

Foreign Resident” (Application) to the USPTO. In the Application, Petitioner indicated that he is “registered and in good standing before the Trademark Office of Canadian Intellectual Property Office (CIPO)” and requested “recognition to practice in trademark cases before the United States Patent and Trademark Office.”¹

On March 11, 2011, OED issued a Show Cause Requirement, informing Petitioner that he “[did] not appear to have met the burden of establishing that he is of good moral character and reputation,” as required by 35 U.S.C. § 2(b)(2)(D), and directing Petitioner to “show cause why his request to practice in trademark cases before the USPTO should be granted.”² In support of its preliminary assessment, the Show Cause Requirement cited a list of thirty-six cases in which Petitioner had “been previously listed as the Attorney of Record” and indicated that “questions have arisen concerning the [Petitioner] being listed as Attorney of Record on the . . . listed U.S. Trademark Applications, prior to his January 28, 2011 request to register and practice before the USPTO.”³

On March 25, 2011, Petitioner submitted his response to the Show Cause Requirement indicating that all of the thirty-six United States trademark applications in which he was listed as the Attorney of Record “were filed on behalf of corporations resident in Canada” and that his “failure to submit an application for reciprocal recognition was inadvertent.”⁴

On April 13, 2011, the Acting OED Director issued a Decision determining that Petitioner had failed to demonstrate that he was of good moral character and reputation, and denying Petitioner’s request for recognition to practice in trademark cases before the USPTO. The Decision found that over a twenty-year period (from approximately May 16, 1980, through

¹ Application at 1-2.

² Show Cause Requirement at 1.

³ Show Cause Requirement at 1-2 and 4.

⁴ Response to Show Cause Requirement at 1.

September 21, 2010), Petitioner, without applying for and being granted reciprocal recognition by the OED Director, had filed and prosecuted thirty-six trademark applications.⁵

Petitioner now seeks review of the OED Director’s Decision pursuant to 37 C.F.R. § 11.2(d). In his Petition for Review, Petitioner argues that the OED Director erred in finding that Petitioner has not sustained his burden of showing that he is of good moral character and reputation because (1) the “entire purpose of 35 U.S.C. § 2(b)(2)(D) is protection of the public from unqualified practitioners” and the determination as to whether an applicant has met his burden of showing good moral character and reputation is therefore unimportant to effectuating the mission of the Office articulated in the statute;⁶ (2) there is no evidence that the public suffered any harm as a result of Petitioner’s unauthorized practice before the Office;⁷ and (3) Petitioner’s past unauthorized practice was inadvertent.⁸ Each of Petitioner’s arguments is addressed separately below.

II. LEGAL STANDARD

The recognition of all practitioners, foreign and domestic, before the Office is subject to 35 U.S.C. § 2(b)(2)(D), which states in pertinent part that the USPTO may establish regulations which:

may require [agents, attorneys, or other persons representing applicants or other parties before the USPTO], before being recognized as representatives of applicants or other persons, *to show that they are of good moral character and reputation* and are possessed of the necessary qualifications to render to applicant or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.

(emphasis added).

⁵ Decision at 5.

⁶ Petition at 2-3.

⁷ Petition at 2.

⁸ *Id.*

Furthermore, 37 C.F.R. § 11.14 governs the admission of foreign trademark attorneys and agents to practice before the USPTO. 37 C.F.R. § 11.14 states, in pertinent part:

(c) *Foreigners.* Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal registration . . . and prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices and *is possessed of good moral character and reputation*, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters

(e) No individual other than those specified [above] . . . will be permitted to practice before the Office in trademark matters on behalf of a client.

(emphasis added).

III. ANALYSIS

A. *Scope of Statutory Authority*

Petitioner asserts that the OED Director misapplied 35 U.S.C. § 2(b)(2)(D). Specifically, Petitioner argues that in determining that Petitioner does not meet the requirements for recognition to practice in trademark cases before the Office – because he failed to fulfill his burden of showing that he is of good moral character and reputation – the OED Director failed to recognize that the entire purpose of 35 U.S.C. § 2(b)(2)(D) is to protect the public from unqualified practitioners.⁹ Thus, Petitioner implies that if an applicant for reciprocal recognition possesses sufficient professional credentials, the importance placed on the requirement that the applicant provide a showing of good moral character and reputation should be minimized. Petitioner’s assertion is not persuasive.

35 U.S.C. § 2(b)(2)(D) authorizes the USPTO Director to require agents, attorneys, or other persons representing applicants or other parties before the Office, not only show that they

⁹ Petition at 2-3.

“are possessed of the necessary qualifications to render . . . valuable service” but that they are also of “good moral character and reputation.”¹⁰ Pursuant to that authorization, the OED Director requires applicants to show that they are of good moral character. The requirement to demonstrate good moral character was put into place in recognition of USPTO’s “responsib[ility] for protecting the public from the evil consequences that might result if practitioners should betray their high trust.”¹¹ The OED Director, thus, appropriately applied the law when he required Petitioner to show that he not only possessed the necessary qualifications, but he possessed good moral character before reciprocal recognition would be granted pursuant to 37 C.F.R. § 11.14(c).¹²

B. Significance of Unauthorized Practice

Petitioner’s assertion that his past unauthorized practice should be excused because there is no evidence that the trademark applications he submitted were not properly prepared or that the public suffered any harm as a result thereof¹³ is not compelling. The OED Director “must exercise his judgment carefully in determining whether Petitioner has shown he is of good moral character.”¹⁴ “[A]n applicant’s unauthorized practice of law is a relevant factor in evaluating moral character.”¹⁵

Whether the trademark applications submitted by Petitioner were properly prepared or resulted in public harm is irrelevant to the issue of whether he has met his burden of showing that

¹⁰ 35 U.S.C. § 2(b)(2)(D).

¹¹ *Kingsland v. Dorsey*, 338 U.S. 318, 319-20 (1949) (internal quotations omitted). *Cf. Lipman v. Lehman*, 1996 WL 420869 (D.D.C. 1996) (citing *Dorsey* and stating “that attorneys practicing before the PTO have a special relationship to the PTO . . . [that] ‘requires the highest degree of candor and good faith.’”)

¹² *See* 35 U.S.C. § 2(b)(2)(D).

¹³ Petition at 2.

¹⁴ *Moral_16 @ 9* (July 15, 2009) (OED Reading Room) (citing *Schware v. Board of Bar Examiners of New Mexico*, 335 U.S. 232, 248 (1957)). *Moral_16* is accessible at the following web address: http://des.uspto.gov/Foia/ReterivePdf?system=OED&fNm=0563_MOR_2009-07-15

¹⁵ *Id.* at 9 (citing *In re Singer*, 819 So.2d 1017 (La. 2002); *In re Greenwald*, 808 A.2d 1231 (D.C. 2002)); *See, e.g., Colorado v. Corbin*, 82 P.3d 373 (Colo. 2003) (disbarring practitioner for the unauthorized practice of law by filing trademark applications while under a suspension order).

he is of good moral character and reputation. Petitioner was required to be recognized to practice before the USPTO by the OED Director before filing any trademark applications.¹⁶ By violating this requirement, Petitioner has demonstrated that he does not possess the good moral character and reputation required for the OED Director to be able to recognize him to practice before this Office.¹⁷

C. Inadvertence

Petitioner argues that his past unauthorized practice should be excused because it was inadvertent and thus is not an indication of a lack of good moral character.¹⁸ This argument is not persuasive.

USPTO regulations have – during the twenty-year period during which Petitioner engaged in the unauthorized practice of law before the Office – clearly and consistently required foreign attorneys to apply for and obtain the appropriate recognition from the USPTO prior to practicing before the Office in trademark matters.¹⁹ Further, the Trademark Manual of Examining Procedure (TMEP) clearly provides that “[a] foreign attorney . . . may not practice before the USPTO in trademark matters prior to being recognized by the OED Director.”²⁰ Over a twenty-year period, Petitioner filed and prosecuted thirty-six trademark applications even though he had not applied for or been recognized to practice before the Office by the OED Director. Petitioner claims that he was technically qualified to practice trademark law; thus, he

¹⁶ 37 C.F.R. § 11.14.

¹⁷ 35 U.S.C. § 2(b)(2)(D); 37 C.F.R. § 11.14(c).

¹⁸ Petition at 2.

¹⁹ 37 C.F.R. § 11.14. In 1980, the year Petitioner first engaged in unauthorized practice before the Office, the requirement was codified in 37 C.F.R. § 2.12(c) and (e).

²⁰ TMEP § 602.03.

should be well versed in the Office's regulations. As such, Petitioner's failure to seek reciprocal recognition over a twenty-year period is inexcusable.²¹

III. CONCLUSION

Petitioner has engaged in the unauthorized practice of law over the course of twenty years by filing documents with the USPTO without properly being recognized by the OED Director to represent foreign applicants. The OED Director's determination that Petitioner has failed to demonstrate that he possesses good moral character and reputation for recognition to practice in trademark cases before the Office is appropriate and should be affirmed. Upon reapplication for reciprocal recognition, Petitioner has the burden of establishing that he has been rehabilitated.²²

ORDER

Upon consideration of the petition to the USPTO Director for review under 37 C.F.R. § 11.2(d), it is ORDERED that Petitioner's request for reciprocal recognition to practice as a foreign attorney in trademark cases before the Office is **DENIED**, and the April 13, 2011, decision of the OED Director is **AFFIRMED**.

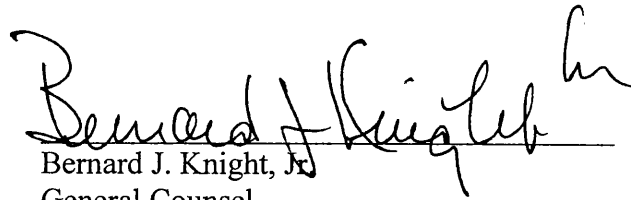
[signature page follows]

²¹ Petitioner points out that at all relevant times, he has been a member in good standing of the Law Society of Upper Canada. Petition at 2. However, this fact is of little or no consequence in his practice before the Office in view of Petitioner's continuous and long-standing disregard of USPTO regulations.

²² Law. Man. Of Prof. Conduct (ABA/BNA) 21:801 (Apr. 17, 1985). *Cf. Hightower v. State Bar*, 34 Cal 3d 150, 157 (1983) (although a petitioner for application to the California State Bar had engaged in the unauthorized practice of law, he could qualify for bar membership by demonstrating rehabilitation and moral qualification); 37 C.F.R. § 11.7(i).

SEP _ 6 2011

Date



Bernard J. Knight, Jr.
General Counsel
United States Patent and Trademark Office

on behalf of

David J. Kappos
Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent
and Trademark Office

cc:

Director
Office of Enrollment and Discipline
Mailstop OED
USPTO
P.O. Box 1450
Alexandria, VA 22313-1450