A Career-Path Timeline for Trademark Administrators

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The career paths of trademark administrators will vary from country to country and even within countries. The career-path timeline presented here is U.S.-oriented, but it will have applicability elsewhere as well. We hope you find it useful, and we welcome your comments and suggestions (Publications@inta.org).

It is possible to take both degree and non-degree paralegal university courses that will teach you some of these skills; in addition, there are many conferences, lectures and roundtables, offered by INTA and other organizations, that one can attend to hone skills appropriate to one’s level of experience.

Year 1

- Trademarks 101: What is a Trademark? Introduction to basic concepts of trademark law. Introduction to docketing systems and the importance of deadlines, with a view to performing simple basic docketing of trademark deadlines for the home country by the end of Year 1

Learn more:


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INTA Fact Sheets, in particular, INTA Fact Sheet, Learn the Language
INTA Glossary

- Familiarity with USPTO website, primarily TESS, TSDR and TEAS
- Familiarity with USPTO official documents and timing associated with each:
  - Trademark Application
    - Learn more: INTA Fact Sheet, Filing a Trademark Application in the United States
    - INTA Fact Sheet, Service Marks
  - Official Filing Receipt
  - Office Action
  - Allegation of Use
  - Notice of Allowance
    - Learn more: INTA Fact Sheet, Trademark Use
  - Publication in the Official Trademark Gazette
  - Statement of Use
  - Request for Extension of Time to File Statement of Use
  - Certificate of Registration
  - Section 8 and 15 Declaration
  - Certificate of Renewal
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- Section 8 and 9 Declaration

  Learn more:
  INTA Fact Sheet, Maintenance and Renewal

- Notice of Abandonment/Petition to Revive
- Grace periods permitted for certain filing dates
- All documents submitted to the USPTO must be signed by the client or by an attorney on behalf of the client; administrators may not submit documents under their name

- Preparation of simple report to clients:
  - Filing Receipt
  - Notice of Allowance

  Learn more:
  INTA Fact Sheet, Trademark Use

- Notice of Publication
- Request for Extension of Time to File Statement of Use
- Acceptance of Statement of Use
- Acceptance of Section 8 and 15 Declaration
- Certificate of Registration
- Certificate of Renewal

- Introduction to simple electronic filings:
  - Electronic forms provided by the USPTO can be prepared by an administrator; there is a simple procedure for forwarding the form to an attorney for review and signature
  - Understand ethical obligations and the necessity for attorney supervision
  - Electronic forms include:
- *Power of Attorney* / Appointment of Domestic Representative for Non-U.S. Client
- Assignment Recordal

**Learn more:**
INTA Fact Sheet, *Assignments*
Practitioner's Checklists, *Trademark Assignment Agreement Checklist*, by Michael Lisi

- Change of Name
- Change of Address
- Change of Correspondent
- Request for Extension of Time to File Statement of Use
- Statement of Use with Specimen

- **Introduction to searching:**
  - Conduct a preliminary screening search
  - Order a search from a professional search service
  - Investigate possibly conflicting marks on the Internet
  - Order more extensive investigations from professional investigators

- **Introduction to research:**
  - Familiarity with the basic research tools, such as the USPTO website (*design search codes*, *approved goods descriptions*, etc.) and Internet search engines and resources
Years 2–3

- Establish clear understanding of trademark concepts and laws:
  - Basis for filing
  
  **Learn more:**
  Trademark Administration: Useful Resources

  - Acceptable drawing of the mark
  - Importance of first use in commerce date
  - Understanding of what constitutes “use in commerce”
  - Intent to Use (ITU)—understanding the importance of how a mark will be used on or in connection with the goods and/or services
  - Understanding of acceptable specimen/the difference between use on goods and use in connection with services
  - Convention priority claims
  - Legalization of documents and the Hague Convention

- USPTO-related skills:
  - Draft responses to simple, mainly technical or procedural, Office Actions, under supervision of attorney
  - Ethical considerations and obligations firmly in place; ensure that drafts are reviewed and signed by an attorney
  - Perform factual research regarding client’s use of the mark, third-party registrations, etc.
Review cited applications/registrations

Conduct basic legal research regarding USPTO rules and Trademark Manual of Examining Procedure (TMEP)

Draft responses to Office Actions, including substantive issues for attorney review

Draft report of Office Actions and Office Action Responses for supervising attorney to review before it is sent to client

• Searching and clearance:
  Perform advanced searching of available databases, including formulating competitor searches and/or industry-specific searches
  Review and analyze search results; create a report to the supervising attorney
  Conduct advance investigation of potential conflicting marks
  Understand how to order an investigation from a professional vendor
  Review and analyze professional investigation report, including writing up the report for the supervising attorney
  Prepare draft opinion to client under supervision of attorney
  Knowledge of ethical considerations involved in conducting investigations

Learn more about searching and clearance:
Practitioner’s Checklist, Trademark Clearance Search, by Rose Auslander and Michael Lisi
Trademark Administration, Trademark Searching and Clearance, by Glenn A. Gundersen

• Begin learning international filing processes:
  Work with supervising attorney to understand the reasoning behind a client’s international filing strategies
**Learn more:**

INTA Fact Sheet, *Filing a Trademark Application Outside the United States*

INTA Fact Sheet, *Single Class vs. Multi-Class Trademark Applications*

- Familiarity with which international counsel are used for which clients/industries
- Learn basic communication skills and etiquette when dealing with international counsel
- Familiarity with differences in national filings, whether U.S. or elsewhere, and other office filings, such as **WIPO, OHIM, BENELUX, OAPI and ARIPO**

**Learn more:**

INTA Fact Sheet, *Community Trade Mark*

- Prepare and send basic filing instruction letters to international counsel, along with the appropriate supporting documentation for each country

- Begin learning international renewal processes for non-U.S. national as well as **WIPO, OHIM, BENELUX, OAPI** and **ARIPO** filings:
  - Learn basic renewal time frames
  - Learn basic proof of use time frames
  - Learn to prepare and send basic renewal instructions to international counsel where needed, along with the appropriate supporting documentation for each country
  - Begin learning process and planning of worldwide recordation programs for assignments, licenses, changes of name and changes of address
  - Know what documents are required to place the requests for recordation on file, including powers of attorney and legalization thereof
Learn more about trademark administration and maintenance:
INTA Fact Sheet, Maintenance and Renewal
Trademark Administration, Administration and Maintenance, by Mary Katherine Merlino and Virginia Smith, updated by Michelle Renne

Learn more about trademark law and practice worldwide:
INTA’s Country Guides
INTA’s Global Portal

- Billing and time records:
  - Keep accurate record of time, if billing is based on time
  - Review all international counsel invoices, including comparison with quoted costs and fees with recommendation for approval of payment
  - Promptly forward international counsel bills to the appropriate department personnel

- Docketing:
  - Perfect basic docketing skills and learn more sophisticated docketing skills, including in home country and internationally
  - Learn to supplement information not supplied by the docketing team; most systems will have a “remarks” area that can be useful in understanding the progress of the mark
  - Maintain up-to-date status reports for all clients based on new documents and information as it becomes available
  - Establish a regular system of follow-up after regular review

- Begin learning the basics of opposition, cancellation and litigation:
o Review watch lists and work with the supervising attorneys to determine which marks might need to be further researched before bringing them to a client’s attention
o Suggest to attorneys which marks might warrant further review/research

• Research:
  o Hone and maintain excellent research skills; become the firm’s research expert
  o Ensure that all research websites are available at your fingertips and know how to use them effectively: USPTO, WIPO, OHIM, Internet search sites, domain research sites, investigative search sites, clearance search sites/vendors, INTA resources, etc. See Trademark Administration: Useful Resources.

### Years 4–6

• Draft responses to substantive Office Actions for review by supervising attorney

• Draft letters of consent for review by supervising attorney

• As necessary, arrange for translations of Office Actions and provide to supervising attorney

• Provide draft responses for possible inclusion in responses to international office actions for review by supervising attorney; respond to international counsel with the response where appropriate

• As needed, assist supervising attorney and/or client in gathering proof of use information

• Familiarity with proof of use and cancellation for non-use time frames for the countries most important to a particular client

• Familiarity with searching strategies

• As needed, assist newer attorneys with learning searching strategies
• Participate in client portfolio management in the United States and abroad:
  o Familiarity with client’s portfolio and reasoning behind all international filing strategies
  o Ability to determine whether a national, regional or international registration would be appropriate for any given strategy
  o Ability to suggest new strategies to the attorney and/or client when new countries are added to or subtracted from the various treaty filings

  Learn more about managing a trademark portfolio:
  INTA Fact Sheet, Trademark Portfolio Management Strategies
  Practitioner’s Checklist, Assuming Responsibility for a Trademark Portfolio, by Frank S. Hiscox

• Develop a clear understanding of treaties and different filing systems – for example, OHIM, the Madrid System, ARIPO, OAPI and Andean Community – and be able to answer any procedural questions the attorneys may have regarding the same

  Learn more:
  INTA Fact Sheet, Community Trademark
  INTA Fact Sheet, International Treaties
  INTA Fact Sheet, Madrid Protocol
  INTA’s Madrid Agreement and Protocol: A Practitioner’s Guide

• Develop strategies for international filing programs, including national filings, OHIM filings, WIPO, OAPI:
  o Keep up to date on the country listings for each of the filing programs (or know where on the Internet to quickly find the latest information)

• Understand the importance of international counsel; develop and maintain those relationships:
o Retain all basic information regarding international counsel (email, phone, fax, etc.)

- Develop expertise on the costs of certain procedures; know when to dispute invoices of vendors or international counsel
- Familiarity with steps required to perform due diligence tasks

**Years 7–10**

- Familiarity with administrative proceedings, including oppositions and cancellations in the USPTO
- Draft and file Notices of Opposition or Cancellation under the supervision of an attorney

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Learn more about opposition and cancellation law and practice worldwide:
INTA Fact Sheet, Opposing a Trademark Application
INTA's International Opposition Guide
INTA's Trademark Cancellations: International Practice and Procedure
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- Assist in collecting and organizing discovery documents and evidence for use in administrative proceedings
- Familiarity with professional watch services; develop expertise and knowledge of ordering and renewing the most beneficial service per client
- Review and analyze watch notices in the home country and internationally for possible infringing uses and applications
- Develop expertise on conflicting marks that should be brought to attorney’s attention for possible opposition or cancellation, based on client’s portfolio
- Draft report to client with recommendation for proceeding with opposition or cancellation, under the supervision of attorney
Draft instructions to international counsel for preliminary advice and investigation regarding possible infringing uses and applications

Draft report to client with recommendation for proceeding with international opposition or cancellation, under the supervision of attorney

Draft instructions to international counsel regarding preparation and filing of an opposition or a cancellation action, with knowledge of legal basis for filing, provision of all pertinent information and possible argumentation under the supervision of the attorney

Know what documents will be required to place the administrative proceeding on file, including powers of attorney, certificates of good standing, and legalization thereof as appropriate

Prepare all required documents for forwarding to client, with specific instructions regarding execution and legalization

Draft license agreements and instructions to international counsel regarding review and approval of license agreements and recordation of agreements

Learn more:
INTA Fact Sheet, Trademark Licensing

Know which documents will be required to place the license agreement on file, including powers of attorney and legalization thereof

Familiarity with and knowledge of coexistence agreements as required by the USPTO or as instructed by international counsel as to filing abroad

Draft coexistence agreements for review and revision by attorney

Monitor final signed agreements for compliance with settlement terms

Use of watch services, Internet, field information and investigation in monitoring for compliance