

Legal Update

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AVOIDING MISLEADING TRADEMARK AND DOMAIN NAME SOLICITATIONS

By Glenn Rice

If you own a federally registered trademark or service mark or if you have applied to register one with the U.S. Patent and Trademark Office (USPTO), chances are that you have recently received one or more official-looking “notices” or invoices by mail requesting payment of fees for various trademark-related services. For a fee, they typically offer to “register” a trademark on a private registry, record a registered trademark with U.S. Customs and Border Protection (CBP), or provide legal services or trademark monitoring services. The senders often use official-sounding names like the “United States Trademark Registration Office” but they actually have no legitimate affiliation with the USPTO or any other government agency.

Unsuspecting trademark owners may not realize this and may end up paying for services that have little or no real value. They may also pay hefty fees to purchase unnecessary domain names based upon misleading domain registration solicitations. Unfortunately for trademark owners, the problem of misleading trademark and domain name solicitations seems to be getting worse.

The Recent Rise in Trademark Services Solicitations

Trademark attorneys have noted a sharp rise in such trademark services solicitations over the past few months. So, too, has the USPTO, prompting it to post a detailed warning on its website about the official-looking notices and invoices and how they have led some trademark owners to mistakenly pay what they believed were required government fees. See http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

Trademark owners can expect to be targeted with more solicitations in the future. Trademark applications and registrations are publically available through the USPTO’s online database, making trademark owners easy prey for unscrupulous operators who aggressively mine the database. To give their notices and invoices an aura of official legitimacy, many mailings emphasize the USPTO registration and application serial number, the International Class number, filing date, and other information gleaned from the USPTO’s records, as well as refer to sections of the U.S. Code.

Like many other trademark owners, we recently received an “IMPORTANT NOTIFICATION” from the “United States Trademark Registration Office” concerning registration of our service mark POST OR PERISH[®] for our Firm blog (<http://postorperish.com/>). The official-looking form stated that the United States Trademark Registration Office would record our POST OR PERISH[®] registration with CBP and

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conduct trademark monitoring services upon payment of the stated \$375 fee. To elicit a sense of urgency, the “Reply Date” was marked “DUE NOW.”

While recording one’s federally registered *trademark* with the CBP can assist it in preventing importation of *physical goods*, there is no reason to record a *service mark*, such as our POST OR PERISH® blog, with the CBP. We also saw little reason to place our trust in the proffered trademark watch services, given that it was immediately followed by a bolded advisory that the protection of our mark from confusingly similar names was our own “sole responsibility.” Although the form did state further down that it was not a bill, but a solicitation, and not made by an agency of the government, unsuspecting trademark owners might not spot such a disclaimer, particularly when the notice otherwise appears to come from a U.S. government agency. Worse yet, because these notices often have the appearance of an official invoice, they may be routed directly to your accounting staff for payment.

Domain Name Registration Solicitations

Many trademark owners have also received e-mails from domain name registration companies claiming that another company has applied to register domain names based upon the owner’s trademark. The e-mails warn that unless the trademark owner takes quick action, the domain name applications will be approved. The domain name companies offer to help trademark owners register the domains before this can occur for an inflated fee. The solicitations typically focus on top-level domains in Asia such as .cn, .hk, or .asia, and in many instances do so even though the trademark owner has no business interests in Asia that would warrant domain registration.

Such solicitations are highly misleading because legitimate domain registrars do not undertake to search trademarks for their rightful owner. There is no domain name application investigation process or challenge period. If a domain name is available, it may be registered immediately. If a domain has been registered and is being used in bad faith, a trademark owner may seek to have it turned over by filing a complaint for arbitration under the Uniform Domain Name Dispute Resolution Policy or a lawsuit under the Anti-Cybersquatting Consumer Protection Act.

Tips and Best Practices

Trademark owners can successfully avoid being victimized by misleading trademark and domain name solicitations by following these tips and best practices:

- Be aware that the USPTO does not send notices or invoices requesting payment for trademark monitoring, recordation of a trademark with CBP, private registry or directory listings or similar services, and does not itself provide any such services to trademark owners.
- If a trademark owner has used an attorney to prosecute a trademark application, the USPTO’s practice is to communicate directly with counsel of record rather than the trademark owner. All official correspondence will come from the “United States Patent and Trademark Office” in Alexandria, Virginia and, if by e-mail, will be sent from the domain “@uspto.gov.”

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- Inclusion of your trademark in a private registry confers no substantive legal rights and provides no value or benefit to you.
- While trademark monitoring can be a valuable service, trademark owners should ask an experienced trademark attorney to recommend a trusted and reputable trademark watch service.
- Alert accounts payable and accounting staff so that they can be on the watch for misleading trademark services notices or invoices that should not be paid.
- Do not respond to e-mails from domain service companies that claim the existence of applications to register domain names based on your trademark and offer to help you register the domains. Instead, ask whether it makes good business sense for you to own the domains in question and, if so, register them yourself with an accredited registrar or use a reputable company to help you do so.

Trademark owners should carefully scrutinize all trademark and domain name communications they receive. When doubts or questions arise, trademark owners should consult their trademark counsel.

FVLD publishes updates on legal issues and summaries of legal topics for its clients and friends. They are merely informational and do not constitute legal advice. We welcome comments or questions. If we can be of assistance, please call or write Glenn Rice 312.701.6895 grice@fvldlaw.com or your regular FVLD contact.

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