

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

In the Matter of)	
)	
Harrison B. Oldham,)	Proceeding No. D2024-11
)	
Respondent)	
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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. Harrison B. Oldham (“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 conclusions, and sanctions.

Jurisdiction

1. Respondent is an attorney who is licensed to practice law in the State of Texas, and is currently “active” and in good standing. As such, Respondent is authorized to practice before the USPTO in trademark and other non-patent matters. *See* 37 C.F.R. § 11.14(a). At all times relevant hereto, Respondent was engaged in practice before the Office in trademark matters.

2. Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et. seq.*

3. 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.

Background

A. Relevant USPTO Trademark Rules of Practice and Trademark Regulations

The U.S. Counsel Rule

4. Foreign-domiciled trademark applicants or registrants must be represented before the USPTO by an attorney who is licensed to practice law in the United States. *See* 37 C.F.R. § 2.11(a); *Requirement of U.S. Licensed Attorney for Foreign Trademark Applicants and Registrants*, 84 Fed. Reg. 31498 (July 2, 2019) (“the U.S. Counsel Rule”).

5. In part, the U.S. Counsel Rule was intended to (a) increase compliance with U.S. trademark law and USPTO regulations, (b) improve the accuracy of trademark submissions to the USPTO, and (c) safeguard the integrity of the U.S. trademark register. *See* 84 Fed. Reg. 31498.

37 C.F.R. § 2.193 – Signature Requirements for Trademark Documents

6. The USPTO trademark signature rules require that (a) all signatures on trademark documents be signed by a proper person, (b) trademark documents be personally signed by the signatory named on the document, and (c) 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 and that combination be placed between two forward slash (“/”) symbols in the signature block on the electronic submission. *See* 37 C.F.R. §§ 2.193(a), (c), and (e); and 37 C.F.R. § 11.18(a).

7. The Trademark Manual of Examining Procedure (“TMEP”) provides additional clear and straightforward guidance to practitioners regarding the USPTO

trademark electronic signature rules' requirement that the named signatory sign the document:

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 TEAS form or in the emailed 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.

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.

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

Adverse Consequences to Applications and Issued Registrations due to Violations of USPTO Trademark Signature Rules

8. If the signature on a trademark application or other submission fails to comply with 37 C.F.R. §2.193(a) or (e) because it was entered by someone other than the named signatory or not signed by a proper person, then the submission is improperly executed, cannot be relied upon to support registration, and normally renders the application void. *See* 84 Fed. Reg. at 31498 (stating that “[i]f signed by a person determined to be an unauthorized signatory, a resulting registration may be invalid.”). *See also In re Cowan*, 18 USPQ2d 1407, 1409 (Comm’r Pats. 1990); *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Yusha Zhang*, 2021 TTAB LEXIS 465, *10, *13 (Dir. USPTO Dec. 10, 2021). When trademark filings are impermissibly signed and filed with the USPTO, the integrity of the federal trademark registration process is adversely affected.

9. 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 the applicants' use of the mark in commerce and/or the applicants' intent to use the mark in commerce. The USPTO relies on such sworn declarations signed under penalty of perjury in trademark applications in the course of examining trademark applications and issuing registrations.

B. Certifications Required to Present Papers to the USPTO

10. A practitioner makes important certifications via 37 C.F.R. § 11.18 whenever presenting (*e.g.*, by signing, filing, submitting, or later advocating) any trademark or patent paper to the USPTO. Specifically, the practitioner certifies that all statements made on his or her own knowledge are true, and that all statements based on the practitioner's information and belief are believed to be true. *See* 37 C.F.R. § 11.18(b)(1). The practitioner also certifies that:

[t]o the best of the party's knowledge, information and belief, *formed after an inquiry reasonable under the circumstances* (i) [t]he 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) [t]he 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) [t]he 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) [t]he denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 C.F.R. § 11.18(b)(2) (emphasis added).

11. Accordingly, a practitioner who presents any paper to the USPTO—including trademark filings—certifies that he or she has conducted an inquiry reasonable under the

circumstances that supports the factual assertions set forth in the paper. *See* 37 C.F.R. § 11.18(b)(2)(iii).

12. Violations of 37 C.F.R. § 11.18 may jeopardize the probative value of the filing, and any false or fraudulent statements are subject to criminal penalty under 18 U.S.C. § 1001. *See* 37 C.F.R. § 11.18(b)(1).

13. Any practitioner who violates the provisions of 37 C.F.R. § 11.18 may also be subject to disciplinary action. *See* 37 C.F.R. § 11.18(d).

Joint Stipulated Facts

14. On November 2, 2012, Respondent was admitted to practice law in the State of Texas.

15. Respondent is the sole principal of Oldham Law, PLLC, which is based in Dallas, Texas. Respondent is a solo practitioner with a staff of non-practitioner assistants.

16. Respondent has experience as a trademark attorney.

17. Around 2021, Respondent, with others, started an online company known as “Trademark Pandora.” Trademark Pandora’s aim was to offer comprehensive trademark services in the United States, European Union, and China for foreign-domiciled applicants (mostly from China), especially for individuals and companies interested in selling products on e-commerce websites. To streamline the trademark-application process, Respondent and others developed an Internet-based client portal for managing trademark applications, monitoring status, and automatically docketing deadlines. According to Respondent, Trademark Pandora also translated the USPTO Trademark Next Generation ID Manual goods and services listing into the Chinese language, enabling applicants to directly select

from the USPTO-approved Goods & Services. To the best of Respondent's knowledge, the company is no longer in operation.

18. Between January 2021 and May 2023, Respondent served as attorney of record for over 1,800 trademark applications or registrations.

19. Approximately 95 percent of Respondent's trademark clients were foreign-domiciled, who therefore required a US-licensed attorney to serve as attorney of record for their applications pursuant to the U.S. Counsel Rule.

20. Trademark Pandora's computer system would transform information inputted by prospective trademark clients into a trademark application able to be processed by the USPTO's Trademark Electronic Application System ("TEAS"). Respondent was the sole U.S.-licensed attorney responsible for reviewing, signing, and filing the application with the USPTO and for otherwise representing the applicant before the USPTO.

21. In some cases, however, Respondent directed non-practitioner assistants—including an attorney who was licensed in the country of Portugal but who was not licensed in the United States—to electronically enter Respondent's signature on trademark filings, including sworn declarations, rather than Respondent signing them personally as the named signatory, as required by USPTO rules.

22. Respondent acknowledges that his failure to abide by the USPTO's signature rules jeopardized the integrity of the trademark registry in that it led to the registration of marks that may ultimately be deemed invalid for failure to comply with the USPTO's signature requirements, and which could preclude federal registration of legitimate marks.

23. Respondent acknowledges that his failure to abide by the USPTO's signature rules jeopardized his clients' intellectual property interests in their pending trademark applications and issued registrations.

24. Respondent represents that:

- a. He has conducted an in-depth and good-faith review of all trademark documents that he has presented to the USPTO and has identified all trademark documents on which he is the named signatory but where he did not personally sign the document;
- b. He has informed the USPTO's Office of Deputy Commissioner for Trademark Policy in writing of each such trademark document; and
- c. He has provided written notification to the applicants or registrants associated with such trademark documents as to the actual or potential harm to their intellectual property rights in their pending trademark applications and/or registered trademarks caused by the presenting of such impermissibly signed trademark documents to the USPTO.

Additional Considerations

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

26. Respondent fully cooperated with OED's investigation, to include making himself available to be interviewed by the OED staff attorneys investigating Respondent's conduct.

27. In 2024, Respondent voluntarily attended several continuing legal education ("CLE") courses pertaining to federal trademark practice and enrolled in the USPTO's *Trademark Basics Boot Camp*.

Joint Legal Conclusions

28. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct in connection with his trademark practice before the USPTO:

- a. 37 C.F.R. § 11.103 (not acting with reasonable diligence and promptness in representing a client) by, *inter alia*, (i) not timely informing trademark clients of the actual or potential adverse consequences to their intellectual property rights due to the impermissible signing of trademark applications; (ii) presenting to the USPTO trademark documents, including sworn declarations, that were not signed by the named signatory or allowing other persons to do so; and (iii) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 and failing to take reasonable steps to ensure that clients' trademark filings were reviewed and filed in accordance with the USPTO trademark signature rules;
- b. 37 C.F.R. § 11.303(a)(1) and (a)(3) (candor toward the tribunal) by, *inter alia*, (i) knowingly presenting to the USPTO trademark documents, including sworn declarations, that were not signed by the named signatory; and (ii) falsely certifying under 37 C.F.R. § 11.18 that the factual assertions presented in trademark documents (*i.e.*, the named signatory signed the document being presented to the USPTO) were true when he knew that the named signatory did not sign certain trademark documents submitted to the USPTO;
- c. 37 C.F.R. § 11.503(a) and (b) (responsibilities over non-practitioner assistants) by, *inter alia*, allowing his non-practitioner assistant(s) to sign Respondent's name to trademark documents presented to the USPTO;
- d. 37 C.F.R. § 11.804(c) (engaging in conduct involving misrepresentation) by, *inter alia*, (i) presenting to the USPTO trademark documents, including sworn declarations, that were not signed by the named signatory; and (ii) allowing false certifications under 37 C.F.R. § 11.18 that the factual assertions presented in trademark document (*i.e.*, the named signatory signed the document being presented to the USPTO) were true when he knew that the named signatory did not sign certain trademark documents submitted to the USPTO; and
- e. 37 C.F.R. § 11.804(d) (engaging in conduct prejudicial to the integrity of the USPTO trademark registration system) by, *inter alia*, (i) knowingly

presenting to the USPTO trademark documents, including sworn declarations, that were not signed by the named signatory; and (ii) allowing false certifications under 37 C.F.R. § 11.18 that the factual assertions presented in trademark documents (*i.e.*, the named signatory signed the document being presented to the USPTO) were true when the named signatory did not sign certain trademark documents submitted to the USPTO.

Agreed-Upon Sanction

29. Respondent has freely and voluntarily agreed, and it is hereby ORDERED that:
- a. Respondent shall be suspended from practice before the Office for a period of thirty (30) days and that the suspension shall commence thirty (30) days from the date of this Final Order;
 - b. Starting on the date of this Final Order and ending 30 days from the date of this Final Order, Respondent's practice before the USPTO shall be limited to concluding work on behalf of a client on any matters pending before the Office; and, if such work cannot be concluded during that 30-day period, Respondent shall timely advise the client so that the client may make other arrangements;
 - c. Any petition for reinstatement by Respondent shall include evidence of Respondent having completed all modules of the USPTO's *Trademark Basics Boot Camp*;
 - d. 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;
 - e. Respondent shall comply fully with all provisions of 37 C.F.R. § 11.58;

- f. Respondent shall serve a probationary period that commences 30 days after the date of this Final Order and shall terminate twelve (12) months after a decision by the OED Director granting a petition seeking Respondent's reinstatement to practice before the USPTO;
- g. Respondent may satisfy his obligations under 37 C.F.R. § 11.58(c)(3)(i) for those clients who are domiciled in a foreign country and have immediate or prospective business before the Office in trademark or other non-patent matters (*e.g.*, trademark applicants, and parties before the USPTO Trademark Trial and Appeal Board) by emailing, in the client's native language, the requisite 37 C.F.R. § 11.58 notices and information (including a copy of this Final Order that has been correctly translated into the client's native language) to:
 - 1. the email address for each client and, if applicable, the email address as set forth in the "Applicant's Information" portion of each client's trademark application, but only if such email address is an email address belonging to the client and one that Respondent reasonably believes to which the client has direct access (*i.e.*, not the email address belonging to a foreign referring entity);
 - 2. an email address belonging to the client and one that Respondent reasonably believes to which the client has direct access (*i.e.*, not the email address belonging to a foreign-domiciled third person or a foreign domiciled entity who referred the matter to Respondent); or

3. the foreign-domiciled third person or a foreign-domiciled entity who referred the matter to Respondent, but only if:
 - A. Respondent takes reasonable measures to ensure that the foreign-domiciled third person or a foreign-domiciled entity thereafter promptly forwards Respondent's email to the client with the translated Final Order attached and Respondent is copied on the forwarded email;
 - B. Respondent takes reasonable measures to learn from the foreign-domiciled third person or a foreign-domiciled entity that the client actually received Respondent's email and translated Final Order forwarded to the client; and
 - C. Respondent's affidavit submitted pursuant to 37 C.F.R. § 11.58(d) sets forth the details of his reasonable measures that are required by subparagraphs (3)(A) and (B) immediately above;
- h. During the period starting on the date of this Final Order and ending 30 days from the date of this Final Order, Respondent shall deactivate all USPTO.gov accounts that Respondent sponsored;
- i. Effective the date of the suspension, the USPTO is hereby authorized to disable or suspend any USPTO.gov accounts registered to Respondent as of the date of this Final Order (including all accounts that Respondent has ever established, sponsored, or used in connection with any trademark matter);

- j. Respondent shall not apply for a USPTO verified Electronic System account, shall not obtain a USPTO verified Electronic System account, nor shall he have his name added to a USPTO verified Electronic System account, unless and until he is reinstated to practice before the USPTO;
- k. Upon Respondent's suspension, he shall be barred from using, assessing, or assisting others in using or accessing any USPTO.gov account(s) or other USPTO filing systems for preparing or filing documents with the USPTO;
- l. Until a petition seeking Respondent's reinstatement to practice before the USPTO is granted pursuant to 37 C.F.R. § 11.60, Respondent shall be prohibited, and the USPTO is authorized to disallow Respondent, from the following: (1) opening or activating any USPTO.gov account(s) to be used for preparing or filing documents with the USPTO; (2) applying for, or attempting to apply for any USPTO.gov account(s) to be used for preparing or filing 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 preparing or filing documents with the USPTO; and (4) sponsoring or attempting to sponsor USPTO.gov account(s) to be used for preparing or filing documents with the USPTO;
- m. Nothing herein shall obligate the USPTO to take action, *sua sponte*, to re-activate any USPTO.gov account disabled or suspended pursuant to this order; rather, it shall be Respondent's sole responsibility to initiate any such re-activation of any such USPTO.gov account;

- n. Respondent shall cooperate fully with the USPTO in any present or future USPTO inquiry made into any foreign associates with whom Respondent worked in connection with trademark or patent documents submitted to the USPTO.
- o. If the OED Director is of the good-faith opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Agreement, this Final Order (including compliance with 37 C.F.R. § 11.58), or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:
 - 1. issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to an additional six (6) months for the violations set forth in the Joint Legal Conclusions, above;
 - 2. send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;
 - 3. grant Respondent fifteen (15) days to respond to the Order to Show Cause; and
 - 4. 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 good-faith opinion that Respondent, during Respondent's probationary period, failed to comply with any provision

of the Agreement, this Final Order, or the USPTO Rules of Professional Conduct, 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 an additional six (6) months for the violations set forth in the Joint Legal Conclusions above;
- p. 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;
- q. In the event the Respondent seeks a review of any action taken pursuant to subparagraph o., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- r. While Respondent is on probation, Respondent shall, at least on a monthly basis, (i) search the USPTO's online trademark search system (currently located at <https://tmsearch.uspto.gov/search/search-information>) for applications identifying him as the attorney of record; and (ii) promptly inform in writing the USPTO Office of Trademark Examination Policy of each trademark document filing identifying him as the attorney of record that was made without his knowledge or consent;

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- s. While Respondent is on probation, Respondent shall, at least on a bi-monthly basis, submit a written report to the OED Director stating that he has completed the monthly searches of the online trademark search system, and, as applicable, (i) stating that he identified no applications or other trademark filing in which he was named as the attorney of record that were not made by him or without his knowledge and consent; or (ii) providing copies of correspondence sent to the USPTO Office of Trademark Examination Policy as described in the preceding subparagraph;
- t. Nothing in this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order: (1) when addressing any further complaint or evidence of 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;
- u. The OED Director electronically publish this 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/>;
- v. 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. Harrison B. Oldham of Dallas, Texas, an attorney licensed in the State of Texas who engaged in practice before the United States Patent and Trademark Office (“USPTO”) or (“Office”). The USPTO Director has suspended Mr. Oldham from practice before the Office for a period of 30 days and placed him on probation for 12 months. This disciplinary sanction is based on Mr. Oldham having violated the following provisions of the USPTO Rules of Professional Conduct: §§ 11.103 (lack of diligence); 11.303(a)(1) and (3) (lack of candor to the tribunal—i.e., the USPTO); 11.503(a) and(b) (failure to adequately supervise non-practitioner assistants); 11.804(c) (engaging in conduct involving misrepresentation); and 11.804(d) (engaging in conduct prejudicial to the integrity of the USPTO trademark registration system).

Mr. Oldham is the sole principal of Oldham Law, PLLC. At all relevant times, Mr. Oldham operated a company called Trademark Pandora. In connection with Trademark Pandora, Mr. Oldham became the attorney of record for foreign-domiciled trademark applicants in approximately 1,800 trademark applications filed with the USPTO between January 2021 and May 2023. Mr. Oldham violated the USPTO’s ethics rules and trademark rules of practice. He impermissibly directed non-practitioner assistants—including an attorney who was licensed in the country of Portugal but who was not licensed in the United States—to sign his name to trademark documents that were then filed with the Office. Many of these documents contained sworn oaths on which the USPTO relied during *ex parte* proceedings to make factual and legal determinations regarding the applicants’ respective intellectual property rights. Such conduct violated the trademark signature rules set forth in 37 C.F.R. § 2.193 and the express guidance set forth in § 611.01(c) of the Trademark Manual of Examining Procedure.

In agreeing to the disposition of the matter, the OED Director has credited Mr. Oldham’s promptness, candor, and full cooperation with OED’s investigation. He participated in multiple interviews with OED and provided informative, thorough, and candid responses to requests for information. He promptly acknowledged the misconduct at issue herein.

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

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- w. Based on Respondent’s agreement to do so, Respondent waives all rights to seek reconsideration of this Final Order under 37 C.F.R. § 11.56, waives the right to have this Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge this Final Order in any manner; and
- x. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.

Users,
Shewchuk,
David

Digitally signed by
Users, Shewchuk,
David
Date: 2024.05.29
12:58:25 -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 the foregoing Final Order was mailed by email on this day to Respondent via counsel as follows:

Emil Ali
McCabe Ali LLP
emil@mccabeali.com

Users, Walker, Robert (Shawn)
Digitally signed by Users,
Walker, Robert (Shawn)
Date: 2024.05.29 15:52:01
-04'00'

DATE

U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450