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5 TIPS FOR TRADEMARK SUCCESS AS AN ATTORNEY

trademark

/'treɪdmɑ:k/

a symbol, word, or words legally repre-

The number of trademark applications filed at the United States Patent and Trademark Office (USPTO) has been rising for at least the past five years. Especially during the pandemic, we have seen considerable growth in trademark filings from small and large businesses alike. Why? There are many reasons for the surge, including the fact that more companies have realized a need to transition their businesses to e-commerce and online platforms. More importantly, with so many people losing their jobs or working from home, many side hustles have turned into new businesses being formed.

According to United States census [statistics](#), new businesses grew from just under 3 million in 2016 to 3.5 million in 2019. However, in 2020, Americans formed 4.35 million new businesses – nearly a 25% year-over-year increase. Not coincidentally, that increase also aligns with the surge in trademark applications we have seen starting in August 2020 and throughout 2021. As of the end of August 2021, YTD applications are up nearly 25% over last year, an increase of nearly 80,000 applications.

The fact remains that businesses, no matter their size, are increasingly savvy about how important it is to differentiate themselves both online and in the general marketplace. The best differentiator is by having a strong brand. Enter the trademark attorney.

Why Practice Trademark Law?

Trademark law is based on a federal statute and practiced before the USPTO, a federal agency. Trademark attorneys can be barred in any one state and file applications for clients from any state. There is no special exam required to practice before the USPTO, and all filings at the USPTO are submitted electronically. For these reasons, many attorneys are drawn to practice trademark law, and it also lends itself nicely to a virtual law firm practice. Beyond the virtual practice appeal, many continue to practice trademark law because the work is deliciously nuanced, substantively challenging, and the clients can be a lot of fun. You never know when you might help build the next big household brand.

However, practicing trademark law is far from filling out forms or working a few hours a day. It takes significant work to master trademark law and scale any law firm practice – you must understand and become familiar with a litany of rules and new case precedent is created every day.

If you are not interested in keeping up with the ever-changing rules and body of law, then this may not be the practice for you. Additionally, while it can be a fun practice area, clients have a lot at stake – it takes significant time, resources, and money for clients to create a brand – so if you aren't sure what you're doing or are not fully vested in the work, you could harm the client's rights.

Given all that's at stake, what's the best way to go about learning this exciting and fun practice area and establishing a successful practice? Here are five tips – drawn from my 15+ years of real-life experience – to help you get started building the trademark law practice of your dreams and boost your firm's revenue.



7 Learn How Business Works

As a trademark attorney, your clients will be operating a business of some kind. While you may not have gone to business school, it's helpful to understand how business works in general. Think about this from your experience as a consumer. If you plan to focus on one or two specific industries, make sure you understand how those businesses work. Some questions you may want to ask your client include:

- What does the client sell?
- What is the client's distribution model?
- Who is the client's target customer?
- Who are the client's main competitors?
- What challenges does the client face?
- How does the client differentiate itself from its competitors?
- Why did the client create this product or service?

Understanding your client's business is the first key to your success; it will not only help you draft a better trademark application for them, but also help you sell them more services. These insights may help you see gaps in their trademark filings and recommend additional trademark filings. The more you understand your client's business, the more value you can add. The more value you can add, the more legal work you can likely generate from the client, leading to greater revenue and more referrals. It will also help you differentiate your practice from the cheap online providers that generally don't add any value to clients. Taking the time to ask questions will not only establish a valuable relationship with your client, but it will ultimately allow you to prosper as a trademark attorney – it is a straightforward process with high reward.

2 Pay Attention To The Details

If you are already a detail-oriented person, you are well suited for a career in trademark law, as this is a practice area all about the details. If you are not particularly detail-oriented, you'll want to be sure to have someone on your team who is. Trademark law comes down to the finest details, and often the best arguments are drafted based on the ability to distinguish between very subtle details. Don't worry; it takes time to develop the substantive knowledge to see some of the finer points in trademark law. The more you can see those fine distinctions, the more successful you will be in this practice area. Trademark law is a very subjective area, so having a colleague or mentor to gut-check some of your searches and arguments will help you develop your skills and become successful.





3 Systematize Your Processes

There is a standard workflow for trademark applications at the USPTO, so it's essential to make sure you set up your systems to manage your time efficiently, send timely communications, and deliver a great customer experience to your clients. The trademark process is a long one; you will want to leverage technology to manage each filing, stay organized, assign tasks to staff members, and help identify changes or opportunities for additional work. Well-established systems should include at least a client management system, project management tools, and docketing software. But before you start purchasing technology platforms or building one or more systems, you should document your internal workflows with clear, written Standard Operating Procedures (SOPs) for all current and future team members. This will ensure your long-term success and a great client experience.

4 Learn The Trademark Rules Of Practice

It's not sexy, but it's critically important. All trademark lawyers, or anyone that practices at the USPTO, must know the Trademark Rules of Practice and be familiar with the [Trademark Manual of Examining Procedure](#) (TMEP) before filing their very first application. The TMEP is the trademark attorney's Bible. Filing anything at the USPTO without knowing the applicable rules is irresponsible and could potentially harm your client's rights without your intending to do so. While it can be overwhelming to sit down and read a bunch of rules, you will need to familiarize yourself with the basic applicable rules before you file anything at the USPTO. You will learn the others through practice. To help get started, consider subscribing to the [TTABlog](#) to receive daily summaries on cases decided by the Trademark Trial and Appeal Board (the administrative tribunal of the USPTO). Reviewing case history is the best way to become familiar with the USPTO rules and trademark case law procedure. Trademark law is, after all, still the practice of law, and the TMEP's impact on your daily life as a trademark attorney cannot be overstated. Before long, you'll find that the TMEP will become a staple of your daily life as a trademark practitioner – on everything from filing an application to advising a client on a clearance search.



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Educate Yourself On The USPTO Process

My last and perhaps most important tip is to make sure you have the proper practical education in place to learn a new practice area.

Before you file anything on behalf of a client, make sure you know the trademark process inside and out. There are many CLEs available that will give you a general overview of this process; even the [USPTO](#) has some basic, introductory videos in their learning library.

However, most of these CLEs and online videos are not instructive or long enough to help a practitioner who wants to know how to represent clients confidently before the USPTO. A one-hour CLE likely does not provide the in-depth education and practical tips and strategies an attorney needs when they are looking to learn a new practice area. Unless you work under the supervision of an experienced trademark practitioner, the best way to educate yourself and build your confidence to represent clients is to take a comprehensive training course, like the [Trademarkabilities® Masterclass](#). The course will show you step by step, screen by screen how to navigate the entire trademark prosecution process at the USPTO. The Masterclass will teach you the relevant TMEP rules and provide practical strategies and tips, client communication templates, substantive templates to respond to USPTO refusals, and ongoing group mentoring. It's the best value available for anyone looking to set up a trademark practice or add trademark law to their existing practice.

Conclusion

Trademark law is a growing and exciting field that attracts many transactional attorneys, and with good reason: (1) it's a federal statute, (2) the USPTO filings are completely electronic, and (3) nearly every U.S. business can benefit from a trademark registration. However, representing clients well is not as easy. The effects of the cheap online providers can be seen throughout the USPTO register, often resulting in adverse effects on the clients who fall prey to them.

By understanding how to practice trademark law and making client service the focus of your practice, you give yourself a solid foundation for success.

Please be sure to follow our [blog](#) and [LinkedIn](#) page for ongoing tips and information.

If you have any questions or concerns, you can contact me at any time at sck@trademarkabilities.com.

Cheers to you!



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