

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

In the Matter of	)	
	)	
Rumit R. Kanakia	)	Proceeding No. D2023-25
	)	
Respondent	)	
<hr/>	)	

**FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Rumit R. Kanakia (“Respondent”) have submitted a Proposed Settlement 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. At all times relevant, Respondent of Mumbai, India, has been a registered patent attorney (USPTO Registration Number 72,461) and, therefore is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*

2. 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, and 11.26.

## Legal Background

### Micro Entity Status for Certain Patent Applicants

3. 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.

4. There are two separate bases for establishing micro entity status. One is referred to as the “gross income basis” under 35 U.S.C. § 123(a), and the other is referred to as the “institution of higher education basis” under 35 U.S.C. § 123(d). *See* MPEP § 509 (“II. Bases for Establishing Micro Entity Status.” Under the “gross income basis” for establishing micro entity status, there is a limit to the number of previously filed applications for an applicant to qualify for micro entity status.

5. In order to qualify as a micro entity, patent applicants must certify that:

- (1) the applicant qualifies as a small entity as defined in 37 C.F.R. § 1.27;
- (2) neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed patent applications;
- (3) neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income . . . exceeding three times the median household income for that preceding calendar year; and
- (4) neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that . . . had a gross income . . . exceeding three times the median household income for that preceding calendar year . . . .

*See generally* 37 CFR § 1.29; MPEP § 509.04 (underline added).

### Calculating the “Previously Filed Applications” Limit

6. For purposes of establishing micro entity status under the “gross income” basis, the application filing limit includes: (i) previously filed U.S. nonprovisional applications (e.g., utility, design, plant, continuation, and divisional applications), (ii) previously filed U.S. reissue applications, and (iii) previously filed U.S. national stage applications under the Patent Cooperation Treaty (PCT). *See* MPEP § 509.04(a) (“B. Application Filing Limit”)

7. “All such applications naming the inventor or a joint inventor are counted toward the application filing limit, whether the applications were filed before, on, or after March 19, 2013. Further, it does not matter whether the previously filed applications are pending, patented, or abandoned; they are still included when counting to determine whether the application filing limit has been reached.” MPEP § 509.04(a) (“B. Application Filing Limit”)

8. “The application filing limit does not include: (i) foreign applications; (ii) international (PCT) applications for which the basic U.S. national stage filing fee was not paid; and (iii) provisional applications. In addition, where an applicant, inventor, or joint inventor has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant’s, inventor’s, or joint inventor’s previous employment; the applicant, inventor or joint inventor is not considered to be named on the prior filed application for purposes of determining micro entity status. *See* 37 CFR 1.29(b).” MPEP § 509.04(a) (“B. Application Filing Limit”)

9. “Because the four application limit is a limit on previously filed U.S. nonprovisional applications, reissues applications, and national stage applications, the maximum number of applications in which fees can be paid at the micro entity discount rate can vary from 0 to 5 for any given inventor.” MPEP § 509.04(a) (“B. Application Filing Limit”)

### Certification of Micro Entity Status

10. “35 U.S.C. 123 requires a certification as a condition for an applicant to be considered a micro entity. 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.” MPEP § 509.04

11. “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).” MPEP § 509.04

12. “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. See 37 CFR 1.29(j).” MPEP § 509.04

### Reevaluation of Micro Entity Status; Notifying the USPTO; and Correcting Errors of Micro Entity Status

13. An applicant is not required to provide a certification of micro entity status with each fee payment once micro entity status has been established by filing a certification in an application. *See* MPEP § 509.04(d).

14. While an applicant is not required to provide such a certification with each fee payment, the applicant must still be entitled to micro entity status to pay a fee in the micro entity amount at the time of all payments of fees in the micro entity amount. Thus it must be determined whether the requirements for micro entity status exist at the time each fee payment is made. *See* MPEP § 509.04(d).

15. If any requirement for micro entity status is no longer met, then the applicant must notify the Office of loss of micro entity status and pay the required fee in the small entity or undiscounted amount, as appropriate. *See* MPEP § 509.04(d); *see also* MPEP § 509.04(e).

16. If (a) an applicant or patentee establishes micro entity status in an application or patent in good faith; (b) the applicant or patentee pays fees as a micro entity in the application or patent in good faith; and (c) the applicant or patentee later discovers that such micro entity status either was established in error, or that the Office was not notified of a loss of entitlement to micro entity status as required through error, the error will be excused upon compliance with the separate submission and itemization requirements of 37 C.F.R. § 1.29(k)(1) and the deficiency payment requirement of § 1.29(k)(2). *See* MPEP § 509.04(f).

#### Certifications to the USPTO when Presenting Papers

17. Registered practitioners make important certifications via 37 C.F.R. § 11.18 whenever presenting (*e.g.*, by signing, filing, submitting, or later advocating) any paper to the USPTO.

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

19. The registered 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). Accordingly, a registered practitioner who presents any paper to the USPTO—including certifications of micro entity status—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).

20. 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).

21. Any registered 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**

#### **A. Respondent**

22. The USPTO registered Respondent as a registered patent attorney (Reg. No. 72,461) on April 7, 2014, and he currently resides in Mumbai, India.

23. Respondent is also an attorney who was licensed by California on June 4, 2013 (California Bar # 289577) and by Texas on July 15, 2021 (Texas Bar # 24124286).

#### **B. KA Filing, KA Partners, and KAanalysis**

24. According to publicly available online records from the Florida Department of State, “KA Filing, LLC” is a Florida limited liability company (FEI/EIN Number 83-3415941) located at 2112 W. Marjory Avenue, Tampa, Florida, and its managers are Nilanshu Shekhar, Ashutosh Choudhary, and Wayne V. Harper.

- a. Mr. Shekhar and Mr. Choudhary are non-practitioners. *See* 37 C.F.R. § 11.1 (definition of “practitioner”). According to Respondent, Mr. Shekhar and Mr. Choudhary are intellectual property lawyers licensed in India.

b. Mr. Harper is a registered practitioner who is currently on disability inactive status. *See In re Harper*, Proceeding No. D2010-10 (USPTO Oct. 2, 2020 “Notice of Transfer to Disability Inactive Status”).

25. Respondent’s relationship with KA Filing, LLC began approximately in December 2018 when he was contacted by two individuals who owned the company.

26. Respondent represents that KA Partners is an Indian law firm located in New Delhi, India. Respondent further represents that KA Partners uses the alternative business name, KAnalysis.

27. Respondent’s relationship with KA Partners began in or around December 2020 when he starting working directly for KA Partners in an “Of Counsel” capacity.

28. Respondent understands that KA Filing LLC is “U.S. affiliate” of KA Partners and that the two companies have maintained an active business relationship since 2018. According to Respondent, KA Partners and KA Filing LLC are essentially the same entity (*e.g.*, sharing the same office space and office staff).

29. Hereinafter, KA Partners, KAnalysis, and KA Filing are jointly referred to as “KA.”

30. KA conducts business with numerous foreign-domiciled companies—including many located in China—that refer patent applicants seeking U.S. patent protection to KA.

31. Respondent understands that the foreign associates include, but are not limited to,

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

32. Respondent understands that KA is currently managing a portfolio of 15,000 patents in over 80 countries.

33. In December 2020, Respondent became the USPTO registered practitioner of record for thousands of patent clients referred to KA for filing and prosecuting patent applications before the USPTO.

34. Respondent represents that he already gave his notice of resignation and intends to resign from his “Of Counsel” position with KA effective May 31, 2023 due to a personal emergency.

C. USPTO Customer Number for KA Filing

35. In February 2019, the USPTO issued a Customer Number to a registered practitioner previously affiliated with KA. The name and correspondence address for the Customer Number was “KA Filing, LLC., 2112 W. Marjory Ave., Tampa, FL 33606.”

36. At all relevant times, Respondent was associated with that Customer Number.

37. From January 15, 2021, through February 3, 2023, Respondent was the only registered practitioner in active status associated with that USPTO Customer Number.

38. Over 4,300 design patent applications were filed with (or received by) the USPTO from January 15, 2021, through February 3, 2023, that are associated with that USPTO Customer Number as of the date of this Agreement.

39. Respondent was the only registered practitioner associated with over 1,850 design patent applications filed with the USPTO in 2022 associated with that Customer Number.



#### D. Respondent's Improper Certifications of Micro Entity Status

40. Respondent represents that he supervised a team of twelve (12) employees of KA and took charge of its U.S. operations. Respondent's team currently includes two partners and ten support staff including paralegals, draftsmen and office staff. None of the persons on Respondent's team were practitioners. Respondent's team of non-practitioner assistants helped Respondent in obtaining client entity status information besides helping him in all other aspects of his practice.

41. Respondent explained that he and his team had a difficult time obtaining information about the applicant's eligibility for micro entity status. Respondent explained that this was, in part, due to language and cultural barriers and the Respondent relied upon instructions from foreign associates. He also explained how no information about the China-based applicants could readily be found online. Respondent acknowledges that these challenges in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

42. The USPTO issued Notices of Payment Deficiency in applications that were filed where the applicant, inventor, or joint inventor was named on more than four previously filed patent applications. Each notice informed applicant that there was *prima facie* evidence that the certification of micro entity was in error because the filing limit was exceeded. Further, each notice informed applicant that to avoid abandonment, if the certification was erroneous, applicant had to provide an itemization of the total deficiency payment and pay the deficiency owed or if applicant asserted the certification of micro entity was not made in error, applicant had to reply with an explanation and necessary evidence that is sufficient to rebut the *prima facie* evidence.

43. Specifically, between August 2021 and February 2022, the USPTO issued a Notice of Payment Deficiency for several design patent applications that were filed under the Customer Number for KA Filing. A review of the notices revealed Mr. Kanakia was responsible for filing the Certification of Micro Entity in fifty-five (55) of those design patent applications, and personally signed the Certification with the USPTO for thirty-seven (37) of those fifty-five (55) applications. Most of the affected applications were filed on behalf of applicants domiciled in China.

44. Based upon the representations made to him by the foreign associate for the applicants, Respondent personally signed the Certification of Micro Entity submitted in thirty-seven (37) of the aforementioned 55 design patent applications. Respondent represents that he signed twenty-seven (27) of the 37 certifications because regulations require that all filings for a juristic entity be signed by the practitioner of record—or if not a juristic entity, by the practitioner or all joint inventors. *See 37 CFR § 1.33.* Respondent represents that ideally, he should have had the inventors sign the certifications in the remaining ten (10) applications; however, he believes he was otherwise permitted to, and in these cases, did so due to the filing requests (i.e., expedited requests or having to coordinate filings on the same exact day in different countries). Respondent acknowledges that his stated reasons for signing the certifications in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

45. Respondent acknowledged that mistakes were made by him and his team regarding the above referenced 37 applications that he signed where micro entity status was incorrectly claimed at the time of filing. Respondent acknowledged that his personally signing the USPTO

Form PTO/SB15A in some of the cases may have required some more diligence from him. Contrary to Respondent's position, the OED Director asserts that Respondent's personally signing the USPTO Form PTO/SB15A in cases in fact required some more diligence from Respondent. Respondent acknowledged that mistakes were made, in part, because of docketing problems, namely: applications not appearing in his docketing system. Respondent acknowledges that his problems with his docketing system in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

46. Despite changing the entity status and paying the deficiency fee, Respondent represents he reasonably believed that he properly signed and/or filed 27 of the 37 Certifications of Micro Entity Status because, based on his inquiry, the applications: (i) passed his internal checks and publicly available records for the number of filings and/or (ii) appeared to have assigned all ownership rights, or were obligated to assign all ownership rights, as a result of the applicant's previous employment. The OED Director disagrees that Respondent's belief was reasonable or Respondent's inquiry prior to presenting the certifications to the Office was reasonable under the circumstances.

47. Respondent also represents that he reasonably believed that, at the time of filing, his presentation of the Certifications of Micro Entity Status was proper because the requests for micro entity status were submitted to him by foreign associates (a) with whom Respondent's firm had existing relationships, (b) who had been trained as to the qualifications for micro entity status, and (c) his team checked the number of applications filed per applicant/inventor. The OED Director disagrees that Respondent's belief was reasonable or that Respondent's presentations were proper.

48. On thirteen (13) occasions, Respondent also authorized payment of a reduced micro entity patent issue fee for applicants that no longer qualified for micro entity status.

49. Respondent acknowledged that mistakes were made when paying issue fees for applicants who were no longer eligible for micro entity status because he did not have a specific process for verifying the entity status at the time of the payment of the fee.

50. Respondent represents that the period of Respondent's lapses coincided with a Covid wave in India, which was particularly devastating and impacted his firm's ability to function as the whole team was required to work remotely during the lockdown and through illnesses. Respondent acknowledges that his firm's ability to function in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

51. Respondent represents that he is currently facing a personal and family emergency. He resigned from the firm and is leaving the practice of law to focus on his family in the near future. Respondent acknowledges that his personal and family emergencies in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

52. Since the receipt of the above referenced Notices of Payment Deficiency, Respondent represents that he and his team have helped implement new policies and procedures at KA to help ensure that entity status claims are reasonably and appropriately corroborated before presenting certificates of entity status to the USPTO when filing applications, including the following:

- a. Respondent and his team at KA now send a questionnaire for all

inventors/applicants to be filled out at intake. The questionnaire is in a language that allows the information to be communicated accurately to the China-domiciled inventors/applicants. The questionnaire warns the inventors and applicants about the consequences of not being accurate with their responses while asking them about the following issues:

- i. The questionnaire asks the inventors and applicants to voluntarily list all previous US patent applications in which they have been named as inventors.
  - ii. The questionnaire asks questions pertaining to inventorship under MPEP § 2109.
  - iii. The questionnaire provides information and asks questions pertaining to patentability and on sale bar issues under AIA 35 U.S.C. § 102.
  - iv. The questionnaire asks questions that help the inventor and applicants decide which entity status to claim and informs them of the rules governing entity status discounts under MPEP §2550.
  - v. The questionnaire warns the inventors and applicants about potential damages from falsely claiming small or micro entity status under the new rules outlined in the Unleashing American Innovators Act of 2022.
  - vi. The questionnaire asks the inventors and applicants to sign the questionnaire with a handwritten signature.
  - vii. The questionnaire informs the inventors and applicants about their ongoing duty to disclose any information material to patentability under 37 C.F.R. § 1.56.
- b. Respondent and his team at KA have performed an internal audit of all US applications in its docketing system to proactively change the entity status of applications caught in its audit that were erroneously filed claiming micro entity status.
  - c. KA has assigned personnel to oversee all these checks and is in the process of increasing the personnel in charge of docketing and maintaining the docketing system.
  - d. Respondent and his team at KA are sending an inquiry email before accepting a clients' additional fees for any deficient fees to further ensure and confirm the client's eligibility for small entity status.
  - e. Respondent and his team at KA are checking with the client about any changes in entity status at the time of paying any fees (including but not limited to fees for

expedited examination, issue fees etc.).

53. In addition, regarding certification of entity status at the time of paying issue fees, Respondent recently informed the partners at KA via email of the following USPTO rules and practices to be followed to comply with such rules:

- a. While an applicant is not required to provide a certification of micro entity status with each fee payment, the applicant must still be entitled to micro entity status to pay a fee in the micro entity amount at the time of all payments of fees in the micro entity amount. Therefore, it must be determined whether the requirements for micro entity status exist at the time each fee payment is made and regardless of if there is a notice of loss of micro entity status issued by the Office.
- b. Adequate measures are to be in place to ensure that, at the time an applicant or patentee pays fees (*e.g.*, including but not limited to patent issue fees), the applicant or patentee is still entitled to micro entity status to pay a fee in the micro entity amount.
- c. The USPTO rules and regulations provide that, if any requirement for micro entity status is no longer met, the applicant must notify the Office of loss of micro entity status and pay the required fee in the small entity or undiscounted amount, as appropriate, as set forth in MPEP § 509.04(e).
- d. The USPTO rules and regulations provide that, if (a) an applicant or patentee establishes micro entity status in an application or patent in good faith, (b) the applicant or patentee pays fees as a micro entity in the application or patent in good faith, and (c) the applicant or patentee later discovers that such micro entity status either was established in error, or that the Office was not notified of a loss of entitlement to micro entity status as required through error, the error will be excused upon compliance with the separate submission and itemization requirements of 37 C.F.R. § 1.29(k)(1) and the deficiency payment requirement of 37 C.F.R. § 1.29(k)(2), as set forth in MPEP § 509.04(f).

#### **Additional Considerations**

54. Respondent has never been the subject of professional discipline by the USPTO, and he represents that he has not been disciplined on ethical grounds by any other jurisdiction.

55. Respondent has acknowledged his lapses in conducting inquiries reasonable under the circumstances as required by 37 C.F.R. § 11.18 when presenting entity status claims to the USPTO; demonstrated genuine contrition for such lapses; and accepted responsibility for his acts and omissions.

56. Respondent fully cooperated with OED's investigation by conducting a voluntary interview with OED and by providing *sua sponte* informative, supplemental responses to his original response to OED's request for information.

57. Respondent took *sua sponte* action to endeavor to comply with the professional responsibilities set forth in the USPTO Rules of Professional Conduct after he received the Notices and before the OED inquiry.

#### **Joint Legal Conclusions**

58. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, that Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.103 (diligence) *inter alia* by (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 (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (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 (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (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 not paying the required issue fee in the small entity or undiscounted amount, as appropriate; and
- b. 37 C.F.R. § 11.804(d) (conduct prejudicial to the administration of the USPTO patent process) *inter alia* by (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 (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (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 (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (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 not paying the required issue fee in the small entity or undiscounted amount, as appropriate.

### **Agreed-Upon Sanction**

59. Respondent has freely and voluntarily agreed, and it is hereby ORDERED that:

a. Respondent is publicly reprimanded;

b. 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/>;

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

### **Notice of Reprimand**

This notice concerns Runit R. Kanakia of Mumbai, India, who is a registered patent attorney (Registration Number 72,461). Mr. Kanakia is hereby reprimanded for violating 37 C.F.R. §§ 11.103 (failing to act with reasonable diligence in representing a client) and 11.804(d) (engaging in conduct that is prejudicial to the integrity of the patent process). The reprimand is predicated upon his violations of these provisions of the United States Patent and Trademark Office ("USPTO" or "Office") Rules of Professional Conduct in connection with Mr. Kanakia (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 (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (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 (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (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 not paying the required issue fee in the small entity or undiscounted amount, as appropriate.

Mr. Kanakia worked for (a) KA Filing, LLC, a Florida company and (b) KA Partners, an Indian law firm located in New Delhi, India, that uses the alternative business name, KAnalysis (jointly referred to as "KA"). Mr. Kanakia represented that KA Partners and KA Filing are essentially the same entity and have business relationships with numerous foreign-domiciled companies—including many located in China—that refer patent applicants seeking U.S. patent protection to KA Partners and KA Filing.

At all relevant times, Mr. Kanakia's team of non-practitioner assistants at KA helped Mr. Kanakia in obtaining client entity status information. Mr. Kanakia explained that he and his team had a difficult time obtaining information about the applicant's eligibility for micro entity status especially due to language and cultural barriers. He also explained how no information about the China-based applicants could readily be found online. Respondent acknowledges that these challenges in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

The USPTO issued a Notice of Payment Deficiency for fifty-five (55) design patent applications that were filed under the Customer Number for KA Filing that Mr. Kanakia was responsible for filing. A review of the fifty-five applications revealed Mr. Kanakia was responsible for filing the Certifications of Micro Entity and personally signing the Certification with the USPTO for thirty-seven (37) design patent applications. Most of the affected applications were filed on behalf of applicants domiciled in China. Based upon the representations made to him by the foreign associate for the applicants, Respondent personally signed the Certification of Micro Entity submitted in 37 of the aforementioned 55 design patent applications.

Respondent acknowledged that mistakes were made by him and his team at KA regarding the above referenced 37 applications that he signed where micro entity status was incorrectly claimed at the time of filing. Respondent acknowledged that these mistakes were made, in part, because of docketing problems. Respondent acknowledges that his problems with his docketing system in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances

prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

Respondent also acknowledged that mistakes were made when paying issue fees for applicants who were no longer eligible for micro entity status. Respondent acknowledged that these mistakes were made because he did not have a specific process for verifying the entity status at the time of the payment of the fee.

Registered practitioners are reminded of their obligations under 37 C.F.R. § 11.8 to conduct an inquiry reasonable under the circumstances whenever presenting assertions of micro or small entity status to the USPTO on behalf of a client (*e.g.*, when paying a patent application fee or patent issue fee). 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. Establishing entity status or paying fees as a micro entity improperly and with intent to deceive shall be considered as a fraud practiced or attempted on the Office. *See* 37 C.F.R. § 1.29(j); MPEP § 509.04. 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). Any registered practitioner who violates the provisions of this section may also be subject to disciplinary action. *See* 37 C.F.R. § 11.18(d).

Registered practitioners are also reminded that, even though an applicant is not required to provide a certification of micro entity status with each fee payment once micro entity status has been established by filing a certification in an application (*see* MPEP § 509.04(d)), the applicant must still be entitled to micro entity status to pay a fee in the micro entity amount at the time of all payments of fees in the micro entity amount. Thus, it must be determined whether the requirements for micro entity status exist at the time each fee payment is made. *See* MPEP § 509.04(d). If any requirement for micro entity status is no longer met, the applicant must notify the Office of loss of micro entity status and pay the required fee in the small entity or undiscounted amount, as appropriate. *See* MPEP § 509.04(d); *see also* MPEP § 509.04(e).

In reaching this Agreement, the Office of Enrollment and Discipline (“OED”) Director took into account that (a) Mr. Kanakia has never been the subject of professional discipline by the USPTO and Mr. Kanakia represents that he has not been disciplined on ethical grounds by any other jurisdiction; (b) Mr. Kanakia has acknowledged his lapses in conducting inquiries reasonable under the circumstances as required by 37 C.F.R. § 11.18 when presenting entity status claims

to the USPTO; demonstrated genuine contrition for such lapses; and accepted responsibility for his acts and omissions; (c) Mr. Kanakia cooperated with OED's investigation by offering to conduct an interview with OED and by providing *sua sponte* informative, supplemental responses to his original response to OED's request for information; and (d) Mr. Kanakia took *sua sponte* action to endeavor to comply with the professional responsibilities set forth in the USPTO Rules of Professional Conduct.

This action is the result of a settlement agreement between Respondent 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/>;

d. Respondent shall cooperate fully with the USPTO in any present or future USPTO inquiry made into improper filings by KA Filing, KA Partners (a.k.a. KAnalysis), or any foreign associates with whom these two companies have worked or to whom Mr. Kanakia has provided patent legal services.

e. Respondent shall (1) provide a copy of the Final Order to KA Filing and KA Partners (a.k.a. KAnalysis); the owners of these two companies; and to all officers, directors, and managers of these two companies and (2) retain copies of all notices sent and maintain records of the various steps taken under this subparagraph;

f. The OED Director shall provide a copy of the Final Order to all registered practitioners associated with the Customer Number referenced above as of the effective date of the Final Order.

g. The OED Director shall provide a copy of the Final Order to KA Filing's managers as identified in the public records of the Florida Department of State, at 2112 W. Marjory Avenue, Tampa, FL 33606.

h. Nothing in this Agreement or 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 the same or similar misconduct concerning Respondent brought to the attention of the Office and (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;

i. Respondent, by his agreement, has waived all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waived the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waived the right otherwise to appeal or challenge the Final Order in any manner; and

j. Each party shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.

Users,  
Shewchuk,  
David

Digitally signed by  
Users, Shewchuk, David  
Date: 2023.05.08  
16:26:29 -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 via email-

Emil Ali  
[emil@mccabeali.com](mailto:emil@mccabeali.com)  
*Counsel for Respondent*

Hendrik deBoer  
  
*Counsel for the OED Director*

\_\_\_\_\_  
Date

Users, Walker, Robert (Shawn)  Digitally signed by Users, Walker, Robert (Shawn)  
Date: 2023.05.09 13:04:39 -04'00'

---

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