



June 12, 2012

Cantor Colburn LLP Client Alert

Beware of Trademark Notices from Third Parties that Resemble Official Communications from the United States Patent and Trademark Office

We have become aware that private companies are soliciting federal trademark applicants and registrants, including our clients, via mail or e-mail. Please be aware that these companies are not associated in any manner with the United States Patent and Trademark Office (“USPTO”), and are essentially operating scams. The correspondence is designed to appear as if it is an official communication coming directly from the USPTO, when in fact it is not. These companies will use names that resemble “USPTO”, typically names that include the terms “United States” or “U.S.”

Unfortunately these companies are able to obtain their contact information for applicants and registrants from the USPTO’s public databases. These companies purport to offer a variety of services, including: trademark monitoring services, recording trademarks with U.S. Customs and Border Protection, or “registering” the trademark in the company’s own private registry. Frequently these “offers” are designed to appear as if they are requirements for the USPTO, rather than optional, and carry fees that go to the companies and not to the USPTO.

For your reference two examples of the types of communications our clients have received from these companies are at the end of this document.

If Cantor Colburn is responsible for any of your trademark applications or registrations, all official USPTO communications should come directly to us, and we will in turn report to you the requirements for all necessary filings and any associated fees. If you ever have any questions about any communication you receive concerning your trademarks, please do not hesitate to let us know.

In addition, the USPTO has requested recipients of these misleading communications to report the communications to the following USPTO email address: TMFeedback@uspto.gov. The following information should be included in the report:

1. A copy of the misleading communication, and a copy of the envelope in which it came, if mailed.
2. A statement whether the recipient thought the communication was an official U.S. government communication, or had to ask an attorney or the USPTO whether it was legitimate.



3. Whether fees were mistakenly paid in response to the communication and, if so, provide a copy of the cancelled check. The report should also specify what services, if any, were provided in exchange for the payment made.

We would be happy to make such reports to the USPTO on your behalf.

For Further Information and Assistance

The attorneys in the Trademark & Copyright Department at Cantor Colburn LLP stand ready to answer any questions you may have about this Client Alert and provide you with specific advice and guidance. Please do not hesitate to contact any of the individuals listed below:

[Curt Krechevsky](#), Partner and Chair, Trademark & Copyright Department
860.286.2929, ext. 1207 & ckrechevsky@cantorcolburn.com

[P. Jay Hines](#), Partner
703.236.4500, ext. 4109 & jhines@cantorcolburn.com

[George Pelletier](#), Counsel
860.286.2929, ext. 1132 & gpelletier@cantorcolburn.com

[Michelle Ciotola](#), Associate
860.286.2929, ext. 1229 & mciotola@cantorcolburn.com

[Jamie Platkin](#), Associate
860.286.2929, ext. 1136 & jplatkin@cantorcolburn.com

Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.

USTMS

UNITED STATES TRADEMARK MAINTENANCE SERVICE
SECTION 8 AFFIDAVIT

78829996

P.O. Box 1227 Chandler, Arizona 85244 • 1-866-398-8187

TRADEMARK: [REDACTED] REGISTRATION #: [REDACTED] REGISTRATION DATE: [REDACTED] CLASS(ES): 035, 041 START OF 6TH YEAR: 20120703

SECTION 8 FILING / PENDING TRADEMARK CANCELLATION

ATTN: TRADEMARK OWNER
[REDACTED]
[REDACTED]
[REDACTED]

ATTENTION:
Trademark Owner

REGARDING:
Section 8
Filing

SECTION 8 OF THE UNITED STATES TRADEMARKS ACT:

An affidavit or declaration of use is required during the sixth year after the date of registration.

Trademarks registered at the United States Patent and Trademark Office (USPTO) are subject to ongoing maintenance and renewal filings in order to remain registered. The reason for the requirements is that in return for the benefits of exclusivity granted by trademark registration, a registrant must use the mark in commerce or provide a legitimate reason for not doing so. The USPTO does not provide any reminder of the section 8 requirement beyond the information of the original Certificate of Registration and will CANCEL a trademark registration for non-compliance. Further, whether or not an owner receives any notice of cancellation, the marks that are not maintained or renewed will be shown as "DEAD" in any trademark search.

Trademark owners must be aware of the requirement to file a Section 8 Affidavit, Declaration of Use or Excusable Non-Use within the 6th year after the date of registration or within a grace period of 6 months after the end of that 6th year. The USTMS helps reduce the risk of loss of a trademark resulting from not making a timely maintenance or renewal filing with the USPTO. The USTMS monitors the approach of the operative dates, using our software, and notifies the listed registrant in sufficient time to act. If the grace period is missed, the trademark will be cancelled with no recourse to the owner other than the making of a new trademark application. USTMS is a private corporation that assists trademark owners in adhering to trademark compliance deadlines. For more information or online enrolment please visit our website at www.ustmservice.com.

Your trademark will be cancelled by the USPTO if the Section 8 Affidavit or Declaration of Use is not filed within their deadlines.

UNITED STATES PATENT AND TRADEMARK OFFICE SECTION 8 FILING FEES

FILING FEE PER TRADEMARK - \$100 PER INTERNATIONAL CLASS
OUR FEE TO FILE - \$369 PER TRADEMARK

I am interested in receiving information regarding filing a Section 15 Declaration of Incontestability.

If your attorney is not handling this filing for you, and your trademark is exactly as originally filed, please complete the information below and return to our office in the envelope provided. One of our filing agents will contact you. If your trademark requires an amendment please contact your attorney.

| MAILING INFORMATION | | | | PLEASE INDICATE METHOD OF PAYMENT BY MARKING ONE OF THE BOXES BELOW: | |
|---------------------|--|----------|----------------------------|--|--|
| 1 CONTACT NAME | | | 10 MASTERCARD NUMBER | | |
| 2 TITLE | | | 11 VISA NUMBER | | |
| 3 ADDRESS | | | 12 AMERICAN EXPRESS NUMBER | | |
| 4 CITY | | 5 STATE | 13 EXPIRY DATE | 14 SIGNATURE | |
| 6 ZIP | | 7 E-MAIL | CHECK PAYABLE TO: USTMS | | |
| 8 PHONE | | 9 FAX | | | |
| | | | CALCULATED FEE: | 569.00 | |

(RETAIN COPY MARKED "TRADEMARK OWNER" FOR YOUR FILING)
431

STATE TAXES INCLUDED WHERE REQUIRED



PAYMENT MUST ACCOMPANY COMPLETED FORM
THIS IS NOT AN INVOICE

VERSION #2 - F-102334

UNITED STATES TRADEMARK REGISTRATION OFFICE

Trademark Registration and Monitoring Division

633 West Fifth Street

28TH Floor

Los Angeles CA 90071-2005



TRADEMARK



IMPORTANT NOTIFICATION REGARDING YOUR FEDERAL TRADEMARK



Serial Number: [REDACTED]

Filing Date: 20111027

Primary Code: 012

Intl Code: 012



PROCESSING FEE —> \$375.00

DESCRIPTION

Owner



Trademark



Serial Number



Registration Number

0000000

Filing Date: 20111027

PRIMARY CODE: 012

INTERN. CODE: 012

Reference: [REDACTED]

Fee: \$375

Reply By: NOW DUE

U.S. Customs & Border Protection (CBP), a bureau of the Department of Homeland Security, maintains a trademark recordation system for marks registered at the United States Patent and Trademark Office. Parties who register their marks on the Principal Register may record these marks with CBP, to assist CPB in its efforts to prevent the importation of goods that infringe registered marks. The recordation database includes information regarding all recorded marks, including images of these marks. CBP officers monitor imports to prevent the importation of goods bearing infringing marks and can access the recordation database at each of the 317 ports of entry.

Upon receipt of this form and your payment United States Trademark Registration Office will: A) Record your U.S. Trademark Registration with the U.S. Customs & Border Protection (CBP) and send you notice(s) when the blocking of such goods occurs. B) Monitor your trademark using USTRO's proprietary search engine and notify you regarding possible third party trademark infringement(s) (enforcing your intellectual property rights and protecting a trademark from confusingly similar names is essential and the sole responsibility of the owner and not the USPTO (United States Patent and Trademark Office). C) Send you reminder notices of the following filing requirements. 1) First Filing Deadline: 15 U.S.C. §§1058, 1141k: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. 2) SECOND FILING DEADLINE: 15 U.S.C. §1059: YOU MUST FILE A DECLARATION OF USE (OR EXCUSABLE NONUSE) AND AN APPLICATION FOR RENEWAL BETWEEN THE 9TH AND 10TH YEARS AFTER THE REGISTRATION DATE. WARNING: YOUR REGISTRATION WILL BE CANCELED IF YOU DO NOT FILE THE DOCUMENTS ABOVE DURING THE SPECIFIED TIME PERIODS.

39 USC 3001(d)(2)(A): "THIS IS NOT A BILL. THIS IS A SOLICITATION. YOU ARE UNDER NO OBLIGATION TO PAY THE AMOUNT STATED ABOVE UNLESS YOU ACCEPT THIS OFFER." THIS PRODUCT OR SERVICE HAS NOT BEEN APPROVED OR ENDORSED BY ANY GOVERNMENTAL AGENCY, AND THIS OFFER IS NOT BEING MADE BY AN AGENCY OF THE GOVERNMENT.

United States Trademark Registration Office is trademark enforcement, registration and monitoring service to help you protect your intellectual property rights and your Trademark from possible third party trademark infringement(s). *We will monitor and notify you of confusingly similar marks, but the responsibility is ultimately in the trademark owner's hands. Reversal of a trademark registration may require legal action from the trademark owner. Information submitted by the terms and conditions set forth on the reverse side of this form.



2011-2REQ-5FGJ-USTRO

DETACH AND MAIL THIS STUB WITH YOUR PAYMENT

DO NOT STAPLE, TAPE OR CLIP PAYMENT STUB OR CHECK



2REQ-5FGJ-USTRO

SERIAL NUMBER



012

INDICATE AMOUNT PAID

PROCESSING FEE —> \$375.00

\$

Contact Name* _____

Phone*(____) _____

Email Address* _____

MAKE CHECKS PAYABLE TO: Please write the SERIAL NO on the lower left corner of your check or money order.

US TRADEMARK REGISTRATION OFFICE
Registration and Monitoring Division
633 West Fifth Street
28TH Floor
Los Angeles CA 90071-2005