

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of)	
)	
Che-Yang Chen,)	Proceeding No. D2024-01
)	
Respondent)	
<hr/>		

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Che-Yang Chen (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions.

Jurisdiction

1. Respondent is an attorney who is licensed to practice law by the District of Columbia, and he is in “active” and good standing status in that jurisdiction. As such, Respondent is authorized to practice before the USPTO in trademark and other non-patent matters. *See* 37 C.F.R. § 11.14(a). At all times relevant hereto, Respondent was engaged in practice before the Office in trademark matters.

2. Respondent is also a registered patent practitioner. The USPTO registered Respondent as a registered attorney on March 9, 2009 (Reg. No. 64,015). Respondent has engaged in practice before the Office in patent matters.

3. Respondent is subject the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et. seq.*

4. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, 11.26, 11.32, and 11.39.

Background

A. Relevant USPTO Trademark Rules of Practice and Trademark Regulations

The U.S. Counsel Rule

5. Effective August 3, 2019, any foreign-domiciled trademark applicant or registrant 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”).

6. In part, the U.S. Counsel Rule was intended to (a) increase compliance with U.S. trademark law and USPTO regulations, (b) improve the accuracy of trademark submissions to the USPTO, and (c) safeguard the integrity of the U.S. trademark register. *See* 84 Fed. Reg. 31498. 37 C.F.R. § 2.193 – *Signature Requirements for Trademark*

Documents

7. The USPTO trademark signature rules require that (a) all signatures on trademark documents be signed by a proper person, (b) trademark documents be personally signed by the signatory named on the document, and (c) a person electronically signing a

document must personally enter any combination of letters, numbers, spaces, and/or punctuation marks that he or she has adopted as a signature and that combination be placed between two forward slash ("/") symbols in the signature block on the electronic submission. *See* 37 C.F.R. §§ 2.193(a), (c), and (e); and 37 C.F.R. § 11.18(a).

8. The Trademark Manual of Examining Procedure ("TMEP") provides additional clear and straightforward guidance to practitioners regarding the USPTO trademark electronic signature rules' requirement that the named signatory sign the document:

All documents must be properly signed. 37 C.F.R. §§ 2.193(a)(1), 11.18(a). The person(s) identified as the signatory must personally sign the printed form or personally enter his or her electronic signature, either directly on the TEAS form or in the emailed form. 37 C.F.R. § 2.193(a), (d).

Another person (e.g., paralegal, legal assistant, or secretary) may not sign or enter the name of a qualified U.S. attorney or other authorized signatory.

Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.

TMEP § 611.01(c) (case citations omitted) (line spacing added) (bold added).

Adverse Consequences to Applications and Issued Registration due to Violations of USPTO Trademark Signature Rules.

9. If the signature on a trademark application or other submission fails to comply with 37 C.F.R. § 2.193(a) or (e) because it was entered by someone other than the named signatory or not signed by a proper person, then the submission is improperly executed, cannot be relied upon to support registration, and normally renders the application void. *See* 84 Fed. Reg. at 31498 (stating that "[i]f signed by a person determined to be an improper person, the registration may be invalid."). *See also In re Cowan*, 18 USPQ2d 1407, 1409 (Comm'r Pats. 1990); *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Yusha*

Zhang, 2021 TTAB LEXIS 465, *10, *13 (Dir. USPTO Dec. 10, 2021). When trademark filings are impermissibly signed and filed with the USPTO, the integrity of the federal trademark registration process is adversely affected

10. Trademark applications contain declarations that are signed under penalty of perjury, with false statements being subject to punishment under 18 U.S.C. § 1001. Signatories to declarations in trademark applications make specific representations regarding applicants' use of the mark in commerce and/or their intent to use the mark in commerce. The USPTO relies on such declarations signed under penalty of perjury in trademark applications in the course of examining trademark applications and issuing registrations.

B. Relevant USPTO Patent Rules of Practice and Trademark Regulations

Patent Signature Rules

11. The USPTO's signature requirements for patent correspondence (e.g., entity status determinations, application data sheets, and inventor declarations) are found, in part, at 37 C.F.R. § 1.4(d), which states:

(1) Handwritten signature. Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (d)(4), (e), 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.

(2) S-signature. An S-signature is a signature inserted between forward slash marks, but not a handwritten signature as defined by paragraph (d)(1) of this section. An S-signature includes any signature made by electronic or mechanical means, and any other mode of making or applying a signature other than a handwritten signature as provided for in paragraph (d)(1) of this section.

Correspondence being filed in the Office in paper, by facsimile transmission as provided in § 1.6(d), or via the USPTO patent electronic filing system as an attachment as provided in § 1.6(a)(4), for a patent application, patent, or a reexamination or supplemental examination proceeding may be S-signature signed instead of being personally signed (i.e., with a handwritten signature) as provided for in paragraph (d)(1) of this section. The requirements for an S-signature under this paragraph (d)(2) of this section are as follows.

- (i) The S-signature must consist only of letters, or Arabic numerals, or both, with appropriate spaces and commas, periods, apostrophes, or hyphens for punctuation, and the person signing the correspondence must insert his or her own S-signature with a first single forward slash mark before, and a second single forward slash mark after, the S-signature (e.g.,/Dr. James T. Jones, Jr./); and
- (ii) A patent practitioner (§ 1.32(a)(1)), signing pursuant to §§ 1.33(b)(1) or 1.33(b)(2), must supply his/her registration number either as part of the S-signature, or immediately below or adjacent to the S-signature. The number (#)

character may be used only as part of the S-signature when appearing before a practitioner's registration number; otherwise the number character may not be used in an S-signature.

(iii) The signer's name must be:

(A) Presented in printed or typed form preferably immediately below or adjacent the S-signature, and

(B) Reasonably specific enough so that the identity of the signer can be readily recognized.

See 37 C.F.R. § 1.4(d).

Adverse Consequences to Applications and Issued Registration due to Violations of USPTO Signature Rules

12. It is not genuinely disputed that a patent document is to be signed by the named signatory. *See* 37 C.F.R. § 1.4(d)(4)(ii) (“The person inserting a signature under paragraph (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature. A person submitting a document signed by another under paragraph (d)(2) or (d)(3) of this section is obligated to have a reasonable basis to believe that the person whose signature is present on the document was actually inserted by that person, and should retain evidence of authenticity of the signature. False signatures on applications may jeopardize patent rights. *See, e.g., Ex parte Hipkins*, 20 USPQ2d 1694, 1696-97 (BPAI 1991) (request to correct false signature of co-inventor on oath application rejected by USPTO in reissue application).

Micro Entity Status for Certain Patent Applicants

13. Certain applicants and patent owners can benefit from a significant reduction on most USPTO fees if they qualify and file the appropriate papers in their application or patent. To benefit from this fee reduction, applicants and patentees must establish “micro entity” status pursuant to 37 C.F.R. § 1.29. *See generally* Manual of Patent Examining Procedure (“MPEP”) § 509.04.

Certification of Micro Entity and Fraud Considerations

14. A certification is required as a condition for an applicant to be considered a micro entity. *See* 35 U.S.C. § 123. The certification must be in writing and must be filed prior to or at the time a fee is first paid in the micro entity amount in an application or patent. *See* MPEP § 509.04(I).

15. A fee may be paid in the micro entity amount only if it is submitted with, or subsequent to, the submission of a certification of entitlement to micro entity status. *See* 37 C.F.R. § 1.29(f) and MPEP § 509.04(I).

16. “Any attempt to fraudulently establish status or pay fees as a micro entity shall be considered as a fraud practiced or attempted on the Office. Improperly, and with intent to deceive, establishing status or paying fees as a micro entity shall be considered as a fraud practiced or attempted on the Office.” 37 C.F.R. § 1.29(j) (underlines added), *see also* MPEP § 509.04(I).

C. Certifications to the USPTO when Presenting Trademark or Patent Papers

17. A practitioner makes important certifications via 37 C.F.R. § 11.18 whenever presenting (*e.g.*, by signing, filing, submitting, or later advocating) any trademark or patent paper to the USPTO. Specifically, the practitioner certifies that all statements made

on his or her own knowledge are true, and that all statements based on the practitioner's information and belief are believed to be true. *See* 37 C.F.R. § 11.18(b)(1). The practitioner also certifies that:

[t]o the best of the party's knowledge, information and belief, *formed after an inquiry reasonable under the circumstances* (i) the paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; (ii) the other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law; (iii) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and (iv) the denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 C.F.R. § 11.18(b)(2) (emphasis added).

18. Accordingly, a practitioner who presents any paper to the USPTO — including patent or trademark documents — certifies that he or she has conducted an inquiry reasonable under the circumstances that supports the factual assertions set forth in the paper. *See* 37 C.F.R. § 11.18(b)(2)(iii).

19. Violations of § 11.18 may jeopardize the probative value of the filing, and any false or fraudulent statements are subject to criminal penalty under 18 U.S.C. § 1001. *See* 37 C.F.R. § 11.18(b)(1).

20. Any practitioner who violates the provisions of this section may also be subject to disciplinary action. *See* 37 C.F.R. § 11.18(d).

Joint Stipulated Facts

21. On December 8, 2008, Respondent was admitted to practice law in the District of Columbia.

22. On January 29, 2009, Respondent signed an Oath or Affirmation in which he swore or

affirmed that he would observe the laws and rules of practice of the USPTO if admitted to practice before the USPTO.

23. On March 9, 2009, Respondent was registered as a patent attorney with the USPTO and assigned registration number 64,015.

24. Respondent was a solo practitioner with a small staff of non-practitioner assistants.

25. Respondent has fifteen years of experience as a trademark attorney.

26. Respondent is the sole principal of the Law Office of Michael Chen, which is based in California.

27. Between January 2021 and December 2022, Respondent served as attorney of record for over nine thousand trademark applications.

28. Most or all of the applicants were foreign-domiciled and therefore required a US-licensed attorney to serve as attorney of record for their applications due to the U.S. Counsel Rule.

29. Respondent became aware of the U.S. Counsel Rule around the time that it went into effect in August 2019.

30. The applications that Respondent handled for foreign-domiciled applicants were referred to him by one of several foreign intellectual property companies with which he associated, including Xingyue Technology Co. Ltd.; INIPA; Shenzhen BiaoDaGe Enterprise Consulting Co. Ltd.; Shenzhen Seller Growth Network Tech. Ltd.; Shanghai Maidetong Software Technology Co. Ltd. (aka "IPP Master"); Shenzhen SeaArea IPR Technology Co., Ltd.; and One Stop Cross-Border Electricity Suppliers Service.

31. Respondent received between \$20 to \$50 per trademark application for which he

served as attorney of record, depending on the specific compensation terms he agreed to with the company that referred the applicant to him.

32. For each trademark application that Respondent filed on behalf of a foreign-domiciled client, a representative of a foreign intellectual property company (rather than Respondent or his non-practitioner assistants) used the USPTO's Trademark Electronic Application System ("TEAS") to prepare a draft application.

33. These representatives were not licensed to practice law in the United States.

34. After drafting the application, the representative would send the applications electronically to Respondent to review, sign, and file.

35. Prior to July 2022, Respondent allowed non-practitioner assistants to electronically sign his name on thousands of trademark applications, including the sworn declarations, rather than signing them personally as the named signatory, as required by USPTO rules.

36. In July 2022, Respondent had a telephone conversation with an OED employee, Senior Counsel for Disciplinary Investigations.

37. Respondent stated that during this conversation, he first learned that USPTO rules require trademark applications to be personally signed by the named signatory.

38. After his July 2022 conversation with the OED employee, Respondent continued to allow his non-practitioner assistant to sign his name on trademark applications, including the sworn declarations, that were filed with the USPTO.

39. Respondent admitted that while on vacation in Las Vegas, Nevada, he allowed his non-practitioner assistant to sign Respondent's name on at least 27 trademark applications, including the sworn declarations, that were filed with the USPTO.

40. Between August 2022 and September 2022, Respondent served as attorney of record for approximately 190 trademark applications that were filed with a handwritten signature that was scanned into a PDF format and uploaded through TEAS.

41. Respondent received the handwritten signed applications from representatives of foreign trademark companies, rather than directly from the signatories.

42. Although these applications were purportedly signed by the trademark applicants themselves, Respondent took no steps to ensure that the applicants were actually signing the applications as named signatories in compliance with the USPTO's signature rules, instead relying exclusively on intellectual property companies to secure the proper signatures prior to filing.

43. Although he learned in July 2022 that he had submitted thousands of impermissibly signed trademark applications, Respondent took no action to notify his clients about the impermissible signatures or the potential consequences to their intellectual property rights until July 2023.

44. Respondent also took no action to notify the USPTO about the impermissible signatures until July 2023.

45. Respondent's inaction jeopardized the integrity of the trademark registry in that it led to the registration of marks that may ultimately be deemed invalid for failure to comply with the USPTO's signature requirements, and which, until that time, may serve to prevent the registration of legitimate marks.

46. On multiple instances, prior to, and after, his communication with OED, Respondent allowed his non-practitioner assistant to review, sign, and file responses to Office Actions

prepared by foreign intellectual property companies.

47. Respondent did not review these Office Action responses prior to his assistant signing his name and filing them with the USPTO.

48. Respondent did not perform a reasonable inquiry under the circumstances to ensure that the factual contentions made in the responses to Office Actions had evidentiary support.

49. Between January 2021 and August 2023, Respondent served as attorney of record for over 2,000 design patent applications filed with the USPTO.

50. Respondent received referrals for design patent business from some of the same foreign intellectual property companies that referred trademark business to him: Xingyue Technology Co. Ltd.; INIPA; Shenzhen Seller Growth Network Tech. Ltd.; Shanghai Maidetong Software Technology Co. Ltd. (aka “IPP Master”); and Shenzhen SeaArea IPR Technology Co., Ltd.

51. Respondent received between \$100 to \$250 per design patent application for which he served as attorney of record, depending on the specific compensation terms he agreed to with the foreign intellectual property company that referred the design patent applicant to him.

52. In most cases, the design patent applications that Respondent filed were prepared by representatives of the foreign intellectual property companies based on templates that Respondent provided to them.

53. These representatives were not registered practitioners before the USPTO.

54. After drafting the applications, the representative would send the applications electronically to Respondent to review and file.

55. In most cases, when Respondent submitted a design patent application, he signed the

name of the inventor on the inventor oath, rather than the inventor signing his or her own name as required by USPTO rules.

56. Respondent has acknowledged that he served as attorney of record for at least 136 design patent applications with inventor oaths that he impermissibly signed.

57. Respondent also signed certifications of micro entity status that he filed along with the design patent applications for which he served as attorney of record.

58. Respondent relied on representatives of foreign intellectual property companies to explain the criteria for micro entity status to the inventors or design patent applicants and verify their eligibility, rather than communicating with the inventors or design patent applicants himself.

59. Respondent did not adequately supervise the representatives of foreign intellectual property companies to ensure that they verified the eligibility of each inventor or design patent applicant claiming micro entity status.

60. Respondent did not perform an inquiry reasonable under the circumstances to ensure that the factual contentions made in the certifications of micro entity status had evidentiary support.

61. Due to Respondent's failure to perform a reasonable inquiry to verify micro entity status, Respondent signed several certifications of micro entity status that were not eligible for micro entity status, because they had been named as the inventor or patent applicant in more than four previously filed patent applications.

62. In many such instances, the USPTO issued Notices of Payment Deficiency because the inventor paid the micro entity fee despite being ineligible for micro entity status.

63. Respondent also submitted numerous certifications of micro entity status that were defective in a variety of ways, including those which did not properly identify the application to which it pertained, were unsigned, or not signed by an authorized party (i.e., the inventor, inventor's representative, or practitioner of record).

64. Respondent represents:

- a. he has conducted an in depth and good faith review of all trademark documents that he or his non-practitioner assistants have presented to the USPTO and has identified all trademark documents on which he is the named signatory but where he did not personally sign the document;
- b. he has informed the USPTO's Office of Deputy Commissioner for Trademark Policy in writing of each such trademark document; and
- c. he has provided written notification to the applicants or registrants associated with such trademark documents as to the actual or potential harm to their intellectual property rights in their pending trademark applications and/or registered trademarks caused by the presenting of such impermissibly signed trademark documents to the USPTO.

65. Respondent represents:

- a. he has conducted an in depth and good faith review of all trademark documents that he or his non-practitioner assistants have presented to the USPTO at time when Respondent was the attorney of record for the applicant;
- b. he has identified all trademark documents on which the named signatory did not personally sign the document. Respondent further represents that he has informed the USPTO's Office of Deputy Commissioner for Trademark Policy in writing of each such trademark document; and
- c. he has provided written notification to the applicants or registrants associated with such trademark documents as to the actual or potential harm to their intellectual property rights in their pending trademark applications and/or registered trademarks caused by the presenting of such impermissibly signed trademark documents to the USPTO.

66. Respondent represents:

- a. he has conducted an in depth and good faith review of all inventorship oaths

that he or his non-practitioner assistants have presented to the USPTO and has identified all inventorship oaths that were not signed by the named signatory on the oath;

- b. he has informed the USPTO's Office of Patent Legal Administration in writing of each such patent document; and
- c. he has provided written notification to the inventors associated with such patent documents as to the actual or potential harm to their intellectual property rights in their pending patent applications or issued patents caused by the presenting of such impermissibly signed inventorship oaths to the USPTO.

Additional Considerations

67. Respondent represents that he has never been the subject of professional discipline by the USPTO, any court, or any state bar.

68. Respondent cooperated with OED's investigation, including accepting an invitation to participate in an interview during the OED Director investigation of Respondent's conduct.

Joint Legal Conclusions

69. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct in connection with his trademark practice before the USPTO:

- a. 37 C.F.R. § 11.101 (not providing competent representation to a client) by, *inter alia*, (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 and failing to take reasonable steps to ensure that clients' trademark filings were reviewed and filed in accordance with the USPTO trademark signature rules; (ii) not knowing the USPTO trademark rules until July 2022 despite having practiced before the USPTO in trademark matters since 2008; (iii) not informing trademark clients of the actual or potential adverse consequences to their intellectual property rights to the impermissible signing of trademark applications; (iv) submitting to the USPTO trademark documents, including declarations, that were not signed by the named signatory or allowing other persons to do so; and (v) not having adequate controls in place to ensure the appropriate use

of the H-SIGN signature method for trademark applications;

- b. 37 C.F.R. § 11.103 (not acting with reasonable diligence and promptness in representing a client) by, *inter alia*, (i) not informing trademark clients of the actual or potential adverse consequences to their intellectual property rights due to the impermissible signing of trademark applications; (ii) submitting to the USPTO trademark documents, including declarations, that were not signed by the named signatory or allowing other persons to do so; (iii) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 and failing to take reasonable steps to ensure that clients' trademark filings were reviewed and filed in accordance with the USPTO trademark signature rules; and (iv) not having adequate controls in place to ensure the appropriate use of the H-SIGN signature method for trademark applications;
- c. 37 C.F.R. § 11.104(a)(3) (keeping the client reasonably informed about the status of the matter) and § 11.104(b) (explaining a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation) by, *inter alia*, (i) delaying and/or not timely informing clients about trademark signature requirements; and (ii) not informing trademark clients of the actual or potential adverse consequences to their intellectual property rights related to the impermissible signing of trademark applications;
- d. 37 C.F.R. § 11.303(a)(1) and (a)(3) (candor toward the tribunal) by, *inter alia*, (i) knowingly submitting to the USPTO trademark documents, including declarations, that were not signed by the named signatory or allowing other persons to do so; and (ii) falsely certifying under § 11.18 that the factual assertions presented in trademark document (*i.e.*, the named signatory signed the document being presented to the USPTO) when he knew that the named signatory did not sign certain Trademark document submitted to the USPTO;
- e. 37 C.F.R. § 11.503(a) and (b) (responsibilities over non-practitioner assistants) by, *inter alia*, (i) allowing his non-practitioner assistant to review responses to Office Actions prepared by foreign entities, sign Respondent's name to the responses, and file the responses; (ii) otherwise allowing his non-practitioner assistant to "operate" while Respondent was out of town or when had limited access to a computer by signing and/or filing trademark applications and other documents with the Office; and (iii) not having adequate controls in place to ensure the appropriate use of the H-SIGN signature method for trademark applications;
- f. 37 C.F.R. § 11.505 (assisting another in practicing law in a jurisdiction in violation of the legal profession in that jurisdiction) by, *inter alia*, (i) allowing his non-practitioner assistant to review responses to Office Actions prepared by foreign entities, sign Respondent's name to the responses, and file the responses and (ii) otherwise allowing his non-practitioner assistant to "operate" while Respondent was

out of town or when had limited access to a computer by signing and/or filing trademark applications and other documents with the Office;

- g. 37 C.F.R. § 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation) by, *inter alia*, (i) submitting to the USPTO trademark documents, including declarations, that were not signed by the named signatory or allowing other persons to do so; and (ii) falsely certifying under § 11.18 that the factual assertions presented in trademark document (*i.e.*, the named signatory signed the document being presented to the USPTO) were true when the named signatory did not sign certain trademark documents submitted to the USPTO; and/or
- h. 37 C.F.R. § 11.804(d) (engaging in conduct prejudicial to the administration of the USPTO trademark registration system) by, *inter alia*, (i) allowing his non-practitioner assistant to review responses to Office Actions prepared by foreign entities, sign Respondent's name to the responses, and file the responses; (ii) otherwise allowing his non-practitioner assistant to "operate" while Respondent was out of town or had limited access to a computer by signing and/or filing trademark applications and other documents with the Office; (iii) knowingly submitting to the USPTO trademark documents, including declarations, that were not signed by the named signatory; (iv) falsely certifying under § 11.18 that the factual assertions presented in trademark document (*i.e.*, the named signatory signed the document being presented to the USPTO) were true when the named signatory did not sign certain trademark documents submitted to the USPTO; and (v) not having adequate controls in place to ensure the appropriate use of the H-SIGN signature method for trademark applications.

70. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct in connection with his patent practice before the USPTO:

- a. 37 C.F.R. § 11.101 (not providing competent representation to a client) by, *inter alia*, (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO; (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant; (iii) presenting certifications of micro entity status to the USPTO when the applicant was not entitled to micro entity status; (iv) submitting patent documents to the USPTO (*e.g.*, certifications of micro entity status) containing missing information, which invoked the Office to issue Notices to File Missing Parts and, at times, Notices of Incomplete Replies; (v) not

notifying the USPTO of applicants' loss of micro entity status and, instead, filing certifications of micro entity status when the applicant was not entitled or no longer entitled to micro entity status; (vi) impermissibly signing oaths of inventorship on behalf of inventors; and (vii) generally engaging in a pattern of otherwise sloppy practice before the USPTO in the handling of clients' design patent applications (e.g., as evidenced by the filing of the same figures for different applications);

- b. 37 C.F.R. § 11.103 (diligence) by, *inter alia*, (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO; (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant; (iii) presenting certifications of micro entity status to the USPTO when the applicant was not entitled to micro entity status; (iv) submitting patent documents to the USPTO (e.g., certifications of micro entity status) containing missing information, which invoked the Office to issue Notices of Missing Parts and, at times, Notices of Incomplete Replies; (v) not notifying the USPTO of applicants' loss of micro entity status and, instead, filing certifications of micro entity status when the applicant was not entitled or no longer entitled to micro entity status; (vi) impermissibly signing oaths of inventorship on behalf of inventors; and (vii) generally engaging in a pattern of otherwise sloppy practice before the USPTO in the handling of clients' design patent applications (e.g., as evidenced by the filing of the same figures for different applications);
- c. 37 C.F.R. § 11.303(a)(1) and (a)(3) (knowingly making false statements of material facts to a tribunal or offering evidence the practitioner knows to be false) by, *inter alia*, (i) signing improper micro entity certifications and (ii) signing inventor oaths/declarations on behalf of the named signatory and submitting the oaths/declarations to the USPTO knowing that the named signatory did not sign the oath/declaration;
- d. 37 C.F.R. § 11.503(a) and (b) (supervision of non-practitioner assistants) by, *inter alia*, not adequately supervising or monitoring the foreign representatives' activities connected to determining whether the applicant meets the requirements for micro entity status (e.g., ensuring that the applicant signed the translated micro entity status forms) such that Respondent signed and presented certificates of micro entity status claims to the Office where the applicant did not meet the requirements for micro entity status;
- e. 37 C.F.R. § 11.804(c) (engage in conduct involving dishonesty, fraud, deceit or misrepresentation) by, *inter alia*, (i) signing inventors' signatures to inventors' oaths and declarations or allowing others to do so; (ii) submitting patent documents to the Office (e.g., inventor oaths/declarations) or allowing others to do so that were not

signed by the named signatory; and (iii) improperly establishing or paying fees for micro entity status on behalf of unentitled patent applicants; and/or

- f. 37 C.F.R. § 11.804(d) (conduct prejudicial to the administration of the USPTO patent process) by, *inter alia*, (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO; (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant; (iii) presenting incorrect certifications of micro entity status to the USPTO at the time applications were filed; (iv) claiming micro entity status when authorizing the payment of micro entity issue fees even though the applicant was no longer entitled to micro entity status; and (v) not notifying the USPTO of applicants' loss of micro entity status and, instead, filing certifications of micro entity status when the applicant was not entitled or no longer entitled to micro entity status; (vi) impermissibly signing oaths of inventorship on behalf of inventors; and (vii) filing responses to Notices of Missing Parts that were incomplete and invoked the Office to issue Notices of Incomplete Replies.

Agreed-Upon Sanction

71. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:

- a. Respondent is suspended from practice before the Office for a period of fourteen (14) months;
- b. Respondent is to remain suspended from practice before the USPTO until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60;
- c. Respondent shall serve a probationary period that commences on the date the Final Order is signed and terminates twenty-four (24) months after a decision by the OED Director granting a petition seeking Respondent's reinstatement to practice before the USPTO;
- d. Respondent shall comply fully with 37 C.F.R. § 11.58;

e. Respondent may satisfy his obligations under 37 C.F.R. § 11.58(c)(3)(i) for those clients who are domiciled in a foreign country and have immediate or prospective business before the Office in patent, trademark, or other non-patent matters (e.g., trademark applicants, parties before the USPTO Trademark Trial and Appeal Board, patent applicants, parties before the USPTO Patent Trial and Appeal Board) by emailing, in the client's native language, the requisite 37 C.F.R. § 11.58 notices and information (including a copy of the Final Order that has been correctly translated into the client's native language) to:

1. the email address for each client and, if applicable, the email address as set forth in the "Applicant's Information" portion of each client's trademark application, but only if such email address is an email address belonging to the client and one that Respondent reasonably believes to which the client has direct access (*i.e.*, not the email address belonging to a foreign referring entity);
2. an email address belonging to the client and one that Respondent reasonably believes to which the client has direct access (*i.e.*, not the email address belonging to a foreign-domiciled third person or a foreign domiciled entity who referred the matter to Respondent); or
3. the foreign-domiciled third person or a foreign-domiciled entity who referred the matter to Respondent, but only if:
 - A. Respondent takes reasonable measures to ensure that the foreign-domiciled third person or a foreign-domiciled entity thereafter promptly

forwards Respondent's email to the client with the translated Final Order attached and Respondent is copied on the forwarded email;

- B. Respondent takes reasonable measures to learn from the foreign-domiciled third person or a foreign-domiciled entity that the client actually received the Respondent's email and translated Final Order forwarded to the client;
- C. Respondent's affidavit submitted pursuant to 37 C.F.R. § 11.58(d) sets forth the details of his/her reasonable measures that are required by subparagraphs 37 C.F.R. § 11.58(c)(3)(i) and (ii) immediately above; and
- D. any petition for reinstatement filed by or on behalf of Respondent sets forth the details of his reasonable measures that are required by subparagraphs 37 C.F.R. § 11.58(c)(3)(i) and (ii) immediately above;

f. Respondent shall be granted limited recognition pursuant to 37 C.F.R. § 11.58(f) for thirty (30) days starting on the date of the Final Order approving this Agreement so that Respondent may endeavor to conclude work on behalf of clients on any matters pending before the Office and, if such work cannot be concluded within such thirty (30) days, Respondent shall so advise each such client so that the client may make other arrangements;

g. Effective the date of the expiration of the 30-day period of limited recognition afforded to Respondent under 37 C.F.R. § 11.58(f), the USPTO is hereby authorized to disable or suspend any USPTO.gov accounts registered to Respondent as of the date of the

Final Order approving this Agreement (including all accounts that Respondent has ever established, sponsored, used in connection with any trademark or patent matter);

h. Respondent shall not apply for a USPTO verified Electronic System account, shall not obtain a USPTO verified Electronic System account, nor shall he have his name added to a USPTO verified Electronic System account, unless and until he is reinstated to practice before the USPTO;

i. Immediately upon expiration of the 30-day period of limited recognition afforded to Respondent under § 11.58(f), Respondent is prohibited from using, assessing, or assisting others in using or accessing any USPTO.gov account(s) or other USPTO filing systems for preparing or filing documents with the USPTO;

j. Until a petition seeking Respondent's reinstatement to practice before the USPTO is granted pursuant to 37 C.F.R. § 11.60, Respondent shall be prohibited, and the USPTO is authorized to disallow Respondent, from the following: (1) opening or activating any USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; (2) applying for, or attempting to apply for any USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; (3) verifying, or attempting to verify, any other person's credentials in connection with USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; and (4) sponsoring or attempting to sponsor USPTO.gov account(s) to be used for preparing or filing documents with the USPTO;

k. Nothing herein shall obligate the USPTO to take action, *sua sponte*, to re-activate any USPTO.gov account disabled or suspended pursuant to this order; rather, it is

Respondent's sole responsibility to initiate any such re-activation of any such USPTO.gov account;

1. Respondent shall cooperate fully with the USPTO in any present or future USPTO inquiry made into the following companies: Xinyue Technology Co. Ltd.; INIPA; Shenzhen BiaoDaGe Enterprise Consulting Co. Ltd.; Shenzhen Seller Growth Network Tech. Ltd.; Shanghai Maidetong Software Technology Co. Ltd. (aka "IPP Master"); Shenzhen SeaArea IPR Technology Co., Ltd.; One Stop Cross-Border Electricity Suppliers Service; or any foreign associates with whom Respondent worked in connection with trademark or patent documents submitted to the USPTO.

m. (1) If the OED Director is of the good faith opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of this Agreement, the Final Order (including compliance with 37 C.F.R. § 11.58), or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to an additional six (6) months for the violations set forth in the Joint Legal Conclusions, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and

(2) In the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with the USPTO Rules of Professional Conduct, the OED Director shall:

- (A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position; and
- (B) request that the USPTO Director enter an order immediately suspending Respondent for up to an additional six (6) months for the violations set forth in the Joint Legal Conclusions above;

n. Nothing herein shall prevent the OED Director from seeking discrete discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the preceding subparagraph;

o. In the event the Respondent seeks a review of any action taken pursuant to subparagraph m, above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;

p. While Respondent is on probation, Respondent shall, at least on a bi-weekly basis, (i) search the USPTO's online trademark search system (currently located at <https://tmsearch.uspto.gov/search/search-information>) for applications identifying him as the attorney of record; and (ii) promptly inform in writing the USPTO Office of Trademark Examination Policy of each trademark document filing identifying him as the attorney of record that was made without his knowledge or consent;

q. While Respondent is on probation, Respondent shall, at least on a bi-monthly basis, submit a written report to the OED Director stating that he has completed the monthly searches of the online trademark search system, and, as applicable, (i) stating that he identified no applications or other trademark filing in which he was named as the attorney of record that were not made by him or without his knowledge and consent; or (ii) providing copies of correspondence sent to the USPTO Office of Trademark Examination Policy as described in the preceding subparagraph;

r. As a condition of being reinstated to practice before the USPTO, Respondent shall provide to the OED Director a declaration, affidavit, or statement in compliance with 28 U.S.C. § 1746 signed by Respondent stating that he has successfully completed six (6) hours of continuing legal education credit on ethics/professional responsibility;

s. Respondent shall have a Trademark Practice Monitor during the portion of his probation that commences upon his being reinstated to practice before the Office and that the Trademark Practice Monitor shall be an attorney (1) who is a member in good standing of the bar of the highest court of 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, (2) who is in “active” status before the such court during such portion of the probation, and (3) who has been continuously engaged in trademark practice before the Office for at least five (5) years immediately preceding Respondent’s reinstatement;

t. Respondent shall have a Patent Practice Monitor during the portion of his probation that commences upon his being reinstated to practice before the Office and that the Patent Practice Monitor shall be a person (1) who is registered by the USPTO to

practice before the Office in patent matters, (2) who is in “active” status before the USPTO during such portion of the probation, and (3) who has been continuously engaged in patent practice before the Office for at least five (5) years immediately preceding Respondent’s reinstatement;

u. The Trademark Practice Monitor and the Patent Practice Monitor may be the same person provided that such person satisfies the aforementioned qualification requirements for being the Trademark Practice Monitor and the Patent Practice Monitor;

v. During the duration of that part of Respondent’s probation commencing on the date of his reinstatement, Respondent shall provide each practice monitor with firm documents, client records, and other information the practice monitor may request concerning the report, inquiry, and audit referenced in subparagraphs w and x;

w. Every three (3) months, during the duration of that part of Respondent’s probation commencing on the date of his reinstatement, each practice monitor shall submit a written report to the OED Director verifying whether, in the professional opinion of the practice monitor—formed after conducting an inquiry reasonable under the circumstances, including, an audit of a reasonable number of Respondent’s filings—Respondent’s processes for obtaining and evaluating information concerning clients’ trademark or patent matters are adequate to ensure that Respondent’s presentation of documents to the USPTO comply with the TMEP and MPEP. The Practice Monitor’s quarterly report to the OED Director shall identify with specificity his or her concerns with Respondent’s processes and Respondent’s intended changes to address such concerns. Further, the Practice Monitor’s quarterly report to the OED Director shall identify the specific filings, in the

professional opinion of the Practice Monitor, represent significant problems requiring corrective action;

x. The Practice Monitor's initial report shall be filed promptly with the OED Director within ninety-one (91) days of the date of a decision granting a petition requesting Respondent's reinstatement to practice before the Office; and the Practice Monitor's subsequent quarterly reports shall be promptly filed every ninety (90) days thereafter (*i.e.*, 181 days after granting such petition; 271 days after granting such petition; etc.);

y. Respondent is responsible for the timely submission of the Practice Monitor's quarterly reports, and the failure of Respondent to ensure that the Practice Monitor submits the required written reports promptly shall be appropriate grounds for the OED Director to issue a show cause pursuant to subparagraph m, above;

z. The intent of the practice monitor's report, inquiry, and audit is to increase the effectiveness of the practice monitor in assisting Respondent to represent clients before the Office competently and ethically. To the extent the Practice Monitor has concerns based upon any aspect of the audit referenced in the preceding subparagraphs, the Practice Monitor shall make suggestions or recommendations to Respondent to alleviate such concerns and to help ensure implementation of prudent and effective procedures. Specifically, (a) the Trademark Practice Monitor shall make specific suggestions necessary to assure that Respondent's presentation of trademark documents to the Office complies with all provisions of the USPTO Trademark Manual of Examining Procedure ("TMEP") and (b) the Patent Practice Monitor shall make specific suggestions necessary to assure that Respondent's presentation of patent documents to the Office complies with

all provisions of the USPTO Manual of Patent Examining Procedure (“MPEP”);

aa. Respondent shall take reasonable steps to ensure that, whenever the practice monitor views confidential client information, the practice monitor understands and agrees that such matters are to remain confidential pursuant to 37 C.F.R. § 11.106;

bb. Respondent shall be responsible for paying all costs associated the Trademark Practice Monitor and the Patent Practice Monitor, including the costs, expenses, and fees of the practice monitor (if any are so charged by such practice monitor);

cc. Nothing in the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of similar misconduct concerning Respondent brought to the attention of the Office; and/or (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;

dd. The OED Director shall electronically publish the Final Order at the OED’s electronic FOIA Reading Room, which is publicly accessible through the Office’s website at: <https://foiadocuments.uspto.gov/oed/>;

ee. The OED Director shall publish a notice in the Official Gazette that is materially consistent with the following:

Notice of Suspension and Probation

This notice concerns Mr. Che-Yang Chen of Diamond Bar, California, an attorney licensed in the District of Columbia who engaged in practice before the United

States Patent and Trademark Office (“USPTO”) or (“Office”). Mr. Chen is also a USPTO-registered patent attorney (Reg. No. 64015). The USPTO Director has suspended Mr. Chen from practice before the Office for a period of fourteen (14) months and placed him on probation, and ordered that his trademark and patent practice be formally monitored upon being reinstated to practice before the Office. This disciplinary sanction is based on Mr. Chen having violated the following provisions of the USPTO Rules of Professional Conduct: §§ 11.101 (lack of competence); 11.103 (lack of diligence); 11.104(a)(3) and (b) (inadequate communication with clients); 11.303(a)(1) and (3) (lack of candor to the tribunal — i.e., the USPTO); 11.503(a) and(b) (failure to adequately supervise non-practitioner assistants); 11.505 (assisting others unauthorized practice before the USPTO); 11.804(c) (engage in conduct involving dishonesty, fraud, deceit or misrepresentation); and 11.804(d) (engaging in conduct prejudicial to the integrity of the U.S. trademark registration and U.S. patent issuance processes).

Mr. Chen is the sole principal of the Law office of Michael Chen. At all relevant times, Mr. Chen maintained a business relationship with numerous foreign located trademark and patent companies. In connection with his business relationships with these companies, Mr. Chen became the attorney of record for foreign-domiciled trademark applicants in over 9,000 trademark applications filed with the USPTO between January 2021 and December 2022. Respondent received between \$20 and \$50 per trademark application. Also, in connection with his business relationships with the foreign-located companies, Mr. Chen became the attorney of record on over 2,000 design patent applications filed with the USPTO between January 2021 and August 2023. Mr. Chen received between \$100 to \$250 per design application.

Regarding his unethical trademark practice before the USPTO, Mr. Chen violated numerous ethics rules and trademark rules of practice. He impermissibly directed his assistant to sign his name to trademark documents that were then filed with the Office, many of these documents contained sworn oaths on which the USPTO relied during *ex parte* proceedings to make factual and legal determinations regarding the applicants’ respective intellectual property rights. Such conduct violated the trademark signature rules set forth in 37 C.F.R. § 2.193 and the express guidance set forth in section 611.01(c) of the Trademark Manual of Examining Procedure. Mr. Chen also impermissibly allowed his non-practitioner assistant to draft responses to Office Actions, that often contained legal argument, then directed his assistant to review, sign his name, and file the responses to Office Actions with the USPTO – i.e., assist in the unauthorized practice of law before the USPTO. He also violated 37 C.F.R. § 11.18 when presenting trademark documents to the USPTO without conducting an inquiry reasonable under the circumstances.

Regarding his unethical patent practice before the USPTO, Mr. Chen signed his clients’ names to inventorship oaths accompanying design patent applications filed them with the Office, in violation of the patent signature rules found in 37 C.F.R. §

1.4(d). Mr. Chen also impermissibly signed and filed design patent applications claiming micro entity status when the client did not qualify for micro entity status. He also violated 37 C.F.R. § 11.18 when presenting patent documents to the USPTO without conducting an inquiry reasonable under the circumstances.

This action is the result of a settlement agreement between Mr. Chen and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <https://foiadocuments.uspto.gov/oed>;

ff. Based on Respondent's agreement to do so, Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner;

gg. Within a reasonable period after the entry of the Final Order approving this Agreement, the OED Director shall file a motion dismissing the pending disciplinary action without prejudice; and

hh. As a condition of being reinstated, Respondent shall comply fully with all Provisions of 37 C.F.R. § 11.60.

Users, Shewchuk, David
Digitally signed by
Users, Shewchuk, David
Date: 2024.03.20
11:02:32 -04'00'

David Shewchuk
Deputy General Counsel for General Law
United States Patent and Trademark Office

Date

on delegated authority by

Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing Final Order was sent, on this day, to the parties in the manner indicated below-

Via e-mail:

Michael E. McCabe, Jr.
Emil Ali
mike@mccabeali.com
emil@mccabeali.com
Counsel for Respondent

Hendrik deBoer
Melinda DeAtley
Hendrik.deboer@uspto.gov
Melinda.deatley@uspto.gov
[REDACTED]
Counsel for the OED Director

Date

Users, Walker,
Robert (Shawn)

Digitally signed by Users,
Walker, Robert (Shawn)
Date: 2024.03.20 13:02:14 -04'00'

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450