**Session 2:** Avoiding the Rabbit HOle – Managing Large-Scale Trademark Projects

**Audience:** General Session – TM Administrators and Young Practitioners

**Format:** Panel; 1 Hour

**Team**: Mandy (Lead); Fiona

Outline

Introduction of panelists and overview by Moderator

1. Portfolio Intake
   1. Conduct Worldwide Trademark Search
      1. Confirm that the chain of title matches the portfolio
      2. Confirm that the trademarks match the portfolio
   2. Setting the IP team – Identify IP decision makers
      1. Who is positioned to answer IP questions?
      2. Does the same person sign all documents on behalf of owner and/or subsidiaries?
      3. Do you require the assistant of former portfolio manager?
   3. Filing Strategy – Case files
      1. Are you equipped to safeguard case files?
      2. Consider a scanning program for all documents and safeguard original chain of title documents and registration/maintenance certificates
      3. Determine off-site storage strategy for historical documentation, search reports, and abandon case files
      4. Ensure docket file numbers and case file numbers are in concert.
2. Portfolio Chain of Title – Who owns what?
   1. The Documents
      1. Identify any necessary gaps in the chain of title
      2. Determine steps for updating chain of title (domestic and foreign), if necessary
      3. Create or locate appropriate chain of title documents (assignments, POAs, etc.)
      4. Execute chain of title documents
      5. Create and manage shared spreadsheet by marks and country
   2. The Costs
      1. Consider asking for foreign counsel discount for multiple (20 or more) marks
      2. Identify legalization costs savings and consider using third party agency for continuity
   3. The Filing Approach
      1. Execute and forward chain of title documents to foreign counsel or file with USPTO
      2. Update shared spreadsheet and update accordingly
   4. The Finished Work
      1. Confirm that chain of title was properly filed
      2. Update docket system
      3. Update shared spreadsheet accordingly until all are complete
3. Portfolio Clearance – Global Search Clearance
   1. The Brand
      1. Determine if you wish to expand brand(s) and into what jurisdictions
   2. The Approach
      1. Conduct knock out searches and communicate results to business stakeholders
      2. Determine if priority filings are an option
      3. Contact outside/foreign counsel for best strategy
      4. Create and update global search opinion spreadsheet as results come in
   3. The Costs
      1. Contact outside/foreign counsel for estimates (consider requesting a discount for multiple searches)
4. Portfolio Filing Strategy – Trademark gaps and cost savings measures
   1. The Portfolio
      1. Identify brand(s) requiring coverage and the jurisdiction of use (proposed use)
      2. Consult with outside/foreign counsel regarding best approaches for maximum coverage
      3. Consider Madrid, CTM, and Senior Priority filings as appropriate
   2. The Costs
      1. Consider requesting discount for multiple foreign filings
      2. Use Global Estimator or other tools for determining costs
   3. The Filing Approach
      1. Create and manage shared spreadsheet, including costs and periodically share with business stakeholders
      2. Communicate multiple filings under one communication with outside/foreign counsel accordingly
      3. Ensure docketing team is copied on all filings (incl. foreign counsel communication)
5. Portfolio Maintenance – Protect, Trim and Save
   1. The Portfolio
      1. Prepare maintenance docket report in Q3 for deadlines for upcoming year and communicate with business stakeholders requesting instructions
      2. Consult with outside/foreign counsel regarding best approaches for maximum coverage
   2. The Costs
      1. File maintenance documents as soon as possible
      2. Consider requesting discount for multiple maintenance filings
   3. The Filing Approach
      1. Communicate multiple filings under one communication with foreign counsel
      2. Update maintenance docket report and share with business stakeholders
      3. Ensure docketing team is copied on all filings (incl. foreign counsel communication)

Q&A