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Client Alert: Business Owners and Managers Beware: “Your Trademark is About to Expire” Scam

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Your intellectual property (IP) is, of course, valuable to your business, and you have likely taken appropriate steps to maximize the legal protection for those assets. The most common form of protecting your company name, logo, or tagline is by a federal trademark registration with the United States Patent and Trademark Office (USPTO). Other federally granted protections include federal copyright registration with the United States Copyright Office and federal patent registration with the USPTO. Here’s a quick IP refresher: Copyright is a form of protection for original works of authorship that are “fixed in a tangible medium of expression”; a trademark is a word, name, phrase, or logo that identifies a product or service and helps distinguish it from that offered by the competition; and a patent is a grant to an inventor that allows the inventor to monopolize the manufacture, use, sale, and importation of an invention¹.

A current scam linked to such assets involves the “renewals” of your trademark registration rights. The trademark registration rights described above come with a requirement to take certain action in order to maintain the registration on the books of the USPTO, including filing a notification with the USPTO between the fifth and sixth years after the registration grant, and between the ninth and tenth years after the registration grant – let’s refer to both of these filings as “Renewals.”

These scammers try to take advantage of your fear of the unknown details of the legal processes and procedures of Renewals by creating a false urgency to action. The notifications you are receiving are cleverly deceptive and likely do cause some panic – that’s why I receive many frantic phone calls and emails about a Renewal issue! While these letters do contain a somewhat legitimate notification of a need to take the Renewal requirement actions discussed above, I treat these “notifications” as a “scam” because of the false sense of urgency created by the form and words used in the notification. Visit shumaker.com to view samples of these forms.

As you will note, the forms look official as if they are coming from a federal agency, use sender names, such as “Patent and Trademark Bureau” or “Patent and Trademark Office,” and in some cases, use a Washington D.C. address. They use language, such as “Pending Trademark Cancellation” or “Your Trademark is about to expire.” Yes, there are disclaimers that these companies are not governmental agencies – but in the fine print of course. What these companies are trying to do is get your business by interrupting the normal flow

of the Renewal process with your attorney – and in many cases, charge you more than your attorney would for such services. These notifications are often sent when the current registration period has a year or more left to go!

My response to those many calls and emails, after carefully reviewing the actual notice which was sent, is to ignore such notices. However, keep in mind that the UPSTO does send out various legitimate types of notices, but they would not be soliciting you to “help” you with a Renewal. And for my clients, know that we will be in contact with you at the appropriate time, with plenty of advanced notice, and most importantly, not send you an inflammatory letter or email to raise your blood pressure. Always feel free to send us a copy of any notices received so that we can verify the legitimacy (or not) of such notices.

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¹ From Nolo.com: “Which Protection Do I Need: Patent, Copyright, or Trademark?”