Trademark Specialist

JOB DESCRIPTION

DEPARTMENT: Practice Support: IP Support
STATUS: Non-exempt

SUMMARY

Performs trademark practice support duties in the Northern Virginia Office; provides legal and non-legal research and reference support to attorneys and staff. The trademark practice at Hogan Lovells consists of a team of individuals working together to produce high quality legal representation of the firm’s clients in trademark matters. Members of this team contribute their diverse array of skills, ranging from administrative skills to research analyst skills and legal assistant skills and to attorney skills. Consistent, proactive, and cooperative high quality performance from each team member is essential to achieve the goals of our trademark practice. This position has a billable hours component of 1,350 hours per year.

JOB DESCRIPTION

ESSENTIAL DUTIES & RESPONSIBILITIES:

- Maintaining an agenda of items for discussion at monthly trademark meetings.
- Assisting with trademark monitoring
- Conducting, ordering, reviewing and analyzing trademark search reports
- Knowledgeable and proficient regarding the firm’s trademark docketing software and trademark files.
- Preparing and filing trademark applications, extensions of time, statements of use, combined declarations, and renewals with the United States Patent and Trademark Office (“PTO”).
- Communicating with colleagues in other U.S. and international offices and counsel in other jurisdictions regarding international trademark prosecution and maintenance
- Knowledgeable of intent to use and use based as well as international filing strategies
- Preparing and filing trademark, patent, copyright, and domain name assignments
- Preparing and filing responses to office actions and other miscellaneous documents with the PTO
- Preparing trademark prosecution and maintenance correspondence to clients and to the PTO
- Preparing and filing copyright applications.
- Preparing cost estimates for trademark prosecution and maintenance matters
- Preparing client status reports for trademark, copyright, domain name and related matters
- Provide due diligence support for corporate transactions
- Prepare and file U.S. Customs & Border Protection recordations
• Assist with domain name related matters issues
• Provide support for Trademark Trial and Appeal Board ("TTAB") opposition and cancellation proceedings and appeals
• Provide support for trademark enforcement matters
• Provide ready reference and substantive trademark and copyright procedural research assistance to attorneys.
• and other duties as assigned.

Quality Control:

The Trademark Specialist is expected to perform these responsibilities to the standards set by the trademark team to achieve high quality work product in both appearance and substance. All work product produced by the Trademark Specialist is to be for lawyer review, sometimes in a form suitable for forwarding to clients. The Trademark Specialist is expected to proactively identify, present, and discuss possible improvements to the trademark practice, and to take proactive steps to perform the above responsibilities.

Advanced Skills:

Advanced skills and responsibilities for the Trademark Specialist include responsibility to perform on-line research to determine the availability of a proposed trademark for use and registration. Such research is intended to supplement, and not replace, the use of trademark search reports prepared by third party services. The analysis of the on-line research and trademark search reports and the preparation of a draft written analysis (using standard forms) are also advanced skills.

QUALIFICATIONS

REQUIRED SKILLS:

• Minimum: 2+ years of equivalent trademark experience
• Experience with electronic filings at the PTO.
• Experience in on-line database searching, including Westlaw, trademark databases and other on-line sources.
• Extensive knowledge of substantive trademark law
• Extensive knowledge of trademark research
• Extensive knowledge of Internet and domain name research.
EDUCATION, CERTIFICATIONS, AND/OR EXPERIENCE:

- BS/BA degree or equivalent experience preferred.

PHYSICAL DEMANDS:

- While performing the duties of this job, the employee is sometimes required to lift equipment and/or move boxes up to 20 lbs.

OFFICE HOURS (includes lunch hour):

9:00 AM-5:30 PM Monday-Friday with overtime as needed.

This job description sets forth the authorities and responsibilities of this position and may be changed from time to time as shall be determined. We are an Equal Opportunity Employer.