IP Proficiencies Matrix – Trademarks

Intellectual Property Proficiencies
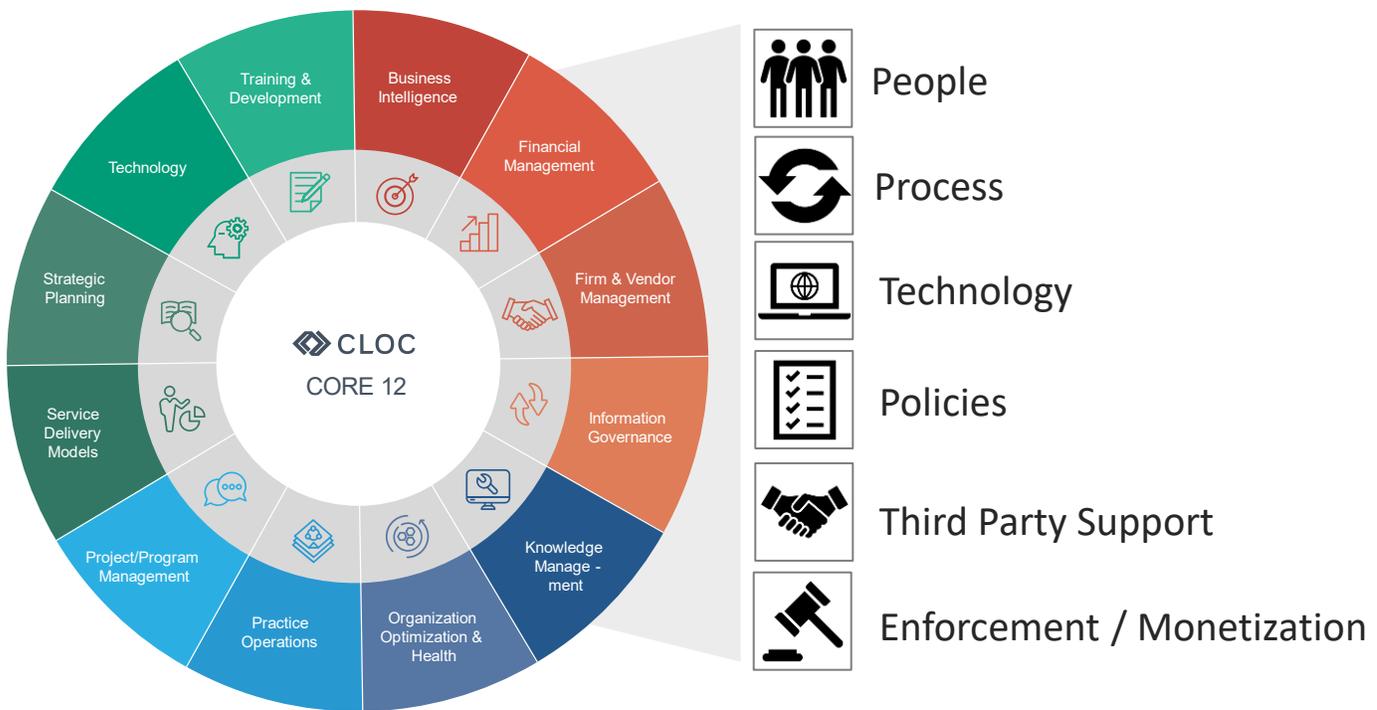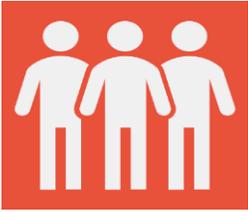
PEOPLE

PEOPLE Proficiency Assessment

Developing	Foundational	Advanced	Mature
• Individual contributors with no coordination or management, including lack of centralized management focusing on efficiency and/or balance of work. • Lack of prioritization of work to be performed - fire hose vs. faucet. • Lack of deep subject matter expertise in rules and US/global jurisdiction IP office procedures. • Lack of development roadmap for skills growth or career advancement. • Lack of defined approach or assigned responsibility of general office management tasks (HR, billing, records, IT, systems, etc.) • Lack of established invoice management/billing review. All functions managed manually and individually.	• Practices shared informally within working groups or decentralized teams. • SME in the areas of TM clearance, prosecution, enforcement, maintenance, and docketing. • Administrative support staff for routine general tasks and word processing needs. • Decentralized managers/lack of discrete teams for various functions (paralegals, docketing, admin/WP, IT, records). • No centralized individual(s) who establish skill set roadmaps and coordinate development efforts. • Lack of single point of contact or ownership/SME for various work streams or records management. • Ad hoc training and development in use of research/analytics databases. • Invoicing support to review and manage invoices. In house, invoices reviewed by individual practitioners; OC invoices managed by central individual. • General core HR individual(s) to manage employee relations, payroll and performance.	• Dedicated teams formed to provide services within functional areas (e.g., eBilling, docketing, renewals, filing, IT systems support, records management), with established functional managers. • Coordination of customer numbers and practitioner registration numbers to allow visibility, tracking and organization of portfolios and TEAS access. • Centralized function to establish skill set roadmaps and coordinate development efforts. • Single point of contact or ownership/SME for various work streams or records management. • Coordinated training and development in use of research/ analytics databases and best practices. • Centralized invoice and billing management individual(s) responsible for all aspects of eBilling, inquiries, and serving as an escalation point. • Basic LPO/PMO individuals to manage projects across the department and provide updates to management	• Enterprise level team established with team charter, clear roles and responsibilities, led by a professional with a seat on the relevant brand executive/management committee. • Security/Privacy officer to ensure ongoing understanding and compliance with GDPR, and other global regulations. • Established LPO/PMO to manage projects across the department/ organization. This individual works with practice management and leadership to map projects to strategy and manage resource allocation, budget/scope and project reporting/dashboards. • Training and development individual to drive adoption of tools, processes and other key learning opportunities. This individual leads change management function and compliance.

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PEOPLE Proficiency
Actions & Tasks to Move to a More Mature Level

Developing	Foundational	Advanced	Mature
	• Exchange operational practices informally to share knowledge and develop common ways of working.	• Establish a centralized IP operations team including functional teams led by dedicated functional managers in the areas of docketing, renewals, filing, eBilling, IT systems, records management and vendor management.	• Create an enterprise-level team with a team charter with clear roles and responsibilities for team members and led by a professional with a seat on the relevant trademark executive/management committee.
	• Establish an administrative support team for routine general tasks.	• Develop skill set roadmaps for team members to coordinate and encourage professional development efforts.	• Hire a dedicated Security/Privacy officer to ensure ongoing understanding and compliance with global regulations (e.g., export control, GDPR).
	• Identify SME/SPOC in the areas of TM prosecution and docketing.	• Create and deliver coordinated training to team members and customers on relevant IP operations systems, processes, research/analytics databases and best practices.	• Hire a dedicated professional to oversee training, development and change management to drive understand and adoption of tools, processes and other key learning opportunities.
	• Provide ad hoc training for systems and the use of research/analytics databases.	• Centralize responsibility for invoice and/or billing management and identify a SPOC responsible for all aspects of eBilling and all related inquiries.	• Establish a project management function to manage operations-related projects across the organization. Ensure projects align with and support IP strategy and are managed within budget.
	• Establish a process for invoice review and support.	• Identify team member(s) with basic project management skills to manage operations-related projects and provide updates to management.	• Establish a team to focus on business intelligence, legal research and analytics.
	• Identify an HR business partner to manage team development, payroll and performance.		

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PROCESS

PROCESS Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Analytics	• Lack of metrics, quality review, or KPI's for in-house legal professionals and staff and OC/vendors.	• Basic data quality and performance metrics generated for management.	• Ability to monitor process metrics for compliance and to identify trends.	• Robust and well-defined data quality and audit capabilities/measured KPI's managed on routine basis with centralized ownership. • Regular strategy-driven planning sessions based on data/metrics that allow the organization to respond proactively to opportunities and challenges, and new product launches.
Asset Management	• Minimal or non-existent management of IP assets; rely on OC for asset reporting and tracking.	• IP assets are actively tracked and managed in-house, by OC, or a hybrid approach.	• Well defined process for in-house vs. OC/vendor management of assets and data which allows for flexibility/agility of approach. • Comprehensive rating program for portfolio assets that maps to company strategy. • Well-defined acquisitions and divestitures process for management of assets.	• Clearly established best practices for asset management with routine compliance reviews and quality measurement.
Change Management	• Absence of standard operating procedures and in-house change management expertise.	• Central repository for procedures with reviews at a defined cadence and basic change management process for advising organization of changes.	• Annual strategy planning process to identify change needs or address new opportunities.	• Established change management/knowledge management practices for all processes and data. • Active knowledge management and change management committees. • Routine reviews and compliance checks for adoption of new processes.

PROCESS Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Docket Management	• No central oversight of deadline/docket compliance.	• Automated deadlines managed through centralized docket system with law engine/jurisdiction laws. • Some manual processing required. • Docket provided to attorneys on set schedule, may still be manual for designs, copyright.	• Law engine logic is kept up-to-date for applicable TM jurisdictions, other jurisdictions and IP types may still require manual update. • All deadlines are automatically driven via workflows and (regularly updated) law engine logic. Attorneys can self-serve docket with some ability to filter, sort, etc.	• Law engine logic kept up-to-date for all jurisdictions and IP types.
Jurisdictional Filing	• Domestic filing only.	• Filing in multiple jurisdictions. • Foreign filing decisions made ad hoc / last minute and not mapped to a portfolio strategy.	• Defined process for reviewing foreign filing decisions and WIPO (Madrid Protocol) phase filings that is mapped to portfolio and overall business strategy. • Synergy between domestic and foreign outside counsel to ensure common approach to coverage globally.	• Formalized foreign filing strategies mapped to /strategic value/global market opportunities with analytics/AI to assist in selection.
Knowledge Management	• No system in place to share best practices / best-in-class work product. • Templates based on individual preferences.	• Various processes shared between small groups.	• Basic knowledge management program to bring consistency across similar work groups; repository for information sharing.	• Formalized knowledge management program with single-sourced repository, ability for cross-team input, possibly including Q&A bots and chat features.
Onboarding/ Training IP Legal Department Employees	• Information consistent onboarding program for new hires; new employees learn about existing processes and systems from co-workers.	• General onboarding process for all new hires with training available on IP-related and other key business systems, e.g., docket systems, and processes. • Attorney and staff training as needed on changes in the law and developing trends in the practice area.	• Structured onboarding materials for each IP functional area with required trainings (privacy/security, ethics, export control, trade secret and other items deemed business critical). • Process for monitoring compliance and gathering feedback for further refinement.	• Dedicated onboarding portal providing customized materials for each new hire based on their individual role/responsibilities and assigned mentor to assist with training and relationship- building internally and with OC.

PROCESS Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
			• Training about, and exposure to, company's lines of business. • Regular cadence of trainings on legal trends and best practices.	• Regular, deep-dive training on company's current and future lines of business and strategy that affect IP. • Robust ongoing legal education offerings to ensure teams kept abreast of trends in the industry and best practices learnings. • Automated mechanism for ensuring compliance, tracking attendance and gathering feedback.
Outside Counsel Management	• Each in-house attorney chooses which OC to use; no centralized coordination and no consistency of standards.	• Centralized management of OC selection and use with reviews of provider selection on ad hoc basis. • Ad hoc quality reviews of in-house and OC/vendor work.	• Well-defined and evangelized OC procedures for TM drafting, prosecution and ongoing coordination. • RFP process to solicit competitive bids from IP firms to ensure best-in-class pricing models, technology support, and strategic IP thinking. Could be used to develop Preferred Provider network. • Routine feedback process for ongoing management of quality and timeliness. • Periodic review of OC and jurisdiction for compliance with FCPA.	• "Outside Counsel Days" held at regular intervals to encourage IP landscape and Patent Office knowledge sharing. • ML/AI capabilities for analyzing OC/vendor impact against strategy, and value propositions against cost. • Automated/real-time review of OC and jurisdiction for compliance and FCPA.

PROCESS Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Record Management	• Paper file system.	• Hybrid paperless and electronic processing of TM files.	• Primarily paperless, limited use of paper files.	• 100% digital, except for storage and tracking of original signature documents and trademark registration certificates
Renewal/ Maintenance Fees	• Renewals managed by OC or international counsel directly.	• Foreign renewal process managed by experienced vendor and U.S. MFs paid by in- house staff.	• U.S. MF's and renewals globally managed by reputable provider with ongoing reviews for cost measures.	• All global renewals/MFs (trademark) managed by reputable provider with incorporated analytics to drive pay decisions.
Reporting	• Reporting done manually through spreadsheets on as- needed basis.	• Basic reporting capabilities through system or simple reporting platform. • Subscription reports may be available.	• Well-established reporting platform providing ability to produce real-time. • Rich data/analytics around portfolio contents and strength • Both self-service and subscription reports available.	• Advanced reporting capabilities enabling deeper data analytics and business intelligence by combining multiple data sources, e.g., marrying trademark data with finance data (e.g., costs per application by jurisdiction, comparative cost assessment by OC), ability to generate specialized dashboards with advanced representations of data.
Submission/ Review	• Little to no solicitation of ideas by IP legal staff; employees approach IP legal staff with trademark submissions ad hoc.	• Intermittent trademark submission conducted; basic education of employees on documenting their work to assist with submissions.	• Formal trademark submission program in place, including regular rotating meetings with different BUs; in-house team stays abreast of industry developments to inform filing decisions and guide inventors. This may include OC or vendor support and coordination of trademark submission.	• Employees and attorneys submit trademark submissions in real time at regular meetings.

PROCESS Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Tax Issues	• Lack of defined tax planning, registration ownership, intercompany licenses.	• Manual process for managing tax planning and needs.	• Well defined tax plan for trademark ownership, licensing and intercompany licenses with clearly defined workflows and escalation path. • Engagement with internal and OC local jurisdiction tax counsel 'as necessary'.	• Close coordination with company tax planners and tax counsel to ensure consistency. • Established cadence for auditing and refreshing program on recurring basis.
Technology	• No established technology processes.	• Ad hoc audits for asset management/docketing data quality and system health checks.	• Routine/ongoing audit process to ensure asset management/docketing data quality, system health, workflow efficiency and law-engine accuracy and compliance.	• AI-supported audit capabilities for real time monitoring of asset management/docketing data quality, system health, workflow efficiency and law-engine accuracy and compliance. • Ongoing, regular reconciliation of assets and docketing deadlines between in-house and OC docketing systems to ensure accuracy.
TM Prosecution Task Manager	• Reliance on vendor or OC to manage all clearance, drafting, preparation, and opinion work.	• Hybrid in-house and external management of clearance, drafting, preparation, opinion work.	• Defined strategy for in-house versus outside resourcing hybrid model to manage all clearance, drafting, preparation, opinion work.	
Vendor Feedback	• No process for soliciting feedback internally or externally.	• Ad hoc feedback solicitation process.	• Routine feedback solicitation process with ongoing in-house reviews to address quality, compliance and cost issues with OC/vendors.	• Established OC/vendor feedback committee who routinely reviews and shares feedback, driven by quality and timeliness metrics. • Standardized Service Level Reports, including benchmarking and performance improvement tracking, regularly shared with OC/vendors.

PROCESS Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Vendor / OC Billing Arrangements	• No structured review of invoices and payments.	• Basic process for reviewing invoices and managing payments. • Some analytics around reviewing multiple bills across matters handled by one OC.	• IP group-wide, standardized process for reviewing invoices and payments process. • Analytics around reviewing multiple bills across matters and across OCs.	• Sophisticated, automated system for reviewing invoices, processing payments, and interacting with vendors related to errors. • Extensive/in-depth analytics across bills, matters, OCs to identify issues/trends and extended audit capabilities.
Workflow	• Informal/inconsistent and undocumented workflows and processes. • Workflows based on individual preferences. • No automation of process/workflows.	• Primarily standardized process/workflows and documentation/SOPs implemented. • Hybrid use of automation and manual processes/workflows.	• Well-defined process/workflow documentation. • Emphasis on automation as a general approach when defining process/workflows. • Automation of most process/workflows with limited need for manual solutions. • Ability to monitor for compliance and identify trends. • Evolving workflows that address real time needs	• Robust, well-defined processes implemented electronically. • Documented workflows for each business process within a department. • Process ownership and escalation/approval path for changes.

PROCESS Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
General		• Standardize basic/required process for general use by internal staff. • Identify metrics for determining satisfaction of operational goals and adherence to procedures. • Develop reports for general use (e.g. attorney docket report) & management (e.g. metrics on number of cases assigned to each attorney to monitor workload). • Develop Standard Operating Procedure (SOP) documents for each process managed by operations (including processes driven/executed by external vendors (e.g. outside counsel). • Create general onboarding process for all new hires with training available on IP-related and other key business systems.	• Develop process and mechanism for operations to monitor compliance with standard processes and identify trends. • Engage with business groups to improve team-specific processes and expand number of standardized processes. • Evolve and expand metrics to ensure operational goals are being met at deeper level and derive business operational intelligence. • Expand report library to include cross-functional reports and deeper management reports based on improved metrics. • Update and expand on SOP documentation. • Develop mechanism to solicit and incorporate user feedback. • Formalize onboarding materials for each IP functional area with required trainings (e.g., privacy/security, ethics, export control, trade secret, tax and other items deemed business critical).	• Develop process ownership matrix with escalation/approval paths for changes. • Evolve and expand metrics to ensure operational goals are being met at deeper level and derive business operational intelligence. • Manage KPIs on routine basis with centralized ownership. • Develop advanced reporting capabilities enabling deeper data analytics and business intelligence by combining multiple data sources. • Collate SOP documentation and other KM into a single-sourced repository having ability for cross-team input, possibly including Q&A bots and chat features. • Develop dedicated onboarding portal providing customized materials for each new hire based on their individual role/responsibilities and assigned mentor to assist with training and relationship- building internally and with OC.

TECHNOLOGY

TECHNOLOGY Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Billing	• Light touch or invoice management system and/or no electronic billing solution ("e-billing").	• Invoice management or e-billing solution allowing for invoice review and scalable payment system.	• E-billing solution that allows full visibility (e.g. client/matter, task level spend)with established approval workflows and escalations. • Ability to customize solution to fit different business models, billing requirements (e.g., monthly v. project completion), and fee arrangements (e.g., fixed fees, block billing, flat fees, accounting potential future success fees, etc.) • Light touch outside counsel feedback mechanism to measure and analyze effectiveness in view of overall spend.	• Electronic feedback mechanism for capturing input on vendors/OC fed into reporting platform. • Extensive analytic capabilities to track spend/feedback/practice area/geographic region/ and output for a full view of vendors/OC impact and effectiveness.
Filing Management	• Paper/fax filings by credit card or direct payment means and no use of electronic filing or deposit accounts.	• Joint USPTO Customer Number(s) with OC. • Primary filing mechanism is through EFS Web or electronic means. OC handles all filing.	• USPTO Customer Number and Deposit Account established. • All filings managed electronically with automated USPTO PAIR scrapes and use of Global Dossier.	• Automated reconciliation of patent office information against L O B tool. • Automated ability to upload file histories directly into system. • Automated ability to download USPTO outgoing correspondence and bibliographic information from PAIR.

TECHNOLOGY Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Infrastructure	• No IP- focused tools	• Minimal/out-of-the-box IP specific tools	• Custom-tailor IP specific tools. Cloud-leveraged tools based on defined strategy and risk profile. • IP specific tools integrated with standard business tools (communications, plug-ins, DMS, billing, etc.) • IP specific tools integrated with standard business tools (communications, plug-ins, DMS, billing, etc.)	• Use of AI and machine learning technologies (automated program or other technology) to replace routine manual tasks or answer questions.
IP System	• No technology or unsophisticated docketing system for tracking IP assets. IP assets tracked in spreadsheet(s) or no tracking at all; trade secret and copyright assets may not be tracked at all.	• TM assets in electronic IP management system with full docketing capabilities; trade secret and copyright assets tracked in spreadsheet(s). • Trademark docketing systems may be distinct from Patent. • Regular cadence of law updates and system kept relatively current with upgrades (no more than 2 upgrades behind).	• Queries, reports and templates available for managing TM assets, including docketing deadlines and reminders; trade secret and copyright assets integrated into electronic management system. System will produce seamless reports with corresponding logos, images and designs.	• Dashboard(s) available to IP professionals (and other stakeholders, e.g., inventors) for real-time visibility and management of IP assets (e.g., trademark families and prosecution status, products, licensing, contracts, marking/virtual marking, clearance and search data, enforcement actions, cease & desist tracking, customs registrations). • Use of technology for ongoing automated reconciliation of assets and docketing deadlines between in-house and OC to ensure accuracy and compliance with Patent Office deadlines.

TECHNOLOGY Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
IT Support Model	• Lack of IT support in the areas of security, privacy, systems integrations and systems management for office systems.	• Designated IT resource (s) to manage in-house tools and mitigate issues, with no development capabilities. Basic knowledge / understanding of privacy and security.	• Established IT group with sufficient expertise in privacy and security as demonstrated through high standards applied to system. • IP-focused IT experts to manage systems and integrations with some support and development capabilities, and responsibility for ensuring best practices applied to security/privacy standards. • Regular training and knowledge around general tool/software usage. • Basic security/privacy practices are established and managed.	• Developer expertise and proficiency to build, implement and integrate tools in-house.
New Mark Submission and Clearance	• Marketing submits requests via email; reviewed manually on ad hoc basis.	• Requests for clearance and filings (trademarks) through IP Management system; reviewed manually on a regular cadence.	• Clearance and filing request submittals flow through a workflow process related to accepting a request, clearing mark and filing a new application, etc.	• Established system of requests, integrated with key systems (e.g. document management) and mining and co-development opportunities. All submissions are managed "end to end (e.g., clearance, filing, prosecution."
Record Management	• Paper files and/or no files maintained on assets.	• Combination of paper and electronic management of case files.	• Document management capabilities to store file histories and communications with minimal paper required. • In-house intranet to house all key documents, processes, and information that is shared across the organization and centrally managed.	• Fully integrated IP docket system and document management system through direct integration or APIs. • Sophisticated data retention capabilities allowing for automated management/purging of relevant materials

TECHNOLOGY Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
			• Data retention policies implemented into tools with routine/timed reviews and purge mechanisms. • System ability for OC to upload documents directly into IP asset management system.	
Reporting	• No reporting platform or capabilities to extract relevant data without manual interventions.	• Ability to produce real-time docket reports and track deadlines either in-house or through OC. Ability to provide basic portfolio data and metrics through system reporting or basic platform/tool.	• Comprehensive reporting • platform enabling ability to combine data sources, produce metrics around portfolio assets, and track costs associated with the portfolio, in-house or via OC. • Data science expertise sufficient to establish reports and data models/cubes. • Integrations/APIs between LOB tool and other key business tools (e.g., with finance data).	• Sophisticated reporting platform with cross-group integration providing ability to accurately forecast spend and predict trends through use of technology and data models, in-house or via OC, also enabling visibility to IP licensing deals, monetization, etc. • Six Sigma quality metrics around docketing/data processing with automated reporting/audit capabilities. To compare internal and external sources • Machine Learning/AI capabilities applied to portfolio analysis/strength and review of competitor landscape. • Established data science practices and expertise.

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TECHNOLOGY Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Research Tools	• Research done through internet or other free sources.	• Research tools/subscriptions relevant to practice area.	• Suite of research tools/systems for portfolio and legal analysis./	• Custom -tailored research solutions and integrations.
Security & Privacy	• Little or no security/privacy focus leaving information generally unprotected.	• Basic security and privacy standards applied to all tools.	• Export control and GDPR restrictions applied to all LOB tools. • Security review of all LOB tools and systems housing MBI/HBI data.	• In-depth security reviews performed on all systems with assigned data stewards, expanded beyond EU data. • Established compliance standards for security/privacy with strict oversight. • AI capabilities to search across systems and documents for unprotected or unsecure data/information.
Workflow	• No established workflows or consistency of work product. Ad hoc management of day- to-day work with no direct oversight or measurement.	• Generally established workflows with basic procedural documentation • Light touch or minimal oversight of compliance with general workflows, but stronger management of key risk areas.	• Workflows available to manage process steps with clear documentation and compliance audits. • Automation and optimization of workflows for routine tasks. • Introduction of Machine Learning/AI capabilities to workflows and portfolio analysis.	• Machine Learning/AI capabilities applied to workflows and routine tasks. • Majority of routine tasks fully automated with KPI's and audit abilities to ensure quality.

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TECHNOLOGY Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
Billing		• Establish invoice management mechanism that allows for submission and review of invoices by individuals, and a basic payment system.	• Establish electronic invoice management system that allows for submission and review of invoices, customization, escalations and integrated reporting capabilities.	• Establish electronic invoice management system with extensive automation and feedback mechanisms to measure spend against OC performance.
Filing Management				• Establish automated reconciliation of trademark office data against IPMS, and automated file download/upload capabilities.
General Tools		• On premise management of tools/IPMS and possibly some Cloud adoption	• Establish productivity tools for use in various work streams, and use of ML/AI to gain insights into further optimization opportunities. • Leverage cloud hosted solutions	• Use of BOTS/automated technology to replace routine manual tasks and inquiries.
IP System		• Establish IP asset management system with managed service agreement and regular cadence of law updates	• Establish IP asset management system with fully integrated reporting solutions and electronic file management.	• Establish IP asset management system with fully integrated reporting solutions and electronic file management. • Establish fully integrated dashboards allowing for visibility across IP, financial and other data sources that provides real- time data. Automated reconciliation of data and deadlines.
IT Support Model		• Establish IT support model that manages in-house tools with defined standard level of security practices established.	• Establish IT support model incorporating industry best practices for security/privacy, with expertise sufficient to manage integrations and minor development activities.	• Establish IT support model operating under industry best practices, with deep expertise in integrations, security and system development.

TECHNOLOGY Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
New Mark Submission and Clearance		• Establish mark submission mechanism with routine review cycle	• Establish mark submission tool with established workflows for clearance, review and decision making.	• Fully integrate mark submission and clearance tool with end-to-end workflow management and use of technology in making filing decisions.
Record Management		• File management system for paper and/or electronic management of IP files, with simple tracking mechanism	• Establish electronic file management/document management system with possible integrations for management of IP files and other business documentation with established data retention standards and ability to manipulate permissions based on business needs.	• Establish fully integrated document management system with the ability to identify and mark confidentiality of information, and automate data retention. AI capabilities to search across systems for unsecured/trade secret information and escalations.
Reporting		• Establish basic reporting system for extraction and manipulation of portfolio information from IP management system	• Establish reporting platform for extraction and manipulation of portfolio information from IP management system and other systems, with data science expertise sufficient to build data models for extraction.	• Fully integrate extensive reporting platform across business groups; integrated data models leveraging data science expertise, ML/AI; automated audit functionality capable of measuring to six sigma quality standards.
Research Tools		• Basic level research tool system or subscription for searching of IP data	• Establish suite of in-house research tools or subscriptions for searching of IP data and legal research purposes.	• Implement a variety of research and analytics tools, licensed or homegrown, to support various business practice areas.
Workflow		• Basic level of workflows established within business tools	• Establish workflows with high levels of automation across workstreams, documentation and defined audit steps for compliance measurement.	• Develop workflows that are primarily automated with ML/AI capabilities applied for further learning and optimization.

POLICIES

POLICIES Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Billing	• No policy regarding number or types of OC/vendors or fee structures.	• Established basic fee structure requirements (e.g. task-based billing; fixed fee per matter), applied across all patent prosecution matters; limitations on number of different prosecution OC/vendors established. • Billable hour work with some discussion of budgets.	• Trademark -specific policy requirements included in formal, fully vetted billing policy, incorporated into retention agreements and enforced consistently. • Hybrid of fixed/AFA and billable hour work.	• Retentions of OC are primarily AFA.
Conflicts, Outside Vendors	• Undefined conflicts review policy when utilizing OC or vendors.	• Defined conflicts review policy applied consistently and department-wide, with practice area specific differences as needed.	• Expanded policy regarding treatment of conflicts with regard to specific competitors.	• Requirements for nature of client base established and enforced (e.g., OC cannot represent non-practicing entities; or cannot represent generic producers, in pharma space). • Committee review of conflicts- based reassessment of competitors, and audit of OC representation to ensure compliance.
Inventor/ Contributor Awards	• No program.	• Ad hoc recognition for employee identification of third -party infringers/counterfeiting.	• Formal incentive program for employee identification of third-	
Portfolio Management	• No strategy or policy regarding portfolio size, composition, filing decisions, or jurisdictions.	• Basic policy/strategy regarding filing decisions and budget in place • Portfolio occasionally streamlined to manage costs • Periodic valuations of trademarks in portfolio performed.	• Comprehensive policy/strategy in place to align the portfolio with business needs. • Established streamlining program conducted on a routine basis with cross group input (global brand, business units and trademark attorneys).	• Protection decision framework established (registration vs common law use) and aligned with overall corporate strategy • Portfolio streamlined at regularly occurring intervals.

POLICIES Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
Privacy and Security	• Undefined privacy and security standards.	• General privacy and security policy as supported by line of business tool(s) and permissions provisioned.	• Well defined security/privacy policy that addresses GDPR and other privacy issues as they relate to IP practice group. • Semi-regular audits to ensure compliance.	• Best in class security/privacy policies incorporating all aspects of GDPR and privacy best practices relating to the IP practice group with established audits. • Automated escalations for identified breaches or risks.
Training/ Education	• Lack of defined or mandated trainings regarding the trademark process, employee obligations and ongoing education re: developments/trends in the industry.	• Basic onboarding and training materials provided to new hires that includes trademark process, employee obligations and ongoing education re: developments/trends in the industry.	• Established onboarding with trademark/IP best practices included in employee orientation. • Ensure consistency of training across the organization.	• Regular, ongoing company-wide education conducted, or reminders sent, re: trademark/IP practices and policies.

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POLICIES Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
Billing		• Determine fair fixed-fee/cap for trademark applications if OC is used; set and enforce budgets for hourly-fee retentions.	• Formalize retention agreement for prosecution matters; centralize for use across all matters.	
Conflicts, Outside Vendors		• Develop and Introduce written policy regarding treatment of conflicts uniformly applied across all Legal depts. (e.g., policy on advance conflict waivers, whether there are practice-area specific conflict policies).	• Expand policy regarding treatment of conflicts with regard to specific competitors.	• Require annual review by vendors of current conflict footprint.
Ownership of IP Rights		• Work with HR/Employment to develop basic provisions, for inclusion in a confidentiality or other agreement, specifying the company's ownership rights in IP developments by employees. • Ensure provisions are in compliance with local and foreign laws.	• Further develop provisions to ensure consistency of language and approach across the organization and employment types (e.g., non-employees, vendors, interns, etc.). • Include explanation of provisions in new employee orientation presentations	
Portfolio Management		• Sell/abandon trademarks occasionally to reduce maintenance costs	• Determine targets for portfolio size, budget, and geographic coverage in conjunction with the size, scope, and market of the company	• Schedule regular, ongoing meetings with business units to determine level of necessary trademark protection and identify holes in portfolio

POLICIES Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
Privacy and Security		• Work with IT to define and distribute general privacy/security policy to IP team. • Establish and implement basic permissions in support of the general privacy and security policy.	• Implement basic GDPR-compliant privacy and security policies • Perform semi-regular audits to measure compliance with privacy and security policies.	• Research and implement best- in-class privacy (including GDPR) and security policies that relate directly to the IP group. • Schedule audits at regular intervals to measure compliance with privacy nd security policies • Implement automated escalations of identified breaches or risks
Training/ Education		• Work with HR to include basic written materials in new employee orientation that explain the mark submission and clearance process, company ownership of IP.	• Expand written materials in new employee orientation to teach best practices regarding mark submission and clearance, prosecution, maintenance and enforcement.	

THIRD PARTY SUPPORT

THIRD PARTY SUPPORT Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
General	• Full reliance on 3rd party vendors to perform work without oversight or visibility into efficiencies. • Conversely, no use of 3rd party vendors to offset work volumes or leverage expertise.	• Hybrid use of in-house and 3rd party vendors (or no vendors at all)/OC for defined workstreams. • OC hires and manages all other 3rd party vendors (e.g., searchers, foreign counsel, translation). • General understanding of best practices for engaging with 3rd party vendors.	• Use of OC for broad range of services including analysis/charting and routine patent and TM prosecution/drafting. • Identification of appropriate outside counsel in jurisdictions that require local OC to act on behalf of the applicant. • Use of 3rd party vendors for strategy and planning, competitor analysis and portfolio valuations. • Well-defined strategy of cost savings through use of external vendors as quantified by measured ROI. • Use of RFP process to select 3rd party vendors. • Comprehensive review and implementation of best practices for engaging with 3rd party vendors • General onboarding process for 3rd party vendors.	• Established joint in-house and outside vendor team with integrated processes, KPI's and established audit/metrics management. • Quality control function to ensure SLA's are met. • 3rd party vendor team with deep business understanding and partnership model. • Coordinated onboarding and routine oversight of vendor support with dedicated manager focused on ensuring synergy, efficiency and ROI. • Implemented best practices for engaging with 3rd party vendors with regular review and revision to capture most current best practices.

THIRD PARTY SUPPORT Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
General		• Ad-hoc work and/or projects sent out to 3rd party vendor as needed (i.e., to alleviate existing backlog) • Conduct as-needed meetings with 3rd party to review outsourced work and address pending issues	• Establish outsourced relationship, when feasible and appropriate, for the following tasks including but not limited to (in addition to Foundational tasks). 1) Docketing - Trademark office correspondence entered in IPMS to generate deadlines, maintain accurate records and document portfolio information. Includes second eye quality assurance review and weekly PTO history audits to ensure no correspondence has been missed to be docketed 2) Prosecution Support - Administrative support required for various types of preparations and filings during the course of prosecution 3) Foreign Filing Support - Administrative support to instruct the filing of non-US applications 4) Renewal Services - Provide administrative support to clients in managing Trademark Renewals handled via their own agent network	• Establish outsourced relationship, when feasible and appropriate, including but not limited to (in addition to Foundational and Advanced tasks): 1) Notice of Allowance Review - Complete review of the US prosecution history to provide valuable summary of prosecution which includes a review package, allowed claims, and Issue fee transmittal. 2) Portfolio Acquisition Services - Provide administrative assistance when acquiring new portfolios, including new matter creation and data validation for online countries. 3) Invoice Management - Reviewing, approving and paying agent invoices on behalf of the client in a centralized function with accounting expertise 4) Registration Issue Fee Payments 5) Recordals - Trademark recordals/title updates in response to corporate restructuring or mergers and acquisitions

CLOC CORPORATE LEGAL OPERATIONS CONSORTIUM

Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
General			• Define established and consistent work and/or projects to be managed by 3rd party vendor using fixed price billing or FTE model. • Conduct cost/time effort estimation analysis to determine whether or not to use 3rd party vendor • Assess internal controls and policies and determine appropriate levels of internal risk management for critical vs. non-critical activities • Develop method to solicit feedback on cost, accuracy, reliability of 3rd party vendor • Understand legal regulations, compliance controls, and legal recourse options based on selected 3rd party vendor • Understand 3rd party vendors' risk management levels and processes, training of personnel, data security and protection levels and procedures (creation, storage and destruction)	6) Portfolio Transfers – Merger and acquisition related portfolio data transfer, integration and data validation 7) Search and Analytics - initial symantec searches, clearances, trademarks, infringements 8) IP Portfolio Valuation – Economic valuation of IP assets for tax, M&A, remuneration, and other purposes 9) Royalty Compliance - Monitoring, audit, and recovery of royalties derived from IP assets • Conduct cost/time effort estimation analysis to determine whether 3rd party vendor work should be located locally, abroad in a lower cost location, or a blend of both, subject to regulatory and other considerations • Document "client playbook process" and incorporate 3rd party vendor "best practices" with all changes made through controlled sign off process • Establish in-house project management transition team.

THIRD PARTY SUPPORT Proficiency
Actions & Tasks to Move to a More Mature Level

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General			• Create measurement system that includes measurement of the key performance indicators (KPIs) and Service Level Agreements (SLAs) which govern and indicate the status and quality of the process. KPIs included are: 1) Quality - The Quality metrics are formulated based on our experience of similar projects and tasks and also include specific client requirements and expectations 2) Turn Around Time (TAT) - TAT metrics measures our service to meet client expectations in terms of timely delivery • Monitor success of 3rd party vendors by obtain monthly reports detailing metrics on quality, turn-around-time and volumes across all services, and conducting standing meetings and regular audits around KPIs, SLAs, and other performance metrics. General onboarding coordination for all 3rd party vendors.	• Formalize 3rd party support process using the following defined phases for effective change management: 1) Transition Planning - Conduct kick-off call, define resources, tasks, roles and responsibilities, and communication plan, define and document as-is workflows and processes and metrics, review existing process documentation, define control plan for identified issues or defects 2) Knowledge Transfer - Define and document to-be workflows, processes, reports and metrics, ensure IT/system connectivity and setup, provide onsite/remote training 3) Testing - Conduct pilot production, conduct QC, monitor performance, provide feedback, re-train if necessary, sign-off on process 4) Implementation - Continually monitor process, SLAs, conduct regular post-implementation business reviews and regularly implement enhancements

THIRD PARTY SUPPORT Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
General				• Conduct face to face partnership/business review of 3rd party vendor teams and resources to discuss all elements or services, potential enhancements, and any areas of concern. Conduct workshop to fine tune processes and implement any necessary service improvements. • Ensure ISO and export control compliance and periodically review security policies and controls to ensure confidentiality, integrity and security of data. Coordinate onboarding to ensure 3rd party vendor awareness of company policies and procedures • Establish strategic partnership with 3rd party vendor by leveraging available strategic consulting capabilities to ensure IP operations are aligned with overall business objectives and industry standards • Utilize single IPMS with access for 3rd party vendor with appropriate security limitations • Utilize budget planning technology for financial reporting to ensure proper resource allocation and realized cost savings

ENFORCEMENT / MONETIZATION

ENFORCEMENT / MONETIZATION Proficiency Assessment

CATEGORY	Developing	Foundational	Advanced	Mature
General	• No outbound licensing or enforcement program. • No anti-counterfeiting program (if applicable).	• Outbound license terms established/form created; targets monitored informally and contacted ad hoc. • Infringement and counterfeiting addressed on an ad hoc basis as they are discovered.	• Formal licensing program established; targets systematically contacted; litigation filed when necessary; business units consulted regularly to coordinate with, and avoid harming, strategic relationships. • Formal monitoring and watch system for identifying infringement and counterfeiting.	• Comprehensive strategy formed as to all targets in relevant markets; license tracking integrated with other document management systems; licensees audited regularly for payment term compliance. • Comprehensive strategy for identifying third party infringement and counterfeiting. Implemented best practices for engaging with 3rd party vendors and OC to facilitate cost effective and efficient enforcement actions.

CLOC
CORPORATE LEGAL OPERATIONS CONSORTIUM

ENFORCEMENT / MONETIZATION Proficiency
Actions & Tasks to Move to a More Mature Level

CATEGORY	Developing	Foundational	Advanced	Mature
General		• Establish outbound license terms and template. • Monitor market and licensing targets informally and contact ad hoc. • Consult with business units before contacting any target to protect strategic relationships.	• Establish formal licensing program by monitoring and contacting targets systematically and filing litigation when necessary. • Educate management/finance about the risks/rewards, and financial support needed, for the licensing program, including funding litigation and defending company trademarks. • Consult regularly with business units to protect strategic relationships and to learn about market participants and threats. • Hire dedicated employee(s) to focus on licensing program. • Create license database. • Establish an team of relevant subject matter experts to address infringement and counterfeiting to address on an ad hoc basis.	• Establish committee that includes Legal, Finance, and business units to form comprehensive strategy (e.g., license, litigate/seek injunction, JV/partnership, status quo) as to all market participants. • Integrate license database with other document management systems (e.g. trademark portfolio, contracts), to track encumbrances on company trademarks. • For running royalty/lump sum installment licensing fee arrangements, regularly audit licensees to ensure compliance with payment terms. • Enforcement/Monetization] Hired dedicated employee(s) to address infringement, counterfeiting with responsibility for engaging relevant stakeholders and establishing a strategy (and budget) for addressing issues systematically.