



North Carolina Law Life

But Wait.... There's More: Recent Offers to Trademark Applicants and Registrants

By: Donna Ray Berkelhammer. *Wednesday, February 29th, 2012*

A client with a pending federal trademark application called the other day and asked if he should go ahead and pay the "Trademark Office" invoice directly. Trouble is, the **U.S. Patent and Trademark Office** does not send invoices. It is up to the applicant or his attorney to keep up with necessary filings and pay the associated fees at the time of filing.

There are a growing number of businesses that mine data from governmental filings, and then try to sell questionable and expensive services. Many of these company names sound like legitimate governmental offices, and people think they have to pay these fees. Often the services are either unnecessary, not applicable to the particular trademark, or something the business owner or her attorney can do much more efficiently.

In fact, the Trademark Office has posted its own **warning**.

Here are some recent solicitations our clients have received. If you look closely at the fine print, all of them say that "this is an offer, not an invoice."

1. (**CBP Registration Offer**) This is a service that will register your registered trademark with the US Customs and Border Protection, a federal agency responsible for protecting intellectual property rights at the border. Trouble is, this client has a service that cannot be illegally imported, and does not yet have a trademark registration to register. For more information on how **CBP** can protect your products from infringement and counterfeit imports, click **here**. The filing fee is \$190 per **copyrighted** document or \$190 per class for each registered trademark.
2. (**GBO Trademark and Servicemark Registration**) This is a service that compiles a list of registered trademark, with the implication being that the trademark owner gets some kind of more powerful notice provisions by registering in this publication. This company also will help you monetize your unused or outdated trademark by transferring ownership to a third party. One of the most important reasons to obtain a federal trademark registration, is that your company is given the exclusive right to use that trademark exclusively for the goods or

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services listed in the registration. Potential competitors should know to look in one central database to determine what trademarks have been previously registered. The Trademark Office is supposed to deny registration to confusingly similar marks, but the trademark owner also has rights to oppose applications or sue third parties for infringement.

3. (**International Catalog**) This is an offer for listing your registered trademark in an international catalog of trademarks. At \$1650 (USD) it may well be cheaper to register in other countries or extend protections under **international treaties**.

If you are working with **trademark counsel**, always run these by your attorney. If not, read the small print to make sure you understand what's required and what's an advertisement.

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