

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

In the Matter of

Tony C. Hom,

Respondent

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Proceeding No. D2021-10 & [REDACTED]

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Tony C. Hom (“Respondent”), have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval. The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Brooklyn, New York, has been a registered patent attorney (Registration No. 72,904) and an attorney in good standing in the State of New York who has engaged in practice before the Office in patent and trademark matters. Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

Background

A. U.S. Counsel Rule for Trademark Matters

3. The USPTO published a final rule (“U.S. Counsel Rule”) requiring applicants, registrants, or parties to a trademark proceeding whose domicile is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. *See* Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 FR 31498 (July 2, 2019).

4. The U.S. Counsel Rule became effective on August 3, 2019. *See* 37 C.F.R. § 2.11(a).

5. In the few years preceding the U.S. Counsel Rule’s effective date, the USPTO had seen many instances of unauthorized practice of law (“UPL”) where foreign parties who are not authorized to represent trademark applicants were improperly representing foreign applicants before the USPTO. As a result, increasing numbers of foreign applicants were likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law. This practice raised legitimate concerns that affected applications and any resulting registrations are potentially invalid, and thus negatively impacting the integrity of the trademark register.

6. Hence, the USPTO implemented the requirement for representation by a qualified U.S. attorney in response to the increasing problem of foreign trademark applicants who purportedly are *pro se* (*i.e.*, one who does not retain a lawyer and appears for himself or herself) and who are filing inaccurate and possibly fraudulent submissions that violate the Trademark Act and/or the USPTO’s rules. For example, such foreign applicants filed applications claiming use of a mark in commerce, but frequently support the use claim with mocked-up or digitally altered specimens

that indicate the mark may not actually be in use. Many appear to be doing so on the advice, or with the assistance, of foreign individuals and entities who are not authorized to represent trademark applicants before the USPTO. This practice undermines the accuracy and integrity of the U.S. trademark register and its utility as a means for the public to reliably determine whether a chosen mark is available for use or registration, and places a significant burden on the trademark examining operation. *See* 84 FR at 31498-31499.

7. U.S. attorneys are required to provide their bar information when representing applicants and registrants, whether domiciled inside or outside the U.S. *See* 37 C.F.R. §§ 2.17(b)(3), 2.32(a)(4).

B. Trademark Specimens

8. A trademark application filed under section 1 (a) of the Trademark Act must include a specimen (*i.e.*, a label, tag, container, or display) showing the mark as used on or in connection with the goods or services listed in the application. *See* 37 C.F.R. § 2.56.

9. Specifically, the specimen must show the mark in “use in commerce,” which is the bona fide use of the mark in the ordinary course of trade, and not merely to reserve a right in the mark. *See* 15 U.S.C. § 1127; TMEP § 901.

10. A mock-up or representation of how the mark will appear in the sale or advertising of the goods or services is not a proper specimen. *See* TMEP §§ 904.03(a), 904.04. Similarly, material inserted into a package is not a proper specimen. *See* TMEP § 904.04(c).

11. By filing a trademark application with the USPTO, the practitioner is certifying, among other things, that “[t]o the best of the [practitioner's] knowledge, information and belief, formed after an inquiry reasonable under the circumstances” the allegations and representations in the application have evidentiary support. *See* 37 C.F.R. § 11.18.

12. The TMEP explicitly advises that an inquiry “may be appropriate when the specimen consists of a photograph of the mark reproduced on a plain white label adhered to the goods or printed packaging[.]” TMEP § 904.03(a).

C. Trademark Signature Rules

13. USPTO trademark signature rules require that all signatures be personally entered by the named signatory and that a person electronically signing a document must personally enter any combination of letters, numbers, spaces, and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission. *See* 37 C.F.R. §§ 2.193(a) and (c), and 37 C.F.R. § 11.18(a).

14. At all relevant times, the following unequivocal published guidance from the USPTO identified the proscription against any person other than the named signatory signing electronically trademark documents 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).

15. 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 signed under penalty of perjury in trademark applications in the course of examining trademark applications and issuing registrations.

Joint Stipulated Facts

16. At all times relevant hereto, Respondent has been a registered patent attorney and a U.S. attorney in good standing in the state of New York.

17. At all relevant times hereto, Respondent has been the principal attorney at his law firm, the Law Office of Tony Hom (“the Hom Law Firm”), where he provides legal services.

18. Respondent has been listed as the attorney of record on more than 13,000 trademark documents filed with the USPTO.

19. Before August 3, 2019, Respondent has been listed as the attorney of record on more than 2,000 trademark documents filed with the USPTO.

20. After August 3, 2019, Respondent has been listed as the attorney of record on more than 11,000 trademark documents filed with the USPTO.

21. In connection with the thousands of trademark applications Respondent filed, Respondent typically received instructions for filing from intermediaries and associates located in China. Such associates were often not U.S. practitioners themselves. Such associates typically collected information from prospective trademark applicants and would use such information to prepare a draft form of trademark application to be provided to Respondent.

22. Due in part to the constraints in time caused by accepting a very large volume of trademark clients over a relatively short period of time and of his reliance on non-U.S. practitioners to obtain information from prospective trademark applicants, Respondent often did not advise or discuss directly with the applicants themselves important legal issues regarding their trademark

applications, such as what constitutes a proper specimen or whether the applicant's use qualifies for use in commerce.

23. Respondent represented a number of different clients who engaged Respondent to prepare and file a trademark application and provided Respondent with what the applicant purported to be a specimen. In some instances, the specimens provided to Respondent as alleged proof of use appeared to be identical to other specimens for different applicants for different marks that were also filed by Respondent—sometimes within days of one another.

24. Respondent acknowledges that he did not fully conduct an inquiry reasonable under the circumstances to determine whether the specimens he was submitting with the applications he was being asked to file properly depicted the mark as used in commerce.

25. Respondent represents to OED that he did not adequately understand the U.S. Counsel Rule during his trademark practice. Respondent represents that he now fully understands the U.S. Counsel Rule and expresses contrition for his prior lack of understanding of the U.S. Counsel Rule and how his acts and omissions implicated provisions of the USPTO Rules of Professional Conduct.

26. In 2020, Respondent was listed as the attorney of record on over 7,000 trademark documents filed with the USPTO.

27. Respondent did not personally enter his electronic signature on many of the 7,000 trademark documents filed with the USPTO in 2020 where he appears as the signatory and attorney of record.

28. Respondent did not directly inform many of the trademark applicants of the impermissibly signed trademark documents. Respondent did not directly communicate with many of the trademark applicants about the impermissibly signed trademark documents and explain the

potential adverse consequences to their intellectual property rights occasioned by the impermissible signatures.

29. Respondent represents to OED that he did not adequately understand the USPTO trademark signature rules during his trademark practice. Respondent represents that he now fully understands the USPTO trademark signature rules and expresses contrition for his prior lack of understanding of the USPTO trademark signature rules and how his acts and omissions implicated provisions of the USPTO Rules of Professional Conduct.

Additional Considerations

30. Respondent has expressed contrition for his prior lack of understanding of the U.S. Counsel Rule, the USPTO specimen rules, the USPTO trademark signature rules, and how his acts and omissions implicated provisions of the USPTO Rules of Professional Conduct.

31. Respondent has expressed his understanding of the seriousness of the violations of the USPTO Rules of Professional Conduct stipulated to herein, and he acknowledges the potential adverse impact on his clients' intellectual property rights from the trademark filings that were made in violation of the USPTO's trademark regulations.

32. Respondent represents that in 24 years of practice he has never been the subject of professional discipline by the USPTO, any court, or any state bar.

Joint Legal Conclusions

33. Respondent acknowledges that, based on the information contained in the joint stipulated facts, above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.101 (practitioner shall provide competent representation) by not ensuring that he knew and understood the U.S. Counsel Rule, the USPTO specimen rules, and the USPTO trademark

signature rules, which resulted in violations of those rules in the course of representing trademark clients;

b. 37 C.F.R. § 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) by failing to take reasonable steps to ensure that his clients' trademark filings were prepared, reviewed, signed, and filed in compliance with the U.S. Counsel Rule, the USPTO specimen rules, and the USPTO trademark signature rules;

c. 37 C.F.R. §§ 11.104(a) and (b) (communications with client) by not informing his clients, directly or through any associate, as to the actual or potential adverse consequences of not complying with the U.S. Counsel Rule, the USPTO specimen rules, and the USPTO trademark signatures rules, so that the clients could make informed decisions about their trademark applications and/or issued registrations;

d. 37 C.F.R. § 11.503(b) (responsibilities regarding non-practitioner assistance) by authorizing or otherwise allowing non-practitioners to prepare drafts of trademark documents without adequate supervision to ensure that such documents were being prepared with proper specimens;

e. 37 C.F.R. § 11.505 (assisting unauthorized practice before the USPTO in trademark matters) by authorizing non-practitioners to communicate with his clients and provide advice to such clients about specimens; and

f. 37 C.F.R. § 11.804(d) (conduct prejudicial to the integrity of the U.S. trademark registration system) by (i) not complying with the U.S. Counsel Rule and the USPTO trademark signature rules, and (ii) not complying with 37 C.F.R. § 11.18 by not conducting a reasonable inquiry prior to filing trademark documents filed with the USPTO, with the knowledge that the USPTO would rely on such trademark documents in examining applications and issuing registrations.

Agreed-Upon Sanction

34. Respondent agrees and it is hereby ORDERED that:

a. Respondent shall be, and hereby is, suspended from practice before the Office for a period of two (2) years after the date of the Final Order;

b. Respondent may file a written notice of his intent to seek reinstatement and a petition for reinstatement at eighteen (18) months after the date of the Final Order;

c. The OED Director shall not grant the petition for reinstatement until after the expiration of the two (2) year period of suspension;

d. After Respondent files a petition for reinstatement and if requested by the OED Director, Respondent shall file a supplemental affidavit satisfactory to the OED Director that addresses Respondent's purported compliance with 37 C.F.R. § 11.58 for the time following the submission of the petition for reinstatement;

e. Respondent shall serve a probationary period commencing on the date of the Final Order and continuing for twelve (12) months after the date the OED Director grants Respondent's petition for reinstatement;

f. As a condition of reinstatement, Respondent shall provide to the OED Director a sworn affidavit or verified declaration attesting, and evidence demonstrating, that Respondent has: (1) successfully completed eight hours of continuing legal education on ethics/professional responsibility, and (2) reviewed thoroughly all provisions of the Trademark Manual of Examining Procedure ("TMEP"), including, but not limited to, the provisions of the USPTO's signature requirements; 37 C.F.R. § 2.11, and the commentary on the Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, found at 84 FR 31498-01;

g. Respondent shall comply with 37 C.F.R. §§ 11.58 and 11.60;

h. Respondent shall remain suspended from the practice of patent, trademark, and non-patent matters before the USPTO until reinstated by the OED Director pursuant to 37 C.F.R. § 11.60;

i. (1) In the event that the OED Director is of the opinion that Respondent, during his probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct or the provisions of the Agreement, the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending Respondent for up to an additional twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and

(2) In the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, the Final Order, or the USPTO Rules of Professional Conduct, the OED Director shall:

(A) deliver to the USPTO Director or his designee: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence causing the OED Director to be of the opinion that Respondent failed to comply with any provision of the Agreement, the Final Order, or the USPTO Rules of Professional Conduct during the probationary period; and

(B) request that the USPTO Director immediately suspend Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions above;

- j. In the event the USPTO Director suspends Respondent pursuant to subparagraph i, above, and Respondent seeks a review of the suspension, any such review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- k. The OED Director shall electronically publish the Final Order at the OED'S electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <https://foiadocuments.uspto.gov/oed/>;
- l. The OED Director shall publish the following notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension and Probation

This notice concerns Mr. Tony C. Hom, a registered practitioner and trademark attorney licensed in the state of New York, who resides in Brooklyn, New York. Mr. Hom is hereby suspended from practice before the Office for a period of two (2) years and placed on probation for violating 37 C.F.R. §§ 11.101, 11.103, 11.104(a), 11.104(b), 11.503(b), 11.505, and 11.804(d). Mr. Hom may file a written notice of his intent to seek reinstatement and a petition for reinstatement at eighteen (18) months after the date of the Final Order. However, the OED Director shall not grant the petition until after the expiration of the two (2) year period of suspension.

Mr. Hom is a registered patent attorney who provides patent and trademark legal services. These violations are predicated on Mr. Hom's acts and omissions during the course of his representation of trademark clients.

Mr. Hom has filed over 13,000 trademark documents with the USPTO. Before August 3, 2019, Respondent has been listed as the attorney of record on more than 2,000 trademark documents filed with the USPTO. After August 3, 2019, Respondent has been listed as the attorney of record on more than 11,000 trademark documents filed with the USPTO. In 2020, Respondent was listed as the attorney of record on over 7,000 trademark documents filed with the USPTO.

In many of the representations, Respondent allowed non-practitioners to interact with the trademark applicant clients, advise them, prepare drafts of trademark application materials, and enter his electronic signature on trademark documents filed with the USPTO where Respondent appears as the signatory and attorney of record. Respondent did not substantively review many of the documents prepared on his behalf by non-practitioners, directly inform the trademark applicants of the impermissibly signed trademark documents, or directly communicate with the trademark applicants about the impermissibly signed trademark documents and explain the potential adverse consequences to their intellectual property rights occasioned by the impermissible signatures.

USPTO trademark signature regulations require that a proper person sign a trademark document and that the person named as the signatory on the document be the one who enters his or her electronic signature on the document (*i.e.*, personally enter the combination of letters, numbers, spaces and/or punctuation marks that he or she has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission). *See* 37 C.F.R. § 2.193(a)(2), (c) and (e).

The USPTO Trademark Manual of Examining Procedure (“TMEP”) provides straightforward guidance regarding the USPTO trademark electronic signature regulations:

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.

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.

See TMEP § 611.01(c) (case citations omitted) (line spacing added).

Mr. Hom represents that he did not understand adequately the USPTO trademark signature requirements of 37 C.F.R. § 2.193, the guidance set forth in TMEP § 611.01(c), or the U.S. Counsel Rule.

The U.S. Counsel Rule became effective on August 3, 2019, and requires applicants, registrants, or parties to a trademark proceeding whose domicile is not

located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. *See* 84 FR 31498; 37 C.F.R. § 2.11(a). In the few years preceding the U.S. Counsel Rule's effective date, the USPTO had seen many instances of unauthorized practice of law where foreign parties who are not authorized to represent trademark applicants were improperly representing foreign applicants before the USPTO. As a result, increasing numbers of foreign applicants were likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law. This practice raised legitimate concerns that affected applications and any resulting registrations are potentially invalid, and thus negatively impacting the integrity of the trademark register.

Hence, the USPTO implemented the requirement for representation by a qualified U.S. attorney in response to the increasing problem of foreign trademark applicants who purportedly are *pro se* (*i.e.*, one who does not retain a lawyer and appears for himself or herself) and who are filing inaccurate and possibly fraudulent submissions that violate the Trademark Act and/or the USPTO's rules. For example, such foreign applicants filed applications claiming use of a mark in commerce, but frequently support the use claim with mocked-up or digitally altered specimens that indicate the mark may not actually be in use. Many appear to be doing so on the advice, or with the assistance, of foreign individuals and entities who are not authorized to represent trademark applicants before the USPTO. This practice undermines the accuracy and integrity of the U.S. trademark register and its utility as a means for the public to reliably determine whether a chosen mark is available for use or registration, and places a significant burden on the trademark examining operation. *See* 84 FR at 31498-31499.

The U.S. Counsel Rule is intended to increase USPTO customer compliance with U.S. trademark law and USPTO regulations, improve the accuracy of trademark submissions to the USPTO, and safeguard the integrity of the U.S. trademark register. For example, practitioners who represent trademark applicants before the USPTO are expected to, among other things, undertake a bona fide review of specimens submitted to the USPTO in support of a trademark application. A practitioner's failure to comply with his or her ethical obligations under the U.S. Counsel rule potentially adversely affects the integrity of the USPTO trademark registration process.

A USPTO practitioner has an ethical obligation under the USPTO Rules of Professional Conduct to know who is the client. *See* 37 C.F.R. § 11.101 (concerning competency) and 11.804(i) (concerning other conduct that adversely reflects on a practitioner's fitness to practice before the Office). "The PTO expects practitioners to know the identities of their clients and to take reasonable steps to avoid foreseeable prejudice to the rights of their clients." *See Responsibilities of Practitioners Representing Clients in Proceedings Before The*

Patent and Trademark Office, 1421 CNOG 2690 (December 29, 2015) (citing 50 Federal Register 5164 (Feb. 6, 1985) and 1086 Trademark Official Gazette 357 (Jan. 5, 1988)).

Where a trademark practitioner works with a foreign intermediary, the client is the trademark applicant. *See Responsibilities of Practitioners Representing Clients in Proceedings Before The Patent and Trademark Office*, 1091 OG 26 (May 25, 1988). *See also Strojirenstvi v. Toyoda*, 2 USPQ 2nd 1222 (Comm'r Pat. 1986) (explaining, in part, that a U.S. practitioner who receives instructions from a trademark owner through a foreign agent does not change the fact that the client is still the trademark owner rather than the foreign or agent).

Mr. Hom represents that in 24 years of practice he has never been the subject of professional discipline by the USPTO, any court, or any state bar.

This action is the result of a settlement agreement between Mr. Hom and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <https://foiadocuments.uspto.gov/oed>;

- m. Nothing in the Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding and investigation, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; and/or (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;
- n. Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- o. The parties shall bear their own costs incurred to date and in carrying out the terms of the Agreement and any Final Order.

Users, Shewchuk, David
Digitally signed by Users,
Shewchuk, David
Date: 2021.12.17 10:41:50
-05'00'

David Shewchuk
Acting General Counsel
United States Patent and Trademark Office

Date

on delegated authority by
Andrew Hirshfeld
Performing the Functions and Duties Of The
Under Secretary of Commerce for Intellectual Property and
Director Of The United States Patent And Trademark Office