CLIENT ALERT: UNSOLICITED OFFERS FOR TRADEMARK SERVICES

DECEMBER 2, 2004

Owners of registered trademarks or applications to register trademarks in the United States and abroad often receive unsolicited offers relating to their trademarks.

The documents are sent directly to trademark owners using the registrant or applicant information that is listed in publicly available trademark databases and harvested by these companies for marketing purposes. The name of the company sending the offer often suggests a governmental affiliation and the document resembles an official invoice for a trademark-related service, such as monitoring, protecting or publishing trademarks in an effort to detect or prevent infringement. Generally, these services are either unnecessary or offered at significantly higher costs than similar services offered by reputable, well-known companies.

One such organization is the United States Trademark Protection Agency ("USTPA") located in Seattle, Washington. The USTPA sends a document called a "Form 104B" to owners of trademark applications, apparently based upon publicly available information in the United States Patent and Trademark Office ("USPTO") online database.[1] The form may say "Elective Electronic Trademark Monitoring Service" or "Urgent Notice of EETM Service Registration." It is our experience that many educated clients may mistake this form for an official document and send in the requested fees before consulting with counsel. The USTPA's monitoring service, which costs $375 per trademark per year, is nothing more than an automated monitoring of the Trademarks Official Gazette, located on the USPTO website at http://www.uspto.gov/web/trademarks/tmog/ which lists applications approved for publication by the USPTO, and the USPTO online database of trademark applications and registrations located at http://tess2.uspto.gov/bin/gate.exe?f=tess&state=lpk8vm.1.1. The USTPA purports to report to a trademark owner any potentially conflicting or confusing applications that are found during the searches so that the owner may oppose a pending registration at the appropriate time or otherwise contact the owner of the potentially confusing trademark.

The form does provide a very small disclaimer that states, "Electronic Trademark Monitoring provided by the United States Trademark Protection Agency is an elective service and is neither a legal requirement nor a mandatory registration." It is ironic that an entity that claims to be concerned about eliminating trademark confusion has chosen a name confusingly similar to the USPTO. The similarity of the name has even prompted the USPTO to post a

[1] *See* www.ustrademarkwatch.com/tpastruts/more.htm as of Dec. 2, 2004.

warning on its website that "An entity doing business as the **'United States Trademark Protection Agency'** is **NOT** affiliated with the United States Patent and Trademark Office."[2]

Additional companies that may solicit unnecessary services or services for higher than average fees include:

- Company for Publications and Information (CPI) Anstalt in Liechtenstein (which claims to publish trademarks in The Publication of Brand Names of the International Economy);
- Society pour Publications et Information (SARL) in Vienna, Austria;
- Globus Edition S.L. in Palma de Mallorca, Spain;
- Trademark Renewal Service in Washington, D.C.;
- Company for Economic Publications Ltd. in Austria;
- Global Edition KFT;
- Institute of Commerce for Industry, Trade, and Commerce in Switzerland;
- TMI Trademark Info Corporation located in Pearland, Texas;
- ZDR Datenregister GmbH in Germany; and
- INFOCOM in Schaan, Switzerland.

What can you do?

Although a monitoring service may allow a trademark owner to learn of conflicting trademark applications to take advantage of administrative procedures to oppose pending applications for confusing marks, such services are available for less cost from companies with established reputations that do not resort to confusing, unsolicited mailings for services to generate business.

- Reputable companies provide similar monitoring services for significantly less cost. For example, Thomson & Thomson provides a USPTO Official Gazette Watch and Pending Application Watch for $170 per mark, per class.[3] CCH

[2] *See* www.uspto.gov/main/newsandnotices.htm, as of Dec. 2, 2004 (emphasis in original).

[3] *See* www.thomson-thomson.com, as of Sept. 9, 2004.

Corsearch provides similar packages that begin at about $180 per mark, per class.[4]

- A company can designate employees to conduct regular searches for confusingly similar trademarks as part of their assigned duties. For example, a paralegal could be tasked to search the USPTO online database, located at www.uspto.gov, the Internet and other available databases on a regular basis searching for companies using trademarks the same as or similar to your company's trademarks.

- If you identify another company's use of a name that you believe to be confusing, whether through a regular search or otherwise, you should consult with a qualified counsel immediately as you may need to move swiftly to protect your rights.

- Alert your employees in relevant areas of the existence of these potential trademark scams.

- If you receive information from one of the companies listed, contact them and request that you be removed from their mailing list.

- You should receive official notices relating to your trademark or trademark application only from the United States Patent and Trademark Office or your attorney. Be careful to consult with your attorney before sending any correspondence regarding your trademarks or payments to any third party.

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If you have any questions about the subject matter of this memorandum or issues related to trademarks or other intellectual property matters, please contact Lori E. Lesser (212-455-3393; llesser@stblaw.com) or Robyn J. Rahbar (212-455-2254; rrahbar@stblaw.com) of the Firm's Intellectual Property practice group.

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[4] *See* www.corsearch.com, as of Sept. 9, 2004.