

Client Alert: Beware of New Variation on Unsolicited Trademark Services

May 31, 2006

Recently, it has come to our attention that companies unaffiliated with the official United States Patent and Trademark Office ("PTO") are sending owners of registered trademarks and applications to register trademarks unsolicited and unofficial notices requesting payment of trademark renewal fees. This is a new variation on the type of unsolicited offers that we brought to your attention in December 2004 in our memo "Client Alert: Unsolicited Offers for Trademark Services," which is attached here for your reference.

As with other unsolicited trademark services offers, these companies send documents directly to trademark owners using information that is publicly listed on the PTO database. Not only does the name of the company sending the documents resemble an official government entity, but the forms themselves are designed to look like legitimate invoices and request trademark renewal fees and offer monitoring services to allow trademark owners to keep track of when renewal filings are due. While, as discussed below, renewal filings are required to preserve registered trademarks, these filings and the fees associated with them should only be made to the PTO.

A company called the American Trademark Agency, located in Houston, Texas, is one such scam organization that sends a document called a "Section 9 Trademark Renewal/Section 8 Affidavit," pursuant to which it offers to file certain renewal affidavits with the PTO to prevent the owner's trademarks from being cancelled, and to monitor the approach of operative dates for future renewal deadlines. The fees requested are significantly higher than the actual fees charged by the PTO. However, it is our experience that even educated clients may mistake this form for an official document and send in the requested fees without consulting with counsel, especially because the timing of these unofficial renewal forms coincides with the deadline by which the actual PTO renewal filings are due, thereby making them seem even more legitimate. Please alert employees in your accounting and financial departments so that they can identify these unofficial documents and avoid the inadvertent payment of fees.

Trademark owners are required to file (i) an affidavit of continued use (or excusable non-use) between the fifth and sixth year after the date of registration of the trademark ("Section 8 Affidavit"), (ii) a Section 8 Affidavit and an application for renewal between the ninth and ten year after the registration date ("Section 9 Affidavit"), and (iii) a Section 8 Affidavit and a Section 9 Affidavit between each successive ninth and tenth year period after the first ten-year period ends. The PTO provides notification of these requirements on the certificates of trademark registration as originally issued, but it does not send reminders. Therefore, trademark owners must remember and meet these deadlines or risk cancellation of their trademarks.

If you have any questions about the subject matter of this memorandum, or would like further information, please contact Kerry Konrad (212-455-2663; kkonrad@stblaw.com), Lori Lesser (212-455-3393; llesser@stblaw.com) or Jennifer Rackoff (212-455-2733; jrackoff@stblaw.com) of the firm's Intellectual Property Practice Group. Please visit our web site at <http://www.simpsonthacher.com>.