

Owner Beware: Fraudulent Trademark Renewal Solicitation Scam

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Trademark owners generally know that to maintain a trademark, a trademark holder must file the required documents. For trademarks, these filings occur between the fifth and sixth years after the registration date, between the ninth and tenth years after the registration date, and every 10 years after that for as long as the trademark is in use. These are long periods of time, and it can be easy to lose track of time. A reminder notice is always helpful, but holders must ensure the reminder comes from United States Patent and Trademark Office (USPTO), rather than a fraudulent organization or a so-called IP expert offering their assistance.

Such scams are not necessarily a new phenomenon. In July 2017, the USPTO held a **public roundtable** to discuss how to combat such fraudulent solicitations. One of the ways the USPTO devised to fight the scams was to post a constantly updated **list of third-party solicitations** on their website. The USPTO also works with the Department of Justice (DOJ) to uncover these schemes. In September 2021, the DOJ announced that the head of one of these schemes was sentenced to four years in federal prison and ordered to pay \$4.5 million in restitution, after he pled guilty to mail fraud in a multi-million-dollar scheme, carried out over a nearly three-year period, that defrauded holders of United States trademark registrations.¹

So, what should you do if you receive a notice reminding you to renew your application? There are a few steps to take. First, check that the email really came from the USPTO and not one of the third-party scams listed on the USPTO website. All official correspondence about your trademark application or registration will come from your trademark attorney, or directly from the United States Patent and Trademark Office (USPTO) in Alexandria, Virginia, and all emails will be from the domain "@uspto.gov." If the email came from a third-party, do NOT engage with them and do not send them any money. You can also file a consumer complaint with the Federal Trade Commission (FTC), the nation's consumer protection agency. You may also email TMScams@uspto.gov if the scam originated from a company not on the **USPTO warning list**.

You can also verify maintenance requirements for your patent or trademark registration on the **USPTO's website**. Finally, the **trademark team** at Morse is always available to answer any questions you may have and help you avoid these fraudulent solicitations.

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1. <https://www.justice.gov/usao-sc/pr/latvian-national-sentenced-more-4-years-federal-prison-ordered-pay-over-45m-restitution> [↔]