

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

In the Matter of:

Mark S. Graham

Respondent

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Proceeding No. D2022-13

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.24

Pursuant to 37 C.F.R. § 11.24, Mark S. Graham (“Respondent”) is hereby suspended for three years from the practice of patent, trademark and other non-patent law before the United States Patent and Trademark Office (“USPTO” or “Office”) for violation of 37 C.F.R. § 11.804(h).

Background

On June 8, 2022, a “Notice and Order Pursuant to 37 C.F.R. § 11.24” (“Notice and Order”) was sent by both certified mail (receipt nos. 70220410000250012628 and 70220410000250012611) and by first-class mail notifying Respondent that the Director of the Office of Enrollment and Discipline (“OED Director”) had filed a “Complaint for Reciprocal Discipline Pursuant to 37 C.F.R. § 11.24” (“Complaint”) requesting that the Director of the United States Patent and Trademark Office impose reciprocal discipline upon Respondent identical to the discipline imposed by the February 11, 2021 Order of the of the Supreme Court of Tennessee in *In re Mark Steven Graham*, BPR #011505, No. M2021-00148-SC-BAR-BP, suspending Respondent from the practice of law in that jurisdiction based on ethical grounds for three years with an active suspension for one year and probation for the remaining period of suspension. The Notice and Order provided

Respondent an opportunity to file, within forty (40) days, a response opposing the imposition of reciprocal discipline identical to that imposed by the February 11, 2021 Order of the of the Supreme Court of Tennessee in *In re Mark Steven Graham*, BPR #011505, No. M2021-00148-SC-BAR-BP, based on one or more of the reasons provided in 37 C.F.R. § 11.24(d)(1).

The Notice and Order was delivered to Respondent on June 13, 2022. Respondent has not filed a response to the Notice and Order.

Analysis

In light of Respondent's failure to file a response, it is hereby determined that there is no genuine issue of material fact under 37 C.F.R. § 11.24(d) and Respondent's suspension from the practice of patent, trademark, and other non-patent matters before the USPTO is the appropriate discipline.

ACCORDINGLY, it is hereby **ORDERED** that:

1. Respondent is suspended for three (3) years from the practice of patent, trademark, and other non-patent matters before the USPTO, commencing on the date of this Final Order;
2. Respondent shall remain excluded from the practice of patent, trademark, and other non-patent law before the USPTO until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60;
3. Respondent shall be eligible to file a petition requesting reinstatement to practice before the Office twelve (12) months after the effective the date of the Final Order;
4. Respondent shall serve a probationary period commencing on the date the Final Order is signed and continuing for twenty-four (24) months after the date on which the OED

Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60;

5. Discipline shall not be imposed *nunc pro tunc*;

6. The OED Director shall electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at: <http://foiadocuments.uspto.gov>;

7. (1) In the event the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Final Order, or any disciplinary rule of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director should not order that Respondent be immediately suspended for up to an additional twenty-four (24) months;

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

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

(2) In the event that after the 15-day period for response and after the 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 Final Order, or any disciplinary rule of 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 Final Order, or any disciplinary rule of the USPTO Rules of Professional Conduct during the probationary period; and

(B) request that the USPTO Director immediately suspend Respondent for up to an additional twenty-four (24) months;

8. Nothing herein shall prevent the OED Director from seeking discrete discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the paragraph 7, above;

9. In the event the USPTO Director suspends Respondent pursuant to paragraph 7, 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;

10. The OED Director publish a Notice in the *Official Gazette* materially consistent with the following:

Notice of Suspension and Probation

This notice concerns Mark S. Graham of Knoxville, Tennessee, who is a registered patent attorney (Registration Number 32,355). In a reciprocal disciplinary proceeding, the Director of the United States Patent and Trademark Office ("USPTO") has ordered that Mr. Graham (a) be suspended for three years from practice before the USPTO in patent, trademark, and other non-patent matters for violating 37 C.F.R. § 11.804(h) predicated upon being suspended from the practice of law by a duly constituted authority of a State and (b) Mr. Graham be placed on probation. Mr. Graham may seek reinstatement after serving one year of his suspension. He is also required to serve a probationary period commencing on the date the Final Order is signed and continuing for twenty-four (24) months after the date on which the OED Director grants a petition seeking Mr. Graham's reinstatement.

The Supreme Court of Tennessee disciplined Mr. Graham on ethical grounds predicated on the following facts: (a) Mr. Graham represented a company involved in intellectual property litigation in the United States, (b) the company retained an expert witness, (c) the client sent funds to Mr. Graham for payment of the expert witness fees, (d) Mr. Graham failed to pay the expert as agreed, and (e) Mr. Graham used a portion of the funds to pay his outstanding attorney fees. Procedurally, first, on March 11, 2020, in *In re Mark Steven Graham, BPR #011505* (Case No. M2020-000398-SC-BAR-BP), the Supreme Court of Tennessee temporarily suspended Respondent from the practice of law in Tennessee pursuant to Tenn. Sup. Ct. R. 9, § 12.3. Second, on October 2, 2020, in *In re Mark Steven Graham, BPR #011505* (Case No. M2020-000398-SC-BAR-BP), the Supreme Court of Tennessee denied Respondent's request for dissolution of his temporary suspension from practice of law in Tennessee. Third, on February 11, 2021, the Supreme Court of Tennessee suspended Respondent for three years, retroactive to the date of his temporary suspension on March 11, 2020, pursuant to Tennessee Supreme Court, Rule 9, § 12.2(b) for misappropriating client funds in violation of Tennessee Rules of Professional Conduct 1.15(a), (b) and (d), and 8.4(a) and (c).

This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. § 11.24. Disciplinary decisions are available for public review at the Office of Enrollment and Discipline's FOIA Reading Room, located at: <https://foiadocuments.uspto.gov/oed/>;

11. The OED Director give notice pursuant to 37 C.F.R. § 11.59 of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s) where Respondent is admitted to practice, to courts where Respondent is known to be admitted, and to the public;

12. Respondent shall comply with the duties enumerated in 37 C.F.R. § 11.58; and

13. The USPTO shall dissociate Respondent's name from any Customer Number(s) and USPTO verified Electronic System account(s), if any.

Users, Oettinger,
Nicolas

Digitally signed by Users,
Oettinger, Nicolas
Date: 2022.08.12 16:25:00 -04'00'

Date

Nicolas Oettinger
Acting Deputy General Counsel
Office of General Law
United States Patent and Trademark Office

on delegated authority by

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