Client Alert: Trademark Owners

Don't Get Scammed! Beware of Fake or Misleading Trademark Notices

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As you may know, trademark registrations require maintenance. Trademark owners must file a Declaration of Use between the 5th and 6th year of registration, a Declaration of Use and Renewal between the 9th and 10th year of registration, and the same again every 9-10 years after that. The fees for such filings are set by the USPTO, and the filings are typically made by the trademark attorney of record. Unfortunately, there are people who take advantage of trademark owners by sending notices regarding such deadlines well before the filing is due to divert the Declarations of Use and Renewals to themselves.

Most of these notices come from companies that are impersonating the USPTO by using business names that are very similar, such as "Patent and Trademark Bureau" or "Trademark and Patent Office." Most of these notices list fees that are inflated, and while sometimes the Declarations and Renewals are actually filed, often they are not. In some cases the notice arrives well before the Declaration can even be filed, while one attorney told me a notice arrived after they had already filed the Declaration for their client.

You can avoid being taken advantage of by reading any notice carefully. Official notices will typically go to your attorney of record. If you are pro se, meaning you are representing yourself before the USPTO, then make sure you are reading any correspondence carefully. Remember that anything valid will be coming from the United States Patent and Trademark Office, or USPTO.

See an example here. When in doubt, ask your counsel.

If you have questions regarding this topic please reach out to our Trademark team.