

TRADEMARK PROSECUTION PARALEGAL

Jackson Walker LLP

Dallas, Texas

Jackson Walker is seeking a Trademark Prosecution Paralegal with significant experience in prosecuting, managing and docketing large and mid-sized portfolios of trademarks. The Trademark Prosecution Paralegal will assist attorneys in trademark clearance searches using the Corsearch platform; preparing and electronically filing trademark applications with the USPTO; maintaining and prosecuting a large volume of trademark applications; managing a large portfolio of U.S. and foreign trademark registrations; and docketing applications and registrations in PATTSY. The paralegal also will serve as the primary correspondent with clients and foreign counsel. The ideal candidate will have at least 5+ years of experience in clearing, electronically filing, helping prosecute, maintaining large portfolios of, and docketing trademarks.

Responsibilities include:

- Managing and docketing large portfolios of U.S. federal, U.S. state and foreign trademarks in PATTSY
- Trademark clearance/availability searches using the Corsearch platform
- Prepare U.S. trademark applications, including client conference, use specimens for analysis and assist with description of goods/services
- Electronically file U.S. trademark applications
- Prepare and electronically file statements of use, requests for extension of time, Section 8, 9 & 15 documents, recordation of ownership changes and chain of title documents, and amendments for trademark prosecution and maintenance
- Monitor publication of trademarks
- Review and analysis of watch service reports for trademarks and domains
- Coordinate prosecution activities of foreign associates
- Assist in preparation of pleadings in trademark opposition proceedings and litigation
- Engage in domain name research
- Prepare and file copyright applications

Experience with the following is necessary:

- Trademarks, copyrights and domain names
- Due diligence review for IP portfolios
- Ability to manage trademark and copyright portfolios
- Filing and helping prosecute at least 300-500 trademark applications
- Trademark prosecution (domestic and international)
- Trademark docketing with PATTSY, CPA Inprotech, or other docketing software
- Solid understanding of the U.S. Trademark rules, policies and procedures
- Knowledge of the Trademark Manual of Examining Procedure (TMEP)

Qualifications:

- Bachelor's degree from an accredited four-year college/university, Associate's degree in Paralegal Studies or Paralegal certification

- At least 5+ years of experience in trademark prosecution
- Proficiency with docketing software such as PATTSY
- Excellent interpersonal and communication skills
- Ability to prioritize, lead and execute on numerous projects simultaneously