

August 9, 2018

Companies Should Be Aware of Misleading Trademark Renewal Notices

Federal trademark registrations are an extremely valuable asset to any company's intellectual property portfolio. With an emerging trend of private companies sending misleading trademark renewal notices that appear official but are inaccurate or incomplete and solicit more funds than necessary for renewal, any business with federal trademark registrations needs to be aware to protect its assets.

A federal registration protects a company's trademarks and extends a company's trademark rights throughout the United States. After acquiring a federal registration, a trademark owner must renew his or her registration between the fifth and sixth years following registration, and then between the ninth and 10th years following registration. In order to renew a registration, a registrant must swear under oath that the trademark is being used with all of the goods and/or services contained in the registration and submit a specimen of use showing use of the trademark in conjunction with such goods and/or services. Additionally, a registrant must pay a fee to the United States Patent and Trademark Office ("USPTO") for the renewal. Under recent USPTO practice, the USPTO sends courtesy reminders for renewal to attorneys that represent registrants, or to the registrants themselves.

Over the last few years, numerous private companies have surfaced that send renewal notices to trademark registrants that appear to be official notices from the USPTO. These notices may provide an erroneous renewal date, do not request specimens for renewal and request more money from the registrant than is required to renew a registration. Many of the companies sending these misleading notices operate under names that sound like they are in fact the USPTO, or affiliated with the USPTO.

Just recently, a Brownstein client was misled into (over)paying for a trademark renewal by a company named the "Patent & Trademark Bureau." A redacted communication from this company can be viewed [here](#). There are a number of issues with this "Reminder" notice. To begin with, it states: "Your trademark is about to expire. Renewal date: July 21, 2018." This statement is misleading at best. Since the registration in question was registered on July 21, 2009, the registration does not need to be renewed until July 21, 2019. Additionally, a registrant is provided with a six-month grace period to renew if they pay an extra fee. So technically, the registration would not expire until Jan. 21, 2020 – a far cry from July 21, 2018. The "Reminder" also does not even ask for a required specimen. Finally, the governmental cost to the USPTO for a two-class Section 8/9 renewal is \$850, yet the "Patent & Trademark Bureau" requested \$2,500.

While the "Reminder" states in small print that the Patent & Trademark Bureau is a private company, the communication clearly appears (erroneously) to the ordinary observer to be an official government form. We have seen other such forms that appear even more sophisticated and official.

The USPTO has issued an advisory about these types of practices, which includes a list of companies already reported to the USPTO for this kind of activity. It can be viewed [here](#).

The USPTO urges those who receive such notices to file a consumer complaint with the Federal Trade Commission. *Id.*

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If you have received a notice or other communication from one of the companies listed in the USPTO's advisory or another suspicious company, we urge you to contact us to discuss the communication and options for trademark renewal.

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