



United States Patent and Trademark Office

Office of the Commissioner for Trademarks

January 29, 2018

Yang Guohua
Shenzhen YaYi Intellectual Property Agency Co., Ltd
Longhua New District
Weidonglong Technology Building 1331-1332
Shenzhen, Guangdong
CHINA 518109

VIA AIRMAIL

杨国华先生
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EXCLUSION ORDER

Dear Mr. Yang:

This letter is to inform you that, effective immediately, the United States Patent and Trademark Office (USPTO) is excluding you and your agency, Shenzhen YaYi Intellectual Property Agency Co., Ltd, from participating as an attorney, correspondent, domestic representative, or signatory in any trademark applications or registrations before the USPTO.

Summary of Prior Correspondence

In a show cause order dated November 15, 2016, the USPTO questioned your involvement in nearly 1,400 trademark applications or registrations. The order listed the relevant records and noted that the information available to the USPTO suggests that you are not a U.S. attorney and that you may be engaging in unauthorized practice of trademark law by preparing and filing documents with the USPTO in connection with trademark applications and registrations, or otherwise acting on behalf of others in matters before the USPTO.

Therefore, the order required you to show cause why the USPTO should not: (1) cease acceptance of any filings from you in trademark applications or registrations; (2) cease use of your contact information for correspondence purposes; and (3) prohibit participation by you as an attorney, correspondent, domestic representative, or signatory in any trademark applications or registrations before the USPTO.

The order stated that you must respond within 30 days of the date of the order and indicated that your response should include, for each case, evidence demonstrating the legitimacy of

designating you as attorney of record in the relevant applications and of using your correspondence information for purposes relating to trademark applications or registrations.

Your response to the show cause order, dated December 23, 2016, was provided to the USPTO in May 2017 via the consulate in Guangzhou. Your response included the following explanation, on unnumbered page 1, regarding your agency and your actions before the USPTO:

We provide International Trademark Consulting Services for our customers. All our customers have signed commission contracts with our company. After commission, [w]e prepare the trademark application materials including translating the goods from Chinese to US trademark Acceptable Identification of Goods & Services . . . and provide our company address for reception of certificates. [A]nd then we assist them to file the trademark application on-line themselves.

[W]e know only American or Canada attorney can do the filing. [S]o, we just provide consultation and let our customers do the filing on themselves. I attach some of the original contracts for your reference.

Although your explanation indicates that the applicants file the applications themselves, the service contracts that were submitted with your response indicate that you or others at your agency (referred to as Party B) perform the actual filings and submissions on behalf your clients (referred to as Party A).

The following is the English translation of the relevant contract provisions (emphasis added):

Contract for YXGOOD and for FAVOLOOK:

Section 3 具体事务 item 3:

*After Party B has accepted the commission, and after Party A has provided all the necessary information for filing an application, **Party B must submit application materials to trademark department, and provide updates on application developments within one business day.***

*Section 4: Over the course of trademark application, if there's a situation where there is a refusal or examination opinion (office action) from the government, Party B must notify Party A and is responsible for responding to the USPTO's office action. Once notified, Party A must provide the necessary information within the deadline to help **Party B submit the response.***

Contract for HOLYFIRE, under the section “附件条款” (Attachment provision):

*Upon receiving fees from Party A, Party B must within 2 business days **submit application to the overseas partnership organization or the relevant trademark registration department . . .***

Facts and Circumstances Support Exclusion

Under U.S. federal regulations, the only individuals who may represent an applicant or registrant in trademark matters before the USPTO, other than certain previously recognized trademark agents, are (1) attorneys who are licensed to practice in the United States or (2) Canadian agents or attorneys who are authorized by the USPTO to represent applicants located in Canada. *See* 37 C.F.R. §§ 2.17, 11.1, 11.14. Otherwise, foreign attorneys and non-attorneys are not recognized to practice before the USPTO in trademark matters and therefore may not perform any of the following actions:

1. Giving advice to an applicant or registrant in contemplation of filing a trademark application or application-related document;
2. Preparing or prosecuting an application, response, post-registration maintenance document, or other related document;
3. Signing amendments to applications, responses to Office actions, petitions to the Director, requests to change the correspondence address, or letters of express abandonment; or
4. Authorizing issuance of examiner's amendments and priority actions. *See* 37 C.F.R. §§ 11.5(b)(2), 11.14(b); *Trademark Manual of Examining Procedure* (TMEP) §§ 602.01, 608.01.

Based on a review of relevant application and registration records, the circumstances of your involvement with these applications and registrations, and the information you have provided, there is a sufficient and reasonable basis to conclude that you are not qualified to practice before the USPTO and thus have engaged in unauthorized practice before the USPTO by preparing, signing, and filing submissions in connection with trademark applications and registrations. *See* 37 C.F.R. § 11.5(b); TMEP § 608.01.

Specifically, over 1,400 applications and registrations, which belong to various entities and individuals other than you, have listed your name, mailing address, or an email address associated with you, for the purpose of correspondence. In addition, you have been designated as attorney of record in at least 56 application records. *See, e.g.*, U.S. Registration Nos. 4926899, 4926901, 4926909, and 4963034.

Furthermore, you and your agency appear to have submitted digitally rendered or altered specimens of use in some applications. *See, e.g.*, U.S. Application Serial Nos. 87012142, 87136144, 87232119, and 87203119. A digitally altered image or a mock-up of the intended depiction of the mark on the goods or their packaging is not an acceptable specimen because it does not show use of the mark in commerce. *See* TMEP § 904.04(a). Moreover, failure to provide an appropriate specimen can preclude registration of an applied-for trademark. *See* TMEP §904. The questionable nature of specimens that were submitted in some the filings you are associated with suggests an unfamiliarity with, or disregard for, U.S. trademark law, and

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could jeopardize the validity of any registrations that ultimately issue based on the affected applications.

In your response to the show cause order, and your other communications with the USPTO, you have not provided any explanation or evidence establishing that you are a qualified practitioner or demonstrating the legitimacy of designating you as attorney of record or using your correspondence information for purposes relating to trademark applications or registrations. None of the information currently available to the USPTO indicates that you are an attorney or are otherwise an authorized signatory of these trademark applicants and registrants as required by 37 C.F.R. § 2.193(e). *See* TMEP §§ 611.02, 611.03(a)–611.04.

However, as noted above, the sample contracts you provided in your response to the show cause order indicate that you are preparing and submitting to the USPTO trademark applications and Office action responses on behalf of others. In addition, a separate August 2017 letter to the Office of the Commissioner for Trademarks, requesting that the USPTO extend reciprocal recognition to allow the agency practice before the USPTO, indicated that your agency files trademark applications on behalf of Chinese applicants.

Decision

Under 35 U.S.C. § 3(b)(2)(A), the Commissioner for Trademarks possesses the authority to manage and direct all aspects of the activities of the USPTO that affect the administration of trademark operations. This includes the authority to exclude a person from conducting business in trademark matters before the USPTO, when appropriate. *See* 35 U.S.C. § 3(b)(2)(A). Furthermore, the Director of the USPTO has delegated to the Commissioner for Trademarks the power to exercise supervisory authority in trademark-related matters. *See* TMEP § 1709.

Based on this authority, and in view of the facts and circumstances described above, you are hereby excluded from participating as an attorney, correspondent, domestic representative, or signatory on behalf of others in any current or future trademark matters before the USPTO. Accordingly, your name and contact information may not appear in the attorney, correspondence, or domestic representative fields of any trademark applications and registrations. *Your contact information, including any email addresses associated with you, will be removed in due course from all relevant trademark applications and registrations.* Furthermore, if you attempt to re-enter correspondence information into the record after the USPTO removes it, the re-entered information may be stricken in accordance with 37 C.F.R. §11.18.

If necessary, the USPTO may notify the affected applicants and registrants of any change to the application/registration record. In addition, the USPTO will not accept your signature on behalf of an applicant or registrant on any submissions that require the signature of a qualified practitioner or the applicant/registrant, including changes of correspondence address. Finally, you must otherwise cease acting as a representative for others in trademark matters before the USPTO and may not prepare or submit filings, or designate yourself as attorney of record, in connection with any trademark application and registration before the USPTO.

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Responding to this Order

You are not required to respond to this order. However, you may appeal your exclusion by filing a petition to the Director of the USPTO. *See* 37 C.F.R. § 2.146. If you choose to appeal, the petition must be filed within two months of this order's mailing date. *See* 37 C.F.R. § 2.146(d). You may file the petition through the Trademark Electronic Application System at www.uspto.gov. The petition should include a verified statement of the relevant facts, the points to be reviewed, the requested action or relief, and the fee required by 37 C.F.R. § 2.6. *See* 37 C.F.R. § 2.146(c). It should be accompanied by a supporting brief and any evidence to be considered. For detailed information on petition procedures, see TMEP §§ 1705–1705.09.

Very truly yours,



Mary Boney Denison
Commissioner for Trademarks
MBD: RJL