

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

In the Matter of)
)
Charles M. Caldwell II,)
)
Respondent)
_____)

Proceeding No. D2020-12

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 Mr. Charles M. Caldwell II 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.

This 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’ joint stipulated facts, joint legal conclusions, and agreed upon sanctions found in the Agreement.

Jurisdiction

1. At all times relevant, Respondent of Pensacola, Florida, has been an attorney in good standing in the State of Florida engaged in practice before the Office in trademark matters pursuant to 37 C.F.R. § 11.14(a). Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, 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

3. USPTO trademark signature rules require that all signatures be personally entered by the named signatory and require that a proper person sign the trademark document. *See* 37 C.F.R. § 2.193(a) and (e).

4. The USPTO Trademark Manual of Examining Procedure (“TMEP”) provides guidance to practitioners regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

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

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

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

5. The USPTO's signature requirements are critical to the integrity of the United States trademark registration process because the USPTO receives, reviews, and relies upon signed declarations submitted to it during the registration process in determining whether to register an applicant's mark.

6. Trademark documents filed with the USPTO, such as Trademark/Service Mark Statements of Use pursuant to 15 U.S.C. § 1051(c) and (d), typically carry an important warning in the declarations, such as:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

7. Violations of the USPTO trademark signature rules likely adversely affect trademark rights. For example, impermissible signatures on declarations submitted to the USPTO during the registration process may cause actual harm to trademark applicants. *See In re Cowan*, 18 USPQ2d 1407 (Comm'r Pats. 1990) (denying petition to reverse cancellation of a registration where cancellation was based on Section 8 and 15 declaration not being signed by the named signatory) and *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007) (affirming examining attorney's refusal to register a mark on the basis that the declaration filed to support allegations in statement of use referred only to the statements and beliefs of another and not to the named declarant's own statements and beliefs).

Joint Stipulated Facts

8. From late 2015 to August 9, 2019, Respondent worked with Trademark Factory International, Inc. ("Trademark Factory") a company located in Canada that offers trademark search and registration (e.g., preparing, filing, and prosecution) services to applicants located within Canada and outside of Canada.

9. At all relevant times, Respondent represented Trademark Factory customers as their attorney of record before the USPTO in pending trademark applications or issued trademark registrations.

10. Respondent allowed a USPTO reciprocally-recognized Canadian trademark agent (i.e., a person who was not authorized to represent trademark applicants located outside of Canada) at Trademark Factory to enter Respondent's electronic signature on trademark documents prior to the filing of the trademark documents with the USPTO.

11. After he was contacted by OED, Respondent terminated his relationship with Trademark Factory and directed the company to cease using his name on trademark documents filed with the USPTO.

12. Respondent represents that he took reasonable action to see that his former clients were timely notified of impermissible signature issues that may have adverse consequences to their respective trademark rights, namely: he advised Trademark Factory of the impermissible nature of the signature process and drafted a proposed notice for the new attorney of record to distribute to his former clients.

13. Respondent represents that he is no longer the attorney of record for any Trademark Factory-related matters.

Additional Considerations

14. Respondent has not been publicly disciplined by any state, territorial bar, state or federal court, or state or federal agency (including the USPTO).

15. Prior to his relationship with Trademark Factory, Respondent had no experience in the field of trademark law and no experience practicing before the USPTO.

16. Respondent fully, diligently, and without hesitation cooperated with OED's investigation by thoroughly responding to OED's requests in a timely and candid manner, voluntarily participating in a telephonic interview, and maintaining active communication throughout the investigation and settlement process.

17. Respondent expressed contrition for his misconduct.

18. Additionally, Respondent terminated his relationship with Trademark Factory and informed the company and the new attorney of record of the potential consequences of failing to comply with USPTO signature regulations.

Joint Legal Conclusions

19. 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. 37 C.F.R. § 11.101 (practitioner shall provide competent representation to a client) by not adequately understanding the USPTO trademark signature requirements of 37 C.F.R. § 2.193;
- b. 37 C.F.R. § 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) by failing to take reasonable steps to ensure his clients' filings were signed in accordance with USPTO trademark signature rules; and
- c. 37 C.F.R. § 11.804(c) (misrepresentation) and (d) (conduct prejudicial to the USPTO trademark registration process) by allowing a reciprocally-recognized Canadian trademark agent to sign Respondent's name on trademark documents filed with the USPTO.

Agreed Upon Sanction

20. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:
 - a. Respondent be and hereby is publicly reprimanded;
 - b. Respondent shall serve a probationary period of twelve (12) months beginning on the date of this Final Order;
 - c. (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 the USPTO Rules of Professional Conduct, the OED Director shall:
 - (A) issue to Respondent an Order to Show Cause why the USPTO Director should not order that Respondent be immediately suspended 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 the last address of record Respondent furnished to the OED Director; and
 - (C) 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 the USPTO Rules of Professional Conduct, the OED Director shall:
 - (A) deliver to the USPTO Director or his designee: (i) the Order to

Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) 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 the USPTO Rules of Professional Conduct during the probationary period; and

(B) request that the USPTO Director immediately suspend Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;

- d. In the event the USPTO Director suspends Respondent pursuant to subparagraph c, 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;
- e. 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/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;
- f. 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>;
- g. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Reprimand and Probation

This notice concerns Charles M. Caldwell II of Pensacola, Florida. Mr. Caldwell is an attorney admitted to practice in Florida who has no previous record of public discipline. Mr. Caldwell is hereby reprimanded and placed on probation for twelve (12) months for violating 37 C.F.R. §§ 11.101, 11.103, 11.804(c), and 11.804(d).

From late 2015 to August 2019, Mr. Caldwell worked with Trademark Factory International, Inc. ("Trademark Factory"), a company located in Canada that offers trademark search and trademark registration (e.g., preparing, filing, and prosecution) services to applicants located within Canada and outside of Canada.

In USPTO trademark applications where Mr. Caldwell was the attorney of record, a reciprocally-recognized trademark agent at Trademark Factory entered Mr. Caldwell's electronic signature on trademark documents filed with the USPTO in violation of USPTO trademark signature regulations.

Mr. Caldwell was fully candid in acknowledging his acts and omissions, and he completely cooperated fully and without hesitation in OED's investigation. Mr. Caldwell expressed contrition for his misconduct.

As a result of the above misconduct, Mr. Caldwell 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), 11.804(c) (practitioner shall not engage in conduct involving dishonesty, fraud, deceit or misrepresentation), and 11.804(d) (practitioner shall not engage in conduct that is prejudicial to the administration of justice).

USPTO trademark signature regulations require a proper person to sign a trademark document and that the person named as the signatory on the document be the one who enters his or her electronic signature on the document (i.e., personally enters the 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 of the electronic submission). See 37 C.F.R. § 2.193(a)(2), (c), and (e). The USPTO Trademark Manual of Examining Procedure ("TMEP") provides straightforward guidance regarding the USPTO trademark electronic signature regulations:

All documents must be personally signed. 37 C.F.R. §§ 2.193(a)(1), (c)(1), 11.18(a).

The person(s) identified as the signatory must manually enter the elements of the electronic signature.

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

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

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

The USPTO's trademark signature requirements are critical to the integrity of the United States trademark registration and renewal processes because the USPTO receives, reviews, and relies upon signed declarations submitted to it when determining whether to register and renew a trademark.

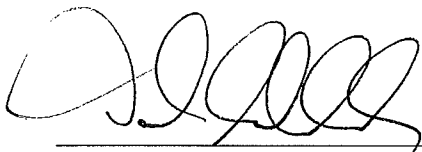
Violations of the USPTO trademark signature rules likely adversely affect trademark rights. For example, impermissible signatures on trademark application declarations may cause actual harm. See *In re Cowan*, 18 USPQ2d 1407 (Comm'r Pats. 1990) (denying petition to reverse cancellation of a registration where cancellation was based on Section 8 and 15 declaration not being signed by the named signatory) and *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007) (affirming examining attorney's refusal to register a mark on the basis that the declaration filed to support allegations in statement of use referred only to the statements and beliefs of another and not to the named declarant's own statements and beliefs).

Violations of the USPTO trademark signature rules implicate numerous provisions of the USPTO Rules of Professional Conduct for which practitioners have been disciplined. See *In re Caraco*, Proceeding No. D2019-50 (USPTO Sep. 12, 2019); *In re Rajan*, Proceeding No. D2019-30 (USPTO Sep. 5, 2019); *In re Mar*, Proceeding No. D2019-11 (USPTO Aug. 2, 2019); *In re Sweeney*, Proceeding No. D2019-33 (USPTO June 19, 2019); *In re Sapp*, Proceeding No. D2019-31 (USPTO May 15, 2019); *In re Crabtree*, Proceeding Nos. D2018-31 and D2018-47 (USPTO April 25, 2019); *In re Meikle*, Proceeding No. D2019-17 (USPTO March 21, 2019); *In re Swyers*, Proceeding No. D2016-20 (USPTO Jan. 26, 2017).

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

- h. 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

- i. The OED Director and Respondent shall each bear their own costs incurred to date in carrying out the terms of the Agreement and this Final Order.



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

17 Mar 2020
Date

on delegated authority by

Andrei Iancu
Deputy Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

Mr. Charles M. Caldwell II

