

# Senior Paralegal - Trademark

**Department:** Paralegal

**Organizational Relationship:** Reports to the Legal Professional and Paralegal (LPP) Committee

**FLSA Status:** Non- Exempt

**Last Updated:** January 28, 2025

## **General Summary:**

The Senior Paralegal - Trademark manages and leads all supportive aspects for cases or transactions for the Trademark Prosecution team. Their responsibilities include, but are not limited to, supervising and guiding the work done by paralegals, secretaries and support departments to ensure the completion of work for complex cases or transactions. Highly skilled in legal research and analyzing facts and information, reviewing invoices, billing entries and resolving problems as they arise. Advanced knowledge and research of complex legal matters is expected.

## **Essential Duties and Responsibilities**

“Essential duties” are those that an individual must be able to perform, including, but not limited to the following:

1. Conduct pre-screening trademark searches, and analyze full trademark searches; Draft opinion letter regarding risks and availability of mark(s) for use and registration
2. Handle all aspects of U.S. trademark prosecution and maintenance, including maintenance of files, preparation and filing of applications, preparation and filing of Office Action responses, ITU-related documents (e.g., Statements of Use, Extension requests) and Post Registration documents (e.g., Sections 8 & 15 Affidavits, renewals)
3. Oversee filing and maintenance of international trademark applications and registrations, including maintenance of files, reviewing correspondence from foreign counsel and drafting responses to same; obtaining and providing foreign counsel with information/documentation necessary to prosecute/maintain trademark applications and registrations
4. Prepare Assignments of trademark registrations and applications and file same with PTO Assignment Branch
5. Investigate possible infringement; Draft cease and desist letters
6. Prepare and file Copyright applications with the U.S. Copyright Office
7. Identify and resolve any discrepancies throughout the duration of a case or transaction
8. Supervises and oversees the work product of and provides guidance to, Paralegals, Project Assistants, Secretaries and Support Departments, prior to attorney review
9. Coordinates with other areas/departments of the Firm to develop efficient procedures/communications to stream-line processes and satisfy various department needs.

10. Analyzes information pertaining to relevant issues to a case or transaction.
11. Conducts research utilizing external court or agency websites, Lexis, Westlaw, and/or Livedgar to retrieve factual information for a case or transaction.
12. Reviews invoices and billing entries for case or transactional activities to ensure their accuracy.
13. Coordinate outside services, either directly or through support departments, and acts as liaison with involved third parties.
14. Trains paralegals and new attorneys in local office and department procedures and technical aspects of the paralegal area of expertise.
15. Promotes effective work practices and works as a team leader.
16. Perform IP due diligence research using online and commercial databases and preparing reports detailing results

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## Position Specifications

### *Education*

- Bachelor's degree (and signed declaration if located in a California office), or paralegal certificate from an ABA-approved program required.

### *Work Experience*

- A minimum of six (6) full years of relevant experience
- At least three (3) to five (5) years of trademark paralegal experience is preferred, but all strong candidates will be considered
- Experience with all aspects of USPTO trademark work (prosecution, maintenance and renewals) as well as TTAB proceedings (oppositions, cancellations)

### *Knowledge, Skills, and Abilities*

- Knowledge of, and familiarity with, trademark laws and procedures worldwide
- Proficient knowledge of internal software applications, such as word processing, internet searching skills, spreadsheets and databases.
- Knowledge of MS Office applications, specifically MS Word, MS Excel and MS Outlook.
- Highly developed and professional interpersonal skills; ability to interact effectively with people at all organizational levels of the Firm.
- Excellent communication skills, both written and verbal that convey professionalism and responsiveness.
- Ability to work in a team environment with a client service focus.
- Ability to handle confidential and sensitive information with the appropriate discretion.
- Effective utilization of portable and remote technology to respond to requests and facilitate the completion of assignments.
- Exceptional knowledge of legal concepts and methodologies as they relate to practice areas.
- Outstanding management skills (e.g., organizing, planning, and problem-solving).
- Demonstrated leadership skills that establish the direction of work needed on a case or transaction.
- Motivates team members and delegates work appropriately.
- Strong organizational skills; Highly versatile and adaptable; Able to multi-task in a pressured environment
- Work well independently, and as a team player
- Computer literacy, including the ability to work with Pattsy, Saegis, Corsearch, Lexis/Nexis, Westlaw, and other informational databases

### *Working Conditions*

All Latham & Watkins LLP positions are in a typical indoor office environment.

The statements contained in this position description are not necessarily all-inclusive; additional duties may be assigned and requirements may vary from time to time, and from location to location.