

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

In the Matter of)	
)	
Jinggao Li,)	Proceeding No. D2023-19
)	
Respondent)	
_____)	

AMENDED FINAL ORDER¹

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Jinggao Li (“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 conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Norwalk, Connecticut, was a registered patent attorney (Registration Number 64,450). Respondent 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

¹ This Amended Final Order is being issued to change the reference to Dr. Li’s gender pronoun, in paragraph 24(e), from “her” to “his.”

3. A party, such as Respondent, presenting any paper to the USPTO (whether by signing, filing, submitting, or later advocating) certifies that:

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To 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.

See 37 C.F.R. § 11.18(b).

4. At all times relevant to this matter, patent applicants who qualify as micro entities are entitled to a significant reduction on most USPTO patent fees. In order to qualify as a micro entity on a gross income basis, the applicant must file a Certification of Micro Entity Status with the USPTO that certifies the following—

(1) The applicant qualifies as a small entity as defined in 37 C.F.R. § 1.27 without relying on a government use license exception under 37 C.F.R. § 1.27(a)(4);

(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, other than applications filed in another country, provisional applications under 35 U.S.C. 111(b), or international applications for which the basic national fee under 35 U.S.C. 41(a) was not paid;

(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, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census; 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, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

See generally 37 C.F.R. § 1.29(a) and Manual of Patent Examining Procedure § 509.04(a).

5. A willful false claim of micro entity status may be considered fraud on the USPTO and can adversely affect the proceeding. *See* 37 C.F.R. § 1.29(j), 37 C.F.R. § 11.18(b)(1) (citing to 18 U.S.C. 1001) and (c).

Joint Stipulated Facts

6. At all times relevant, Respondent was a registered patent attorney and was licensed to practice law in the states of Connecticut and New York.

7. Respondent is the sole owner of the Dragon Sun Law Firm, P.C. (“the Firm”).

8. The Firm presented approximately 630 design patent applications filed with the USPTO on behalf of applicants between August 2019 and September 2021 (“the relevant time period”). Respondent acknowledges that, as the sole owner of the Firm, he was responsible for the Firm’s presentation of documents to the USPTO during the relevant time period.

9. The USPTO issued a Notice of Payment Deficiency for each of twenty-nine (29) design patent applications that Respondent filed during the relevant time period. The Notices were issued beginning on August 16, 2021, after Respondent had filed twenty-eight (28) of the twenty-nine (29) design patent applications.

10. Respondent personally signed the Certifications of Micro Entity Status in twenty-seven (27) of the twenty-nine (29) design patent applications issued a Notice; two (2) of the twenty-nine (29) were signed by the inventor.

11. Each Notice was issued based on *prima facie* evidence that the micro entity application filing limit in 37 C.F.R. § 1.29(a)(2) had been exceeded by the applicant and/or inventor(s) listed in each design patent application.

12. In response to the Notices, Respondent changed the entity status and paid the deficient amount on all the design patent applications but one, which was abandoned.

13. Despite changing the entity status and paying the deficient amount, Respondent represents that he reasonably believed that, at the time of filing, his presenting of the twenty-nine (29) Certifications of Micro Entity Status (twenty-seven (27) that he personally signed) was proper because the requests for micro entity status were submitted to him by foreign law firms (i) with whom Respondent had multi-year relationships, (ii) who had been granted power of attorney by the applicants, and (iii) whom Respondent had instructed as to the qualifications for micro entity status. Respondent, however, did not conduct a reasonable inquiry into the Firm's own past filings on behalf of certain applicant/inventor(s). Respondent represents that his inability to identify when the micro entity application filing limit was exceeded by the applicant and/or inventor(s) for each of the design patent applications was due, in part, to shortcomings in the Firm's then-current docketing system.

14. Respondent acknowledges that nineteen (19) of the aforementioned twenty-nine (29) Certifications of Micro Entity Status were filed in error with the USPTO. Specifically, Respondent represents that the aforementioned inadequacies with the Firm's docketing system for which he was responsible, contributed to his inability to identify when the micro entity application filing limit was exceeded by the applicant and/or inventor(s) for each of those nineteen (19) design patent applications.

15. Respondent *sua sponte* adopted measures intended to prevent the recurrence of the incorrect certification of micro entity status, including the creation of a shared docket management system after Respondent received the Notices and prior to his November, 2022 receipt of the OED inquiry. Since implementing those measures, the Firm has not received any Notices of Payment Deficiency.

16. Respondent also conducted an internal audit of all existing applications claiming micro entity status that revealed at least an additional three (3) unqualified applications were presented to the USPTO in violation of the micro entity application filing limit in 37 C.F.R. § 1.29(a)(2). Each of these applications has been changed to small entity status and the additional fees paid.

17. Respondent represents that the Firm no longer accepts claims for micro entity status.

Additional Considerations

18. 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.

19. Respondent has acknowledged his lapses, demonstrated genuine contrition, and accepted responsibility for his acts and omissions.

20. Respondent cooperated with OED's investigation by offering to conduct a telephonic interview with OED and by providing *sua sponte* informative, supplemental responses to his original responses to requests for information.

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

22. Respondent represents that he is, and has been, an active participant in providing pro bono legal services to his community, including legal assistance to a regional cultural institution and financially under-resourced inventors, amounting to approximately eighty (80) hours per year.

Joint Legal Conclusions

23. 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) by (i) not always conducting a reasonable inquiry under the circumstances pursuant to 37 C.F.R. § 11.18 prior to presenting certifications of micro entity status to the USPTO and (ii) not having had in place adequate procedures to ensure that certifications of micro entity status complied with USPTO regulations; and
- b. 37 C.F.R. § 11.804(d) (engaging in conduct that is prejudicial to the integrity of the patent application process) by (i) not having always conducted a reasonable pre-filing inquiry under the circumstances pursuant to 37 C.F.R. § 11.18 prior to presenting certifications of micro entity status to the USPTO; and (ii) not having had in place adequate procedures to ensure that certifications of micro entity status complied with USPTO regulations.

Agreed-Upon Sanction

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

- a. Respondent shall be and is hereby 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 Jinggao Li of Norwalk, Connecticut, who is a registered patent attorney (Registration Number 64,450). Dr. Li is hereby reprimanded for violating 37 C.F.R. §§ 11.103 (not always acting with reasonable diligence in representing a client) and 11.804(d) (engaging in conduct that is prejudicial to the integrity of the patent application process). The reprimand is predicated upon Dr. Li's violations of these provisions of the United States Patent and Trademark Office ("USPTO") Rules of Professional Conduct in connection with the submission of erroneous Certifications of Micro Entity Status. *See* 37 C.F.R. § 1.29(a)(2).

The USPTO notified Dr. Li of twenty-nine (29) errors where the micro entity application filing limit appeared to be exceeded in applications filed by applicants of design patent applications. As the attorney of record for these applications, Dr. Li presented (including personally signing many) the respective Certifications of Micro Entity Status certifying that "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 U.S. patent applications . . ." Dr. Li explained that a reasonable inquiry could not be always performed prior to presentation of the applications to USPTO due, in large part, to shortcomings of his firm's then-existing docketing system or his reliance on representations made by applicants' foreign counsel. Dr. Li acknowledges that (i) he did not always conduct a reasonable inquiry under the circumstances pursuant to 37 C.F.R. § 11.18 prior to presenting certifications of micro entity status to the USPTO on behalf of certain applicant/inventor(s) and (ii) he did not have in place at the time of the micro entity certifications adequate procedures to ensure that certifications of micro entity status complied with USPTO regulations.

In reaching this settlement, the Office of Enrollment and Discipline ("OED") Director considered the following: (i) Dr. Li has never been the subject of professional discipline by the USPTO, and Dr. Li represented that he has not been disciplined on ethical grounds by any other jurisdiction; (ii) Dr. Li has acknowledged his lapses, demonstrated genuine contrition, and accepted responsibility for his acts and omissions; (iii) Dr. Li fully cooperated with OED's investigation, including demonstrating a willingness and desire to attend personal interviews with OED personnel and provided *sua sponte* informative, supplemental responses to his original responses to requests for information; (iv) Dr. Li took *sua sponte* corrective action to fully comply with his professional responsibilities, including timely changing the entity status and paying the deficient amount on all the appropriate applications; (v) prior to OED's investigation, Dr. Li adopted additional measures intended to prevent the recurrence of these violations, including the adoption of a shared docket management system; and (vi) Dr. Li represents that he is, and has been, an active participant in providing pro

bono legal services to his community, including legal assistance to a regional cultural institution and financially under-resourced inventors, amounting to approximately eighty (80) hours per year.

This action is the result of a settlement agreement between Jinggao Li 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. 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;
- e. Respondent, by his agreement, has waived 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; and
- f. 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: 2023.04.19
18:01:49 -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 Amended Final Order was sent, on this day, to the parties in the manner indicated below-

Via first-class mail and e-mail:

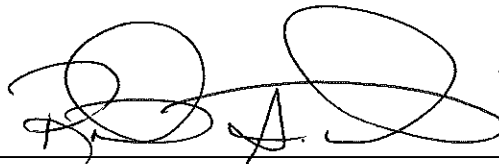
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Counsel for Respondent

Via e-mail:

Sydney Johnson
[REDACTED]
Counsel for the OED Director

Date

4/21/2023



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