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Thank you for reading the August 2022 issue of Sterne Kessler's MarkIt to Market® newsletter. This month, we discuss a Show Cause Order recently issued by the USPTO to combat thousands of fraudulent trademark applications. We also provide an update on a new gTLD Sunrise Period.

Our [Trademark & Brand Protection practice](#) here at Sterne Kessler is devoted to guiding companies of all sizes in developing and maintaining strong brands around the world. There is always something new and exciting happening in our unique IP niche, and we bring you updates each month to help you keep on top of it all. Thanks for your readership. If there is something you would like us to cover, please don't hesitate to reach out to us and let us know!

Kind Regards,

[Monica Riva Talley](#)
Editor

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U.S. brand owners were heartened to learn of the [Show Cause Order](#) issued late last week by the USPTO's Office of the Commissioner for Trademarks, which takes aim at potentially thousands of trademark applications thought to be fraudulently filed and registered.

As the Order indicates, the USPTO has uncovered evidence that a group of entities (identified as "Shenzhen Haiyi Enterprise Management Co., Ltd., Haiyi Enterprise Service (Shenzhen) Co., Ltd. and Haiyi Co., Ltd., and the employees, agents, affiliates, subsidiaries, parent companies, holding companies, or officers thereof, including Haiyi Group Co., Ltd., Chen Huanyong, Liu Chunyu, and Huang Wenhai" – collectively "Respondents") have been filing applications and other documents to obtain or maintain registrations that make material misrepresentations or contain false attorney information and signatures. The Respondents must show cause as to why the USPTO should not immediately sanction them for fraudulently filing thousands of trademark-related documents with the USPTO.

When an entity is sanctioned, it means that the USPTO has determined the entity has violated the USPTO's Trademark Rules of Practice. Sanctions can include any or all of the following:

1. Termination of proceedings, including termination of a pending application which the owner will not be able to rehabilitate or reinstate, regardless of the owner's awareness of the intentional violations;
2. Non-consideration or giving any weight to the affected submission;
3. Preclusion of submissions of any documents in trademark matters before the USPTO;
4. Deactivation of affected USPTO.gov accounts through which all electronic forms must be filed.

In this particular case, the USPTO learned that documents necessary for obtaining trademark registrations were filed and/or signed "directly" by attorneys who do not appear to exist, or who were deceased as of the time of filing. For example, an attorney identified as "Jeffrey Stewart Firestone" (and variations thereof) is listed as the attorney of record for over 8,000 trademark applications and registrations, and is the authorized signatory for at least 300 submissions filed since August 2, 2021 – days after Mr. Firestone's death. Respondents also listed a fictitious U.S. attorney, for whom no record exists, by the name of

“Jackson George” as the attorney of record in over 2,500 trademark applications and/or registrations.

The Show Cause Order is a public example of the USPTO’s efforts to monitor and take action against those who try to circumvent its rules, such as those requiring a U.S. attorney to act on behalf of foreign applicants.

If the offending entities are sanctioned, the USPTO may also update electronic records for the affected registrations to include a notice that the registrations are subject to an order for sanctions, which could impact the underlying validity of the registration.

In light of the proliferation of such fraudulent filings, brand owners facing challenges with registering marks or maintaining registrations should look with a critical eye at any blocking third party marks. In addition, as encouraged by the USPTO, brand owners seeking trademark counsel should carefully analyze and investigate solicitations from individuals and firms advertising low-cost application and registration-related legal services. If the offer looks too good to be true, it probably is.

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As of August 31, 2022, ICANN lists a new Sunrise period as open for the following new gTLD that may be of interest to our clients. A full list can be viewed [here](#).

.kids

ICANN maintains an up-to-date list of all open Sunrise periods [here](#). This list also provides the closing date of the Sunrise period. We will endeavor to provide information regarding new gTLD launches via this monthly newsletter, but please refer to the list on ICANN's website for the most up-to-date information – as the list of approved/launched domains can change daily.

Because new gTLD options will be coming on the market over the next year, brand owners should review the list of new gTLDs (a full list can be found [here](#)) to identify those that are of interest.

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