a Lack of Response letter, which stated that Respondent had failed to respond to the October RFI. The Lack of Response letter set forth the consequences of a failure to respond and provided Respondent with another copy of the October RFI. The Lack of Response letter informed Respondent that he was to respond no later than December 27, 2019. OED mailed the Lack of Response letter to Respondent via certified mail, return receipt requested to Respondent’s Washington address. A copy of the letter was also sent via airmail to Respondent’s British Columbia address and via email to Respondent’s Ontario address. None of the letters were returned to the USPTO. Respondent did not respond to the December Lack of Response letter.

On March 16, 2020, OED sent Respondent a Final Notice of Lack of Response and RFI via certified mail, return receipt requested and regular U.S. mail to Respondent’s Washington

address. The certified mailing was “Delivered, To Agent” on March 19, 2020. A copy of the March Final Notice of Lack of Response and RFI was also sent via airmail to Respondent’s British Columbia address and was not returned to the USPTO. A second copy was sent via airmail to Respondent’s Ontario address and was not returned to the USPTO. The March 16, 2020 Final Notice of Lack of Response and RFI identified the provisions of the USPTO Rules of Professional Conduct implicated by Respondent’s conduct, discussed Respondent’s lack of response to the October RFI, and invited Respondent to provide information, evidence, and comments that he believed were reasonable for the OED Director to consider. The March Final Notice of Lack of Response and RFI was lawfully issued pursuant to 37 C.F.R. § 11.22(f)(1)(ii). Respondent did not respond to the March Final Notice of Law of Response and RFI.

On April 8, 2020, OED sent Respondent a “Request to Correspond Electronically over the Internet” via certified mail, return receipt requested, and regular U.S. mail to Respondent’s Washington address. A copy of the Request was also sent via airmail to Respondent’s British Columbia address and was not returned to the USPTO. A second copy was sent via airmail to Respondent’s Ontario address and was not returned to the USPTO. Respondent did not respond to the Request to correspond electronically.

On June 16, 2020, OED sent Respondent a RFI via certified mail, return receipt requested, and regular U.S. mail to Respondent’s Washington address. A copy of the June 16, 2020 RFI (“June RFI”) was sent via airmail to Respondent’s British Columbia address and was not returned to the USPTO. A second copy was sent via airmail to Respondent’s Ontario address and was not returned to the USPTO. The June RFI sought information regarding certain trademark documents that were filed with the USPTO that contained Respondent’s purported signature. The June RFI requested that Respondent respond within fourteen days or on or before June 30, 2020. The June RFI was lawfully issued pursuant to 37 C.F.R. § 11.22(f)(1)(ii). Respondent did not respond to the June RFI.

On July 1, 2020, OED sent a Lack of Response to the June RFI letter to Respondent explaining that he had failed to respond to the June RFI. The letter set forth the consequences of a failure to respond and provided Respondent with another copy of the June RFI. The July Lack of Response letter requested that Respondent respond within seven days or on or before July 8, 2020. The July Lack of Response letter was sent via certified mail, return receipt requested, to Respondent’s Washington address and was not returned to the USPTO. A copy was sent via airmail to Respondent’s British Columbia address and was not returned to the USPTO. A second copy was sent via airmail to Respondent’s Ontario address and was not returned to the USPTO.

As of the date of the filing of the *Complaint*, OED has not received a response to any of the RFIs, Lack of Response letters, or Request to Communicate electronically. Other than the November 4, 2019 telephone call, Respondent has not communicated with OED. Respondent was provided ample notice and opportunity to respond to the RFIs and the Lack of Response letters, but has failed to do so. Even though Respondent did not respond to OED’s RFIs and other communications from OED, Respondent continued to practice before the USPTO.

CONCLUSIONS OF LAW

Based upon the foregoing findings of fact, the Court concludes that Respondent violated the following USPTO Rules of Professional Conduct, for the following reasons.

1. 37 C.F.R. § 11.103 provides that a practitioner “shall act with reasonable diligence and promptness in representing a client.” Respondent violated this rule by directing or otherwise allowing TMF personnel to enter the signature of the named signature (*e.g.*, his signature or the signature of a U.S. licensed attorney of record for the trademark applicant) on trademark applications and related documents filed with the USPTO and not taking reasonable steps to ensure that trademark filings were signed in accordance with the USPTO trademark signature rules.

2. 37 C.F.R. § 11.104(a)(3) provides that a practitioner shall “[k]eep the client reasonably informed about the status of the matter.” Respondent violated this rule by failing to inform TMF clients as to the actual or potential adverse consequences of not complying with the USPTO trademark signature rules—including that the electronic signing of a trademark declaration by one other than the named signatory potentially jeopardizes or had actually jeopardized the intellectual property rights of the client—despite knowing that a TMF-affiliated trademark agent or non-practitioner assistant had impermissibly signed the declarations; and by failing to inform Mr. Downey about the status of his trademark application.

3. 37 C.F.R. § 11.104(b) provides that a practitioner shall “explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.” Respondent violated this rule by failing to explain to TMF clients as to the actual or potential adverse consequences of not complying with the USPTO trademark signature rules—including the electronic signing of a trademark application declaration by one other than the named signatory jeopardizes the intellectual property rights of the client—so that the clients could make informed decisions about their pending trademark applications and/or issued registrations.

4. 37 C.F.R. § 11.105(e) provides that a “division of a fee between practitioners who are not in the same firm may only be made if ... the division is in proportion to the services performed by each practitioner... the client agrees to the arrangement...confirmed in writing[, and the] total fee is reasonable.” Respondent violated this rule by sharing fees for trademark legal services with U.S. licensed attorneys who were not part of TMF and to whom he referred trademark legal work without obtaining the clients’ informed written consent.

5. 37 C.F.R. § 11.303(a)(1) provides that a practitioner “shall not knowingly ... [m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner.” Respondent violated this rule by filing trademark applications with the Office—which, therefore, impliedly represented that the named signatory was the person who actually signed the declaration—and not correcting the impliedly false statements despite knowing that a TMF affiliated trademark agent or non-practitioner assistant had impermissibly signed the filings.

6. 37 C.F.R. § 11.303(a)(3) provides that a practitioner “shall not knowingly ... [o]ffer evidence that the practitioner knows to be false. If the practitioner ... has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.” Respondent violated this rule by filing trademark applications with the Office—which, therefore, impliedly represented that the named signatory was the person who actually signed the declaration—and not correcting the impliedly false statements despite knowing that a TMF affiliated trademark agent had impermissibly signed the declarations.

7. 37 C.F.R. § 11.303(b) provides that a practitioner “who represents a client in a proceeding before a tribunal and who knows that a person intends to engage, is engaging or has engaged in criminal or fraudulent conduct related to the proceeding shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.” Respondent violated this rule by filing trademark application declarations signed under criminal penalty of perjury to the USPTO that were signed by other than the named signatory—which, therefore, constituted criminal or fraudulent conduct—and not taking remedial measures (*e.g.*, informing the USPTO about the impermissibly-signed declarations) despite knowing that a TMF-affiliated trademark agent or non-practitioner assistant had impermissibly signed the declarations.

8. 37 C.F.R. § 11.303(d) provides that a practitioner “[i]n an *ex parte* proceeding ... shall inform the tribunal of all material facts known to the practitioner that will enable the tribunal to make an informed decision, whether or not the facts are adverse.” Respondent violated this rule by filing trademark applications with the Office—which, therefore, impliedly represented that the named signatory was the person who actually signed the declaration—and not correcting the impliedly false statement despite knowing that a TMF-affiliated trademark agent or non-practitioner assistant had impermissibly signed the declarations.

9. 37 C.F.R. § 11.501(a) provides that a “practitioner who is a partner in a law firm ... shall make reasonable efforts to ensure that the firm has is in effect measures giving reasonable assurance that all practitioners in the firm conform to the USPTO Rules of professional Conduct.” Respondent violated this rule by directing or otherwise allowing another practitioner to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on trademark application declarations filed with the USPTO.

10. 37 C.F.R. § 11.501(b) provides that a “practitioner having direct supervisory authority over another practitioner shall make reasonable efforts to ensure that the other practitioner conforms to the USPTO Rules of Professional Conduct.” Respondent violated this rule by failing to make reasonable efforts as the direct supervisor of subordinate practitioners to ensure the subordinate practitioners conformed to the USPTO Rules of Professional Conduct such that trademark application declarations bearing his name were signed by himself and that of a U.S. licensed attorney’s name were signed by the attorney.

11. 37 C.F.R. § 11.501(c)(1) provides that a practitioner shall “be responsible for another practitioner’s violation of the USPTO Rules of Professional Conduct if [the] practitioner orders or, with knowledge of the specific conduct, ratifies the conduct involved[.]” Respondent violated this rule by directing or otherwise allowing another practitioner to impermissibly enter

his electronic signature or the electronic signature of a U.S. licensed attorney on trademark application declarations filed with the USPTO.

12. 37 C.F.R. § 11.501(c)(2) provides that a practitioner shall “be responsible for another practitioner’s violation of the USPTO Rules of Professional Conduct if [the] practitioner is a partner or has comparable managerial authority in the law firm in which the other practitioner practices, or has direct supervisory authority over the other practitioner, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action. Respondent violated this rule by failing to take reasonable remedial action after directing or otherwise allowing a subordinate practitioner to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on trademark application declarations filed with the USPTO.

13. 37 C.F.R. § 11.503(a) provides that, with respect to a non-practitioner assistant employed, retained, or associated with a practitioner; a practitioner who is a partner shall “make reasonable efforts to ensure that the firm has in effect measures giving reasonable assurance that the person’s conduct is compatible with the professional obligations of the practitioner.” Respondent violated this rule by failing to make reasonable efforts as the CEO of TMF to ensure the firm has measures giving reasonable assurance that the conduct of a non-practitioner is compatible with the USPTO Rules of Professional Conduct such that trademark application declarations bearing his name were signed by himself and that of a U.S. licensed attorney’s name were signed by the attorney.

14. 37 C.F.R. § 11.503(b) provides that, with respect to a non-practitioner assistant employed, retained, or associated with a practitioner; a practitioner having direct supervisory authority over the non-practitioner assistant shall “make reasonable efforts to ensure that the person’s conduct is compatible with the professional obligations of the practitioner.” Respondent violated this rule by failing to make reasonable efforts as the direct supervisor of a subordinate non-practitioner to ensure the subordinate practitioner’s conduct is compatible with the USPTO Rules of Professional Conduct such that trademark application declarations bearing his name were signed by himself and those bearing a U.S. licensed attorney’s name were signed by the attorney.

15. 37 C.F.R. § 11.503(c)(1) provides that, with respect to a non-practitioner assistant employed, retained, or associated with a practitioner; a practitioner shall be “responsible for conduct of such a person that would be a violation of the USPTO Rules of Professional Conduct if [t]he practitioner orders or, with the knowledge of the specific conduct, ratifies the conduct involved.” Respondent violated this rule by directing or otherwise allowing a non-practitioner to impermissibly enter his electronic signature of the electronic signature of a U.S. licensed attorney on trademark application declarations and other trademark documents filed with the USPTO.

16. 37 C.F.R. § 11.503(c)(2) provides that, with respect to a non-practitioner assistant employed, retained, or associated with a practitioner; a practitioner shall be “responsible for conduct of such a person that would be a violation of the USPTO Rules of Professional Conduct if [t]he practitioner is a partner or has comparable managerial authority in the law firm in which

the person is employed, or has direct supervisory authority over the person, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action.” Respondent violated this rule by failing to take reasonable remedial action after directing or otherwise allowing a subordinate non-practitioner to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on trademark application declarations filed with the USPTO

17. 37 C.F.R. § 11.505 provides that a practitioner shall “not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.” Respondent violated this rule by preparing and filing trademark applications on behalf of clients that are not located in Canada; holding himself out as the attorney of record in such trademark applications before the USPTO; instructing or otherwise allowing another reciprocally-recognized Canadian trademark agent to prepare and file trademark applications on behalf of clients that are not located in Canada; and permitting another reciprocally-recognized Canadian trademark agent and/or unauthorized trainee to consult with or give trademark advice to clients that are not located in Canada and prepare trademark documents on their behalf for filing at the USPTO.

18. 37 C.F.R. § 11.801(b) provides that a practitioner shall not “fail to cooperate with the Office of Enrollment and Discipline in an investigation or any matter before it, or knowingly fail to respond to a lawful demand or request for information from an admissions or disciplinary authority.” Respondent violated this rule by failing to respond to OED’s RFIs and Lack of Response letters, despite being provided ample notice, time, and opportunity to do so.

19. 37 C.F.R. § 11.804(a) provides that a practitioner shall not “[v]iolate or attempt to violate the USPTO Rules of Professional Conduct, knowingly assist or induce another to do so, or do so through the acts of another.” Respondent violated this rule by directing and otherwise allowing TMF employees or affiliates to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on declarations filed with the USPTO, and by instructing a TMF-affiliated trademark agent not to respond to OED’s requests for information.

20. 37 C.F.R. § 11.804(b) provides that a practitioner shall not “[c]ommit a criminal act that reflects adversely on the practitioner’s honesty, trustworthiness or fitness as a practitioner in other respects.” Respondent violated this rule by directing or otherwise allowing TMF personnel to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on declarations filed with the USPTO, which constitutes a willful false statement punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001.

21. 37 C.F.R. § 11.804(c) provides that Respondent shall not “engage in conduct involving dishonesty, fraud, deceit or misrepresentation.” Respondent violated this rule by, with knowledge of the signature rules, directing or otherwise allowing TMF personnel to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on trademark application declarations filed with the USPTO, on which the USPTO relied in examining the applications and issuing trademark registrations.

22. 37 C.F.R. § 11.804(d) provides that Respondent shall not “engage in conduct that is prejudicial to the administration of justice.” Respondent violated this rule by directing or otherwise allowing TMF personnel to impermissibly enter his electronic signature or the electronic signature of a U.S. licensed attorney on trademark application declarations filed with the USPTO, on which the USPTO relied in examining the applications and issuing trademark registrations; engaging in or assisting Ms. Mar, Ms. Bashtanyk, and Ms. Cheply to engage in the unauthorized practice of trademark law before the USPTO; and by failing to respond to OED’s RFIs and Lack of Response letters, despite being provided ample notice, time, and opportunity to do so.

SANCTIONS

The OED Director asked the Court to sanction Respondent by entering an order excluding him from practice before USPTO in patent, trademark, and other non-patent matters. The primary purpose of legal discipline is not to punish, but rather “to protect the public and the administration of justice from lawyers who have not discharged, will not discharge, or are unlikely properly to discharge their professional duties to clients, the public, the legal system, and the legal profession.” *In re Brufsky*, Proceeding No. D2013-18 at 8 (USPTO June 23, 2014)⁸ (citing *Matter of Chastain*, 532 S.E.2d 264, 267 (S.C. 2000)).

In determining an appropriate sanction, USPTO regulations require this Court to consider the following four factors: (1) whether the practitioner has violated a duty owed to a client, the public, the legal system, or 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 conduct; and (4) the existence of any aggravating or mitigating factors. See 37 C.F.R. § 11.54(b). See also *In re Morishita*, Proceeding No. D2017-25 (USPTO Sept. 28, 2018)⁹; *In re Lau*, Proceeding No. D2016-37 (USPTO May 1, 2017)¹⁰; and *In re Schwedler*, Proceeding No. D2015-38 (USPTO Mar. 21, 2016)¹¹.

1. Respondent violated duties owed to his clients, the public, and the legal profession

Respondent violated 22 provisions of the USPTO Rules of Professional Conduct (“Rules”) when he failed, *inter alia*, to act with reasonable diligence and promptness during his representation of TMF clients, to obtain informed consent from TMF clients to divide legal fees with practitioners who were not members of TMF, to take reasonable remedial measures including disclosure to the tribunal of the impermissibly signed declarations, to make reasonable efforts to ensure that practitioners and non-practitioner assistants’ conduct conformed to the Rules, and to cooperate with OED’s investigation. Respondent’s conduct also violated duties owed to the client, the public, and the legal system.

⁸ Available at: <https://go.usa.gov/x7x9Y>.

⁹ Available at: <https://go.usa.gov/x7x94>.

¹⁰ Available at: <https://go.usa.gov/x7x92>.

¹¹ Available at: <https://go.usa.gov/x7x9T>.

The practitioner-client relationship is a fiduciary relationship that requires Respondent to act with “devotion to the interest of the client, warm zeal in the maintenance and defense of [the client’s] rights and the exertion of his utmost learning and ability” to the client’s matter. In re Greer, 52 Ariz. 385, 391 (1938) (internal citations omitted); see also Moatz v. Bender, Proceeding No. D2000-01 at 20 (USPTO Sept. 30, 2003)¹² (“Respondent owed a fiduciary duty individually to each of his clients”), Pet. Of Bd. Of Law Examiners, 210 N.W. 710, 711 (Wis. 1926) (“An attorney occupies a fiduciary relationship towards his client. It is one of implicit confidence and of trust.... There is no field of human activity which requires fuller realization with respect to fiduciary relationship than that which exists between the lawyer and his client.”).

Respondent violated the fiduciary practitioner-client relationship when he instructed, or otherwise condoned, the practice of TMF employees and affiliates impermissibly signing declarations on trademark applications and did not subsequently inform the tribunal or his clients about the practice despite knowing that the practice violated U.S. federal law and USPTO regulations. Respondent also violated the fiduciary practitioner-client relationship by failing to keep TMF clients reasonably informed about the status of their matters (*i.e.*, informing clients that their trademark applications and registrations were potentially jeopardized), to explain the state of their applications and registrations to the extent necessary for the client to make an informed decision about the representation, and by keeping TMF clients in the dark about the division of fees with U.S. licensed attorneys who were not members of TMF. Respondent has clearly violated the fiduciary practitioner-client relationship, which is the most important ethical duty. See People v. Rhodes, 107 P.3d 1177, 1183 (Colo. 2005) (“[T]he most important duty [respondent] violated was that owed to his clients. The clients sought his counsel, trusted his judgment, and expected that he would handle their affairs[.] Respondent’s failure to act with integrity when dealing with client property was egregious.”]

Respondent violated duties owed to the public when he failed to observe the USPTO’s laws and rules of practice. Congress bestowed the USPTO with plenary authority to govern the conduct of agents, attorneys, and other individuals that represent applicants before the Office. See 35 U.S.C. § 2(b)(2)(D). Pursuant to that authority, the USPTO established the USPTO Code of Professional Responsibility and the Rules, which became effective May 3, 2013. See 37 C.F.R. §§ 11.01 through 11.901; 37 C.F.R. § 11.19 et seq. Every foreign agent granted reciprocal recognition for the limited purpose of representing parties located in their country of origin is required to conduct themselves in compliance with the Rules. As such, upon granting Respondent permission to practice under 37 C.F.R. § 11.14(c), the OED Director also explicitly informed Respondent of his obligation “to conduct yourself in compliance with the U.S. Patent and Trademark Code of Professional Responsibility.” Accordingly, when Respondent failed to conduct himself in compliance with the Rules, by violating 22 separate disciplinary provisions, he violated duties owed to the public, as well as the legal profession, and the USPTO.

Respondent violated his duty to the legal profession (*i.e.* the trademark bar) by engaging in misconduct that decreases the public’s confidence in the integrity and professionalism of trademark practitioners by, *inter alia*, failing to competently and diligently represent TMF clients, failing to take remedial action to address the impermissible signature practice, failing to inform the tribunal of an adverse material fact, and failing to cooperate during OED’s

¹² Available at: <https://go.usa.gov/xyEWt>.

investigation. When Respondent failed to file an answer to the *Complaint*, he flouted this Court's authority and imperiled the orderly functioning of the disciplinary process. See *In re Lau, supra* (practitioner violated duties owed to patent bar and decreased confidence in patent practitioners).

2. Respondent acted intentionally and knowingly

Evaluation of a lawyer's mental state, or *mens rea*, requires a determination as to whether, at the time of the misconduct, the lawyer acted intentionally, knowingly, or negligently. These three mental states address the degree of the lawyer's culpability for disciplinary purposes. See Standards § 3.0; see also, e.g., *In re Phillips*, 244 P.3d 549, 555 (Ariz. 2010) (lawyer's mental state at the time of a violation is important, as it affects the appropriate discipline imposed; "[i]ntentional or knowing conduct is sanctioned more severely than negligent conduct because it threatens more harm"); *People v. Varallo*, 913 P.2d 1 (Colo. 1996) (lawyer's mental state is decisive element in determining level of discipline). Intent is the most culpable mental state and is defined as when a practitioner "acts with conscious objective or purpose to accomplish a particular result." STANDARDS at pg. xix. Knowing conduct occurs when a practitioner "acts with conscious awareness of the nature or attendant circumstances of his or her conduct both without the conscious objective or purpose to accomplish a particular result." *Id.* Respondent's acts and omissions were intentional and knowing.

Respondent intentionally signed multiple trademark filings on behalf of applicants located outside of Canada as the Trademark Agent of record for the applicant and/or attorney of record. During a conversation with a USPTO trademark examining attorney, Respondent intentionally and falsely told the examining attorney that he was a U.S. licensed attorney authorized to practice before the USPTO and represent applicants located outside of Canada. Respondent also intentionally instructed TMF employees and affiliates to sign his name on trademark documents.

In addition, Respondent intentionally ordered practitioners and non-practitioner assistants to sign hundreds of trademark filings in the name of Mr. Caldwell. He directed TMF employees and affiliates to engage in this conduct even though he knew that it violated the USPTO's signature rules and the USPTO Rules of Professional Conduct. Respondent intentionally refused to take remedial action to, *inter alia*, mitigate the potential harm that he caused TMF clients. He intentionally failed to distribute the notice that Mr. Caldwell drafted that informed TMF clients about the improper signatures and the potential adverse consequences to their trademark applications and registrations. Respondent intentionally continued to list Mr. Caldwell on trademark documents after Mr. Caldwell terminated his relationship with TMF and explicitly said that his name should not appear on any trademark filings in the future. Indeed, Respondent intentionally continued TMF's unethical and unlawful practice of impermissibly signing trademark filings submitted to the USPTO.

Respondent also intentionally allowed Ms. Cheply—who is not a trademark agent or attorney—to provide legal advice to TMF clients, prepare and file trademark documents, and serve as the primary contact for law-related questions from U.S. licensed attorneys. He intentionally instructed Ms. Steinberg and Ms. Lenza to sign Revocation/Appointment of power

of attorney forms that they were not authorized to sign. He intentionally told Ms. Bashtanyk not to cooperate with OED. Respondent himself intentionally failed to cooperate with OED's investigation when he failed to respond to the October RFI, the June RFI, two Lack of Response letters, and the request to communicate electronically.

Respondent's conduct was also knowing: Respondent knowingly failed to inform Mr. Downey and Ms. Estok about the division of fees between TMF and the practitioners who provided trademark legal services to TMF clients. He knowingly failed to ensure that the fees paid to Mr. Caldwell, Ms. Steinberg, and Ms. Lenza were in proportion to the services that each performed. Respondent intentionally and knowingly engaged in conduct that violates the Rules and warrants his exclusion from practice before the USPTO. See e.g., In re Ho, Proceeding No. D2009-04 at 8 (USPTO Jan. 30, 2009)¹³ (initial decision on default excluding practitioner who, *inter alia*, "knowingly failed to provide information requested by OED and intentionally failed to cooperate with OED's investigation."); In re Glazer, Proceeding No. D2018-34 at 5 (USPTO Mar. 4, 2020)¹⁴ (initial decision excluding practitioner whose acts were "intentional and knowing").

3. The Actual Injuries are Significant

Respondent's conduct caused potential injury. See In re Fuess, Proceeding No. D2015-08 at 64 (USPTO July 21, 2017)¹⁵ ("[t]he harm from the violation need not be actual, only potential") citing In re Claussen, 909 P.2d 862, 872 (Ore. 1996). Hundreds of trademark documents containing fraudulent signatures were filed with the USPTO, and thus hundreds of TMF clients are in jeopardy of having their applications or registrations cancelled. See, e.g. In re Mar, *supra* at 24 ("if a competitor seeks to use the trademark, the competitor can have the trademark cancelled based on the false signatures.") TMF clients paid money to Respondent's company with the expectation that they would receive reputable trademark legal services including valid trademark registrations and the intellectual property rights that flow from federal registration. Respondent has kept TMF clients completely in the dark about the status of their matters, which only delays but does not eliminate the potential injury TMF clients may experience in the future.

Similarly, because Respondent has failed to, *inter alia*, take reasonable remedial measures to disclose the impermissibly signed documents to the USPTO, the trademark registry has numerous applications and registrations that were signed in violation of U.S. federal law and USPTO regulations. Respondent's conduct thereby reduces the integrity of the trademark registry on which the public and the tribunal rely when deciding whether to seek and bestow important intellectual property rights. Having caused multiple clients, the public, and the tribunal significant potential injuries, Respondent should receive a significant sanction.

¹³ Available at: <https://go.usa.gov/xsR42>.

¹⁴ Available at: <https://go.usa.gov/xsR4W>.

¹⁵ Available at: <https://go.usa.gov/x68YA>.

4. Aggravating and Mitigating Factors Exist in this Case

The STANDARDS FOR IMPOSING LAWYER SANCTIONS (2019), (“STANDARDS” or “STANDARD”), published by the American Bar Association, set forth aggravating and mitigating factors for the Court to consider in determining an appropriate sanction. The OED Director asserts that, of the potential mitigating factors identified in the STANDARDS, the sole mitigating factor present here is the “absence of a prior disciplinary record.” See STANDARDS § 9.32. By contrast, the OED Director contends that the following aggravating factors warrant a more severe sanction in this case: a dishonest or selfish motive; a pattern of misconduct; multiple violations; bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of OED; failure to cooperate in this disciplinary process, refusal to acknowledge the wrongful nature of his conduct, and substantial experience in the practice of law. *Id.* § 9.22.

The OED Director argues that Respondent acted with a dishonest and selfish motive when he himself engaged in conduct, or repeatedly instructed TMF employees and affiliates to engage in conduct, that he knew was unethical and unlawful. TMF’s impermissible signature practice and Respondent representing applicants located outside of Canada are two such examples of this improper conduct. Respondent also acted with a dishonest or selfish motive when he failed to keep TMF clients reasonably informed about the status of their matters so that they could take action if warranted. Similarly, he dishonestly and selfishly failed to inform the USPTO about TMF’s impermissible signature practice.

Further, Respondent acted dishonestly or selfishly when he continued to list Mr. Caldwell’s name on trademark documents after Mr. Caldwell told Respondent not to do so. He also acted with a dishonest and selfish manner when falsely telling Ms. Lenza that her work was in compliance with USPTO rules and regulations. And, Respondent acted dishonestly or selfishly when he failed to obtain informed consent from TMF clients to split fees with U.S. licensed attorneys. TMF advertises that they provide money back guaranteed trademark legal services, but the reality is that they engage in unethical and improper practices that put clients’ trademark applications and registrations at risk. See *In re Mar*, *supra*, (practitioner acted with dishonest and selfish motive when she “accepted payment from her clients to prepare and file trademark applications ... but then endangered the status of any such trademarks by forging signatures on trademark documents (or allowing others to do so).”); *In re Anderson*, *supra* (practitioner acted with dishonest and selfish motive when she, *inter alia*, failed to communicate with her clients).

The OED Director asserts that Respondent engaged in a pattern of misconduct when he repeatedly failed to inform TMF clients and the USPTO about TMF’s business practice of impermissibly entering signatures on trademark filings that were submitted to the USPTO. He also repeatedly instructed TMF employees and affiliates to engage in this practice. More, Respondent repeatedly failed to respond to OED’s RFIs and other correspondence during the investigation. Clearly, Respondent engaged in a pattern of misconduct. See *In re Stevenson*, *supra* at 14 (“repeated instances of similar misconduct”); *In re Iussa*, *supra* (pattern of misconduct where practitioner repeatedly failed to exercise diligence and promptness, communicate with client, and respond to OED’s requests for information and evidence).

The third aggravating factor is the commission of “multiple offenses.” See STANDARDS § 9.22(d). Multiple offenses committed in the context of a single disciplinary proceeding may be an aggravating factor. See In re Flindt, Proceeding No. D2016-04 (USPTO Aug. 4, 2017)¹⁶ (practitioner committed “multiple offenses” that violated six separate provisions of the Rules); In re Fuess, *supra* (practitioner abandoned multiple applications and violated multiple Rules). Respondent’s misconduct impacted multiple TMF clients, the tribunal, and OED, and violated 22 provisions of the USPTO disciplinary rules.

The OED Director argues that the fourth aggravating factor is “bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of the disciplinary agency.” See STANDARDS § 9.22(e); In re Mar, *supra* at 26 (practitioner demonstrated obstruction of disciplinary proceeding by, *inter alia*, “fail[ing] to participate in the disciplinary process once the *Complaint* was filed.”). Despite multiple efforts on behalf of the USPTO to ensure that Respondent received the *Complaint* and other filings in this matter, Respondent did not file an answer to the *Complaint* or seek permission to file a late answer. See, e.g., In re Coyle, *supra* (bad faith obstruction found where practitioner, *inter alia*, did not file answer or seek permission to file a late answer).

Respondent’s behavior demonstrates a willful disregard of his obligations to the USPTO and the Court. A practitioner’s failure to cooperate in his own disciplinary proceeding is indicative of indifference toward, and even contempt for, disciplinary procedures, and demonstrates a complete want of professional responsibility. See In re Morishita, *supra*; In re Lau, *supra*; In re Schwedler, *supra*; see also In re Kantor, 850 A.2d 473, 477 (N.J. 2004) (“An attorney who declines to appear before this Court to explain his unprofessional conduct [...] openly displays his unfitness to continue to practice law.”); People v. Barbieri, 61 P.3d. 488, 495 (Colo. O.P.D.J. 2000) (“In disciplinary matters involving an attorney’s conduct, compliance with unchallenged orders issued by the disciplinary body is not elective; it is mandatory. Failure to do so, almost invariably, will inure substantially enhanced discipline.”); Iowa Supreme Court Bd. of Prof’l Ethics and Conduct v. Ramey, 639 N.W.2d 243, 246 (Iowa 2002) (attorney’s “failure to respond to this attorney disciplinary proceeding suggests an overall attitude of disrespect and disregard for this profession.”).

The fifth aggravating factor that is applicable to this proceeding is Respondent’s “refusal to acknowledge wrongful nature of the conduct.” See STANDARDS § 9.22(g). A lack of remorse warrants a more severe sanction. See In re Stecewycz, Proceeding No. D2014-15 at 37 (USPTO May 5, 2016)¹⁷ (“failure to acknowledge the wrongful nature of [the] misconduct or show any remorse for [the] conduct is a weighty factor in aggravation.”). Respondent has not displayed any remorse for his actions. He never expressed remorse for the potential injury that he has caused hundreds of TMF clients and the USPTO. He has not expressed remorse for intentionally ignoring OED’s communications during the investigation or for failing to participate in this proceeding. Instead, with full awareness of his bad behavior, Respondent has repeatedly boasted that the USPTO cannot touch him because he resides in Canada, and refused to mitigate his wrongful conduct.

¹⁶ Available at: <https://go.usa.gov/x63dK>.

¹⁷ Available at: <https://go.usa.gov/x68gt>.

Finally, “substantial experience in the practice of law” is an aggravating factor. See STANDARDS § 9.22(i). Substantial years of practice before the USPTO is an aggravating factor because a practitioner “with a great deal of experience should know better than to engage in misconduct.” See STANDARDS at pg. 480; *In re Anderson*, *supra* (practitioner’s over nine years of experience warrants a severe sanction). In 2011, Respondent was admitted to practice law in Canada, although he later relinquished his law license. In 2021, the USPTO granted Respondent reciprocal recognition to practice pursuant to 37 C.F.R. § 11.14(c). Thus, Respondent has at least nine years of trademark legal experience, and the Court should find the aggravating factor of substantial experience in the practice of law. See, e.g., *In re Vickers*, 729 SE.2d 355 (Ga. 2012) (several aggravating factors including lawyers’ six years of law practice experience warranted disbarment); *People v. Townshend*, 933 P.2d 1327 (Colo. 1997) (lawyer with six years of practice found to have substantial experience).

The foregoing aggravating factors, along with the injury Respondent caused to his clients, the intentional and knowing nature of his conduct, and the fact that he violated duties owed to the client, the public, and his profession, warrant the sanction of exclusion in this case.

CONCLUSION

Because Respondent has failed to answer the *Complaint* or otherwise appear in this matter, Respondent is found to be in **DEFAULT** and to have admitted all the allegations in the *Complaint*. Based on the facts hereby admitted, the Court finds that Respondent has violated the USPTO Rules of Professional Conduct as discussed above.

After analyzing the factors enumerated in 37 C.F.R. § 11.54(b), the Court concludes that Respondent’s misconduct warrants the sanction of exclusion. Accordingly, Respondent shall be **EXCLUDED** from practice before the U.S. Patent and Trademark Office in patent, trademark, and other non-patent matters.¹⁸

So **ORDERED**,

**ALEXANDER
FERNANDEZ
-PONS**

Digitally signed by: ALEXANDER
FERNANDEZ-PONS
DN: CN = ALEXANDER
FERNANDEZ-PONS C = US O = U.
S. Government OU = Department of
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Office of the Secretary
Date: 2021.08.23 12:25:57 -04'00'

Alexander Fernández-Pons
United States Administrative Law Judge

Notice of Required Actions by Respondent: Respondent is directed to refer to 37 C.F.R. § 11.58 regarding his responsibilities in the case of suspension or exclusion.

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

¹⁸ An excluded practitioner is eligible to apply for reinstatement no earlier than five years from the effective date of the exclusion. See 37 C.F.R. § 11.60(b). Eligibility is predicated upon full compliance with 37 C.F.R. § 11.58.