



## Client Alert

November 2012

### Trademark Scams and Misleading Solicitations

by Stacey Carrara Friends, Esq.

Misleading solicitations and scams related to trademark registrations seem to be more and more prevalent lately. Here are some tips so you can spot the scams, not waste valuable time responding to them or checking on their validity, or even worse, being taken in by them. There are three main types of solicitations to be aware of: 1) notices about renewing your trademark; 2) notices about the publication of your trademark, and 3) Emails about domain names including your trademark being registered by someone else.

1. Notices about Renewing your Trademark - These are arguably the most pernicious because they seem so real. They often come from organizations with names that resemble the United States Patent and Trademark Office (USPTO), such as the "United States Trademark Registration Office," "Patent & Trademark Agency," or, more recently, "Trademark Renewal Service" (see attached example, included here with the kind permission of our client, Paradigm Works). These notices may include some accurate information about your trademark and warn you that the registration will be cancelled if you do not renew. Even cleverer is that these companies are sending the notices BEFORE the time frame for filing the renewal, which means their notices are beating our reminder letters to you. The notices ask for a high fee to file the necessary documents, or, as is the case with the Trademark Renewal Service, a \$200 fee just to receive the documents needed to renew. Please be aware that you should never receive anything from the USPTO (or any international trademark office, either, such as WIPO or OHIM) about renewing your registrations. This is something that you need to calendar yourself, and which we help you with through our docketing system. Any other notices from the USPTO or other official organization will come to Ruberto, Israel & Weiner as your representative, so you should never receive anything directly. If you did, it would come from the USPTO in Alexandria, VA, or if by email, from an address at uspto.gov.

2. Notices about Publishing your Trademark - These notice come from companies which pretend to be either an official agency or an official publication of marks. The ones we have seen recently have come from "TM-Edition," and "Register of Protected Trademarks," but we have also seen very misleading notices attempting to disguise the source as the World Intellectual Property Organization (WIPO), such as "WIPD World Intellectual Property Database" and "WBIP World Bureau Intellectual Property." Such notices list your trademark information as well as a fee and payment instructions. The fine print tells you that this is for inclusion in their directory of marks, which is not required or genuine. Trademarks are published by the trademark office of the country in which you applied, so in the U.S., the USPTO publishes approved marks in its Official Gazette. WIPO, for example, does not even publish marks at all, that is done by the individual trademark offices in each country. One big clue to help you figure out if a notice is bogus is to see what country or state the notice has come from. The notices we have seen have come from Hungary, England, Slovak Republic, Austria, the UK, and Belgium, and in the U.S. from Miami, Aloha, OR, Wilmington, DE, Los Angeles, and Summerville, SC. Like the renewal notices discussed above, anything official regarding your trademark registrations should not come to you directly if you have an attorney, and even if it did, it would come from the USPTO in Alexandria, VA.

3. Communications about your Domain Name - These are typically in the form of an email, and often come from a company in China or Hong Kong. The sender states that they are an internet or IP consulting organization and that someone is attempting to register domain names which include your trademark, and

which they discovered during their audit or investigation. The domain names listed typically have a sTLD (sponsored top level domain) extension such as .asia, a ccTLD (country code top level domain) extension such as .hk or .cn, or use .hk or .cn as a second level domain extension. The email will ask if you have any relationship with the company trying to register these domain names and if not, ask you to contact them. When you do, they offer to help you register the domain names instead, but in their name. These are never valid. It is unlikely that someone is attempting to register these domain names at all, and even if they were, no company or registrar would notify you. Unfortunately anyone can register any domain name, and if it violates a trademark owner's rights, that owner must seek a transfer of the domain name through a cease & desist letter or the arbitration procedure through ICANN (Internet Corporation for Assigned Names and Numbers). In addition, it is unlikely you need these domain names, and if you do, we would be happy to put you in touch with an accredited registrar who would register them properly in your name.

If you receive a notice and would like to check it out yourself, a list of known misleading notices can be found on the WIPO web site at [http://www.wipo.int/pct/en/warning/pct\\_warning.html](http://www.wipo.int/pct/en/warning/pct_warning.html)

Of course, if you have any questions at all about notices that you receive, or your trademark protection in general, feel free to contact me at [sfriends@riw.com](mailto:sfriends@riw.com).

---

Stacey Friends is a shareholder of Ruberto, Israel & Weiner, P.C. Her practice is focused on trademark and copyright law, licensing, corporate and business matters, and entertainment. Stacey handles all aspects of trademark clearance, registration, and enforcement, both federally and internationally for large and small companies. Before joining RIW, Stacey was an attorney at Peabody & Arnold LLP and was founder of Stacey Friends & Associates. Stacey is a *summa cum laude* graduate of Suffolk University Law School, where she was a Note Editor for the Transnational Law Review, and where she has also taught Copyright Law. Stacey is also a frequent speaker on trademark and copyright law, most recently for MCLE, Suffolk Law, MITX, and the MBA.

Ruberto Israel & Welner, P.C. | 255 State Street, 7th Floor | Boston, MA 02109 | 617.742.4200

[contact us](#) | [www.riw.com](http://www.riw.com)

©2012 Ruberto, Israel & Welner, P.C.

*This material is intended for informational purposes only and is not meant to be construed as legal advice. For a comprehensive understanding of the issues raised in this material, please contact a qualified attorney of your choice.*

255 State Street, 7th Floor, Boston, MA 02109

This email was sent to [% member:email %]. To ensure that you continue receiving our emails, please add us to your address book or safe list.

[manage](#) your preferences | [opt out](#) using TrueRemove®.

Got this as a forward? [Sign up](#) to receive our future emails.

