

THE
NATIONAL LAW REVIEW

New Years Solicitations - Creative Marketing or Deceptive Advertising?

Friday, January 27, 2012

With the start of the new year, it's time for trademark owners again to be on guard against solicitations and advertisements that may appear to be "official" or look like invoices. It is prudent to warn your bookkeeping departments to be alert to these types of solicitations and not mistake them for invoices. **Please post a comment below if you have received solicitations** that you found to be confusing.

I was recently contact by the recipient of two documents with respect to a trademark and asked whether or not these "invoices" should be paid. On closer inspection, neither document was an invoice and both were solicitations for services which, because of the format, the recipient mistook for invoices.

The first (seen below) solicits for payment of a "registration fee" for the service of publishing the registered trademark in the solicitors index.

This format was confusing to the recipient since it looked like an invoice rather than a more traditional form of direct mail advertising, such as a brochure, for example. After you get past the format and the solicitation for a "registration fee," the text of the document, however, expressly provides that the service offered is that of publication of the trademark in the solicitor's catalogue. The only indication of the value of this service is that it provides "a notice to others that your described trademark/servicemark is already taken." The risk here is that recipients who are not well versed in trademark registration or protection may be misled to think that such a notice is somehow required and simply pay the invoice.

While the solicitation did not contain a phone number for the company, it did contain a URL for the company's website which expressly identifies itself as "a U.S. based privately owned trademark and patent firm." I suspect that changing the format and including this language on the mailing would help avoid confusion.

Another solicitation (seen below) received by the same recipient, was on its surface, quite a bit more confusing.

In this case, the name of the organization, "United States Trademark Registration Office, Trademark Registration and Monitoring Division," lead the recipient to believe that this came from an official governmental agency. For the record, New Jersey law makes it unlawful to operate under a name that implies association with a state of federal governmental agency. See [NJSA 56:8-2.1](#).

Does the use of the name "United States Trademark Registration Office" run afoul of this statute? Interestingly, the only case to address a similar issue found that the use of the name "United States Consumer Council" with an American eagle emblem violated the statute while the use of the same name without the emblem did not. [In re Fleet](#), 95 B.R. 319 (E.D.Pa 1989).

The other confusing aspect of this solicitation is that it appears to be an invoice. This is especially evident from the listing of the \$375 fee as being "DUE NOW." However, at least this company offers a more potentially



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GBO INC., Trademark and Patent Dep.
1031 Ives Dairy Road, Suite 228
Miami, FL 33179

TRADEMARK AND SERVICEMARK REGISTRATIONS
GTM CATALOG YEAR: 2012
COMPANY ID: [REDACTED]

TRADEMARK / SERVICEMARK OWNER:	CLASS OF GOODS/SERVICES: 035
[REDACTED]	REGISTERED: [REDACTED]
T851 P1 248826	<i>Firm</i>
[Barcode]	ACCT: 100-5085-00
TRADEMARK / SERVICEMARK:	VENDOR NO-
[REDACTED]	DATE REC'D 12-9-11
	INPUT DATE
	A PPROVEDBY

The above mentioned data represents a sample of your trademark registration. By paying the indicated amount you accept this offer that will approve the listing of this information in the "The Global Trademark and Servicemark Selection of the USA" catalogue and our online Global Trademark database at www.gbo-trademark.com.

The law considers a trademark to be a form of property. Your above registration provides a notice to others that your described trademark/servicemark is already taken. Our publication contains a depiction of your registered mark, the identification of goods and/or services, year of the registration and owner information as well.

This publication is available in America, Europe, Asia and Australia and printed publications scheduled for September 2012.

We can also help you transfer your active trademark with the best conditions to the third party. Transfer option would be a great opportunity to sell unused or out dated trademarks for financial gain. If you intend to sell your current trademark, please mark the price category in USD below, pay the fees and return this form.

10-50,000 50-100,000 100-250,000 Other \$.....

In case of any changes, further questions or incorrect details, we kindly ask you contact us at:

e-mail: info@gbo-trademark.com Fax: (850) 807-7292

Your trademark details are found using free databases. For more details or Terms & Conditions, please visit www.gbo-trademark.com. All future correspondence with the GBO Inc. Patent and Trademark Department must include the unique company ID, which can be found in the top right corner of this letter.

CHARGES AND FEES:	
REGISTRATION FEE	\$960.00
EXTRA COST	\$0.00
TOTAL FEES:	\$960.00
The TOTAL FEE is payable in advance. Payable by the methods below.*	

***Payment methods:**

- 1. Pay by check**
Send the check to the mailing address:
1031 Ives Dairy Road, Suite 228, Miami, FL 33179. Payable to "Global Business Option, Inc." Be sure to state your COMPANY ID. (Please find it above.)
- 2. Wire transfer**
Bank of America,
1900 Tyler Street, Hollywood, FL 33020
Account: 8980 4890 9582
ABA: 026009593,
SWIFT: BOFAUS3N

Global Business Option, Inc. – Patent and Trademark Department
Mailing Address: 1031 Ives Dairy Road, Suite 228., Miami, FL 33179, www.gbo-trademark.com

valuable service. Specifically, for the \$375 fee, the company will register your trademark with US Customs and Boarder Protection (CBP), notify you when your goods are blocked and send reminders to you when its time to file maintenance and renewal filings with the USPTO. However, the CBP only charges \$190 for the registration and is then obligated by regulation to provide the trademark owner with notice when goods are block. Moreover, in this case, the recipient's mark was a service mark so registration with the CBP was unlikely to have any meaningful value.

The moral of this story is to read all such material carefully before paying anything that appears as an invoice. In each of these cases, a careful reading of the material reveals that these are not from governmental agencies and not mandatory purchases.

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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: [REDACTED]
 Primary Code: 035
 Intl Code: 035



PROCESSING FEE → \$375.00

DESCRIPTION

Owner

Trademark

Serial Number

Registration Number

Filing Date: [REDACTED]

PRIMARY CODE: 035

INTERN. CODE: 035

Reference: [REDACTED]

Fee: \$375

Reply By: NOW DUE



2011-2REQ-5FGJ-USTRO

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 CBP 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. §1056**; YOU MUST FILE A DECLARATION OF USE (OR EXCUSABLE NONUSE) AND AN APPLICATION FOR RENEWAL BETWEEN THE 5TH 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.**

32 USC 2001(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 subscription, registration and monitoring service to help you protect your intellectual property rights and your trademark from possible third party trademark infringement. We will monitor and notify you of confusingly similar marks, but the responsibility is ultimately in the trademark owner's hands. Renewal 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.

DETACH AND MAIL THIS STUB WITH YOUR PAYMENT
 DO NOT STAPLE, TAPE OR CLIP PAYMENT STUB OR CHECK

035



2REQ-5FGJ-USTRO

SERIAL NUMBER



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

Please see the back of this form for important information. Please remember to Enclose Your Payment.