

BEWARE PATENT AND TRADEMARK SCAMS

Picture this scenario affecting a growing number of patent and trademark owners:

Congratulations! You have overcome the obstacles and brought a product to the market. You created a brand for this product that was distinct enough to be awarded a U.S. Trademark Registration. This Registration carries presumptions of distinctiveness and exclusivity of the mark in your favor. It gives you the ability to enforce your rights at the border against infringing imports entering the country. Perhaps your product is also so unique that you were awarded a U.S. Patent, which allows you to exclude others from making, using, selling, offering to sell, or importing your invention. You are on your way.

One day, you receive a document in the mail stating that you need to take action to protect your mark or your invention. The document looks official. It may even say "Patent and Trademark Office" at the top. It states that your Registration or Patent is coming due for renewal or maintenance, which you can accomplish by paying the sender hundreds or even thousands of dollars. Thinking you are protecting your rights, you promptly remit payment, believing that your Registration will be renewed or that your Patent is being maintained.

In reality, however, the company does nothing to renew your Registration. It does not submit the maintenance payment for your Patent. You have just been the victim of one of many scams increasingly targeting patent and trademark owners.

Private companies scour the Patent and Trademark Office records to obtain patent or trademark owner information for the purpose of sending various solicitations for services. Some services, such as offering assistance in responding to an Office Action, renewing a Registration, maintaining a Patent, or applying to register a mark or patent in a foreign country, may be legitimate. Others, such as

recording your mark or invention in a special private registry, are not. In any event, there is no guarantee the services will actually be provided, and oftentimes they are not. Some companies even pose as government agencies collecting required fees, which is certainly not a legitimate purpose.

As a general rule, if you have sought legal representation with respect to your patent or trademark filings, then any official correspondence from the USPTO pertaining to your patent or trademark registration or application will be directed to your attorneys and not you directly. McHale & Slavin docket all dates and deadlines relating to your registration or application, and notifies you well in advance of any required tasks and associated fees and costs. If you are considering filing in foreign countries, we have an extensive network of associate firms ready to protect your rights in virtually any jurisdiction throughout the world.

The United States Patent & Trademark Office (USPTO) is aware of these solicitations, to the extent that it has even posted warnings for Trademark Owners on its website at :

<https://www.uspto.gov/trademarks-getting-started/caution-misleading-notices> and

<https://www.uspto.gov/trademarks-getting-started/non-uspto-solicitations>, though there does not appear to be similar postings regarding patents. The USPTO does not have legal authority to stop these solicitations, though its website links to an online complaint form with the Federal Trade Commission. If you have any questions about a notice you receive pertaining to your patent or trademark, feel free to contact us for a consultation and review.

By: Brian M. Taillon