

The Docketing Excellence Webinar Series



TOP 3 PATENT DOCKETING VULNERABILITIES AND UNRECOVERABLE DATES

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Overview

- Unrecoverable docketing errors
- Process vulnerabilities
- Preventative measures

Top 3 Unrecoverable Docketing Errors

1. US Deadlines

- Deadline to claim priority to U.S. provisional applications

2. Foreign filing deadlines

- Paris Convention deadlines
- Patent Cooperation Treaty (PCT) deadlines

3. Maintenance Fee / Annuity Deadlines

US Deadlines

- **Deadlines to claim priority to U.S. provisional applications**
 - *“a nonprovisional application that was filed more than 12 months after the filing date of the provisional application, but within 14 months after the filing date of the provisional application, may have the benefit of the provisional application restored by filing a grantable petition (including a statement that the delay in filing the nonprovisional application was unintentional and the required petition fee) to restore the benefit under 37 CFR 1.78.”*

<http://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent>

Foreign Filing Deadlines

- Paris Convention deadlines
 - Six months from priority date for design patents
 - Twelve months from priority date for utility patents
- 30/31 Month National Phase deadlines (PCT Chapter I or II)
 - Examples: 31 Month Countries (EP, AU, KR), 32 Month Countries (CN) & 42 Months (CA)
 - http://www.wipo.int/pct/en/texts/time_limits.html

Maintenance Fee Deadlines

- **Deadlines to pay maintenance fees or annuities**
 - **US Maintenance Fees**
 - 37 CFR 1.378 provides for acceptance of delayed payment of maintenance fees in the US
 - Beware of situations with shared responsibility for a maintenance!
 - **Foreign Annuity Payments**
 - Maybe difficult or impossible to revive

Process Vulnerabilities

Why are these docketing errors problematic?

- These deadlines are unforgiving
- These deadlines can be tricky to docket
- Even if properly docketed, these deadlines can easily be inadvertently crossed-off

Process Vulnerabilities

Where and when do these errors frequently occur?

- File opening process
- File transfer / intake process
- Docket cross-offs

File Opening Process

Common Errors during routine file opening:

- Priority date not transferred from a previous file
- Priority date is transferred, but error is made in entering date
- Multiple priority dates for single new file due to multiple provisional filings

File Transfer / Intake Process

Common Problems during File Transfer / Intake Processes include:

- New **unfiled application Vs. application filed** by a previous counsel and later transfer to your firm.
- Don't always receive **accurate information**. Client Reference # is only provided and a title (sometimes incomplete).
- Receive **multiple reports** (Mismatch).
- A **docket report with due date** is not always received.
- Don't always receive **file history** from client or previous counsel. It becomes an issue when you don't have access to the Country Patent Website.
- Need to file **Rev POAs** ASAP. Issues with Assignments
- Not enough staff to intake files in a timely manner
- Complicated process that increases chances for errors

Docket Cross-offs

- Cross-offs in the day-to-day docketing process
- Cross-offs in the transfer in process
 - Make sure all reports received are reviewed. Some will match and others will have extra information. Most of the time priority information will be missing.
 - Confirm information received is updated and accurate.
 - Always go with what the Country Patent website indicates.

Preventative Measures

- ✓ For file transfers, it is critical to get full docket from transferring firm, and immediately double check that the docket covers all transferred patent files
- ✓ Immediately triage all files so that all files with near term docket deadlines are added to docket ASAP
- ✓ Double check all docketing for transferred files – this is a time when mistakes can easily be made
- ✓ For cross-offs, verify all cross-offs of unrecoverable deadlines, to be certain there is not a single point of failure
- ✓ For docketing of foreign filing deadlines, verify all priority dates used to calculate the deadlines
- ✓ Dual docket all unrecoverable foreign filing deadlines.
- ✓ Scrape priority dates from PAIR files, and perform automated verification of priority dates

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Thank you for your participation.

Questions?

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September 28, 1 PM Central