

UNITED STATES PATENT AND TRADEMARK OFFICE

In the Matter of)	
)	
Yi Wan,)	Proceeding No. D2022-04
)	
Respondent)	
_____)	

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 Yi Wan (“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 Guangzhou, China, is an attorney licensed by, and in good standing with, the State of New York who has engaged in practice before the Office in trademark matters. Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

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

A. U.S. Counsel Rule for Trademark Matters

3. The USPTO published a final rule (“U.S. Counsel Rule”) requiring applicants, registrants, or parties to a trademark proceeding whose domicile is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. *See Requirement of U.S. Licensed Attorney for*

Foreign Trademark Applicants and Registrants, 84 FR 31498 (July 2, 2019).

4. The U.S. Counsel Rule became effective on August 3, 2019. *See* 84 FR 31498; 37 C.F.R. § 2.11(a).

5. In the few years preceding the U.S. Counsel Rule's effective date, the USPTO saw many instances of unauthorized practice of law where entities who were not authorized to represent trademark applicants were improperly representing foreign-domiciled applicants before the USPTO. As a result, increasing numbers of foreign-domiciled applicants were likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law. This practice raised legitimate concerns that affected applications and any resulting registrations are potentially invalid, thus negatively impacting the integrity of the U.S. trademark registration process.

6. Hence, the USPTO implemented the requirement for representation by a qualified U.S. attorney in response to the increasing problem of foreign-domiciled trademark applicants who purportedly were *pro se* (*i.e.*, one who does not retain a lawyer and appears for himself or herself) and who were filing inaccurate and possibly fraudulent submissions that violated the Trademark Act and/or the USPTO's rules. For example, such foreign-domiciled applicants filed applications claiming use of a mark in commerce, but frequently supported the use claim with mocked-up or digitally altered specimens that indicated the mark may not actually be in use. Many appeared to be doing so on the advice, or with the assistance, of foreign-domiciled individuals and entities who were not authorized to represent trademark applicants before the USPTO. This practice undermined the accuracy and integrity of the U.S. trademark register and its utility as a means for the public to reliably determine whether a chosen mark is available for use or registration and

placed a significant burden on the trademark examining operation. *See* 84 FR at 31498-31499.

7. U.S. attorneys are required to provide their bar information to the USPTO when representing applicants and registrants, whether domiciled inside or outside the U.S. *See* 37 C.F.R. §§ 2.17(b)(3), 2.32(a)(4).

B. USPTO Signature Rules for Trademark Matters

8. The USPTO trademark signature rules require that all signatures be personally entered by the named signatory and that 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, placed between two forward slash (“/”) symbols in the signature block on the electronic submission. *See* 37 C.F.R. § 2.193(a) and (c).

9. At all relevant times, the following unequivocal published guidance from the USPTO identified the proscription against any person other than the named signatory signing electronically trademark documents filed with the USPTO:

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 [Trademark Electronic Application System] form or in the e-mailed 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. *See In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Cowan*, 18 USPQ2d 1407 (Comm’r Pats. 1990). 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.

Trademark Manual of Examining Procedure § 611.01(c).

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.

11. When trademark documents are impermissibly signed and filed with the USPTO, the integrity of the U.S. trademark registration process is adversely affected and a resulting registration may be invalid.

C. The Trademark Applicant is the Practitioner's Client

12. A practitioner has an ethical obligation under the USPTO Rules of Professional Conduct to know who is the client. *See* 37 C.F.R. § 11.101 (concerning competency). “The PTO expects practitioners to know the identities of their clients and to take reasonable steps to avoid foreseeable prejudice to the rights of their clients.” *See Responsibilities of Practitioners Representing Clients in Proceedings Before The Patent and Trademark Office*, 1421 CNOG 2690 (Dec. 29, 2015).

13. When a trademark practitioner works with a foreign intermediary, the client is the trademark applicant. *See id.*; *see also Strojirenstvi v. Toyoda*, 2 USPQ 2nd 1222 (Comm’r Pat. 1986) (explaining, in part, that when a U.S. practitioner receives instructions from a patent owner through a foreign agent the client is still the patent owner rather than the foreign agent).

D. Certifications to the USPTO upon Presentation of Papers

14. By presenting any paper to the USPTO (whether by signing, filing, submitting, or later advocating), the party presenting such paper, whether a practitioner or non-practitioner, is certifying that:

- a. 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

- b. To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, (i) 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 (ii) 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.

Joint Stipulated Facts

15. At all times relevant hereto, Respondent has been a U.S. attorney licensed by, and in good standing with, the State of New York.

16. Since 2017, Respondent has been the principal attorney at his law firm, the Law Office of Yi Wan, where he provides trademark legal services. Respondent employed at least one non-practitioner assistant.

17. On July 29, 2019, Respondent entered into an agreement with a non-practitioner company known as the International Trademark Company ("ITC") to act as an intermediary between Respondent and various non-practitioner trademark "agencies" acting as foreign representatives for foreign-domiciled persons seeking to file U.S. trademark applications. ITC also collected trademark applications from the trademark agencies for Respondent to review and file, billed the trademark agencies on Respondent's behalf, and forwarded communications from Respondent to the trademark agencies and vice versa. Respondent represents to OED that ITC did not provide legal services to the trademark agencies and their trademark applicants.

18. Before August 3, 2019, Respondent was listed as the attorney of record on more than 2,500 trademark applications filed before the USPTO.

19. Between August 3, 2019 and March 31, 2021, Respondent became the attorney of record on more than 18,000 trademark applications filed before the USPTO on behalf of mostly foreign-domiciled trademark applicants.

20. In connection with the thousands of trademark applications Respondent filed, Respondent typically received instructions from the trademark agencies through ITC. Those trademark agencies typically collected information from prospective trademark applicants and would use such information to prepare a draft form of the trademark applications to be provided to Respondent through ITC.

21. Respondent and his non-practitioner assistant(s), who acted with Respondent's knowledge, impermissibly entered trademark applicants' electronic signatures in the attendant application declarations when filing the applications. Respondent represents to OED that he believed the hand-signed powers of attorney and declarations that he received from the applicants granted him and his non-practitioner assistant(s) authority to enter the keystrokes comprising the applicants' electronic signatures.

22. Due in part to the time constraints caused by accepting a very large volume of trademark clients over a relatively short period of time and relying on ITC to communicate with the trademark agencies to obtain information from prospective foreign-domiciled trademark applicants, Respondent often did not advise or discuss directly with the applicants themselves important legal issues regarding their trademark applications, such as what constitutes a proper specimen or whether an applicant's use qualifies for use in commerce.

23. For one trademark agency, Shenzhen Shenmahui Intellectual Properties Co., Ltd. ("Shenmahui"), Respondent reviewed the applications collected by ITC from Shenmahui and, after review, had ITC return the trademark applications to Shenmahui for filing. Respondent did not

retain control over the filing of the final applications. Respondent did not verify whether the trademark applicants signed the attendant application declarations when the applications were filed. Respondent represents to OED that he believed he would not be responsible for the applications filed by Shenmahui until he responded to an Office action.

24. For another trademark agency, Shenzhen Huanyee Intellectual Property Co., Ltd. (“Huanyee”), Respondent granted that agency permission to list his name and bar information in the attorney section of applications that Huanyee filed, knowing that he would not review the applications prior to filing. Respondent did not have control over the filing of these applications and, accordingly, did not know whether the trademark applicants signed the attendant application declarations when the applications were filed. He typically became aware of an application filed by Huanyee only upon the issuance of an Office action. Respondent represents to OED that he believed he would not be responsible for the applications filed by Huanyee until he responded to an Office action. Since then, Respondent has taken reasonable steps to inform the applicants of any harm that his inaction may have caused to the rights and privileges of their applications and registrations.

25. Respondent represents to OED that he did not adequately understand the U.S. Counsel Rule during his trademark practice. Respondent represents that he now fully understands the U.S. Counsel Rule and expresses contrition for his prior lack of understanding of the U.S. Counsel Rule and how his acts and omissions implicated several provisions of the USPTO Rules of Professional Conduct.

26. Respondent did not directly inform the trademark applicants or the USPTO of the impermissibly signed trademark documents. Respondent did not directly communicate with the trademark applicants about the impermissibly signed trademark documents and explain the

potential adverse consequences to their intellectual property rights occasioned by the impermissible signatures. Since then, Respondent has taken reasonable steps to inform the trademark applicants of the impermissible signatures.

27. Respondent represents to OED that he did not adequately understand the USPTO trademark signature rules during his business relationship with ITC and the trademark agencies. Respondent represents that he now fully understands those rules and expresses contrition for his prior lack of understanding of those rules and how his acts and omissions implicated several provisions of the USPTO Rules of Professional Conduct.

28. Since receiving OED's initial Request for Information on June 24, 2021, Respondent has, among other corrective actions, (i) terminated his relationship Huanyee; (ii) ceased to enter applicants' signatures when filing applications; (iii) adopted a practice of using the E-SIGN-ON signature method (*i.e.*, where a link to document is sent to the named signatory for signing) to have the applicants, themselves, sign their own trademark applications; and (iv) terminated his relationships with trademark agencies that refused to comply with his new practices and policies.

29. Additionally, Respondent has provided to the OED Director a sworn affidavit or verified declaration listing the serial numbers of all trademark applications (i) where he or his non-practitioner assistant(s) signed for the applicant and (ii) on which his name and bar information is listed but he did not retain reasonable control over the filing of the final trademark applications and, instead, allowed non-practitioners to have such control.

30. Respondent agrees to cooperate fully with the USPTO in any present or future USPTO inquiry made into other impermissible signings or improper filings of trademark documents filed with the USPTO by trademark agencies with whom Respondent works or had worked.

Additional Considerations

31. Respondent has not been disciplined by the USPTO and represents that he has not been disciplined by any state, territorial bar, state or federal court, or state or federal agency.

32. Respondent has expressed contrition for his prior lack of understanding of the U.S. Counsel Rule and the USPTO trademark signature rules and how his acts and omissions implicated many provisions of the USPTO Rules of Professional Conduct and adversely affected the integrity of the U.S. trademark registration process and the U.S. trademark register.

33. Respondent has expressed his understanding of the seriousness of the violations of the USPTO Rules of Professional Conduct stipulated to herein, and he acknowledges the potential adverse impact on his clients' intellectual property rights because trademark filings were made in violation of trademark laws, rules, and regulations.

34. Respondent has been exceptionally cooperative with OED's investigation, including providing candid responses to requests for information, taking corrective action, and engaging in an interview with OED via video conference.

Joint Legal Conclusions

35. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R § 11.101 (practitioner shall provide competent representation) by not understanding adequately, and not complying with, the U.S. Counsel Rule and the USPTO trademark signature rules, which resulted in violations of those rules in the course of representing foreign-domiciled trademark clients;
- b. 37 C.F.R. § 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) by (i) failing to take reasonable steps to ensure that his clients' trademark filings were prepared, reviewed, signed, and filed in compliance with the U.S. Counsel Rule and the USPTO trademark signature rules and (ii) using a trademark document submission process where Respondent did

not retain reasonable control over the filing of the final trademark applications and, instead, allowed non-practitioners to have such control;

- c. 37 C.F.R. §§ 11.104(a) and (b) (communications with client) by not informing his clients, directly or through ITC or through trademark agencies purportedly acting as foreign representatives of his clients, as to the actual or potential adverse consequences of not complying with the U.S. Counsel Rule or the USPTO trademark signature rules, including whether the electronic signing of a document, including a declaration, by one other than the named signatory potentially jeopardizes the intellectual property rights of the clients, so that the clients could make informed decisions about their trademark applications and/or issued registrations;
- d. 37 C.F.R. §§ 11.303(a)(1), (a)(3), (b), and (d) (candor toward the USPTO) by (i) knowingly permitting a non-practitioner trademark agency to use Respondent's name and bar information in preparing and filing trademark applications with the USPTO without Respondent's prior review in violation of the U.S. Counsel Rule, (ii) knowingly signing applicants' names to trademark documents, including the attendant declarations, and (iii) failing to disclose the aforementioned filings and documents to the USPTO;
- e. 37 C.F.R. § 11.503(b) (responsibilities regarding non-practitioner assistance) by (i) permitting Respondent's non-practitioner assistant(s) to sign applicants' names to trademark documents, including declarations, filed with the USPTO, (ii) permitting a non-practitioner trademark agency to list Respondent's name and bar information on trademark documents that the trademark agency filed with the USPTO when Respondent knew that the trademark agency was preparing, signing, and filing such documents (*e.g.*, trademark applications) with the USPTO without his prior review, and (iii) permitting non-practitioner trademark agencies to have control over the filing of the final applications;
- f. 37 C.F.R. § 11.505 (assisting in unauthorized practice of law) by (i) permitting a non-practitioner trademark agency to file trademark documents before the USPTO listing Respondent's name and bar information when Respondent knew that the trademark agency was preparing, signing, and filing such documents (*e.g.*, trademark applications) with the USPTO without his prior review, (ii) using a trademark submission process where Respondent did not retain control over the filing of the final applications and, instead, allowed persons who filed the applications to retain such control, and (iii) permitting Respondent's assistant(s) to sign applicants' names to trademark documents, including the attendant declarations, filed with the USPTO;
- g. 37 C.F.R. § 11.804(c) (conduct involving dishonesty, fraud, deceit, or misrepresentation) by (i) signing applicants' names on trademark documents filed with the USPTO and permitting Respondent's assistant(s) to do the same and (ii) permitting a non-practitioner trademark agency to prepare trademark

applications using Respondent's name and bar information and file those applications with the USPTO when Respondent knew that the trademark agency was preparing, signing, and filing such documents (*e.g.*, trademark applications) with the USPTO without his prior review, such that it would appear that Respondent was involved in the application preparation and filing when he was not so involved;

- h. 37 C.F.R. § 11.804(d) (conduct prejudicial to the integrity of the U.S. trademark registration system) by (i) allowing a non-practitioner trademark agency to engage in the unauthorized practice of law before the USPTO in trademark matters by permitting that trademark agency to prepare applications using Respondent's name and bar information and file those applications with the USPTO without Respondent's prior review, (ii) assisting that trademark agency in circumventing compliance with the U.S. Counsel Rule by permitting that trademark agency to prepare applications using Respondent's credentials and file those applications without Respondent's prior review such that it would appear that Respondent was involved in the application preparation and filing when he was not so involved, (iii) not complying with the USPTO trademark signature rules by personally signing applicants' names on trademark documents filed with the USPTO, including the attendant declarations, and permitting his assistant(s) to do the same, and (iv) using a trademark submission process where Respondent did not retain control over the filing of the final applications and, instead, allowed persons who filed the applications to retain such control; and
- i. 37 C.F.R. § 11.804(i) (practitioner shall not engage in other conduct adversely reflecting on fitness to practice before the Office) by serving as the U.S. attorney for foreign-domiciled trademark applicants without establishing, in his dealings with ITC and non-practitioner trademark agencies, reasonable practices or policies aimed at ensuring that the integrity of the U.S. federal trademark registration process would be protected.

Agreed-Upon Sanction

36. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:
- a. Respondent shall be and hereby is suspended from practice before the Office for a period of six (6) months commencing on the date of this Final Order;
 - b. Respondent shall serve a probationary period beginning on the date of this Final Order approving the Proposed Settlement Agreement and continuing for a period of twelve (12) months from the date of an order granting Respondent's petition for reinstatement to practice before the USPTO in trademark matters;
 - c. Before the conclusion of the probationary period, Respondent shall provide to the OED Director a sworn affidavit or verified declaration attesting, and evidence demonstrating, that Respondent has successfully completed six (6)

hours of continuing legal education as follows: two (2) hours on ethics/professional responsibility and four (4) hours on U.S. trademark law;

- d. Before the conclusion of the probationary period, Respondent shall provide to the OED Director a sworn affidavit or verified declaration attesting that Respondent has reviewed thoroughly (i) all provisions of the Trademark Manual of Examining Procedure ("TMEP"), including, but not limited to, the provisions the USPTO's signature requirements, (ii) 37 C.F.R. § 2.11, and (iii) the commentary on the *Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, found at 84 FR 31498 (July 2, 2019);
- e. On at least a weekly basis throughout the term of the probationary period, Respondent shall (i) search the USPTO Trademark Electronic Search System ("TESS") for applications identifying him as the attorney of record and (ii) promptly inform appropriate personnel at the USPTO in writing of any filings identifying him as the attorney of record that were not made by him or with his knowledge and consent;
- f. On a quarterly basis throughout the term of the probationary period, Respondent shall submit a written report to the OED Director stating that he has completed the searches of the USPTO TESS database required by section g., above, and, if applicable, stating that he identified no applications in which he was named as the attorney of record that were not made by him or made without his knowledge and consent;
- g. Respondent shall cooperate fully with the USPTO in any present or future USPTO inquiry made into other impermissible signings or other improper filings of trademark documents filed with the USPTO by trademark agencies with whom Respondent works or had worked.
- h. (1) If the OED Director is of the opinion that Respondent, during his probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct; the provisions of the Proposed Settlement Agreement; the Final Order; or any of the above conditions identified in items c. through e., 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 twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;
 - (B) send the Order to Show Cause to Respondent at [REDACTED]
 - (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 provisions of the Proposed Settlement Agreement; the Final Order; or any of the above conditions identified in items c. through g., 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 twelve (12) months for the violations set forth in the Joint Legal Conclusions above;

- i. 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;
- j. In the event the Respondent seeks a review of any action taken pursuant to subparagraph h., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- k. Respondent shall comply with 37 C.F.R. § 11.58;
- l. Respondent shall remain suspended from practice before the Office in trademark and other non-patent matters until the OED Director grants Respondent's petition for reinstatement pursuant to 37 C.F.R. § 11.60;
- m. The OED Director 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/>;
- n. 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. Yi Wan of Guangzhou, China, who is an attorney licensed in the State of New York and authorized to practice before the United States Patent and Trademark Office ("USPTO") in trademark and other non-patent matters. Mr. Wan is not authorized to practice before the USPTO in patent matters. Mr. Wan is hereby suspended from practice before the Office for a period of six (6) months and required to complete a probationary period for violating 37 C.F.R. §§ 11.101; 11.103; 11.104(a) and (b); 11.303(a)(1), (a)(3), (b), and (d); 11.503(b); 11.505; 11.804(c); 11.804(d); and 11.804(i).

Mr. Wan shall serve a probationary period beginning on the date of the Final Order imposing his suspension and continuing for a period of twelve (12) months from the date of an order granting his petition for reinstatement to practice before the USPTO in trademark matters. Mr. Wan's probation includes a continuing legal education requirement. He has also agreed to cooperate fully with the USPTO in any present or future USPTO inquiry made into other impermissible signings or other improper filings of trademark documents filed with the USPTO by trademark companies with whom Mr. Wan works or had worked.

Mr. Wan's legal practice encompasses trademark legal services. He has been listed as the attorney of record in over 20,500 trademark applications filed with the USPTO. Before August 3, 2019, Mr. Wan was listed as the attorney of record on more than 2,500 trademark documents filed with the USPTO. After August 3, 2019, Mr. Wan was listed as the attorney of record on more than 18,000 trademark documents filed with the USPTO.

The aforementioned violations of the USPTO Rules of Professional Conduct are predicated on Mr. Wan's acts and omissions during the course of his business relationship with a non-practitioner entity (International Trademark Company ("ITC")) and various non-practitioner trademark "agencies," relationships that began on or about July 29, 2019. As explained below, Mr. Wan permitted one such trademark agency to list his name and bar information in the attorney information portion of trademark application documents that the trademark agency filed on behalf of foreign-domiciled applicants without prior review by Mr. Wan. He also permitted another trademark agency to file trademark applications that he reviewed but he himself did not file or sign. In each situation, Mr. Wan was unable to verify that the applicants signed the attendant declarations and he did not retain control over the filing of the final applications. Instead, he allowed other persons to retain such control. Such acts and omissions allowed both trademark agencies to circumvent the purposes of the U.S. Counsel Rule, which sets forth a U.S.-licensed attorney requirement for foreign-domiciled trademark applicants and registrants. *See Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, 84 FR 31498 (July 2, 2019). Mr. Wan also violated the USPTO trademark signature rules by signing applicants' names to application declarations that he filed and permitting his assistant(s) to do the same.

On July 29, 2019, Mr. Wan signed an agreement with ITC which, *inter alia*, provided him referrals from the trademark agencies. While Mr. Wan reviewed the trademark applications that were referred to him, he signed applicants' names to the attendant application declarations when filing the applications and permitted his assistant(s) to do the same. In the case of one trademark agency, Mr. Wan reviewed the applications but permitted the trademark agency to file the applications. He did not retain control over the filing of the final applications and did not verify whether the applicants signed the applications prior to filing.

In November of 2020, Mr. Wan agreed to allow another one of the trademark agencies to list his name as attorney of record on applications that he did not review. Accordingly, only that trademark agency – not Mr. Wan – interacted with the trademark applicant clients and prepared the trademark application materials. Mr. Wan did not communicate with those clients directly or through ITC or the trademark agency unless an Office action arose. Mr. Wan did not attempt to verify who entered the name of the applicants in the signature blocks. Mr. Wan did not alert the USPTO that these applications were being filed.

Mr. Wan recognized his ethical lapses, demonstrated genuine contrition, and accepted responsibility for his conduct. Acknowledging his personal duty to take remedial steps, Mr. Wan took corrective actions by, *inter alia*, (a) terminating his relationship with the trademark agencies that he permitted to file applications listing him as attorney of record; (b) when filing applications, ceasing to enter applicants' signatures in the attendant application declarations; (c) reforming his practice to require that applicants use ESIGN-ON to sign the attendant application declarations; and (d) terminating his relationships with trademark agencies that refused to comply with his new practices and policies.

Trademark practitioners engaged in practice before the USPTO are to be reasonably well informed as to the USPTO trademark signature rules and U.S. Counsel Rule. The latter rule became effective on August 3, 2019, and requires applicants, registrants, or parties to a trademark proceeding whose domicile is not located within the U.S. or its territories to be represented by an attorney who is an active member in good standing of the bar of the highest court of a state in the U.S. *See* 84 FR 31498; 37 C.F.R. § 2.11(a).

In the few years preceding the U.S. Counsel Rule's effective date, the USPTO saw many instances of unauthorized practice of law where parties who were not authorized to represent trademark applicants were improperly representing foreign-domiciled applicants before the USPTO. As a result, increasing numbers of foreign-domiciled applicants were likely receiving inaccurate or no information about the legal requirements for trademark registration in the U.S., such as the standards for use of a mark in commerce, who can properly aver to matters and sign for the mark owner, or even who the true owner of a mark is under U.S. law. This practice raised legitimate concerns that affected applications and any resulting registrations were potentially invalid, and thus negatively impacted the integrity of the trademark register. Hence, the USPTO implemented the requirement for representation by a qualified U.S. attorney in response to the increasing problem of foreign-domiciled trademark applicants who purportedly were *pro se* (*i.e.*, one who does not retain a lawyer and appears for himself or herself) and who were filing inaccurate and possibly fraudulent submissions that violate the Trademark Act and/or the USPTO's rules. For example, such foreign-domiciled applicants filed applications claiming use of a mark in commerce but frequently supported the use claim with mocked-up or digitally altered specimens that indicate the mark may not actually have been in use. Many appear to have done so on the advice, or with the assistance, of foreign-domiciled individuals and

entities who were not authorized to represent trademark applicants before the USPTO. This practice undermined the accuracy and integrity of the U.S. trademark register and its utility as a means for the public to reliably determine whether a chosen mark was available for use or registration and placed a significant burden on the trademark examining operation. *See* 84 FR at 31498-31499.

The U.S. Counsel Rule is intended to increase compliance with U.S. trademark law and USPTO regulations, improve the accuracy of trademark submissions to the USPTO, and safeguard the integrity of the U.S. trademark register. For example, practitioners who represent trademark applicants before the USPTO are expected to, among other things, undertake a bona fide review of specimens submitted to the USPTO in support of a trademark application. A practitioner's failure to comply with his or her ethical obligations under the U.S. Counsel Rule may potentially adversely affect the integrity of the USPTO trademark registration process.

A USPTO practitioner has an ethical obligation under the USPTO Rules of Professional Conduct to know who is the client. *See* 37 C.F.R. § 11.101 (concerning competency) and 11.804(i) (concerning other conduct that adversely reflects on a practitioner's fitness to practice before the Office). "The PTO expects practitioners to know the identities of their clients and to take reasonable steps to avoid foreseeable prejudice to the rights of their clients." *See Responsibilities of Practitioners Representing Clients in Proceedings Before The Patent and Trademark Office*, 1421 CNOG 2690 (Dec. 29, 2015).

When a trademark practitioner works with a foreign intermediary, the client is the trademark applicant. *See id.*; *see also Strojirenstvi v. Toyoda*, 2 USPQ 2nd 1222 (Comm'r Pat. 1986) (explaining, in part, that when a U.S. practitioner receives instructions from a patent owner through a foreign agent, the client is still the patent owner rather than the foreign agent).

Mr. Wan has been exceptionally cooperative with OED's investigation, including providing candid responses to requests for information, taking corrective action, and engaging in an interview with OED via video conference. As mentioned, he has agreed to cooperate fully with the USPTO in any present or future USPTO inquiry made into other impermissible signings or other improper filings of trademark documents filed with the USPTO by trademark agencies with whom he works or had worked.

This action is the result of a settlement agreement between Mr. Wan 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>;

- o. 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; (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;
- p. 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; and
- q. The parties shall bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.

Kathryn Siehndel

4/11/22

Kathryn Siehndel
Acting Deputy General Counsel for General Law
United States Patent and Trademark Office

Date

on delegated authority by

Andrew Hirshfeld
Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office