

How Do You Start a Trademark Prosecution Practice at an Existing Law Firm?

Ever wonder how to go about starting a new trademark prosecution practice at a law firm without one? **Mona A. Lee** of DW Partners in Seoul, Korea, who started a trademark practice at a general practice firm, and **Peter S. Sloane** of Leason Ellis LLP in White Plains, New York, USA, who started a trademark practice at an IP boutique, share their experiences in doing just that.

Mona: Peter, I thought it would be interesting to talk about our experiences in starting a trademark prosecution practice at an existing firm.

Starting Off

Mona: For starters, when I think of some of the very first things I had to address, office supplies comes to mind. While my firm had all kinds of office supplies, it did not exactly have what I needed. In Korea, trademark attorneys use file folders with a unique front cover that has labeled boxes for various information, which folders I believed were essential to have, as were preprinted stamps for stamping correspondence.

Another early task that I recall is actually having to put together a Schedule of Minimum Fees and set up an account for paying of official fees.

Peter: We also had to draft what we call a Schedule of Standard Charges. As far as payment of official fees, we dispensed with the deposit account at the U.S. Trademark Office in favor of payment by credit card. In establishing the trademark practice, we also had to set up wire transfers for all our associates around the world.

Docketing Software—Deadlines, Deadlines and More Deadlines

Mona: Another thing to which I gave my immediate attention was obtaining docketing software specifically designed to handle trademark prosecution deadlines. I remember early in my career that general practice firms in the United States were not particularly interested in having an IP prosecution practice, due to the risk that came from managing numerous deadlines and the administrative support necessary to keep track of them in order to avoid claims of malpractice. That remained with me years after I relocated to Korea, so docketing software weighed heavily on my mind.

Peter: There is no doubt that specialized docketing software is critical to running an effective IP practice.

Drafting Policies and Procedures and Other Documents

Mona: Another step I took to lay the foundation for a trademark practice was to draft policies and procedures. For example, to help employees prioritize their work, I drafted a timetable for how soon particular tasks should be completed. I also developed guidelines for how search strategies should be formulated so that we would not have to go back and reinvent the wheel every time we were to perform a clearance search. I created checklists so that we would not have to rely on our memories. I put together an orientation folder to systematize the orientation of new hires. I also started keeping an index of successful cases so that we could go back and study them later and try to apply similar strategies in future cases.

Peter: I am amazed at how much you have been able to accomplish. I am now just halfway through my second year at the firm, so there is still much to do.

Team Meetings

Mona: The last thing I wanted to mention about what we did early on was that we held weekly team meetings to discuss issues such as urgent work matters, specific ways to improve, our vision for the practice, and new developments in laws and procedures. As the workload grew, the team meetings became less frequent, but we still have full team meetings about twice a month and then ad hoc mini meetings in between.

Peter: Until recently, our trademark practice was too small to justify having team meetings. As the practice has grown, I can see where that would be beneficial.

Hiring, Training, Managing and Motivating

Mona: Well, one of the keys to having a solid team is having solid team members, which leads me to the next big step I took: hiring. After taking care of the more “mechanical” aspects of starting a practice, I shifted gears from the microscopic level to the macroscopic level and started focusing on human resources.

Peter: Without a doubt, this is the most difficult part of establishing a trademark practice. It is one thing to be able to work effectively on your own and to develop clients. Inevitably, the work increases to the point where you cannot do everything yourself. The INTA Job Bank is a great resource for looking for new hires. This is especially true for new trademark practices that do not have the resources to pay for outside recruiters.

Mona: Another source for team building that I came to rely on was management books. I found myself taking the opportunity to browse airport bookstores for such books, especially since they seem to have a high concentration of them (usually on my way to or from an INTA Annual Meeting).

My reading helped me to ask and answer a fundamental question about how I envisioned our practice should be managed. I understood that if we had an assembly line culture, it might increase efficiencies. For example, if we had one person preparing reports on preliminary rejections based on faulty descriptions, he or she might become an expert in handling them. It might mean more profit to the firm and less stress to the employee. But that same strength could prove to be a weakness as well. In the event that the employee became sick, depending on the skill and experience of the remaining persons in the office, it could paralyze our practice.

Peter: You are right. When the work comes in the door, particularly as an emerging trademark practice, we do not necessarily have the luxury of picking and choosing what to handle. If litigation heats up, it is important to have people with the ability and desire to shift from prosecution. The same holds true in the other direction.

Mona: Yes, and the other concern I had with overspecialization was diminishing motivation. It is easy to imagine that same employee over time becoming bored with his or her job through sheer monotony. When starting this practice, I felt an obligation to keep everyone motivated and happy, because when starting anything from nothing you need a lot of hard work and dedication. You cannot expect that from people without providing them with interesting work, a sense of satisfaction and hope for the future.

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Peter: I actually think that some people *like* specialization. I have found that not everyone wants to be a generalist when it comes to trademark practice. But this becomes an issue for us when the firm needs help in other areas in which they may be less comfortable. Plus, specializing may come at the expense of perspective. Experience in litigation is extremely helpful in evaluating risk in search reports and in providing sophisticated advice in trademark clearance. To take another example, it may be shortsighted to focus on domestic rights without considering international implications.

Mona: Exactly. I believe part of the answer lies in maintaining a healthy balance in work variety. In that regard, I organized our work according to client and not according to tasks. I made mini-teams for each client so that the lawyers and staff could get to know the client and its matters well. In other words, work was not strictly assigned based on the nature of the work or the capacity to take on additional work.

Peter: Although our practice is not yet large enough for mini-teams, I agree that it is important to be sensitive to client needs and relations in assigning work. I also think it is beneficial to let associates write correspondence and file pleadings and applications under their own names. This allows them to develop stronger relations with clients and gives them pride of authorship, which should lead to a better work product.

Mona: Absolutely. In that regard, I try to provide team members with opportunities to have a say in the operation of our practice. I let them know that I value their opinion. Also, I encourage team members to go to shops that sell our clients' goods so that they can see for themselves what is happening in the marketplace. I also bring into the office newspapers and magazines that show our clients' marks, so team members can appreciate their reputation.

Peter: One of my clients is a consumer electronic products company that allows us to buy from its "friends and family" schedule at the holidays, so I make sure to give everyone a chance to order. In addition to providing a benefit to them, it makes them more familiar with our client and its products. In terms of building the practice, we occasionally do things like have a "revenue Wednesday," where we order in pizza for lunch and encourage everyone to double-down their efforts in billing.

Clients!

Mona: Now, that's an interesting thought. And there is no such thing as a trademark practice without clients, right? Which brings me to another issue that we had to face: letting people know where we were and what we had to offer. When starting out, I did not have the benefit of having a sizable advertising budget, so I had to publicize the least expensive way I knew how—I sent emails to friends and colleagues.

Peter: We also do not have a significant advertising budget, so getting the word out is an old-fashioned combination of networking, public speaking and writing. With the Internet, effective public relations is possible even for a start-up practice. When the occasion arises, we draft a press release and send it out to everyone, from IP publications to websites that disseminate free press releases, like PR-Log.org. It is amazing how widely the press releases get picked up. We also take advantage of social networking websites, like LinkedIn,

Facebook and Twitter, that allow us the same access to potential clients as existing practices. I try to "tweet" on behalf of the firm at least once a day.

Mona: Along the lines of client development, I know that many general practice firms engage in cross-marketing efforts, such as when the trademark group gives a presentation to a client serviced by another practice group. I confess that I do not engage in it, but I can see where it could benefit a young trademark practice. Is this something you do?

Peter: I am familiar with the practice, but we do not engage in it either. Although those kinds of activities may be valuable in developing client relations, they take a substantial amount of time and effort to put together. Existing large firms may have an advantage here to the extent that they have the resources to devote to such activities.

Mona: Looking back, I have to say that my involvement in INTA was a key factor in building the practice. Beyond that, the only other means I had to grow our client base was to just continue to strive to put out excellent work quality.

Peter: I could not agree more. On a day-to-day basis, I try to produce the best work product possible. When I started with my firm, I found it easy to get caught up in devoting most of my time to marketing. At some point, it becomes necessary to get back to functioning as an attorney and billing for work to pay for all the administrative expenses that come with building a practice.

Mona: Well, it has been said, "A race horse that can run a mile a few seconds faster is worth twice as much. That little extra proves to be the greatest value."

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