



# Client Memorandum

August 11, 2014

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## Reminder to IP Owners: Beware of Suspicious Solicitations

### Domestic Communications

The United States Patent and Trademark Office (USPTO) recently issued a warning to patent and trademark owners to be aware of misleading solicitations from private companies not associated with the USPTO. These solicitations, intended to look like official U.S. government notices, often make offers for legal services, payment of patent maintenance fees, trademark monitoring services, trademark registration renewal, and more.

These private companies use publicly available information to create solicitations that mimic the look of official U.S. government documents. It is important to read all intellectual property (IP)-related communications carefully. If you are a COJK client, most official correspondence from the USPTO regarding your matters will be sent to COJK, rather than directly to you. If you do receive something from the USPTO, it will be addressed from the United States Patent and Trademark Office in Alexandria, VA; and if by email, specifically from the domain @uspto.gov. Maintenance fees and other IP-related requirements can be found on the USPTO web site at [www.uspto.gov](http://www.uspto.gov).

### Foreign Communications

Another area of IP seeing a rise in suspicious communications is that of domain names, in which U.S. trademark registrants receive emails purportedly from foreign domain name registration agencies advising that a third party is seeking to register domain names using the registrant's mark(s). These foreign domain names commonly have extensions such as "Asia," "cn" (China), "hk" (Hong Kong), "tw" (Taiwan), etc. The message advises that from a search that was performed, the domain names identified are identical to the recipient's U.S. trademarks. Typically, the message states that unless any counter measures are taken within 7 – 10 days, the domain name registration applications will proceed.

These solicitations are attempts to obtain fees from U.S. trademark owners to register domain names in foreign countries, a service the trademark owner may not require. These communications are further misleading because there is no mechanism by which a trademark owner can be forewarned about impending domain name registrations of their mark(s). Domain names are registered strictly on a first-to-file basis; a domain name registrar cannot delay a registration application to conduct a search to see if the domain name is the trademark of another party.

If you are a U.S. trademark owner conducting significant business in Asia or other foreign countries, you may want to consider registering your domain name abroad. Please contact your COJK attorney to discuss your options. With any IP-related communication, if you have any questions at all, please contact your COJK attorney to discuss.

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This memorandum is not intended to provide legal advice, and no legal or business decision should be based on its content. Questions concerning issues addressed in this memorandum should be directed to your COJK attorney.