UNITED STATES PATENT AND TRADEMARK OFFICE



Trademark scams: how to avoid them and what to do if you get fooled

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Images used in this presentation are for educational purposes only.



Discussion topics

- Introduction
- Representation before the USPTO
- Trademark filing firm scams
- False solicitation scams
- Phone spoofing scams
- Post-registration solicitation scams
- ID verification scams
- Tips for attorneys, applicants, and registrants



Discussion topic

- Steady increase in scams related to trademark registration
 - Constantly evolving and growing in sophistication
 - Happening across all phases of the trademark registration process



- Trademark register protection tools used by the USPTO include:
 - Administrative sanctions program
 - Director-initiated expungement and reexamination proceedings
 - Post-registration audit and maintenance filing deletion fees



- USPTO continues to increase public awareness of scams to help protect our customers
 - Revamped webpages on scams
 - Refreshed application filing receipts and registration notice emails to raise scam awareness
 - Social media posts to reach more USPTO customers
 - Webinars



Discussion topic

Representation before the USPTO

Representation before the USPTO

- U.S. applicants or registrants may appear in trademark matters on behalf of themselves or a business in which they are an officer.
 - If represented, services must be provided by U.S.-licensed attorney.
- Generally, applicants or registrants domiciled outside the U.S. must hire a U.S. licensed attorney.
- Applying for a trademark is a legal proceeding.
 - Failure to adhere to USPTO statutes, rules, or procedures can impact your application or registration.
 - In some cases, the resulting defect cannot be cured.



Discussion topic

Trademark filing firm scams

Trademark filing firm scams

- Generally advertise ultra low-cost services, but not clearly involving identifiable attorneys
- Logo design services and "conflicting marks" notices
- Fake USPTO correspondence or cease and desist letters
- Individuals impersonating attorneys and misusing bar information
- Attorney "cooperation" solicitations
- See our <u>filing firms</u> page for more information.



Abtach, Ltd.

- January 25, 2022 USPTO issued an order for sanctions against Abtach Ltd. and its subsidiaries
 - Abtach operated dozens of logo design and trademark registration websites
 - Advertised suspiciously-low flat rate pricing, often advertising via search engines:

 Ad · www.trademarkfalcon.com/

 Found to be overcharging filing fees, misleading customers about goods and services in applications, falsifying applicant signatures, and doctoring office actions

\$49 Trademark Registration - Flat 50% Off Today - Recommended by USPTO

Protect the Brand you've worked so hard to Build. 3 Simple Steps. Same Day Filing. Over 10 Years of Experie...

Result: thousands of trademark application proceedings terminated

Discussion topic

False solicitation scams

False solicitation scams

- Unsolicited email, text, or phone call
- Relating to logo, trademark application or registration
- Demands urgent action be taken to protect rights
- Often requires payment
- May use false attorney name or information, or falsely identify USPTO as sender

Cover sheet for alleged search report

The USPTO does not prepare search reports or issue Office actions with the logo on top.

Nonsensical references to laws or regulations.

Note the false urgency.

USPTO

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The USPTO (United States Patent Trademark Office) reviews each trademark application that is filed in the United States of America. The USPTO often issues what are known as "office actions" to applicants or their filing companies that describe the legal status of their Trademark Filings. It is important for the companies or applicants to understand the different types of office action letters and how to respond them or working on them

Office received an application for the business name like there was no design that was attached to an application received to register for trademark. According to the act 1972 section AD-2471cf51 trademark application is not acceptable to register the business name without logo design of the business/company.

In this letter we are particularly writing about

Owner of the Mark:

Also those applications not having the proper attorney assigned to them by the filer/company and such applications won't be catered. As letter was sent previously and notified your concern department in this regards.

Priority action is required by the applicant or the company on behalf so the registration certificate's preparation shall be started.

U.S. Patent and Trademark Office Information Products Division

MDW – 4C18 P.O. Box 1450 Alexandria, VA 22313-1450 (571) 5384002 Clear typographical errors and grammatical errors.

Incorrect contact information.

Look for strange disclaimers.

USPTO specializes in optimizing available information that is utmost authentic to prepare your search report. We have taken all the require d and reasonable steps to ensure the accuracy and completeness of the data provided, however as industry standard due to the subjective nature of this type of research and the possibility of incomplete data supplied to us by the US Patent and Trademark Office, the Secretary of State Offices, the World Wide Web, etc., it is impossible to warrant that this report is complete or error free. Therefore, USPTO, hereby disciant all warranties and representations, express, implied or statutory, with regard to its products and services, including but not limited to any implied warranty of merchantability, fitness for a particular purpose and non-infringement. In no event will USPTO be liable for any direct, indirect, including to incidental, punitive, special or consequential damages, even if advised of the possibility of such damages in

USPTO has taken reasonable steps to ensure that this report includes complete and accurate information. United States Patent and Trademark Office

400 Dulany St, Alexandria, VA 22314, United States

uspto

False solicitation about "conflicting marks"



A real law firm will not contact you to say they have received a competing application.

Registering a mark with the USPTO is never mandatory.

This is Robert from ... We are an IP Agency that works to protect intellectual property such as Trademark, Copyright, and Patent for our customers. Whenever we receive an application for filing, we do comprehensive research given the USPTO Standards, and if we find out that someone already uses a similar business name so we send them a courtesy notice.

We would like to bring to your knowledge that we have received the Trademark application for the same business name. If we proceed with their application and if they get the federal ownership and protection for the be required to cease all use of this name as per the Trademark Law. The application is being filed with the United States Patent & Trademark Office for trademark registration. Upon doing the research on IP Databases regarding the business name. If your information popped up. USPTO and IP protocols suggest giving priority to the business name/mark user over the new applicant. Therefore, we are reaching out to you for confirming whether would you be interested in reserving the federal trademark rights under your ownership for your business name.

If you're not willing to register the trademark, then we'll have to register the federal trademark for the other applicant with the United States Patent & Trademark Office, as Trademarks are provided on a first come first serve basis, not on first use.

As per the Act of 1946 §§ 1051 et seq, it is mandatory to register your mark to hold the ownership rights federally.

We would appreciate your prompt response, as the other applicant is still on hold until we receive your response. In case of no contact from you within the next 2 business days, the other applicant will be given the opportunity to begin their registration following the standard examination and filing procedure with the United States Patent & Trademark Office.

Please do let us know by reply back to us on this email if you are interested so that we can guide you through the complete process.

Please ignore this email if you have already responded.

Thank you,

There is no "IP Protocol" to change priority in this manner.

False urgency is a common theme in scams.



Letterhead impersonating the USPTO



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DAPARTMENT OF COMMERCE United States Patent and Trademark Office

P.O. Box 1450

Alexandria, Virginia 22313-1450

STATE SHOW

This is to notify (with reference to successful examination and completion of the Trademark Application – Serial No. below:

100

The Patent's office has successfully received required office to actions, legal affidavits and attested copies/documentations as to the supporting documentations for the application mentioned above.

is required to submit the fee for the Issuance of the Registration ID, in order for the Registration No. to be issued to the respective application, after which in the 30 – 45 business days' time, the Registration No. would be issued and the Owner/Applicant can Legally use the R sign/symbol along with the Business Name.

Below are the associated registration fees along with federal taxes for you to go ahead and submit your respective fee for the application to your Attorney/Legal Agency.

Registration ID Issuance Fee: \$1800.00 (Per Application)

Federal Taxes: 13%

Total Fee: \$1800.00 x 1 Application = \$2034.00

Once the fee is submitted, kindly have the scanned copy of the receipt submitted to your Attorney/Legal Agency in order to be submitted along with paperwork for final processing.

Final Paperwork would be sent out to the registered mailing address on the application.

Regards,

United States Patent and Trademark Office



Typographical errors!

Misuse of government seal!



Wrong Office.

Nonsense fees!

Email impersonating the USPTO

From: uspto.gov <no-reply@uspto.org>

Date: Wed, Mar Subject: U.S. Trademark Application Serial No. To: The USPTO does not correspond Hello with filing firms or We have been notified by your Trademark Agency regarding the refund request for the Trademark agencies. Application Serial No. This is in regard to the payment you disputed \$1,750 U.S. domiciled after using the services. applicants may file on If the Refund request will not be reverted in next 24 hours from the Trademark Agency, your their own Trademark Application will be marked as dead and you will not be not reapply for the same mark behalf, or for next 5 years. We are still giving you the opportunity to settle the payment. may be represented Regard, by a qualified Teas TM Application Department attorney. The United States Patent and Trademark Office

Email comes from
"uspto.org" and not
"uspto.gov." Legitimate
agency domain names
always end in ".gov."

Typographical error and reference to nonexistent rule on refiling.

[uspto]

Phony registration certificates

Certificate uses an incorrect seal and lacks any reference to the owner or the goods/services.

Look for signs of digital tampering.
Here the mark appears to have been digitally added to the document.



Incorrect title. "Q. Todd Dickinson" allegedly signed as "Acting Commissioner for Patents and Trademarks."

Certificates are signed by the Director of the USPTO or individuals "Performing the function of" rather than "Acting."

A real Trademark Registration Certificate:

Digitally signed by United States Patent and Trademark Office Location: United States Patent and Trademark Office

United States of America

Your Trademark

Reg. No.
Registered
Int. Cl.: 35, 41
Service Mark
Principal Register



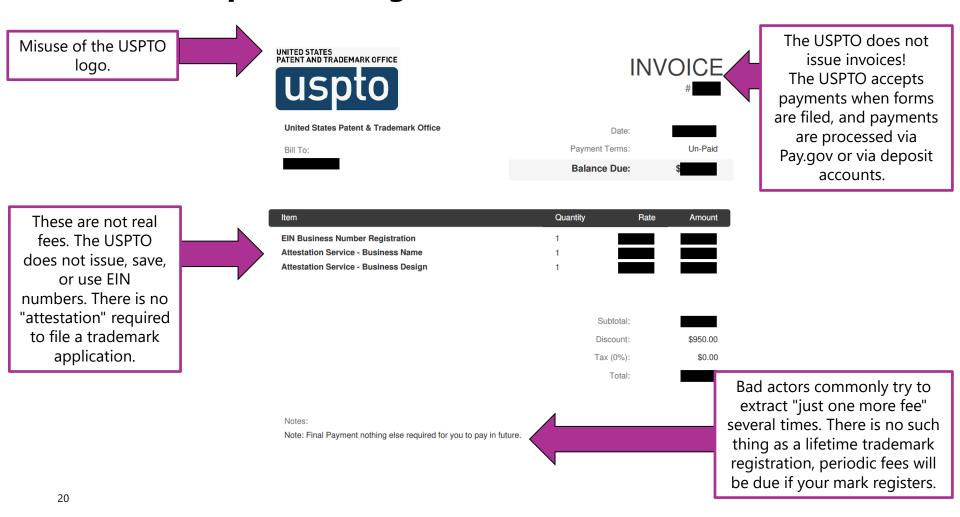


Kathevine Kelly Vidal

Director of the United States
Patent and Trademark Office



Invoices impersonating the USPTO



Individuals impersonating attorneys

Hello

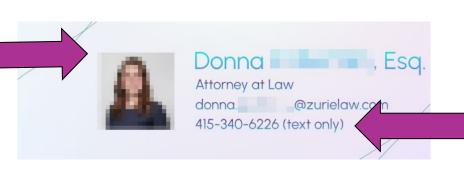
I am Attorney Donna, and I will try to be as short as possible.

You just filed your trademark application and it can take up to two years for the process to be complete and your trademark certificate issued, especially during this Covid period. Fortunately, there is a mechanism we can use to accelerate the process and get your mark registered in just a few months. I'd be glad to help with that and get it done correctly. Please get in touch and rest assured I do not use any automated bot or AI and personally respond to your emails. I looked at your case already before sending you this email so I can respond promptly.

Bad actors claim to be able to expedite registration through an undefined process.

Sincerely,

Beware that bad actors can claim to be attorneys! In this case, the photograph was edited to combine two different people, and the bad actor set up a fake law firm website.



Be cautious of "text only" or "email only" instructions from an attorney.

I have hearing impairment and a phone call is not the best method of communication for me. However, in a bid to compensate for my disability, I offer the best rates amongst attorneys and a very quick turn around time.

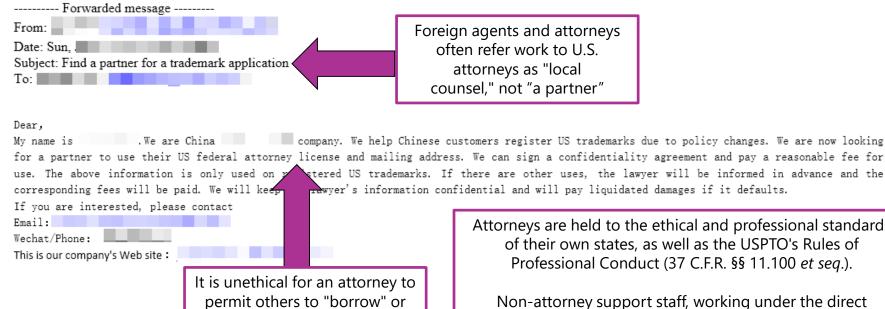
And I am happy to answer any number of questions you may have. Have a look at my reviews here:

I never scammed anyone. I will look for the filing confirmation and send it over to you shortly.

Thank you for your understanding.

Be skeptical of "review" websites. In this case, the bad actor appears to be the only "attorney" reviewed, and we suspect the bad actor controls this website.

Attorney foreign "cooperation" solicitation

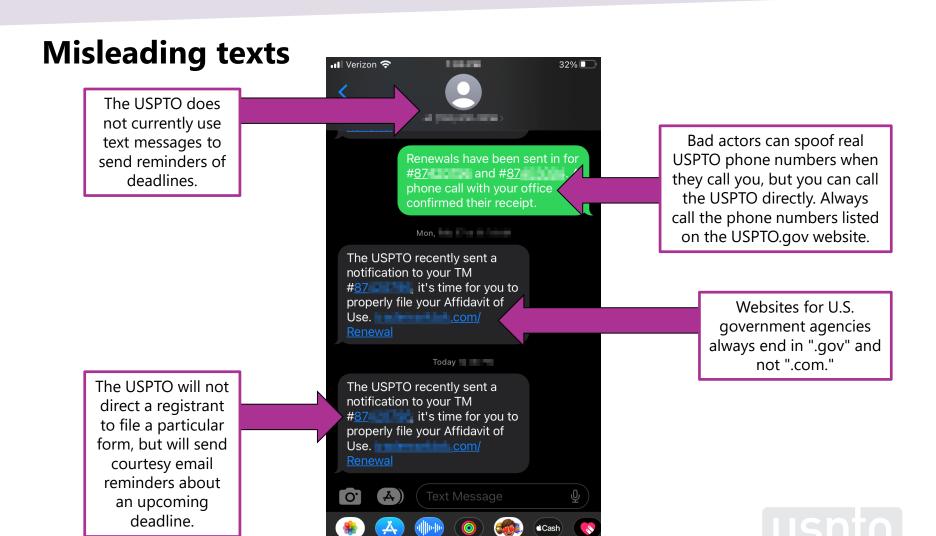


"rent" a license to practice law

in the manner suggested here.

Attorneys are held to the ethical and professional standards of their own states, as well as the USPTO's Rules of Professional Conduct (37 C.F.R. §§ 11.100 et seq.).

Non-attorney support staff, working under the direct supervision of an attorney, may assist the attorney in practicing before the USPTO in trademark matters, but an attorney may not sponsor USPTO.gov accounts for foreign counsel or allow unlicensed individuals to practice law. Doing so violates USPTO.gov account agreements and may also violate relevant professionalism rules.



Discussion topic

- What is caller ID spoofing?
 - Spoofing is when a caller deliberately falsifies the information transmitted to your caller ID display to disguise their identity.
 - Scammers often spoof a number from a company or a government agency that you may already know and trust.
 - If you answer, they use scam scripts to try to steal your money or valuable personal information, which can be used in fraudulent activity.

- Targets current trademark applicants and potential applicants who have never filed with USPTO before (typically individuals or a small business).
- Scammers often impersonate real USPTO employees and phone numbers (for example, examining attorneys).
- Scammers try to create false urgency.
 - For example, claiming that another party is seeking to file for the same mark
 - Often accompanied by threat to delay application if not paid immediately



- 571-272-1000 or 800-786-9199 are spoofed most frequently.
 - Falsely appear to be coming from Alexandria, VA (location of USPTO headquarters)
- Scams are often accompanied by fake letters/office actions on "USPTO letterhead."
- Scammers may request excessive fees for unnecessary or nonsensical services.
 - Fees not charged by USPTO or for multiple classes when not necessary
 - E.g., no USPTO trademark application requires "attestation" from the 50 states

- Please report spoofed calls to the Federal Communications Commission (FCC).
- The FCC is also working on steps to end this type of practice via mandatory Caller ID authentication.



Avoiding caller ID spoofing scams

• USPTO employees do not request payment over the phone, via email or text.

- You can verify the identity of any USPTO staff member and request to call them back.
 - USPTO employee phone numbers are listed in the employee directory on the USPTO website.
 - Please see the scam prevention resources flyer for more information and resources related to this scam.

Discussion topic

Post-registration solicitation scams

Post-registration solicitation scams

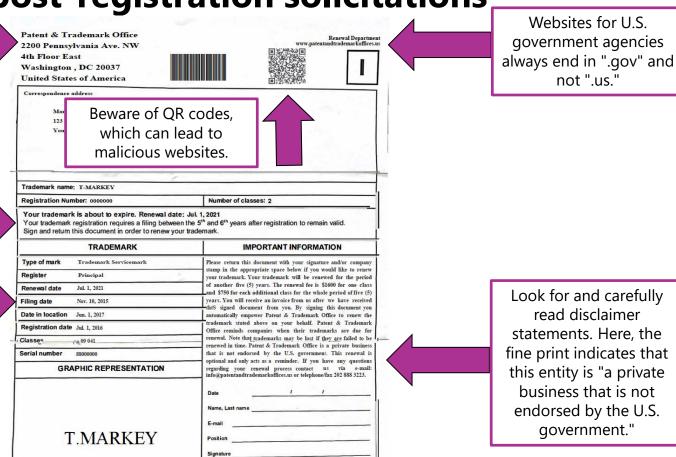
- Registrant receives correspondence directing them to act urgently to maintain registration.
 - Correspondence is often received well before any actual USPTO deadline.
- USPTO fees are required to maintain registrations.
 - But fees requested may be higher than USPTO fees
 - Often "disguised" to appear as if related to USPTO
 - Sometimes unclear if services are being provided by U.S.-licensed counsel

Misleading post-registration solicitations

Confusingly similar names to the actual USPTO. The USPTO is located in Alexandria, VA.

False urgency. Bad actors frequently misrepresent deadlines.

Always check the maintenance dates on TSDR.USPTO.GOV by entering the serial or registration number, selecting "Status" and clicking "Maintenance."



SIGN AND RETURN IN THE ENCLOSED ENVELOPE.

Avoiding post-registration solicitation scams

- Check the status of your registration and the due dates of any filings or fees via the Trademark Status & Document Retrieval (TSDR) system.
- Contact the Trademark Assistance Center (TAC) with any questions about post-registration maintenance requirements.



Discussion topic

ID verification scams

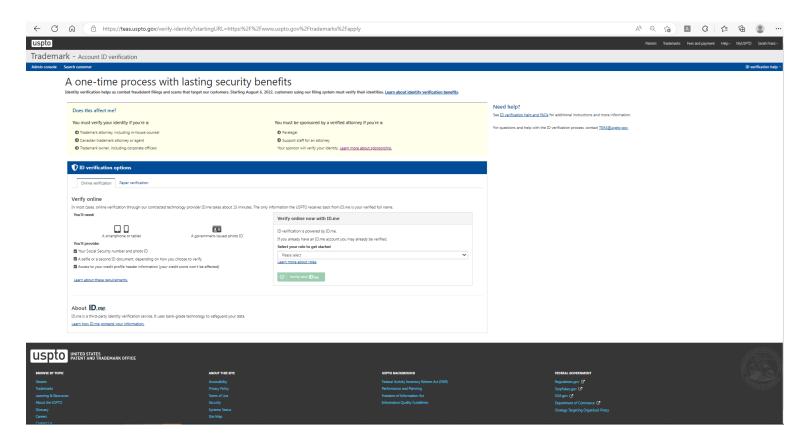
ID verification

Mandatory for filing through TEAS and TEASi since August 2022

 Two methods: electronic (ID.me) and paper (USPTO)



ID verification



ID verification scams

ID verification scams

- Applicant or registrant asked to verify their identity using an email address under control of a scammer.
- Scammer uses applicant or registrant's identity to conduct business with the USPTO.

Identifying documents scam

- Scammers request copies of identification documents (driver's license, passport, etc.) for use in ID verification.
- Sometimes pretend to be affiliated with USPTO.



Avoiding ID verification scams

- Use your own email address.
 - If you have verified an account using an email address not under your control, contact the USPTO and ID.me.
- USPTO employees will not ask for copies of identification documents.
- USPTO employees will not set up a USPTO.gov account on your behalf.



Discussion topic

Tips for attorneys, applicants, and registrants

Tips for attorneys

- Beware of "cooperation" solicitations.
- Unauthorized use of your name, bar number, and/or law firm name
 - USPTO filings, correspondence
 - Contact USPTO immediately.
 - Ethics questions? Contact the Office of Enrollment and Discipline.
- Educate your clients about scams.
 - Correspondence about application or registration should be directed to you, not your client.
 - For example, cease and desist letters and renewal notices
 - Note: The USPTO sends courtesy reminders about registration maintenance deadlines to all email addresses of record, including the registrant's.
 - Registrants can check TSDR to verify that any filing reminders came from the USPTO.

Tips for applicants and registrants

- USPTO employees will not ask you to provide payment information.
 - Fees paid via the TEAS system
- Verify fees and deadlines.
- Be wary if you receive a communication requiring you to immediately take an action.
 - Particularly if payment involved
- Questions about a document or communication?
 - Contact TAC (or if you are represented, your attorney).

If you've been scammed

Remember the big 5:

- Report financial scams to your bank.
- Submit a fraud complaint to the Federal Trade Commission (FTC).
- Contact your local Federal Bureau of Investigation (FBI) field office.
- Contact your local attorney general.
- Report phone scams to the Federal Communications Commission (FCC).

What the USPTO is doing about scams

- When you provide trademark-related tips about potential scams to the USPTO at <u>TMScams@uspto.gov</u>, experienced attorneys review them.
- Where appropriate we:
 - Warn the public about the scams with the goal of preventing others from being scammed.
 - Issue appropriate sanctions directed at trademark submissions that violate USPTO rules (e.g. fraudulent signatures).

Keep in mind:

- The USPTO is not a law enforcement agency.
 - We protect the use of the USPTO name and logo, where possible (e.g. Reg. No. 6832052).
- The USPTO cannot provide financial relief or restitution when money is paid to a scammer.





Thank you!

TMPolicy@uspto.gov

TMScams@uspto.gov

www.uspto.gov