

Role description

Associate/Senior Associate (Trade
Mark Attorney)

The opportunity for you

Key responsibilities

The successful candidate will work with a high degree of autonomy but will work closely with the partners and other senior team members. They will be instructing and supervising more junior attorneys, trainee trade mark attorneys and paralegals.

- Managing national and international trade mark portfolios and providing high quality holistic brand management support.
- Handling trade mark conflicts and registry disputes, including advising on strategies to defend, prosecute and settle oppositions, cancellation and revocation actions.
- Coordinating high volume/standard infringement disputes which may be related to registry actions, including preparing and sending cease and desist letters, dealing with follow up correspondence, negotiating settlements (working alongside solicitor associates if the dispute becomes more contentious and litigious).
- Conducting and advising on trade mark availability searches, using appropriate online tools and through search agents.
- Advising clients on registrability of trade marks and recommending cost-effective registration strategies.
- Filing and prosecuting trade marks on a worldwide basis, including the UK, EU and Madrid system.
- Gathering and presenting witness statement evidence to show acquired distinctiveness, reputation or for infringement purposes, including instruction of investigators.
- Drafting legal submissions for UKIPO or EUIPO proceedings and handling UKIPO hearings (whether doing advocacy themselves or through counsel).
- Advising on assignment or recordal projects and implementing them to run within budget, on time and with efficient reporting.
- Conducting detailed portfolio audits to identify gaps and discrepancies, presenting findings in a report along with recommendations.
- Advising on and handling domain name/company name complaints.
- Instructing and managing work of foreign attorneys, including critically reviewing their invoices before approval.
- Supervising the review of watch notices and advising on possible oppositions.
- Assisting with management of portfolio disbursements, matter billing and client payment for their matters in a timely and efficient manner to help improve matter profitability (including liaising with specialist trade mark billers and credit control teams).

Job title

Associate/Senior Associate
(Trade Mark Attorney)

Recruiting manager

Alison Cole

Department

Technology IP & Information

Working hours

Monday to Friday (09:30 – 17:30)

Working at least 3 days a week from our offices.

Location

London or Cambridge

Perm/FTC

Permanent

Salary

Competitive

Working pattern

Taylor Wessing supports agile working, and the Talent Acquisition team would happily have conversations with potential candidates about how we could support agile or flexible working needs.

The opportunity for you

Key responsibilities

- Proactive contribution to business development, offering thought leadership and building the profile of the firm in this area, e.g. building and using a network of contacts, writing articles and securing their publication, attending industry events and being actively involved in industry organisations, public speaking including webinars and our annual TW Brands Forum event.
- Assisting partners to develop and strengthen existing client relationships and build new ones.
- Participation in client pitch preparations and attending pitch meetings
- Working with partners on issues of pricing and giving (and managing compliance with) cost estimates for filing, recordal, clearance or other projects.
- Volunteering ideas to improve business practices.
- Actively contributing to internal know how and at team meetings, e.g. giving internal training, reviewing cases for internal discussion sessions.
- Being a supervisor for trainee trade mark attorneys and providing career guidance and development to help them through the CITMA qualification process.

Knowledge, skills & experience

The role is intended to be a mid to senior trade mark lawyer/attorney role, perhaps up to about 10 years PQE (but this will not be determinative). There is no need for a client following.

We are looking for a candidate experienced with working autonomously and directly with clients to manage their portfolios in a wide range of industry sectors and capable of managing, supervising and developing a team. One or more of those portfolios will be reasonably substantial and active.

Experience of handling cases at the UKIPO and EUIPO is essential, as is working with foreign associates. Any experience working in an in-house trade mark department of a brand owning company could be useful but is not required. Candidate should preferably be a CITMA qualified attorney, but other qualifications will be considered.

The following skills are essential:

- A real enthusiasm for trade mark law, a passion for brands and self-motivation.
- Sound judgment on merits and risks of claims, reflecting experience and commercial reality.
- Good oral and written communication and advocacy skills.
- Strong attention to detail and accuracy in work.
- Strong academics and technical ability.
- Well organised and ability to prioritise and manage their own high volume workload
- Commercially astute and practical.
- Ability to quickly engender trust and rapport with team members and many different types of clients.

Technology IP & Information

Our UK Brand Protection practice sits within our 75-strong UK Technology IP & Information (TIPI) group. The Team members are located in our London, Liverpool or Cambridge offices, with no difference between the type of clients and nature of work undertaken in each office. The brands practice is part of our wider international TIPI practice which is one of the most highly respected around the world. Due to the strength and depth of our expertise, Taylor Wessing has an outstanding reputation in the field of IP and IT.

The team advises global clients on a wide range of IP issues through the full lifecycle of a business, and across a large variety of matters. Our international Brand Protection practice is not just one of the largest practices of its type, it is also among the top rated, with a major international trade mark filing and portfolio practice that is strategically core to the firm. Taylor Wessing has been consistently ranked Band 1 for Brand Management in Legal 500 and top tier by WTR1000, with a number of team members individually identified as leaders in their field.

This, together with the variety of the brands we represent across all business sectors, means that we have outstanding experience in every area of trade mark and design law. By integrating all aspects of trade mark and design practice into one team, we provide a full IP service, advising not just on clearance, prosecution and portfolio management, but also anticipating, avoiding and handling disputes and litigation. Advising clients ranging from those with extensive international portfolios to SMEs and start-ups, we have an excellent track record in successfully resolving high-profile and complex brand disputes throughout Europe and Asia. We have recently added core IP/IT strength to our Dubai office and also offer full brand protection services across the MENA region.

Technology IP & Information



Roland Mallinson

Partner, London

[Click to view full CV](#)

Roland is the head of our Brands practice in the UK and co-heads the international trade mark group. For over 30 years, he's advised major international brand and technology owners on their IP rights.

Clients describe Roland as a tactically smart, solutions-focused, and commercially-minded. He's responsible for protecting the name, logos, shapes, colours and packaging for numerous household name brands in a wide range of sectors. These include food and beverage, FMCG, fashion, luxury goods, tech, financial services, auto industry and travel.

Roland advises on the full range of contentious and non-contentious "soft" IP matters, including: trade mark, designs and copyright disputes and litigation, lookalikes, anti-counterfeiting, domain name and content infringements, trade mark clearance, prosecution, oppositions and strategic portfolio advice, comparative advertising, and all types of commercial transactions involving these rights.



Alison Cole

Partner, London

[Click to view full CV](#)

Alison is a senior Chartered trade mark attorney in our IP & Media team. With over 20 years of experience, Alison advises clients in all areas of brand protection including contentious and non-contentious trade mark matters, such as trade mark clearance, prosecution, oppositions, settlements and strategic portfolio advice, as well as on design and domain name issues. She also acts in commercial dealings of these rights such as assignments and licensing.

Alison has particular expertise in obtaining protection for unusual trade marks. She advises clients across a range of sectors including in social media, fashion and transport, managing their worldwide trade mark portfolios and protecting their brand. Alison is a Fellow of CITMA, an active member of INTA and a Fashion For Good mentor.

About us

Taylor Wessing is a global law firm that serves the world's most innovative people and businesses.

Deeply embedded within our sectors, we work closely together with our clients to crack complex problems, enabling ideas and aspirations to thrive. Together we challenge expectation and create extraordinary results. By shaping the conversation in our sectors, we enable our clients to unlock growth, protect innovation and accelerate ambition.

Our UK sector focus



Technology, Media
& Communications



Private Wealth



Real Estate,
Infrastructure & Energy



Life Sciences
& Healthcare

Our areas of expertise

- Banking & Finance
- Brands & Advertising
- Commercial & Consumer Contracts
- Competition, EU & Trade
- Copyright & Media Law
- Corporate Crime & Compliance
- Corporate/M&A & Capital Markets
- Data Protection & Cyber
- Disputes & Investigations
- Employment, Pensions & Mobility
- Environmental, Planning & Regulatory
- Financial Services Regulation
- Information Technology
- Patents & Innovation
- Private Client
- Private Equity
- Projects, Energy & Infrastructure
- Real Estate & Construction
- Restructuring & Insolvency
- Tax
- Venture Capital

Challenge expectation, together

With our team based across Europe, the Middle East, US and Asia, we work with clients wherever they want to do business. We blend the best of local commercial, industry and cultural knowledge with international experience to provide proactive, integrated solutions across the full range of service areas.

1200+ lawyers | **300+** partners | **28** offices | **17** jurisdictions

About us

The way we work

At Taylor Wessing, we never settle for average. We're creative thinkers, problem solvers and continuous learners who excel at what we do and believe our best work is still ahead of us. We are a firm that's large enough for you to achieve your ambitions, but connected enough to be a true community.

You are joining an inclusive culture that allows you to be yourself and balance your work and home commitments. You'll gain access to high-end technology, agile processes and the trust to deliver your best work in a flexible way whilst spending the balance of your time with colleagues in our offices.

Employee development and career progression

We are committed to fostering an environment of continuous professional growth. Our dedicated approach to employee development ensures that each member of the firm receives the support and resources necessary to achieve their career aspirations. In line with this commitment, we have tailored development plans that align with both individual goals and our firm's strategic vision.

For a detailed look at these development opportunities and how they can support your career progression, please refer to our [Always Learning Brochure](#). This document will provide an in-depth view of our commitment to skill development and show you the support network available as you advance within Taylor Wessing.

About us

Investing in you | Tailored benefits

Your wellbeing is always our priority and we are proud to offer bold and progressive ways of working alongside an excellent range of benefits and perks designed to support you and your family.

Key benefits

- 25 days' annual leave
- Life assurance
- Group personal pension – salary sacrifice
- Income protection
- In-house GP service

Health and wellness benefits

- Private medical insurance (individual)
- Health assessments
- Dental insurance
- Critical illness insurance
- Flu vaccinations
- Eye tests
- Employee assistance programme
- GymFlex
- Counselling sessions

Lifestyle benefits

- Cloud Nine – our subsidised restaurant and coffee bar (London only)
- Enhanced family leave – after one year qualifying service, you are entitled to up to 26 weeks leave full pay if you or your partner give birth or adopt a child
- Cycle to work scheme
- Payroll giving
- Technology loan
- Health cash plan
- National Art Pass
- Mortgage surgeries
- Interest free season ticket loan
- Salary sacrifice electric car scheme (UK staff only)

Our values

What we stand for

We are a community of independent thinkers, connected by our values and our drive to challenge expectation. Our values shape what we do and how we do it. We have built a team that reflects the firm's core values and which exemplifies inclusivity. To learn more, [click here](#).

Excellence

Creative

Responsible

Team

Integrity

Respect

Acting responsibly, together

We're committed to being a responsible business and taking accountability for our actions.

We have high ethical standards and take care of our people. We're reducing the footprint we leave in nature and engaging with our communities through cultural and charity work. Being a responsible business means we're active members of our broader society, of the legal community, and of our clients' sectors.

Whether it's building an inclusive workplace, reducing our waste or supporting the arts; we're actively working together to build a better business, and a more sustainable world.

Find out more about our responsible business initiatives [online](#).

Read our latest impact report by clicking the link below.



Our Responsible Business Impact Report 2023

Diversity & Inclusion

Mansfield Certification



Taylor Wessing UK is proud to have achieved Mansfield Rule UK certification for a second year running and has committed to participating for a third year!

We're committed to delivering an inclusive culture and a progressive environment where we empower all our people to lead, learn and grow. The Mansfield Rule keeps us and the wider legal profession accountable for achieving and surpassing these goals; over the last year alone the Mansfield Rule has helped us continue to focus on monitoring our recruitment and promotion activities, as well as improving the diversity of our firm.

We've seen tangible changes in our firm from championing diverse voices across all areas of our business, something we want to see continue to flourish in the years to come and with Mansfield as a key partner in building in an inclusive environment for all.

To read more about this fantastic achievement please [click here](#)

Inclusive Recruitment Charter

Take a look at our new Inclusive Recruitment Charter...

The Charter builds on some of our great initiatives from the last year, like taking part in the 10,000 Black Interns programme, introducing mandatory inclusion training for all our people, and achieving Mansfield Certification Plus.

Learn more about our commitments to being a responsible business by [clicking here](#)

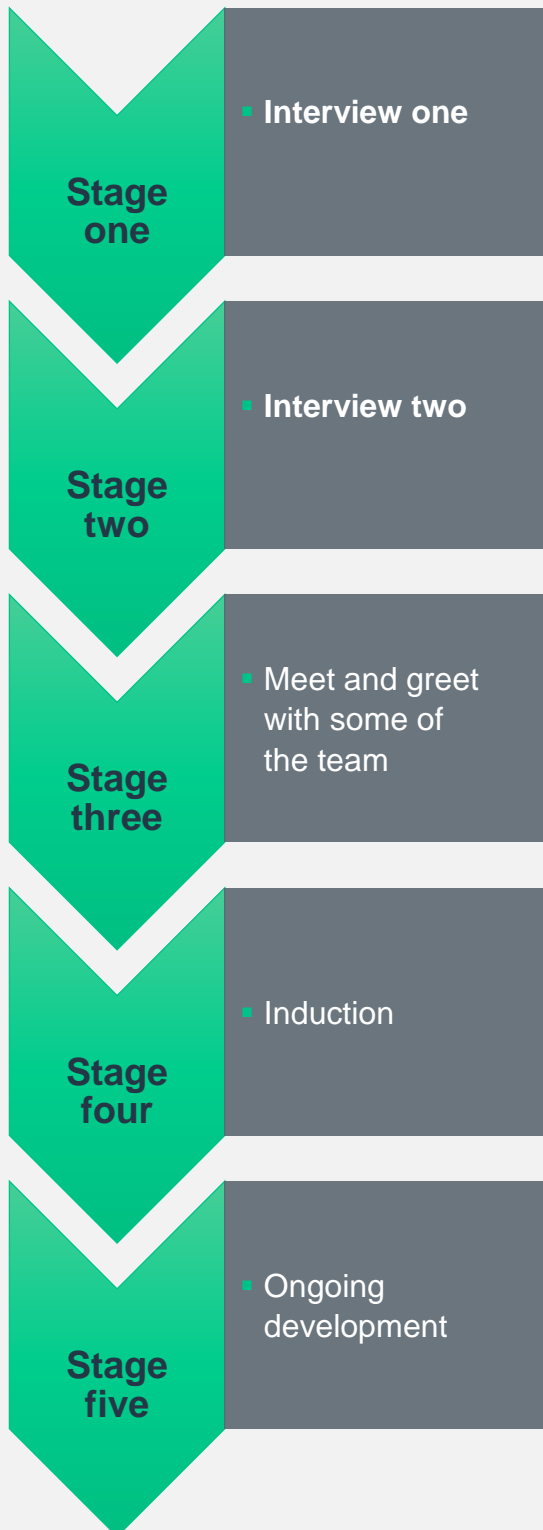
Responsible Business Networks

We embrace individuality and bring diverse teams together, creating an inclusive work environment where all of our talent can flourish. Our inclusion programme has five priority areas, each with partner champions and network groups, in addition to other networks and societies that bring people together within the responsible business programme.

Our current networks include:

- Arts Society
- Balance in Business - our gender balance network
- Cultural Diversity network
- equaliTW - our LGBTQ+ network
- Family Matters network
- Social Mobility network
- Sustainability network
- Wellbeing network

Your recruitment journey



Rob Fowler
Head of Talent Acquisition
+44 20 7300 4841
r.fowler@taylorwessing.com



Hannah Jackson
Senior Recruitment Manager
+44 203 077 7262
h.jackson@taylorwessing.com



Sara Gordon
Senior Talent Acquisition Manager
+44 1513355139
s.gordon@taylorwessing.com



Kendell Woods
Recruitment Advisor
+44 151 335 5192
k.woods@taylorwessing.com



Lottie Williams
Recruitment & Onboarding Advisor
+44 151 335 5191
ch.williams@taylorwessing.com



Daniel Cheasley
Senior Recruitment Advisor
+44 20 7300 4965
d.cheasley@taylorwessing.com

Please contact us if you require any adjustments to your application or our recruitment process.

2000+ people
1200+ lawyers
300+ partners
28 offices
17 jurisdictions

Argentina*	Buenos Aires	Mexico*	Mexico City
Austria	Klagenfurt Vienna	Netherlands	Amsterdam Eindhoven
Belgium	Brussels	Nicaragua*	Managua
Brazil*	Belo Horizonte Brasilia Rio de Janeiro São Paulo	Panama*	Panama City
Chile*	Santiago de Chile	Poland	Warsaw
China	Beijing Hong Kong Shanghai	Portugal*	Braga Lisbon Porto
Colombia*	Bogotá Bogotá, main office	Puerto Rico*	San Juan
Costa Rica*	Guanacaste San José	Republic of Ireland	Dublin
Czech Republic	Brno Prague	Slovakia	Bratislava
Dominican Republic*	Santo Domingo	South Korea**	Seoul
Ecuador*	Cuenca Guayaquil Manta Quito	Spain*	Barcelona Canary Islands Madrid Pamplona Seville Valencia Vitoria Zaragoza
El Salvador*	San Salvador	UAE	Dubai
France	Paris	Ukraine	Kyiv
Germany	Berlin Düsseldorf Frankfurt Hamburg Munich	United Kingdom	Cambridge Liverpool London
Guatemala*	Guatemala	Uruguay*	Montevideo
Honduras*	San Pedro Sula Tegucigalpa	USA	New York San Francisco
Hungary	Budapest		

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www.taylorwessing.com

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