



United States Patent and Trademark Office

Office of the Commissioner for Trademarks

November 23, 2016

Ms. Emilie Bo
SHENGXINDONGHUAN LU, HUAQI
55NONG, 181HAO
KUNSHAN, JIANGSU 215332
CHINA

VIA AIRMAIL

EXCLUSION ORDER

Dear Ms. Bo:

This letter is to inform you that, effective immediately, the United States Patent and Trademark Office (USPTO) is excluding you from participating as an attorney, correspondent, domestic representative, or signatory on behalf of others in any trademark matters before the USPTO.

Summary of Prior Correspondence

A show-cause order sent to you on September 19, 2016, indicated that the information available to the USPTO suggests that you are preparing, signing, and filing documents with the USPTO in connection with trademark applications and registrations, or are otherwise acting on behalf of others in matters before the USPTO. The order noted that these actions may constitute the unauthorized practice of trademark law before the USPTO. *See* 37 C.F.R. §§ 2.17(a), 11.5(b) (2), 11.14; *Trademark Manual of Examining Procedure* (TMEP) §§ 602, 608.

The order listed more than 1,000 trademark applications and registrations associated with you, and noted that, although you were designated as attorney of record and had signed submissions in many of these applications and registrations, there was no indication that you are a licensed U.S. attorney or are otherwise an authorized signatory under 37 C.F.R. § 2.193(e)(2). Thus, 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 provided you 30 days to submit evidence demonstrating the legitimacy of using your signature or correspondence information for purposes relating to trademark applications or registrations.

On October 24, 2016, the USPTO received a response from you, which included the following explanation, quoted here without correction, regarding your actions before the USPTO:

As for the mentioned issue, we are familiar the process of filing mark application from USPTO, so we always gave advice to the companies or individuals who want to applying trade mark to USPTO. So applicant always

put our name and address at their application. We didn't realized that our behavior had made you thought that we are attorney.

Facts and Circumstances Support Exclusion

As previously noted, over 1,000 applications and registrations appear to be associated with you. These applications and registrations, which belong to various entities and individuals other than you, list you as the attorney of record and/or correspondent. In addition, email addresses apparently associated with you are provided in these applications for the purpose of correspondence. Numerous applications include your signature and identify your title as attorney of record (*see, e.g.*, U.S. Application Serial No. 86580702). Your signature also appears in other filings, including responses to Office actions (*see, e.g.*, U.S. Application Serial Nos. 86467147 and 86777613), in which you are identified as "Attorney of Record" or "President."

Your response to the show-cause order does not include any evidence or explanation that would establish the legitimacy of designating yourself as attorney of record, signing trademark application submissions, or otherwise acting on behalf of applicants in trademark matters before the USPTO. You have stated that you have given advice to companies and individuals who wish to submit trademark applications to the USPTO, but have not indicated that you are, in fact, a qualified practitioner under 37 C.F.R. §§ 11.1 and 11.14. Instead, your response suggests that you are not a qualified practitioner and that you did not intend to create the impression that you are acting as an attorney, despite the fact that your name was entered as attorney of record in numerous applications and related submissions.

Generally, a non-attorney may not act as a representative for others in the prosecution of a trademark application, in the maintenance of a trademark registration, or in a proceeding before the USPTO. 37 C.F.R. § 11.14; TMEP §§ 602.02, 608.01. 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 on behalf of others and thus may not perform any of the following actions: giving advice to an applicant or registrant in contemplation of filing a trademark application or application-related document; preparing or prosecuting an application, response, post-registration maintenance document, or other related document; signing amendments to applications, responses to Office actions, petitions to the Director, requests to change the correspondence address, or letters of express abandonment; or authorizing issuance of examiner's amendments and priority actions. *See* 37 C.F.R. §§ 11.5(b) (2), 11.14(b); TMEP §§ 602.01, 608.01.

In addition, responses to Office actions, amendments to applications, requests for express abandonment, requests for reconsideration of final actions, requests to change the correspondence address, and requests to divide must be signed by a qualified practitioner if one has been appointed; otherwise, these submissions must be signed by the individual applicant or registrant, or, in the case of juristic entities, someone with legal authority to bind the applicant or registrant. *See* 37 C.F.R. §§ 2.62(b), 2.68(a), 2.74(b), 2.87(f), 2.163(b), 2.171(b)(1), 2.184(b)(2), 2.193(e)(2)–2.193(e)(2)(ii), 11.18(a); TMEP §§ 611.03(b), (i).

Based on a review of the relevant application and registration records, as well as your response to the show-cause order, there is a sufficient and reasonable basis to conclude that you have engaged in unauthorized practice before the USPTO by preparing, signing, and submitting trademark filings and by otherwise providing advice to those filing trademark applications. *See* 37 C.F.R. § 11.5(b); TMEP § 608.01.

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.

Pursuant to this authority, 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 or correspondence fields of any trademark applications and registrations. 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. 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.

The USPTO will continue to monitor trademark filings to ensure that you are abiding by the terms of this exclusion order.

Appointment of Qualified Practitioner and Removal of Your Name and Contact Information

Your response to the show-cause order appears to indicate that you are planning to appoint a domestic representative who, according to you, meets the requirements for filing trademark applications. You have indicated that this domestic representative will submit and handle trademark applications. However, the designation of a domestic representative is not the same as appointing a qualified attorney. Rather, the designation of a domestic representative serves a different purpose, namely, to provide a contact and address for service of process in judicial proceedings in the United States. Thus, the mere designation of a domestic representative does not authorize the person designated to practice before the USPTO by, for example, preparing or prosecuting an application or representing a party in a proceeding before the USPTO. 37 C.F.R. §§ 2.24(a) (3), 11.5(b)(2).

Therefore, the domestic representative you plan to designate in the relevant applications and registrations may represent applicants and registrants in trademark matters before the USPTO only if he or she is a qualified practitioner under 37 C.F.R. § 11.14. *See* 37 C.F.R. § 2.17. That is, he or she may act as an attorney on behalf of these applicants and registrants only if he or she is a member in good standing of the highest court in any of the 50 states of the United States of America, the District of Columbia, or any Commonwealth or territory of the United States of America. *See* 37 C.F.R. §§ 11.1, 11.14. If the person you plan to designate as domestic representative is a qualified practitioner under 37 C.F.R. § 11.14, and will be acting as attorney on

behalf of applicants or registrants, he or she should also be designated as attorney in the application or registration record. *See* 37 C.F.R. § 2.17. Trademark owners may appoint an attorney of record in a trademark application or registration by using the “Revocation of Attorney and/or Appointment of Attorney/Domestic Representative” form available at www.uspto.gov/trademarks-application-process/filing-online/correspondence-and-attorneydomestic-representative. This form must be signed by the individual applicant/registrant or by a person authorized to legally bind a juristic applicant/registrant (e.g., an officer of a corporation or a partner in a partnership).

Your response to the show-cause order asks whether you need to designate this domestic representative only in new applications or in all the applications you have submitted. First, since the USPTO has excluded you from acting as an attorney, correspondent, domestic representative, or signatory on behalf of others in any current or future trademark matters before the USPTO, your contact information must be removed from all current records and should not appear in any future applications or submissions. Second, the decision to appoint a new domestic representative or a qualified practitioner is one to be made by the trademark owner.

Because your response suggests that you may be planning to have your contact information removed from the relevant application and registration records and that a qualified practitioner may be appointed to represent the applicants and registrants, you are hereby granted 90 days from the date of this exclusion order to contact your clients and have them remove you as attorney of record if you are currently designated as attorney; update their correspondence information to remove your contact information, including any email addresses associated with you; and, if they so choose, appoint a qualified practitioner to represent them.

Thus, your removal as attorney of record, correspondent, and/or domestic representative from all relevant records must be completed by February 22, 2017. After that date, the USPTO will perform any remaining corrective actions to ensure that all relevant records are properly updated in a timely manner. As necessary, the USPTO will notify the affected applicants and registrants of any administrative actions taken with respect to the application/registration record.

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.

Sincerely,



Mary Boney Denison
Commissioner for Trademarks