

Beware of These Trademark Scams

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Have you filed a trademark application and received an email from a company that has an awfully official sounding name, but the offer just doesn't appear to be on the up and up. That is probably because it isn't. Trademark registrations are public records and can be searched by the general public. Unfortunately, there are unscrupulous companies that monitor US trademark registrations and send out letters to the registrants with offers to renew the registration. These companies intentionally choose names that sound official to confuse registrants into believing the letter sent is legitimate. The United States Patent and Trademark Office (USPTO) lists [\[1\]](#) several examples of names used by these companies. They use names such as Patent & Trademark Renewal Services, Patent and Trademark Office, Patent & Trademark Agency, Patent and Trademark Bureau, Patent and Trademark Organization, Trademark and Patent Office, Trademark Compliance Center, etc. As can be seen, these names are meant to be official sounding, official looking, and be as close as possible to the USPTO's own official name. Many of these organization are located in the US, but there are also foreign organizations. The problem has gotten sever enough that, in August, 2021, the United States Patent and Trademark Office (USPTO) has filed registrations [\[2\]](#) to protect its own name.

These companies run at least three types of scams.

The first is an offer by a company to "publish" your trademark application. Trademark applications are published by the United States Patent and Trademark Office - for free (actually its part of the filing fee). An offer from one of these companies to publish your application won't jeopardize any of your rights, but it won't give you any added benefit either. All it will do is separate you from your money.

The second type of scam is an offer to help you maintain your registration. A trademark owner must file a declaration of use between the 5th and 6th year after issuance of a registration, and then must renew the registration between the 9th and 10th year after registration and every 10 years thereafter. A trademark can be maintained in force as long as it is renewed.^[3] In these maintenance scams, the scammers “offer” to help you maintain your registration. Their “offers” include a dire warning that your registration is about to expire. However, these “offers” are almost always off by exactly one year. So they are sending the letters out long before you can even file your declaration of use or renewal. At a minimum, these registrations, too, will only separate you from your money. More concerning, however, is that if you do accept the “service” provided by these scammers, your registration could be in jeopardy.

A third, seemingly, newer scheme is the sending of a email which appears to come from a law firm. In this email, the “law firm” informs the company that they have a client who is filing a registration application for the company’s name. This letter continues with warnings of potential trademark infringement if the company does not contact the law firm.

The USPTO website includes a section - <https://www.uspto.gov/trademarks/protect> - dedicated to protecting against these scams. In addition, the USPTO works with other federal agencies, such as the Department of Justice, the Federal Trade Commission, and the Department of Commerce’s Office of the Inspector General, to investigate and shut down these companies. As recently as September 2021, the USPTO obtained a criminal conviction^[4] against an individual, Viktors Suhorukovs, who had defrauded over 2900 registrants.

Viktors Suhorukovs was sentenced to more than four years in prison and ordered to pay more than \$4.5 million in restitution. However, there are many companies that send fraudulent notices and it is nearly impossible for the US Government to stop all such activity. Thus, trademark owners need to be wary of solicitations regarding their trademarks.

This raises the question – how can trademark owners know if official looking correspondence regarding their trademarks is legitimate. Firstly, these letters are written to create fear, and contain statements such as, “Your trademark is about to expire”. These statements are wrong. All registrations have a one-year window during which the registration can be renewed. In fact, the registration can be renewed for 6 months after the one-year window closes by paying late filing fees. No registration is “about to expire” until it is close to 18 months after the renewal window opens. Any “official looking” communication regarding a registration which creates a fear of expiration should be viewed with suspicion.

Also, review these letters carefully. We have seen many of these letters asserting that the registration is going to expire before the window to renew actually opens. Often times, the letters are sent out one year before the renewal period opens, well before the registrant’s attorney will be sending out the letter.

Finally, if there is any question as to why you are receiving a letter or email about your trademark, contact your trademark attorney. There is a good chance that the email or letter you received is a scam,

^[1] See <https://www.uspto.gov/trademarks/protect/caution-misleading-notices> (accessed March 5, 2022)

[2] The USPTO filed registrations for USPTO, UNITED STATES PATENT AND TRADEMARK OFFICE, and the USPTO logo.

[3] Currently, the oldest existing trademark registration (Reg. No. 11210) was granted on May 27, 1884 was for SAMSON and Design for use with ropers, cords and lines.

[4] <https://www.uspto.gov/subscription-center/2021/developments-fraudulent-solicitations> (accessed March 5, 2022)