

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

In the Matter of	)	
	)	
Thomas Carwin Caraco,	)	Proceeding No. D2019-50
	)	
Respondent	)	
_____	)	

**FINAL ORDER**

Pursuant to 37 C.F.R. § 11.27(b), the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) received for review and approval from the Director of the Office of Enrollment and Discipline (“OED Director”) an Affidavit of Resignation Pursuant to 37 C.F.R. § 11.27 executed by Thomas Carwin Caraco (“Respondent”) on September 10, 2019. Respondent submitted the six-page Affidavit of Resignation to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

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

**Jurisdiction**

Respondent of Delmar, New York is an attorney admitted to practice in law in New York, and currently has no record of public discipline in that jurisdiction. Respondent is also licensed to practice law in Florida, but is currently administratively suspended and not eligible to practice law there. Respondent has practiced before the Office in trademark matters. Respondent is a “practitioner” pursuant to 37 C.F.R. § 11.1. Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*

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

### **Respondent's Affidavit of Resignation**

Respondent acknowledges in his September 10, 2019 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered, and he is not being subjected to coercion or duress.

2. He is aware that, pursuant to 37 C.F.R. § 11.34, the OED Director has filed a Disciplinary Complaint alleging that he violated the USPTO Rules of Professional Conduct, namely: *In re Thomas Carwin Caraco*, Proceeding No. D2019-50. The Complaint alleges, *inter alia*, the following:

- a. Respondent was admitted to practice law in the State of New York on October 15, 2014 (New York Bar Number 5291943).
- b. Respondent was admitted to practice law in the State of Florida on October 1, 2012 (Florida Bar Number 100517).
- c. Respondent practiced trademark law before the USPTO in trademark matters, from his office in Albany, New York.
- d. Respondent's acts and omissions leading to the alleged violations of the USPTO Rules of Professional Conduct were willful.
- e. USPTO regulations require that the person named as the signatory on an electronic trademark document to be filed with the Office must personally enter his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash ("/") symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c), and (e).
- f. The USPTO Trademark Manual of Examining Procedure ("TMEP") provides guidance to practitioners regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

Another person (*e.g.*, paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory.

Just 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.

*See* TMEP § 611.01(c) (case citations omitted) (line spacing added).

- g. The USPTO's signature requirements are critical to the integrity of the United States trademark registration process because each application includes a declaration required to be signed by the person whose name appears on the application as the signatory.
- h. Trademark documents filed with the Office—such as Trademark/Service Mark Statements of Use pursuant to 15 U.S.C. § 1051(d)—typically carry an important warning in the declarations, such as:

*The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.*

- i. Beginning as early as August 19, 2017 and ending on November 1, 2018, Respondent worked with Ms. [REDACTED] who was reciprocally recognized by the USPTO to represent Canadian-located trademark applicants before the Office. Ms. [REDACTED] owns a company called Trademark Angel, Inc. Ms. [REDACTED] and Trademark Angel, Inc. (hereinafter “Ms. [REDACTED]”) are located in Ontario, Canada.
- j. Before working with Ms. [REDACTED] Respondent was unfamiliar with the USPTO signature rule requirements. Once Respondent began working with Ms. [REDACTED] he did not conduct independent research to educate himself about the USPTO signature rule requirements.

- k. Ms. ■■■ utilizes remote non-practitioner assistants and remote practitioners like Respondent, coordinated by Ms. ■■■ to do trademark legal work in the United States before the USPTO.
- l. Respondent's work for Ms. ■■■ involved pre-filing review of documents and applications and trademark prosecution for clients referred to Respondent by Ms. ■■■ Respondent did not communicate directly with his clients at any time.
- m. Contrary to the USPTO trademark signature regulations and guidance referenced in paragraphs e. through h., above, Respondent gave Ms. ■■■ permission for her to enter Respondent's signature on trademark documents filed with the USPTO. Such practice violated the USPTO's trademark signature rules.
- n. Contrary to the USPTO trademark signature regulations and guidance referenced in paragraphs e. through h., above, Respondent also gave Ms. ■■■ permission to allow Trademark Angel's non-practitioner assistants (including those who were located outside the United States) to enter Respondent's signature on trademark documents filed with the USPTO. Such practice violated the USPTO's trademark signature rules.
- o. Respondent did not personally sign the trademark applications and documents filed with the Office in the trademark applications in which Respondent was the attorney of record.
- p. As attorney of record on the Trademark applications and documents where Respondent's signature was entered, Respondent had supervisory authority over Ms. ■■■ and the non-practitioner assistants who entered his signature on trademark applications and documents filed with the Office.
- q. Respondent has not contacted any of the applicants on whose applications and filings his name was entered by Ms. ■■■ and her non-practitioner assistants to inform them that Respondent, as the named signatory, did not personally sign the declarations that were filed in their respective trademark applications and filings.
- r. Respondent has not contacted any of the applicants on whose applications and filings his name was entered by Ms. ■■■ and her non-practitioner assistants to inform his clients about the actual or potential adverse consequences to them of not complying with the USPTO trademark signature rules, including whether the electronic signing of a document, including a declaration, by one other than the named signatory may jeopardize the intellectual property rights of the client.

- s. Respondent has not contacted Ms. [REDACTED] to inquire about whether Ms. [REDACTED] has contacted any of the applicants on whose applications and filings his name was entered by Ms. [REDACTED] and her non-practitioner assistants to inform the clients of the impermissible signatures and the actual or potential adverse consequences of not complying with the USPTO trademark signature rules, including whether the electronic signing of a document, including a declaration, by one other than the named signatory may jeopardize the intellectual property rights of the clients.
- t. Respondent has not contacted Trademark Operations at the USPTO to inform them about the impermissible signatures in the numerous trademark filings and applications where he is the attorney of record.

3. Respondent is aware that based on the allegations set out in the Complaint, that the OED Director is of the opinion that he violated the following provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. § 11.101 (requiring a practitioner to provide competent representation to a client); 37 C.F.R. § 11.103 (requiring a practitioner to act with reasonable diligence and promptness in representing a client); 37 C.F.R. § 11.104(a)(3) (failing to keep the client reasonably informed about the status of a matter); 37 C.F.R. § 11.104(b) (failing to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation); 37 C.F.R. § 11.303(a)(1) (proscribing a practitioner from making false statements of fact or law to the USPTO and requiring a practitioner to correct a false statement of material fact or law previously made to the USPTO by the practitioner); 37 C.F.R. § 11.303(a)(3) (requiring a practitioner to take reasonable remedial measures, including, if necessary, disclosure to the tribunal, if the practitioner comes to know of the falsity of material evidence the practitioner has offered to the tribunal); 37 C.F.R. § 11.303(b) (requiring 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 to take reasonable remedial measures, including, if necessary, disclosure to the tribunal); 37 C.F.R. § 11.303(d) (requiring that a practitioner in an *ex parte* proceeding 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); 37 C.F.R. § 11.503(b) (requiring a practitioner having direct supervisory authority over a non-practitioner assistant to make reasonable efforts to ensure that the non-practitioner's conduct is compatible with the professional obligations of the practitioner); 37 C.F.R. § 11.503(c)(1) (proscribing a practitioner with knowledge of the conduct, from ordering or ratifying the conduct of non-practitioner assistants which would have violated the USPTO Rules of Professional Conduct if it had been engaged in by the practitioner); 37 C.F.R. § 11.503(c)(2) (requiring a practitioner to take reasonable remedial action when the conduct of non-practitioner assistants under the supervision of the practitioner violates the USPTO Rules of Professional Conduct, when the practitioner knows of the conduct at a time when its consequences can be avoided or mitigated); 37 C.F.R. § 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation); 37 C.F.R. § 11.804(d) (engaging in conduct prejudicial to the administration of justice); and/or 37 C.F.R. § 11.804(i) (engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the USPTO).

4. Without admitting to violating any of the disciplinary rules of the USPTO Rules of Professional Conduct outlined in the Complaint *In re Thomas Carwin Caraco*, Proceeding No. D2019-50, Respondent acknowledges that, if and when he applies for reinstatement under 37 C.F.R. § 11.60 to practice before the USPTO in trademark and/or other non-patent matters, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that (a) the allegations regarding him in the Complaint *In re Thomas Carwin Caraco*, Proceeding No. D2019-50 are true, and (b) he could not have successfully defended himself against such allegations.

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

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

#### **Exclusion on Consent**

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

1. Respondent's Affidavit of Resignation shall be, and hereby is, approved;
2. Respondent shall be, and hereby is, excluded on consent from practice before the Office in trademark and other non-patent matters commencing on the date of this Final Order;
3. The OED Director shall electronically publish the Final Order at the Office of Enrollment and Discipline's electronic FOIA Reading Room, which is publicly accessible at <https://foiadocuments.uspto.gov/oed/>;
4. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

#### **Notice of Exclusion on Consent**

This notice concerns Thomas Carwin Caraco, of Delmar, New York. Mr. Caraco is an attorney admitted to practice in New York, and currently has no record of public discipline. Mr. Caraco is also licensed to practice law in Florida, but currently is administratively suspended and not eligible to practice in Florida. The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has accepted Mr. Caraco's affidavit of resignation and ordered his exclusion on consent from practice before the Office in trademark and other non-patent law matters.

Mr. Caraco voluntarily submitted his affidavit at a time when a disciplinary investigation was pending against him. The investigation concerned Mr. Caraco practicing trademark law before the USPTO in trademark matters from his Office in Albany, New York, in violation of the USPTO signature rules and regulations. USPTO regulations require that the person named as the signatory on an electronic trademark document to be filed with the Office must personally enter his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c), and (e); TMEP § 611.01(c).

Beginning as early as August 19, 2017 and ending on November 1, 2018, Mr. Caraco worked with a Canadian trademark practitioner and her company located in Ontario, Canada. Before working with the Canadian trademark practitioner, Mr. Caraco was unfamiliar with the USPTO signature rule requirements. Once Mr. Caraco began working with the Canadian trademark practitioner he did not conduct independent research to educate himself about the USPTO signature rule requirements. The Canadian trademark practitioner utilized remote non-practitioner assistants and remote practitioners like Mr. Caraco to do trademark legal work in the United States before the USPTO. Mr. Caraco’s work for the Canadian trademark practitioner involved pre-filing review of documents and applications and trademark prosecutions for clients referred to Mr. Caraco by the Canadian trademark practitioner. Mr. Caraco did not communicate directly with his clients at any time.

Contrary to the USPTO trademark signature rules and regulations, Mr. Caraco gave the Canadian trademark practitioner permission for her to enter Mr. Caraco’s signature on trademark filings, including trademark applications that were filed with the USPTO. Such practice violated the USPTO’s trademark signature rules. Mr. Caraco also gave the Canadian trademark practitioner permission to allow non-practitioner assistants located outside the United States to enter Mr. Caraco’s signature on trademark filings, including trademark applications that were filed with the USPTO. Such practice violated the USPTO’s trademark signature rules. Mr. Caraco did not personally sign the trademark applications and documents in the trademark applications. As attorney of record on the Trademark applications and documents where Mr. Caraco’s signature was entered, Mr. Caraco had supervisory authority over the non-practitioner assistants who entered his signature.

Mr. Caraco has not contacted any of the applicants on whose applications and filings his name was entered by the Canadian trademark practitioner and her non-practitioner assistants, to inform them that he, as the named



signatory, did not personally sign the declarations that were filed in their respective trademark applications and filings.

Mr. Caraco has not contacted any of the applicants on whose applications and filings his name was entered by the Canadian trademark practitioner and her non-practitioner assistants, to inform his clients about the actual or potential adverse consequences to them of not complying with the USPTO trademark signature rules, including whether the electronic signing of a document, including a declaration, by one other than the named signatory may jeopardize the intellectual property rights of the clients.

Respondent has not contacted the Canadian trademark practitioner for whom he worked to inquire whether she has contacted any of the applicants on whose applications and filings his name was entered by her and her non-practitioner assistants to inform the clients of the impermissible signatures and the actual or potential adverse consequences to them of not complying with the USPTO trademark signature rules, including whether the electronic signing of a document, including a declaration, by one other than the named signatory may jeopardize the intellectual property rights of the clients.

Mr. Caraco has not contacted Trademark Operations in the USPTO to inform them about the impermissible signatures in the numerous trademark filings and applications where he is the attorney of record.

Mr. Caraco acknowledged that the OED Director was of the opinion that his conduct violated 37 C.F.R. §§ 11.101 (requiring a practitioner to provide competent representation to a client); 11.103 (requiring a practitioner to act with reasonable diligence and promptness in representing a client); 11.104(a)(3) (failing to keep the client reasonably informed about the status of a matter); 11.104(b) (failing to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation); 11.303(a)(1) (proscribing a practitioner from making false statements of fact or law to the USPTO and requiring a practitioner to correct a false statement of material fact or law previously made to the USPTO by the practitioner); 11.303(a)(3) (requiring a practitioner to take reasonable remedial measures, including, if necessary, disclosure to the tribunal, if the practitioner comes to know of the falsity of material evidence the practitioner has offered to the tribunal); 11.303(b) (requiring 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 to take reasonable remedial measures, including, if necessary, disclosure to the tribunal); 11.303(d) (requiring that a practitioner in an *ex parte* proceeding to 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); 11.503(b) (requiring a practitioner having direct supervisory authority over a non-practitioner assistant to make reasonable efforts to ensure that the non-practitioner's conduct is compatible with the professional obligations of the practitioner); 11.503(c)(1) (proscribing a practitioner with knowledge of the conduct, from ordering or ratifying the conduct of non-practitioner assistants which would have violated the USPTO Rules of Professional Conduct if it had been engaged in by the practitioner); 11.503(c)(2) (requiring a practitioner to take reasonable remedial action when the conduct of non-practitioner assistants under the supervision of the practitioner violates the USPTO Rules of Professional Conduct, when the practitioner knows of the conduct at a time when its consequences can be avoided or mitigated); 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation); 11.804(d) (engaging in conduct prejudicial to the administration of justice); and 11.804(i) (engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the USPTO).

While Mr. Caraco did not admit to violating any provisions of the USPTO Rules of Professional Conduct as alleged in the Complaint, he acknowledged that, if and when he applies for reinstatement, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that (i) the allegations set forth in the Complaint against him are true, and (ii) he could not have successfully defended himself against those allegations.

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

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



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

12 Sept 2019

Date

on delegated authority by

Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

cc:

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

Mr. Thomas Carwin Caraco  
532 Kenwood Avenue  
Delmar, New York 12054  
[REDACTED]