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legal alert



underberg & kessler LLP

Unsolicited Trademark Communications Call for Close Scrutiny

From time to time, attorneys at Underberg & Kessler receive inquiries from our clients regarding solicitations that resemble official government documents concerning trademark matters, but that are actually commercial solicitations from private companies.

For example, private companies not associated with the United States Patent and Trademark Office (USPTO) often use trademark application and registration information from the USPTO's databases to prepare and mail trademark-related solicitations. Such solicitations may include offers for legal services, for trademark monitoring services, and to "register" trademarks in the company's own private registry.

These companies may use names that resemble the USPTO name in order to catch the attention of the recipient. For example, one or more of the terms "United States," "Trademark," "Patent," "Office," "Registration," or "Agency" may appear in the company name. Some companies also attempt to make their solicitations mimic the look of official government documents rather than the look of a typical commercial or legal solicitation by emphasizing official government data that is publicly available from USPTO records. For example, the solicitation may include the relevant USPTO application serial number, the registration number, or the International Class of relevant goods or services. Many refer to particular government agencies and sections of the U.S. Code. Most require "fees" to be paid.

The solicitations sometimes urge clients to consider taking actions that may be costly, and not necessarily in the clients' best interest. In fact, on April 30, 2013, a lawsuit was filed in New York aimed at shutting down a business that allegedly charges exorbitant fees for trademark registration services and gives bad advice to prospective customers. The plaintiff sued Patent & Trademark Agency LLC and its operator (PTA), saying that PTA's solicitations are intended to give the impression that PTA is associated with the USPTO. The complaint seeks an injunction and monetary damages. The complaint also accuses PTA of including in its notices intimidating language that falsely states that a recipient's trademark "is about to expire." According to the lawsuit, another concern is that if PTA performs the types of services it purports to provide customers, it could rise to the level of practicing law without a license. In light of the fact that many solicitations from companies such as PTA request the payment of fees and other actions that may prove costly, a recipient should take care to read all trademark-related communications carefully before making a decision about whether to respond.

If you receive a trademark-related solicitation that you believe is deceptive and wish to discuss this with an attorney from Underberg & Kessler, please contact Paul Nunes or Luis Ormaechea.

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