

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

In the Matter of)	
)	
Matthew H. Swyers,)	Proceeding No. D2016-20
)	
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 For Consent Exclusion pursuant to 37 C.F.R. § 11.27, executed by Matthew H. Swyers (“Respondent”) on December 20, 2016. Respondent submitted the twelve-page Affidavit For Consent Exclusion 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 For Consent Exclusion shall be approved, and Respondent shall be excluded on consent from practice before the Office in trademark and non-patent matters commencing on the date of this Final Order.

Jurisdiction

Respondent, of Vienna, Virginia, is an attorney licensed to practice law in the Commonwealth of Virginia and the District of Columbia and has practiced before the USPTO in trademark matters. As such, he is subject to the USPTO Code of Professional

Responsibility, which is set forth at 37 C.F.R. § 10.20 *et seq.*, and the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.¹

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 for Consent Exclusion and to exclude Respondent on consent from the practice of trademark and non-patent matters before the Office.

Allegations of the Disciplinary Complaint

A disciplinary complaint is pending against Respondent (Proceeding No. 2016-20) which alleges that:

- a. Respondent, an experienced trademark lawyer and former USPTO Trademark Examining Attorney, established The Trademark Company, PLLC, and through that business systematically permitted non-attorneys to practice trademark law for him with little or no supervision.
- b. Respondent, the sole attorney at the company, did not personally review or sign thousands of trademark applications and related documents (including statements of use, § 2(f) declarations, and responses to Office actions) prepared by his non-lawyer employees and filed with the USPTO, in violation of USPTO signature and certification rules and despite assurances on the company website that trademark applicants would be represented by a specialized attorney.
- c. As a result of Respondent's failure to supervise his employees, multiple fraudulent or digitally manipulated specimens of use were filed with the Office, which potentially jeopardized the trademark applications of his clients.

¹ The USPTO Code of Professional Responsibility applies to conduct prior to May 3, 2013, and the USPTO Rules of Professional Conduct apply to conduct on or after May 3, 2013.

- d. Respondent failed to deposit client funds paid in advance into a client trust account and improperly split legal fees with his non-practitioner employees.
- e. Respondent failed to respond to lawful requests for information or cooperate with the investigation conducted by the Office of Enrollment and Discipline.

Respondent's Affidavit For Consent Exclusion

Respondent acknowledges in his December 20, 2016 Affidavit For Consent Exclusion that:

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

2. He is aware that the disciplinary complaint filed against him (Proceeding No. D2016-20) alleges that he violated the following Disciplinary Rules of the USPTO Code of Professional Responsibility and/or the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 10.23(a) (engaging in disreputable or gross misconduct by, *inter alia*: directing or allowing his employees to prepare, sign, and file trademark applications, responses to Office Actions, and other trademark documents; directing or allowing his employees to provide legal advice and guidance to trademark applicants; and/or directing or allowing his employees to communicate with his clients about trademark search reports and opinions, without his involvement or supervision; engaging in disreputable or gross misconduct by, *inter alia*: failing to comply with the USPTO's electronic signature rules by not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, which resulted in the validity of registered trademarks being jeopardized; engaging in disreputable or gross misconduct by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the

Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations and when he knew or reasonably should have known that the validity of an applicants' applications and registrations were jeopardized by the false and/or forged declarations; and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;" engaging in disreputable or gross misconduct by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them, and/or (iii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks; engaging in disreputable or gross misconduct by, *inter alia*: (i) not informing clients who purchased trademark legal services from The Trademark Company that their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office; and/or (ii) collecting fees from clients for trademark legal services that were supposed to be performed by an attorney when their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office);

- b. 37 C.F.R. § 10.23(b)(4) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: not informing clients who purchased trademark legal services from The Trademark Company that their applications and other trademark documents were not prepared or reviewed

by an attorney prior to being filed with the Office; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, thereby misleading the USPTO, his clients, and the public into believing that Respondent had actually signed the trademark application or trademark document; and/or (ii) not affirmatively informing the Trademark Examining Attorney that the actual signatory, the employee, was not identified on the document; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations, and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;" engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them, and/or (iii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) not informing

clients who purchased trademark legal services from The Trademark Company that their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office; and/or (ii) collecting fees from clients for trademark legal services that were supposed to be performed by an attorney when their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office);

- c. 37 C.F.R. § 10.23(b)(5) (engaging in conduct prejudicial to the administration of justice by, *inter alia*: (i) directing or allowing his employees to prepare, sign, and file trademark applications, responses to Office Actions, and other trademark documents; directing or allowing his employees to provide legal advice and guidance to trademark applicants; and/or directing or allowing his employees to communicate with his clients about trademark search reports and opinions, without his involvement or supervision; and/or (ii) not reviewing trademark applications and other trademark documents (*e.g.*, responses to Office Actions) prepared and filed by his employees before they were filed with the Office; engaging in conduct prejudicial to the administration of justice by, *inter alia*: (i) failing to comply with the USPTO's electronic signature rules by not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, which resulted in the validity of registered trademarks being jeopardized and/or (ii) directing or allowing his employees to sign or forge his electronic signature to trademark applications and other trademark documents knowing that the actual signatory, the employee, was not identified on the documents contrary to Respondent's certifications under § 11.18; engaging in conduct prejudicial to the administration of justice by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations; and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become

distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;" and/or (iii) he knew that (a) the actual signatory, the employee, was not identified on the document and (b) the actual signatory, the employee, did not have the knowledge to support the factual contentions found in the declaration; engaging in conduct prejudicial to the administration of justice by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, and/or (ii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered mark);

- d. 37 C.F.R. § 10.23(b)(6) (engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count I of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Code of Professional Responsibility; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count II of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Code of Professional Responsibility; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count III of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Code of Professional Responsibility; any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count IV of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Code of Professional Responsibility);

- e. 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(2)(ii) (knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information to the USPTO or any employee of the USPTO by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations, and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;" and/or (iii) he knew that (a) the actual signatory, the employee, was not identified on the document and (b) the actual signatory, the employee, did not have the knowledge to support the factual contentions found in the declaration);

- f. 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(15) (violating the certifications made to the USPTO under 37 C.F.R. § 11.18 by, *inter alia*: directing or allowing his employees to sign or forge his electronic signature to trademark applications and other trademark documents knowing that the actual signatory, the employee, was not identified on the documents; violating the certifications made to the USPTO under 37 C.F.R. § 11.18 by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, knowing that (i) the actual signatory, the employee, was not identified on the document and (ii) the actual signatory, the employee, did not have the knowledge to support the factual contentions found in the declaration; violating the certifications made to the USPTO under 37 C.F.R. § 11.18 by, *inter alia*, failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office);

- g. 37 C.F.R. § 10.31(a) (deceiving or misleading prospective applicants or other persons having immediate or prospective

business before the Office by word, circular, letter, or advertising with respect to prospective business before the Office by, *inter alia*: advertising on The Trademark Company's website that trademark applications would be prepared by an attorney when Respondent knew that trademark applications were not prepared or reviewed by an attorney prior to being filed with the USPTO; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count V of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Code of Professional Responsibility);

- h. 37 C.F.R. § 10.47(a) and (c) (aiding a non-practitioner in the unauthorized practice of law before the Office by, *inter alia*: (i) directing or allowing his employees to prepare, sign, and file trademark applications, responses to Office Actions, and other trademark documents; directing or allowing his employees to provide legal advice and guidance to trademark applicants; and/or directing or allowing his employees to communicate with his clients about trademark search reports and opinions, without his involvement or supervision; and/or (ii) not reviewing trademark applications and other trademark documents (*e.g.*, responses to Office Actions) prepared and filed by his employees before they were filed with the Office);
- i. 37 C.F.R. § 10.48 (sharing legal fees with a non-practitioner by paying employees non-discretionary monthly bonuses tied to the proceeds generated by the trademark legal services provided to applicants with whom they interacted);
- j. 37 C.F.R. § 10.77(b) (handling a legal matter without preparation adequate under the circumstances by, *inter alia*: failing to comply with the USPTO's electronic signature rules by not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, which resulted in the validity of registered trademarks being jeopardized);

- k. 37 C.F.R. § 10.77(c) (neglecting client matters by, *inter alia*: not reviewing trademark applications, responses to Office Actions, and other trademark documents prepared and filed by his employees before they were filed with the Office; neglecting client matters by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, and/or (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them);
- l. 37 C.F.R. § 10.84(a)(1) (intentionally failing to seek the lawful objectives of a client through reasonably available means permitted by law by, *inter alia*: intentionally failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them);
- m. 37 C.F.R. § 10.84(a)(3) (intentionally prejudicing or damaging the client during the course of a professional relationship by, *inter alia*: intentionally failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them);
- n. 37 C.F.R. § 10.89(c)(6) (intentionally or habitually violating any provision of the USPTO Code of Professional Responsibility while appearing in a professional capacity before a tribunal by, *inter alia*: (i) directing or allowing his employees to prepare, sign, and file trademark applications, responses to Office Actions, and other trademark documents; directing or allowing his employees to provide legal advice and guidance to trademark applicants; and/or directing or allowing his employees to communicate with his clients about trademark search reports and opinions, without his

involvement or supervision; and/or (ii) not reviewing trademark applications, responses to Office Actions, and other trademark documents prepared and filed by his employees before they were filed with the Office; intentionally or habitually violating any provision of the USPTO Code of Professional Responsibility while appearing in a professional capacity before a tribunal by, *inter alia*: failing to comply with the USPTO's electronic signature rules by not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, which resulted in the validity of registered trademarks being jeopardized; intentionally or habitually violating any provision of the USPTO Code of Professional Responsibility while appearing in a professional capacity before a tribunal by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations, and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;"; intentionally or habitually violating any provision of the USPTO Code of Professional Responsibility while appearing in a professional capacity before a tribunal by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, and/or (ii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks);

- o. 37 C.F.R. § 10.112(a) (failing to deposit legal fees paid in advance into a separate client trust account by depositing them instead into The Trademark Company's operating account);

- p. 37 C.F.R. § 11.101 (failing to provide competent representation by, *inter alia*: not reviewing trademark applications, responses to Office Actions, and other trademark documents prepared and filed by his employees before they were filed with the Office; failing to provide competent representation by, *inter alia*: failing to comply with the USPTO's electronic signature rules by not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, which resulted in the validity of registered trademarks being jeopardized; failing to provide competent representation by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations and when he knew or reasonably should have known that the validity of the applicants' applications and registrations were jeopardized by the false declarations; failing to provide competent representation by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, and/or (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them);

- q. 37 C.F.R. § 11.104(a) (failing to keep his client reasonably informed by, *inter alia*: (i) not informing Ms. Teague of the Office Action received on her behalf in U.S. Trademark

Application No. 86/287,301 and by not informing her that he had filed substitute specimens without confirming with her whether the substitute specimens depicted her mark as used in commerce, and/or (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them);

- r. 37 C.F.R. § 11.115(a) (failing to hold property of a client or third person that is in the lawyer's possession in connection with a representation separate from the lawyer's own property, by depositing fees paid in advance by clients for trademark legal services and costs into his operating account);
- s. 37 C.F.R. § 11.115(c) (failing to deposit into a client trust account legal fees and expenses that have been paid in advance, to be withdrawn by the practitioner only as fees are earned or expenses incurred, by depositing fees paid in advance by clients for trademark legal services and costs into his operating account);
- t. 37 C.F.R. § 11.303(a)(1) (knowingly making a false statement of fact to a tribunal or failing to correct a false statement of material fact previously made to the tribunal by the practitioner by, *inter alia*: failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks);
- u. 37 C.F.R. § 11.303(d) (failing, 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, even if the facts are adverse by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years

immediately before the date of this statement;"; failing, 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, even if the facts are adverse, by, *inter alia*, failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks);

- v. 37 C.F.R. § 11.503(a) (failing to make reasonable efforts to ensure that The Trademark Company had in effect measures giving reasonable assurance that its employees' conduct was compatible with Respondent's professional obligations, as is required by him as a partner or a person of comparable managerial authority of The Trademark Company by, *inter alia*: failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy);
- w. 37 C.F.R. § 11.503(b) (failing to make reasonable efforts to ensure that the conduct of The Trademark Company employees over whom he had direct supervisory authority was compatible with Respondent's professional obligations by, *inter alia*: failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy);
- x. 37 C.F.R. § 11.503(c) (ordering or ratifying the conduct of the employees of The Trademark Company which would have been a violation of the USPTO Rules of Professional Conduct had it been committed by a practitioner, and/or failing to take remedial measures once he learned of the conduct by, *inter*

alia: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them, and/or (iii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks);

- y. 37 C.F.R. § 11.504(a) (sharing legal fees with a non-practitioner by paying employees non-discretionary monthly bonuses tied to the proceeds generated by the trademark legal services provided to applicants with whom they interacted);
- z. 37 C.F.R. § 11.505 (assisting other persons in the unauthorized practice of law before the USPTO by, *inter alia*: (i) directing or allowing his employees to prepare, sign, and file trademark applications, responses to Office Actions, and other trademark documents; directing or allowing his employees to provide legal advice and guidance to trademark applicants; and/or directing or allowing his employees to communicate with his clients about trademark search reports and opinions, without his involvement or supervision; and/or (ii) not reviewing trademark applications and other trademark documents (*e.g.*, responses to Office Actions) prepared and filed by his employees before they were filed with the Office);
- aa. 37 C.F.R. § 11.701 (making false or misleading communications about the practitioner or the practitioner's services by, *inter alia*: advertising on The Trademark Company's website that trademark applications would be prepared by an attorney when Respondent knew that trademark applications were not prepared or reviewed by an attorney prior to being filed with the USPTO);

- bb. 37 C.F.R. §11.801(b) (failing to respond to lawful requests for information and failing to cooperate with OED by *inter alia*: (i) telling a witness not to talk to OED; (ii) falsely telling potential witnesses that talking to OED could affect their trademark rights; (iii) withholding the names of former employees for months; and/or (iv) not providing OED with the documents it sought (invoices, employment agreements, correspondence about § 2(f) declarations, and/or a privilege log));
- cc. 37 C.F.R. § 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: not informing clients who purchased trademark legal services from The Trademark Company that their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) not personally electronically signing trademark applications and trademark documents filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, thereby misleading the USPTO, his clients, and the public into believing that Respondent had actually signed the trademark application or trademark document; and/or (ii) not affirmatively informing the Trademark Examining Attorney that the actual signatory, the employee, was not identified on the document; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations, and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;" engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation, by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images

of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, (ii) failing to inform his clients that their trademark registrations or applications were potentially invalid and/or take timely and effective remedial action on their behalf and/or offer or provide restitution to them, and/or (iii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) not informing clients who purchased trademark legal services from The Trademark Company that their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office; and/or (ii) collecting fees from clients for trademark legal services that were supposed to be performed by an attorney when their applications and other trademark documents were not prepared or reviewed by an attorney prior to being filed with the Office; engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*, falsely telling potential witnesses that talking to OED could affect their trademark rights);

- dd. 37 C.F.R. § 11.804(d) (engaging in conduct prejudicial to the administration of justice by, *inter alia*: (i) directing or allowing his employees to prepare, sign, and file trademark applications, responses to Office Actions, and other trademark documents; directing or allowing his employees to provide legal advice and guidance to trademark applicants; and/or directing or allowing his employees to communicate with his clients about trademark search reports and opinions, without his involvement or supervision; and/or (ii) not reviewing trademark applications and other trademark documents (*e.g.*, responses to Office Actions) prepared and filed by his employees before they were filed with the Office; engaging in conduct prejudicial to the administration of justice by, *inter alia*: (i) failing to comply with the USPTO's electronic signature rules by not personally electronically signing trademark applications and trademark documents

filed with the USPTO and, instead, directing or allowing his employees to sign or forge his electronic signature to the documents, which resulted in the validity of registered trademarks being jeopardized and/or (ii) directing or allowing his employees to sign or forge his electronic signature to trademark applications and other trademark documents knowing that the actual signatory, the employee, was not identified on the documents contrary to Respondent's certifications under § 11.18; engaging in conduct that is prejudicial to the administration of justice by, *inter alia*: directing or allowing his employees to sign or forge his name to § 2(f) declarations and file the § 2(f) declarations with the Office, when (i) he knew that the Trademark Examining Attorneys would rely on the declarations when examining trademark applications and issuing registrations, and/or (ii) he knew or should have known his employees did not have adequate knowledge to aver, "The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement;" and/or (iii) he knew that (a) the actual signatory, the employee, was not identified on the document and (b) the actual signatory, the employee, did not have the knowledge to support the factual contentions found in the declaration; engaging in conduct that is prejudicial to the administration of justice by, *inter alia*: (i) failing to adequately supervise his employees or adequately review their work, thus permitting them to create false or fraudulent specimens and/or digitally altered images of marks that did not depict the actual mark as used in commerce and file these specimens with the Office, and as a result, in some cases, the USPTO issued trademark registrations based on the false or fraudulent specimens or digitally altered marks, putting the validity of the resulting trademarks in jeopardy, and/or (ii) failing to inform the USPTO of the potentially invalid applications and/or registrations that resulted from the filing of false or fraudulent specimens or digitally altered marks; engaging in conduct prejudicial to the administration of justice by, *inter alia*: (i) telling a witness not to talk to OED; (ii) falsely telling potential witnesses that talking to OED could affect their trademark rights; (iii) withholding the names of former employees for months; and/or (iv) not providing OED with

the documents it sought (invoices, employment agreements, correspondence about § 2(f) declarations, and/or a privilege log));

- ee. 37 C.F.R. § 11.804(i) (engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count I of the Complaint, to the extent that the conduct does not otherwise violate another provision of the USPTO Rules of Professional Conduct; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count II of the Complaint, to the extent that the conduct does not otherwise violate another provision of the USPTO Rules of Professional Conduct; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count III of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Rules of Professional Conduct; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count IV of the Complaint to the extent that his conduct does not otherwise violate a provision of the USPTO Code of Professional Responsibility; engaging in any other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the conduct referenced in Count V of the Complaint, to the extent that the conduct does not otherwise violate another provision of the USPTO Rules of Professional Conduct; other conduct that adversely reflects on the practitioner's fitness to practice before the Office, by engaging in the acts and omissions described in Count VIII above).

3. Without admitting that he violated any of the Disciplinary Rules of the USPTO Code of Professional Responsibility and/or the Rules of Professional Conduct which are the subject of the disciplinary complaint in Proceeding No. D2016-20, he acknowledges that, if and when he applies for reinstatement to practice before the USPTO in trademark or other non-patent matters under 37 C.F.R. § 11.60, the OED Director will conclusively

presume, for the limited purpose of determining the application for reinstatement, that (a) the allegations regarding him in the complaint filed in Proceeding No. D2016-20 are true and (b) he could not have successfully defended himself against such allegations.

4. 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 non-patent matters.

5. He consents to being excluded from practice before the USPTO in trademark and non-patent matters.

Exclusion on Consent

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

1. Respondent's Affidavit For Consent Exclusion shall be, and hereby is, approved;

2. Respondent shall be, and hereby is, excluded on consent from practice before the Office in trademark and 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 <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

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 Matthew H. Swyers of Vienna, Virginia, an attorney licensed to practice law in the Commonwealth of Virginia and the District of Columbia and practicing before the United States Patent and Trademark Office ("USPTO" or "Office) in trademark matters. The Director of the USPTO has accepted Mr. Swyers' affidavit for consent exclusion and ordered his exclusion on consent from practice before the Office in trademark and non-patent matters.

Mr. Swyers voluntarily submitted his affidavit at a time when a disciplinary complaint was pending against him. The complaint alleged that Mr. Swyers, an experienced trademark lawyer and former USPTO Trademark Examining Attorney, established The Trademark Company, PLLC, and through that business systematically permitted non-attorneys to practice trademark law for him with little or no supervision. The complaint alleged that Mr. Swyers, the sole attorney at the company, did not personally review or sign thousands of trademark applications and related documents (including statements of use, § 2(f) declarations, and responses to Office actions) prepared by his non-lawyer employees and filed with the USPTO, in violation of USPTO signature and certification rules and despite assurances on the company website that trademark applicants would be represented by a specialized attorney. Further, the complaint alleged that, as a result of Mr. Swyers' failure to supervise his employees, multiple fraudulent or digitally manipulated specimens of use were filed with the Office, which potentially jeopardized the trademark applications of his clients. The complaint also asserted that Mr. Swyers failed to deposit client funds paid in advance into a client trust account and improperly split legal fees with his non-practitioner employees. Finally, the complaint alleged that Mr. Swyers failed to respond to lawful requests for information or cooperate with the investigation conducted by the Office of Enrollment and Discipline.

Mr. Swyers' affidavit acknowledged that the disciplinary complaint filed against him alleged that his conduct violated the following provisions of the USPTO Code of Professional Responsibility, for conduct prior to May 3, 2013: 37 C.F.R. §§ 10.23(a) (engaging in disreputable or gross misconduct); 10.23(b)(4) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation);

10.23(b)(5) (engaging in conduct prejudicial to the administration of justice); 10.23(a) and (b) via 10.23(c)(2)(ii) (knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information to the USPTO or any employee of the USPTO); 10.23(a) and (b) via 10.23(c)(15) (violating the certifications made to the USPTO under 37 C.F.R. § 11.18); 10.31(a) (deceiving or misleading prospective applicants or other persons having immediate or prospective business before the Office by advertising with respect to prospective business before the Office); 10.47(a) and (c) (aiding a non-practitioner in the unauthorized practice of law before the Office); 10.48 (sharing legal fees with a non-practitioner); 10.77(b) (handling a legal matter without preparation adequate under the circumstances); 10.77(c) (neglecting client matters); 10.84(a)(1) (intentionally failing to seek the lawful objectives of a client); 10.84(a)(3) (intentionally prejudicing or damaging the client during the course of a professional relationship); 10.89(c)(6) (intentionally or habitually violating any provision of the USPTO Code of Professional Responsibility while appearing in a professional capacity before a tribunal); 10.112(a) (failing to deposit legal fees paid in advance into a separate client trust account); and 10.23(b)(6) (engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

Mr. Swyers's affidavit also acknowledged that the disciplinary complaint alleged that his conduct violated the following provisions of the USPTO Rules of Professional Conduct, for conduct on or after May 3, 2013: 37 C.F.R. §§ 11.101 (failure to provide competent representation); 11.104(a)(3) (failing to keep the clients reasonably informed about the status of a matter); 11.115(a) (failing to hold property of a client or third person that is in the lawyer's possession in connection with a representation separate from the lawyer's own property); 11.115(c) (failing to deposit into a client trust account legal fees and expenses that have been paid in advance, to be withdrawn by the practitioner only as fees are earned or expenses incurred); 11.303(a)(1) (knowingly making a false statement of fact to a tribunal or failing to correct a false statement of material fact previously made to the tribunal); 11.303(d) (failing, 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, even if the facts are adverse); 11.503(a) (failing to make reasonable efforts to ensure that The Trademark Company had in effect measures giving reasonable assurance that its employees' conduct was compatible

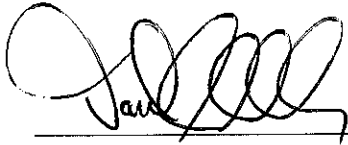
with Respondent's professional obligations); 11.503(b) (failing to make reasonable efforts to ensure that the conduct of The Trademark Company employees over whom he had direct supervisory authority was compatible with Respondent's professional obligations); 11.503(c) (ordering or ratifying the conduct of the employees of The Trademark Company which would have been a violation of the USPTO Rules of Professional Conduct had it been committed by a practitioner, and/or failing to take remedial measures once he learned of the conduct); 11.504(a) (sharing legal fees with a non-practitioner); 11.505 (aiding in the unauthorized practice of law before the USPTO); 11.701 (making false or misleading communications about the practitioner or the practitioner's services); 11.801(b) (failing to cooperate with the Office of Enrollment and Discipline in an investigation); 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit or misrepresentation); 11.804(d) (engaging in conduct that is prejudicial to the administration of justice); and 11.804(i) (engaging in the acts and omissions that adversely reflect on Respondent's fitness to practice before the Office).

While Mr. Swyers did not admit to violating any of the Disciplinary Rules of the USPTO Code of Professional Responsibility or the USPTO Rules of Professional Conduct as alleged in the pending disciplinary 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 OED investigation against him are true, and (ii) he could not have successfully defended himself against such 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: <http://go.usa.gov/x9rhg>.

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

26 Jan 2017

Date

on behalf of

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

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

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