

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

In the Matter of

Weibo Zhang,

Respondent

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Proceeding No. D2022-16

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 Weibo Zhang (“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, Respondent of Flushing, New York, has been an attorney engaged in practice before the USPTO in trademark matters and 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.

Joint Stipulated Facts

3. On March 13, 2019, Respondent was admitted to practice law in the State of New York.
4. Effective August 3, 2019, the USPTO amended its rules of practice to require that trademark applicants not domiciled within the United States be represented by an attorney who is licensed to practice law in a jurisdiction of the United States (also known as the “U.S. Counsel Rule”).
5. Respondent learned of the U.S. Counsel Rule at the time it was adopted in August 2019.
6. In 2020, a number of trademark agents (“Agents”) hired Respondent to serve as the U.S.-licensed attorney of record on applications that the Agents prepared on behalf of

foreign-domiciled trademark applicants with the intention of filing those applications with the Office.

7. Respondent represents that the Agents included Lin Zhang, Xing Don, Jing Liu, Jiaqi Wang, Linzhi Xiang, Ju Xiao Yan, Si Li, Xinguang Zhang, Lang Wan, Xinyi International IP, Shenzhen Yaotianxia IP, Shenzhen Ruilixin IP, Shenzhen Sellergrowth Network, Beijing Haoke International Intellectual Agent, Shenzhen Kuazintong Consulting Service, Mingri Intellectual Property Shenzhen Co., and Shenzhen Kuashiji Intellectual Property Co.

8. The Agents were not licensed to practice law in the United States.

9. At all relevant times, the foreign-domiciled trademark applicants were Respondent's clients.

10. The Agents paid Respondent between \$40 and \$60 per application for representing the foreign-domiciled trademark applicants before the USPTO.

11. Generally, the Agents prepared the applications using the Trademark Electronic Application System ("TEAS"), the USPTO's trademark filing and prosecution system.

12. After preparing the applications on TEAS, the Agents generally sent the applications to Respondent electronically to review, sign, and file.

13. A large portion of the applications reviewed, signed, and filed by Respondent were based on use in commerce under 15 U.S.C. § 1051(a).

14. Pursuant to 37 C.F.R. § 11.18, Respondent was required to review sufficiently his clients' applications in order to certify that he believed all statements made therein to be true.

15. Respondent was named attorney of record for approximately 8,500 applications filed in 2020 and 9,800 applications filed in 2021. Respondent reviewed, signed, and filed over 3,000 applications in December 2020, including over 350 applications in a single day: December 31, 2020.

16. Due to the volume of applications he filed, Respondent did not always conduct a sufficiently thorough review of trademark applications prior to filing, including, for example, not performing an inquiry reasonable under the circumstances to determine whether the specimens showed the marks as used in commerce or failing to review specimens to determine that they were authentic (e.g., not mockups or digitally altered). At all relevant times, Respondent understood that the USPTO would rely on documents that he signed and filed when the USPTO examined applications and issued registrations.

17. Additionally, Respondent acknowledged that he allowed an Agent to sign his name to 49 trademark applications and appurtenant declarations and to file those applications with the USPTO without his reviewing the applications prior to filing. The applications were filed with the USPTO on a single day.

18. Respondent acknowledged that he knew that the 49 applications were impermissibly signed at the time they were filed, but he did not inform the trademark applicants of the impermissible signing until over a year later.

19. Respondent did not inform anyone at the USPTO of the impermissible signing of the 49 applications until asked about the applications by OED during the course of its investigation of Respondent.

20. Regarding Office Actions issued in trademark applications where Respondent was the attorney of record, Respondent established a system whereby the relevant Agent received Office Actions via email directly from the USPTO. Respondent then relied on the Agents to communicate with applicants about the Office Actions. Respondent did not take sufficient steps to confirm that the Agents received the emails or that the Agents informed the applicants about the Office Actions. Respondent did not take action on behalf of applicants with respect to Office Actions unless he received a draft response from an Agent. Respondent interpreted silence from an Agent with respect to an Office Action as the applicant's intention not to respond.

Additional Considerations

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

22. Respondent cooperated with OED's investigation.

23. Respondent represents that he is willing to take any corrective action in the future to fully comply with the professional responsibilities set forth in the USPTO Rules of Professional Conduct.

24. Respondent represents that he is willing to cooperate fully with the USPTO in any present or future USPTO inquiry made into improper filings of trademark documents filed with the USPTO by trademark entities with whom Respondent works or has worked.

Legal Conclusions

25. Respondent acknowledges that, based on the information contained in the joint stipulated facts above, he violated the following provisions of the USPTO Rules of Professional Conduct:

- a. failing to provide competent representation to clients by, *inter alia*:
 - (i) accepting a volume of clients so large that he could not always conduct a sufficient review of his clients' trademark filings prior to filing with the USPTO; (ii) not reviewing applications that Agents signed and filed wherein Respondent served as attorney of record; and (iii) failing to put proper procedures in place to ensure compliance with USPTO regulations, in violation of 37 C.F.R. § 11.101;

- b. failing to act with reasonable diligence and promptness by, *inter alia*:
(i) not always conducting a sufficiently thorough review of trademark applications prior to filing with the USPTO; (ii) failing to put procedures in place to ensure his clients' filings were in compliance with the USPTO regulations; (iii) failing to put procedures in place to ensure adequate communication of USPTO-issued correspondence with clients; (iv) failing to adequately review trademark applications on which he was identified as the attorney of record (e.g., failing to properly review applications Agents filed and specimens to confirm the mark showed actual use in commerce); and (v) failing to review, prior to filing, 49 trademark applications for which he was named attorney of record, in violation of 37 C.F.R. § 11.103;
- c. failing to reasonably consult with the client about the means by which the client's objectives are to be accomplished by, *inter alia*, failing to ensure that applicant decisions regarding important USPTO-issued correspondence were communicated to Respondent by Agents, in violation of 37 C.F.R. § 11.104(a)(2);
- d. failing to keep clients reasonably informed about the status of a matter by, *inter alia*, failing to ensure through adequate communication that applicants received important USPTO-issued correspondence, in violation of 37 C.F.R. § 11.104(a)(3);
- e. failing to explain matters to the extent reasonably necessary to permit clients to make informed decisions regarding the representation by, *inter alia*, not timely informing clients that Respondent knowingly allowed applications to be signed in violation of USPTO signature rules and not timely informing clients of the potential adverse consequences to their respective intellectual property rights due to the impermissible signings, in violation of 37 C.F.R. § 11.104(b);
- f. knowingly making a false statement of fact to a tribunal or failing to correct in a timely manner a false statement of material fact made to the tribunal by the practitioner by, *inter alia*: (i) allowing another person to enter Respondent's signature on and file 49 trademark applications and failing to inform the USPTO of such impermissible signatures on the filings; (ii) submitting declarations to the USPTO in trademark applications without conducting a reasonable inquiry into the veracity of the averments made appurtenant thereto, wherein said declarations are relied upon by trademark examining attorneys in the course of evaluating trademark applications; and (iii) failing to inform the USPTO in a timely manner upon learning of the falsity of such declarations, in violation of 37 C.F.R. 11.303(a)(1);
- g. failing to make reasonable efforts to ensure that Respondent's office has in effect measures giving reasonable assurance that the conduct of non-practitioner assistants is compatible with the professional obligations of

the practitioner by, *inter alia*: (i) allowing non-practitioners to prepare and file trademark documents with the USPTO on behalf of Respondent's clients without properly reviewing and vetting such documents; (ii) failing to ensure adequate communication of USPTO-issued correspondence with clients and that client decisions regarding said documents were communicated to Respondent; and (iii) authorizing non-practitioners to enter Respondent's signature on 49 trademark applications (including declarations) filed with the USPTO, in violation of 37 C.F.R. § 11.503(a);

- h. assisting in the unauthorized practice of law by, *inter alia*: (i) allowing non-practitioners to prepare and file with the USPTO trademark filings for Respondent's clients that he had not reviewed prior to filing; and (ii) authorizing non-practitioners to prepare, enter his signature on, and file 49 trademark applications (including declarations) with the USPTO, in violation of 37 C.F.R. § 11.505;
- i. engaging in conduct involving dishonesty by, *inter alia*: (i) signing declarations representing that specimens showed marks as used in commerce when Respondent had not performed an inquiry reasonable under the circumstances to determine whether the specimens showed the marks as used in commerce, and (ii) authorizing non-practitioners to enter Respondent's signature on 49 trademark applications (including declarations) filed with the USPTO and failing to inform the USPTO of such improper filings, in violation of 37 C.F.R. § 11.804(c); and
- j. engaging in conduct that is prejudicial to the administration of justice by, *inter alia*: (i) failing to review specimens to determine that they were authentic (e.g., not mockups or digitally altered); (ii) failing to comply with 37 C.F.R. § 11.18 by not conducting a reasonable inquiry under the circumstances prior to presenting trademark documents to the USPTO on behalf of Respondent's clients with the knowledge that the USPTO would rely on such documents in examining the applications and issuing registrations; and (iii) authorizing non-practitioners to enter Respondent's signature on 49 trademark applications (including declarations) filed with the USPTO, in violation of 37 C.F.R. § 11.804(d).

Agreed Upon Sanction

- 26. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:
 - a. Respondent is suspended from practice before the Office in patent, trademark, and non-patent law for ninety (90) days commencing on the date of this Final Order;
 - b. Respondent is to remain suspended from practice before the USPTO until the OED Director grants a petition requesting Respondent's reinstatement

pursuant to 37 C.F.R. § 11.60;

c. Pursuant to 37 C.F.R. § 11.58(f), Respondent is granted limited recognition for a period of thirty (30) days for winding up his trademark practice and concluding work on behalf of clients on trademark matters pending before the Office;

d. Effective the date of the expiration of the 30-day period of limited recognition afforded to Respondent, the USPTO is to terminate, suspend, or otherwise deactivate the following USPTO.gov accounts, which Respondent represents are USPTO.gov accounts that he opened and are under his control:

(1) [REDACTED]

(2) [REDACTED]

(3) [REDACTED]

(4) [REDACTED]

e. Respondent is to (1) continue in good faith to look for other USPTO.gov accounts that he opened are under his control, (2) immediately inform OED via email of any such accounts, and (3) authorize the USPTO to suspend, or otherwise deactivate such accounts;

f. No USPTO.gov account(s) used in connection with trademark matters that are suspended, terminated, or otherwise deactivated pursuant to this Final Order are to be unsuspended or otherwise re-activated until a petition seeking Respondent's reinstatement to practice before the USPTO is

granted pursuant to 37 C.F.R. § 11.60;

- g. After the expiration of the 30-day period of limited recognition set forth in paragraph c., above, Respondent is prohibited from using, assessing, or assisting others in using or accessing any USPTO.gov account(s) or other USPTO trademark filing systems for filing trademark documents with the USPTO; however, Respondent, when acting as a paralegal for a supervising practitioner under the limited circumstances set forth in 37 C.F.R. § 11.58(h), is permitted to access and use the supervising practitioner's USPTO.gov account(s) under the direct supervision of the supervising practitioner;
- h. Until a petition seeking Respondent's reinstatement to practice before the USPTO is granted pursuant to 37 C.F.R. § 11.60, Respondent is prohibited from (1) opening or activating any USPTO.gov account(s) to be used for filing trademark documents with the USPTO, (2) applying for, or attempting to apply for, any USPTO.gov account(s) to be used for filing trademark documents with the USPTO, (3) verifying, or attempting to verify, any other person's credentials in connection with USPTO.gov account(s) to be used for filing trademark documents with the USPTO, and (4) sponsoring or attempting to sponsor USPTO.gov account(s) to be used for filing trademark documents with the USPTO;
- i. The USPTO may act to prevent Respondent from (1) opening or activating any USPTO.gov account(s) to be used for filing trademark documents with the USPTO, (2) applying for, or attempting to apply for, any USPTO.gov account(s) to be used for filing trademark documents with the USPTO, (3) verifying, or attempting to verify, any other person's credentials in connection with USPTO.gov account(s) to be used for filing trademark documents with the USPTO, and (4) sponsoring or attempting to sponsor USPTO.gov account(s) to be used for filing trademark documents with the USPTO;
- j. Nothing herein shall prevent Respondent from having access to Fee Processing Next Generation System accounts;
- k. Respondent, as a condition of being reinstated, is to provide to the OED Director a sworn affidavit or verified declaration attesting, and evidence demonstrating, that Respondent successfully completed two (2) hours of continuing legal education credit on law office management for solo or small practitioners;
- l. Respondent, after consulting with a U.S. licensed attorney who has at least five years of federal trademark experience, is, for all trademark documents filed with the USPTO on behalf of foreign domiciled trademark applicants, to:

- (1) prepare a detailed plan outlining his intended future practice for making a reasonable inquiry that specimens are authentic (e.g., not digitally altered) and the goods or services identified are being used in commerce (at the time of the filing of a §1(a) application, at the time a Statement of Use is filed in connection with a §1(b) application, at the time a § 8 Declaration is filed affirming that a federally registered trademark has been in use continuously for a period five years, and at any subsequent request to renew the registered mark); and
 - (2) present the plan to the OED Director as part of any petition seeking Respondent's reinstatement that may be later filed with the USPTO;
- m. After consulting with a U.S. licensed attorney who has at least five years of federal trademark experience, Respondent is, for all trademark documents filed with the USPTO on behalf of foreign domiciled trademark applicants, to:
- (1) prepare a detailed plan outlining his intended future practice for handling Office Actions issued in his clients' trademark applications including the following: (i) learning that Office Actions have been issued, (ii) informing clients (directly or through bona-fide third party foreign intermediaries) as to the issuance of Office Actions, (iii) receiving and memorializing confirmation that the clients have been informed of the Office Actions, (iv) receiving, memorializing, and acting on client instructions regarding Office Actions, and (v) memorializing client instructions not to respond to an Office Action and, instead, to let the matter be abandoned, and
 - (2) present the plan to the OED Director as part of any petition seeking Respondent's reinstatement that may be later filed with the USPTO;
- n. Respondent, after consulting with a U.S. licensed attorney, is to
- (1) prepare a detailed plan outlining his intended future practice for conflicts of interest checking and
 - (2) present the plan to the OED Director as part of any petition for reinstatement that Respondent may later file with the USPTO;
- o. Respondent is to:
- (1) prepare a detailed plan outlining his intended future practice for ensuring that trademark applications are thoroughly reviewed consistent with his obligations under the U.S. Counsel Rule, 37 C.F.R. § 11.18, and the USPTO Rules of Professional Conduct (e.g., plans for increasing his non-practitioner staff, for reducing the number of trademark application clients he agrees to represent, etc.) and

- (2) present the plan to the OED Director as part of any petition seeking Respondent's reinstatement that may be later filed with the USPTO;
- p. Respondent shall serve a probationary period that commences on the date the Final Order is signed and terminates eighteen (18) months after a decision by the OED Director granting a petition seeking Respondent's reinstatement to practice before the USPTO in trademark and other non-patent matters;
- q. Respondent, within the first twelve (12) months of his probationary period, shall provide to the OED Director a sworn affidavit or verified declaration attesting, and evidence demonstrating, that Respondent successfully completed six (6) hours of continuing legal education credit on trademark practice before the USPTO;
- r. Respondent, on at least a bi-weekly basis throughout the term of the probationary period, shall:
- (1) search the USPTO Trademark Electronic Search System ("TESS") for applications identifying him as the attorney of record, and
- (2) 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;
- s. Respondent, on a quarterly basis throughout the term of the probationary period, shall submit a written report to the OED Director stating that he has completed the searches described in the preceding subparagraph;
- t. Respondent shall cooperate fully with the USPTO in any present or future USPTO inquiry made into improper filings of trademark documents by trademark entities with whom he works or has worked;
- u. (1) In the event the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, the Final Order, or any disciplinary rule of the USPTO Rules of Professional Conduct, the OED Director shall:
- (i) issue to Respondent an Order to Show Cause why the USPTO Director should not order that Respondent be immediately suspended for up to an additional nine (9) months for the violations set forth in the Joint Legal Conclusions, above;
- (ii) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director; and

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

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

(i) deliver to the USPTO Director or his designee: (a) the Order to Show Cause; (b) Respondent's response to the Order to Show Cause, if any; and (c) argument and evidence causing the OED Director to be of the opinion that Respondent failed to comply with any provision of the Agreement, the Final Order, or any disciplinary rule of the USPTO Rules of Professional Conduct during the probationary period; and

(ii) request that the USPTO Director immediately suspend Respondent for up to an additional nine (9) months for the violations set forth in the Joint Legal Conclusions, above;

- v. 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;
- w. In the event the USPTO Director suspends Respondent pursuant to subparagraph u., above, and Respondent seeks a review of the suspension, any such review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- x. Respondent shall comply with 37 C.F.R. §§ 11.58 and 11.60;
- y. Respondent may satisfy his obligations under 37 C.F.R. § 11.58(c)(3)(i) regarding providing written notice of the order of suspension to clients (i.e., trademark applicants) who are domiciled in a foreign country and who have immediate or prospective business before the Office in trademark or other non-patent matters by emailing a copy of the Final Order that has been correctly translated into the client's respective native language to the email address provided for each client in the "Applicant's Information" portion of each client's trademark application or to an email address that Respondent otherwise knows belongs to the client;
- z. Nothing in this 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/or (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;

- aa. The OED Director shall electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at: <http://foiadocuments.uspto.gov>;
- bb. 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 Weibo Zhang of Flushing, New York, an attorney licensed in the state of New York. The United States Patent and Trademark Office ("USPTO") has suspended Mr. Zhang from practice before the USPTO for ninety (90) days. Mr. Zhang will also serve a probationary period.

In 2020, Respondent began serving as attorney of record for a large volume of foreign-domiciled trademark applicants pursuant to the agency's U.S. Counsel Rule (*see* Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants, 84 Fed. Reg. 31498 (July 2, 2019)). Respondent served as attorney of record on thousands of trademark applications. Respondent received already-prepared trademark applications from foreign-domiciled companies and firms and did not conduct an adequate review of such applications before signing them and authorizing their filing with the USPTO. He signed declarations under 18 U.S.C. § 1001 attesting that his clients' specimens showed the marks as used in commerce without conducting an inquiry reasonable under the circumstances. He also authorized non-practitioners to sign his name on 49 trademark applications without conducting any review of the applications himself. Finally, he failed to communicate with applicant clients about Office Actions issued by the USPTO with respect to their applications.

As a result of the above misconduct, Mr. Zhang violated the following provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. §§ 11.101 (practitioner shall provide competent representation to a client), 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client), 11.104(a)(2) (practitioner shall reasonably consult

with the client about the means by which the client's objectives are to be accomplished), 11.104(a)(3) (practitioner shall keep clients reasonably informed about the status of a matter), 11.104(b) (practitioner shall explain matters to the extent reasonably necessary to permit clients to make informed decisions regarding the representation), 11.303(a)(1) (practitioner shall not knowingly make a false statement of fact to a tribunal or fail to correct a false statement of material fact made to the tribunal by the practitioner), 11.503(a) (practitioner shall take reasonable efforts to ensure that non-practitioners' conduct is compatible with the professional obligations of the practitioner), 11.505 (practitioner shall not assist another in practicing law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction), 11.804(c) (practitioner shall not engage in conduct involving dishonesty), and 11.804(d) (practitioner shall not engage in conduct that is prejudicial to the administration of justice).

Mr. Zhang cooperated with the OED investigation and has agreed to cooperate with the USPTO's efforts to combat improper filings of trademark documents.

This action is the result of a settlement agreement between Mr. Zhang 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 OED Reading Room, available at: <http://foiadocuments.uspto.gov>;

- cc. 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;
- dd. Within a reasonable period after the entry of a Final Order, the OED Director shall file a motion dismissing the pending disciplinary action without prejudice; and
- ee. The OED Director and Respondent shall each bear their own costs incurred to date in carrying out the terms of the Agreement and the Final Order.

(signature page follows)

(signature page for Final Order (D2022-16))

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

Date

on delegated authority by

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

cc:

William R. Covey
OED Director, USPTO

Weibo Zhang
Respondent