

in good standing before the patent and trademark office in Canada[,]” and requested recognition “by the United States Patent & Trademark Office for the limited purpose of representing parties located in Canada before the Office in the presentation and prosecution of trademark cases.” Request at 1.

On November 21, 2007, OED issued a Show Cause Requirement, informing 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 to “show cause why his request to practice in trademark cases before the USPTO should not be denied.” Show Cause Requirement at 1. In support of its preliminary assessment, the Show Cause Requirement cited an extensive list of cases in which Petitioner had

prosecuted ... trademark applications before the Office without having received recognition pursuant to 37 C.F.R. § 10.14(c). Even after having been informed that “[f]oreign attorneys are not permitted to practice before the USPTO, other than properly authorized Canadian attorneys,” [Petitioner] continued to prosecute trademark applications.

Show Cause Requirement at 5. The OED Director also identified an apparent lack of truthfulness, citing Petitioner’s April 30, 2007, statement in a response to an Office action in which Petitioner claimed that he had been granted reciprocal recognition, when, in fact, he had not received such recognition. *Id.*

On December 19, 2007, Petitioner submitted his response to the Show Cause Requirement. The OED Director thoroughly considered Petitioner’s submission before issuing a decision on March 16, 2009, determining that Petitioner had failed to demonstrate that he was of good moral character and reputation, and therefore denying Petitioner’s request for recognition to practice before the USPTO as a foreign attorney.

now seeks review of the OED Director's decision under 37 C.F.R. § 11.2(d).

In his Petition for Review, [redacted] argues that (1) because the record contains no evidence of "moral turpitude," he necessarily possesses good moral character, Petition at 1-2; (2) to the extent [redacted] was engaged in the unauthorized practice of law or made false statements, he should be excused, because he did so out of ignorance rather than intent, and at least partially due to the USPTO's "fail[ure] to follow its own rules" and "acquiescence" to Petitioner's unauthorized practice, Petition at 4, 5; and (3) other considerations – including the absence of harm to any of Petitioner's clients – militate against denying Petitioner recognition. Petition at 6.

II. LEGAL STANDARDS

The admission of foreign trademark attorneys and agents to practice before the USPTO is governed by regulation. Under 37 C.F.R. § 10.14,

(c) *Foreigners.* Any foreign attorney or agent not a resident of the United States who shall 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, *may be recognized* for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases ...

(e) No individual other than those specified [above] ... will be permitted to practice before the Office in trademark cases.

(emphasis added).

The recognition of all practitioners, foreign and domestic, is subject to 35 U.S.C.

§ 2(b)(2)(D), which states in pertinent part that the USPTO:

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...*

(emphasis added).

The courts have recognized the USPTO Director's duty to protect the public. "[T]he relationship of attorneys to the ... Office requires the highest degree of candor and good faith. In its relation to applicants, the Office ... must reply upon their integrity and deal with them in a spirit of trust and confidence It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the public from the evil consequences that might result if practitioners should betray their high trust." *Kingsland v. Dorsey*, 338 U.S. 318, 319-20 (1949) (in context of patent practitioners) (internal quotations omitted).

A factor in determining whether an applicant is of good moral character is whether that applicant has engaged in an act constituting the unauthorized practice of law, which includes the filing and prosecution of trademark applications. *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).

III. ANALYSIS

Neither his Show Cause Response nor his Petition for Review provides any basis to grant Petitioner's Request for Recognition or otherwise disturb the OED Director's decision.

First, Petitioner is incorrect when he equates good moral character with a mere absence of moral turpitude. Although showing the latter is certainly a *necessary* condition for the demonstration of good moral character, it is not a *sufficient* condition. "[G]ood moral character is not limited solely to that conduct which constitutes moral turpitude." *Frasher v. W. Va. Bd. of Law Examiners*, 185 W. Va. 725, 731 (1991).

This view is widely accepted throughout American jurisdictions: "Finding a lack of good moral character is not restricted to acts reflecting moral turpitude, but, rather, includes 'acts and conduct which would cause a reasonable man to have substantial doubts about an individual's

honesty, fairness and respect for ... the laws of the state and nation.” *The Fla. Bar re Jahn*, 559 So.2d 1089, 1090 (Fla. 1990) (internal citations omitted); *see also* *Petition of Wright*, 690 P.2d 1134, 1136 (Wash. 1984) (citing, and adopting, Florida courts’ reasoning with respect to good moral character not being limited to absence of turpitude); *In re Haukebo*, 352 N.W.2d 752, (Minn. 1984) (citing *Law Students Civil Rights Research Council v. Wadmond*, 401 U.S. 154, 159 (1971) to support the proposition that “[a]lthough good moral character has traditionally been defined as ‘absence of ... moral turpitude,’ the concept has gradually been expanded in the bar admissions context to include concern for ‘misconduct clearly inconsistent with the standards of a lawyer’s calling’” (internal quotations omitted)).

In keeping with this approach, the USPTO has consistently required its prospective practitioners to demonstrate good moral character beyond a mere absence of moral turpitude. This is clearest, perhaps, in the denial of admission to applicants who have not demonstrated good moral character for reasons of financial mismanagement. *E.g.*, Memorandum and Order (May 18, 2007) (and cases cited therein); Memorandum and Order (Apr. 3, 2008) (and cases cited therein).² *See also* Memorandum and Order (July 16, 2008) (sustaining OED Director’s determination that applicant had failed to demonstrate good moral character and reputation in light of conviction for possession and use of controlled substance without consideration of whether acts reflected moral turpitude); Memorandum and Order, p.7 (Sept. 26, 2007) (citing cases for proposition that “falsehoods, misrepresentations, and other types of irresponsible conduct ... have regularly been held as evidence of an applicant’s poor moral character”).

Because evaluating good moral character is not simply a matter of considering whether an applicant has committed acts of moral turpitude, Petitioner’s argument that he has not

² OED final decisions and decisions on petitions for review are available to the public at the OED E-FOIA reading room, <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

engaged in moral turpitude and should, therefore, be afforded recognition as a matter of course is unpersuasive.

Second, Petitioner makes a number of claims supporting broad arguments that his unauthorized practice of law and making a false statement were unintentional, and at least partially attributable to the USPTO's own errors of omission and commission. These arguments do not alter the central, uncontested, facts of the case: Petitioner practiced before the USPTO in more than 50 cases over a span of more than a decade, during which time he was an unrecognized foreign practitioner, and Petitioner made, or caused to be made, a false statement pertaining to his recognition status.

In support of his arguments, Petitioner states that he was ignorant of USPTO rules regarding reciprocal admission, and claims that his ignorance may be attributed to the "Office's practice of permitting foreign attorneys to transmit and receive correspondence" under TMEP §602.06(c). Petition for Review at 2, n.1. However, Petitioner has failed to consider TMEP §602.06(c) in its entirety. Specifically, the first sentence of TMEP §602.06(c) reads "[a] foreign attorney or agent who is not authorized to practice before the USPTO under 37 C.F.R. §10.14 may transmit and receive correspondence" (emphasis added). The section continues, however, by stating that "a foreign attorney or agent cannot prepare an application, response, or other paper to be filed in the USPTO, sign responses to Office actions, or authorize examiner's amendments and priority actions." In this case, Petitioner's ignorance cannot be excused by alleged confusion over the TMEP section. The section is clear that an unrecognized attorney is allowed to receive correspondence, but is prohibited from prosecuting applications. Section 602.06(c) of the TMEP clearly references 37 C.F.R. §10.14, which governs reciprocal admission.

Thus, Petitioner's purported confusion over the requirements for reciprocal admission should have been easily resolved.

Furthermore, the regulations – as recited above – are clear that reciprocal admission is a discretionary act, requiring the foreign attorney to make certain demonstrations “to the satisfaction of the [OED] Director,” 37 C.F.R. § 10.14(c)), and vesting in the OED Director the final authority to approve or disapprove the request for recognition (the applicant “...*may be recognized,*” *id.*). Considering the clear wording of both the TMEP section and the C.F.R. section, Petitioner's professed ignorance of the requirements is not a sufficient excuse for failing to comply with the requirements.

Petitioner has further argued that the use of electronic filing by the USPTO “present[s] a quandary for practitioners” because it requires the attorney to “submit everything personally or trust an experienced assistant to submit certain routine documents under his or her signature.” Petition for Review at 5. This argument is without merit, as practitioners are required to sign documents they submit. As stated in TMEP §605.02, “if the applicant/registrant is represented by an attorney authorized to practice before the USPTO under 37 C.F.R. §10.14, *the attorney must sign*” (emphasis added). The following paragraph clearly states who may sign papers submitted to the USPTO:

An authorized signatory must personally sign his/her name. Another person (e.g., paralegal, legal assistant, secretary) may not sign the name of an attorney or other authorized signatory. In cases of submissions through TEAS, all required electronic signatures must be entered manually by the person(s) identified as the signer(s). 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.

TMEP § 605.02. There is no quandary to be found here. The TMEP is clear: those submitting documents must sign their own name to their submissions. Further, Petitioner has not identified

the “routine documents” that he believes may be submitted by an assistant under Petitioner’s signature. Regardless of what Petitioner believes to be “routine documents,” the TMEP is clear that trademark applications, responses, and examiner’s amendments must be authorized and/or signed by the authorized signatory. Petitioner clearly allowed an assistant to submit documents under Petitioner’s signature at a time when he was not admitted before the USPTO. Further, Petitioner has stated that he would have done the same thing if his assistant had not submitted the documents, namely, sign and submit trademark application papers. *Petition for Review* at 5. Thus, Petitioner’s claimed “quandary” is irrelevant. Petitioner would have signed the documents in his own hand, thus engaging in the unauthorized practice of law and making false statements, regardless of whether the electronic filing system had created a “quandary.”

Petitioner argues that his failure to comply with the reciprocity requirements is a result of his reliance on the USPTO’s mistakes. *Request for Review* at 7. Petitioner additionally argues that “it is possible to scour the website of the [USPTO] and find no reference to enrollment of foreign attorneys to practice before it with respect to trademarks” and that “this is a trap for the unwary.” *Petition for Review* at 3. Petitioner’s argument is both incorrect and unavailing. The USPTO has made the rules and regulations regarding reciprocal admission available on its website. The TMEP, containing reciprocity requirements, is available on the USPTO’s website.³ Petitioner’s statement that the website lacks information about reciprocity is plainly incorrect. Moreover, Petitioner is ultimately responsible for complying with USPTO rules and regulations,

³ Furthermore, entering “foreign practitioner” in the search field on the Agency’s website produces a number of links, including to a set of pages organized under the topic “Foreign Attorney[s].” http://usasearch.gov/search?v%3aproject=firstgov&v%3afile=viv_1118%4031%3aTYjBwB&v%3aframe=list&v%3astate=root%7cN298&id=N298&action=list&. Within this topic is a link to an Examination Guide, which sets forth – in detail – the relevant rules and regulations pertaining to foreign practitioners, including the injunction that “A Canadian attorney or agent who wishes to represent a Canadian applicant/registrant in a trademark matter must file an application for recognition with OED *before representing the applicant in a trademark case.*” <http://www.uspto.gov/web/offices/tac/notices/examguide3-06.htm> (emphasis added).

regardless of their ease of access on the Agency's website or whether the Agency – for a time – failed to notice that Petitioner was practicing without having been properly recognized.

Finally, Petitioner's "Other Considerations" do not support overturning the OED Director's reasonable determination that Petitioner has failed to demonstrate good moral character.

Petitioner's invitation to excuse his unauthorized practice of law because his non-compliance did not harm any clients must be declined. Under 35 U.S.C. §2(b)(2)(D), the OED Director has statutory authority to determine whether a person representing applicants before the USPTO is "of good moral character and reputation" and therefore must exercise his judgment carefully in determining whether Petitioner has shown he is of good moral character. *Schware v. Bd. of Bar Examiners of New Mexico*, 353 U.S. 232, 248 (1957) ("satisfaction of the requirement of moral character involves an exercise of delicate judgment on the part of those who reach a conclusion") (Frankfurter, J., concurring). As the OED Director correctly held, an applicant's unauthorized practice of law is a relevant factor in evaluating moral character. *E.g., In re Singer*, 819 So.2d 1017 (La. 2002); *In re Greenwald*, 808 A.2d 1231 (D.C. 2002). In this case, Petitioner has not met his burden.⁴

⁴ The Agency notes that Petitioner has submitted letters from friends and clients allegedly attesting to his good moral character. Of approximately 82 pages of letters, only 5 are of relevance. The remaining letters are from clients and others to Petitioner, typically thanking him for wedding gifts, charitable donations, and the like. These 77 pages have little bearing on Petitioner's moral character or ability to prosecute trademark applications before the USPTO.

III. CONCLUSION

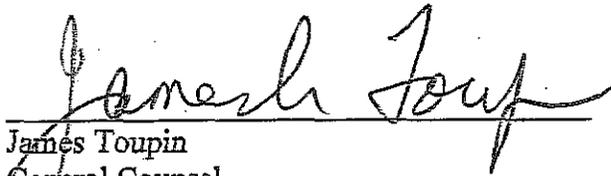
Petitioner has engaged in the unauthorized practice of law by filing documents with the USPTO without properly being admitted to represent foreign applicants. Petitioner has not provided a basis to grant his Petition for Review of the OED Director's March 16, 2009, Final Decision.

ORDER

Upon consideration of the petition to the USPTO Director for review under 37 C.F.R. § 11.2(d), it is ORDERED that the Petition for Review is DENIED, and the Final Decision of March 16, 2009, is AFFIRMED.

JUL 15 2009

Date


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on behalf of

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