

MISLEADING COMMUNICATIONS REGARDING TRADEMARKS AND BUSINESS NAMES ON THE RISE

Traditionally, it has been fairly common for trademark applicants and registrants with the U.S. Patent and Trademark Office (USPTO) to receive solicitations from third parties regarding their pending or registered marks. These private companies use trademark application and registration information from the USPTO's database, as well as public information, to mail or e-mail trademark-related solicitations. Many of these solicitations come from companies trying to mimic the USPTO and have the third parties pay an enhanced fee for a variety of services including (1) trademark monitoring services; (2) renewal of registered trademarks; (3) recordation of trademarks with the U.S. Customs and Border Protection; (4) registration of the trademark in the company's private database; and (5) a variety of other legal services.

More recently, there has been an increase in the number of solicitations from companies that require an "urgent response." The solicitations allege that without response, the trademark holder or business owner risks losing their trademark rights because their brand name is not registered with the USPTO and has now been filed by a third party. The solicitations are often misleading to business owners because of the need to respond quickly. These communications are not legitimate, and we do not recommend responding. Of course, if there is ever a question as to the legitimacy of a solicitation, legal counsel can assist in reviewing.

If the mark cited in the solicitation is not registered with the USPTO and you have an interest in filing an application to register the mark, we recommend first evaluating your trademark portfolio and searching the USPTO records for similar marks. Securing federal registration of a mark with the USPTO is not required but provides certain advantages, including providing public notice to third parties of your rights in the mark, the right to use the federal trademark registration symbol (i.e., ®), a legal presumption that you own the trademark, and the right to bring a lawsuit concerning the trademark in federal court. A federal registration with the USPTO is not required to have trademark rights in

PEOPLE

Elizabeth O'Donoghue, Ph.D.

Donna Frazier Schmitt

SERVICES AND INDUSTRIES

Trademark

Intellectual Property



the U.S. because trademark rights in the U.S. are based on use of the mark in connection with goods and/or services.

Armstrong Teasdale's Trademark Services team will continue to monitor for updates or additional red flags related to solicitation and will keep clients apprised via further email communication. If you are interested in filing an application with the USPTO, please contact your regular AT lawyer or one of the listed authors, and we are happy to assist with the process.