



Dear Betty Sue,

How ya'll doing down there in Texas. Greetings from Ty Ty, Georgia. We grow some of the best pecans in the U.S. (did ya know that Georgia is the #1 pecan growing state? Sure are!) We have a brand of spiced pecans called Southern Hotty and it has been a big success. We are receiving more orders worldwide and our brand is becoming well known. Right now we have a TM but no formal ®.

Recently we received an email from a Chinese firm warning us that a trademark is going to be filed by another company in China. We have no immediate need for a ® in China. We don't yet ship to China but we might one day soon.

How should I respond or should I respond at all. From what I've heard tell this a common scam? I read the story about Michael Jordan and it looks pretty shaky with intellectual property in China. Need some advice if you got an expert that can help us.

Signed

™ Pecan with an ® Attitude

Dear ™ Pecan with an ® Attitude,

Ya know we Texans love pecans, especially Earnie Earl. Bet he can't wait to try some of your Southern Hotties. I understand the Chinese are buying up pecans like lotto tickets at a 2 for 1.

You are right to be cautious of this well-known intellectual property scam. (See our paper on 5 top scams) but we need to look at all sides of the barn cause there could be some answers we're missing.

Let's ask our expert, Mr. James Saikin. James, a senior technologist and global operations specialist has taken the lead in start up, development and acquisition of numerous technology companies. He assists companies with intellectual property strategy, having written and assisted with over 100 patents. James specialties include power systems, energy control systems, nano-technology, composites, applied material, semiconductors, optics and defense systems. Mr. Saikin obtained a BA in Physics from Texas A & M. His Juris Doctorate in Law from Oklahoma City University allows him to plan IP strategy while staying out of the courtroom.

Signed,

Betty Sue.. loving a gal with a attitude

*Disclaimer: The names of exporters and their stories have been changed to protect their identity. The names and expertise of our advisors are very real and often understated. The story is funny, the advice is authentic.

Source: James Saikin, Leader Insight

Dear Betty Sue and TMPecan with an ® Attitude,

My clients used to receive these letters about once per month after a formal filing with the United States Patent and Trademark Office. The USPTO www.uspto.gov publishes information about trademarks (and their owners) through the Official Gazette for Trademarks (OG), which comes out each Tuesday and contains bibliographic information, a representative drawing for published trademarks, along with a list of cancelled and renewed registrations. Furthermore, information about each applied for trademark may be found in the office's public trademark database, which is updated daily and accessible directly from the home page of the trademark office web site.

The very public nature of the filing plus all the information that must be filed along with a USPTO filing provides all the information necessary for, in some cases unscrupulous operators, to scam anyone. Not surprisingly, the public nature of trademarks creates a perfect opportunity for scams. Scams arise via both snail mail and e-mail, as typically enough information will be provided during the filing for either.

Most of these dubious offers are received as a result of applying for or registering a federal trademark and are in the grey area of not technically fraudulent. A common example is the offer to be placed in some sort of alternate registry, which is often marketed in such a way to mimic "official" registration of some sort by cloaking the offer with official sounding names and associating it with symbols.

In my opinion, regardless of their nature or origin, offers by the "trademark industry" are of dubious value. With all such offers whether by letter or email your counsel is the first place to seek advice. Counsel will at least be able to determine whether there is a threat to your brand or recommend a means in which to further protect your mark (whether trade or service).

The most common form of scam I have seen is an email from China but it may be from someplace in Asia. The narrative changes over time, but mostly revolves around a notice that someone in Asia is attempting to register your trademark in various foreign countries. If you engage the scammer directly, you will be asked to provide credit card information to purchase services to stop this behavior or encourage the scammers to buy some domains, only to sell them back to you at inflated prices. There is no upside in engaging the scammers. The very best advice here is:

Do not engage directly. Immediately contact counsel and let them handle it.

While we may all assume it is a scam, it is always preferable to establish a legal basis at this juncture to assist in the defense of a potential future infringement claim if it is not a scam or least let others know you are vigilante in protecting your brand.

In my opinion, the only sensible course of action is to seek a trusted advisor who is knowledgeable in these matters to assist who can guide you in this very complex and ever changing area of law. Your mark whether it is trade or service is your brand and should be where you spend legitimate expenses including international trademark registrations, and trademark renewals, as well as monitoring for infringement and competing trademarks.

Respectfully yours,

James Saikin