

INTA Bulletin

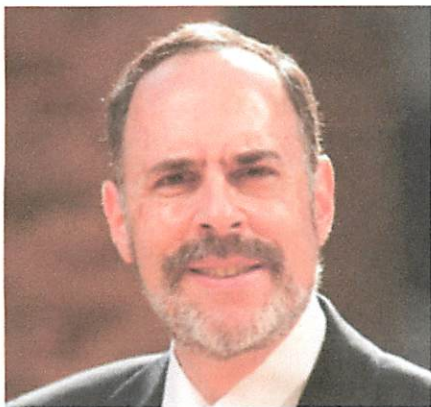
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Taking Trademark Administration into the 21st Century



Co-editors of the **first electronic version of *Trademark Administration***, Glenn Bacal (Bacal Law Group, USA) and Mary Donovan (Donovan & Yee LLP, USA), explained to the *INTA Bulletin* why members should take advantage of this updated, expanded and enhanced version of INTA's thorough introduction to trademark practice and procedure.

What has been your role with the project and what was the process like?

We have been the co-editors of this first electronic version of *Trademark Administration* from conception of the project, which began more than four years ago. The project involved the efforts of dozens of named authors, who are highly experienced attorneys, trademark administrators and paralegals, selected from the ranks of INTA. These authors were coordinated and supported by the INTA staff. Each chapter went through many careful revisions and edits, and the chapters fit together well as an integrated work. Now that the initial chapters have been released, additional chapters, already close to publication stage, will be rolled out in the coming months, covering more and more topics.

We are proud that Mary, in addition to being a co-editor, authored one of the important opening chapters of this seminal electronic work. Glenn was involved as a co-editor and co-author in all the various editions of the hard copy *Trademark Administration* going back over two decades, and he was thrilled to have the opportunity, working with Mary, to completely redo and revamp this popular INTA title for the twenty-first century.

The goal of the work as a whole was to come up with great new content that would be a resource that anyone involved in trademark work would regularly think to "reach for" electronically, in order to obtain clear, practical information, as well as sophisticated best practices tips, checklists and charts, regarding choosing, prosecuting, maintaining and enforcing trademark rights. The electronic format of the book is interactive, providing immediate links to relevant articles, guides and outside resources with a simple click. While the goal was lofty, we think that this work will quickly become one of those few indispensable titles often relied upon by trademark attorneys, trademark administrators and trademark paralegals alike. It fits the needs of trademark professionals at many different levels of sophistication.

And this work, by design, is already giving birth to additional works at the very highest level of sophistication in the trademark area—works aimed at the most highly experienced trademark professionals. For example, David Andersen (Bacal Law Group, USA), who wrote a splendid 100+ page treatment of U.S. Trademark Registration practice for this work, has also already authored a supplemental work (to be published separately by INTA) aimed at lawyers who have practiced in the area for a very long time. The supplemental work extends that portion of *Trademark Administration* about registration practice that is at the very highest level. This is the first spin-off work from *Trademark Administration*, and we hope that there are more.

What key topics are covered and why were they chosen?

The goal was to cover all of the major tasks for professionals involved in the adoption, registration and protection of trademarks in the twenty-first century. In addition to administrative matters, such as prosecution and portfolio management, the work covers due diligence, Internet issues and enforcement. Essentially, the day-to-day functions in the course of adopting and registering marks are covered. We wanted to give a framework to the process and suggest the plenitude of tasks that one can undertake in the course of such work. But we also cover the administrator's role in trademark litigation support. A lawyer will find it useful to see the things that a paralegal or associate should be doing in terms of diligence—indeed, we think that this may suggest to many lawyers that they may not be doing enough in some regards. This work covers these topics in as up to date a treatment as you will find in any treatise, whether hard bound or electronic. From social media to UDRP domain name challenges, teams of skilled lawyers and paralegals produced chapter after chapter of gems. We were and are very honored to work with the many contributors to the work.

Can it be useful for non-administrators?

Very. There is something for all skill levels, and for anyone involved at every level of trademark adoption, registration and protection. We have sections on due diligence, domain name issues, social media, assignments and litigation. What makes the work so valuable is that it includes links to other publications and to third-party resources. Because it is electronic, it can be expanded and kept up to date with changes in practice or new technologies.

What have you learned working on the project?

That INTA has many amazing, insightful members and internal staff who contributed many hours dedicated to this work. We are thankful for the guidance and support of the iconic **Mary McGrane** of INTA, who recently retired after helping so many good works get through to publication, and to Liz Hanellin for getting this so gracefully over the finish line after Mary McGrane's retirement. In a sense, this is Mary McGrane's true legacy work, one that we can foresee having an important place in every trademark professional's library for decades to come.

Although every effort has been made to verify the accuracy of items in the *INTA Bulletin*, readers are urged to check independently on matters of specific concern or interest.

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