

Client Alert: Beware of Trademark Scams – More than your Money is at Stake

Related Services

Intellectual Property

Trademarks

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Your company spends vast resources developing and protecting its brand. A brand or trademark is shorthand communication for your company's values and the quality of your products or services. Obtaining a trademark registration from the United States Patent and Trademark Office (USPTO) provides the fullest protection under the law. Once your company is granted a registration, though, there are ongoing obligations to maintain the registration through proper use and renewal at the USPTO. The renewal documents have legal implications and should not be filed without sufficient review or understanding.

The Scam

Since the USPTO records, including trademark owners' addresses, are now publically available online, a plethora of new, unscrupulous businesses have emerged that purport to offer owners renewals or other services. Many such services are wholly unnecessary, such as publication in a third party publication; others are legally questionable, such as trademark renewal without any legal analysis of the sufficiency of that filing. Even the apparently legitimate services, such as recording a trademark registration with the United States Customs & Border Protection, are offered at costs far beyond what a reputable company would offer.

Many of these businesses use deceptive means to market their services, including adopting corporate names that are similar to the USPTO like "Patent and Trademark Office," providing incorrect quickly approaching deadlines, or stamping the correspondence with official-looking seals. Following are some tips to identify whether a piece of correspondence comes from the USPTO and some information concerning the potential consequences of engaging these unscrupulous services.

How to Identify a Scam

1. Official communications from the USPTO will be sent to the “Attorney of Record.”

When a trademark application is filed with the USPTO by an attorney, the attorney is listed as the “Attorney of Record.” This means that the USPTO is only permitted to communicate or discuss the application with the Attorney of Record. Accordingly, if Vorys maintains your trademark portfolio, all official communications from the USPTO will be sent to Vorys as the Attorney of Record.

2. The USPTO does not send bills or invoices.

Fees for renewals and other trademark filings are paid online at time of filing. No pre-payment is required. Any correspondence demanding upfront payment is fraudulent.

3. The USPTO is located in Alexandria, Virginia.

If the correspondence you receive has a return address located somewhere other than in Alexandria, Virginia, the correspondence is likely a scam.

4. The USPTO's domain is USPTO.GOV.

If the correspondence you receive uses or refers you to a domain other than one ending in USPTO.GOV, such as patenttrademarkoffice.us, the correspondence is a scam.

5. The fine print will likely include a disclaimer about a relationship with the USPTO or the government.

While these businesses are out to deceive trademark owners about some aspect of their trademark registration or application, they still want to protect themselves. Accordingly, scam notices will include a statement about how they are a “private business” or not “endorsed by or associated with” the USPTO or a government agency.

The Consequences of the Scam

Engaging these businesses can be a costly mistake for the following reasons.

1. Unnecessary Services

The fees demanded are sometimes for unnecessary “services.” Despite official-looking correspondence and using terms of art in trademark law like “publication,” paying fees of several thousand dollars for publication in a third party journal is useless and is not required to maintain or protect your registration.

2. Inadequate Services

The services offered may also be inadequate to properly maintain your registration. For example, some of these businesses demand large payments to merely gather information needed to file renewal documents but **you** are responsible for actually filing the documents with the USPTO. Other offers are to file the documents without reviewing them for legal sufficiency. Since there are specific time frames for which the

documents have to be filed, failure to meet the legal requirements could cause your registration to be cancelled.

3. Invalidity

Offers to renew trademark registrations by these businesses create weaknesses in your registration. Trademark registration renewal documents contain legally binding declarations (which are made under penalty of law) concerning the extent of use of the trademark and require specific evidence of current use of the trademark. Having a party sign the declaration that does not have firsthand knowledge of the use of the mark jeopardizes the validity of the filings. Also, some of these renewal businesses expressly state that to renew the registration they will use the same proof of use of the trademark filed with the original application and will not revise the identification of goods or services. Should the registration be challenged after such a renewal, these facts could support cancellation of the registration.

The USPTO maintains a list of scam trademark solicitations with samples of the scam notices at <http://www.uspto.gov/trademarks-getting-started/non-uspto-solicitations>. If you receive a solicitation and are still unsure as to whether it is legitimate, please do not hesitate to contact the Vorys team. It is better to be sure than to put your valuable trademark registration at risk.