

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

In the Matter of)
Kevin R. Gallagher,)
Respondent)
_____)

Proceeding No. D2023-28

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 Kevin R. Gallagher (“Respondent”) on June 16, 2023.

Respondent submitted the eight-page Affidavit of Resignation to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

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

Jurisdiction

Respondent of Flemington, New Jersey, is an attorney admitted to practice in New Jersey and Pennsylvania. Respondent has practiced before the Office in trademark matters, but he is not registered and not otherwise eligible to represent other persons before the Office in patent 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 all matters before the Office.

Respondent's Affidavit of Resignation

Respondent acknowledges in his June 16, 2023 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered in the making of the Affidavit, and he is not being subjected to coercion or duress.

2. He is aware that, pursuant to 37 C.F.R. § 11.22, the Director of the Office of Enrollment and Discipline ("OED Director") opened an investigation of allegations that he violated the USPTO Rules of Professional Conduct, namely: OED File No. G4201.

He is aware that the investigation is pending and concerns, *inter alia*, the following information involving his alleged misconduct:

- a. Respondent has been licensed to practice law for over thirty (30) years. For most of his career, however, Respondent has not practiced law but has worked for insurance companies in non-attorney positions.
- b. Mr. Tony C. Hom is a friend of Respondent. Respondent has known him since 1999. Mr. Hom is a USPTO registered practitioner and an attorney licensed by the State of New York.
- c. In August 2020, the Office of Enrollment and Discipline ("OED") informed Mr. Hom that he was being investigated for alleged violations of the USPTO Rules of Professional Conduct in connection with Mr. Hom's representation of China-domiciled trademark applicants and the U.S. Counsel Rule. From August 2020 to July 2021, OED investigated Mr. Hom's alleged misconduct (including requesting and receiving information from Mr. Hom) and endeavored to resolve the matter via settlement negotiations with Mr. Hom.
- d. On August 20, 2021, the OED Director filed *In re Hom*, Proceeding No. D2021-10, which instituted formal disciplinary charges against Mr. Hom for alleged violations of the USPTO Rules of Professional Conduct in connection with Mr. Hom's representation of China-domiciled trademark applicants who were referred to Mr. Hom by third-party intermediaries and associates located in China. On September 10, 2021, Mr. Hom filed a motion for an extension of time

to file his answer to the formal disciplinary charges in *In re Hom*, Proceeding No. D2021-10. On October 19, 2021, Mr. Hom filed his answer in *In re Hom*, Proceeding No. D2021-10.

- e. Following the filing of the formal disciplinary charges against Mr. Hom, the OED Director and Mr. Hom, through their respective counsel, engaged in settlement negotiations to resolve *In re Hom*, Proceeding No. D2021-10. On December 10, 2021, Mr. Hom signed a Proposed Settlement Agreement, and on December 13, 2021, the OED Director signed the Proposed Settlement Agreement to resolve *In re Hom*, Proceeding No. D2021-10.
- f. In connection with the settlement negotiations culminating in the Final Order in *In re Hom*, Proceeding No. D2021-10, Mr. Hom (i) represented that he fully understands the USPTO trademark signature rules and the U.S. Counsel Rule and how his acts and omissions implicated provisions of the USPTO Rules of Professional Conduct, and (ii) expressed his understanding of the seriousness of the violations of the USPTO Rules of Professional Conduct and the potential adverse impact on his clients' intellectual property rights from the trademark filings that were made in violation of the USPTO's trademark regulations.
- g. On December 17, 2021, the USPTO Director approved the parties' Proposed Settlement Agreement and entered a Final Order in *In re Hom*, Proceeding No. D2021-10 suspending Mr. Hom for two years on ethical grounds for violating numerous provisions of the USPTO Rules of Professional Conduct in connection with Mr. Hom's practice before the Office in trademark matters.
- h. The Final Order entered in *In re Hom*, Proceeding No. D2021-10 explains that Mr. Hom engaged in professional misconduct as follows:
 - i. Mr. Hom violated 37 C.F.R. § 11.101 (practitioner shall provide competent representation) by, *inter alia*, not ensuring that he knew and understood the U.S. Counsel Rule, the USPTO specimen rules, and the USPTO trademark signature rules, which resulted in violations of those rules in the course of representing trademark clients;
 - ii. Mr. Hom violated 37 C.F.R. § 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) by failing to take reasonable steps to ensure that his clients' trademark filings were prepared, reviewed, signed, and filed in compliance with the U.S. Counsel Rule, the USPTO specimen rules, and the USPTO trademark signature rules;
 - iii. Mr. Hom violated 37 C.F.R. §§ 11.104(a) and (b) (communications with client) by not informing his clients, directly or through any associate, as to the actual or potential adverse consequences of not complying with the U.S. Counsel Rule, the USPTO specimen rules, and the USPTO

trademark signatures rules, so that the clients could make informed decisions about their trademark applications and/or issued registrations;

- iv. Mr. Hom violated 37 C.F.R. § 11.503(b) (responsibilities regarding non-practitioner assistance) by authorizing or otherwise allowing non-practitioners to prepare drafts of trademark documents without adequate supervision to ensure that such documents were being prepared with proper specimens;
 - v. Mr. Hom violated 37 C.F.R. § 11.505 (assisting unauthorized practice before the USPTO in trademark matters) by authorizing non-practitioners to communicate with his clients and provide advice to such clients about specimens; and
 - vi. Mr. Hom violated 37 C.F.R. § 11.804(d) (conduct prejudicial to the integrity of the U.S. trademark registration system) by (i) not complying with the U.S. Counsel Rule and the USPTO trademark signature rules, and (ii) not complying with 37 C.F.R. § 11.18 by not conducting a reasonable inquiry prior to filing trademark documents filed with the USPTO, with the knowledge that the USPTO would rely on such trademark documents in examining applications and issuing registrations.
- i. The OED Director asserts that Respondent reasonably should have known about Mr. Hom's unethical conduct prior to October 2022. Even though Respondent had not practiced trademark law previously, the OED Director asserts that he reasonably should have known about the numerous published USPTO decisions disciplining practitioners for violations of the USPTO Rules of Professional Conduct based on the practitioners' violations of the U.S. trademark signature rules and the U.S. Counsel Rule prior to October 2022.
 - j. In October 2021, Mr. Hom told Respondent that he had a lot of trademark work with which he needed help. Mr. Hom said that his trademark clients were from China and required U.S. licensed attorneys to file their trademark applications on their behalf.
 - k. Respondent agreed to represent foreign-domiciled trademark applicants before the USPTO, including taking over the representation of approximately 3,500 pending trademark matters from Mr. Hom. Respondent did so because he needed the money.
 - l. Mr. Hom informed Respondent about Wuzhou Puhua IP Group, a China-based company. Thereafter, Respondent received trademark work from Wuzhou Puhua IP Group. Respondent received trademark work from Wuzhou Puhua IP Group pursuant to an "International Trademark Agency Cooperation Agreement" into which Respondent entered with Hangzhou Wuzhuo Trademark

Service Company, Ltd. According to Respondent's agreement with Hangzhou Wuzhou Trademark Service Company, Ltd., he agreed to accept minimal compensation for his trademark legal services, including, but not limited to, the following fees:

- i. fifty-five dollars (\$55.00) per U.S. trademark application "for clients with pre-drafted filing plans;"
 - ii. fifteen dollars (\$15.00) per "pre-prepared" reply to Office Actions; and
 - iii. twenty dollars (\$20.00) per filing of a Statements of Use.
- m. Respondent estimates that he earned about \$3,986 in 2021 and \$6,228 in 2022 working for Wuzhou Puhua IP Group and Hangzhou Wuzhou Trademark Service Company, Ltd.
- n. In connection with Respondent's work for Wuzhou Puhua IP Group, Mr. Hom had Respondent open a USPTO.gov account in Respondent's name (*i.e.*, the USPTO.gov account with the user identification: kgallagher55@gmail.com). Mr. Hom knew the password to this account and had access to it. Respondent is not aware of anyone else using the account, but he did not closely monitor its usage. Aside from the USPTO.gov account with the user identification: kgallagher55@gmail.com email address, Respondent also used another USPTO.gov account (*i.e.*, the USPTO.gov account with the user identification: kg709@outlook.com email address) in connection with his trademark practice. This account was created by Mr. Hom and used by the Hangzhou Wuzhou Trademark Service Company, Ltd. representative who signed the "International Trademark Agency Cooperation Agreement." Respondent's point of contact at Wuzhou Puhua IP Group and her associates had access to this account. Respondent did not understand his responsibilities regarding the USPTO subscriber agreements or the USPTO.gov accounts used in his trademark practice.
- o. Mr. Hom provided some training to Respondent on U.S. trademark law, but Mr. Hom did not train Respondent on the USPTO trademark signature rules, the U.S. Counsel Rule, or the duty under 37 C.F.R. § 11.18 to conduct an inquiry reasonable under the circumstances prior to presenting trademark papers to the USPTO. While representing trademark applicants before the USPTO, Respondent did not adequately understand U.S. trademark laws and regulations; the USPTO signature rules; or the U.S. Counsel Rule. For example, Respondent filed at least one Request to Make Special, but he did not know what was a "Request to Make Special."
- p. While representing trademark applicants before the USPTO, Respondent should have adequately understood U.S. trademark laws and regulations, the USPTO signature rules, and the U.S. Counsel Rule, but he did not.

- q. Starting in October 2021, Respondent filed trademark applications for foreign-domiciled applicants referred to him by Wuzhou Puhua IP Group. Respondent is the named signatory on over 640 separate trademark documents filed with the USPTO from mid-October 2021 through September 2022 on behalf of applicants referred to Respondent by Wuzhou Puhua IP Group. These documents included Principal Register (TeasPlus) Trademark/Service Mark Applications; Trademark/Service Mark Allegations of Use (Statement of Use); Responses to Office Action; Statements of Use Extension Request; Response to Suspension Inquiry or Letter of Suspension; Declarations of Use and/or Excusable Nonuse of Mark in Commerce Under Section 8; Declarations of Use and Excusable Nonuse under Section 71; Declarations of Incontestability of a Mark under Section 15; and Responses to Office Action for Post-Registration Matters).
- r. For each trademark application or filing, Wuzhou Puhua IP Group would generally provide Respondent with an OBJ file and information received from the trademark applicant for his review and filing. Respondent would receive and review the information, upload the OBJ file to the USPTO system, sign the application's declaration, pay the filing fee using one of two credit cards provided by Wuzhou Puhua IP Group or Hangzhou Wuzhuo Trademark Service Company, Ltd, and file the application. Respondent typically spent only a short amount of time reviewing filings prior to signing and filing. He took no action to confirm, corroborate, or otherwise verify the information provided to him. Respondent relied on the information being provided to him to be accurate. For example, he never clicked on URLs identified for specimens to determine whether the webpage was bona fide, and he relied on Wuzhou Puhua IP Group to inquire and provide the first date of use in commerce for a §1(a) application.
- s. Respondent signed the trademark filings based upon representations made by Wuzhou Puhua IP Group; he did not verify the information provided with Wuzhou Puhua IP Group or the trademark applicants. Respondent did not realize he was signing trademark application declarations under penalty of perjury pursuant to 18 U.S.C. § 1001. Respondent received pre-prepared Responses to Office Actions from Wuzhou Puhua IP Group, and he would sign and file the responses without making any changes. During October 2021, Respondent impermissibly allowed Mr. Hom to sign his name on at least thirty-nine (39) trademark filings. Mr. Hom signed his name during training due to schedule conflicts and when he became ill.
- t. Respondent, as the attorney of record for trademark applicants, received correspondence addressed to the applicant in at least six USPTO Trademark Trial and Appeal Board ("TTAB") opposition proceedings initiated between January 2022 and August 2022, including one matter (TTAB Proceeding No. 91275308) concerning a trademark application —filed by Mr. Hom and taken over by Respondent in November 2021 and prosecuted by Respondent thereafter— alleging that the applicant had engaged in fraud on the USPTO by,

inter alia, submitting an altered specimen and fraudulently asserting use of the mark in commerce. Respondent was not familiar with the TTAB and did not communicate with Wuzhou Puhua IP Group about any TTAB matters.

3. Respondent is aware that the OED Director is of the opinion that, based on the information obtained in OED File No. G4201, he violated at least the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.101 (practitioner shall provide competent representation) by, *inter alia*, representing trademark applicants before the USPTO when he: (i) did not have substantive knowledge or experience in USPTO trademark laws, rules, regulations, or procedure representing trademark applicants before the USPTO; (ii) did not know or understand his obligations under 37 C.F.R. § 11.18 to conduct an inquiry reasonable under the circumstances to support the factual contentions in declarations attached to applications bearing his signature prior to presenting papers; (iii) did not know or understand the USPTO trademark signature rules; and (iv) did not know or understand the U.S. Counsel Rule;
- b. 37 C.F.R. § 11.103 (diligence) by, *inter alia*, (i) failing to take reasonable steps to ensure that his clients' trademark filings were prepared, reviewed, signed, and filed in accordance with the laws, rules, and regulations applicable to representing others before the USPTO in trademark matters, and (ii) reviewing and signing certifications in trademark documents filed with the Office without first conducting an inquiry reasonable under the circumstances in violation of 37 C.F.R. § 11.18;
- c. 37 C.F.R. § 11.504(c) (a practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another to direct or to regulate the practitioner's professional judgment in rendering such legal services) by, *inter alia*, signing and filing trademark documents prepared by Wuzhou Puhua IP Group when he: (i) did not have substantive knowledge or experience in USPTO trademark laws, rules, regulations, or procedure representing trademark applicants before the USPTO; (ii) did not know or understand his obligations under 37 C.F.R. § 11.18 to conduct an inquiry reasonable under the circumstances to support the factual contentions in declarations attached to applications bearing his signature prior to presenting papers; (iii) did not know or understand the USPTO trademark signature rules; and (iv) signed and presented trademark documents with the USPTO without verifying the information provided and typically spending only a short amount of time reviewing documents prior to signing and filing them;
- d. 37 C.F.R. § 11.505 (assisting others in the unauthorized practice before the Office in trademark matters) by, *inter alia*, (i) authorizing non-practitioners at Wuzhou Puhua IP Group to communicate with his clients and provide advice to

such clients about their trademark applications, and (ii) signing and filing trademark documents with the USPTO prepared by Wuzhou Puhua IP Group without verifying the information provided;

- e. 37 C.F.R. § 11.804(c) (engaging in deceit, dishonesty, and misrepresentation) by, *inter alia*, (i) authorizing another person to impermissibly sign his name to trademark applications and appurtenant declarations that were filed with the USPTO, and (ii) signing certifications without conducting an inquiry reasonable under the circumstances to support the factual contentions in declarations attached to applications bearing his signature as required by 37 C.F.R. § 11.18;
- f. 37 C.F.R. § 11.804(d) (conduct prejudicial to the integrity of the U.S. trademark registration system) by, *inter alia*: (i) not knowing or understanding his obligations under 37 C.F.R. § 11.18 to conduct an inquiry reasonable under the circumstances to support the factual contentions in declarations attached to applications bearing his signature prior to presenting papers; (ii) not knowing or understanding the USPTO trademark signature rules; (iii) not knowing or understanding the U.S. Counsel Rule; (iv) failing to take reasonable steps to ensure that his clients' trademark filings were prepared, reviewed, signed, and filed in accordance with the laws, rules, and regulations applicable to representing others before the USPTO in trademark matters and the U.S. Counsel Rule; (v) reviewing and signing certifications in trademark documents filed with the Office without first conducting an inquiry reasonable under the circumstances in violation of 37 C.F.R. § 11.18; (vi) authorizing another person to impermissibly sign his name to trademark applications and appurtenant declarations that were filed with the USPTO; and (vii) signing certifications without conducting an inquiry reasonable under the circumstances to support the factual contentions in declarations attached to applications bearing his signature as required by 37 C.F.R. § 11.18; and
- g. 37 C.F.R. § 11.804(i) (engaging in other conduct that adversely reflects on a practitioner's fitness to practice before the USPTO) by, *inter alia*, representing other persons before the USPTO in trademark matters in light of: (i) his lack of experience in trademark matters; (ii) his lack of adequate training in trademark practice before the USPTO; (iii) his lack of awareness that his conduct violated agency trademark signature rules and the U.S. Counsel Rule; (iv) his unreasonable lack of knowledge of Mr. Hom's misconduct; (v) his unreasonable lack of knowledge of the ample published USPTO disciplinary decisions concerning the agency's trademark signature rules and the agency's U.S. Counsel Rule; and (vi) his lack of knowledge of his obligation under 37 C.F.R. § 11.18 to conduct a reasonable inquiry under the circumstances prior to presenting such documents to the USPTO instead of relying on non-practitioners to prepare trademark documents for his signature.

4. Without admitting to violating any of the provisions of the USPTO Rules of Professional Conduct investigated by the OED Director in OED File No. G4201, Respondent acknowledges that, if and when he applies for reinstatement under 37 C.F.R. § 11.60 to practice before the USPTO, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that:

- a. (i) the facts regarding him in OED File No. G4201 are true, and
- b. (ii) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated 37 C.F.R. §§ 11.101, 11.103, 11.504(c), 11.505, 11.804(c), 11.804(d), and 37 C.F.R. § 11.804(i).

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

6. Respondent consents to being excluded from practice before the USPTO in all 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 all 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 Kevin R. Gallagher, an attorney admitted to practice law in New Jersey and Pennsylvania, and who has practiced before the Office in trademark matters. The Director of the United States Patent and Trademark Office (“USPTO” or “Office”) has accepted Mr. Gallagher’s affidavit of resignation and ordered his exclusion on consent from practice before the Office in all matters. Mr. Gallagher is not registered and not otherwise eligible to represent other persons before the Office in patent matters.

Mr. Gallagher voluntarily submitted his affidavit at a time when a disciplinary investigation was pending against him. The investigation concerned, *inter alia*, the following information involving his alleged misconduct under sections 11.101, 11.103, 11.504(c), 11.505, 11.804(c), 11.804(d), and 11.804(i) of the USPTO Rules of Professional Conduct in connection with his representation of foreign-domiciled trademark applicants before the USPTO.

The USPTO has published ample, readily available information for practitioners regarding what is competent practice before the Office in trademark matters. For example, the agency maintains a webpage regarding important trademark information ([link](#)), including specific links to relevant laws, rules, regulations, and rulemaking ([link](#)). The agency publishes online and regularly updates its Trademark Manual of Examining Procedure (“TMEP”) ([link](#)). The TMEP provides trademark practitioners, *inter alia*, with a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO. The TMEP provides unambiguous information about the agency’s signature requirements at TMEP § 611.01(c) (stating, in part, “All documents must be personally signed or bear an electronic signature that was personally entered by the named signatory”). 37 C.F.R. §2.193(a)(1), (c)(1). Another person (*e.g.*, paralegal, legal assistant, secretary) may not sign or enter the name of an attorney or other authorized signatory. See *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Cowan*, 18 USPQ2d 1407 (Comm’r Pats. 1990).” (parenthesis in original)). It also maintains a webpage earmarked for information concerning the agency’s trademark administration sanctions process ([link](#)); see also *New U.S. Counsel rule: USPTO’s Initiatives to Ensure Accuracy and Integrity of the Trademark Register* (July 30, 2019) ([link](#)); see also *Trademarks Administrative Sanctions Process*, 87 FR 431 (Jan. 5, 2022) (Notice of Proposed Rule Making) ([link](#)).

The USPTO has published online ample information about the U.S. Counsel Rule. *See, e.g., Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, 84 FR 31498 (Final Rule) (July 2, 2019) ([link](#)).

Therefore, practitioners who represent applicants, registrants, or others before the USPTO in trademark matters — including those who serve as U.S. counsel for foreign domiciled clients — are reasonably expected to know (a) the laws, rules, regulations, and procedures pertaining to their representation of their trademark clients, and (b) the potential adverse consequences to clients' intellectual property rights in trademark applications and registrations as well as to the integrity of the U.S. trademark registration system when such laws, rules, regulations, or procedures are violated.

There is also ample, readily available information for practitioners regarding what is ethical practice before the Office in trademark matters. The USPTO Rules of Professional Conduct is published online ([link](#)), and the agency maintains an online searchable Freedom of Information Act Documents page listing all of its professional misconduct disciplinary case decisions ([link](#)).

The USPTO Director has issued and published online numerous Final Orders imposing discipline on practitioners who engaged in professional misconduct by violating USPTO Rules of Professional Conduct predicated on not complying with their obligations under § 11.18 to conduct an inquiry reasonable under the circumstances in support of factual assertions made to the USPTO, including.

In re Anonymous, Proceeding No. D2014-05 (USPTO Apr. 1, 2014)
In re Kroll, Proceeding No. D2014-14 (USPTO Mar. 4, 2016)
In re Hao, Proceeding No. D2021-14 (USPTO Apr. 27, 2022)
In re Zhang, Proceeding No. D2022-16 (USPTO July 11, 2022)
In re Chew, Proceeding D2023-08 (USPTO Jan. 20, 2023)
In re McNally, Proceeding D2023-22 (USPTO Apr. 7, 2023)
In re Wu, Proceeding No. D2023-24 (USPTO Apr. 7, 2023)
In re Li, Proceeding No. D2023-19 (USPTO Apr. 19, 2023)
In re Kanakia, Proceeding D2023-25 (USPTO May 8, 2023)

The USPTO Director has issued numerous Final Orders imposing discipline on practitioners who violated the USPTO Rules of Professional Conduct based on not complying with the agency's trademark signature rules, including:

In re Swyers, Proceeding No. D2016-20 (USPTO Jan. 26, 2017)

In re Meikle, Proceeding No. D2019-17 (USPTO Mar. 21, 2019)
In re Crabtree, Proceeding Nos. D2018-31 & -47 (USPTO Apr. 25, 2019)
In re Sapp, Proceeding No. D2019-31 (USPTO May 15, 2019)
In re Sweeney, Proceeding No. D2019-33 (USPTO June 19, 2019)
In re Mar, Proceeding No. D2019-11 (USPTO Aug. 2, 2019)
In re Rajan, Proceeding No. D2019-30 (USPTO Sep. 5, 2019)
In re Caraco, Proceeding No. D2019-50 (USPTO Sep. 12, 2019)
In re Caldwell, II, Proceeding No. D2020-12 (USPTO Mar. 17, 2020)
In re Bashtanyk, Proceeding No. D2020-09 (USPTO Apr. 17, 2020)
In re Lou, Proceeding No. D2021-04 (USPTO May 12, 2021)
In re Mincov, Proceeding No. D2020-30 (USPTO Aug. 23, 2021)
In re David, Proceeding No. D2021-08 (USPTO Sep. 24, 2021)
In re Li, Proceeding No. D2021-16 (USPTO Oct. 7, 2021)
In re Hom, Proceeding No. D2021-10 (USPTO Dec. 17, 2021)
In re Yang, Proceeding No. D2021-11 (USPTO Dec. 17, 2021)
In re Pasquine, Proceeding No. D2019-39 (USPTO Mar. 28, 2022)
In re Wan, Proceeding No. D2022-04 (USPTO Apr. 1, 2022)
In re Hao, Proceeding No. D2021-14 (USPTO Apr. 27, 2022)
In re Zhang, Proceeding No. D2022-16 (USPTO July 11, 2022)
In re Liu, Proceeding No. D2022-03 (USPTO Aug. 9, 2022)
In re Han, Proceeding No. D2022-23 (USPTO Jan. 6, 2023)
In re Song, Proceeding No. D2023-10 (USPTO May 1, 2023)

The USPTO Director has issued numerous Final Orders imposing discipline on practitioners for violating the USPTO Rules of Professional Conduct while representing foreign-domiciled trademark applicants pursuant to the U.S. Counsel Rule, including:

In re Lou, Proceeding No. D2021-04 (USPTO May 12, 2021)
In re Reddy, Proceeding No. D2021-13 (USPTO Sep. 9, 2021)
In re David, Proceeding No. D2021-08 (USPTO Sep. 24, 2021)
In re Li, Proceeding No. D2021-16 (USPTO Oct. 7, 2021)
In re Hom, Proceeding No. D2021-10 (USPTO Dec. 17, 2021)
In re Yang, Proceeding No. D2021-11 (USPTO Dec. 17, 2021)
In re Wan, Proceeding No. D2022-04 (USPTO Apr. 1, 2022)
In re Morton, Proceeding No. D2022-07 (USPTO Apr. 20, 2022)
In re Hao, Proceeding No. D2021-14 (USPTO Apr. 27, 2022)
In re Zhang, Proceeding No. D2022-16 (USPTO July 11, 2022)
In re Liu, Proceeding No. D2022-03 (USPTO Aug. 9, 2022)
In re Han, Proceeding No. D2022-23 (USPTO Jan. 6, 2023)
In re Song, Proceeding No. D2023-10 (USPTO May 1, 2023)

Therefore, practitioners who represent applicants, registrants, or others before the USPTO in trademark matters — including those who serve as U.S. counsel for foreign domiciled clients — are reasonably expected to know (a) the provisions of the USPTO Rules of Professional Conduct

implicated by such representation, and (b) the potential disciplinary consequences when such provisions of the USPTO Rules of Professional Conduct are violated.

Accordingly, all practitioners engaged in practice before the Office in trademark matters are reasonably aware that a practitioner's failure to comply with his or her obligations under 37 C.F.R. § 11.18, the agency's signature rules, and the agency's U.S. Counsel Rule significantly adversely affect the integrity of the U.S. trademark registration process as well as the intellectual property rights of trademark applicants.

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, with the additional time considerations noted below, which extend the time provided under § 11.58(f) by an additional thirty (30) days;

6. Respondent may satisfy his obligations under 37 C.F.R. § 11.58(c)(3)(i) regarding providing written notice of the order of suspension to clients (e.g., trademark applicants, parties before the USPTO Trademark Trial and Appeal Board, and other persons having prospective or immediate business before the Office in trademark matters) who are domiciled in a foreign country by emailing a copy of this Final Order that has been correctly translated into the client's respective native language to: (1) the email address for each client as set forth in the "Applicant's Information" portion of each client's trademark application (if applicable), but only if such email address is an email address belonging to the client and one that Respondent reasonably believes to which the client has direct access (e.g., not the email address belonging to a foreign-referring entity); (2) an email address belonging to the client and one that Respondent reasonably believes to which the client has direct access (e.g., not the email address belonging to a foreign-referring entity); or (3) to the foreign-referring entity who referred the client to Respondent, but only if: (i)

Respondent takes reasonable measures to ensure that the foreign-referring entity thereafter promptly forwards Respondent's email to the client with this Final Order attached and Respondent is copied on the forwarded email; (ii) Respondent takes reasonable measures to learn from the foreign-referring entity that the client actually received the email and Final Order forwarded to the client; (iii) Respondent's affidavit submitted pursuant to 37 C.F.R. § 11.58(d) sets forth the details of his reasonable measures that are required by this subparagraph; and (iv) any petition for reinstatement filed by or on behalf of Respondent sets forth the details of his reasonable measures that are required by this subparagraph;

7. Respondent shall be granted limited recognition pursuant to 37 C.F.R. § 11.58(f) for sixty (60) days starting on the date of this Final Order so that Respondent may endeavor to conclude work on behalf of clients on any matters pending before the Office and, if such work cannot be concluded within such sixty (60) days, Respondent shall so advise each such client so that the client may make other arrangements;

8. Effective the date of the expiration of the 60-day period of limited recognition afforded to Respondent under 37 C.F.R. § 11.58(f), the USPTO is hereby authorized to disable or suspend any USPTO.gov accounts registered to Respondent as of the date of this Final Order (including all accounts that Respondent has ever established, sponsored, or used in connection with any trademark matter); Respondent shall not apply for a USPTO verified Electronic System account, shall not obtain a USPTO verified Electronic System account, nor shall he have his name added to a USPTO verified Electronic System account, unless and until he is reinstated to practice before the USPTO;

9. Immediately upon expiration of the 60-day period of limited recognition afforded to Respondent under § 11.58(f), Respondent is prohibited from using, assessing, or assisting others

in using or accessing any USPTO.gov account(s) or other USPTO filing systems for preparing or filing documents with the USPTO;

10. Until a petition seeking Respondent's reinstatement to practice before the USPTO is granted pursuant to 37 C.F.R. § 11.60, Respondent shall be prohibited, and the USPTO is authorized to act to disallow Respondent, from the following: (1) opening or activating any USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; (2) applying for, or attempting to apply for, any USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; (3) verifying, or attempting to verify, any other person's credentials in connection with USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; and (4) sponsoring or attempting to sponsor USPTO.gov account(s) to be used for preparing or filing documents with the USPTO;

11. Notwithstanding the granting of any petition requesting Respondent's reinstatement to practice before the USPTO pursuant to 37 C.F.R. § 11.60, nothing in this Final Order requires the USPTO to re-enable or unsuspend any USPTO.gov account disabled or suspended pursuant to this Final Order. Any such accounts shall not be automatically re-enabled or unsuspended, and, instead Respondent shall be responsible for (1) contacting and working with the appropriate USPTO business unit for re-enabling or unsuspending any USPTO.gov account disabled or suspended in this Final Order, or (2) acquiring or creating a new USPTO.gov account, in accordance with the USPTO policies, practices, and rules concerning USPTO.gov accounts existing at such time;

12. Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.

Users, Shewchuk, David
Digitally signed by Users, Shewchuk, David
Date: 2023.06.23
14:39:13 -04'00'

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

Date

on delegated authority by

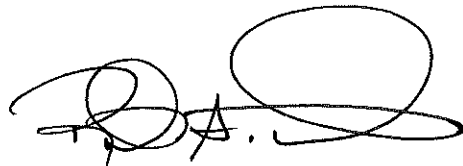
Kathi Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Certificate of Service

I hereby certify the foregoing Final Order was mailed by first-class certified mail, return receipt requested, and transmitted by electronic mail, on this day to Respondent via counsel as follows:

Emil Ali
McCabe Ali LLP
13337 South Street, Suite 555
Cerritos, CA 90703
emil@mccabeali.com

6/23/2023
Date



United States and Trademark Office
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