

UNITED STATES
PATENT AND TRADEMARK OFFICE



Representation, signatures, and ethics in trademark cases

Paul Nguyen-Ba

Staff Attorney, Office of Enrollment and Discipline

David Mayer

Staff Attorney, Trademark Legal Policy Office



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Topics

- Role of the Office of Enrollment and Discipline (OED)
- USPTO Rules
 - Representation and authority
 - Verified and sponsored USPTO.gov accounts
 - U.S. counsel rule
 - Signatures and certification
- Sanctions
- Misconduct
- Tips and takeaways



Discussion topic

Role of the Office of Enrollment and Discipline (OED)

OED

- **Mission**
 - Protect the public and integrity of the patent and trademark system
- **Statutory authority**
 - 35 U.S.C. §2(b)(2)(D) and §32
- **Disciplinary jurisdiction (37 C.F.R. §11.19)**
 - All practitioners engaged in practice before the USPTO
 - Non-practitioners who engage in or offer to engage in practice before the USPTO
- **Governing regulations**
 - USPTO Rules of Professional Conduct: 37 C.F.R. §§11.101-11.901
 - Procedural rules: 37 C.F.R. §§11.19-11.60



OED: investigation

- **Receipt of a grievance**
 - Grievance: written submission from any source received by OED Director that presents possible grounds for discipline of a specified practitioner
 - Self-reporting often considered a mitigating factor in the disciplinary process
- **Time period for filing formal complaint**
 - One year from receipt of grievance or 10 years from date of misconduct
- **After investigation, OED may do any of the following:**
 - Terminate investigation with no action
 - Issue a warning to the practitioner
 - Institute formal charges with approval of committee on discipline
 - Enter into a settlement agreement and submit to USPTO Director for approval

OED: role in addressing trademark rule violations and scams

- OED protects the public by investigating rule violations and scams that involve an identifiable **practitioner**.
- OED can refer scams that do not involve a practitioner to other USPTO business units, including the Register Protection Office, that reviews suspicious trademark filing activity as well as other federal and state agencies.

Other USPTO business units

- Trademark Register Protection Office ("RPO")
 - Directs administrative sanctions process
 - Monitors and reviews reports of scams and suspicious filing behavior
- Trademark Legal Policy Office ("LPO")
 - Provides guidance on trademark statutes, regulations, policies, and practices



Trademarks: administrative sanctions process

- Formal administrative orders issued when parties are found to have violated USPTO rules
 - Rules concerning signatures, certifications, and representation of others before the USPTO, and/or
 - Terms of use for USPTO.gov accounts
- Rule violations may result in sanctions, for example:
 - Termination of applications and reopened registration decisions
 - Account suspensions



Discussion topic

USPTO Rules: Representation and authority

Recognition as representative

37 C.F.R. §2.17(b)(1): To be recognized as a representative in a trademark case, a practitioner qualified under 37 C.F.R. §11.14 may:

- (i) File a **properly signed** power of attorney (appointment/revocation via Change of Address or Representation (CAR) form);
- (ii) Sign a document on behalf of an applicant, registrant, or party to a proceeding **who is not already represented** by a qualified practitioner from a different firm; or
- (iii) Appear by being identified as the representative in a document submitted to the office on behalf of an applicant, registrant, or party to a proceeding **who is not already represented** by a qualified practitioner from a different firm.



Recognition as representative (cont'd)

- When is a party “already represented?”
 - Representation during pendency of an application or post-registration proceeding continues until the applicant files a new power of attorney and/or revokes the previous power, the attorney withdraws, or the attorney is suspended or excluded from practice before the USPTO. *See* 37 C.F.R. §2.19(a)(1), (4).
 - Certain actions automatically end recognition of a power of attorney: (i) Abandonment of the application; (ii) Ownership change; (iii) Acceptance/refusal of a maintenance filing; or (iv) Registration of the mark. *See* 37 C.F.R. §2.17(g).

Federal precedent on representation

- Applicants are bound by the acts or omissions of their chosen representatives. *See, e.g.:*
 - *Link v. Wabash R. Co.*, 370 U.S. 626 (1962)
 - *Japanese Found. for Cancer Rsch. v. Lee*, 773 F.3d 1300 (Fed. Cir. 2014)
 - *Robinson v. Wix Filtration Corp., LLC*, 559 F.3d 403 (4th Cir. 2010)
 - *Singhal v. Mentor Graphics Corp.*, 329 F. App'x 648 (Fed. Cir. 2009)
 - *Huston v. Ladner*, 973 F.2d 1564 (Fed. Cir. 1992) (If “an attorney’s negligence constitutes good cause for failing to meet a PTO requirement, the PTO’s rules could become meaningless . . . [because] parties could regularly allege attorney negligence in order to avoid an unmet requirement.”)

Verified and sponsored accounts

- ID verified USPTO.gov accounts – Mandatory for electronic filing since August 2022
 - ID.me
- Sponsored accounts
 - ID verification required for all sponsored account users since January 20, 2024
 - An attorney **must** sponsor paralegals and support staff for them to be able to access the system.

Account agreement

- Sponsorship of attorney support staff accounts
 - **Directly** employed or retained by you, your company, or your law firm
 - Under your **direct** supervision
 - **Immediately** remove sponsorship if no longer employed or supervised by you



Sponsored accounts

- Attorneys are “personally, professionally, and ethically responsible for conduct” of sponsored staff while using USPTO.gov accounts.
- Failure to adequately supervise use of sponsored accounts may result in, for example:
 - Sponsored Account Shutdown Order (SASO)
 - Referral to OED



Discussion topic

USPTO Rules: Signatures and certification

Signature requirements

- All correspondence that requires a signature must bear either:
 - an "electronic signature" that meets the requirements of 37 C.F.R. §2.193(c), personally entered by the signatory,
 - a handwritten signature personally signed in permanent ink by the person named as the signatory, or
 - "[S]ome other form of electronic signature specified by the Director," – which includes document-signing software, under certain limitations, personally signed by the individual identified in the signatory name field.

Signature requirements (cont'd)

- USPTO Trademark Manual of Examining Procedure ("TMEP") §611.01(c) and relevant case law – prohibit anyone other than the named signatory signing a trademark submission.
- Person(s) identified as the signatory must **personally** sign the printed form or personally enter signatory's electronic signature (37 C.F.R. §2.193(a), (d)).
- One cannot delegate authority to sign, and no person may sign or enter the name of another.
- Another person may not use document-signing software to create or generate the electronic signature of the named signatory.



Signature requirements: electronic signatures

- Electronic signature directly on the form
 - Any combination of letters, numbers, spaces, and/or punctuation marks **that the signatory has adopted as a signature**, placed between two forward slash symbols. See 37 C.F.R. §2.193(c).
- Electronic signature via email
 - The document is completed and then a link for signature is emailed to the signatory. Once the signature is entered, the document is returned to the party completing the form for submission.
- Document-signing software
 - The underlying software must (i) preserve signature data in the form of a digital certificate, token or audit trail, (ii) generate the data signed, (iii) indicate the signature page or form, was generated electronically, and (iv) be specifically designed to generate electronic signatures. **The option is only available for verification signatures and Change of Address or Representation (CAR) forms.**

Signature requirements (cont'd 2)

- Signatures must be that of a real person.
 - Juristic entities act through their principals or officers.
 - See TMEP §611.06(b)-(h).
- The first and last name, and the title or position, of the person who signed the document must be set forth below or adjacent to the signature. 37 C.F.R. §2.193(d).

Authority to sign

- All documents submitted to the USPTO in connection with a trademark application or registration must be signed by a proper person; who the “proper person” is depends on the nature of the submission. See 37 C.F.R. §2.193(e). The proper person depends on the type of document being signed:
 - Verifications of fact
 - Responses, amendments, requests, and petitions
 - Power of attorney



Authority to sign: verifications of fact

- Verifications of fact
 - Primarily include: applications, allegations of use, requests for extension to file statements of use, petitions to revive, and declarations in support of substitute specimens or claims of acquired distinctiveness.
 - May be signed by any of the following individuals:
 - a person with legal authority to bind the applicant;
 - a qualified attorney representing the applicant; **or**
 - a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant.
 - Generally, the office does not question the authority of the person who signs a verification of facts, unless there is an inconsistency in the record as to the signatory's authority to sign. See TMEP §804.04.

Authority to sign: responses, amendments, and requests

- Responses, amendments, and requests
 - Primarily includes: responses to office actions, amendments to applications, requests for express abandonment, requests to divide, petitions to the director, requests to update correspondence information
 - **Must** be signed by attorney, if one is appointed.
 - Otherwise, must be signed by individual applicant(s) or by someone with legal authority to bind the applicant/registrant (if a juristic entity).
 - For joint applicants/registrants, **all** must sign.
 - For juristic entities, the record must reflect that the signatory has apparent authority by virtue of his/her title or position. See TMEP §611.04 for examples.



Authority to sign: power of attorney

- Power of attorney
 - Must be signed by the individual applicant, registrant, or party to a proceeding pending before the office, or by someone with legal authority to bind the applicant, registrant, or party (e.g., a corporate officer).
 - **However**, once an attorney is properly designated, “the named practitioner may sign an associate power of attorney appointing another qualified practitioner(s) as an additional person(s) authorized to prosecute the application or registration.”
 - **Revocation of the primary attorney’s power also revokes the power of all associate powers of attorney.**



Authority to sign: submissions with verifications and other amendments

- Submissions with both verifications and other amendments
 - Each portion, verification and amendments, must be considered separately to determine if the submission is properly signed.
- Therefore:
 - If an attorney is appointed, the attorney must sign responses and voluntary amendments.
 - An applicant may sign a declaration contained in a response or amendment. However, if an attorney is appointed, the response/amendment is not properly signed unless the attorney signs the submission.

Authority to sign: apparent authority for juristic entities

- Apparent authority for juristic entities
 - Partnership: General partner, or for a LLP, any partner. TMEP §611.06(b),(h).
 - Joint Venture: Each party to the venture. TMEP §611.06(c).
 - Domestic Corporation: Corporate officer (e.g., “President,” “Chief Financial Officer,” “Senior Vice President, Legal”). TMEP §611.06(d).
 - Foreign Corporation/Limited Company: Equivalent to domestic corporate officers, including “Manager” or “Director.” TMEP §611.06(e).
 - Unincorporated Associations: Unfamiliar titles can be accepted **with** a statement explaining that the signer has the authority equivalent to a corporate officer within the framework of the organization. TMPE §611.06(f).
 - Limited Liability Company – Anyone with a corporate-style title **or** a “manager,” “owner,” “principal,” or “member.” TMEP §611.06(g).

Authority to sign: unacceptable titles

- Unacceptable titles for persons authorized to sign for juristic entities
 - “Trademark Coordinator”
 - “Foreign Trademark Counsel”
 - “Agent of XXX, Corp.”
 - “Authorized Signatory” (unless previously properly identified)
- Special attention for “General Counsel” or “In-House Counsel”
 - In-house attorneys qualified to practice before the office may act as the attorney of record, but may not sign as corporate representatives for the owner unless also identified as a corporate officer or equivalent. TMEP §§606, 611.02, 611.04.
 - Acceptable: “Senior Vice President and General Counsel”
 - Unacceptable: “Senior Trademark Counsel”



Authority to sign: U.S. counsel rule

- Foreign-domiciled trademark applicants, registrants, and parties to proceedings in trademark matters must be represented before the USPTO by an attorney licensed to practice law in the United States.
- Purpose of the rule:
 - Increases compliance with U.S. trademark law and USPTO regulations
 - Improves the accuracy of trademark submissions to the USPTO
 - Safeguards the integrity of the U.S. trademark register



Signature as certification: Rule 11.18

- By presenting (filing, submitting, advocating) any document to the USPTO, an attorney makes certifications pursuant to 37 C.F.R. §11.18.
- In part, the attorney certifies that to the best of his or her knowledge, information, and belief **formed after an inquiry reasonable under the circumstances**, the factual contentions or denials have evidentiary support.



Signature as certification: Rule 11.18

(cont'd)

- (c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—
 - (1) Striking the offending paper;
 - (2) Referring a practitioner's conduct to the Director of Enrollment and Discipline for appropriate action;
 - (3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;
 - (4) Affecting the weight given to the offending paper; or
 - (5) Terminating the proceedings in the office.
- (d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.



Discussion topic

Sanctions

Signature violations: OED sanctions

- *In re Zhong*, USPTO May 21, 2025
 - U.S.-licensed attorney suspended for, *inter alia*, impermissibly entering clients' signatures on trademark documents presented to the Office.
- *In re Ni*, USPTO Mar. 21, 2025
 - Texas-licensed attorney reprimanded for, *inter alia*, presenting trademark documents (including declarations) to the USPTO that were signed by other than the named signatory.
- *In re Wang*, USPTO Aug. 22, 2025
 - Texas-licensed attorney reprimanded for, *inter alia*, directing his paralegal to enter his signature on trademark documents and sworn declarations and enter applicant signatures on CAR forms.
- *In re Toledano*, USPTO Sept. 3, 2025
 - New York-licensed attorney suspended for, *inter alia*, presenting documents that were impermissibly signed.

Signature violations: administrative sanctions

- *In re Stelcore Mgmt. Servs., LLC*, 2025 Commr. Pat. LEXIS 3 (Dir. USPTO 2025) (precedential)
 - Terminated application proceedings where filing firm improperly entered applicant and attorney signatures and provided false signatory information as well as false attorney information
- *In re Shenzhen Seller Growth Network Technology Co., Ltd. et al.*
 - Filing firm submitted documents on behalf of others without the proper authority or qualifications
 - Terminated proceedings in over 52,000 applications and reopened registrations

In re Stelcore Mgmt. Servs., LLC, et. al.

- Stelcore, through its related companies and officers, admitted to preparation of U.S. trademark-related submissions on behalf of others and routinely entering the signatures of others – including a U.S.-licensed attorney.
- The requirement for personally-entered signatures has been in place for more than 20 years.
- The averments in trademark submissions support material facts, and the identity of the signatory determines the effect of the document.
 - “It necessarily harms the registration process when submissions are not personally signed by the named signatory.”
- Providing improper signatures with intent to circumvent USPTO rules is not a curable defect.

In re Shenzhen Seller Growth Network Technology Co., Ltd., et al.

- On August 6, 2025, the USPTO issued sanctions against a foreign filing firm and terminated proceedings in over 52,000 applications and registrations connected to the firm.
- The filing firm submitted documents on behalf of others without the proper authority or qualifications to do so. They attempted to conceal this by:
 - Seeking out the cooperation of U.S.-licensed attorneys and then misused their credentials and faked their electronic signatures;
 - Repeatedly signed documents using other people's names;
 - Submitting fake specimens of use; and
 - Misusing USPTO.gov accounts.
- OED issued six Final Orders to complicit attorneys that described the filing firm's practice of improperly entering the names and signatures of U.S.-licensed attorneys and using their bar credentials to conceal their direct prosecution of applications before the USPTO.

Discussion topic

Misconduct

Sponsored account violations

- Attorney is “hired” by a firm or trademark filing business.
- Attorney is asked to sponsor accounts for individuals they may or may not supervise.
- Accounts used to file submissions, sometimes without knowledge or consent of attorney.
- Sponsored accounts may continue to be used even after arrangement has ended.



Sponsored account violations (cont'd)

- *In re Worley*, USPTO Aug. 14, 2025
 - New York-licensed attorney reprimanded for sponsoring USPTO.gov accounts for unauthorized individuals.
- *In re Okeke*, USPTO Jan. 06, 2025
 - Texas-licensed attorney briefly suspended for, *inter alia*, sponsoring USPTO.gov accounts for non-practitioner assistants in violation of the user agreement.



Avoiding violations of the Sponsored Account Agreement

- Follow the rules as set forth in the account agreement.
 - Make sure you are allowed to sponsor individuals under the Agreement.
 - Supervise users you are sponsoring.
 - Remove sponsorships if you are unable or no longer supervising users.



Foreign “cooperation” requests

----- Forwarded message -----

From: [REDACTED]
Date: Sun, [REDACTED]
Subject: Find a partner for a trademark application
To: [REDACTED]

Foreign agents and attorneys often refer work to U.S. attorneys as “local counsel,” not “a partner”

Dear,

My name is [REDACTED]. We are China [REDACTED] company. We help Chinese customers register US trademarks due to policy changes. We are now looking for a partner to use their US federal attorney license and mailing address. We can sign a confidentiality agreement and pay a reasonable fee for use. The above information is only used on [REDACTED] registered US trademarks. If there are other uses, the lawyer will be informed in advance and the corresponding fees will be paid. We will keep [REDACTED] lawyer's information confidential and will pay liquidated damages if it defaults.

If you are interested, please contact

Email: [REDACTED]

Wechat/Phone: [REDACTED]

This is our company's Web site : [REDACTED]

It is unethical for an attorney to permit others to “borrow” or “rent” a license to practice law in the manner suggested here.

Attorneys are held to the ethical and professional standards of their own states, as well as the USPTO's Rules of Professional Conduct (37 C.F.R. §§ 11.100 *et seq.*).

Non-attorney support staff, working under the direct supervision of an attorney, may *assist* the attorney in practicing before the USPTO in trademark matters, but an attorney may not sponsor USPTO.gov accounts for foreign counsel or allow unlicensed individuals to practice law. Doing so violates USPTO.gov account agreements and may also violate relevant professionalism rules.

Filing mill/U.S. counsel violations

- Legal services or legal work often advertised on “gig work” sites or via direct email correspondence.
- Attorneys are often paid per submission.
- Volume of work can lead to failure to conduct a thorough and reasonable inquiry under 37 CFR 11.18 (see, e.g., *In re Koh*, USPTO Feb. 7, 2024).
- Applicants may have been targeted by scammers, and attorneys may be unwittingly complicit (see, e.g., *In re Toledano*, USPTO Sept. 3, 2025).



Avoiding filing mill/U.S. counsel violations

- Do your research!
 - Know who you are doing business with.
 - Use the Trademark Decisions and Proceedings search tool.
- Monitor the use of your name and bar number using the Trademark Search tool.
- Remember that you have ethical obligations to your **clients** who are the **applicants**.

Discussion topic

Tips and takeaways

Protecting yourself: USPTO.gov

- **ID Verification:**
 - Use your own email address.
 - If you have verified an account using an email address not under your control, contact the USPTO and ID.me.
- **Know the rules for sponsoring accounts.**
 - Remove sponsorship immediately if support staff are no longer under your direction.
- **Report account security concerns and change your password immediately.**



Protecting yourself: unauthorized use of attorney credentials

- Regularly monitor the use of your name and bar number using the Trademark Search tool.
- Beware of “cooperation” solicitations.
- Beware of unauthorized use of your name, bar number, and/or law firm name on USPTO submissions.
 - Report to USPTO immediately via TMScams@uspto.gov.
- Ethics questions?
 - Contact OED via OED@uspto.gov.



Protecting your clients from scams

- Correspondence about applications/registrations will be directed to you, not your client.
- USPTO employees will not ask them to provide payment information.
- Verify fees and deadlines.
- Be wary if you receive a communication requiring immediate action.
- Questions about a document or communication?
 - Contact TAC (attorneys can contact TAC too!).
- Has your client been directed to a scam webpage via an ad?
 - If so, consider reporting the ad.



If your client is scammed

- Remember the big 5:
 - Report financial scams to your bank.
 - Submit a fraud complaint to the Federal Trade Commission (FTC).
 - File a complaint with the Internet Crime Complaint Center (IC3).
 - Contact your local attorney general.
 - Report phone scams to the Federal Communications Commission (FCC).

If your client is scammed (cont'd)

- Review the record carefully and discuss the scam with the client.
 - If the applications or other submissions contain fake information, false signatures, or fictitious specimens of use, consider counseling the client to refile the application quickly.
 - False declarations or verifications are particularly concerning because they are often non-correctable.
- You can inform the USPTO about the scam by contacting TMScams@uspto.gov.



What the USPTO is doing about scams

- Where appropriate we:
 - Warn the public about the scams with the goal of preventing others from being scammed.
 - Issue sanctions directed at trademark submissions that violate USPTO rules (e.g., fraudulent signatures).
 - Take measures to protect our own intellectual property and work to address fraud with other agencies and private entities, when appropriate.
- Keep in mind:
 - The USPTO is not a law enforcement agency.
 - The USPTO cannot provide financial relief or restitution when money is paid to a scammer.



Resources

- Monitor use of your name and bar number.
 - www.uspto.gov/SearchTrademarks
- FOIA Reading Room for OED decisions
 - <https://foiadocuments.uspto.gov/oed/>
- Trademark sanctions orders
 - <https://developer.uspto.gov/tm-decisions/search/administrative>
- Learn more about trademark scams.
 - www.uspto.gov/trademarks/protect



Resources (cont'd)

- Ethical questions and practitioner bad behavior
 - OED@uspto.gov
- Report a trademark scam
 - TMScams@uspto.gov
- Report fraud to the Federal Trade Commission
 - <https://reportfraud.ftc.gov/#/?orgcode=USPTO>
- Report internet crime to the FBI
 - <https://complaint.ic3.gov>

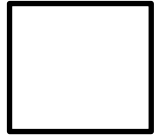


Questions?

Discussion topic

Hypotheticals

Authority to sign: hypothetical #1



- A partner at a boutique IP firm submits a trademark application on behalf of a corporation, identifying herself as the attorney of record and additionally appointing her two law partners by name.
- The firm later hires a new associate, who takes on this matter and submits a Response to Office action, signing his own name as "Attorney of Record."
- Is this properly signed?

Authority to sign: hypothetical #1



- **Yes.** While ideally the firm will file a CAR form to update the primary attorney responsible for the matter, the USPTO will accept the signature of another qualified attorney purporting to work for the same firm. *See* TMEP §712.03.



Authority to sign: hypothetical #2



- The same associate completes a Response to Office action for the firm's biggest client.
- He leaves for the day, but forgets to submit the document.
- His paralegal assistant calls to remind him about the submission, so he directs her to file the response and just enter his name in the signature field.
- Is this permissible and ethical?



Authority to sign: hypothetical #2



- **No.** All trademark submissions must be **personally** signed by the named signatory.
- The attorney is responsible for the conduct of supervised support staff.
- A pattern of similar behavior could subject the attorney to discipline, and could impact whether the USPTO will accept the submissions.



Authority to sign: hypothetical #3



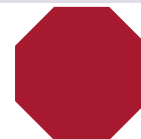
- The law firm has been contacted by a company in another country where trademark representatives must be licensed, but are not attorneys.
- The foreign entity has 200 trademark clients who wish to file in the United States, and the entity is willing to pay the firm \$20 per application.
- The foreign entity is willing to counsel their own clients and prepare all the submissions, and suggests the law firm create a sponsored support account at USPTO.gov to permit the foreign entity to do so.
- The foreign entity will send final applications for attorney signature via the email electronic signature feature.
- Is this permissible and ethical?



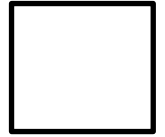
Authority to sign: hypothetical #3



- **No.**
- The law firm is violating the USPTO.gov account agreement by sponsoring support staff who are not actually employed or retained by the firm.
- The firm is likely aiding in the unauthorized practice of law by giving the foreign entity the means to engage in “practice before the Office.”
- The attorney may be reviewing the applications, but the attorney likely has no reasonable basis upon which to make the necessary averments in the application.
- The firm may also be engaging in improper fee-splitting, and may not be properly representing the interests of the **clients** (i.e. the applicants).



Authority to sign: hypothetical #4



- Tom Smith, an individual domiciled in Connecticut submits his own application *pro se*.
- After receiving a complicated-looking office action, he asks his attorney-niece, Anne Atorney, to take a look. She is a criminal defense attorney admitted only in Maine.
- Ms. Atorney reviews the record and realizes the issues are very straightforward. Despite unfamiliarity with the USPTO Rules, she fills out the response but fails to check off the box to indicate a new attorney is appearing.
- No declaration is required, but on the signature box she personally enters her name and identifies her as “applicant’s attorney.”
- Is this properly signed under the Trademark Rules of Practice?



Authority to sign: hypothetical #4



- **Yes.** Ms. Atorney is an attorney admitted to practice by the highest court of a U.S. jurisdiction, and is therefore authorized to practice before the USPTO in trademark matters. Her signature is sufficient to be recognized as the attorney of record under 37 C.F.R. §2.17(b)(1)(ii).
- However, she will draw a new Office action. Attorney bar information is required, when a new attorney appears. *See* 37 C.F.R. §2.17(b)(3). She could have avoided this if she had been more familiar with USPTO forms.



Authority to sign: hypothetical #5



- Longtime corporate counsel, Al Oyer, signs and submits a trademark application for his company, a domestic corporation. He does not enter his name or bar information in the attorney fields, but signs the application using the title “general counsel.”
- An Office action is issued, raising several issues which Mr. Oyer is not prepared to address, so he refers the matter to outside counsel.
- A new attorney, Noah Little of Outside Counsel LLP, files a response with several amendments to the application.
- Is this permissible?

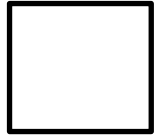
Authority to sign: hypothetical #5



- **No.** Al Oyer signed the application as “general counsel,” which will be presumed to identify him as an attorney. Assuming he is admitted to the bar of the highest court of a state, he is the primary attorney of record because his signature on the initial application is enough to recognize him. See 37 C.F.R. §2.17(b)(1)(ii).
- Noah Little cannot sign the response unless either appointed by someone with legal authority to bind the corporation, or is granted an associate power of attorney **in the record** by Mr. Oyer.



Authority to sign: hypothetical #6

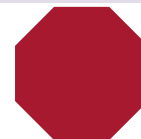


- After issuance of a 30-day non-responsive amendment noting the improper change of attorney, Mr. Little prepares a Change of Address or Representation (CAR) form, appointing himself the new attorney of record. He sends it to Ms. Jones, the corporation's Vice-President for her electronic signature.
- Mr. Little is recognized and submits a new response, but the examining attorney finds it unpersuasive and she issues a second Office action.
- The corporation decides to handle the second response in-house, and submits a new CAR form appointing their new in-house trademark counsel as the attorney of record. Mr. Oyer signs the CAR form as the corporation's "general counsel."
- Is this permissible?

Authority to sign: hypothetical #6



- **No.** A revocation of power of attorney must be signed by a corporate officer, and the title of “General Counsel” is **not** presumed to identify an officer.
- Mr. Oyer does not have apparent authority to bind the corporation in this way and cannot appoint new counsel.
- **If** Mr. Oyer is also an officer, he could have signed with an officer title (e.g., “Chief Legal Officer”).
- Mr. Oyer could have also used the email option to have an officer at the company sign instead.



Questions?



Thank you!

OED@uspto.gov

TMPolicy@uspto.gov

TMScams@uspto.gov

www.uspto.gov