



Nov 21 2022

**CAUSE NO.** 67306

## **Jurisdiction**

1. Since May 6, 2011, and at all times relevant to this Complaint, Respondent has been an attorney licensed to practice in the State of Texas, and is currently an active member in good standing. Respondent was also licensed to practice law in California as of September 1, 2009.

2. Respondent was registered by the USPTO as a patent attorney on October 14, 2009 (Registration No. 65,324).

3. Respondent has been engaged in practice before the USPTO in both patent and trademark matters. As such, he is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

4. This Tribunal has jurisdiction over this proceeding pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.32, and 11.39.

## **Background**

5. USPTO regulations require registered practitioners, like Respondent, to “notify the OED Director of the postal address for their office, at least one and up to three email addresses where they receive email, and a business telephone number, as well as every change to each of said addresses and telephone number within thirty days of the date of the change.” *See* 37 C.F.R. § 11.11(a).

6. At all times relevant to this Complaint, Respondent, pursuant to his obligation under 37 C.F.R. § 11.11(a), provided OED with an official address in Sugar Land, Texas. During OED’s disciplinary investigation of this matter, Respondent informed OED that his correct mailing address was in Houston, Texas. However, Respondent has not updated his mailing address with OED as required by § 11.11 and his address remains on file with OED as Sugar Land, Texas.

7. Respondent is the founder and owner of Liu Law Group, PLLC, located in Houston, Texas.

8. As of the time of OED’s disciplinary investigation, Respondent has been listed as the attorney of record on at least 1,600 trademark applications filed with the USPTO and during OED’s disciplinary investigation Respondent was asked about 1,400 of those applications.

9. Based on the location and timing of the trademark filings, and his admissions to OED that he had only filed a few applications, it is evident that Respondent did not personally sign all 1,400 trademark application documents that were filed with the Office, in violation of the trademark signature rules.

10. Respondent’s acts and omissions leading to the alleged violations of the Rules of Professional Conduct set forth in this Complaint were willful.

## **U.S. Counsel Rule**

11. Effective August 3, 2019, the USPTO amended its rules of practice to require that trademark applicants not domiciled within the United States be represented by an attorney who is an active member in good standing of the bar of the highest court of any of the 50 states of the U.S., the District of Columbia, or any Commonwealth or territory of the U.S. (also known as the “U.S. Counsel Rule”). *See* 37 C.F.R. § 2.11; Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 Fed. Reg. 31498 (July 2, 2019).

12. The purposes of the U.S. Counsel Rule include to “instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.” *See id.* Of most concern, the U.S. Counsel Rule is intended to address, *inter alia*, the rampant filing of suspicious specimens of use and unauthorized practice of trademark law (UPL) occurring frequently with trademark applications filed by or on behalf of foreign applicants. *See New U.S. Counsel rule: USPTO’s initiatives to ensure accuracy and integrity of the Trademark Register* (July 30, 2019), <https://www.uspto.gov/about-us/newsupdates/op-ed-new-us-counsel-rule-usptos-initiatives-ensure-accuracy-and-integrity>.

### **Signature Requirements in Trademark Applications**

13. Trademark applications contain declarations that are signed under penalty of perjury, with false statements being subject to punishment under 18 U.S.C. § 1001.

14. Signatories to declarations in trademark applications make specific representations regarding the applicants’ use of the mark in commerce and/or their intent to use the mark in commerce.

15. The USPTO relies on such declarations in the course of examining trademark applications and issuing registrations.

16. USPTO trademark signature rules require that all signatures be personally entered by the named signatory. *See* 37 C.F.R. §§ 2.193(a) and (c), and 37 C.F.R. § 11.18(a). Typing the electronic signature of another person is not a valid signature under USPTO rules. *Id.*

17. At all times relevant to this Complaint, the following published guidance from the USPTO identified the proscription against any person other than the named signatory entering the electronic signature in trademark documents filed with the USPTO:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a). The person(s) identified as the signatory must manually enter the elements of the electronic signature. Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory. *See In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Cowan*, 18 USPQ2d 1407 (Comm'r Pats. 1990). 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.

Trademark Manual of Examining Procedure § 611.01(c) (Oct. 2018).

### **USPTO Data Confirms the Impermissible Signature Practice**

18. The Trademark Electronic Application System (“TEAS”) is the USPTO’s electronic trademark filing and prosecution system. Trademark documents are electronically prepared, signed, and filed with the USPTO via TEAS.

19. The “DIRECT” signature procedure is one of three ways of entering an electronic signature on a trademark application, attendant declaration, or related filing that is being submitted to the USPTO via TEAS. DIRECT is the default signature procedure.

20. A signatory using the DIRECT signature procedure for a trademark filing enters the signature directly into the form online via TEAS at, or shortly before, the time of filing.

21. The two other available signature procedures are “ESIGN-ON” and “H SIGN.” For the ESIGN-ON procedure, a trademark document preparer is able to have a third party sign their electronic signature to trademark documents that will be filed with the Office. For the “H SIGN” procedure, an electronic version (e.g., a PDF version) of the original handwritten pen-and-ink signature is submitted to the USPTO via TEAS. Unlike the typical use of the DIRECT signature procedure, the ESIGN-ON and H SIGN procedures allow a named signatory who is not located where the filer is located to sign a filing in compliance with the USPTO trademark signature rules.

22. The XML data stored at the USPTO for trademark filings made using the “DIRECT” signature method will show “<signature-type> DIRECT”.

23. The USPTO’s Trademark Image Capture and Retrieval System (“TICRS”) is an internal USPTO database. TICRS captures and records data, including the date and time when a document is created on TEAS and when a document is submitted to the USPTO via TEAS.

24. TICRS also captures and records the signature procedures used for signed documents filed with the USPTO via TEAS and the Internet Protocol (“IP”) address of the computer used by the document preparer to access the TEAS system.

25. Typically, when the DIRECT signature procedure is used, the internet protocol address (“IP address”) captured by TICRS reflects the approximate geographic location (*e.g.*, city, state or province, and country) of the computer from which the trademark document was signed and submitted to the USPTO.

### **Additional Requirements for Signatures under 37 C.F.R. § 11.18.**

26. 37 C.F.R. § 11.18 provides that the signatory of a document filed with the USPTO certifies that:

[t]o the best of the party’s knowledge, information and belief, *formed after an inquiry reasonable under the circumstances* (i) the paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; (ii) the other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law; (iii) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and (iv) the denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 C.F.R. § 11.18(b)(2) (emphasis added).

27. The USPTO relies on the § 11.18 certification in the course of examining trademark applications and issuing registrations.

### **Other Requirements in Trademark Applications**

28. To allege use, USPTO trademark applications must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods and services identified in the application or amendment. *See* 15 U.S.C. § 1051(a)(1); 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); TMEP §§ 904, 904.07(a). The USPTO trademark examination procedures explain what constitutes an acceptable specimen and how a registration may be refused because a specimen is not acceptable. *See* Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); TMEP §§ 904, 904.03(g), 904.07(a).

## COUNT I

*(failing to provide competent or diligent representation; engaging in dishonesty, fraud, deceit, or misrepresentation; making false statements and offering evidence known to be false; engaging in conduct prejudicial to the administration of justice)*

29. Paragraphs 1 through 28 above are incorporated by reference.

30. The Trademark Electronic Search System (“TESS”)<sup>1</sup> contains approximately 1,600 trademark applications wherein Respondent was named as attorney of record. These filings were primarily made on behalf of foreign-domiciled applicants.

31. In an August 19, 2021 Request for Information and Evidence (“RFI”), OED inquired whether Respondent had personally reviewed and signed 1,400 of those trademark application documents in which he was identified as the attorney of record.

32. In an October 18, 2021 email, Respondent acknowledged to OED that he filed “very few” of the 1,400 trademark applications containing his purported signature listed in the August 19, 2021 RFI.

33. TICSRS data confirms Respondent’s admission that he did not personally file the majority of the trademark application documents filed with the USPTO purportedly containing his electronic signature.

34. The TICSRS data shows that many of the electronic trademark application documents containing Respondent’s purported signature were filed with the USPTO within minutes or seconds of one another from various geographical locations, indicating that Respondent did not personally enter his own electronic signature in those documents.

35. One of Respondent’s email addresses is [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com). Respondent received and responded to emails from OED with that email address during the course of the investigation of this matter.

36. Respondent’s [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com) email address was used as the reply email address in at least seven trademark applications<sup>2</sup> filed with the USPTO wherein Respondent was listed as attorney of record and his DIRECT signature was signed to the trademark filing, but the IP address indicated the application was filed from a geolocation other than Texas<sup>3</sup> – where Respondent maintains his law practice.

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1 TESS is the search engine available to the public that allows one to search the USPTO’s database of registered trademarks and prior pending applications.

2 The trademark applications include trademark serial Nos. 90/012,493; 90/034,128; 90/045,640; 90/048,106; 90/048,115; 90/055,576; 90/141,229.

3 The IP addresses for these electronic documents filed with the USPTO show geolocations in Hong Kong and San Jose or San Francisco, California.

37. TEAS automatically sends a filing receipt to the listed reply email address after the filing of any trademark application document. Due to his receiving of the filing receipt by email at [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com), Respondent was aware of the filing of these applications that he did not actually sign, but took no steps to withdraw them or rectify the improper signatures.

38. Therefore, Respondent directed or, at a minimum, allowed his signature to be signed by another individual to trademark applications and other trademark application documents that were filed with the USPTO.

39. Those trademark applications and other application documents, wherein Respondent was the attorney of record and his email address, [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com), was listed as a reply email, also contained a reply email address of [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com).

40. The reply email address [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com) was also associated with trademark application filings containing a Gmail account similar to Respondent's initial email address ([tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com)), this Gmail address being, [liu.trademarks@gmail.com](mailto:liu.trademarks@gmail.com). There are at least 15 trademark applications and associated application filings<sup>4</sup> containing these reply email addresses used together, [liu.trademarks@gmail.com](mailto:liu.trademarks@gmail.com) and [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com).

41. Respondent is listed as the attorney of record for these 15 trademark application filings and they contain his purported signature. However, these trademark application filings are filed from geolocations other than Texas, namely Hong Kong and San Jose or San Francisco, California, as reflected in the IP addresses.

42. Therefore, the trademark application filings wherein Respondent is the attorney of record, contain his DIRECT signature, and contain a reply email address of [liu.trademarks@gmail.com](mailto:liu.trademarks@gmail.com) and [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com), on information and belief, are trademark application filings where Respondent either allowed or directed his signature to be signed by another on trademark application documents filed with the USPTO.

43. The remaining trademark applications and application documents signed with Respondent's purported DIRECT signature were also filed from various geographic locations including Hong Kong, San Jose or San Francisco, and Seattle, Washington as indicated by the IP addresses.

44. Accordingly, on information and belief, the majority of the 1,400 trademark application documents containing Respondent's DIRECT electronic signature were signed by someone other than Respondent.

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<sup>4</sup> The trademark applications include trademark serial Nos. 90/055,576; 90/055,617; 90/055,638; 90/055,684; 90/120,429; 90/120,651; 90/167,466; 90/190,886; 90/212,490; 90/219,175; 90/219,250; 90/239,259; 90/239,301; 90/239,308; 90/305,979.

45. The following chart provides a sample of TICS data from sets of trademark application documents filed in close time to one another from various geographical locations bearing Respondent's purported DIRECT signature:

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/449,947	Application	Jan. 6, 2021 02:24:22 ET	54.219.86.236 San Francisco, CA
90/450,084	Application	Jan. 6, 2021 07:02:10 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/453,815	Application	Jan. 7, 2021 20:30:26 ET	54.219.86.236 San Francisco, CA
90/454,012	Application	Jan. 7, 2021 22:15:49 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/454,585	Application	Jan. 8, 2021 04:32:23 ET	54.219.86.236 San Francisco, CA
90/454,645	Application	Jan. 8, 2021 05:23:24 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/460,299	Application	Jan. 12, 2021 04:29:25 ET	54.219.86.236 San Francisco, CA
90/460,345	Application	Jan. 12, 2021 05:11:05 ET	66.42.75.184 Seattle, WA

46. The January 6 – 8 and 12, 2021 filings in the chart above apparently would have required Respondent to travel back and forth between San Francisco and Seattle five times and submit the filings from these different locations, at least once within less than an hour of each other, a patently dubious and unlikely undertaking.

47. Additionally, on December 31, 2020, ninety-six (96) trademark filings with Respondent listed as the signatory and attorney of record were filed over an 18-hour period. Each of the 96 filings was submitted to the USPTO under Respondent's purported DIRECT signature. These 96 single-day filings were made from various geographic locations, including San Francisco and Seattle. Respondent could not have reasonably reviewed and signed all of the trademark application documents filed in this time period.

48. Accordingly, on information and belief, Respondent permitted others to electronically enter his signature to trademark application documents, listed in paragraph 45 above, that were then filed with the USPTO in matters where he is the attorney of record in violation of the trademark signature rules.



49. Based on, *inter alia*, the rapid filing of the trademark application documents and the lack of Respondent's own signature in the filings, Respondent did not undertake a reasonable and adequate inquiry to determine whether the specimens for a mark submitted with a § 1(a) trademark application were demonstrative of goods and/or services that were actually being used in commerce, in violation of the USPTO rules, in particular 37 C.F.R. § 11.18.

50. The trademark examiners assigned to trademark applications in which Respondent was the attorney of record issued Office actions questioning the authenticity of specimens and whether each was in fact currently being used in commerce consistent with the § 1(a) requirements for trademark applications.

51. Trademark examiners assigned to trademark applications containing Respondent's purported signature and in which Respondent was the attorney of record issued Office actions refusing trademark registrations based on faulty specimens. The following chart provides examples of Office actions identifying specimen problems:

<b>Trademark Application Number</b>	<b>Mark</b>	<b>Office Action date</b>	<b>Mark Reason for refusal</b>
90/045,640	Pochaler	10/21/2020	Specimen refusal; does not show use in commerce; the screenshot from Amazon does not provide a means to purchase goods. The website shows the goods are unavailable; Therefore, the website does not show the goods currently in use in commerce.
90/055,684	ZKMotion	11/04/2020	Specimen refusal; does not show use in commerce; mark on specimen does not match the stylized mark in drawing.
90/219,250	XQIQX	02/18/2021	Specimen refusal; does not show us in commerce; 3 specimens purchase fulfillments only, 1 specimen screenshot of web page only.
90/365,406	Ofoxouq	06/02/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the applied-for mark as actually used in commerce; an attempt to look for the webpage and to review the goods on the website and to review the good on the website did not provide the webpage at issue; an internet search also did not reveal the use of the mark on the website at issue.
90/365,469	Pwoeigt	06/01/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the applied-for mark as actually used in commerce.

90/416,485	Nlfdbfsh	06/25/2021	Specimen refusal; a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce; the specimen shows a notebook but none of the applied-for services is notebooks or journals.
90/239,259	YD-KY-TG	02/18/2021	Specimen refusal; webpage specimen appears to describe insulated drinkware, not any of the identified goods; refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce
90/429,541	Hasinct	07/4/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
91517178	ATAefr	06/05/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
90/519,316	GeoSweet	06/28/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.

49. Respondent violated the rules pertaining to trademark application specimens by not undertaking an adequate and reasonable inquiry as to whether the specimens were in fact being used in commerce, but nonetheless authorizing the § 1(a) trademark applications containing impermissible specimens and allowing them to be filed in applications wherein he was the attorney of record and contained his purported signature. *See* Trademark Manual of Examining Procedure (“TMEP”) § 904.

50. In the August 19, 2021, Request for Information and Evidence Under 37 C.F.R. § 11.22 (“RFI”), sent to Respondent, OED explained to him that he had an ethical obligation to inform the USPTO of any false signatures on trademark application documents filed with the Office.

51. Despite being informed by OED of his ethical obligation to inform the USPTO (Trademark Operations) of false signatures in trademark application documents in which he is listed as attorney of record, Respondent failed to do so.

52. By reason of the conduct described above, Respondent has engaged in the following misconduct:

a. Not acting with reasonable diligence and promptness in representing a client by, *inter alia*:

- i. not personally entering the keystrokes comprising his electronic signature for trademark documents on which he was a named signatory and, instead: (1) directing another person to enter the keystrokes comprising his electronic signature thereon; (2) otherwise allowing or consenting to another person doing so; and/or (3) not taking reasonable steps to ensure that Respondent's clients' trademark filings were signed in accordance with USPTO trademark signature rules;
- ii. not having an adequate review process or procedure for reviewing applications prior to them being signed and filed with the USPTO, and not making an inquiry to determine: (1) whether the application was properly to be filed as a § 1(a) trademark application (actual use in commerce) or a § 1(b) trademark application (intent to use); and/or (2) whether the specimen for a mark submitted with § 1(a) applications for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s);
- iii. not taking reasonable steps to ensure that Respondent's clients' trademark filings were reviewed and filed in accordance with the U.S. Counsel Rule to ensure reasonably (1) increased compliance with U.S. trademark law and USPTO regulations, (2) improved accuracy of trademark submissions to the USPTO, and (3) that the integrity of the U.S. trademark register is safeguarded in violation of 37 C.F.R. § 11.103 of the USPTO Rules of Professional Conduct;

in violation of 37 C.F.R. § 11.103 of the USPTO Rules of Professional Conduct;

b. knowingly making a false statement of fact or law to a tribunal or failing to correct a false statement of material fact or law previously made to a tribunal by, *inter alia*: (i) allowing individual(s) to sign

his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant with knowledge that the USPTO would rely on such trademark documents in examining applications and issuing registrations; and/or, (ii) failing to correct and inform the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature, in violation of 37 C.F.R. § 11.303(a)(1) of the USPTO Rules of Professional Conduct;

- c. knowingly offering evidence the practitioner knows to be false or failing to take reasonable remedial measures, including, if necessary, disclosure to the tribunal, when the practitioner, the practitioner's client, or a witness called by practitioner has offered material evidence and the practitioner comes to know of its falsity by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents, including declarations, and file those documents with the USPTO, where Respondent was the named signatory on the document and the attorney of record for the trademark applicant; and/or (ii) failing to take reasonable remedial measures, by not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature, in violation of 37 C.F.R. § 11.303(a)(3) of the USPTO Rules of Professional Conduct;
- d. engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant; and/or (ii) not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark applications, and did not enter his own electronic signature, in violation of 37 C.F.R. § 11.804(c) of the USPTO Rules of Professional Conduct;
- e. engaging in conduct prejudicial to the administration of justice – specifically, the USPTO trademark registration system - by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant; and/or (ii) allowing § 1(a) trademark applications to be filed with the USPTO where he

did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s), in violation of 37 C.F.R. § 11.804(d) of the USPTO Rules of Professional Conduct; and/or

- f. engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the Office by engaging in the acts and omissions as set forth above to the extent that they do not constitute a violation of the provisions of the USPTO Rules of Professional Conduct set forth in paragraphs a. through e., above in violation of 37 C.F.R. § 11.804(i) of the USPTO Rules of Professional Conduct.

## COUNT II

*(failing to respond to lawfully issued RFI's and failure to cooperate in an OED investigation)*

- 53. Paragraphs 1 through 52 above are incorporated by reference.

54. On August 19, 2021, OED mailed the first RFI to Respondent's 37 C.F.R. § 11.11 address of record in Sugar Land, Texas via certified mail and regular first-class mail.

- 55. The August 19, 2021 RFI was lawfully issued to Respondent.

56. The August 19, 2021 RFI set a response deadline of September 19, 2021.

57. On August 31, 2021, OED received the return certified mail receipt showing that Respondent, or his agent, received the RFI on August 25, 2021. The RFI sent via regular mail was not returned; thus, the presumption is that it was received.<sup>5</sup>

58. Respondent did not respond to the RFI by the September 19, 2021 deadline.

59. Having not received a response from Respondent, OED spoke directly with Respondent via telephone on September 21, 2021. During the call, Respondent advised OED that he no longer lived at the Sugar Land, Texas address and provided OED with an address in Houston, Texas, where he received mail.

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<sup>5</sup> There is a presumption that mail, "properly addressed and stamped," was received by the addressee. *See Toomey v. District of Columbia*, 315 A.2d 565,567 (D.C. 1974) (per curiam) (quoting *Columbia Fin. Co. v. Worthy*, 141 A.2d 185, 186 (D.C. 1958)).

60. During the disciplinary investigation, OED asked Respondent to update his address with the Office consistent with the requirements of 37 C.F.R. § 11.11.

61. Despite being required by the rule to update his § 11.11 mailing address, and Respondent telling OED that he would update his address, as of the filing of this Complaint, Respondent has not updated his address with the Office.

62. On September 24, 2021, OED mailed Respondent a Lack of Response Notification letter and a copy of the RFI to Respondent's Houston, Texas address and to his address of record in Sugar Land, Texas. Both correspondences were mailed via certified mail.

63. On October 4, 2021, OED received a certified mail receipt showing that an agent at the address of record in Sugar Land, Texas, had received the Lack of Response Notification on September 29, 2021. The Lack of Response Notification was also mailed via first class mail to the Sugar Land, Texas address and was not returned.

64. Also, on October 4, 2021, OED received a certified mail receipt showing the addressee at the Houston, Texas address had received the Lack of Response Notification on September 30, 2021. The Lack of Response Notification was also mailed via first class mail to the Houston, Texas address and was not returned.

65. The Lack of Response Notification set a response due date of October 1, 2021.

66. Having not heard from Respondent by the October 1, 2021 due date, OED called Respondent on October 4, 2021.

67. During the October 4, 2021 telephone call, Respondent informed OED that he had received the Lack of Response letter.

68. During the October 4, 2021 telephone call, Respondent represented to OED that he was attempting to gather some of the documents requested by OED from his office in China and requested a fourteen (14) day extension of time to gather the documents. He represented that the additional time would allow him to provide a thorough response to the RFI.

69. OED granted Respondent's request for an extension of time so that he could provide a thorough response to the RFI and, on October 6, 2021, Respondent and the OED Director signed a 14-day tolling agreement providing Respondent with an extension of time until October 15, 2021, in which to answer the RFI.

70. On October 18, 2021, Respondent emailed OED a three-sentence response stating that: (1) he had only filed “very few” of the trademark filings identified in the RFI; (2) unauthorized filings came out of China or were done by a former client; and (3) he would compile a list of unauthorized filings. Respondent, however, did not identify the trademark documents he had filed, nor did he identify what filings were unauthorized or the name of the former client.

71. On October 18, 2021, OED called Respondent to discuss his email response. During the telephone call, OED again emphasized that a complete response to the RFI was needed.

72. During the same telephone call, Respondent represented to OED that he would provide a list of the unauthorized trademark filings by “tomorrow,” October 19, 2021.

73. Also, during the October 18, 2021 phone call, OED requested that Respondent participate in a telephone interview regarding his trademark filings and standard operating procedures. Respondent agreed to participate in the telephone interview and stated that he had open availability the first week of November (2021).

74. OED immediately followed up on the October 18, 2021 telephone call with an email reminding Respondent that OED must receive a response to the RFI and setting the agreed upon telephone interview for November 3, 2021.

75. Respondent did not respond to OED’s October 18, 2021 follow-up email. He did not participate in the November 3, 2021 telephone interview or attempt to reschedule it.

76. After the October 18, 2021 telephone call, Respondent ceased all communication with OED.

77. Respondent knowingly failed to fully respond to OED’s lawfully issued RFI, despite informing OED that he would respond and provide both a list of the trademark applications that he claimed he did not file and produce the requested documents, including those he claimed he was waiting to receive from his China office.

78. By reason of the conduct described above, Respondent has engaged in the following misconduct:

- a. failing to cooperate with OED in an investigation of any matter before it by, *inter alia*, evading meaningful communication with OED, failing to substantively respond to OED’s August 19, 2021 RFI, Lack of Response Notice, and numerous emails sent to the email address that Respondent had used to communicate with OED after being afforded ample time and opportunity to do so, and after

representing that he would cooperate, in violation of 37 C.F.R. § 11.801(b) of the USPTO Rules of Professional Conduct;

- b. engaging in conduct that is prejudicial to the administration of justice by, *inter alia*, failing to notify OED within 30 days of a change of mailing address as required by 37 C.F.R. § 11.11; failing to substantively respond to OED's numerous communications regarding the RFI after being afforded ample time and opportunity to do so; informing OED that he would respond to their communications and failing to do so, in violation of 37 C.F.R. § 11.804(d) of the USPTO Rules of Professional Conduct;
- c. engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the Office by engaging in the acts and omissions as set forth above to the extent that they do not constitute a violation of the provisions of the USPTO Rules of Professional Conduct set forth in paragraph a. and b. above in violation of 37 C.F.R. § 11.804(i) USPTO Rules of Professional Conduct.

4. On or about August 9, 2022, an **Initial Decision on Default Judgment** (Exhibit 2) was issued in a case styled United States Patent to and Trademark Office Before the Administrative Law Judge, *In the Matter of Daoyou Tim Liu, Respondent*, Proceeding No. D2022-03, (Exhibit 2) that states in pertinent part as follows:

#### **FINDINGS OF FACT**

Because Respondent failed to answer the *Complaint*, he is deemed to have admitted the allegations in the *Complaint*, which are set forth below as the Court's findings of fact.

Respondent is an attorney licensed to practice law in the State of Texas, since May 6, 2011. Although Respondent lives in Houston, Texas, he is also licensed to practice law in the State of California, since September 1, 2009.

Respondent's office is located in Houston, Texas. However, many of the electronic trademark documents filed with the USPTO were filed with his purported DIRECT signature from various geographic locations within seconds or minutes of one another, such as Hong Kong, China, San Jose, California, or San Francisco, California. TESS contains approximately 1,600 trademark applications with Respondent named as attorney of record and these filings were primarily made on behalf of foreign-domiciled applicants.



In an August 19, 2021 Request for Information and Evidence (“RFI”), OED inquired whether Respondent had personally reviewed and signed 1,400 of those trademark application documents in which he was identified as the attorney of record. In an October 18, 2021 email, Respondent acknowledged to OED that he filed “very few” of the 1,400 trademark applications containing his purported signature listed in the August 19, 2021 RFI.

TICRS data confirms Respondent’s admission that he did not personally file the majority of the trademark application documents filed with the USPTO purportedly containing his electronic signature. The TICRS data shows that many of the electronic trademark application documents containing Respondent’s purported signature were filed with the USPTO within minutes or seconds of one another from various geographical locations, indicating that Respondent did not personally enter his own electronic signature in those documents. Accordingly, the majority of the 1,400 trademark application documents containing Respondent’s DIRECT electronic signature were signed by someone other than Respondent.

Despite being impermissibly signed and filed by someone other than Respondent, where he was the attorney of record, Respondent knew or should have known that these trademark application documents were being signed and filed with the Office. One of Respondent’s email addresses is tim.d.liu@gmail.com. Of note, Respondent received and responded to emails from OED with that email address during the course of his disciplinary investigation. Respondent’s tim.d.liu@gmail.com email address was used as the reply email address in at least seven trademark applications<sup>6</sup> filed with the USPTO wherein Respondent was listed as attorney of record and his DIRECT signature was signed to the trademark filing, but the IP address indicated the application was filed from a geolocation other than Texas - where Respondent maintains his law practice. TEAS automatically sends a filing receipt to the listed reply email address after the filing of any trademark application document. Due to his receiving the filing receipt by email at tim.d.liu@gmail.com, Respondent was aware of the filing of these applications that he did not actually sign, but took no steps to withdraw them or rectify the improper signatures. Therefore, Respondent directed or, at a minimum, allowed his signature to be signed by another individual to trademark applications and other trademark application documents that were filed with the USPTO.

Those trademark applications and other application documents, wherein Respondent was the attorney of record and his email address, tim.d.liu@gmail.com, was listed as a reply email, also contained a reply email address of zxy\_ip@outlook.com. The reply email address zxy\_ip@outlook.com was also contained within trademark application filings associated with liu.trademarks@gmail.com, a Gmail account similar to Respondent’s primary email address (tim.d.liu@gmail.com). There are at least 15 trademark applications

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<sup>6</sup> The trademark applications are trademark serial Nos. 90/012,493; 90/034,128; 90/045,640; 90/048,106; 90/048,115; 90/055,576; 90/141,229.

and associated application filings<sup>7</sup> containing these reply email addresses used together, liu.trademarks@gmail.com and zxy\_ip@outlook.com. Respondent is listed as the attorney of record for these 15 trademark application filings and they contain his purported signature. However, these trademark application filings are filed from geolocations other than Texas, namely Hong Kong and California, as reflected in the IP addresses. Therefore, the trademark application filings wherein Respondent is the attorney of record, contain his DIRECT signature, and contain a reply email address of liu.trademarks@gmail.com and zxy\_ip@outlook.com are trademark application filings where Respondent either allowed or directed his signature to be signed by another on trademark application documents filed with the USPTO.

The remaining trademark applications and application documents signed with Respondent's purported DIRECT signature were also filed from various locations including Hong Kong, California, and Washington State, as indicated by the IP addresses. Accordingly, the majority of the 1,400 trademark application documents containing Respondent's DIRECT electronic signature were signed by someone other than Respondent.

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/449,947	Application	Jan. 6, 2021 02:24:22 ET	54.219.86.236 San Francisco, CA
90/450,084	Application	Jan. 6, 2021 07:02:10 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/453,815	Application	Jan. 7, 2021 20:30:26 ET	54.219.86.236 San Francisco, CA
90/454,012	Application	Jan. 7, 2021 22:15:49 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/454,585	Application	Jan. 8, 2021 04:32:23 ET	54.219.86.236 San Francisco, CA
90/454,645	Application	Jan. 8, 2021 05:23:24 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/460,299	Application	Jan. 12, 2021 04:29:25 ET	54.219.86.236 San Francisco, CA
90/460,345	Application	Jan. 12, 2021 05:11:05 ET	66.42.75.184 Seattle, WA

<sup>7</sup> The trademark applications are trademark serial Nos. 90/055,576; 90/055,617; 90/055,638; 90/055,684; 90/120,429; 90/120,651; 90/167,466; 90/190,886; 90/212,490; 90/219,175; 90/219,250; 90/239,259; 90/239,301; 90/239,308; 90/305,979.

The January 6 – 8 and 12, 2021 filings in the chart above apparently would have required Respondent to travel back and forth between San Francisco and Seattle five times and submit the filings from these different locations, at least once within less than an hour of each other, a patently dubious and unlikely undertaking. Additionally, on December 31, 2020, ninety-six (96) trademark filings with Respondent listed as the signatory and attorney of record were filed over an 18-hour period. Each of the 96 filings was submitted to the USPTO under Respondent's purported DIRECT signature. These 96 single-day filings were made from various geographic locations, including San Francisco and Seattle. Respondent could not have reasonably reviewed and signed all of the trademark application documents filed during this time period. Therefore, Respondent permitted others to electronically enter his signature to trademark application documents, listed in the four charts above, that were then filed with the USPTO in matters where he is the attorney of record in violation of the trademark signature rules.

Based on, *inter alia*, the rapid filing of the trademark application documents and the lack of Respondent's own signature in the filings, Respondent did not undertake a reasonable and adequate inquiry to determine whether the specimens for a mark submitted with a § 1(a) trademark application were demonstrative of goods and/or services that were actually being used in commerce, in violation of the USPTO rules, in particular 37 C.F.R. § 11.18. The trademark examiners assigned to trademark applications in which Respondent was the attorney of record issued Office actions questioning the authenticity of specimens and whether each was in fact currently being used in commerce consistent with the § 1(a) requirements for trademark applications. These trademark examiners assigned to trademark applications containing Respondent's purported signature and in which Respondent was the attorney of record issued Office actions refusing trademark registrations based on faulty specimens. The following chart provides examples of Office actions identifying specimen problems:

<b>Trademark Application Number</b>	<b>Mark</b>	<b>Office Action date</b>	<b>Mark Reason for refusal</b>
90/045,640	Pochaler	10/21/2020	Specimen refusal; does not show use in commerce; the screenshot from Amazon does not provide a means to purchase goods. The website shows the goods are unavailable; Therefore, the website does not show the goods currently in use in commerce.
90/055,684	ZKMotion	11/04/2020	Specimen refusal; does not show use in commerce; mark on specimen does not match the stylized mark in drawing.
90/219,250	XQIQX	02/18/2021	Specimen refusal; does not show us in commerce; 3 specimens purchase fulfillments only, 1 specimen screenshot of web page only.
90/365,406	Ofoxouq	06/02/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a

			webpage and does not show the applied-for mark as actually used in commerce; an attempt to look for the webpage and to review the goods on the website and to review the good on the website did not provide the webpage at issue; an internet search also did not reveal the use of the mark on the website at issue.
90/365,469	Pwoeigt	06/01/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the applied-for mark as actually used in commerce.
90/416,485	Nlfdbfsh	06/25/2021	Specimen refusal; a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce; the specimen shows a notebook but none of the applied-for services is notebooks or journals.
90/239,259	YD-KY-TG	02/18/2021	Specimen refusal; webpage specimen appears to describe insulated drinkware, not any of the identified goods; refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce
90/429,541	Hasinct	07/4/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
91517178	ATAefr	06/05/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
90/519,316	GeoSweet	06/28/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.

Therefore, Respondent violated the rules pertaining to trademark application specimens by not undertaking an adequate and reasonable inquiry as to whether the specimens were in fact being used in commerce, but nonetheless authorizing the § 1(a) trademark applications containing impermissible specimens and allowing them to be filed in applications wherein he was the attorney of record and contained his purported signature. See Trademark Manual of Examining Procedure (“TMEP”) § 904.

In the August 19, 2021, Request for Information and Evidence Under 37 C.F.R. § 11.22 (“RFI”), sent to Respondent, OED explained to him that he had an ethical obligation to inform the USPTO of any false signatures on trademark application documents filed with the Office.

Despite being informed by OED of his ethical obligation to inform the USPTO (Trademark Operations) of false signatures in trademark application documents, in which he is listed as attorney of record, Respondent failed to do so.

I. Respondent failed to respond to Lawfully Issued Requests for Information and Evidence (“RFI”) and failed to cooperate with an OED Investigation

Respondent failed to respond to OED’s lawfully issued RFI and failed to cooperate with OED’s investigation. As a result, these omissions amounted to additional rule violations. On August 19, 2021, OED mailed the first RFI to Respondent’s 37 C.F.R. § 11.11 address of record in Sugar Land, Texas via certified mail and regular first-class mail. The August 19, 2021 RFI was lawfully issued to Respondent and set a response deadline of September 19, 2021. On August 31, 2021, OED received the return certified mail receipt showing that Respondent, or his agent, received the RFI on August 25, 2021. Respondent did not respond to the RFI by the September 19, 2021 deadline.

Having not received a response from Respondent, OED spoke directly with Respondent via telephone on September 21, 2021. During the call, Respondent advised OED that he no longer lived at the Sugar Land, Texas address and provided OED with an address in Houston, Texas, where he received mail. OED asked Respondent to update his address with the Office consistent with the requirements of 37 C.F.R. § 11.11. Yet, despite being required by the rule to update his § 11.11 mailing address, and Respondent telling OED that he would update his address, as of the filing of the Complaint, Respondent had not updated his address with the Office.

On September 24, 2021, OED mailed Respondent a Lack of Response Notification letter (“Lack of Response letter”) and a copy of the RFI to Respondent’s Houston, Texas address and to his § 11.11 address of record in Sugar Land, Texas. Then on October 4, 2021, OED received a certified mail receipt signed by an agent at the address of record in Sugar Land, Texas, demonstrating the receipt of the Lack of Response letter on September 29, 2021. Also, on October 4, 2021, OED received a certified mail receipt signed by Respondent, the addressee, at the Houston, Texas address, demonstrating that he received the Lack of Response letter on September 30, 2021. The Lack of Response letter set a response due date of October 1, 2021.

Having not heard from Respondent by the October 1, 2021 due date, OED called Respondent on October 4, 2021. During the October 4, 2021 telephone call, Respondent informed OED that he had received the Lack of Response letter.

Respondent also informed OED that he was attempting to gather some of the documents requested by OED from his office in China and requested a fourteen (14) day extension of time to gather the documents. He represented that the additional time would allow him to provide a thorough response to the RFI. OED granted Respondent's request for an extension of time so that he could provide a thorough response to the RFI and, on October 6, 2021, Respondent and the OED Director signed a 14-day tolling agreement providing Respondent with an extension of time until October 15, 2021, in which to answer the RFI.

On October 18, 2021, Respondent emailed OED a three-sentence response stating that: (1) he had only filed "very few" of the trademark filings identified in the RFI; (2) unauthorized filings came out of China or were done by a former client; and (3) he would compile a list of unauthorized filings. Respondent, however, did not identify the trademark documents he had filed, nor did he identify what filings were unauthorized or the name of the former client.

That same day, OED called Respondent to discuss his email response. During the telephone call, OED again emphasized that a complete response to the RFI was needed. Respondent represented to OED that he would provide a list of the unauthorized trademark filings by "tomorrow," October 19, 2021. The OED also requested that Respondent participate in a telephone interview regarding his trademark filings and standard operating procedures. Respondent agreed to participate in the telephone interview and stated that he had open availability the first week of November (2021).

After the termination of the call, on October 18, 2021, OED immediately followed up with an email reminding Respondent that OED must receive a response to the RFI, and setting the agreed upon telephone interview for November 3, 2021. Respondent did not respond to OED's October 18, 2021 follow-up email. He did not participate in the November 3, 2021 telephone interview or attempt to reschedule it. In fact, after the October 18, 2021 telephone call, Respondent ceased all communication with OED.

Respondent knowingly failed to respond fully to OED's lawfully issued RFI, despite informing OED that he would respond and provide both a list of the trademark applications that he claimed he did not file and produce the requested documents, including those he claimed he was waiting to receive from his China office.

## **CONCLUSIONS OF LAW**

Based upon the foregoing findings of fact, the Court concludes that Respondent violated the following Rules, for the following reasons.

1. 37 C.F.R. § 11.103, which provides that a practitioner "shall act with reasonable diligence and promptness in representing a client." Respondent violated this rule by failing to take reasonable steps to

ensure that Respondent's clients' trademark filings were signed in accordance with the USPTO trademark signature rules. In particular, Respondent did not personally enter the keystrokes comprising his electronic signature for trademark documents on which he was a named signatory, and instead: (1) directed another person to enter the keystrokes comprising his electronic signature thereon; (2) otherwise allowed or consented to another person doing so; and/or (3) failed to take reasonable steps to ensure that Respondent's clients' trademark filings were signed in accordance with USPTO trademark signature rules;

Respondent further violated § 11.103 by not having an adequate review process or procedure for reviewing applications prior to them being signed and filed with the USPTO, and not making an inquiry to determine: (1) whether the application was properly to be filed as a § 1(a) trademark application (actual use in commerce) or a § 1(b) trademark application (intent to use); and/or (2) whether the specimen for a mark submitted with § 1(a) applications for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s);

Respondent also violated § 11.103 by not taking reasonable steps to ensure that Respondent's clients' trademark filings were reviewed and filed in accordance with the U.S. Counsel Rule thus ensuring (1) increased compliance with U.S. trademark law and USPTO regulations, (2) improved accuracy of trademark submissions to the USPTO, and (3) that the integrity of the U.S. trademark register is safeguarded.

2. 37 C.F.R. § 11.303(a)(1), which provides that a practitioner "shall not knowingly make a false statement of fact or law to a court or fail to correct a false statement of material fact or law previously made to a court." Respondent violated this rule by allowing another individual(s) to sign his name on trademark documents filed with the USPTO where Respondent was the named signatory on the document and/or the attorney of record for the trademark applicant with knowledge that the USPTO would rely on such trademark documents in examining applications and issuing registrations.

Respondent further violated § 11.303(a)(1) when he failed to correct and inform the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature.

3. 37 C.F.R. § 11.303(a)(3), which provides that a practitioner "shall not knowingly offer evidence that the practitioner knows to be false

... if a practitioner has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the court.” Respondent violated this rule by allowing another individual(s) to sign his name on trademark documents, including declarations, filed with the USPTO where Respondent was the named signatory on the document and/or the attorney of record for the trademark applicant.

Respondent further violated § 11.303(a)(3) when he failed to take reasonable remedial measures, by not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature.

4. 37 C.F.R. § 11.801(b), which provides that “a practitioner in connection with a disciplinary . . . matter, shall not . . . fail to cooperate with the Office of Enrollment and Discipline in an investigation of a matter before it.” Respondent violated this rule by evading meaningful communication with OED, failing to substantively respond to OED’s August 19, 2021 RFI, Lack of Response Notice, and numerous emails sent to the email address that Respondent had used to communicate with OED after being afforded ample time and opportunity to do so, and after representing that he would cooperate.
5. 37 C.F.R. § 11.804(c), which provides that “it is professional misconduct for a practitioner to engage in conduct involving dishonesty, fraud, deceit or misrepresentation.” Respondent violated this rule by allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant.

He further violated § 11.804(c) by not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark applications, and did not enter his own electronic signature.

6. 37 C.F.R. § 11.804(d), which provides that “it is professional misconduct for a practitioner to engage in conduct that is prejudicial to the administration of justice.” Respondent violated this rule by allowing another individual(s) to sign his name on trademark documents and filed those documents with the USPTO where Respondent was the named signatory on the document and/or the attorney of record for the trademark applicant.



Respondent further violated § 11.804(d) by allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s).

Respondent also violated § 11.804(d) by failing to notify OED within 30 days of a change of mailing address as required by 37 C.F.R. § 11.11, and/or by failing to substantively respond to OED's numerous communications regarding the August 19, 2021 RFI after being afforded ample time and opportunity to do so; and, by informing OED that he would respond to their communications, but did not do so. Based upon Respondent's admissions resulting from his failure to answer the Complaint, the Court finds Respondent has violated the USPTO disciplinary rules as alleged.

Based upon Respondent's admissions resulting from his failure to answer the *Complaint*, the Court finds Respondent has violated the USPTO disciplinary rules as alleged.

## SANCTIONS

The OED Director asked the Court to sanction Respondent by entering an order excluding him from practice before USPTO in patent, trademark, and other non-patent matters. The primary purpose of legal discipline is not to punish, but rather "to protect the public and the administration of justice from lawyers who have not discharged, will not discharge, or are unlikely properly to discharge their professional duties to clients, the public, the legal system, and the legal profession." *In re Brufsky*, Proceeding No. D2013-18 (USPTO June 23, 2014)<sup>8</sup> at 8 (citing *Matter of Chastain*, 532 S.E.2d 264, 267 (S.C. 2000)).

In determining an appropriate sanction, USPTO regulations require this Court to consider the following four factors: (1) whether the practitioner has violated a duty owed to a client, the public, the legal system, or the profession; (2) whether the practitioner acted intentionally, knowingly, or negligently; (3) the amount of the actual or potential injury caused by the practitioner's conduct; and (4) the existence of any aggravating or mitigating factors. *See* 37 C.F.R. § 11.54(b). *See also In re Morishita*, Proceeding No. D2017-25 (USPTO Sept. 28, 2018)<sup>9</sup>; *In re Lau*, Proceeding No. D2016-37 (USPTO May 1, 2017)<sup>10</sup>; and *In re Schwedler*, Proceeding No. D2015-38 (USPTO Mar. 21, 2016)<sup>11</sup>.

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<sup>8</sup> Available at: <https://go.usa.gov/x7x9Y>.

<sup>9</sup> Available at: <https://go.usa.gov/x7x94>

<sup>10</sup> Available at: <https://go.usa.gov/x7x92>

<sup>11</sup> Available at: <https://go.usa.gov/x7x9T>

1. Respondent violated duties owed to his clients, the public, and the legal profession.

Respondent violated six provisions of the Rules impacting the duties he owed to his clients, the public, and the legal System. His first violation occurred when he failed to act with diligence in representing his clients. By directing or allowing others to sign his name to trademark application documents, including declarations, he knowingly made false statements to the USPTO. He also made false representations by allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s). He allowed misrepresentations, such as false signatures, to remain on the trademark register by not taking remedial measures by, for example, disclosing the false signatures to Trademark Operations. He engaged in conduct prejudicial to the administration of justice by making these misrepresentations to the Office and failing to cooperate with OED's investigation. As a result, Respondent's misconduct violated duties owed to his clients, the public, and the legal system.

Respondent failed to act with diligence when he did not take reasonable steps to ensure that his clients' trademark filings were signed in accordance with the USPTO signature rules. False signatures on trademark application documents have caused important trademark rights to be lost. See In re Dermahose Inc., supra; In re Cowan, supra. A false signature on trademark documents, including declarations, not only violates the trademark signature rules, but also endangers the mark both before and after registration. As a result, Respondent has clearly violated the fiduciary practitioner-client relationship, which involves the most important ethical duty. See People v. Rhodes, 107 P.3d 1177, 1183 (Colo. 2005) (“[T]he most important duty [respondent] violated was that owed to his clients. The clients sought his counsel, trusted his judgment, and expected that he would handle their affairs[.] Respondent's failure to act with integrity when dealing with client property was egregious.”).

Respondent further violated the duties he owed to his clients by not complying with the U.S. Counsel Rule as it pertains to both the USPTO signatures rules and to filing proper specimens for trademark filings made on behalf of his clients. In addition to the false signature, Respondent did not act with diligence when he failed to review or have a procedure for determining whether the specimen submitted with the client's trademark application was a true example of the goods or services actually being used in commerce. Practitioners have been disciplined for failing to comply with the U.S. Counsel rule that includes diligently reviewing trademark specimens filed with the Office and proper signatures. See, e.g., In re Li,

Proceeding No. D2021-16 (USPTO Oct. 7, 2021)<sup>12</sup> and In re Reddy, Proceeding No. D2021-13 (USPTO Sep. 9, 2021)<sup>13</sup>.

Respondent violated duties owed to the public when he failed to observe the USPTO's laws and rules of practice. Congress bestowed the USPTO with plenary authority to govern the conduct of agents, attorneys, and other individuals that represent applicants before the Office. See 35 U.S.C. § 2(b)(2)(D). Pursuant to that authority, the USPTO established the USPTO Code of Professional Responsibility and the Rules, which became effective May 3, 2013. See 37 C.F.R. §§ 11.01 through 11.901. When Respondent violated six of the Rules, he violated duties he owed to the public, while also failing in the duties he owed to the legal profession and the USPTO.

He further violated his duty to the legal profession when he failed to cooperate with OED's disciplinary investigation. Despite assuring OED that he would update his § 11.11 address, thoroughly respond to the RFI, provide the requested documents, and participate in phone interview, Respondent ignored those assurances and never did any of those things. Respondent undermined the public's confidence in trademark practitioners by not conducting himself with integrity and professionalism. See In re Lau, *supra* (practitioner violated duties owed to patent bar and decreased confidence in patent practitioners); see also In re Muhammad, *supra*<sup>14</sup> (practitioner excluded upon default for, *inter alia*, not filing an Answer to the Complaint, and failing to cooperate with OED, including expressly informing OED twice in emails that he would file a response to the RFIs and not doing so).

## 2. Respondent Acted Knowingly.

Evaluation of a lawyer's mental state, or *mens rea*, requires a determination as to whether, at the time of the misconduct, the lawyer acted intentionally, knowingly, or negligently. These three mental states address the degree of the lawyer's culpability for disciplinary purposes. See Standards § 3.0; see also, e.g., In re Phillips, 244 P.3d 549, 555 (Ariz. 2010) (lawyer's mental state at the time of a violation is important, as it affects the appropriate discipline imposed; "[i]ntentional or knowing conduct is sanctioned more severely than negligent conduct because it threatens more harm"); People v. Varallo, 913 P.2d 1, \*7 (Colo. 1996) (lawyer's mental state is decisive element in determining level of discipline). Intent is the most culpable mental state and is defined as when a practitioner "acts with conscious objective or purpose to accomplish a particular result." STANDARDS at pg. xix. Knowing conduct occurs when a practitioner "acts with conscious awareness of the nature or attendant circumstances of his or

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<sup>12</sup> Available at: <https://go.usa.gov/xJXx9>

<sup>13</sup> Available at: <https://go.usa.gov/xJXxy>

<sup>14</sup> Available at: <https://go.usa.gov/xJcQu>

her conduct both without the conscious objective or purpose to accomplish a particular result.” Id. Respondent’s acts and omissions were knowing.

Respondent allowed others to sign his electronic signature to trademark application documents and to file those documents with the Office. Email addresses with variations of Respondent’s name are found in trademark application documents and those email addresses are listed as the email addresses receiving the filing receipt for that filed document where Respondent is listed as the attorney of record. Therefore, Respondent received the filing receipt for the trademark application documents that were signed with his DIRECT signature from various geographic locations, other than Houston, Texas.

Respondent communicated with counsel for the OED Director, via email, that his regular trademark filing email address is tim.d.liu@gmail.com. That email address was used as the correspondence email address and the filing receipt email address in trademark applications filed with the USPTO, wherein Respondent was the attorney of record. These applications contained his purported DIRECT signature, but the IP address indicated the application was signed and filed from a geolocation other than Texas.<sup>15</sup> Because Respondent’s email address was listed as the contact email for trademark applications and also as the email address for the filing receipts, Respondent knowingly allowed others to sign his signature to trademark documents filed with the Office.

Respondent also intentionally and knowingly failed to cooperate with OED’s investigation. Respondent received, at his Houston, Texas address, the Lack of Response letter containing the RFI. Respondent admitted to OED that he had received the correspondence. He also represented to OED that he would provide a thorough response to the RFI. He never did so. Respondent also agreed to participate in a phone interview with OED, but failed to attend.

Other practitioners have been excluded after they knowingly and intentionally attempted to frustrate OED’s investigation. See e.g., In re Ho, Proceeding No. D2009-04 (USPTO Jan. 30, 2009)<sup>16</sup> at 8 (initial decision on default excluding practitioner who, *inter alia*, “knowingly failed to provide information requested by OED and intentionally failed to cooperate with OED’s investigation.”); In re Glazer, Proceeding No. D2018-34 (USPTO Mar. 4, 2020)<sup>17</sup> at 5 (initial decision excluding practitioner whose acts were “intentional and knowing”). Respondent similarly violated these Rules. His

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15 For example the trademark applications listed in the *Complaint* containing the email address tim.d.liu@gmail.com (confirmed by Respondent as his email address) were DIRECT signed from locations other than Houston, Texas: 90/012,493 – DIRECT sign from Hong Kong; 90/034,128 – DIRECT sign from Hong Kong; 90/045,640 – DIRECT sign from Hong Kong; 90/048,106 – DIRECT sign from Hong Kong; 90/048,115 – DIRECT sign from Hong Kong; 90/141,229 – DIRECT sign from San Mateo, California.

16 Available at: <https://go.usa.gov/xsR42>

17 Available at: <https://go.usa.gov/xsR4W>

intentional attempts to avoid and circumvent the OED disciplinary investigation reflects serious misconduct in violation of the Rules.

3. The Potential Injuries are Significant

Respondent's conduct caused significant potential injury. See In re Fuess, Proceeding No. D2015-08 (USPTO July 21, 2017)<sup>18</sup> at 21 (“[t]he harm from the violation need not be actual, only potential”) (citing In re Claussen, 909 P.2d 862, 872 (Ore. 1996)). More than 1,400 trademark application documents containing fraudulent signatures were filed with the USPTO, and those clients' trademark applications or registered marks are in jeopardy of having their applications or registrations cancelled. See, e.g., In re Mar, supra, at 24 (“if a competitor seeks to use the trademark, the competitor can have the trademark cancelled based on the false signatures.”). Respondent's clients could potentially lose the trademark protection that they thought they had paid Respondent to obtain for them.

Similarly, because Respondent has failed to, *inter alia*, take reasonable remedial measures to disclose the impermissibly signed documents to the USPTO, the trademark registry has numerous applications and registrations that were signed in violation of U.S. federal law and USPTO regulations. Respondent's conduct thereby adversely impacts the integrity of the trademark registry on which the public relies when deciding whether to seek and on which the USPTO as a court relies when deciding whether to bestow important intellectual property rights. Having caused multiple clients, the public, and the USPTO significant potential injuries, Respondent should receive a significant sanction.

4. Aggravating and Mitigating Factors

The STANDARDS, published by the American Bar Association, set forth aggravating and mitigating factors for the Court to consider in determining an appropriate sanction. The OED Director asserts that, of the potential mitigating factors identified in the STANDARDS, the sole mitigating factor present here is the “absence of a prior disciplinary record.” See STANDARDS § 9.32. By contrast, the OED Director contends that the following aggravating factors warrant a more severe sanction in this case: a dishonest or selfish motive; a pattern of misconduct; multiple violations; bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of OED; submission of false evidence, false statements, or other deceptive practices during the disciplinary proceeding; and substantial experience in the practice of law. Id. § 9.22.

a. Four Aggravating Factors are Present

Respondent had a selfish motive in that he sought to profit from a dishonest and improper practice of allowing others to electronically sign his name to trademark application documents that were then filed with the USPTO. See STANDARDS § 9.22(b). Respondent also displayed a dishonest and selfish motive when he sought to profit by allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s).

Respondent engaged in a pattern of misconduct with multiple offenses. See STANDARDS § 9.22(c)-(d). For example, there are at least 1,400 trademark application filings that contain faulty signatures. Respondent was directly connected to no less than seven of these trademarks, which used his primary email for return receipts. Additionally, Respondent displayed a pattern of misconduct with multiple offenses when he violated the rules by engaging in a repeated pattern of failing to ensure that proper specimens were filed in trademark applications wherein he was the attorney of record.

Another pattern of misconduct and multiple offenses occurred during OED's disciplinary investigation. Despite numerous requests from OED, Respondent repeatedly failed to respond in a substantive matter to OED's RFI and Lack of Response letter. See In re Iussa, supra (pattern of misconduct where practitioner repeatedly failed to exercise diligence and promptness, communicate with client, and respond to OED's requests for information and evidence). He also repeatedly assured OED that he would provide a complete response to the RFI and Lack of Response letter but failed to do so.

These patterns of misconduct along with multiple offenses demonstrate serious misconduct worthy of a heightened sanction. See In re Stevenson, Proceeding No. D2019-12 at 14 (USPTO December 13, 2019)<sup>19</sup> ("repeated instances of similar misconduct"); see also In re Flindt, Proceeding No. D2016-04 (Aug. 4, 2017)<sup>20</sup> (practitioner committed "multiple offenses" that violated six separate provisions of the Rules); In re Fuess, supra (practitioner abandoned multiple applications and violated multiple Rules). For these reasons, Respondent deserves a more significant sanction.

The fourth aggravating factor is "bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of the disciplinary agency." See STANDARDS § 9.22(e); In re Mar, supra at 26 (practitioner demonstrated obstruction of disciplinary

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<sup>19</sup> Available at: <https://go.usa.gov/x6vjS>

<sup>20</sup> Available at: <https://go.usa.gov/x63dK>

proceeding by, inter alia, “fail[ing] to participate in the disciplinary process once the *Complaint* was filed.”).

During OED’s investigation, Respondent spoke to OED’s attorney investigator over the phone three times. Each time they discussed the need for Respondent to thoroughly respond to the August 19, 2021 RFI and the September 24, 2021 Lack of Response letter - that also contained a copy of the RFI. Respondent repeatedly told OED that he would provide a thorough response, even entering into a tolling agreement giving him an extension of time to provide the response. Yet, he never provided a complete response. He also agreed to a phone interview, yet did not attend. Thus, this misconduct amounts to “bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with the rules,” that being § 11.801(b).

Respondent’s misconduct has also been ongoing because during this proceeding Respondent has ignored the *Complaint* and this Court’s order to file an Answer. Thus, this serves as further aggravation; whereby, Respondent deserves a more severe sanction. See In re Morishita, supra; In re Lau, supra; In re Schwedler, supra; see also In re Kantor, 850 A.2d 473, 477 (N.J. 2004) (“An attorney who declines to appear before this Court to explain his unprofessional conduct [...] openly displays his unfitness to continue to practice law.”); People v. Barbieri, 61 P.3d. 488, 495 (Colo. O.P.D.J. 2000) (“In disciplinary matters involving an attorney’s conduct, compliance with unchallenged orders issued by the disciplinary body is not elective; it is mandatory. Failure to do so, almost invariably, will inure substantially enhanced discipline.”); Iowa Supreme Court Bd. of Professional Ethics and Conduct v. Ramey, 639 N.W.2d 243, 246 (Iowa 2002) (attorney’s “failure to respond to this attorney disciplinary proceeding suggests an overall attitude of disrespect and disregard for this profession.”). Respondent’s bad faith obstruction of OED’s disciplinary proceeding, ignoring the *Complaint*, and this Court’s orders warrant a more severe sanction.

b. One mitigating factor

In terms of the mitigating factors, Respondent has no prior disciplinary record. However, in light of the facts of this matter and the five aggravating factors discussed above, Respondent’s previously clear disciplinary record is insufficient to overcome the facts and aggravating factors.

## CONCLUSION

Because Respondent has failed to answer the *Complaint* or otherwise appear in this matter, Respondent is found to be in **DEFAULT** and to have admitted all the allegations in the Complaint. Based on the facts hereby admitted, the Court finds that Respondent has violated the USPTO Rules of Professional Conduct as

discussed above. After analyzing the factors enumerated in 37 C.F.R. § 11.54(b), the Court concludes that Respondent's misconduct warrants the sanction of exclusion. Accordingly, Respondent shall be **EXCLUDED** from practice before the U.S. Patent and Trademark Office in patent, trademark, and other non-patent matters.<sup>21</sup>

5. A certified copy of the Complaint and Notice of Proceedings (Exhibit 1), and Initial Decision on Default Judgment (Exhibit 2), are attached hereto as Petitioner's Exhibits 1 and 2 and made a part hereof for all intents and purposes as if the same was copied verbatim herein. Petitioner expects to introduce a certified copy of Exhibits 1 and 2 at the time of hearing of this cause.

6. Pursuant to 37 C.F.R. § 11.54(d), an initial decision becomes "the final decision of the SUPTO Director 30 days from the date of the decision of the hearing officer" if an appeal is not filed. Respondent did not file an appeal and the Initial Decision on Default Judgment became a final decision on February 11, 2022.

7. Petitioner prays that, pursuant to Rule 9.02, Texas Rules of Disciplinary Procedure, that this Board issue notice to Respondent, containing a copy of this Petition with exhibits, and an order directing Respondent to show cause within thirty (30) days from the date of the mailing of the notice, why the imposition of the identical discipline in this state would be unwarranted. Petitioner further prays that upon trial of this matter that this Board enters a judgment imposing discipline identical with that imposed by the United States Patent and Trademark Office and that Petitioner have such other and further relief to which it may be entitled.

Respectfully submitted,

**Seana Willing**  
Chief Disciplinary Counsel

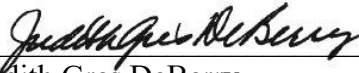
**Judith Gres DeBerry**  
Assistant Disciplinary Counsel  
Office of the Chief Disciplinary Counsel

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<sup>21</sup> An excluded practitioner is eligible to apply for reinstatement no earlier than five years from the effective date of the exclusion. See 37 C.F.R. § 11.60(b). Eligibility is predicated upon full compliance with 37 C.F.R. § 11.58.  
Petition for Reciprocal Discipline – Liu  
Page 32 of 33



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\_\_\_\_\_  
Judith Gres DeBerry  
Bar Card No. 24040780

ATTORNEYS FOR PETITIONER

**CERTIFICATE OF SERVICE**

I certify that upon receipt of the Order to Show Cause from the Board of Disciplinary Appeals, I will serve a copy of this Petition for Reciprocal Discipline and the Order to Show Cause on Daoyou Tim Liu, by personal service.

Daoyou Tim Liu  
6901 Corporate Drive, Ste. 111  
Houston, Texas 77036

  
\_\_\_\_\_  
Judith Gres DeBerry



## UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF ENROLLMENT AND DISCIPLINE

November 1, 2022

For certified copy purposes, I declare under penalty of perjury that the attached copy of the Complaint and Notice of Proceedings in USPTO Proceeding No. D2022-03, *In the Matter of Daoyou Tim Liu* is a true and correct copy of the Complaint and Notice of Proceedings in, *In the Matter of Daoyou Tim Liu*, USPTO Proceeding No. D2022-03.

/David R. Harley/

David R. Harley  
Paralegal Specialist  
Office of Enrollment and Discipline



**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE  
UNITED STATES DEPARTMENT OF HOUSING AND URBAN DEVELOPMENT**

In the Matter of	)	
	)	
Daoyou Tim Liu,	)	Proceeding No. D2022-03
	)	
Respondent	)	
_____	)	

**COMPLAINT AND  
NOTICE OF PROCEEDINGS UNDER 35 U.S.C. § 32**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) hereby gives notice of a disciplinary proceeding and statement of charges against Daoyou Tim Liu (“Respondent”) as follows:

This Complaint and Notice of Proceedings (“Complaint”) is filed pursuant to 37 C.F.R. §§ 11.32 and 11.34. Within thirty days from the date of the filing of this Complaint, Respondent’s written answer shall be filed with the Administrative Law Judge, and a copy of the answer shall be served on the OED Director. *See* 37 C.F.R. §§ 11.34(a)(3), 11.36(a), and 11.36(b). The attached Notice of Correspondence Addresses provides the addresses where the answer is to be mailed or delivered. Additionally, a copy of the answer, in portable document format (“PDF”), should be transmitted by electronic mail to the Administrative Law Judge at: [alj.alj@hud.gov](mailto:alj.alj@hud.gov). A decision by default may be entered against Respondent if a written answer is not timely filed. *See* 37 C.F.R. §§ 11.34(a)(4) and 11.36(e). The provisions of 37 C.F.R. § 11.41 govern the filing of papers in this disciplinary proceeding.

## **Jurisdiction**

1. Since May 6, 2011, and at all times relevant to this Complaint, Respondent has been an attorney licensed to practice in the State of Texas, and is currently an active member in good standing. Respondent was also licensed to practice law in California as of September 1, 2009.

2. Respondent was registered by the USPTO as a patent attorney on October 14, 2009 (Registration No. 65,324).

3. Respondent has been engaged in practice before the USPTO in both patent and trademark matters. As such, he is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

4. This Tribunal has jurisdiction over this proceeding pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.32, and 11.39.

## **Background**

5. USPTO regulations require registered practitioners, like Respondent, to “notify the OED Director of the postal address for their office, at least one and up to three email addresses where they receive email, and a business telephone number, as well as every change to each of said addresses and telephone number within thirty days of the date of the change.” *See* 37 C.F.R. § 11.11(a).

6. At all times relevant to this Complaint, Respondent, pursuant to his obligation under 37 C.F.R. § 11.11(a), provided OED with an official address in Sugar Land, Texas. During OED’s disciplinary investigation of this matter, Respondent informed OED that his correct mailing address was in Houston, Texas. However, Respondent has not updated his mailing address with OED as required by § 11.11 and his address remains on file with OED as Sugar Land, Texas.

7. Respondent is the founder and owner of Liu Law Group, PLLC, located in Houston, Texas.

8. As of the time of OED's disciplinary investigation, Respondent has been listed as the attorney of record on at least 1,600 trademark applications filed with the USPTO and during OED's disciplinary investigation Respondent was asked about 1,400 of those applications.

9. Based on the location and timing of the trademark filings, and his admissions to OED that he had only filed a few applications, it is evident that Respondent did not personally sign all 1,400 trademark application documents that were filed with the Office, in violation of the trademark signature rules.

10. Respondent's acts and omissions leading to the alleged violations of the Rules of Professional Conduct set forth in this Complaint were willful.

#### **U.S. Counsel Rule**

11. Effective August 3, 2019, the USPTO amended its rules of practice to require that trademark applicants not domiciled within the United States be represented by an attorney who is an active member in good standing of the bar of the highest court of any of the 50 states of the U.S., the District of Columbia, or any Commonwealth or territory of the U.S. (also known as the "U.S. Counsel Rule"). *See* 37 C.F.R. § 2.11; Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 Fed. Reg. 31498 (July 2, 2019).

12. The purposes of the U.S. Counsel Rule include to "instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters." *See id.* Of most concern, the U.S. Counsel Rule is intended

to address, *inter alia*, the rampant filing of suspicious specimens of use and unauthorized practice of trademark law (UPL) occurring frequently with trademark applications filed by or on behalf of foreign applicants. See *New U.S. Counsel rule: USPTO's initiatives to ensure accuracy and integrity of the Trademark Register* (July 30, 2019), <https://www.uspto.gov/about-us/news-updates/op-ed-new-us-counsel-rule-usptos-initiatives-ensure-accuracy-and-integrity>.

### **Signature Requirements in Trademark Applications**

13. Trademark applications contain declarations that are signed under penalty of perjury, with false statements being subject to punishment under 18 U.S.C. § 1001.

14. Signatories to declarations in trademark applications make specific representations regarding the applicants' use of the mark in commerce and/or their intent to use the mark in commerce.

15. The USPTO relies on such declarations in the course of examining trademark applications and issuing registrations.

16. USPTO trademark signature rules require that all signatures be personally entered by the named signatory. See 37 C.F.R. §§ 2.193(a) and (c), and 37 C.F.R. § 11.18(a). Typing the electronic signature of another person is not a valid signature under USPTO rules. *Id.*

17. At all times relevant to this Complaint, the following published guidance from the USPTO identified the proscription against any person other than the named signatory entering the electronic signature in trademark documents filed with the USPTO:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a). The person(s) identified as the signatory must manually enter the elements of the electronic signature. Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory. See *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Cowan*, 18 USPQ2d 1407 (Comm'r Pats. 1990). 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.

Trademark Manual of Examining Procedure § 611.01(c) (Oct. 2018).

### **USPTO Data Confirms the Impermissible Signature Practice**

18. The Trademark Electronic Application System (“TEAS”) is the USPTO’s electronic trademark filing and prosecution system. Trademark documents are electronically prepared, signed, and filed with the USPTO via TEAS.

19. The “DIRECT” signature procedure is one of three ways of entering an electronic signature on a trademark application, attendant declaration, or related filing that is being submitted to the USPTO via TEAS. DIRECT is the default signature procedure.

20. A signatory using the DIRECT signature procedure for a trademark filing enters the signature directly into the form online via TEAS at, or shortly before, the time of filing.

21. The two other available signature procedures are “ESIGN-ON” and “H SIGN.” For the ESIGN-ON procedure, a trademark document preparer is able to have a third party sign their electronic signature to trademark documents that will be filed with the Office. For the “H SIGN” procedure, an electronic version (*e.g.*, a PDF version) of the original handwritten pen-and-ink signature is submitted to the USPTO via TEAS. Unlike the typical use of the DIRECT signature procedure, the ESIGN-ON and H SIGN procedures allow a named signatory who is not located where the filer is located to sign a filing in compliance with the USPTO trademark signature rules.

22. The XML data stored at the USPTO for trademark filings made using the “DIRECT” signature method will show “<signature-type> DIRECT”.

23. The USPTO’s Trademark Image Capture and Retrieval System (“TICRS”) is an internal USPTO database. TICRS captures and records data, including the date and time when a document is created on TEAS and when a document is submitted to the USPTO via TEAS.

24. TICRS also captures and records the signature procedures used for signed documents filed with the USPTO via TEAS and the Internet Protocol (“IP”) address of the computer used by the document preparer to access the TEAS system.

25. Typically, when the DIRECT signature procedure is used, the internet protocol address (“IP address”) captured by TICRS reflects the approximate geographic location (*e.g.*, city, state or province, and country) of the computer from which the trademark document was signed and submitted to the USPTO.

#### **Additional Requirements for Signatures under 37 C.F.R. § 11.18.**

26. 37 C.F.R. § 11.18 provides that the signatory of a document filed with the USPTO certifies that:

[t]o the best of the party’s knowledge, information and belief, *formed after an inquiry reasonable under the circumstances* (i) the paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; (ii) the other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law; (iii) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and (iv) the denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 C.F.R. § 11.18(b)(2) (emphasis added).

27. The USPTO relies on the § 11.18 certification in the course of examining trademark applications and issuing registrations.

#### **Other Requirements in Trademark Applications**

28. To allege use, USPTO trademark applications must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods and



services identified in the application or amendment. *See* 15 U.S.C. § 1051(a)(1); 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); TMEP §§ 904, 904.07(a). The USPTO trademark examination procedures explain what constitutes an acceptable specimen and how a registration may be refused because a specimen is not acceptable. *See* Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); TMEP §§ 904, 904.03(g), 904.07(a).

#### COUNT I

*(failing to provide competent or diligent representation; engaging in dishonesty, fraud, deceit, or misrepresentation; making false statements and offering evidence known to be false; engaging in conduct prejudicial to the administration of justice)*

29. Paragraphs 1 through 28 above are incorporated by reference.

30. The Trademark Electronic Search System (“TESS”)<sup>1</sup> contains approximately 1,600 trademark applications wherein Respondent was named as attorney of record. These filings were primarily made on behalf of foreign-domiciled applicants.

31. In an August 19, 2021 Request for Information and Evidence (“RFI”), OED inquired whether Respondent had personally reviewed and signed 1,400 of those trademark application documents in which he was identified as the attorney of record.

32. In an October 18, 2021 email, Respondent acknowledged to OED that he filed “very few” of the 1,400 trademark applications containing his purported signature listed in the August 19, 2021 RFI.

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<sup>1</sup> TESS is the search engine available to the public that allows one to search the USPTO’s database of registered trademarks and prior pending applications.

33. TIGRS data confirms Respondent's admission that he did not personally file the majority of the trademark application documents filed with the USPTO purportedly containing his electronic signature.

34. The TIGRS data shows that many of the electronic trademark application documents containing Respondent's purported signature were filed with the USPTO within minutes or seconds of one another from various geographical locations, indicating that Respondent did not personally enter his own electronic signature in those documents.

35. One of Respondent's email addresses is [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com). Respondent received and responded to emails from OED with that email address during the course of the investigation of this matter.

36. Respondent's [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com) email address was used as the reply email address in at least seven trademark applications<sup>2</sup> filed with the USPTO wherein Respondent was listed as attorney of record and his DIRECT signature was signed to the trademark filing, but the IP address indicated the application was filed from a geolocation other than Texas<sup>3</sup> - where Respondent maintains his law practice.

37. TEAS automatically sends a filing receipt to the listed reply email address after the filing of any trademark application document. Due to his receiving of the filing receipt by email at [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com), Respondent was aware of the filing of these applications that he did not actually sign, but took no steps to withdraw them or rectify the improper signatures.

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<sup>2</sup> The trademark applications include trademark serial Nos. 90/012,493; 90/034,128; 90/045,640; 90/048,106; 90/048,115; 90/055,576; 90/141,229.

<sup>3</sup> The IP addresses for these electronic documents filed with the USPTO show geolocations in Hong Kong and San Jose or San Francisco, California.

38. Therefore, Respondent directed or, at a minimum, allowed his signature to be signed by another individual to trademark applications and other trademark application documents that were filed with the USPTO.

39. Those trademark applications and other application documents, wherein Respondent was the attorney of record and his email address, [tim.d.liu@gmail.com](mailto:tim.d.liu@gmail.com), was listed as a reply email, also contained a reply email address of [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com).

40. The reply email address [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com) was also associated with trademark application filings containing a Gmail account similar to Respondent's initial email address (tim.d.liu@gmail.com), this Gmail address being, liu.trademarks@gmail.com. There are at least 15 trademark applications and associated application filings<sup>4</sup> containing these reply email addresses used together, [liu.trademarks@gmail.com](mailto:liu.trademarks@gmail.com) and [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com).

41. Respondent is listed as the attorney of record for these 15 trademark application filings and they contain his purported signature. However, these trademark application filings are filed from geolocations other than Texas, namely Hong Kong and San Jose or San Francisco, California, as reflected in the IP addresses.

42. Therefore, the trademark application filings wherein Respondent is the attorney of record, contain his DIRECT signature, and contain a reply email address of [liu.trademarks@gmail.com](mailto:liu.trademarks@gmail.com) and [zxy\\_ip@outlook.com](mailto:zxy_ip@outlook.com), on information and belief, are trademark application filings where Respondent either allowed or directed his signature to be signed by another on trademark application documents filed with the USPTO.

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<sup>4</sup> The trademark applications include trademark serial Nos. 90/055,576; 90/055,617; 90/055,638; 90/055,684; 90/120,429; 90/120,651; 90/167,466; 90/190,886; 90/212,490; 90/219,175; 90/219,250; 90/239,259; 90/239,301; 90/239,308; 90/305,979.

43. The remaining trademark applications and application documents signed with Respondent's purported DIRECT signature were also filed from various geographic locations including Hong Kong, San Jose or San Francisco, and Seattle, Washington as indicated by the IP addresses.

44. Accordingly, on information and belief, the majority of the 1,400 trademark application documents containing Respondent's DIRECT electronic signature were signed by someone other than Respondent.

45. The following chart provides a sample of TIGRS data from sets of trademark application documents filed in close time to one another from various geographical locations bearing Respondent's purported DIRECT signature:

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/449,947	Application	Jan. 6, 2021 02:24:22 ET	54.219.86.236 San Francisco, CA
90/450,084	Application	Jan. 6, 2021 07:02:10 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/453,815	Application	Jan. 7, 2021 20:30:26 ET	54.219.86.236 San Francisco, CA
90/454,012	Application	Jan. 7, 2021 22:15:49 ET	66.42.75.184 Seattle, WA

<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/454,585	Application	Jan. 8, 2021 04:32:23 ET	54.219.86.236 San Francisco, CA

90/454,645	Application	Jan. 8, 2021 05:23:24 ET	66.42.75.184 Seattle, WA
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<b>Application No.</b>	<b>Filing Type</b>	<b>Date &amp; Time</b>	<b>IP Address</b>
90/460,299	Application	Jan. 12, 2021 04:29:25 ET	54.219.86.236 San Francisco, CA
90/460,345	Application	Jan. 12, 2021 05:11:05 ET	66.42.75.184 Seattle, WA

46. The January 6 – 8 and 12, 2021 filings in the chart above apparently would have required Respondent to travel back and forth between San Francisco and Seattle five times and submit the filings from these different locations, at least once within less than an hour of each other, a patently dubious and unlikely undertaking.

47. Additionally, on December 31, 2020, ninety-six (96) trademark filings with Respondent listed as the signatory and attorney of record were filed over an 18-hour period. Each of the 96 filings was submitted to the USPTO under Respondent's purported DIRECT signature. These 96 single-day filings were made from various geographic locations, including San Francisco and Seattle. Respondent could not have reasonably reviewed and signed all of the trademark application documents filed in this time period.

48. Accordingly, on information and belief, Respondent permitted others to electronically enter his signature to trademark application documents, listed in paragraph 45 above, that were then filed with the USPTO in matters where he is the attorney of record in violation of the trademark signature rules.

49. Based on, *inter alia*, the rapid filing of the trademark application documents and the lack of Respondent's own signature in the filings, Respondent did not undertake a reasonable

and adequate inquiry to determine whether the specimens for a mark submitted with a § 1(a) trademark application were demonstrative of goods and/or services that were actually being used in commerce, in violation of the USPTO rules, in particular 37 C.F.R. § 11.18.

50. The trademark examiners assigned to trademark applications in which Respondent was the attorney of record issued Office actions questioning the authenticity of specimens and whether each was in fact currently being used in commerce consistent with the § 1(a) requirements for trademark applications.

51. Trademark examiners assigned to trademark applications containing Respondent's purported signature and in which Respondent was the attorney of record issued Office actions refusing trademark registrations based on faulty specimens. The following chart provides examples of Office actions identifying specimen problems:

<b>Trademark Application Number</b>	<b>Mark</b>	<b>Office Action date</b>	<b>Mark reason for refusal</b>
90/045,640	Pochaler	10/21/2020	Specimen refusal; does not show use in commerce; the screenshot from Amazon does not provide a means to purchase the goods. The website shows the goods are unavailable. Therefore, the website does not show the goods currently in use in commerce.
90/055,684	ZKMotion	11/04/2020	Specimen refusal; does not show use in commerce; mark on specimen does not match the stylized mark in drawing.
90/219,250	XQIQX	02/18/2021	Specimen refusal; does not show use in commerce; 3 specimens purchase fulfillments only, 1 specimen screenshot of web page only.
90/365,406	Ofoxouq	06/02/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the

<b>Trademark Application Number</b>	<b>Mark</b>	<b>Office Action date</b>	<b>Mark reason for refusal</b>
			applied-for mark as actually used in commerce; an attempt to look for the webpage and to review the goods on the website did not provide the webpage at issue; an internet search also did not reveal the use of the mark on the website at issue.
90/365,469	Pwoeigt	06/01/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the applied-for mark as actually used in commerce.
90/416,485	Nlfdbfsh	06/25/2021	Specimen refusal; a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce; the specimen shows a notebook but none of the applied-for services is notebooks or journals.
90/239,259	YD-KY-TG	02/18/2021	Specimen refusal; webpage specimen appears to describe insulated drinkware, not any of the identified goods; refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce
90/429,541	Hasinct	07/04/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.

Trademark Application Number	Mark	Office Action date	Mark reason for refusal
90517178	ATAefr	6/05/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
90/519,316	GeoSweet	06/28/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.

49. Respondent violated the rules pertaining to trademark application specimens by not undertaking an adequate and reasonable inquiry as to whether the specimens were in fact being used in commerce, but nonetheless authorizing the § 1(a) trademark applications containing impermissible specimens and allowing them to be filed in applications wherein he was the attorney of record and contained his purported signature. *See* Trademark Manual of Examining Procedure (“TMEP”) § 904.

50. In the August 19, 2021, Request for Information and Evidence Under 37 C.F.R. § 11.22 (“RFI”), sent to Respondent, OED explained to him that he had an ethical obligation to inform the USPTO of any false signatures on trademark application documents filed with the Office.

51. Despite being informed by OED of his ethical obligation to inform the USPTO (Trademark Operations) of false signatures in trademark application documents in which he is listed as attorney of record, Respondent failed to do so.



52. By reason of the conduct described above, Respondent has engaged in the following misconduct:

- a. Not acting with reasonable diligence and promptness in representing a client by, *inter alia*:
  - i. not personally entering the keystrokes comprising his electronic signature for trademark documents on which he was a named signatory and, instead: (1) directing another person to enter the keystrokes comprising his electronic signature thereon; (2) otherwise allowing or consenting to another person doing so; and/or (3) not taking reasonable steps to ensure that Respondent's clients' trademark filings were signed in accordance with USPTO trademark signature rules;
  - ii. not having an adequate review process or procedure for reviewing applications prior to them being signed and filed with the USPTO, and not making an inquiry to determine: (1) whether the application was properly to be filed as a § 1(a) trademark application (actual use in commerce) or a § 1(b) trademark application (intent to use); and/or (2) whether the specimen for a mark submitted with § 1(a) applications for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s);
  - iii. not taking reasonable steps to ensure that Respondent's clients' trademark filings were reviewed and filed in accordance with the U.S. Counsel Rule to ensure reasonably (1) increased compliance with U.S. trademark law and USPTO regulations, (2) improved accuracy of trademark submissions to the USPTO, and (3) that the integrity of the U.S. trademark register is safeguarded

in violation of 37 C.F.R. § 11.103 of the USPTO Rules of Professional Conduct;

- b. knowingly making a false statement of fact or law to a tribunal or failing to correct a false statement of material fact or law previously made to a tribunal by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant with knowledge that the USPTO would rely on such trademark documents in examining applications and issuing registrations; and/or, (ii) failing to correct and inform the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did

not enter his own electronic signature, in violation of 37 C.F.R. § 11.303(a)(1) of the USPTO Rules of Professional Conduct;

- c. knowingly offering evidence the practitioner knows to be false or failing to take reasonable remedial measures, including, if necessary, disclosure to the tribunal, when the practitioner, the practitioner's client, or a witness called by practitioner has offered material evidence and the practitioner comes to know of its falsity by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents, including declarations, and file those documents with the USPTO, where Respondent was the named signatory on the document and the attorney of record for the trademark applicant; and/or (ii) failing to take reasonable remedial measures, by not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature, in violation of 37 C.F.R. § 11.303(a)(3) of the USPTO Rules of Professional Conduct;
- d. engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant; and/or (ii) not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark applications, and did not enter his own electronic signature, in violation of 37 C.F.R. § 11.804(c) of the USPTO Rules of Professional Conduct;
- e. engaging in conduct prejudicial to the administration of justice – specifically, the USPTO trademark registration system - by, *inter alia*: (i) allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant; and/or (ii) allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s), in violation of 37 C.F.R. § 11.804(d) of the USPTO Rules of Professional Conduct; and/or
- f. engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the Office by engaging in the acts and omissions as set forth above to the extent that they do not constitute a violation of the provisions of the USPTO Rules of Professional Conduct set forth in paragraphs a. through e., above in violation of 37 C.F.R. § 11.804(i) of the USPTO Rules of Professional Conduct.

## COUNT II

*(failing to respond to lawfully issued RFIs and failure to cooperate in an OED investigation)*

53. Paragraphs 1 through 52 above are incorporated by reference.

54. On August 19, 2021, OED mailed the first RFI to Respondent's 37 C.F.R. § 11.11 address of record in Sugar Land, Texas via certified mail and regular first-class mail.

55. The August 19, 2021 RFI was lawfully issued to Respondent.

56. The August 19, 2021 RFI set a response deadline of September 19, 2021.

57. On August 31, 2021, OED received the return certified mail receipt showing that Respondent, or his agent, received the RFI on August 25, 2021. The RFI sent via regular mail was not returned; thus, the presumption is that it was received.<sup>5</sup>

58. Respondent did not respond to the RFI by the September 19, 2021 deadline.

59. Having not received a response from Respondent, OED spoke directly with Respondent via telephone on September 21, 2021. During the call, Respondent advised OED that he no longer lived at the Sugar Land, Texas address and provided OED with an address in Houston, Texas, where he received mail.

60. During the disciplinary investigation, OED asked Respondent to update his address with the Office consistent with the requirements of 37 C.F.R. § 11.11.

61. Despite being required by the rule to update his § 11.11 mailing address, and Respondent telling OED that he would update his address, as of the filing of this Complaint, Respondent has not updated his address with the Office.

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<sup>5</sup> There is a presumption that mail, "properly addressed and stamped," was received by the addressee. *See Toomey v. District of Columbia*, 315 A.2d 565,567 (D.C. 1974) (per curiam) (quoting *Columbia Fin. Co. v. Worthy*, 141 A.2d 185, 186 (D.C. 1958)).

62. On September 24, 2021, OED mailed Respondent a Lack of Response Notification letter and a copy of the RFI to Respondent's Houston, Texas address and to his address of record in Sugar Land, Texas. Both correspondences were mailed via certified mail.

63. On October 4, 2021, OED received a certified mail receipt showing that an agent at the address of record in Sugar Land, Texas, had received the Lack of Response Notification on September 29, 2021. The Lack of Response Notification was also mailed via first class mail to the Sugar Land, Texas address and was not returned.

64. Also, on October 4, 2021, OED received a certified mail receipt showing the addressee at the Houston, Texas address had received the Lack of Response Notification on September 30, 2021. The Lack of Response Notification was also mailed via first class mail to the Houston, Texas address and was not returned.

65. The Lack of Response Notification set a response due date of October 1, 2021.

66. Having not heard from Respondent by the October 1, 2021 due date, OED called Respondent on October 4, 2021.

67. During the October 4, 2021 telephone call, Respondent informed OED that he had received the Lack of Response letter.

68. During the October 4, 2021 telephone call, Respondent represented to OED that he was attempting to gather some of the documents requested by OED from his office in China and requested a fourteen (14) day extension of time to gather the documents. He represented that the additional time would allow him to provide a thorough response to the RFI.

69. OED granted Respondent's request for an extension of time so that he could provide a thorough response to the RFI and, on October 6, 2021, Respondent and the OED Director signed

a 14-day tolling agreement providing Respondent with an extension of time until October 15, 2021, in which to answer the RFI.

70. On October 18, 2021, Respondent emailed OED a three-sentence response stating that: (1) he had only filed “very few” of the trademark filings identified in the RFI; (2) unauthorized filings came out of China or were done by a former client; and (3) he would compile a list of unauthorized filings. Respondent, however, did not identify the trademark documents he had filed, nor did he identify what filings were unauthorized or the name of the former client.

71. On October 18, 2021, OED called Respondent to discuss his email response. During the telephone call, OED again emphasized that a complete response to the RFI was needed.

72. During the same telephone call, Respondent represented to OED that he would provide a list of the unauthorized trademark filings by “tomorrow,” October 19, 2021.

73. Also, during the October 18, 2021 phone call, OED requested that Respondent participate in a telephone interview regarding his trademark filings and standard operating procedures. Respondent agreed to participate in the telephone interview and stated that he had open availability the first week of November (2021).

74. OED immediately followed up on the October 18, 2021 telephone call with an email reminding Respondent that OED must receive a response to the RFI and setting the agreed upon telephone interview for November 3, 2021.

75. Respondent did not respond to OED’s October 18, 2021 follow-up email. He did not participate in the November 3, 2021 telephone interview or attempt to reschedule it.

76. After the October 18, 2021 telephone call, Respondent ceased all communication with OED.

77. Respondent knowingly failed to fully respond to OED's lawfully issued RFI, despite informing OED that he would respond and provide both a list of the trademark applications that he claimed he did not file and produce the requested documents, including those he claimed he was waiting to receive from his China office.

78. By reason of the conduct described above, Respondent has engaged in the following misconduct:

- a. failing to cooperate with OED in an investigation of any matter before it by, *inter alia*, evading meaningful communication with OED, failing to substantively respond to OED's August 19, 2021 RFI, Lack of Response Notice, and numerous emails sent to the email address that Respondent had used to communicate with OED after being afforded ample time and opportunity to do so, and after representing that he would cooperate, in violation of 37 C.F.R. § 11.801(b) of the USPTO Rules of Professional Conduct;
- b. engaging in conduct that is prejudicial to the administration of justice by, *inter alia*, failing to notify OED within 30 days of a change of mailing address as required by 37 C.F.R. § 11.11; failing to substantively respond to OED's numerous communications regarding the RFI after being afforded ample time and opportunity to do so; informing OED that he would respond to their communications and failing to do so, in violation of 37 C.F.R. § 11.804(d) of the USPTO Rules of Professional Conduct;
- c. engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the Office by engaging in the acts and omissions as set forth above to the extent that they do not constitute a violation of the provisions of the USPTO Rules of Professional Conduct set forth in paragraph a. and b. above in violation of 37 C.F.R. § 11.804(i) USPTO Rules of Professional Conduct.

### **Request for Relief**

WHEREFORE, for the facts and reasons stated herein, the OED Director requests entry of an Order (1) excluding or suspending Respondent from practice before the USPTO in patent, trademark, and other non-patent matters, and (2) such additional relief as this Tribunal deems reasonable and warranted.

January 12, 2022

/William R. Covey/

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William R. Covey  
Deputy General Counsel for Enrollment and Discipline and  
Director of the Office of Enrollment and Discipline

## NOTICE OF CORRESPONDENCE ADDRESSES

Respondent must file an answer to the Complaint in writing with the Administrative Law Judge within thirty (30) days from the date of the filing of this Complaint, addressed as follows:

If sent by mail:	Docket Clerk HUD Office of Hearings and Appeals 451 7 <sup>th</sup> Street, S.W. Room B-133 Washington, D.C. 20410
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If hand-delivered: ( <i>e.g.</i> , via Federal Express or other delivery service)	Docket Clerk HUD Office of Hearings and Appeals 409 3 <sup>rd</sup> Street, S.W. Suite 201 Washington, D.C. 20024
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Respondent must also file a PDF version of the answer with the Administrative Law Judge via email to: [alj.alj@hud.gov](mailto:alj.alj@hud.gov)

Respondent must also serve a copy of the answer on the OED Director, who is represented by Associate Solicitors Melinda M. DeAtley and Hendrik deBoer. A copy of the answer shall be served on counsel for the OED Director in any one of four ways:

1. By email, attaching the answer in PDF format, to the email addresses of the two Associate Solicitors named above and to: [PTO-HUDcases@uspto.gov](mailto:PTO-HUDcases@uspto.gov)

Melinda M. DeAtley may be contacted by telephone at (571) 272-8576 or by e-mail message at [melinda.deatley@uspto.gov](mailto:melinda.deatley@uspto.gov).

Hendrik deBoer may be contacted by telephone at (571) 270-5339 or by e-mail message at [hendrik.deBoer@uspto.gov](mailto:hendrik.deBoer@uspto.gov).

2. By U.S. Postal Service, via mail to the following address:

United States Patent and Trademark Office  
Mail Stop 8  
Office of the Solicitor  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

3. By courier service (*e.g.*, UPS, FedEx, DHL) or hand delivery, via delivery to:

United States Patent and Trademark Office  
Office of the Solicitor



600 Dulany Street – Madison Building West  
Eighth Floor, 8C43-A  
Alexandria, VA 22314

4. By facsimile transmission to the USPTO – Office of the Solicitor at:  
(571) 273-0373.

## CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing COMPLAINT AND NOTICE OF PROCEEDING UNDER 35 U.S.C. § 32 and NOTICE OF CORRESPONDENCE ADDRESSES was mailed this day via certified mail to Respondent at:

Mr. Daoyou Tim Liu  
4735 Burclare Ct.  
Sugar Land, TX 77479

Mr. Daoyou Tim Liu  
Liu Law Group, PLLC  
6901 Corporate Dr. #111  
Houston, TX 77036

January 12, 2022

/s/ Shane Walter  
United States Patent and Trademark Office  
Mail Stop 8  
Office of the Solicitor  
P.O. Box 1450  
Alexandria, Virginia 22313-1450



## UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF ENROLLMENT AND DISCIPLINE

November 1, 2022

For certified copy purposes, I declare under penalty of perjury that the attached copy of the Initial Decision on Default Judgment in USPTO Proceeding No. D2022-03, *In the Matter of Daoyou Tim Liu* is a true and correct copy of the Initial Decision on Default Judgment in, *In the Matter of Daoyou Tim Liu*, USPTO Proceeding No. D2022-03.

/David R. Harley/

David R. Harley  
Paralegal Specialist  
Office of Enrollment and Discipline



**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE**

In the Matter of:

DAOYOU TIM LIU,

Respondent.

Proceeding No. D2022-03

August 9, 2022

**INITIAL DECISION ON DEFAULT JUDGMENT**

This matter arises from a disciplinary complaint filed by the Director for the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “the Office”) against Daoyou Tim Liu (“Respondent”) pursuant to 35 U.S.C. § 32 as implemented by 37 C.F.R. Part 11.<sup>1</sup> The OED Director filed a *Motion for Entry of Default Judgment and Imposition of Disciplinary Sanction* (“Default Motion”) seeking a default judgment and an order excluding Respondent from practice before the Office.

**PROCEDURAL HISTORY**

On January 12, 2022, the OED Director filed a *Complaint and Notice of Proceedings under 35 U.S.C. § 32* (“Complaint”) against Respondent pursuant to 37 C.F.R. §§ 11.32 and 11.34, alleging violations of the USPTO Rules of Professional Conduct (37 C.F.R. §§ 11.101 *et seq.*) (hereinafter, “the Rules”). The *Complaint* stated that Respondent was required to file a written Answer with the Court within 30 days.

Also, on January 12, 2022, in accordance with 37 C.F.R. § 11.35(a)(2), the OED Director mailed the *Complaint* via certified and regular mail to two addresses associated with Respondent. The OED Director sent the *Complaint* to the initial address on file for Respondent in Sugar Land, Texas. The OED Director also sent the *Complaint* via certified mail to a Houston, Texas address that Respondent provided to OED during the disciplinary investigation. On January 15, 2022, Respondent, or his agent, signed for the *Complaint* sent to the Houston, Texas address as indicated by the return receipt postcard received by OED on January 19, 2022.

The Court issued the *Notice of Docketing* that ordered Respondent to file his Answer on or before February 11, 2022. Respondent did not file his Answer by the deadline. Because Respondent did not file a timely Answer, on February 17, 2022, the OED Director emailed Respondent seeking permission to send him the *Complaint* electronically. On Sunday, February 27, 2022, Respondent contacted counsel for the OED Director (“counsel”) by email asking that the correspondence be sent to both his tim.d.liu@gmail.com and [REDACTED] email

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<sup>1</sup> Pursuant to an Interagency Agreement in effect beginning March 27, 2013, Administrative Law Judges of the U.S. Department of Housing and Urban Development have been appointed by the U.S. Commerce Secretary and are authorized to hear cases brought by the U.S. Patent and Trademark Office.

addresses. On Monday, February 28, 2022, counsel used these two email addresses to send Respondent a copy of the *Complaint* and the Court's *Notice of Docketing*.

On June 9, 2022, the OED Director filed the *Motion for Default Judgment and Imposition of Sanction* ("Default Motion"). Pursuant to 37 C.F.R. § 11.43, Respondent had 21 days to respond to the OED Director's motion. Respondent did not file a response. By *Order* dated July 1, 2022, the Court required Respondent to file his Answer and show cause as to why his Answer was not timely filed. As of the date of this decision, Respondent has not filed an Answer to the *Complaint*, responded to the *Default Motion*, sought an extension of time to do so, or otherwise appeared in this matter. The Court has received no communication from or on behalf of Respondent.

### APPLICABLE LEGAL PRINCIPLES

**USPTO Disciplinary Proceedings.** The USPTO has the "exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it." Kroll v. Finnerty, 242 F.3d 1359, 1364 (Fed. Cir. 2001). This authority flows from 35 U.S.C. § 2(b)(2)(D), which empowers the USPTO to establish regulations governing patent practitioners' conduct before the Office, and 35 U.S.C. § 32, which empowers the USPTO to discipline a practitioner who is "shown to be incompetent or disreputable, or guilty of gross misconduct," or who violates the USPTO's regulations. The practitioner must receive notice and an opportunity for a hearing before such disciplinary action is taken. See 35 U.S.C. § 32. Disciplinary hearings are conducted in accordance with the USPTO's procedural rules at 37 C.F.R. part 11, subpart C, and with section 7 of the Administrative Procedure Act, 5 U.S.C. § 556, by a hearing officer appointed by the USPTO. See 37 C.F.R. §§ 11.39(a), 11.44. The OED Director has the burden of proving any alleged violations by clear and convincing evidence. See 37 C.F.R. § 11.49.

The USPTO has its own disciplinary rules governing practice before the Office. In 1985, the USPTO issued regulations based on the ABA Model Code of Professional Responsibility to govern attorney conduct and practice. See Practice Before the Patent and Trademark Office, 50 Fed. Reg. 5158 (Feb. 6, 1985) (Final Rule) (codified at 37 C.F.R. §§ 10.20-10.112). These rules set forth the USPTO Code of Professional Responsibility and "clarif[ied] and modernize[d] the rules relating to admission to practice and the conduct of disciplinary cases." Id. In May 2013, the USPTO replaced the USPTO Code with the Rules. See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20180 (April 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901). By updating its regulations, the USPTO sought to "provid[e] attorneys with consistent professional conduct standards, and large bodies of both case law and opinions written by disciplinary authorities that have adopted the ABA Model Rules."<sup>2</sup> Id. at 20180.

**U.S. Counsel Rule.** Effective August 3, 2019, the USPTO amended its rules of practice to require that trademark applicants not domiciled within the United States be represented by an

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<sup>2</sup> Thus, the USPTO Code, the Comments and Annotations to the ABA Model Rules, and disciplinary decisions and opinions issued by state boards are useful to understanding the USPTO Rules. See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20180.

attorney who is an active member in good standing of the bar of the highest court of any of the 50 states of the U.S., the District of Columbia, or any Commonwealth or territory of the U.S. (also known as the “U.S. Counsel Rule”). See 37 C.F.R. § 2.11; Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 Fed. Reg. 31498 (July 2, 2019). The purposes of the U.S. Counsel Rule include to “instill greater confidence in the public that U.S. registrations that issue to foreign applicants are not subject to invalidation for reasons such as improper signatures and use claims and enable the USPTO to more effectively use available mechanisms to enforce foreign applicant compliance with statutory and regulatory requirements in trademark matters.” See id. Of most concern, the U.S. Counsel Rule is intended to address, *inter alia*, the rampant filing of suspicious specimens of use and unauthorized practice of trademark law (UPL) occurring frequently with trademark applications filed by or on behalf of foreign applicants. See “New U.S. Counsel rule: USPTO’s initiatives to ensure accuracy and integrity of the Trademark Register” (July 30, 2019), <https://www.uspto.gov/about-us/news-updates/op-ed-new-us-counsel-rule-usptos-initiatives-ensure-accuracy-and-integrity>. Therefore, the U.S. Counsel Rule impacts the specimens filed as a § 1(a)<sup>3</sup> trademark application, indicating the mark is currently in use in commerce.

Where the application is a § 1(a) application, the specimen must be filed with the application and be acceptable. Specifically, to allege use, USPTO trademark applications must include a specimen showing the applied-for mark as actually used in commerce for each international class of goods and services identified in the application or amendment. 15 U.S.C. § 1051(a)(1); 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); TMEP §§ 904, 904.07(a). The USPTO Trademark examination procedures explain what constitutes an acceptable specimen and how a registration may be refused because a specimen is not acceptable. Trademark Act Sections 1 and 45, 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56(a); TMEP §§ 904, 904.03(g), 904.07(a).

**Signature Requirements for Trademark Applications.** Trademark applications contain declarations that are signed under penalty of perjury with false statements being subject to punishment under 18 U.S.C. § 1001. Signatories to declarations in trademark applications make specific representations regarding the applicants’ use of the mark in commerce and/or their intent to use the mark in commerce. The USPTO relies on such declarations in the course of examining trademark applications and issuing registrations. USPTO trademark signature rules require that all signatures be personally entered by the named signatory. See 37 C.F.R. §§ 2.193(a) and (c), and 37 C.F.R. § 11.18(a). Typing the electronic signature of another person is not a valid signature under USPTO rules. Id.

The following published guidance from the USPTO identified the proscription against any person other than the named signatory entering the electronic signature in trademark documents filed with the USPTO:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a). The person(s) identified as the

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<sup>3</sup> A § 1(a) application represents that the signatory believes the applicant is the owner of the mark; the mark is used in commerce as of the date of the application, and; the specimen shows the mark as it is currently being used in commerce. 15 U.S.C. § 1051(a).

signatory must manually enter the elements of the electronic signature. Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory. See In re Dermahose Inc., 82 USPQ2d 1793 (TTAB 2007); In re Cowan, 18 USPQ2d 1407 (Comm’r Pats. 1990). 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.

Trademark Manual of Examining Procedure § 611.01(c) (Oct. 2018). The signature rules were published and available to Respondent.

**Signature Types for USPTO Applications.** The Trademark Electronic Application System (“TEAS”) is the USPTO’s electronic trademark filing and prosecution system. Trademark documents are electronically prepared, signed, and filed with the USPTO via TEAS. Those electronic documents include trademark applications, attendant declarations, or related electronic filing documents.

There are three methods for electronically signing trademark application documents via TEAS. The “DIRECT” signature is the default signature procedure. The DIRECT signature procedure is used where the originator and signatory of the document signs the electronic signature directly onto the form online via TEAS, shortly before the form is filed.

The two other available signature procedures are “ESIGN-ON” and “H SIGN.” For the ESIGN-ON procedure, a trademark document preparer is able to have a third party sign their electronic signature to trademark documents that will be filed with the Office. For the “H SIGN” procedure, an electronic version (*e.g.*, a PDF version) of the original handwritten pen-and-ink signature is submitted to the USPTO via TEAS. Unlike the typical use of the DIRECT signature procedure, the ESIGN-ON and H SIGN procedures allow a named signatory who is not located where the filer is located to sign a filing in compliance with the USPTO trademark signature rules.

The USPTO relies on 37 C.F.R. § 11.18 certification in the course of examining trademark applications and issuing registrations. Section 11.18 provides that the signatory of a document filed with the USPTO certifies that:

[t]o the best of the party’s knowledge, information and belief, *formed after an inquiry reasonable under the circumstances* (i) the paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; (ii) the other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law; (iii) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary

support after a reasonable opportunity for further investigation or discovery; and (iv) the denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 C.F.R. § 11.18(b)(2) (emphasis added).

The USPTO's Trademark Image Capture and Retrieval System ("TICRS") is an internal USPTO database. TICRS captures and records data, including the date and time when a document is created on TEAS and when a document is submitted to the USPTO via TEAS. TICRS also captures and records the signature procedures<sup>4</sup> used for signed documents filed with the USPTO via TEAS and the Internet Protocol ("IP") address of the computer used by the document preparer to access the TEAS system. Typically, when the DIRECT signature procedure is used, the internet protocol address ("IP address") captured by TICRS reflects the approximate geographic location (*e.g.*, city, state or province, and country) of the computer from which the trademark document was signed and submitted to the USPTO.

Additionally, the Trademark Electronic Search System ("TESS"), is the search engine available to the public that allows one to search the USPTO's database of registered trademarks and prior pending applications. TESS was available to Respondent to determine all of the trademark applications wherein he was listed as the attorney of record and named signatory.

**Burden of Proof.** The OED Director must prove alleged disciplinary violations by "clear and convincing evidence." 37 C.F.R. § 11.49; *In re Johnson*, Proceeding No. D2014-12 at 2 (USPTO Dec. 31, 2014)<sup>5</sup>. This standard "protect[s] particularly important interests . . . where there is a clear liberty interest at stake." *Johnson*, at 3 (quoting *Thomas v. Nicholson*, 423 F.3d 1279, 1283 (Fed. Cir. 2005)) (internal quotation marks omitted). "Clear and convincing evidence" requires a level of proof that falls "between a preponderance of the evidence and proof beyond a reasonable doubt." *Id.* (quoting *Addington v. Texas*, 441 U.S. 418, 424-25 (1979)) (internal quotation marks omitted). The evidence must be of such weight so as to "produce[] in the mind of the trier of fact a firm belief or conviction, without hesitancy, as to the truth of the allegations sought to be established." *Id.* (quoting *Jimenez v. DaimlerChrysler Corp.*, 269 F.3d 439, 450 (4th Cir. 2001)) (internal quotation marks omitted). "Evidence is clear if it is certain, unambiguous, and plain to the understanding, and it is convincing if it is reasonable and persuasive enough to cause the trier of facts to believe it." *Id.* (quoting *Foster v. AlliedSignal, Inc.*, 293 F.3d 1187, 1194 (10th Cir. 2002)) (internal quotation marks omitted).

**Consequences for Failure to Answer the Complaint.** The USPTO's procedural rules set forth the requirement for answering the *Complaint* and the consequences for failing to do so: "Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment." 37 C.F.R. § 11.36(e). Also, in the *Notice of Docketing*, this Court warned Respondent of the same.

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<sup>4</sup> The XML data stored at the USPTO for trademark filings made using the "DIRECT" signature method will show "<signature-type> DIRECT".

<sup>5</sup> Available at: <https://go.usa.gov/x7x93>.



## FINDINGS OF FACT

Because Respondent failed to answer the *Complaint*, he is deemed to have admitted the allegations in the *Complaint*, which are set forth below as the Court's findings of fact.

Respondent is an attorney licensed to practice law in the State of Texas, since May 6, 2011. Although Respondent lives in Houston, Texas, he is also licensed to practice law in the State of California, since September 1, 2009.

Respondent's office is located in Houston, Texas. However, many of the electronic trademark documents filed with the USPTO were filed with his purported DIRECT signature from various geographic locations within seconds or minutes of one another, such as Hong Kong, China, San Jose, California, or San Francisco, California. TESS contains approximately 1,600 trademark applications with Respondent named as attorney of record and these filings were primarily made on behalf of foreign-domiciled applicants.

In an August 19, 2021 Request for Information and Evidence ("RFI"), OED inquired whether Respondent had personally reviewed and signed 1,400 of those trademark application documents in which he was identified as the attorney of record. In an October 18, 2021 email, Respondent acknowledged to OED that he filed "very few" of the 1,400 trademark applications containing his purported signature listed in the August 19, 2021 RFI.

TICRS data confirms Respondent's admission that he did not personally file the majority of the trademark application documents filed with the USPTO purportedly containing his electronic signature. The TICRS data shows that many of the electronic trademark application documents containing Respondent's purported signature were filed with the USPTO within minutes or seconds of one another from various geographical locations, indicating that Respondent did not personally enter his own electronic signature in those documents. Accordingly, the majority of the 1,400 trademark application documents containing Respondent's DIRECT electronic signature were signed by someone other than Respondent.

Despite being impermissibly signed and filed by someone other than Respondent, where he was the attorney of record, Respondent knew or should have known that these trademark application documents were being signed and filed with the Office. One of Respondent's email addresses is tim.d.liu@gmail.com. Of note, Respondent received and responded to emails from OED with that email address during the course of his disciplinary investigation. Respondent's tim.d.liu@gmail.com email address was used as the reply email address in at least seven trademark applications<sup>6</sup> filed with the USPTO wherein Respondent was listed as attorney of record and his DIRECT signature was signed to the trademark filing, but the IP address indicated the application was filed from a geolocation other than Texas - where Respondent maintains his law practice. TEAS automatically sends a filing receipt to the listed reply email address after the filing of any trademark application document. Due to his receiving the filing receipt by email at tim.d.liu@gmail.com, Respondent was aware of the filing of these applications that he did not actually sign, but took no steps to withdraw them or rectify the improper signatures. Therefore,

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<sup>6</sup> The trademark applications are trademark serial Nos. 90/012,493; 90/034,128; 90/045,640; 90/048,106; 90/048,115; 90/055,576; 90/141,229.

Respondent directed or, at a minimum, allowed his signature to be signed by another individual to trademark applications and other trademark application documents that were filed with the USPTO.

Those trademark applications and other application documents, wherein Respondent was the attorney of record and his email address, tim.d.liu@gmail.com, was listed as a reply email, also contained a reply email address of zxy\_ip@outlook.com. The reply email address zxy\_ip@outlook.com was also contained within trademark application filings associated with liu.trademarks@gmail.com, a Gmail account similar to Respondent's primary email address (tim.d.liu@gmail.com). There are at least 15 trademark applications and associated application filings<sup>7</sup> containing these reply email addresses used together, liu.trademarks@gmail.com and zxy\_ip@outlook.com. Respondent is listed as the attorney of record for these 15 trademark application filings and they contain his purported signature. However, these trademark application filings are filed from geolocations other than Texas, namely Hong Kong and California, as reflected in the IP addresses. Therefore, the trademark application filings wherein Respondent is the attorney of record, contain his DIRECT signature, and contain a reply email address of liu.trademarks@gmail.com and zxy\_ip@outlook.com are trademark application filings where Respondent either allowed or directed his signature to be signed by another on trademark application documents filed with the USPTO.

The remaining trademark applications and application documents signed with Respondent's purported DIRECT signature were also filed from various locations including Hong Kong, California, and Washington State, as indicated by the IP addresses. Accordingly, the majority of the 1,400 trademark application documents containing Respondent's DIRECT electronic signature were signed by someone other than Respondent.

The following chart provides a sample of TICRS data from sets of trademark application documents filed close in time to one another from various geographical locations bearing Respondent's purported DIRECT signature:

Application No.	Filing Type	Date & Time	IP Address
90/449,947	Application	Jan. 6, 2021 02:24:22 ET	54.219.86.236 San Francisco, CA
90/450,084	Application	Jan. 6, 2021 07:02:10 ET	66.42.75.184 Seattle, WA

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<sup>7</sup> The trademark applications are trademark serial Nos. 90/055,576; 90/055,617; 90/055,638; 90/055,684; 90/120,429; 90/120,651; 90/167,466; 90/190,886; 90/212,490; 90/219,175; 90/219,250; 90/239,259; 90/239,301; 90/239,308; 90/305,979.

Application No.	Filing Type	Date & Time	IP Address
90/453,815	Application	Jan. 7, 2021 20:30:26 ET	54.219.86.236 San Francisco, CA
90/454,012	Application	Jan. 7, 2021 22:15:49 ET	66.42.75.184 Seattle, WA

Application No.	Filing Type	Date & Time	IP Address
90/454,585	Application	Jan. 8, 2021 04:32:23 ET	54.219.86.236 San Francisco, CA
90/454,645	Application	Jan. 8, 2021 05:23:24 ET	66.42.75.184 Seattle, WA

Application No.	Filing Type	Date & Time	IP Address
90/460,299	Application	Jan. 12, 2021 04:29:25 ET	54.219.86.236 San Francisco, CA
90/460,345	Application	Jan. 12, 2021 05:11:05 ET	66.42.75.184 Seattle, WA

The January 6 – 8 and 12, 2021 filings in the chart above apparently would have required Respondent to travel back and forth between San Francisco and Seattle five times and submit the filings from these different locations, at least once within less than an hour of each other, a patently dubious and unlikely undertaking. Additionally, on December 31, 2020, ninety-six (96) trademark filings with Respondent listed as the signatory and attorney of record were filed over an 18-hour period. Each of the 96 filings was submitted to the USPTO under Respondent's purported DIRECT signature. These 96 single-day filings were made from various geographic locations, including San Francisco and Seattle. Respondent could not have reasonably reviewed and signed all of the trademark application documents filed during this time period. Therefore, Respondent permitted others to electronically enter his signature to trademark application documents, listed in the four charts above, that were then filed with the USPTO in matters where he is the attorney of record in violation of the trademark signature rules.

Based on, *inter alia*, the rapid filing of the trademark application documents and the lack of Respondent's own signature in the filings, Respondent did not undertake a reasonable and adequate inquiry to determine whether the specimens for a mark submitted with a § 1(a) trademark application were demonstrative of goods and/or services that were actually being used in commerce, in violation of the USPTO rules, in particular 37 C.F.R. § 11.18. The trademark examiners assigned to trademark applications in which Respondent was the attorney of record

issued Office actions questioning the authenticity of specimens and whether each was in fact currently being used in commerce consistent with the § 1(a) requirements for trademark applications. These trademark examiners assigned to trademark applications containing Respondent's purported signature and in which Respondent was the attorney of record issued Office actions refusing trademark registrations based on faulty specimens. The following chart provides examples of Office actions identifying specimen problems:

<b>Trademark Application Number</b>	<b>Mark</b>	<b>Office Action date</b>	<b>Mark reason for refusal</b>
90/045,640	Pochaler	10/21/2020	Specimen refusal; does not show use in commerce; the screenshot from Amazon does not provide a means to purchase the goods. The website shows the goods are unavailable. Therefore, the website does not show the goods currently in use in commerce.
90/055,684	ZKMotion	11/04/2020	Specimen refusal; does not show use in commerce; mark on specimen does not match the stylized mark in drawing.
90/219,250	XQIQX	02/18/2021	Specimen refusal; does not show use in commerce; 3 specimens purchase fulfillments only, 1 specimen screenshot of web page only.
90/365,406	Ofoxouq	06/02/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the applied-for mark as actually used in commerce; an attempt to look for the webpage and to review the goods on the website did not provide the webpage at issue; an internet search also did not reveal the use of the mark on the website at issue.
90/365,469	Pwoeigt	06/01/2021	Specimen refusal; specimen appears to consist of a mockup of a depiction of the mark on a webpage and does not show the applied-for mark as actually used in commerce.

Trademark Application Number	Mark	Office Action date	Mark reason for refusal
90/416,485	Nlfdbfsh	06/25/2021	Specimen refusal; a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce; the specimen shows a notebook but none of the applied-for services is notebooks or journals.
90/239,259	YD-KY-TG	02/18/2021	Specimen refusal; webpage specimen appears to describe insulated drinkware, not any of the identified goods; refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce
90/429,541	Hasinct	07/04/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
90517178	ATAefr	6/05/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.
90/519,316	GeoSweet	06/28/2021	Specimen refusal; registration is refused because the specimen appears to consist of a digitally created or altered image or a mockup of a depiction of the mark on the goods or their packaging and does not show the applied-for mark as actually used in commerce.

Therefore, Respondent violated the rules pertaining to trademark application specimens by not undertaking an adequate and reasonable inquiry as to whether the specimens were in fact

being used in commerce, but nonetheless authorizing the § 1(a) trademark applications containing impermissible specimens and allowing them to be filed in applications wherein he was the attorney of record and contained his purported signature. See Trademark Manual of Examining Procedure (“TMEP”) § 904.

In the August 19, 2021, Request for Information and Evidence Under 37 C.F.R. § 11.22 (“RFI”), sent to Respondent, OED explained to him that he had an ethical obligation to inform the USPTO of any false signatures on trademark application documents filed with the Office. Despite being informed by OED of his ethical obligation to inform the USPTO (Trademark Operations) of false signatures in trademark application documents, in which he is listed as attorney of record, Respondent failed to do so.

I. Respondent failed to respond to Lawfully Issued Requests for Information and Evidence (“RFI”) and failed to cooperate with an OED Investigation

Respondent failed to respond to OED’s lawfully issued RFI and failed to cooperate with OED’s investigation. As a result, these omissions amounted to additional rule violations. On August 19, 2021, OED mailed the first RFI to Respondent’s 37 C.F.R. § 11.11 address of record in Sugar Land, Texas via certified mail and regular first-class mail. The August 19, 2021 RFI was lawfully issued to Respondent and set a response deadline of September 19, 2021. On August 31, 2021, OED received the return certified mail receipt showing that Respondent, or his agent, received the RFI on August 25, 2021. Respondent did not respond to the RFI by the September 19, 2021 deadline.

Having not received a response from Respondent, OED spoke directly with Respondent via telephone on September 21, 2021. During the call, Respondent advised OED that he no longer lived at the Sugar Land, Texas address and provided OED with an address in Houston, Texas, where he received mail. OED asked Respondent to update his address with the Office consistent with the requirements of 37 C.F.R. § 11.11. Yet, despite being required by the rule to update his § 11.11 mailing address, and Respondent telling OED that he would update his address, as of the filing of the Complaint, Respondent had not updated his address with the Office.

On September 24, 2021, OED mailed Respondent a Lack of Response Notification letter (“Lack of Response letter”) and a copy of the RFI to Respondent’s Houston, Texas address and to his § 11.11 address of record in Sugar Land, Texas. Then on October 4, 2021, OED received a certified mail receipt signed by an agent at the address of record in Sugar Land, Texas, demonstrating the receipt of the Lack of Response letter on September 29, 2021. Also, on October 4, 2021, OED received a certified mail receipt signed by Respondent, the addressee, at the Houston, Texas address, demonstrating that he received the Lack of Response letter on September 30, 2021. The Lack of Response letter set a response due date of October 1, 2021.

Having not heard from Respondent by the October 1, 2021 due date, OED called Respondent on October 4, 2021. During the October 4, 2021 telephone call, Respondent informed OED that he had received the Lack of Response letter. Respondent also informed OED that he was attempting to gather some of the documents requested by OED from his office in



China and requested a fourteen (14) day extension of time to gather the documents. He represented that the additional time would allow him to provide a thorough response to the RFI. OED granted Respondent's request for an extension of time so that he could provide a thorough response to the RFI and, on October 6, 2021, Respondent and the OED Director signed a 14-day tolling agreement providing Respondent with an extension of time until October 15, 2021, in which to answer the RFI.

On October 18, 2021, Respondent emailed OED a three-sentence response stating that: (1) he had only filed "very few" of the trademark filings identified in the RFI; (2) unauthorized filings came out of China or were done by a former client; and (3) he would compile a list of unauthorized filings. Respondent, however, did not identify the trademark documents he had filed, nor did he identify what filings were unauthorized or the name of the former client.

That same day, OED called Respondent to discuss his email response. During the telephone call, OED again emphasized that a complete response to the RFI was needed. Respondent represented to OED that he would provide a list of the unauthorized trademark filings by "tomorrow," October 19, 2021. The OED also requested that Respondent participate in a telephone interview regarding his trademark filings and standard operating procedures. Respondent agreed to participate in the telephone interview and stated that he had open availability the first week of November (2021).

After the termination of the call, on October 18, 2021, OED immediately followed up with an email reminding Respondent that OED must receive a response to the RFI, and setting the agreed upon telephone interview for November 3, 2021. Respondent did not respond to OED's October 18, 2021 follow-up email. He did not participate in the November 3, 2021 telephone interview or attempt to reschedule it. In fact, after the October 18, 2021 telephone call, Respondent ceased all communication with OED.

Respondent knowingly failed to respond fully to OED's lawfully issued RFI, despite informing OED that he would respond and provide both a list of the trademark applications that he claimed he did not file and produce the requested documents, including those he claimed he was waiting to receive from his China office.

## **CONCLUSIONS OF LAW**

Based upon the foregoing findings of fact, the Court concludes that Respondent violated the following Rules, for the following reasons.

1. 37 C.F.R. § 11.103, which provides that a practitioner "shall act with reasonable diligence and promptness in representing a client." Respondent violated this rule by failing to take reasonable steps to ensure that Respondent's clients' trademark filings were signed in accordance with the USPTO trademark signature rules. In particular, Respondent did not personally enter the keystrokes comprising his electronic signature for trademark documents on which he was a named signatory, and instead: (1) directed another person to enter the keystrokes comprising his electronic signature thereon; (2) otherwise allowed or consented to another person doing so; and/or (3)

failed to take reasonable steps to ensure that Respondent's clients' trademark filings were signed in accordance with USPTO trademark signature rules;

Respondent further violated § 11.103 by not having an adequate review process or procedure for reviewing applications prior to them being signed and filed with the USPTO, and not making an inquiry to determine: (1) whether the application was properly to be filed as a § 1(a) trademark application (actual use in commerce) or a § 1(b) trademark application (intent to use); and/or (2) whether the specimen for a mark submitted with § 1(a) applications for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s);

Respondent also violated § 11.103 by not taking reasonable steps to ensure that Respondent's clients' trademark filings were reviewed and filed in accordance with the U.S. Counsel Rule thus ensuring (1) increased compliance with U.S. trademark law and USPTO regulations, (2) improved accuracy of trademark submissions to the USPTO, and (3) that the integrity of the U.S. trademark register is safeguarded.

2. 37 C.F.R. § 11.303(a)(1), which provides that a practitioner "shall not knowingly make a false statement of fact or law to a court or fail to correct a false statement of material fact or law previously made to a court." Respondent violated this rule by allowing another individual(s) to sign his name on trademark documents filed with the USPTO where Respondent was the named signatory on the document and/or the attorney of record for the trademark applicant with knowledge that the USPTO would rely on such trademark documents in examining applications and issuing registrations.

Respondent further violated § 11.303(a)(1) when he failed to correct and inform the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature.

3. 37 C.F.R. § 11.303(a)(3), which provides that a practitioner "shall not knowingly offer evidence that the practitioner knows to be false . . . if a practitioner has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the court." Respondent violated this rule by allowing another individual(s) to sign his name on trademark documents, including declarations, filed with the USPTO where Respondent was the named signatory on the document and/or the attorney of record for the trademark applicant.

Respondent further violated § 11.303(a)(3) when he failed to take reasonable remedial measures, by not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark application documents, and did not enter his own electronic signature.



4. 37 C.F.R. § 11.801(b), which provides that “a practitioner in connection with a disciplinary . . . matter, shall not . . . fail to cooperate with the Office of Enrollment and Discipline in an investigation of a matter before it.” Respondent violated this rule by evading meaningful communication with OED, failing to substantively respond to OED’s August 19, 2021 RFI, Lack of Response Notice, and numerous emails sent to the email address that Respondent had used to communicate with OED after being afforded ample time and opportunity to do so, and after representing that he would cooperate.
5. 37 C.F.R. § 11.804(c), which provides that “it is professional misconduct for a practitioner to engage in conduct involving dishonesty, fraud, deceit or misrepresentation.” Respondent violated this rule by allowing individual(s) to sign his name on trademark documents and file those documents with the USPTO where Respondent was the named signatory on the document and the attorney of record for the trademark applicant.  
He further violated § 11.804(c) by not alerting the USPTO (Trademark Operations) about the faulty trademark application documents wherein he was listed as attorney of record, did not file those trademark applications, and did not enter his own electronic signature.
6. 37 C.F.R. § 11.804(d), which provides that “it is professional misconduct for a practitioner to engage in conduct that is prejudicial to the administration of justice.” Respondent violated this rule by allowing another individual(s) to sign his name on trademark documents and filed those documents with the USPTO where Respondent was the named signatory on the document and/or the attorney of record for the trademark applicant.

Respondent further violated § 11.804(d) by allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s).

Respondent also violated § 11.804(d) by failing to notify OED within 30 days of a change of mailing address as required by 37 C.F.R. § 11.11, and/or by failing to substantively respond to OED’s numerous communications regarding the August 19, 2021 RFI after being afforded ample time and opportunity to do so; and, by informing OED that he would respond to their communications, but did not do so.

Based upon Respondent’s admissions resulting from his failure to answer the *Complaint*, the Court finds Respondent has violated the USPTO disciplinary rules as alleged.

### SANCTIONS

The OED Director asked the Court to sanction Respondent by entering an order excluding him from practice before USPTO in patent, trademark, and other non-patent matters. The primary purpose of legal discipline is not to punish, but rather “to protect the public and the administration of justice from lawyers who have not discharged, will not discharge, or are

unlikely properly to discharge their professional duties to clients, the public, the legal system, and the legal profession.” In re Brufsky, Proceeding No. D2013-18 (USPTO June 23, 2014)<sup>8</sup> at 8 (citing Matter of Chastain, 532 S.E.2d 264, 267 (S.C. 2000)).

In determining an appropriate sanction, USPTO regulations require this Court to consider the following four factors: (1) whether the practitioner has violated a duty owed to a client, the public, the legal system, or the profession; (2) whether the practitioner acted intentionally, knowingly, or negligently; (3) the amount of the actual or potential injury caused by the practitioner’s conduct; and (4) the existence of any aggravating or mitigating factors. See 37 C.F.R. § 11.54(b). See also In re Morishita, Proceeding No. D2017-25 (USPTO Sept. 28, 2018)<sup>9</sup>; In re Lau, Proceeding No. D2016-37 (USPTO May 1, 2017)<sup>10</sup>; and In re Schwedler, Proceeding No. D2015-38 (USPTO Mar. 21, 2016)<sup>11</sup>.

1. Respondent violated duties owed to his clients, the public, and the legal profession.

Respondent violated six provisions of the Rules impacting the duties he owed to his clients, the public, and the legal System. His first violation occurred when he failed to act with diligence in representing his clients. By directing or allowing others to sign his name to trademark application documents, including declarations, he knowingly made false statements to the USPTO. He also made false representations by allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s). He allowed misrepresentations, such as false signatures, to remain on the trademark register by not taking remedial measures by, for example, disclosing the false signatures to Trademark Operations. He engaged in conduct prejudicial to the administration of justice by making these misrepresentations to the Office and failing to cooperate with OED’s investigation. As a result, Respondent’s misconduct violated duties owed to his clients, the public, and the legal system.

Respondent failed to act with diligence when he did not take reasonable steps to ensure that his clients’ trademark filings were signed in accordance with the USPTO signature rules. False signatures on trademark application documents have caused important trademark rights to be lost. See In re Dermahose Inc., *supra*; In re Cowan, *supra*. A false signature on trademark documents, including declarations, not only violates the trademark signature rules, but also endangers the mark both before and after registration. As a result, Respondent has clearly violated the fiduciary practitioner-client relationship, which involves the most important ethical duty. See People v. Rhodes, 107 P.3d 1177, 1183 (Colo. 2005) (“[T]he most important duty [respondent] violated was that owed to his clients. The clients sought his counsel, trusted his

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<sup>8</sup> Available at: <https://go.usa.gov/x7x9Y>.

<sup>9</sup> Available at: <https://go.usa.gov/x7x94>.

<sup>10</sup> Available at: <https://go.usa.gov/x7x92>.

<sup>11</sup> Available at: <https://go.usa.gov/x7x9T>.

judgment, and expected that he would handle their affairs[.] Respondent’s failure to act with integrity when dealing with client property was egregious.”).

Respondent further violated the duties he owed to his clients by not complying with the U.S. Counsel Rule as it pertains to both the USPTO signatures rules and to filing proper specimens for trademark filings made on behalf of his clients. In addition to the false signature, Respondent did not act with diligence when he failed to review or have a procedure for determining whether the specimen submitted with the client’s trademark application was a true example of the goods or services actually being used in commerce. Practitioners have been disciplined for failing to comply with the U.S. Counsel rule that includes diligently reviewing trademark specimens filed with the Office and proper signatures. See, e.g., In re Li, Proceeding No. D2021-16 (USPTO Oct. 7, 2021) <sup>12</sup> and In re Reddy, Proceeding No. D2021-13 (USPTO Sep. 9, 2021) <sup>13</sup>.

Respondent violated duties owed to the public when he failed to observe the USPTO’s laws and rules of practice. Congress bestowed the USPTO with plenary authority to govern the conduct of agents, attorneys, and other individuals that represent applicants before the Office. See 35 U.S.C. § 2(b)(2)(D). Pursuant to that authority, the USPTO established the USPTO Code of Professional Responsibility and the Rules, which became effective May 3, 2013. See 37 C.F.R. §§ 11.01 through 11.901. When Respondent violated six of the Rules, he violated duties he owed to the public, while also failing in the duties he owed to the legal profession and the USPTO.

He further violated his duty to the legal profession when he failed to cooperate with OED’s disciplinary investigation. Despite assuring OED that he would update his § 11.11 address, thoroughly respond to the RFI, provide the requested documents, and participate in phone interview, Respondent ignored those assurances and never did any of those things. Respondent undermined the public’s confidence in trademark practitioners by not conducting himself with integrity and professionalism. See In re Lau, *supra* (practitioner violated duties owed to patent bar and decreased confidence in patent practitioners); see also In re Muhammad, *supra* <sup>14</sup> (practitioner excluded upon default for, *inter alia*, not filing an Answer to the Complaint, and failing to cooperate with OED, including expressly informing OED twice in emails that he would file a response to the RFIs and not doing so).

## 2. Respondent Acted Knowingly.

Evaluation of a lawyer’s mental state, or *mens rea*, requires a determination as to whether, at the time of the misconduct, the lawyer acted intentionally, knowingly, or negligently. These three mental states address the degree of the lawyer’s culpability for disciplinary purposes. See Standards § 3.0; see also, e.g., In re Phillips, 244 P.3d 549, 555 (Ariz. 2010) (lawyer’s mental state at the time of a violation is important, as it affects the appropriate discipline imposed; “[i]ntentional or knowing conduct is sanctioned more severely than negligent conduct

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<sup>12</sup> Available at: <https://go.usa.gov/xJXx9>.

<sup>13</sup> Available at: <https://go.usa.gov/xJXxy>.

<sup>14</sup> Available at: <https://go.usa.gov/xJcQu>.

because it threatens more harm”); People v. Varallo, 913 P.2d 1, \*7 (Colo. 1996) (lawyer’s mental state is decisive element in determining level of discipline). Intent is the most culpable mental state and is defined as when a practitioner “acts with conscious objective or purpose to accomplish a particular result.” STANDARDS at pg. xix. Knowing conduct occurs when a practitioner “acts with conscious awareness of the nature or attendant circumstances of his or her conduct both without the conscious objective or purpose to accomplish a particular result.” Id. Respondent’s acts and omissions were knowing.

Respondent allowed others to sign his electronic signature to trademark application documents and to file those documents with the Office. Email addresses with variations of Respondent’s name are found in trademark application documents and those email addresses are listed as the email addresses receiving the filing receipt for that filed document where Respondent is listed as the attorney of record. Therefore, Respondent received the filing receipt for the trademark application documents that were signed with his DIRECT signature from various geographic locations, other than Houston, Texas.

Respondent communicated with counsel for the OED Director, via email, that his regular trademark filing email address is tim.d.liu@gmail.com. That email address was used as the correspondence email address and the filing receipt email address in trademark applications filed with the USPTO, wherein Respondent was the attorney of record. These applications contained his purported DIRECT signature, but the IP address indicated the application was signed and filed from a geolocation other than Texas.<sup>15</sup> Because Respondent’s email address was listed as the contact email for trademark applications and also as the email address for the filing receipts, Respondent knowingly allowed others to sign his signature to trademark documents filed with the Office.

Respondent also intentionally and knowingly failed to cooperate with OED’s investigation. Respondent received, at his Houston, Texas address, the Lack of Response letter containing the RFI. Respondent admitted to OED that he had received the correspondence. He also represented to OED that he would provide a thorough response to the RFI. He never did so. Respondent also agreed to participate in a phone interview with OED, but failed to attend.

Other practitioners have been excluded after they knowingly and intentionally attempted to frustrate OED’s investigation. See e.g., In re Ho, Proceeding No. D2009-04 (USPTO Jan. 30, 2009)<sup>16</sup> at 8 (initial decision on default excluding practitioner who, *inter alia*, “knowingly failed to provide information requested by OED and intentionally failed to cooperate with OED’s investigation.”); In re Glazer, Proceeding No. D2018-34 (USPTO Mar. 4, 2020)<sup>17</sup> at 5 (initial decision excluding practitioner whose acts were “intentional and knowing”). Respondent

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<sup>15</sup> For example the trademark applications listed in the *Complaint* containing the email address tim.d.liu@gmail.com (confirmed by Respondent as his email address) were DIRECT signed from locations other than Houston, Texas: 90/012,493 – DIRECT sign from Hong Kong; 90/034,128 – DIRECT sign from Hong Kong; 90/045,640 – DIRECT sign from Hong Kong; 90/048,106 – DIRECT sign from Hong Kong; 90/048,115 – DIRECT sign from Hong Kong; 90/141,229 – DIRECT sign from San Mateo, California.

<sup>16</sup> Available at: <https://go.usa.gov/xsR42>.

<sup>17</sup> Available at: <https://go.usa.gov/xsR4W>.

similarly violated these Rules. His intentional attempts to avoid and circumvent the OED disciplinary investigation reflects serious misconduct in violation of the Rules.

### 3. The Potential Injuries are Significant

Respondent's conduct caused significant potential injury. See In re Fuess, Proceeding No. D2015-08 (USPTO July 21, 2017)<sup>18</sup> at 21 (“[t]he harm from the violation need not be actual, only potential”) (citing In re Claussen, 909 P.2d 862, 872 (Ore. 1996)). More than 1,400 trademark application documents containing fraudulent signatures were filed with the USPTO, and those clients' trademark applications or registered marks are in jeopardy of having their applications or registrations cancelled. See, e.g., In re Mar, *supra*, at 24 (“if a competitor seeks to use the trademark, the competitor can have the trademark cancelled based on the false signatures.”). Respondent's clients could potentially lose the trademark protection that they thought they had paid Respondent to obtain for them.

Similarly, because Respondent has failed to, *inter alia*, take reasonable remedial measures to disclose the impermissibly signed documents to the USPTO, the trademark registry has numerous applications and registrations that were signed in violation of U.S. federal law and USPTO regulations. Respondent's conduct thereby adversely impacts the integrity of the trademark registry on which the public relies when deciding whether to seek and on which the USPTO as a court relies when deciding whether to bestow important intellectual property rights. Having caused multiple clients, the public, and the USPTO significant potential injuries, Respondent should receive a significant sanction.

### 4. Aggravating and Mitigating Factors

The STANDARDS, published by the American Bar Association, set forth aggravating and mitigating factors for the Court to consider in determining an appropriate sanction. The OED Director asserts that, of the potential mitigating factors identified in the STANDARDS, the sole mitigating factor present here is the “absence of a prior disciplinary record.” See STANDARDS § 9.32. By contrast, the OED Director contends that the following aggravating factors warrant a more severe sanction in this case: a dishonest or selfish motive; a pattern of misconduct; multiple violations; bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of OED; submission of false evidence, false statements, or other deceptive practices during the disciplinary proceeding; and substantial experience in the practice of law. *Id.* § 9.22.

#### a. Four Aggravating Factors are Present

Respondent had a selfish motive in that he sought to profit from a dishonest and improper practice of allowing others to electronically sign his name to trademark application documents that were then filed with the USPTO. See STANDARDS § 9.22(b). Respondent also displayed a dishonest and selfish motive when he sought to profit by allowing § 1(a) trademark applications to be filed with the USPTO where he did not make an inquiry as to whether the

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<sup>18</sup> Available at: <https://go.usa.gov/x63dC>.



specimen for a mark submitted for goods and/or services was a true example of how the mark is used in commerce with such good(s) and/or service(s).

Respondent engaged in a pattern of misconduct with multiple offenses. See STANDARDS § 9.22(c)-(d). For example, there are at least 1,400 trademark application filings that contain faulty signatures. Respondent was directly connected to no less than seven of these trademarks, which used his primary email for return receipts. Additionally, Respondent displayed a pattern of misconduct with multiple offenses when he violated the rules by engaging in a repeated pattern of failing to ensure that proper specimens were filed in trademark applications wherein he was the attorney of record.

Another pattern of misconduct and multiple offenses occurred during OED's disciplinary investigation. Despite numerous requests from OED, Respondent repeatedly failed to respond in a substantive matter to OED's RFI and Lack of Response letter. See In re Iussa, supra (pattern of misconduct where practitioner repeatedly failed to exercise diligence and promptness, communicate with client, and respond to OED's requests for information and evidence). He also repeatedly assured OED that he would provide a complete response to the RFI and Lack of Response letter but failed to do so.

These patterns of misconduct along with multiple offenses demonstrate serious misconduct worthy of a heightened sanction. See In re Stevenson, Proceeding No. D2019-12 at 14 (USPTO December 13, 2019)<sup>19</sup> ("repeated instances of similar misconduct"); see also In re Flindt, Proceeding No. D2016-04 (Aug. 4, 2017)<sup>20</sup> (practitioner committed "multiple offenses" that violated six separate provisions of the Rules); In re Fuess, supra (practitioner abandoned multiple applications and violated multiple Rules). For these reasons, Respondent deserves a more significant sanction.

The fourth aggravating factor is "bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of the disciplinary agency." See STANDARDS § 9.22(e); In re Mar, supra at 26 (practitioner demonstrated obstruction of disciplinary proceeding by, inter alia, "fail[ing] to participate in the disciplinary process once the *Complaint* was filed.").

During OED's investigation, Respondent spoke to OED's attorney investigator over the phone three times. Each time they discussed the need for Respondent to thoroughly respond to the August 19, 2021 RFI and the September 24, 2021 Lack of Response letter - that also contained a copy of the RFI. Respondent repeatedly told OED that he would provide a thorough response, even entering into a tolling agreement giving him an extension of time to provide the response. Yet, he never provided a complete response. He also agreed to a phone interview, yet did not attend. Thus, this misconduct amounts to "bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with the rules," that being § 11.801(b).

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<sup>19</sup> Available at: <https://go.usa.gov/x6vjS>.

<sup>20</sup> Available at: <https://go.usa.gov/x63dK>.

Respondent's misconduct has also been ongoing because during this proceeding Respondent has ignored the *Complaint* and this Court's order to file an Answer. Thus, this serves as further aggravation; whereby, Respondent deserves a more severe sanction. See In re Morishita, supra; In re Lau, supra; In re Schwedler, supra; see also In re Kantor, 850 A.2d 473, 477 (N.J. 2004) ("An attorney who declines to appear before this Court to explain his unprofessional conduct [...] openly displays his unfitness to continue to practice law."); People v. Barbieri, 61 P.3d. 488, 495 (Colo. O.P.D.J. 2000) ("In disciplinary matters involving an attorney's conduct, compliance with unchallenged orders issued by the disciplinary body is not elective; it is mandatory. Failure to do so, almost invariably, will inure substantially enhanced discipline."); Iowa Supreme Court Bd. of Professional Ethics and Conduct v. Ramey, 639 N.W.2d 243, 246 (Iowa 2002) (attorney's "failure to respond to this attorney disciplinary proceeding suggests an overall attitude of disrespect and disregard for this profession."). Respondent's bad faith obstruction of OED's disciplinary proceeding, ignoring the *Complaint*, and this Court's orders warrant a more severe sanction.

b. One mitigating factor

In terms of the mitigating factors, Respondent has no prior disciplinary record. However, in light of the facts of this matter and the five aggravating factors discussed above, Respondent's previously clear disciplinary record is insufficient to overcome the facts and aggravating factors.

### CONCLUSION

Because Respondent has failed to answer the *Complaint* or otherwise appear in this matter, Respondent is found to be in **DEFAULT** and to have admitted all the allegations in the Complaint. Based on the facts hereby admitted, the Court finds that Respondent has violated the USPTO Rules of Professional Conduct as discussed above. After analyzing the factors enumerated in 37 C.F.R. § 11.54(b), the Court concludes that Respondent's misconduct warrants the sanction of exclusion. Accordingly, Respondent shall be **EXCLUDED** from practice before the U.S. Patent and Trademark Office in patent, trademark, and other non-patent matters.<sup>21</sup>

### So ORDERED,

ALEXANDER  
FERNANDEZ-  
PONS

Digitally signed by: ALEXANDER  
FERNANDEZ-PONS  
DN: CN = ALEXANDER FERNANDEZ-  
PONS email = ALEXANDER.FERNANDEZ-  
PONS@HUD.GOV C = AD O = OFFICE OF  
THE SECRETARY OU = OHA  
Date: 2022.08.09 12:35:14 -04'00'

Alexander Fernández-Pons  
United States Administrative Law Judge

**Notice of Required Actions by Respondent and Appeal Rights:** Respondent is directed to refer to 37 C.F.R. § 11.58 regarding his responsibilities in the case of suspension or exclusion. Within thirty (30) days of this initial decision, either party may file an appeal to the USPTO Director pursuant to 37 C.F.R. § 11.55

<sup>21</sup> An excluded practitioner is eligible to apply for reinstatement no earlier than five years from the effective date of the exclusion. See 37 C.F.R. § 11.60(b). Eligibility is predicated upon full compliance with 37 C.F.R. § 11.58.

# INTERNAL PROCEDURAL RULES

## BOARD OF DISCIPLINARY APPEALS

*Current through June 21, 2018*

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# INTERNAL PROCEDURAL RULES

## Board of Disciplinary Appeals

*Current through June 21, 2018*

### I. GENERAL PROVISIONS

#### Rule 1.01. Definitions

- (a) “BODA” is the Board of Disciplinary Appeals.
- (b) “Chair” is the member elected by BODA to serve as chair or, in the Chair’s absence, the member elected by BODA to serve as vice-chair.
- (c) “Classification” is the determination by the CDC under TRDP 2.10 or by BODA under TRDP 7.08(C) whether a grievance constitutes a “complaint” or an “inquiry.”
- (d) “BODA Clerk” is the executive director of BODA or other person appointed by BODA to assume all duties normally performed by the clerk of a court.
- (e) “CDC” is the Chief Disciplinary Counsel for the State Bar of Texas and his or her assistants.
- (f) “Commission” is the Commission for Lawyer Discipline, a permanent committee of the State Bar of Texas.
- (g) “Executive Director” is the executive director of BODA.
- (h) “Panel” is any three-member grouping of BODA under TRDP 7.05.
- (i) “Party” is a Complainant, a Respondent, or the Commission.
- (j) “TDRPC” is the Texas Disciplinary Rules of Professional Conduct.
- (k) “TRAP” is the Texas Rules of Appellate Procedure.
- (l) “TRCP” is the Texas Rules of Civil Procedure.
- (m) “TRDP” is the Texas Rules of Disciplinary Procedure.
- (n) “TRE” is the Texas Rules of Evidence.

#### Rule 1.02. General Powers

Under TRDP 7.08, BODA has and may exercise all the powers of either a trial court or an appellate court, as the case may be, in hearing and determining disciplinary proceedings. But TRDP 15.01 [17.01] applies to the enforcement of a judgment of BODA.

#### Rule 1.03. Additional Rules in Disciplinary Matters

Except as varied by these rules and to the extent applicable, the TRCP, TRAP, and TRE apply to all disciplinary matters before BODA, except for appeals from classification decisions, which are governed by TRDP 2.10 and by Section 3 of these rules.

#### Rule 1.04. Appointment of Panels

- (a) BODA may consider any matter or motion by panel,

except as specified in (b). The Chair may delegate to the Executive Director the duty to appoint a panel for any BODA action. Decisions are made by a majority vote of the panel; however, any panel member may refer a matter for consideration by BODA sitting en banc. Nothing in these rules gives a party the right to be heard by BODA sitting en banc.

- (b) Any disciplinary matter naming a BODA member as Respondent must be considered by BODA sitting en banc. A disciplinary matter naming a BODA staff member as Respondent need not be heard en banc.

#### Rule 1.05. Filing of Pleadings, Motions, and Other Papers

- (a) **Electronic Filing.** All documents must be filed electronically. Unrepresented persons or those without the means to file electronically may electronically file documents, but it is not required.

- (1) Email Address. The email address of an attorney or an unrepresented party who electronically files a document must be included on the document.

- (2) Timely Filing. Documents are filed electronically by emailing the document to the BODA Clerk at the email address designated by BODA for that purpose. A document filed by email will be considered filed the day that the email is sent. The date sent is the date shown for the message in the inbox of the email account designated for receiving filings. If a document is sent after 5:00 p.m. or on a weekend or holiday officially observed by the State of Texas, it is considered filed the next business day.

- (3) It is the responsibility of the party filing a document by email to obtain the correct email address for BODA and to confirm that the document was received by BODA in legible form. Any document that is illegible or that cannot be opened as part of an email attachment will not be considered filed. If a document is untimely due to a technical failure or a system outage, the filing party may seek appropriate relief from BODA.

- (4) Exceptions.

- (i) An appeal to BODA of a decision by the CDC to classify a grievance as an inquiry is not required to be filed electronically.

- (ii) The following documents must not be filed electronically:

- a) documents that are filed under seal or subject to a pending motion to seal; and
- b) documents to which access is otherwise restricted by court order.

- (iii) For good cause, BODA may permit a party to file other documents in paper form in a particular case.

- (5) Format. An electronically filed document must:

- (i) be in text-searchable portable document format (PDF);
- (ii) be directly converted to PDF rather than scanned, if possible; and
- (iii) not be locked.

(b) A paper will not be deemed filed if it is sent to an individual BODA member or to another address other than the address designated by BODA under Rule 1.05(a)(2).

(c) **Signing.** Each brief, motion, or other paper filed must be signed by at least one attorney for the party or by the party pro se and must give the State Bar of Texas card number, mailing address, telephone number, email address, and fax number, if any, of each attorney whose name is signed or of the party (if applicable). A document is considered signed if the document includes:

- (1) an “/s/” and name typed in the space where the signature would otherwise appear, unless the document is notarized or sworn; or
- (2) an electronic image or scanned image of the signature.

(d) **Paper Copies.** Unless required by BODA, a party need not file a paper copy of an electronically filed document.

(e) **Service.** Copies of all documents filed by any party other than the record filed by the evidentiary panel clerk or the court reporter must, at or before the time of filing, be served on all other parties as required and authorized by the TRAP.

#### **Rule 1.06. Service of Petition**

In any disciplinary proceeding before BODA initiated by service of a petition on the Respondent, the petition must be served by personal service; by certified mail with return receipt requested; or, if permitted by BODA, in any other manner that is authorized by the TRCP and reasonably calculated under all the circumstances to apprise the Respondent of the proceeding and to give him or her reasonable time to appear and answer. To establish service by certified mail, the return receipt must contain the Respondent’s signature.

#### **Rule 1.07. Hearing Setting and Notice**

(a) **Original Petitions.** In any kind of case initiated by the CDC’s filing a petition or motion with BODA, the CDC may contact the BODA Clerk for the next regularly available hearing date before filing the original petition. If a hearing is set before the petition is filed, the petition must state the date, time, and place of the hearing. Except in the case of a petition to revoke probation under TRDP 2.23 [2.22], the hearing date must be at least 30 days from the date that the petition is served on the Respondent.

(b) **Expedited Settings.** If a party desires a hearing on a matter on a date earlier than the next regularly available BODA hearing date, the party may request an expedited setting in a written motion setting out the reasons for the

request. Unless the parties agree otherwise, and except in the case of a petition to revoke probation under TRDP 2.23 [2.22], the expedited hearing setting must be at least 30 days from the date of service of the petition, motion, or other pleading. BODA has the sole discretion to grant or deny a request for an expedited hearing date.

(c) **Setting Notices.** BODA must notify the parties of any hearing date that is not noticed in an original petition or motion.

(d) **Announcement Docket.** Attorneys and parties appearing before BODA must confirm their presence and present any questions regarding procedure to the BODA Clerk in the courtroom immediately prior to the time docket call is scheduled to begin. Each party with a matter on the docket must appear at the docket call to give an announcement of readiness, to give a time estimate for the hearing, and to present any preliminary motions or matters. Immediately following the docket call, the Chair will set and announce the order of cases to be heard.

#### **Rule 1.08. Time to Answer**

The Respondent may file an answer at any time, except where expressly provided otherwise by these rules or the TRDP, or when an answer date has been set by prior order of BODA. BODA may, but is not required to, consider an answer filed the day of the hearing.

#### **Rule 1.09. Pretrial Procedure**

##### **(a) Motions.**

(1) Generally. To request an order or other relief, a party must file a motion supported by sufficient cause with proof of service on all other parties. The motion must state with particularity the grounds on which it is based and set forth the relief sought. All supporting briefs, affidavits, or other documents must be served and filed with the motion. A party may file a response to a motion at any time before BODA rules on the motion or by any deadline set by BODA. Unless otherwise required by these rules or the TRDP, the form of a motion must comply with the TRCP or the TRAP.

(2) For Extension of Time. All motions for extension of time in any matter before BODA must be in writing, comply with (a)(1), and specify the following:

- (i) if applicable, the date of notice of decision of the evidentiary panel, together with the number and style of the case;
- (ii) if an appeal has been perfected, the date when the appeal was perfected;
- (iii) the original deadline for filing the item in question;
- (iv) the length of time requested for the extension;
- (v) the number of extensions of time that have been granted previously regarding the item in question; and

(vi) the facts relied on to reasonably explain the need for an extension.

(b) **Pretrial Scheduling Conference.** Any party may request a pretrial scheduling conference, or BODA on its own motion may require a pretrial scheduling conference.

(c) **Trial Briefs.** In any disciplinary proceeding before BODA, except with leave, all trial briefs and memoranda must be filed with the BODA Clerk no later than ten days before the day of the hearing.

(d) **Hearing Exhibits, Witness Lists, and Exhibits Tendered for Argument.** A party may file a witness list, exhibit, or any other document to be used at a hearing or oral argument before the hearing or argument. A party must bring to the hearing an original and 12 copies of any document that was not filed at least one business day before the hearing. The original and copies must be:

- (1) marked;
- (2) indexed with the title or description of the item offered as an exhibit; and
- (3) if voluminous, bound to lie flat when open and tabbed in accordance with the index.

All documents must be marked and provided to the opposing party before the hearing or argument begins.

#### **Rule 1.10. Decisions**

(a) **Notice of Decisions.** The BODA Clerk must give notice of all decisions and opinions to the parties or their attorneys of record.

(b) **Publication of Decisions.** BODA must report judgments or orders of public discipline:

- (1) as required by the TRDP; and
- (2) on its website for a period of at least ten years following the date of the disciplinary judgment or order.

(c) **Abstracts of Classification Appeals.** BODA may, in its discretion, prepare an abstract of a classification appeal for a public reporting service.

#### **Rule 1.11. Board of Disciplinary Appeals Opinions**

(a) BODA may render judgment in any disciplinary matter with or without written opinion. In accordance with TRDP 6.06, all written opinions of BODA are open to the public and must be made available to the public reporting services, print or electronic, for publishing. A majority of the members who participate in considering the disciplinary matter must determine if an opinion will be written. The names of the participating members must be noted on all written opinions of BODA.

(b) Only a BODA member who participated in the decision of a disciplinary matter may file or join in a written opinion concurring in or dissenting from the judgment of BODA. For purposes of this rule, in hearings in which evidence is taken, no member may participate in

the decision unless that member was present at the hearing. In all other proceedings, no member may participate unless that member has reviewed the record. Any member of BODA may file a written opinion in connection with the denial of a hearing or rehearing en banc.

(c) A BODA determination in an appeal from a grievance classification decision under TRDP 2.10 is not a judgment for purposes of this rule and may be issued without a written opinion.

#### **Rule 1.12. BODA Work Product and Drafts**

A document or record of any nature—regardless of its form, characteristics, or means of transmission—that is created or produced in connection with or related to BODA's adjudicative decision-making process is not subject to disclosure or discovery. This includes documents prepared by any BODA member, BODA staff, or any other person acting on behalf of or at the direction of BODA.

#### **Rule 1.13. Record Retention**

Records of appeals from classification decisions must be retained by the BODA Clerk for a period of at least three years from the date of disposition. Records of other disciplinary matters must be retained for a period of at least five years from the date of final judgment, or for at least one year after the date a suspension or disbarment ends, whichever is later. For purposes of this rule, a record is any document, paper, letter, map, book, tape, photograph, film, recording, or other material filed with BODA, regardless of its form, characteristics, or means of transmission.

#### **Rule 1.14. Costs of Reproduction of Records**

The BODA Clerk may charge a reasonable amount for the reproduction of nonconfidential records filed with BODA. The fee must be paid in advance to the BODA Clerk.

#### **Rule 1.15. Publication of These Rules**

These rules will be published as part of the TDRPC and TRDP.

## **II. ETHICAL CONSIDERATIONS**

#### **Rule 2.01. Representing or Counseling Parties in Disciplinary Matters and Legal Malpractice Cases**

(a) A current member of BODA must not represent a party or testify voluntarily in a disciplinary action or proceeding. Any BODA member who is subpoenaed or otherwise compelled to appear at a disciplinary action or proceeding, including at a deposition, must promptly notify the BODA Chair.

(b) A current BODA member must not serve as an expert witness on the TDRPC.

(c) A BODA member may represent a party in a legal malpractice case, provided that he or she is later recused in accordance with these rules from any proceeding before BODA arising out of the same facts.

## **Rule 2.02. Confidentiality**

(a) BODA deliberations are confidential, must not be disclosed by BODA members or staff, and are not subject to disclosure or discovery.

(b) Classification appeals, appeals from evidentiary judgments of private reprimand, appeals from an evidentiary judgment dismissing a case, interlocutory appeals or any interim proceedings from an ongoing evidentiary case, and disability cases are confidential under the TRDP. BODA must maintain all records associated with these cases as confidential, subject to disclosure only as provided in the TRDP and these rules.

(c) If a member of BODA is subpoenaed or otherwise compelled by law to testify in any proceeding, the member must not disclose a matter that was discussed in conference in connection with a disciplinary case unless the member is required to do so by a court of competent jurisdiction

## **Rule 2.03. Disqualification and Recusal of BODA Members**

(a) BODA members are subject to disqualification and recusal as provided in TRCP 18b.

(b) BODA members may, in addition to recusals under (a), voluntarily recuse themselves from any discussion and voting for any reason. The reasons that a BODA member is recused from a case are not subject to discovery.

(c) These rules do not disqualify a lawyer who is a member of, or associated with, the law firm of a BODA member from serving on a grievance committee or representing a party in a disciplinary proceeding or legal malpractice case. But a BODA member must recuse him or herself from any matter in which a lawyer who is a member of, or associated with, the BODA member's firm is a party or represents a party.

## **III. CLASSIFICATION APPEALS**

### **Rule 3.01. Notice of Right to Appeal**

(a) If a grievance filed by the Complainant under TRDP 2.10 is classified as an inquiry, the CDC must notify the Complainant of his or her right to appeal as set out in TRDP 2.10 or another applicable rule.

(b) To facilitate the potential filing of an appeal of a grievance classified as an inquiry, the CDC must send the Complainant an appeal notice form, approved by BODA, with the classification disposition. The form must include the docket number of the matter; the deadline for appealing; and information for mailing, faxing, or emailing the appeal notice form to BODA. The appeal notice form must be available in English and Spanish.

### **Rule 3.02. Record on Appeal**

BODA must only consider documents that were filed with the CDC prior to the classification decision. When a notice of appeal from a classification decision has been filed, the CDC must forward to BODA a copy of the grievance and

all supporting documentation. If the appeal challenges the classification of an amended grievance, the CDC must also send BODA a copy of the initial grievance, unless it has been destroyed.

## **IV. APPEALS FROM EVIDENTIARY PANEL HEARINGS**

### **Rule 4.01. Perfecting Appeal**

(a) **Appellate Timetable.** The date that the evidentiary judgment is signed starts the appellate timetable under this section. To make TRDP 2.21 [2.20] consistent with this requirement, the date that the judgment is signed is the "date of notice" under Rule 2.21 [2.20].

(b) **Notification of the Evidentiary Judgment.** The clerk of the evidentiary panel must notify the parties of the judgment as set out in TRDP 2.21 [2.20].

(1) The evidentiary panel clerk must notify the Commission and the Respondent in writing of the judgment. The notice must contain a clear statement that any appeal of the judgment must be filed with BODA within 30 days of the date that the judgment was signed. The notice must include a copy of the judgment rendered.

(2) The evidentiary panel clerk must notify the Complainant that a judgment has been rendered and provide a copy of the judgment, unless the evidentiary panel dismissed the case or imposed a private reprimand. In the case of a dismissal or private reprimand, the evidentiary panel clerk must notify the Complainant of the decision and that the contents of the judgment are confidential. Under TRDP 2.16, no additional information regarding the contents of a judgment of dismissal or private reprimand may be disclosed to the Complainant.

(c) **Filing Notice of Appeal.** An appeal is perfected when a written notice of appeal is filed with BODA. If a notice of appeal and any other accompanying documents are mistakenly filed with the evidentiary panel clerk, the notice is deemed to have been filed the same day with BODA, and the evidentiary panel clerk must immediately send the BODA Clerk a copy of the notice and any accompanying documents.

(d) **Time to File.** In accordance with TRDP 2.24 [2.23], the notice of appeal must be filed within 30 days after the date the judgment is signed. In the event a motion for new trial or motion to modify the judgment is timely filed with the evidentiary panel, the notice of appeal must be filed with BODA within 90 days from the date the judgment is signed.

(e) **Extension of Time.** A motion for an extension of time to file the notice of appeal must be filed no later than 15 days after the last day allowed for filing the notice of appeal. The motion must comply with Rule 1.09.

#### **Rule 4.02. Record on Appeal**

(a) **Contents.** The record on appeal consists of the evidentiary panel clerk's record and, where necessary to the appeal, a reporter's record of the evidentiary panel hearing.

(b) **Stipulation as to Record.** The parties may designate parts of the clerk's record and the reporter's record to be included in the record on appeal by written stipulation filed with the clerk of the evidentiary panel.

#### **(c) Responsibility for Filing Record.**

##### **(1) Clerk's Record.**

(i) After receiving notice that an appeal has been filed, the clerk of the evidentiary panel is responsible for preparing, certifying, and timely filing the clerk's record.

(ii) Unless the parties stipulate otherwise, the clerk's record on appeal must contain the items listed in TRAP 34.5(a) and any other paper on file with the evidentiary panel, including the election letter, all pleadings on which the hearing was held, the docket sheet, the evidentiary panel's charge, any findings of fact and conclusions of law, all other pleadings, the judgment or other orders appealed from, the notice of decision sent to each party, any postsubmission pleadings and briefs, and the notice of appeal.

(iii) If the clerk of the evidentiary panel is unable for any reason to prepare and transmit the clerk's record by the due date, he or she must promptly notify BODA and the parties, explain why the clerk's record cannot be timely filed, and give the date by which he or she expects the clerk's record to be filed.

##### **(2) Reporter's Record.**

(i) The court reporter for the evidentiary panel is responsible for timely filing the reporter's record if:

- a) a notice of appeal has been filed;
- b) a party has requested that all or part of the reporter's record be prepared; and
- c) the party requesting all or part of the reporter's record has paid the reporter's fee or has made satisfactory arrangements with the reporter.

(ii) If the court reporter is unable for any reason to prepare and transmit the reporter's record by the due date, he or she must promptly notify BODA and the parties, explain the reasons why the reporter's record cannot be timely filed, and give the date by which he or she expects the reporter's record to be filed.

#### **(d) Preparation of Clerk's Record.**

(1) To prepare the clerk's record, the evidentiary panel clerk must:

- (i) gather the documents designated by the parties'

written stipulation or, if no stipulation was filed, the documents required under (c)(1)(ii);

(ii) start each document on a new page;

(iii) include the date of filing on each document;

(iv) arrange the documents in chronological order, either by the date of filing or the date of occurrence;

(v) number the pages of the clerk's record in the manner required by (d)(2);

(vi) prepare and include, after the front cover of the clerk's record, a detailed table of contents that complies with (d)(3); and

(vii) certify the clerk's record.

(2) The clerk must start the page numbering on the front cover of the first volume of the clerk's record and continue to number all pages consecutively—including the front and back covers, tables of contents, certification page, and separator pages, if any—until the final page of the clerk's record, without regard for the number of volumes in the clerk's record, and place each page number at the bottom of each page.

(3) The table of contents must:

(i) identify each document in the entire record (including sealed documents); the date each document was filed; and, except for sealed documents, the page on which each document begins;

(ii) be double-spaced;

(iii) conform to the order in which documents appear in the clerk's record, rather than in alphabetical order;

(iv) contain bookmarks linking each description in the table of contents (except for descriptions of sealed documents) to the page on which the document begins; and

(v) if the record consists of multiple volumes, indicate the page on which each volume begins.

(e) **Electronic Filing of the Clerk's Record.** The evidentiary panel clerk must file the record electronically. When filing a clerk's record in electronic form, the evidentiary panel clerk must:

(1) file each computer file in text-searchable Portable Document Format (PDF);

(2) create electronic bookmarks to mark the first page of each document in the clerk's record;

(3) limit the size of each computer file to 100 MB or less, if possible; and

(4) directly convert, rather than scan, the record to PDF, if possible.

#### **(f) Preparation of the Reporter's Record.**

(1) The appellant, at or before the time prescribed for

perfecting the appeal, must make a written request for the reporter's record to the court reporter for the evidentiary panel. The request must designate the portion of the evidence and other proceedings to be included. A copy of the request must be filed with the evidentiary panel and BODA and must be served on the appellee. The reporter's record must be certified by the court reporter for the evidentiary panel.

(2) The court reporter or recorder must prepare and file the reporter's record in accordance with TRAP 34.6 and 35 and the Uniform Format Manual for Texas Reporters' Records.

(3) The court reporter or recorder must file the reporter's record in an electronic format by emailing the document to the email address designated by BODA for that purpose.

(4) The court reporter or recorder must include either a scanned image of any required signature or "/s/" and name typed in the space where the signature would otherwise

(6<sup>1</sup>) In exhibit volumes, the court reporter or recorder must create bookmarks to mark the first page of each exhibit document.

(g) **Other Requests.** At any time before the clerk's record is prepared, or within ten days after service of a copy of appellant's request for the reporter's record, any party may file a written designation requesting that additional exhibits and portions of testimony be included in the record. The request must be filed with the evidentiary panel and BODA and must be served on the other party.

(h) **Inaccuracies or Defects.** If the clerk's record is found to be defective or inaccurate, the BODA Clerk must inform the clerk of the evidentiary panel of the defect or inaccuracy and instruct the clerk to make the correction. Any inaccuracies in the reporter's record may be corrected by agreement of the parties without the court reporter's recertification. Any dispute regarding the reporter's record that the parties are unable to resolve by agreement must be resolved by the evidentiary panel.

(i) **Appeal from Private Reprimand.** Under TRDP 2.16, in an appeal from a judgment of private reprimand, BODA must mark the record as confidential, remove the attorney's name from the case style, and take any other steps necessary to preserve the confidentiality of the private reprimand.

<sup>1</sup> So in original.

#### **Rule 4.03. Time to File Record**

(a) **Timetable.** The clerk's record and reporter's record must be filed within 60 days after the date the judgment is signed. If a motion for new trial or motion to modify the judgment is filed with the evidentiary panel, the clerk's record and the reporter's record must be filed within 120 days from the date the original judgment is signed, unless

a modified judgment is signed, in which case the clerk's record and the reporter's record must be filed within 60 days of the signing of the modified judgment. Failure to file either the clerk's record or the reporter's record on time does not affect BODA's jurisdiction, but may result in BODA's exercising its discretion to dismiss the appeal, affirm the judgment appealed from, disregard materials filed late, or apply presumptions against the appellant.

#### **(b) If No Record Filed.**

(1) If the clerk's record or reporter's record has not been timely filed, the BODA Clerk must send notice to the party responsible for filing it, stating that the record is late and requesting that the record be filed within 30 days. The BODA Clerk must send a copy of this notice to all the parties and the clerk of the evidentiary panel.

(2) If no reporter's record is filed due to appellant's fault, and if the clerk's record has been filed, BODA may, after first giving the appellant notice and a reasonable opportunity to cure, consider and decide those issues or points that do not require a reporter's record for a decision. BODA may do this if no reporter's record has been filed because:

(i) the appellant failed to request a reporter's record; or

(ii) the appellant failed to pay or make arrangements to pay the reporter's fee to prepare the reporter's record, and the appellant is not entitled to proceed without payment of costs.

#### **(c) Extension of Time to File the Reporter's Record.**

When an extension of time is requested for filing the reporter's record, the facts relied on to reasonably explain the need for an extension must be supported by an affidavit of the court reporter. The affidavit must include the court reporter's estimate of the earliest date when the reporter's record will be available for filing.

(d) **Supplemental Record.** If anything material to either party is omitted from the clerk's record or reporter's record, BODA may, on written motion of a party or on its own motion, direct a supplemental record to be certified and transmitted by the clerk for the evidentiary panel or the court reporter for the evidentiary panel.

#### **Rule 4.04. Copies of the Record**

The record may not be withdrawn from the custody of the BODA Clerk. Any party may obtain a copy of the record or any designated part thereof by making a written request to the BODA Clerk and paying any charges for reproduction in advance.

#### **Rule 4.05. Requisites of Briefs**

(a) **Appellant's Filing Date.** Appellant's brief must be filed within 30 days after the clerk's record or the reporter's record is filed, whichever is later.

(b) **Appellee's Filing Date.** Appellee's brief must be filed

within 30 days after the appellant's brief is filed.

**(c) Contents.** Briefs must contain:

- (1) a complete list of the names and addresses of all parties to the final decision and their counsel;
- (2) a table of contents indicating the subject matter of each issue or point, or group of issues or points, with page references where the discussion of each point relied on may be found;
- (3) an index of authorities arranged alphabetically and indicating the pages where the authorities are cited;
- (4) a statement of the case containing a brief general statement of the nature of the cause or offense and the result;
- (5) a statement, without argument, of the basis of BODA's jurisdiction;
- (6) a statement of the issues presented for review or points of error on which the appeal is predicated;
- (7) a statement of facts that is without argument, is supported by record references, and details the facts relating to the issues or points relied on in the appeal;
- (8) the argument and authorities;
- (9) conclusion and prayer for relief;
- (10) a certificate of service; and
- (11) an appendix of record excerpts pertinent to the issues presented for review.

**(d) Length of Briefs; Contents Included and Excluded.**

In calculating the length of a document, every word and every part of the document, including headings, footnotes, and quotations, must be counted except the following: caption, identity of the parties and counsel, statement regarding oral argument, table of contents, index of authorities, statement of the case, statement of issues presented, statement of the jurisdiction, signature, proof of service, certificate of compliance, and appendix. Briefs must not exceed 15,000 words if computer-generated, and 50 pages if not, except on leave of BODA. A reply brief must not exceed 7,500 words if computer-generated, and 25 pages if not, except on leave of BODA. A computer generated document must include a certificate by counsel or the unrepresented party stating the number of words in the document. The person who signs the certification may rely on the word count of the computer program used to prepare the document.

**(e) Amendment or Supplementation.** BODA has discretion to grant leave to amend or supplement briefs.

**(f) Failure of the Appellant to File a Brief.** If the appellant fails to timely file a brief, BODA may:

- (1) dismiss the appeal for want of prosecution, unless the appellant reasonably explains the failure, and the appellee is not significantly injured by the appellant's

failure to timely file a brief;

(2) decline to dismiss the appeal and make further orders within its discretion as it considers proper; or

(3) if an appellee's brief is filed, regard that brief as correctly presenting the case and affirm the evidentiary panel's judgment on that brief without examining the record.

**Rule 4.06. Oral Argument**

**(a) Request.** A party desiring oral argument must note the request on the front cover of the party's brief. A party's failure to timely request oral argument waives the party's right to argue. A party who has requested argument may later withdraw the request. But even if a party has waived oral argument, BODA may direct the party to appear and argue. If oral argument is granted, the clerk will notify the parties of the time and place for submission.

**(b) Right to Oral Argument.** A party who has filed a brief and who has timely requested oral argument may argue the case to BODA unless BODA, after examining the briefs, decides that oral argument is unnecessary for any of the following reasons:

- (1) the appeal is frivolous;
- (2) the dispositive issue or issues have been authoritatively decided;
- (3) the facts and legal arguments are adequately presented in the briefs and record; or
- (4) the decisional process would not be significantly aided by oral argument.

**(c) Time Allowed.** Each party will have 20 minutes to argue. BODA may, on the request of a party or on its own, extend or shorten the time allowed for oral argument. The appellant may reserve a portion of his or her allotted time for rebuttal.

**Rule 4.07. Decision and Judgment**

**(a) Decision.** BODA may do any of the following:

- (1) affirm in whole or in part the decision of the evidentiary panel;
- (2) modify the panel's findings and affirm the findings as modified;
- (3) reverse in whole or in part the panel's findings and render the decision that the panel should have rendered; or
- (4) reverse the panel's findings and remand the cause for further proceedings to be conducted by:
  - (i) the panel that entered the findings; or
  - (ii) a statewide grievance committee panel appointed by BODA and composed of members selected from the state bar districts other than the district from which the appeal was taken.



**(b) Mandate.** In every appeal, the BODA Clerk must issue a mandate in accordance with BODA's judgment and send it to the evidentiary panel and to all the parties.

#### **Rule 4.08. Appointment of Statewide Grievance Committee**

If BODA remands a cause for further proceedings before a statewide grievance committee, the BODA Chair will appoint the statewide grievance committee in accordance with TRDP 2.27 [2.26]. The committee must consist of six members: four attorney members and two public members randomly selected from the current pool of grievance committee members. Two alternates, consisting of one attorney and one public member, must also be selected. BODA will appoint the initial chair who will serve until the members of the statewide grievance committee elect a chair of the committee at the first meeting. The BODA Clerk will notify the Respondent and the CDC that a committee has been appointed.

#### **Rule 4.09. Involuntary Dismissal**

Under the following circumstances and on any party's motion or on its own initiative after giving at least ten days' notice to all parties, BODA may dismiss the appeal or affirm the appealed judgment or order. Dismissal or affirmance may occur if the appeal is subject to dismissal:

- (a) for want of jurisdiction;
- (b) for want of prosecution; or
- (c) because the appellant has failed to comply with a requirement of these rules, a court order, or a notice from the clerk requiring a response or other action within a specified time.

### **V. PETITIONS TO REVOKE PROBATION**

#### **Rule 5.01. Initiation and Service**

(a) Before filing a motion to revoke the probation of an attorney who has been sanctioned, the CDC must contact the BODA Clerk to confirm whether the next regularly available hearing date will comply with the 30-day requirement of TRDP. The Chair may designate a three-member panel to hear the motion, if necessary, to meet the 30-day requirement of TRDP 2.23 [2.22].

(b) Upon filing the motion, the CDC must serve the Respondent with the motion and any supporting documents in accordance with TRDP 2.23 [2.22], the TRCP, and these rules. The CDC must notify BODA of the date that service is obtained on the Respondent.

#### **Rule 5.02. Hearing**

Within 30 days of service of the motion on the Respondent, BODA must docket and set the matter for a hearing and notify the parties of the time and place of the hearing. On a showing of good cause by a party or on its own motion, BODA may continue the case to a future hearing date as circumstances require.

### **VI. COMPULSORY DISCIPLINE**

#### **Rule 6.01. Initiation of Proceeding**

Under TRDP 8.03, the CDC must file a petition for compulsory discipline with BODA and serve the Respondent in accordance with the TRDP and Rule 1.06 of these rules.

#### **Rule 6.02. Interlocutory Suspension**

(a) **Interlocutory Suspension.** In any compulsory proceeding under TRDP Part VIII in which BODA determines that the Respondent has been convicted of an Intentional Crime and that the criminal conviction is on direct appeal, BODA must suspend the Respondent's license to practice law by interlocutory order. In any compulsory case in which BODA has imposed an interlocutory order of suspension, BODA retains jurisdiction to render final judgment after the direct appeal of the criminal conviction is final. For purposes of rendering final judgment in a compulsory discipline case, the direct appeal of the criminal conviction is final when the appellate court issues its mandate.

(b) **Criminal Conviction Affirmed.** If the criminal conviction made the basis of a compulsory interlocutory suspension is affirmed and becomes final, the CDC must file a motion for final judgment that complies with TRDP 8.05.

(1) If the criminal sentence is fully probated or is an order of deferred adjudication, the motion for final judgment must contain notice of a hearing date. The motion will be set on BODA's next available hearing date.

(2) If the criminal sentence is not fully probated:

- (i) BODA may proceed to decide the motion without a hearing if the attorney does not file a verified denial within ten days of service of the motion; or
- (ii) BODA may set the motion for a hearing on the next available hearing date if the attorney timely files a verified denial.

(c) **Criminal Conviction Reversed.** If an appellate court issues a mandate reversing the criminal conviction while a Respondent is subject to an interlocutory suspension, the Respondent may file a motion to terminate the interlocutory suspension. The motion to terminate the interlocutory suspension must have certified copies of the decision and mandate of the reversing court attached. If the CDC does not file an opposition to the termination within ten days of being served with the motion, BODA may proceed to decide the motion without a hearing or set the matter for a hearing on its own motion. If the CDC timely opposes the motion, BODA must set the motion for a hearing on its next available hearing date. An order terminating an interlocutory order of suspension does not automatically reinstate a Respondent's license.

## VII. RECIPROCAL DISCIPLINE

### Rule 7.01. Initiation of Proceeding

To initiate an action for reciprocal discipline under TRDP Part IX, the CDC must file a petition with BODA and request an Order to Show Cause. The petition must request that the Respondent be disciplined in Texas and have attached to it any information concerning the disciplinary matter from the other jurisdiction, including a certified copy of the order or judgment rendered against the Respondent.

### Rule 7.02. Order to Show Cause

When a petition is filed, the Chair immediately issues a show cause order and a hearing notice and forwards them to the CDC, who must serve the order and notice on the Respondent. The CDC must notify BODA of the date that service is obtained.

### Rule 7.03. Attorney's Response

If the Respondent does not file an answer within 30 days of being served with the order and notice but thereafter appears at the hearing, BODA may, at the discretion of the Chair, receive testimony from the Respondent relating to the merits of the petition.

## VIII. DISTRICT DISABILITY COMMITTEE HEARINGS

### Rule 8.01. Appointment of District Disability Committee

(a) If the evidentiary panel of the grievance committee finds under TRDP 2.17(P)(2), or the CDC reasonably believes under TRDP 2.14(C), that a Respondent is suffering from a disability, the rules in this section will apply to the de novo proceeding before the District Disability Committee held under TRDP Part XII.

(b) Upon receiving an evidentiary panel's finding or the CDC's referral that an attorney is believed to be suffering from a disability, the BODA Chair must appoint a District Disability Committee in compliance with TRDP 12.02 and designate a chair. BODA will reimburse District Disability Committee members for reasonable expenses directly related to service on the District Disability Committee. The BODA Clerk must notify the CDC and the Respondent that a committee has been appointed and notify the Respondent where to locate the procedural rules governing disability proceedings.

(c) A Respondent who has been notified that a disability referral will be or has been made to BODA may, at any time, waive in writing the appointment of the District Disability Committee or the hearing before the District Disability Committee and enter into an agreed judgment of indefinite disability suspension, provided that the Respondent is competent to waive the hearing. If the Respondent is not represented, the waiver must include a statement affirming that the Respondent has been advised of the right to appointed counsel and waives that right as well.

(d) All pleadings, motions, briefs, or other matters to be filed with the District Disability Committee must be filed with the BODA Clerk.

(e) Should any member of the District Disability Committee become unable to serve, the BODA Chair must appoint a substitute member.

### Rule 8.02. Petition and Answer

(a) **Petition.** Upon being notified that the District Disability Committee has been appointed by BODA, the CDC must, within 20 days, file with the BODA Clerk and serve on the Respondent a copy of a petition for indefinite disability suspension. Service must comply with Rule 1.06.

(b) **Answer.** The Respondent must, within 30 days after service of the petition for indefinite disability suspension, file an answer with the BODA Clerk and serve a copy of the answer on the CDC.

(c) **Hearing Setting.** The BODA Clerk must set the final hearing as instructed by the chair of the District Disability Committee and send notice of the hearing to the parties.

### Rule 8.03. Discovery

(a) **Limited Discovery.** The District Disability Committee may permit limited discovery. The party seeking discovery must file with the BODA Clerk a written request that makes a clear showing of good cause and substantial need and a proposed order. If the District Disability Committee authorizes discovery in a case, it must issue a written order. The order may impose limitations or deadlines on the discovery.

(b) **Physical or Mental Examinations.** On written motion by the Commission or on its own motion, the District Disability Committee may order the Respondent to submit to a physical or mental examination by a qualified healthcare or mental healthcare professional. Nothing in this rule limits the Respondent's right to an examination by a professional of his or her choice in addition to any exam ordered by the District Disability Committee.

(1) **Motion.** The Respondent must be given reasonable notice of the examination by written order specifying the name, address, and telephone number of the person conducting the examination.

(2) **Report.** The examining professional must file with the BODA Clerk a detailed, written report that includes the results of all tests performed and the professional's findings, diagnoses, and conclusions. The professional must send a copy of the report to the CDC and the Respondent.

(c) **Objections.** A party must make any objection to a request for discovery within 15 days of receiving the motion by filing a written objection with the BODA Clerk. BODA may decide any objection or contest to a discovery motion.

#### **Rule 8.04. Ability to Compel Attendance**

The Respondent and the CDC may confront and cross-examine witnesses at the hearing. Compulsory process to compel the attendance of witnesses by subpoena, enforceable by an order of a district court of proper jurisdiction, is available to the Respondent and the CDC as provided in TRCP 176.

#### **Rule 8.05. Respondent's Right to Counsel**

(a) The notice to the Respondent that a District Disability Committee has been appointed and the petition for indefinite disability suspension must state that the Respondent may request appointment of counsel by BODA to represent him or her at the disability hearing. BODA will reimburse appointed counsel for reasonable expenses directly related to representation of the Respondent.

(b) To receive appointed counsel under TRDP 12.02, the Respondent must file a written request with the BODA Clerk within 30 days of the date that Respondent is served with the petition for indefinite disability suspension. A late request must demonstrate good cause for the Respondent's failure to file a timely request.

#### **Rule 8.06. Hearing**

The party seeking to establish the disability must prove by a preponderance of the evidence that the Respondent is suffering from a disability as defined in the TRDP. The chair of the District Disability Committee must admit all relevant evidence that is necessary for a fair and complete hearing. The TRE are advisory but not binding on the chair.

#### **Rule 8.07. Notice of Decision**

The District Disability Committee must certify its finding regarding disability to BODA, which will issue the final judgment in the matter.

#### **Rule 8.08. Confidentiality**

All proceedings before the District Disability Committee and BODA, if necessary, are closed to the public. All matters before the District Disability Committee are confidential and are not subject to disclosure or discovery, except as allowed by the TRDP or as may be required in the event of an appeal to the Supreme Court of Texas.

### **IX. DISABILITY REINSTATEMENTS**

#### **Rule 9.01. Petition for Reinstatement**

(a) An attorney under an indefinite disability suspension may, at any time after he or she has been suspended, file a verified petition with BODA to have the suspension terminated and to be reinstated to the practice of law. The petitioner must serve a copy of the petition on the CDC in the manner required by TRDP 12.06. The TRCP apply to a reinstatement proceeding unless they conflict with these rules.

(b) The petition must include the information required by TRDP 12.06. If the judgment of disability suspension

contained terms or conditions relating to misconduct by the petitioner prior to the suspension, the petition must affirmatively demonstrate that those terms have been complied with or explain why they have not been satisfied. The petitioner has a duty to amend and keep current all information in the petition until the final hearing on the merits. Failure to do so may result in dismissal without notice.

(c) Disability reinstatement proceedings before BODA are not confidential; however, BODA may make all or any part of the record of the proceeding confidential.

#### **Rule 9.02. Discovery**

The discovery period is 60 days from the date that the petition for reinstatement is filed. The BODA Clerk will set the petition for a hearing on the first date available after the close of the discovery period and must notify the parties of the time and place of the hearing. BODA may continue the hearing for good cause shown.

#### **Rule 9.03. Physical or Mental Examinations**

(a) On written motion by the Commission or on its own, BODA may order the petitioner seeking reinstatement to submit to a physical or mental examination by a qualified healthcare or mental healthcare professional. The petitioner must be served with a copy of the motion and given at least seven days to respond. BODA may hold a hearing before ruling on the motion but is not required to do so.

(b) The petitioner must be given reasonable notice of the examination by written order specifying the name, address, and telephone number of the person conducting the examination.

(c) The examining professional must file a detailed, written report that includes the results of all tests performed and the professional's findings, diagnoses, and conclusions. The professional must send a copy of the report to the parties.

(d) If the petitioner fails to submit to an examination as ordered, BODA may dismiss the petition without notice.

(e) Nothing in this rule limits the petitioner's right to an examination by a professional of his or her choice in addition to any exam ordered by BODA.

#### **Rule 9.04. Judgment**

If, after hearing all the evidence, BODA determines that the petitioner is not eligible for reinstatement, BODA may, in its discretion, either enter an order denying the petition or direct that the petition be held in abeyance for a reasonable period of time until the petitioner provides additional proof as directed by BODA. The judgment may include other orders necessary to protect the public and the petitioner's potential clients.

## **X. APPEALS FROM BODA TO THE SUPREME COURT OF TEXAS**

### **Rule 10.01. Appeals to the Supreme Court**

(a) A final decision by BODA, except a determination that a statement constitutes an inquiry or a complaint under TRDP 2.10, may be appealed to the Supreme Court of Texas. The clerk of the Supreme Court of Texas must docket an appeal from a decision by BODA in the same manner as a petition for review without fee.

(b) The appealing party must file the notice of appeal directly with the clerk of the Supreme Court of Texas within 14 days of receiving notice of a final determination by BODA. The record must be filed within 60 days after BODA's determination. The appealing party's brief is due 30 days after the record is filed, and the responding party's brief is due 30 days thereafter. The BODA Clerk must send the parties a notice of BODA's final decision that includes the information in this paragraph.

(c) An appeal to the Supreme Court is governed by TRDP 7.11 and the TRAP.