

## Client Alert

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January 20, 2015

# Beware of Fraudulent Trademark Solicitations and Invoices

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Fraudulent solicitations and invoices for trademark services are on the rise, inundating trademark applicants and registrants with offers to perform potentially unnecessary services. These solicitations often come in the form of invoices, with prominent false “due dates.” Alternatively, they look like official communications, on letterhead and with an envelope designed to make it appear like it comes from a government agency, and with a request for instructions and payment. The solicitations purport to offer a variety of services related to a specific trademark, including publication services, watch services, registration services, domain name registration services, renewal services, and more. They may come from entities located anywhere in the world, but are most commonly coming from entities that appear to be located in the U.S. or Europe. If you own registered trademarks or pending trademark applications, you will no doubt receive such solicitations if you have not already. When you do, you can disregard them as they usually seek payment for services that you do not need, or for which you have already paid, but it is sometimes hard to tell if they are legitimate.

For example, we have recently been asked about invoices from the “International Catalogue of Trademarks, TM-Edition.” Their invoices typically include a reproduction of a newly filed trademark and request payment of “registration costs” of \$1,650 or more. The only services to be received for that payment, however, are a “listing in the TM-Edition” and a complimentary copy of the publication. Publications of this sort provide no benefit to trademark holders. Moreover, all registration fees should be paid directly to the relevant trademark office by trademark counsel who is representing the applicant in connection with the filing. Registration fees should never be paid to third parties, no matter how real the invoice looks.

Another recent example comes from the “Trademark Compliance Center” in Alexandria, Virginia. These official-looking invoices, complete with a barcode at the top, list a “processing fee” of \$385 to record a trademark with U.S. Customs & Border Protection. In bold letters, the invoices warn that holders of registered trademarks concerned about the import or export of infringing goods should record their trademarks with Customs. These invoices appear to offer something of value, except that they are regularly sent after new applications are filed, and pending trademark applications cannot be recorded with Customs.

These are just two examples of the numerous solicitations we have seen recently—solicitations that request payment for services with no benefit and that are becoming more and more official-looking, creative, and frequent. Unfortunately, the issue is complicated by the fact that not all legitimate correspondence will be sent to trademark owners through their trademark attorney of record. Some legitimate communications may come from other sources and be sent directly to the trademark owner. For example, if a petition to cancel is filed against a U.S. registration, the U.S. Trademark Office may mail the petition and scheduling order directly to the registrant, not to

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the attorney of record. It is important not to ignore this type of communication because the registration will be cancelled if the registrant does not respond to a petition to cancel. Similarly, if an international registration is filed via the Madrid Protocol to protect a mark in Japan or Korea, the Japanese and Korean trademark offices will send the registration certificates directly to the registrant, not to the attorney of record. Those certificates of registration are the originals and should be retained in a safe place in case the trademarks become the subject of litigation. They should not be disregarded.

If you have any questions regarding any communications you receive pertaining to your trademarks, please contact one of the members of our trademark group. We can confirm whether it is legitimate and whether any action is needed.

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