



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

February 21, 2013

Mr. Bang Shia
102 Lindencrest Court
Sugar Land, TX 77479-5201

Dear Mr. Shia:

This letter is to notify you that, effective immediately, the United States Patent and Trademark Office (USPTO) is excluding you from participating as a correspondent or domestic representative in any trademark matters before the USPTO.

Summary of Prior Correspondence

In a letter to you, dated January 23, 2012, the USPTO indicated that the circumstances surrounding your involvement in more than 230 trademark applications and registrations suggest that you are engaging in the unauthorized practice of trademark law by preparing trademark filings or otherwise representing applicants before the USPTO. *See* 37 C.F.R. §§11.5(b)(2), 11.14; TMEP §608.¹ The letter requested that you show cause why the USPTO should not cease use of your contact information for correspondence and prohibit you from participating as a correspondent or domestic representative in any trademark matters before the USPTO.

On February 2, 2012, you responded, asserting that you are not engaged in unauthorized practice. Your response includes no claim that you are an authorized attorney, but instead indicates that you are merely serving as a correspondent or domestic representative who forwards to the USPTO "ready-to-file" papers that have been prepared by the applicants themselves or by filing services in foreign applicants' home countries. In support of your explanation, you have provided copies of a number of printed trademark filing forms, which appear to have been completed and signed by the relevant applicants.

Facts and Circumstances Support Exclusion

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. Subject to certain exceptions not applicable here, only an attorney who is a member in good standing of the

¹ Please note that "TMEP" identifies the *Trademark Manual of Examining Procedure* (Oct. 2012), available online at <http://tess2.uspto.gov/tmdb/tmep/>.

bar of the highest court of a relevant U.S. jurisdiction may practice before the USPTO on behalf of others in trademark matters. *See* 37 C.F.R. §§11.1, 11.14; TMEP §602. Practice before the USPTO includes consulting with or giving advice to a client in contemplation of filing a trademark application; preparing a trademark application; prosecuting a trademark application by submitting an amendment, response, or other document; signing amendments and responses to Office actions; and authorizing issuance of examiner's amendments. 37 C.F.R. §11.5(b)(2); TMEP §608.01. Although the USPTO encourages foreign applicants to appoint a domestic representative for the purpose of providing a contact and address for service of process, the designation of a domestic representative does not authorize the designated individual to practice before the USPTO. 37 C.F.R. §2.24(a)(3); TMEP §610.

In the present case, you have generally described the services you provide and indicated your belief that you have not engaged in unauthorized practice. However, the available information tends to contradict some of your assertions and suggests that some of your activities go beyond the services you describe providing. For instance, you have indicated that "all papers executed by applicants are the same copies of papers received by PTO without revision," and have provided copies of completed paper trademark filing forms. However, USPTO records show that none of these paper forms was actually filed with the USPTO. Instead, the USPTO's Trademark Electronic Application System (TEAS) was used to submit the relevant filings.

Moreover, embedded information in these TEAS filings indicates that they were directly electronically signed and submitted by someone using a computer on a computer network located in or around Sugar Land, Texas, where you maintain a mailing address. As it is highly unlikely that all of these applicants, most of whom are foreign, are traveling to your location to complete and sign these electronic filings, it may be presumed that you are completing, signing, and submitting these filings yourself. In these instances, you did not merely forward "ready-to-file" papers that were already completed and signed by the applicants themselves.

One of the documents provided in your response further supports the conclusion that you are inappropriately signing TEAS submissions on behalf of others. The document, entitled "Authorization of Electronic Signature Statement of Use," was apparently signed by an individual named Jenny Wu, a representative of the applicant, and purports to authorize the "International Patent Office of Bang Shia" to electronically sign her name for the purpose of filing a statement of use. The relevant application record shows that a statement of use with an electronic signature composed of the name "Jenny Wu" was filed electronically via TEAS. As in the filings referenced above, the embedded information in this filing shows that it was directly electronically signed and submitted by a person using a computer on a computer network in Sugar Land, Texas. As noted, you maintain an address in Sugar Land, but the foreign applicant in this application and Ms. Wu presumably do not. Thus, it appears that you electronically signed Ms. Wu's name to the statement of use, which, although provided for in the referenced document, is nonetheless improper. Under 37 C.F.R. §2.193(c), an electronic signature must be personally entered by the person identified as the signatory; another person may not sign the name of an authorized

signatory. *See* TMEP §§611.01(b), (c). The document you provided in your response does not obviate this requirement.

In addition, USPTO records indicate that you have signed your own name to applications, responses, and other filings, using the title "Representative" or "U.S. Representative." *See, e.g.,* U.S. Application Serial Nos. 77179448, 77247390, and 77247410. While you state that, at the time of filing, you "had business interests affiliated with the Marks and/or Mark applicants," you provide no further explanation or evidence as to the nature of these business interests or how your relationship with these applicants qualifies you to sign on their behalf.

Furthermore, although you have provided a few documents in which applicants have purportedly granted you authority to legally bind them, the USPTO generally does not recognize such documents, by themselves, as effective for purposes of signing responses to Office actions and requests to amend applications. Instead, persons signing these filings on behalf of a juristic applicant must have legal authority to bind the applicant by virtue of the position they hold within the applicant's organization (e.g., a general partner of a partnership or a corporate officer). *See* 37 C.F.R. §§2.62(b), 2.74(b); TMEP §§611.02, 611.03(b). None of the evidence you have provided indicates that you have this authority.

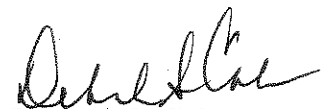
In view of the foregoing, a sufficient and reasonable basis exists to conclude that you are engaging in unauthorized practice before the USPTO by preparing trademark applications; by submitting amendments, responses, or other documents; and by signing responses, amendments, and other filings. *See* 37 C.F.R. §11.5(b)(2); 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, which necessarily includes the ability to exclude particular individuals from practicing before the USPTO in trademark matters or serving as correspondents or domestic representatives in such matters.

Pursuant to this authority, you are hereby excluded from participating as a correspondent or domestic representative in any current or future trademark matters before the USPTO. Accordingly, your contact information will be removed immediately from all relevant trademark applications and registrations. If necessary, the USPTO will notify the affected applicants and registrants of any change to the application/registration record.

No response to this letter is required. However, you may appeal this decision by 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 letter's mailing date. *See* 37 C.F.R. §2.146(d).

Sincerely,



Deborah S. Cohn

Commissioner for Trademarks