

# **Professional responsibility and practice before the USPTO**

Office of Enrollment and Discipline  
(OED)



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# OED: enrollment

- Authorization to practice before the USPTO in patent matters:
  - Attorneys, agents, limited recognition.
- 3 factors for registration:
  - Scientific and technical qualifications;
  - Legal competence: registration exam; and
  - Moral character.

*See 37 C.F.R. § 11.7 and General Requirements Bulletin.*



# Practice before the USPTO and Artificial Intelligence (AI)

- On April 11, 2024, the USPTO issued a Federal Register notice, Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office. See <https://www.federalregister.gov/documents/2024/04/11/2024-07629/guidance-on-use-of-artificial-intelligence-based-tools-in-practice-before-the-united-states-patent>.
- When practicing before the USPTO, practitioners' use of AI may implicate ethical considerations.
- 37 C.F.R. § 11.18 imposes duties on parties and practitioners in connection with submissions before the USPTO, including the practitioner's signature pursuant to 37 C.F.R. §§ 1.4(d)(1), 2.193.
- 37 C.F.R. § 11.18(b), in part, stipulates that parties presenting papers to the Office make a certification, formed after a reasonable inquiry, as to evidentiary support for factual contentions and allegations.
- See <https://www.uspto.gov/initiatives/artificial-intelligence/artificial-intelligence-resources>.



# Practice before the USPTO

- Activities that constitute practice before the USPTO are broadly defined in 37 C.F.R. §§ 11.5(b) and 11.14:
  - Includes communicating with and advising a client concerning matters pending or contemplated to be presented before the USPTO (37 C.F.R. § 11.5(b));
  - Consulting with or giving advice to a client in contemplation of filing a **patent application** or other document with the USPTO (37 C.F.R. § 11.5(b)(1)); or
  - Consulting with or giving advice to a client in contemplation of filing a **trademark application** or other document with the USPTO (37 C.F.R. § 11.5(b)(2)).
  - Nothing in this section (37 C.F.R. § 11.5(b)) proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the USPTO.
  - *See also* 37 C.F.R. § 11.14 for details regarding individuals who may practice before the USPTO in trademark and other non-patent matters.



# OED: discipline

- Mission: protect the public and the integrity of the patent and trademark systems.
- 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, *e.g.*, TM, pro hac vice in PTAB, those representing others in OED proceedings, etc.; and
  - 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; and
  - Procedural rules: 37 C.F.R. §§ 11.19-11.60.



# Investigation and formal complaint process

- OED investigation begins with receipt of a grievance by the OED Director.
  - Grievance: a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner. *See* 37 C.F.R. § 11.1.
  - Self-reporting is often considered as a mitigating factor in the disciplinary process.
- Time period for filing formal complaint = 1 year from receipt of grievance but not later than 10 years from date of misconduct.
  - *See* 35 U.S.C. § 32 and 37 C.F.R. § 11.34(d).
- After investigation, the OED Director may:
  - Terminate an investigation with no action;
  - Issue a warning to the practitioner;
  - Institute formal charges with the approval of the Committee on Discipline; or
  - Enter into a settlement agreement with the practitioner and submit the same to the USPTO Director for approval.

37 C.F.R. § 11.22(h).



# USPTO disciplinary proceedings

- Referral to the Committee on Discipline (COD)
  - OED presents the results of investigation to the COD
  - COD determines if probable cause of misconduct exists
- If probable cause is found, the Solicitor's Office, representing the OED Director, files formal complaint with hearing officer
  - Hearing officer issues an initial decision; and
  - Either party may appeal initial decision to USPTO Director, otherwise it becomes the final decision of the USPTO Director.

*See* 37 C.F.R. §§ 11.22, 11.23, 11.32, 11.34, 11.40, 11.54 and 11.55.

# Warnings – 37 C.F.R. § 11.21

“A warning is neither public nor a disciplinary sanction. The OED Director may conclude an investigation with the issuance of a warning. The warning shall contain a statement of facts and identify the USPTO Rules of Professional Conduct relevant to the facts.”

- A warning will not be an option if a formal complaint has been filed with a hearing officer.



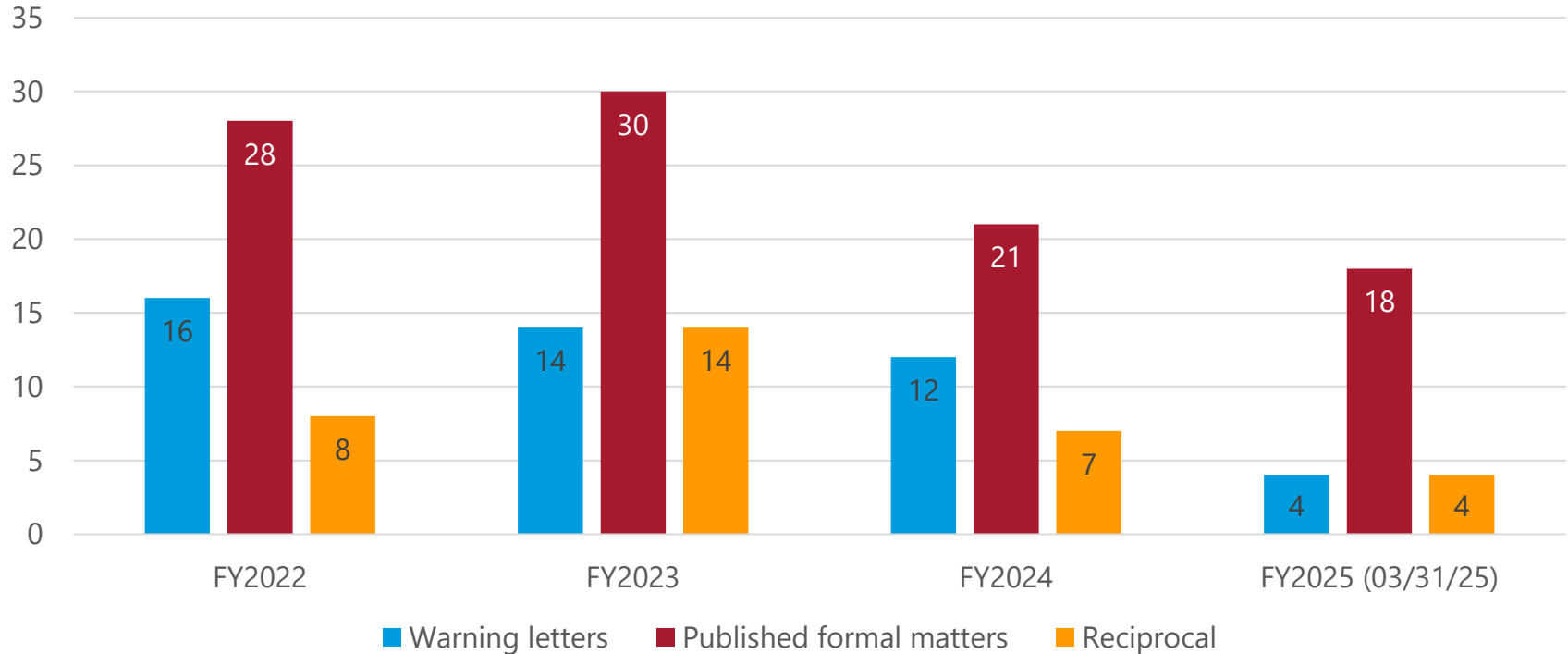
# Disciplinary sanctions -37 C.F.R. § 11.20

- Exclusion from practice before the USPTO
  - Minimum of five years. *See* 37 C.F.R. § 11.60(b)
  - Reinstatement only upon grant of petition. *See* 37 C.F.R. §§ 11.58(a), 11.60(a)
- Suspension from practice before the USPTO for an appropriate period
  - Reinstatement only upon grant of petition upon expiration of suspension period. *See id.*
- Reprimand or censure
- Probation (in lieu of or in addition to other sanctions)
- Possible conditions

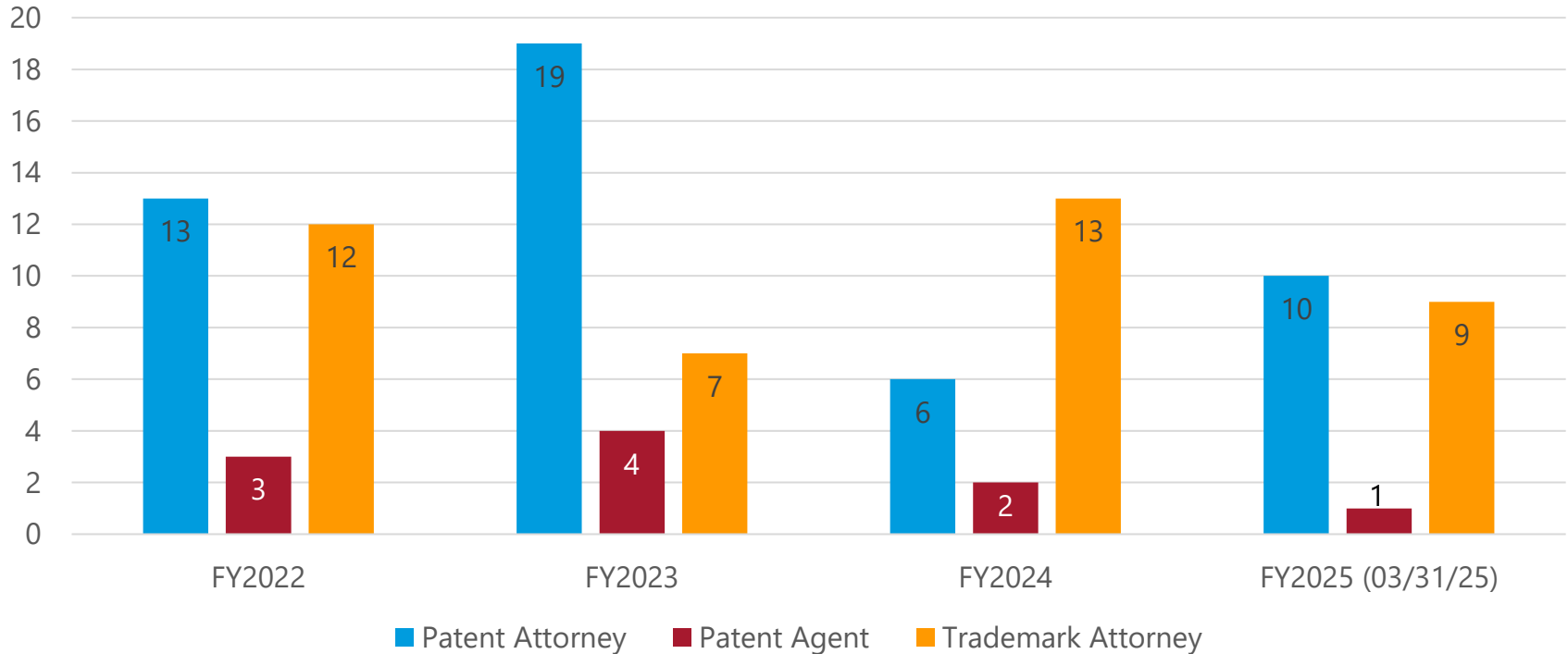
# Other types of discipline

- Reciprocal discipline (37 C.F.R. § 11.24):
  - Based on discipline by a state or federal program or agency, and
  - Often conducted on documentary record only
- Interim suspension based on conviction of a serious crime (37 C.F.R. § 11.25):
  - Referred to a hearing officer for determination of final disciplinary action
- Exclusion on Consent (37 C.F.R. § 11.27)

# USPTO Disciplinary Matters

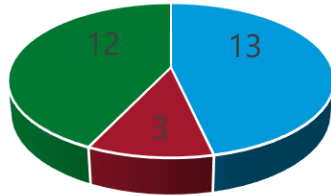


# USPTO Practitioner Breakdown

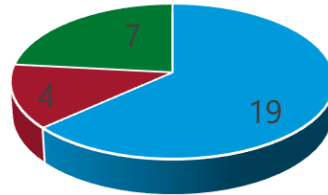


# USPTO Disciplinary Matters

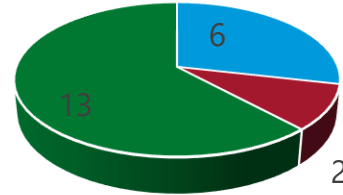
FY 2022



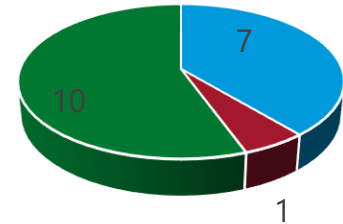
FY 2023



FY 2024



FY 2025



- Patent Attorneys
- Patent Agents
- Trademark Attorneys

OED

# **Ethics scenarios and select case law**

# OED: Examples of misconduct

- Neglect of client matters;
- Failure to communicate with the client;
- Lying to the client;
- Lack of candor to the USPTO;
- Conflicts of interest;
- Unauthorized practice of law;
- Duty of disclosure, candor and good faith; and
- Fee and trust account issues.



# Conflict of interest

- *In re Radanovic*, Proceeding No. D2014-29 (USPTO December 16, 2014)
  - Patent attorney:
    - Represented two joint inventors of patent application;
    - No written agreement regarding representation;
    - Attorney became aware of a dispute where one inventor alleged that the other did not contribute to the allowed claims;
    - Continued to represent both inventors; and
    - Expressly abandoned application naming both inventors in favor of continuation naming one.
  - Mitigating factors included clean 50-year disciplinary history.
  - Received public reprimand.



# Conduct Prejudicial to the Administration of Justice

*In re Jie Yang*, Proceeding No. D2024-04 (USPTO Feb 2, 2024)

- Registered patent agent was practitioner of record in approximately 4000 patent applications, many of which contained false assertions of micro-entity status under 37 C.F.R. § 1.29(a)(2).
- Yang's electronic signature had been entered on filings without her knowledge or consent:
  - Yang entered into professional association with nonpractitioner.
  - Yang was unaware of filings prepared by nonpractitioner, did not review or file the documents, and had no contact with the applicants.
  - Nonpractitioner gained access to practitioner's USPTO.gov account, directed all notices to his own email, and changed the password to the account.



# Conduct Prejudicial to the Administration of Justice, *cont'd*

## – **Applicable regulations:**

- A patent document must be signed by the named signatory per 37 C.F.R. § 1.4(d)(4)(ii).
- A party presenting or signing a paper to the USPTO represents that all statements are true per the certification requirements of 37 C.F.R. § 11.18. A certification violation in a paper filed with the USPTO “may jeopardize the probative value” of the filing. 37 C.F.R. § 11.18(b)(1).
- § 11.804(d) prohibits conduct prejudicial to the administration of justice.

## – **Mitigating factors:**

- Practitioner co-operated fully with OED and had no prior discipline.
- Practitioner notified the affected applicants or their representatives of these acts.

## – **Sanction and Outcome:**

- Practitioner received a public reprimand and 12 months’ probation.
- Final order terminating proceedings in approximately 3100 applications with fraudulent signatures (*In re Application of [Redacted], et al.*, Final Order and Imposition of Sanctions, Oct. 1, 2024).



# Competence, meritorious claim, misrepresentation

## ***In the Matter of Anthony Matos, Proceeding No. D2025-13 (USPTO March 6, 2025)***

- Mr. Matos represented a mark owner before the TTAB as the defendant in a cancellation proceeding.
- The TTAB noted seven instances in which Mr. Matos improperly cited cases in a brief:
  - Cited and quoted a TTAB decision for a specific point, though the case contained no discussion on that point and the quotation did not appear in the decision;
  - Cited a TTAB decision which did not contain any discussion of the point for which it was cited;
  - Cited three purported TTAB decisions which did not exist;
  - Cited to a well-known Federal court decision, though the decision did not discuss the point for which it was cited;
  - Cited to a Federal court decision using an erroneous reporter citation, when the decision had “nothing to do with the issue for which it [was] cited.”

# Competence, meritorious claim, misrepresentation, cont'd

## – **Applicable regulations:**

- A practitioner shall provide competent representation per 37 C.F.R. 11.101;
- A party shall not present legal contentions that were not warranted by existing law per 37 C.F.R. 11.301;
- Presenting non-existent case law to the TTAB is in violation of 37 C.F.R. 11.804(c); and
- A party presenting or signing a paper to the USPTO represents that all statements are true per the certification requirements of 37 C.F.R. 11.18. See 37 C.F.R. 11.804(d).

## – **Mitigating factors:**

- Practitioner co-operated fully with OED and had no prior discipline.
- Practitioner acknowledged his ethical lapses; accepted responsibility; and showed contrition.

## – **Sanctions**

- Practitioner received a public reprimand; and
- Practitioner was required to complete CLE related to the use of generative AI.



# Inequitable conduct

***In the Matter of Robert Tendler, Proceeding No. D2013-17 (USPTO Jan. 8, 2014)***

- Patent attorney filed Rule 131 declaration re: reduction to practice with USPTO.
- Soon after, attorney learned that the inventor did not review the declaration and that declaration contained inaccurate information.
- Respondent did not advise the Office in writing of the inaccurate information and did not fully correct the record in writing.
- District court held resultant patent unenforceable due to inequitable conduct, in part, because of false declaration. *Intellect Wireless v. HTC Corp.*, 910 F. Supp. 1056 (N.D. Ill. 2012). Federal Circuit upheld.
  - First requirement is to expressly advise the USPTO of existence of misrepresentation, stating specifically where it resides.



# Inequitable conduct

***In the Matter of Robert Tendler, Proceeding No. D2013-17 (USPTO Jan. 8, 2014), cont'd***

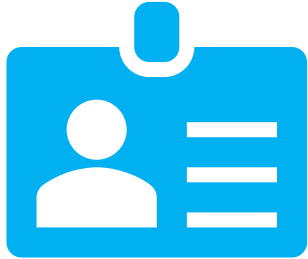
- Second requirement is that the USPTO be advised of misrepresented facts, making it clear that further examination may be required if USPTO action may be based on the misrepresentation.
- It does not suffice to merely supply the Office with accurate facts without calling attention to the misrepresentation.
- Settlement: Four-year suspension (eligible for reinstatement after two years).

# Candor toward tribunal

## ***In the Matter of James Hicks, Proceeding No. D2013-11 (USPTO Sept. 10, 2013)***

- Attorney sanctioned by EDNY for non-compliance with discovery orders.
- Federal Circuit affirmed sanction and found appellate brief to contain “misleading or improper” statements.
  - Brief reads, “Both the Magistrate and the District Court Found that RTI's and its Litigation Counsel Hicks' Pre-Filing Investigation Was Sufficient.” However, neither the magistrate judge nor the district court ultimately found that RTI's or Mr. Hicks's pre-filing investigation was “sufficient.”
  - Mr. Hicks also failed to inform the court that a case citation was non-precedential and therefore unavailable to support his legal contentions aside from “claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like.”
  - *Rates Technology, Inc. v Mediatix Telecom, Inc.*, 688 F.3d 742 (Fed. Cir. 2012)
- Settlement: public reprimand and one-year probation.





# U.S. Counsel Rule



# OED and the U.S. Counsel Rule

- Increase in foreign parties not authorized to represent trademark applicants and improperly representing foreign applicants in trademark (TM) matters.
- Foreign-domiciled trademark applicants or registrants must be represented before the USPTO by an attorney who is licensed to practice law in the United States. See 37 C.F.R. § 2.11(a); Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 Fed. Reg. 31498 (July 2, 2019) (“the U.S. Counsel Rule”).
- Reasons for the U.S. Counsel Rule:
  - Fraudulent or digitally altered specimens;
  - Inaccurate dates of use;
  - Use not in commerce;
  - Goods listed in class(es); and
  - Violation of signature rules.



# U.S. Counsel Rule – solicitation

Dear,

I would like to rent a U.S. lawyer's license or get granted to use your U.S. attorney licensed information. At same time, I pay you yearly fee.

If you are interested in it and want to discuss more, you can contact me.

-----

Regards,  
Francis

# U.S. Counsel Rule Decisions

- **Yiheng Lou, Proceeding No. D2021-04 (USPTO May 12, 2021)**
  - NY-licensed attorney contracted with Chinese IP firm (5/12/2021)
- **Devasena Reddy, Proceeding No. D2021-13 (USPTO Sept. 9, 2021)**
  - CA-licensed attorney contracted with Indian TM filing firm (9/9/2021)
- **Bennett David, Proceeding No. D2021-8 (USPTO Sept. 24, 2021)**
  - Patent attorney and MA-licensed attorney contracted with Chinese IP firm (9/24/2021)
- **Di Li, Proceeding No. D2021-16 (USPTO Oct. 7, 2021)**
  - CA-licensed attorney contracted with Chinese firm that consults with online retailers (10/7/2021)
- **Tony Hom, Proceeding No. D2021-10 (USPTO Dec. 17, 2021)**
  - NY-licensed attorney contracted with several different Chinese firms (12/17/2021)



# U.S. Counsel Rule Decisions

- **Jonathan Morton, Proceeding No. D2022-07 (USPTO Apr. 20, 2022)**
  - NY-licensed attorney contracted with foreign entities
- **Kathy Hao, Proceeding No. D2021-14 (USPTO Apr. 27, 2022)**
  - California licensed attorney contracted with several foreign entities
- **Weibo Zhang, Proceeding No. D2022-16 (USPTO July 11, 2022)**
  - NY licensed attorney contracted with several foreign entities
- **Elizabeth Yang, Proceeding No. D2021-11 (USPTO Dec. 17, 2021)**
  - CA-licensed attorney contracted with foreign firm serving online retailers
- **Zhihua Han, Proceeding No. D2022-23 (USPTO Jan. 09, 2023)**
  - WA-licensed attorney contracted with several foreign firms to file both trademark and patent applications



# U.S. Counsel Rule Decisions

- **Daoyou T. Liu, Proceeding No. D2022-03 (USPTO Aug. 9, 2022)**
  - TX-licensed attorney contracted with foreign entities
- **Yi Wan, Proceeding No. D2022-04 (USPTO Apr. 11, 2022)**
  - NY-licensed attorney contracted with several foreign entities
- **Jingfeng Song, Proceeding No. D2023-10 (USPTO May 4, 2023)**
  - IL-licensed attorney contracted with a foreign entity
- **Kevin R. Gallagher, Proceeding No. D2023-28 (USPTO June 23, 2023)**
  - NJ and PA-licensed attorney contracted with two foreign entities
- **Yue Niu, Proceeding No. 2023-32 (USPTO Jan 3, 2024)**
  - NY and CA-licensed attorney contracted with two foreign entities

# U.S. Counsel Rule Decisions

- **Puja Jabbour, Proceeding No. D2023-33 (USPTO Sept 6, 2023)**
  - GA-licensed attorney contracted with foreign entity
- **Grace Lee Huang, Proceeding No. D2023-37 (USPTO Jan 8, 2024)**
  - MO-licensed attorney contracted with foreign entity
- **Jing Wang, Proceeding No. D2023-38 (USPTO Nov 21, 2023)**
  - CA-licensed attorney contracted with two foreign entities
- **Jie Yang, Proceeding No. D2024-04 (USPTO Feb 2, 2024)**
  - IL-licensed attorney contracted with foreign entity
- **Francis Koh, Proceeding No. D2024-07 (USPTO Feb 7, 2024)**
  - D.C., VA, and MD-licensed attorney contracted with several foreign entities

# U.S. Counsel Rule Decisions

- **Che-Yang Chen, Proceeding No. D2024-01 (USPTO Mar 20, 2024)**
  - D.C.-licensed attorney contracted with several foreign entities
- **Julius A. Haffner, Proceeding No. D2023-35 (USPTO May 21, 2024)**
  - MD-licensed attorney contracted with foreign entity
- **Harrison Oldham, Proceeding No. D2024-11 (USPTO May 29, 2024)**
  - TX-licensed attorney operated a company where he was attorney of record for almost 1,800 filings for foreign-domiciled trademark applicants
- **Lan Yu, Proceeding No. D2024-24 (USPTO Aug 20, 2024)**
  - TX-licensed attorney allowed non-U.S. practitioner to forge his signature in filing nearly 7,000 trademark applications before the USPTO



# U.S. Counsel Rule Decisions

## – **Weitao Chen, Proceeding No. D2024-21 (USPTO Sep 11, 2024)**

- NY- and NJ-licensed attorney served as attorney of record in nearly 7,100 trademark applications on behalf of several foreign entities

## – **Jie Luo, Proceeding No. D2024-02 (USPTO Oct 25, 2024)**

- NY-licensed attorney was attorney of record for nearly 10,657 applications on behalf of several foreign entities

## – **Qinghe Liu, Proceeding No. D2023-39 (USPTO Nov 21, 2024)**

- NY-licensed attorney was attorney of record in over 1,000 applications on behalf of several foreign entities

## – **Angus F. Ni, Proceeding No. D2024-20 (USPTO Dec 19, 2024)**

- NY- and WA-licensed attorney allowed a foreign entity to sign his name on several trademark applications filed before the USPTO

## – **Afamefuna Okeke, Proceeding No. D2024-18 (USPTO Jan 6, 2025)**

- TX- and NY-licensed attorney served as attorney of record for trademark applications on behalf of foreign entities and allowed non-practitioners to access his USPTO.gov account and place his signature on filings before the USPTO





# Dealings with foreign entities

- *In the Matter of Tung-Yun McNally*, Proceeding No. D2023-22 (USPTO April 7, 2023)
  - Registered patent agent:
    - Submitted more than 688 design patent applications on behalf of applicants between Aug 2019 and Sept 2021.
    - USPTO issued a Notice of Payment Deficiency for 21 of these applications where Respondent signed, executed and submitted a Certification of Micro Entity Status.
    - Respondent signed certifications based upon representations made to her by a foreign associate for the applicants.
    - Except for one application, Respondent claimed she was not aware of the Notices of Deficiency, changes in certifications, or the payment of the deficiency amounts until she received communication from OED.



# Dealings with foreign entities, *cont'd*

- Respondent relied upon the foreign associate's representations, with whom Respondent's law firm had an existing relationship.
  - No firm procedures or guidelines were in place to personally verify the underlying basis for Certification of Micro Entity status.
- Mitigating factors:
- Respondent *sua sponte* investigated at least one filing made prior to receiving any communication from OED.
  - Worked with firm and foreign associate to implement new procedures for micro entity status certification and adopted law firm protocols to verify an applicant's claim of micro entity status.
  - No prior discipline and cooperation with OED's investigation.
- Reprimanded.



**37 C.F.R. § 1.3**

# Disreputable or gross misconduct

*In re Schroeder*, Proceeding No. D2014-08 (USPTO May 18, 2015):

- Patent attorney:
  - Submitted unprofessional remarks in two separate Office action responses;
  - Remarks were ultimately stricken from application files pursuant to 37 C.F.R. § 11.18(c)(1);
  - Order noted that behavior was outside of the ordinary standard of professional obligation and client's interests; and
  - Aggravating factor: did not accept responsibility or show remorse for remarks
- Default: 6-month suspension
- Rule highlights:
  - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct;
  - 37 C.F.R. § 10.89(c)(5) – Discourteous conduct before the Office;
  - 37 C.F.R. § 10.23(b)(5) – Conduct prejudicial to the administration of justice; and
  - 37 C.F.R. § 11.18 – Certification upon filing of papers



# USPTO discipline-related records

- Contact OED with questions:

Phone: 571-272-4097

Fax: 571-273-0074

Email: [OED@uspto.gov](mailto:OED@uspto.gov)

Postal Mail:

Mail Stop OED

U.S. PTO

P.O. Box 1450

Alexandria, VA 22313-1450

- Disciplinary Decisions may be found at:  
[foiadocuments.uspto.gov/oed](https://foiadocuments.uspto.gov/oed)





# Thank you!

[www.uspto.gov](http://www.uspto.gov)