

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# **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, and 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.*



# Design Patent Practitioner Bar

- On November 16, 2023, the USPTO published a final rule establishing new technical criteria for applicants that wish to practice design patent work only.
- The application process for design patent practitioner applicants began January 2, 2024.
- The final rule expanded the technical criteria to now *also* include a bachelor's, master's or doctorate of philosophy degree in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, art teacher education, or a degree equivalent to one of the listed degrees.
- Once scientific and technical criteria are met, design patent practitioner applicants must take and pass the current registration examination and pass a moral character evaluation.



# Design Patent Practitioner Bar, cont'd

- Upon registration, design patent practitioners may practice in design patent matters only.
  - If an applicant or registered practitioner meets the scientific and technical criteria to sit for admission to the registration examination (Category A, B, & C; see Bulletin for Admission to the Examination for Registration to practice in Patent Cases Before the UPSTO here [https://www.uspto.gov/sites/default/files/documents/OED\\_GRB.pdf](https://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf)), then they can also practice design patent matters.
- Additional information about becoming a design patent practitioner may be found at:  
<https://www.uspto.gov/sites/default/files/documents/OEDDesignBarFlyer.pdf>.



# 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).

# Investigation and formal complaint process, cont'd

- After investigation, OED Director may:
  - Terminate 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 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.*



# OED: other functions

- Pro Bono programs:
  - Law School Clinic Certification Program; and
  - Patent Pro Bono Program.
- Outreach:
  - Speaking engagements: continuing legal education, roundtables/panels, diversion, pro bono, recent rulemaking, etc.

# OED Diversion Program - 37 C.F.R §11.30

- In 2016, the ABA Commission on Lawyer Assistance Programs and the Hazelden Betty Ford Foundation published a study of about 13,000 currently practicing attorneys and found the following:
  - About 21% qualify as problem drinkers;
  - 28% struggle with some level of depression;
  - 19% struggle with anxiety; and
  - 23% struggle with stress.
- Other difficulties include social alienation, work addiction, sleep deprivation, job dissatisfaction, and complaints of work-life conflict.
- The USPTO launched the Diversion Pilot Program in 2017 and it became formalized as a rule in August 2023.
- Guidance available at:  
[https://www.uspto.gov/sites/default/files/documents/Diversion\\_Guidance\\_Document.pdf](https://www.uspto.gov/sites/default/files/documents/Diversion_Guidance_Document.pdf)



# 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

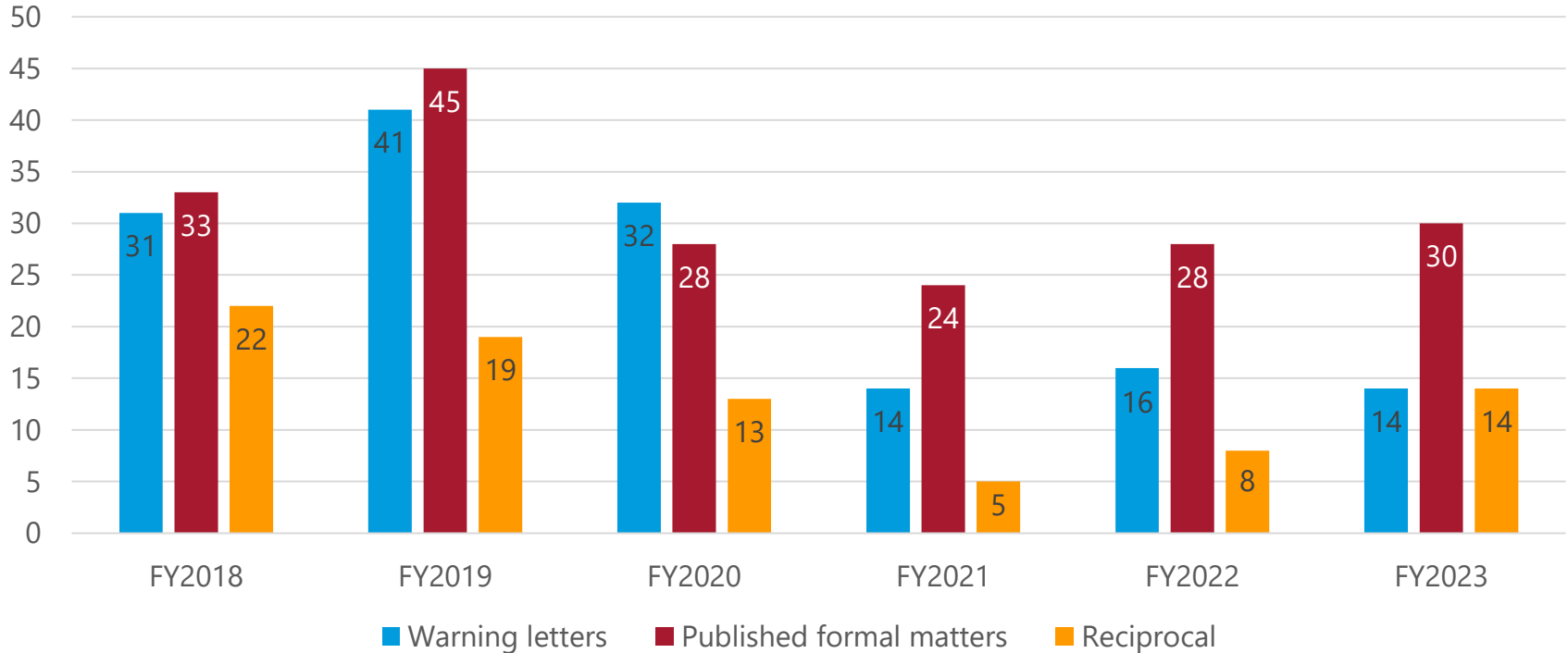
- Exclusion from practice before the USPTO
  - Minimum of five years. *See* 37 C.F.R. § 11.60(b)
  - Reinstatement only upon grant of petition. *See* 37 C.F.R. §§ 11.58(a), 11.60(a)
- Suspension from practice before the USPTO for an appropriate period
  - Reinstatement only upon grant of petition upon 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)

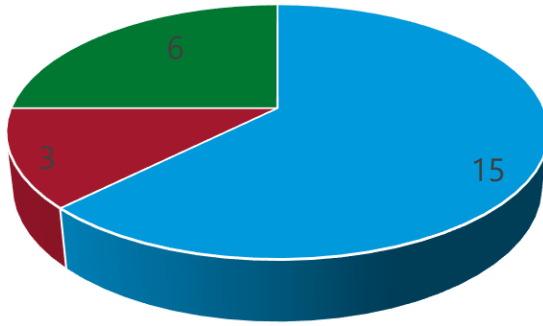


# USPTO disciplinary matters

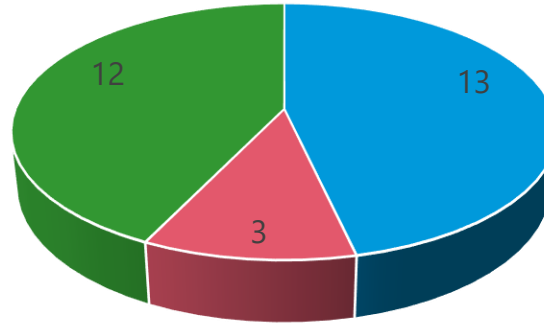


# USPTO disciplinary matters

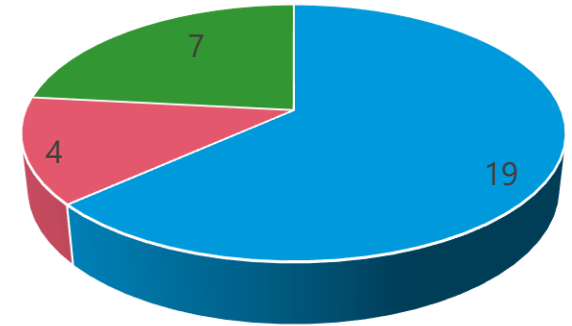
FY 2021



FY 2022



FY 2023



- 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;
- Trademark U.S. counsel cases; and
- Fee and trust account issues.

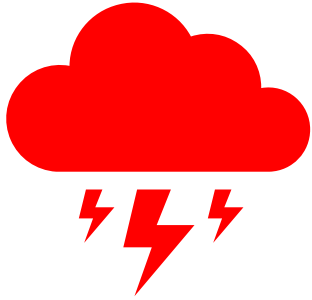


# Neglect/candor

*In re Kroll*, Proceeding No. D2014-14 (USPTO Mar. 4, 2016)

- Patent attorney:
  - Attorney routinely offered (and charged) to post client inventions for sale on his website;
  - Did not use modern docket management system;
  - Failed to file client's application, but posted the invention for sale on his website; and
  - Filed application 20 months after posting on the website
- Aggravating factors included prior disciplinary history.
- Received two-year suspension
- Rule highlights:
  - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct;
  - 37 C.F.R. § 11.18(b) – Certification upon submitting of papers; and
  - 37 C.F.R. § 10.77(c) – Neglect





# Conflicts between clients

# 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.
    - Expressly abandoned application naming both inventors in favor of continuation naming one.
  - Mitigating factors included clean 50-year disciplinary history.
  - Received public reprimand.



## **Patent agent privilege**



# Patent agent privilege

- *Onyx Therapeutics, Inc. v. Cipla Ltd. et. al.*, C.A. No. 16-988-LPS (consolidated), 2019 WL 668846, (D. Del. Feb. 15, 2019)
  - U.S. District Court found that a group of documents it inspected in camera would “almost certainly be within the scope of attorney client privilege,” but would not be “protected by the narrower patent agent privilege,” because they were not “reasonably necessary and incident to” the ultimate patent prosecution.
  - Documents were communications between scientists referencing prior art found by an individual who performed a patent assessment at the direction of a patent agent.
  - Email discussion among the scientists was found not to be protected by the patent-agent privilege **“because the assessment was done as part of a plan to develop new chemical formulations, not to seek patent protection for already-developed formulations.”**



# Patent agent privilege

- *In re Queen's University at Kingston*, 820 F.3d 1287 (Fed. Cir. 2016)
  - U.S. District Court granted Samsung's motion to compel documents, including communications between Queen's University employees and registered (non-lawyer) patent agents discussing prosecution of patents at issue in suit.
  - Federal Circuit recognized privilege **only** as to those activities that patent agents are authorized to perform (see 37 C.F.R. § 11.5(b)(1)).
- *In re Silver*, 540 S.W.3d 530 (Tex. 2018)
  - Lower court ruled that communications between client and patent agent were not protected from discovery because Texas law did not recognize patent agent privilege.
  - Supreme Court of Texas overturned, citing patent agents' authorization to practice law.
- *Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board*, 82 Fed. Reg. 51570 (Nov. 7, 2017)





# Pop Quiz!

## Rule 1.56

# Pop Quiz – Rule 1.56

Which of the following persons is least likely to have a duty to disclose material information to the USPTO in connection with an application or proceeding pursuant to 37 CFR § 1.56?

- A. A registered practitioner representing an applicant in a reexamination proceeding;
- B. An inventor working with her employer's counsel on prosecution of the patent application for her invention;
- C. An unregistered R&D Director who coordinates related patent litigation and reexamination proceedings for a company; or
- D. A typist working for a law firm prosecuting a patent application.



# Pop Quiz – Rule 1.56

Answer: D - Typist

“Individuals having a duty of disclosure are limited to those who are ‘substantively involved in the preparation or prosecution of the application.’ This is intended to make clear that the duty does not extend to typists, clerks, and similar personnel who assist with an application.”

- MPEP 2001.01

# Inequitable conduct:

*In re 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, cont'd

*In re Tendler*, Proceeding No. D2013-17 (USPTO Jan. 8, 2014)

- 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 re 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







# Pop Quiz!

## Signatures

# Pop Quiz - signatures

After consulting with Patent Agent, Client decided to have Patent Agent represent him in prosecuting his patent application before the USPTO. Client wants to grant Power of Attorney to Patent Agent with respect to the patent application.

**Which of the following statements is accurate?**

- A. Patent Agent may sign the Power of Attorney since he is the Client's representative;
- B. Patent Agent may sign the Power of Attorney on behalf of Client as long as Client agrees;
- C. Client, as the applicant, is the only authorized individual to sign the Power of Attorney; or
- D. Patent Agent or anyone acting under the authority of Patent Agent may sign the Power of Attorney as long as Client gives prior consent.



# Pop Quiz – signatures

Answer: C – Client only

37 CFR § 1.32 Power of attorney.

\*\*\*\*\*

(b) A power of attorney must:

\*\*\*\*\*

(4) Be signed by the applicant for patent (§ 1.42) or the patent owner. A patent owner who was not the applicant under § 1.46 must appoint any power of attorney in compliance with §§ 3.71 and 3.73 of this chapter.

# Pop Quiz – signatures

Patent Agent represents Inventor and files Inventor's patent application with the USPTO along with a properly executed Power of Attorney.

**Which of the following statements is accurate with respect to the oath or declaration in the application?**

- A. Patent Practitioner Agent may sign the oath/declaration since he is the Inventor's attorney/representative;
- B. Patent Practitioner may sign the oath/declaration on behalf of Inventor as long as Inventor gives prior consent;
- C. Inventor is the only individual authorized to sign the oath/declaration; or
- D. Patent Practitioner or anyone acting under the authority of Patent Practitioner may sign the oath/declaration as long as Inventor gives prior consent.



# Pop Quiz – signature

Answer: C – Inventor only

35 U.S.C. § 115(a)

“...Except as otherwise provided in this section, each individual who is the inventor or a joint inventor of a claimed invention in an application for patent shall execute an oath or declaration in connection with the application.”

*See however,* substitute statements pursuant to 35 U.S.C. § 115(d).

# Signatures on patent documents

- 37 C.F.R. § 1.4(d)(1) Handwritten signature.
  - “Each piece of correspondence, except as provided in paragraphs (d)(2) through (5), and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:
    - (i) Be an original, that is, have an original handwritten signature **personally signed**, in permanent dark ink or its equivalent, **by that person**; or
    - (ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

# Signatures on trademark documents

- 37 C.F.R. § 2.193 Trademark correspondence and signature requirements:
  - “(a)...Each piece of correspondence that requires a signature must bear:
    - (1) A handwritten signature **personally** signed in permanent ink by the person named as the signatory, or a true copy thereof; or
    - (2) An electronic signature that meets the requirements of paragraph (c) of this section, **personally entered by the person named as the signatory....**
  - \*\*\*
  - (c) Requirements for electronic signature. A person signing a document electronically must:
    - (1) **Personally enter** any combination of letters, numbers, spaces and/or punctuation marks that the signer has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission; or
    - (2) Sign the document using some other form of electronic signature specified by the Director.”



# Post-registration TM audit program

- Launched as a pilot in 2012 to assess accuracy of use claims in TM registration maintenance filings:
  - Random selection of 500 TM registrations with six-year Section 8 or 71 declarations of use;
- 51% (253) of audited registrations did not verify previously claimed use:
  - 35% deleted good/services; and
  - 16% failed to respond to Office actions and were cancelled.
- Effective November 2017, the pilot program became a finalized rule permitting the USPTO to require TM owner to submit information, exhibits and/or affidavits of declaration:
  - Registration may be audited if a Section 8 or 71 declaration is filed and registration includes one class with four or more goods/services OR two classes with two or more goods/services.
- Effective Jan 2, 2021, \$250 per class fee required when:
  - Goods/services, and/or class deleted after Section 8 or 71 is filed and before acceptance.





# Post-registration TM audit program statistics

The following data shows a running total of audit actions and various other statistics since the inception of the audit program in November 2017. This data is updated quarterly.

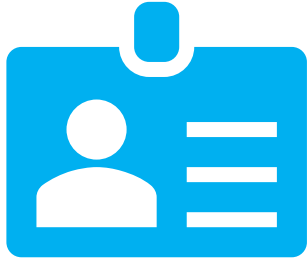
## Audit actions to date

Type of action	Nov 2017 - Dec 2023
First office actions issued	29,022
Registrations with a response deleting goods/services/classes	49.53%
Total registration cancellations	3,883

## Represented by U.S. attorney

Attorney representation	Nov 2017 - Dec 2023
Respondents represented by U.S. attorney	83%
Unrepresented respondents	17%





# U.S. Counsel Rule

# Trademarks: U.S. Counsel Rule

- Increase in foreign parties not authorized to represent trademark applicants and improperly representing foreign applicants in trademark (TM) matters.
- Fraudulent or inaccurate claims of use are a burden on the trademark system and the public and jeopardize the validity of marks.
- Effective August 3, 2019:
  - Foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented at the USPTO by an attorney who is licensed to practice law in the United States.
- Final rule: 84 Fed. Reg. 31498 (July 2, 2019)



# Trademarks: U.S. Counsel Rule, cont'd

- Canadian patent agents are no longer able to represent Canadian parties in U.S. TM matters.
- Canadian TM attorneys and agents will only be able to serve as additionally appointed practitioners:
  - Clients must appoint U.S.-licensed attorney to file formal responses; and
  - The USPTO will only correspond with the U.S. licensed attorney.



# 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 – solicitation

美标源头律师合作，非华人律师

1 message

US\_Trademark\_Agent <[REDACTED]>

Sat, Mar 12, 2022 at 2:23 AM

Reply-To: [REDACTED]

To: [REDACTED]

您好，

初步沟通后，可提供美国白皮律师（非华人）商标方案如下：

- \*符合4月9日新规，USPTO律师实人认证；
- \*可协助OBJ制作（律师助手子账号操作）；
- \*使用USPTO Payment Account支付商标官费；



uspto®

# 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 entities.

# Hijacking of U.S. practitioner data

- Since the implementation of the U.S. Counsel Rule, the Office has encountered several instances of co-opting/hijacking of a U.S. practitioner's name, address, and/or bar number.
- Referral to state bars and other agencies that address fraud and consumer protection.

# U.S. Counsel Rule - sponsorship

- Per the USPTO.gov User Agreement, U.S. trademark (TM) practitioners may only sponsor USPTO.gov accounts for their own employees whom they supervise.
- Lately, there have been instances where U.S. TM practitioners have been solicited to sponsor USPTO.gov accounts for foreign trademark filing entities. Also, there have been instances where U.S. TM practitioners have sponsored users from foreign trademark filing entities.
- Such conduct violates the terms of the USPTO.gov User Agreement. Accordingly, the Commissioner of Trademarks has suspended accounts of practitioners who engage in this conduct.
- This conduct is also subject to investigation by the Office of Enrollment and Discipline for ethical violation(s) of the USPTO Rules of Professional Conduct.
- In the future, all users (attorneys, paralegals and other sponsored account users) will be required to verify their identity before filing TM documents with the USPTO.



# Trademark Scams: Domestic



## PATENT AND TRADEMARK ASSOCIATION

Publication of Protected Patents & Trademarks on the Internet \* [www.ptma.us](http://www.ptma.us) \* [info@ptma.us](mailto:info@ptma.us)  
244 Fifth Avenue, Suite # 2153, New York, NY 10001 \* Tel: 646 757 1886 \* Fax: 646 757 1887



Keep this for your records

Copyright © 2011

TRADEMARK NAME:

<b>PAYMENT FOR</b> <small>IMPORTANT NOTIFICATION REGARDING YOUR TRADEMARK</small>	<b>TRADEMARK OWNER INFORMATION</b>
PTMA REGISTRATION #:	PTMA
PERIOD:	UP TO 2018
GROSS AMOUNT:	\$ 725

Patent and Trademark Database: Patents & Trademarks Publication by PTMA  
U.S.P.T.O. \* United States Patent and Trademark Office, Washington, DC 20231

U.S.P.T.O. REGISTRATION #:	
REGISTRATION DATE:	
CLASSES:	

THE TRADEMARK PUBLICATION PROVIDES THE NAME OF TRADEMARK OR PATENT OWNER AND PRODUCT NAMES ON THE PTMA DATABASE. IT CONTAINS ONLY PAID AND REGISTERED TRADEMARKS AND PATENTS WITH THEIR USPTO REGISTRATION NUMBERS AND CLASSES, ALONG WITH CURRENT OWNER ADDRESS. PLEASE SEND YOUR PAYMENT IN THE REMITTANCE ENVELOPE PROVIDED IN ORDER TO ENABLE PUBLISHING OF YOUR TRADEMARK OR PATENT LISTED AS SHOWN. YOUR DATA WILL BE PUBLISHED FOR A TERM OF TWO YEARS UPON RECEIPT OF PAYMENT. YOU WILL BE NOTIFIED IN SUFFICIENT TIME TO EXTEND YOUR REGISTRATION PUBLICATION ON THE TRADEMARK DATABASE REGISTER ENSURES THE REGISTERED PARTY A WORLDWIDE PUBLICATION ON THE INTERNET. THIS PUBLICATION IS AN ELECTIVE SERVICE WHICH NEITHER SUBSTITUTES THE REGISTRATION NOR PROLONGS THE VALIDITY OF THIS TRADEMARK OR PATENT WITH U.S.P.T.O. THE ASSOCIATION DOES NOT ASSUME ANY LIABILITY EITHER FOR THE ACCURACY OR COMPLETENESS OF THE REGISTERED INFORMATION OR FOR TRADEMARK/PATENT PROTECTION. CHANGES WILL BE MADE FREE OF CHARGE UPON RECEIPT OF A WRITTEN REQUEST. IF THE TRADEMARK OR PATENT IS PARTIALLY OR ENTIRELY ASSIGNED TO ANOTHER OWNER, THE ASSOCIATION MUST BE INFORMED IN WRITING. PREMATURE CANCELLATION OF PUBLISHING MUST BE REQUESTED IN WRITING.

GRAPHICAL REPRESENTATION (IF APPLICABLE)

▶▶▶▶▶ Remittance advice, detach **PAYMENT STUB** and send with your payment. ◀◀◀◀◀

PLEASE MAKE CHECKS PAYABLE TO:  
PATENT AND TRADEMARK ASSOCIATION

INCLUDE THE PTMA REGISTRATION #  
ON CHECK AND SEND THIS STUB WITH CHECK IN THE  
REMITTANCE ENVELOPE TO:

PATENT AND TRADEMARK ASSOCIATION  
244 FIFTH AVE., SUITE # 2153, NEW YORK, NY 10001



CHECK #

NET AMOUNT \$ 725	PERIOD UP TO 2018	PTMA REG. #:
<b>OWNER NAME AND ADDRESS</b>		
<b>CHECK YOUR DATA AND MAKE CORRECTION IF NECESSARY</b>		

Patent and Trademark Association Batch Id: 924587/714



# Trademark Scams: Domestic *cont'd*

**Patent & Trademark Bureau**  
2058 County Line Road #113  
Huntingdon Valley, PA 19006



**REMINDER**  
www.patentandtrademarkbureau.com



Correspondence address: <div style="background-color: black; width: 100%; height: 30px;"></div>	
<b>Trademark name:</b> <div style="background-color: black; width: 100%; height: 30px;"></div>	
<b>Registration Number:</b> <div style="background-color: black; width: 100%; height: 30px;"></div>	<b>Number of classes:</b> 1
<p><b>Your trademark is about to expire. Renewal date: Jan. 21, 2022</b></p> <p>Your trademark registration requires a filing between the 19<sup>th</sup> and 20<sup>th</sup> years after registration to remain valid.</p> <p>Sign and return this document in order to renew your trademark.</p>	
TRADEMARK	IMPORTANT INFORMATION
<b>Type of mark</b> Servicemark <hr/> <b>Register</b> Principal <hr/> <b>Renewal date</b> Jan. 21, 2022 <hr/> <b>Filing date</b> <div style="background-color: black; width: 100%; height: 20px;"></div> <hr/> <b>Date in location</b> Oct. 02, 2012 <hr/> <b>Registration date</b> <div style="background-color: black; width: 100%; height: 20px;"></div> <hr/> <b>Classes</b> <div style="background-color: black; width: 100%; height: 20px;"></div> <hr/> <b>Serial number</b> <div style="background-color: black; width: 100%; height: 20px;"></div>	<p>Please return this document with your signature and/or company stamp in the appropriate space below if you would like to renew your trademark. Your trademark will be renewed for the period of another ten (10) years. The renewal fee is \$1650 for one class and \$850 for each additional class for the whole period of ten (10) years. You will receive an invoice from us after we have received this signed document from you. By signing this document you automatically empower Patent &amp; Trademark Bureau to renew the trademark stated above on your behalf. Patent &amp; Trademark Bureau reminds companies when their trademarks are due for renewal. Note that trademarks may be lost if they are failed to be renewed in time. Patent &amp; Trademark Bureau is a private business that is not endorsed by the U.S. government. Patent &amp; Trademark Bureau provides the expertise that modern businesses need to navigate the Patent and Trademark Office's registration and renewal process. This renewal is optional and only acts as a reminder. If you have any questions regarding your renewal process, contact us via e-mail: info@patentandtrademarkbureau.com or telephone/fax: 215 207 0140.</p>
GRAPHIC REPRESENTATION	
<div style="background-color: black; width: 100%; height: 100%;"></div>	<p><b>Date</b> _____ / ____ / ____</p> <p><b>Name, Last name</b> _____</p> <p><b>E-mail</b> _____</p> <p><b>Position</b> _____</p> <p><b>Signature</b> _____</p>
<p><b>SIGN AND RETURN IN THE ENCLOSED ENVELOPE</b></p>	

if undelivered please return to:

**Patent Trademark Bureau**

PO Box 45672

2311 Cottman Ave Ste 10

Philadelphia, PA 19149

Please do not use this address for any correspondence

Place  
Stamp  
Here

Patent Trademark Bureau  
2058 County Line Road #113  
Huntingdon Valley, PA 19006

From: UNITED STATES DEPARTMENT OF COMMERCE | USPTO | COMMISSIONER FOR TRADEMARKS  
<tmng\_notices@feesdue-uspto.us>  
Date: Tue, Nov 21, 2023 at [REDACTED]  
Subject: Official USPTO Notification of Notice of Allowance: U.S. Trademark Application SN  
[REDACTED] -- Docket/Reference No.  
To: <[REDACTED]>

## **NOTICE OF ALLOWANCE (NOA) AND FEE(S) DUE**

U.S. Application Serial No. [REDACTED]  
Mark: [REDACTED]  
Owner/Holder: [REDACTED]  
Docket/Reference No.

Issue Date: November 21, 2023

No opposition was filed for this application. The issue date of this NOA establishes the due date for the filing of a Statement of Use (SOU) or a Request for Extension of Time to file a Statement of Use (Extension Request). WARNING: An SOU that meets all legal requirements must be filed before a registration certificate can issue. Please read below for important information regarding the applicant's pending six (6) month deadline.

SIX (6)-MONTH DEADLINE: Applicant has six (6) MONTHS from the NOA issue date to file either:

- An SOU, if the applicant is using the mark in commerce (required even if the applicant was using the mark at the time of filing the application, if use basis was not specified originally); OR
- An Extension Request, if the applicant is not yet using the mark in commerce. If an Extension Request is filed, a new request must be filed every six (6) months until the SOU is filed. The applicant may file a total of five (5) extension requests. WARNING: An SOU may not be filed more than thirty-six (36) months from when the NOA issued. The deadline for filing is always calculated from the issue date of the NOA.

How to file SOU and/or Extension Request:  
Use the Trademark Electronic Application System (TEAS) or TEAS International (TEASi).  
Do NOT  
reply to this e-mail, as e-mailed filings will NOT be processed.

**WORLD IP ORGANIZATION PUBLICATION FEE DUE: 1970,00 USD**  
**In accordance with the Regulations under the Protocol Relating to the Madrid Agreement**  
**Concerning the International Registration of Marks (as in force on November 1,**

# Foreign

**2023),  
the publication fee must be paid to the World IP Organization ([www.wipo.int](http://www.wipo.int))  
within  
fifteen (15) days from the issue date of this notice or this application shall be  
regarded  
as abandoned. This statutory period cannot be extended.**

Please pay by SWIFT:  
Beneficiary Name: World IP Organization  
Beneficiary Address: Sokolovska 10, 040 11 Kosice - Mestska cast Zapad, Slovakia  
IBAN: SK340200000000[REDACTED]  
BIC/SWIFT Code: [REDACTED]  
Bank Name: VUB banka, a.s.  
Bank Address: Mlynske nivy 1, 829 90 Bratislava, Slovakia  
Payment Amount: 1970,00 USD  
Charge Type: SHA  
Beneficiary Reference: [REDACTED]

- To help ensure that you receive e-mails from the USPTO, keep your email address(es) current using the Change Address or Representation (CAR) form and add USPTO e-mail addresses to your contacts or "Safe Senders" list.
- If your trademark application identifies goods and/or services not in use with your trademark, you can use the Section 7 form to request deletion of any goods and/or services not in use with your trademark.



# Trademark Scams: Foreign *cont'd*



World Trademark Register -- a private-law register of trademarks: [www.trademark-register.org](http://www.trademark-register.org)  
Correspondence concerning the World Trademark Register should be sent to the following address:  
15, Rue du Tunnel, 1227 Geneva, Switzerland,  
e-mail: [contact@trademark-register.org](mailto:contact@trademark-register.org)



By application No. [REDACTED] on [REDACTED] 2017 you have filed to the United States Patent and Trademark Office for the trademark (Nice Classification Classes: 45) to be taken under legal protection on the territory of United States of America.  
The data presented above come from the *Global Brand Database*, maintained by the World Intellectual Property Organization. Under and in term of the agreement of participation in the *Global Brand Database* project, entered into by the United States Patent and Trademark Office and World Intellectual Property Organization, the World Intellectual Property Organization, with the registered office in Geneva, is the body "possible for registration in the *Global Brand Database*, the subject of which registration are trademarks filed to be taken under legal protection on the territory of United States of America.  
After familiarising with the aforesaid data of the trademark we hereby present this, understood in accordance with Article 14 (1) of the United Nations' CISQ Convention (signed: Vienna, 11.04.1980), conditional proposal of

**REGISTRATION OF THE AFORESAID TRADEMARK IN THE WORLD TRADEMARK REGISTER FOR A 10-YEAR PERIOD**  
with the prerequisite of making the payment, in the amount calculated in the table below:

	Number of classes:	Amount for 1 class:	Total amount:
Nice Classification Classes	1	945,00 USD	945,00 USD
Total number of classes	1	945,00 USD	945,00 USD
<b>TOTAL PAYMENT AMOUNT</b>			<b>945,00 USD</b>

Registration of the trademark in the World Trademark Register and the payment in the amount of 945,00 USD, irrelevant for the creation and duration of legal protection of the trademark, as well as for other legal effects (and registration) in United States Patent and Trademark Office and World Intellectual Property Organization, can be made within the period not exceeding 25.12.2017 by making a SWIFT transfer to the following bank account:

**SWIFT TRANSFER DETAILS:**  
**BENEFICIARY:** WORLD TRADEMARK REGISTER  
**BANK:** PLUS BANK S.A.  
**BANK ADDRESS:** AL. SZANOW ZJEDNOCZONYCH 61A; 04-028 WARSZAWA  
**SWIFT:** IVSEPLPPXXX  
**IBAN:** PL39168012480000000509678593  
**AMOUNT:** 945,00 USD  
**TRANSFER TITLE:** [REDACTED]

*We would like to inform you that in the case of a mistake in the name of the sender/recipient/transfer title or any other irregularities, the only basis for accepting the payment as properly and timely made will be the confirmation of transfer acquired from your bank's branch, not in an electronic form (generated from online banking) and that making the payment is equivalent with accepting all provisions of the World Trademark Register (available on [www.trademark-register.org](http://www.trademark-register.org)). When making the payment, please use the beneficiary name exactly as stated above.*

*A. Gacina*  
Date: 01.12.2017



See <https://www.uspto.gov/trademarks/protect/caution-misleading-notices>



# Fees and trust account issues

- *In the Matter of Everitt Beers*, Proceeding No. D2016-8 (USPTO June 10, 2016)
  - Registered patent attorney:
    - Client hired Respondent to file eight TM applications.
    - Respondent billed for and received \$2,600 advanced costs as filing fees.
    - Respondent failed to deposit any of the \$2,600 in a trust account.
    - Respondent then billed and received \$5,005 advanced fees to prepare and file eight TM applications, neither of which he did.
    - Respondent then sent a list of work purportedly performed – eight fictitious TM applications.
    - Converted all advanced costs and fees for his own use and failed to deposit unearned legal fees and USPTO fees in a trust account.
  - Mitigating factors included no prior disciplinary history during 12 years of practice.
  - Suspended for four months.



# 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
  - Respondent 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**

# Decorum required in trademark (TM) communications

- All those who practice TM matters before the USPTO are required to conduct their business with decorum and courtesy. *See* 37 C.F.R. § 2.192; TMEP 709.07.
- If a submitted document contains rude or discourteous remarks, it may be referred to the Deputy Commissioner for Trademark Examination Policy for review.
- If it is determined that the document is in violation of 37 C.F.R. § 2.192, the document will not be considered and will be removed from the file.



# 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



# Disreputable or gross misconduct

*In re Tassan*, Proceeding No. D2003-10 (USPTO Sept. 8, 2003):

- Registered practitioner who became upset when a case was decided against his client, and left profane voicemails with TTAB judges.
- Called and apologized one week later; said he had the flu and was taking strong cough medicine.
- Also had a floral arrangement and an apology note sent to each judge.
- Mitigating factors: private practice for 20 years with no prior discipline; cooperated fully with OED; showed remorse and voluntarily sought and received counseling for anger management.
- Settlement: Reprimanded and ordered to continue attending anger management and have no contact with Board judges for 2 years.

# Other examples of disreputable or gross misconduct

- Speaking to a TTAB interlocutory and another person, practitioner raged and screamed, stating “how awful [you] all are” and “how terrible all government workers are.”
- While yelling at an interlocutory over the phone, Practitioner claimed to be a friend of TTAB Chief Judge Rogers and that he should receive special treatment, and again attacked the character of PTO employees, and demanded that the interlocutory on his case be replaced. In another instance, after yelling at the interlocutory, he hung up on her.



# Decisions imposing public discipline available in “FOIA Reading Room”

- [foiadocuments.uspto.gov/oed/](https://foiadocuments.uspto.gov/oed/)
- Official Gazette for Trademarks:
  - [www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog](https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog)

# OED Hotline

**Contact OED with your questions!**

**Phone:** 571-272-4097

**Fax:** 571-273-0074

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

**Mailing Address:**

Mail Stop OED

U.S. Patent and Trademark Office

PO Box 1450

Alexandria, VA 22313-1450





# Thank you!

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